

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ELI LILLY AND COMPANY,
Petitioner,

v.

LIFE MOLECULAR IMAGING SA,¹
Patent Owner.

Case IPR2018-00115
Patent 9,592,308 B2

Before ZHENYU YANG, JENNIFER MEYER CHAGNON, and
TIMOTHY G. MAJORS, *Administrative Patent Judges*.

MAJORS, *Administrative Patent Judge*.

DECISION

Termination of the Proceeding
35 U.S.C. § 317(a) and 37 C.F.R. § 42.72
Granting Request to Treat Settlement Document
as Confidential Business Information
35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c)

¹ Patent Owner filed updated mandatory notices indicating a corporate name change. See Paper 15. We update the caption correspondingly.

On September 25, 2018, with Board authorization, the parties filed a joint motion to terminate this proceeding (Paper 16), along with what they indicate is a true copy of their written settlement agreement (Ex. 1044). In their joint motion, the parties indicate that they “have resolved their dispute and executed a settlement agreement in which the parties agreed to request termination of this proceeding.” Paper 16, 1. The parties further contend that other factors (e.g., the early stage of the trial, that a Patent Owner Response has not yet been filed, and conservation of Board resources) favor termination of the proceeding. *Id.* at 1–2.

On September 25, 2018, the parties also filed a joint motion requesting that the settlement agreement be treated as business confidential information and kept separate from the file of U.S. Patent No. 9,592,308 B2. Paper 17, 1.

Under 35 U.S.C. § 317(a), “[a]n inter partes review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” We instituted a trial in this proceeding on May 16, 2018 (Paper 9). The proceeding is still at a relatively early stage and the Board has yet to decide the merits of Petitioner’s challenge.

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 a true copy shall be filed with the Board before the termination of the trial.” The parties have filed what they indicate is a true copy of their written settlement agreement (Ex. 1044). The parties further indicate that, aside

from the present proceeding, they are not aware of any other case pending before the Patent Office or U.S. litigation related to U.S. Patent No. 9,592,308 B2. Paper 16, 2. In view of the foregoing, we determine that it is appropriate to terminate this proceeding without rendering a final written decision. See 37 C.F.R. §§ 42.72, 42.74.

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

Accordingly, it is

ORDERED that the parties' joint motion to terminate the proceeding (Paper 16) is *granted*;

FURTHER ORDERED that the parties' joint request that the settlement agreement (Ex. 1044) be treated as business confidential information (Paper 17) is *granted*; and

FURTHER ORDERED that this proceeding is hereby *terminated*.

IPR2018-00115
Patent 9,592,308 B2

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