

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BIO-TECHNE CORP. and PROTEINSIMPLE,
Petitioners,

v.

CALIPER LIFE SCIENCES, INC.,
Patent Owner.

Cases: IPR2016-00139 (Patent 6,834,240 B2)
IPR2016-00227 (Patent 6,430,512 B1)
IPR2016-00228 (Patent 7,426,442 B2)¹

Before KRISTEN L. DROESCH, BEVERLY M. BUNTING, and
JO-ANNE M. KOKOSKI, *Administrative Patent Judges*.

KOKOSKI, *Administrative Patent Judge*.

TERMINATION
Dismissing the Petitions
37 C.F.R. §§ 42.5(a), 42.71(a)

¹ This Order addresses identical issues in each of three related cases. We exercise our discretion to issue one Order to be entered in each case.

IPR2016-00139 (Patent 6,834,240 B2)
IPR2016-00227 (Patent 6,430,512 B1)
IPR2016-00228 (Patent 7,426,442 B2)

On May 10, 2016, with Board authorization, the parties filed joint motions to terminate these proceedings (Paper 7),² along with what they indicated is a true copy of their written settlement agreement (Ex. 2001). The parties indicated in their joint motions that they “have settled their dispute and have reached an agreement to, among other things, file a motion to terminate” the instant proceedings. Paper 7, 2. On the same day, the parties also filed joint motions requesting that the settlement agreement be treated as business confidential information and kept separate from the patent files. Paper 8.

These matters are preliminary proceedings³ and decisions on whether to institute trial have not been made. Further, under 37 C.F.R. § 42.74(b), “[a]ny agreement or understanding between the parties made in connection with, or in contemplation of, the termination of a proceeding shall be in writing and true copy shall be filed with the Board before the termination of the trial.” The parties have filed what they indicated is a true copy of their written settlement agreement, which they represent constitutes the entire agreement between the parties with respect to these *inter partes* reviews. Paper 7, 3. Under these circumstances, it is appropriate to dismiss these Petitions for *Inter Partes* Review. This paper does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

² The parties filed similar papers in each of the instant proceedings. We refer to those filed in Case IPR2016-00139 for convenience.

³ A preliminary proceeding begins with the filing of a petition for instituting a trial and ends with a written decision as to whether trial will be instituted. 37 C.F.R. § 42.2.

IPR2016-00139 (Patent 6,834,240 B2)
IPR2016-00227 (Patent 6,430,512 B1)
IPR2016-00228 (Patent 7,426,442 B2)

As requested by the parties, the settlement agreement will be treated as business confidential information and kept separate from the patent files. 37 C.F.R. § 42.74(c).

Accordingly, it is

ORDERED that the joint motions to terminate Cases IPR2016-00139 (Paper 7), IPR2016-00227 (Paper 8), and IPR2016-00228 (Paper 7) are *granted*;

FURTHER ORDERED that the Petitions for *Inter Partes* Review in Cases IPR2016-00139, IPR2016-00227, and IPR2016-00228 are *dismissed*; and

FURTHER ORDERED that the parties' joint requests that the settlement agreement (IPR2016-00139, Ex. 2001; IPR2016-00227, Ex. 2005; IPR2016-00228, Ex. 2004) be treated as business confidential information, to be kept separate from the patent files, are *granted*.

IPR2016-00139 (Patent 6,834,240 B2)
IPR2016-00227 (Patent 6,430,512 B1)
IPR2016-00228 (Patent 7,426,442 B2)

PETITIONER:

Erik B. Milch
Jennifer Volk-Fortier
Frank Pietrantonio
COOLEY LLP
emilch@cooley.com
jvolkfortier@cooley.com
fpietrantonio@cooley.com

PATENT OWNER:

Bernard J. Knight
Kenneth Cheney
MCDERMOTT WILL & EMERY
bknight@mwe.com
kcheney@mwe.com