

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FUJIFILM CORPORATION, FUJIFILM MEDICAL SYSTEMS USA, and
FUJIFILM TECHNO PRODUCTS CO., LTD.,
Petitioners,

v.

HOLOGIC, INC.,
Patent Owner.

IPR2018-00595 (Patent 7,688,940 B2)
IPR2018-00672 (Patent 8,452,379 B2)¹

Before MEREDITH C. PETRAVICK, BRIAN J. McNAMARA, and
MATTHEW S. MEYERS, *Administrative Patent Judges*.

PETRAVICK, *Administrative Patent Judge*.

ORDER
Granting Joint Motions to Terminate Proceedings
and
Granting Joint Requests to Treat Settlement Agreement as
Business Confidential Information
35 U.S.C. § 317; 37 C.F.R. §§ 42.72, 42.74

¹ This Order addresses the same or similar issue in the proceedings listed above, and we issue one Order to be filed in each proceeding.

On February 1, 2019, Petitioners and Patent Owner filed Joint Motions to Terminate the above-identified proceedings (Paper 32²) along with true copies of their written Settlement Agreement made in connection with the termination (Ex. 1037). Petitioner and Patent Owner also filed Joint Requests to treat the settlement agreement as business confidential information. Paper 31. We authorized these filings via email on January 18, 2019. For the reasons set forth below, we grant the Motions and Requests.

Under 35 U.S.C. § 317(a), an *inter partes* review proceeding shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Patent and Trademark Office has decided the merits of the proceeding before the request for termination is filed. These proceedings are in the early stages, and we have not yet decided the merits.

“If no petitioner remains in the *inter partes* review, the Office may terminate the review or proceed to a final written decision under section 318(a).” 35 U.S.C. § 317(a). All Petitioners in this *inter partes* review are seeking termination. The Board has discretion to terminate this review with respect to Patent Owner.

Under 35 U.S.C. § 317(b), any agreement or understanding between Patent Owner and Petitioners, including any collateral agreements referred to in such agreement or understanding, made in connection with, or in contemplation of, the termination of the proceeding shall be in writing, and a true copy of such agreement or understanding shall be filed in the Office. The parties state that they have settled their dispute concerning the patents at issue and have reached a written agreement to terminate the proceedings.

² For purposes of expediency, we cite to the papers filed in IPR2018-00595.

Paper 32, 2. In support of the joint motions, the parties submitted a true copy of the Settlement Agreement. Ex. 1037.

Upon consideration of the Motions, we grant the Motions and terminate the above-referenced proceedings as to both Petitioner and Patent Owner without rendering a final written decision. 37 C.F.R. § 42.72. We also grant the Requests to maintain the Settlement Agreement as business confidential information in accordance with 37 C.F.R. § 42.74(c).

ORDER

Accordingly, it is:

ORDERED that the Motions to terminate the above-referenced proceedings are *granted*;

FURTHER ORDERED that the Requests that the Settlement Agreement be treated as business confidential information, to be kept separate from the files of the above-referenced patents, and made available only under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), are *granted*; and

FURTHER ORDERED that the above-referenced proceedings are terminated with respect to both Petitioner and Patent Owner.

IPR2018-00595 (Patent 7,688,940 B2)

IPR2018-00672 (Patent 8,452,379 B2)

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