

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BAYLOR COLLEGE OF MEDICINE,
Petitioner,

v.

THE BOARD OF REGENTS OF THE
UNIVERSITY OF TEXAS SYSTEM,
Patent Owner.

IPR2018-00948 (Patent 8,728,806 B2)
IPR2018-00949 (Patent 9,333,248 B2)¹

Before ZHENYU YANG, CHRISTOPHER G. PAULRAJ, and
JOHN E. SCHNEIDER, *Administrative Patent Judges*.

YANG, *Administrative Patent Judge*.

DECISION
Settlement Prior to Institution of Trial
37 C.F.R. § 42.74

¹ This Order addresses an issue common to each referenced case. We, therefore, issue a single order to be entered in each case. For convenience, paper numbers refer to those filed in IPR2018-00948.

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IPR2018-00949 (Patent 9,333,248 B2)

Baylor College of Medicine (“Petitioner”) filed a Petition (Paper 1), seeking an *inter partes* review of claims of U.S. Patent Nos. 8,728,806 B2 and 9,333,248 B2. In each case, we authorized The Board of Regents of the University of Texas System (“Patent Owner”) to file a Motion to Dismiss based on the doctrine of sovereign immunity. Paper 8. We ultimately denied Patent Owner’s Motion to Dismiss (Paper 13), but granted its unopposed Motion to Stay to afford Patent Owner an opportunity to appeal the denials (Paper 16). The Federal Circuit affirmed our decision denying the Motion to Dismiss, and the mandate issued on February 25, 2021.

Thereafter, in a series of email communications with the Board, the parties informed the Board that they have reached an agreement, whereby Patent Owner would assign the challenged patents to Petitioner upon approval of the National Institute of Health (the “NIH”). Ex. 3001. The parties jointly requested, and the Board granted, several extensions during the NIH review period. *Id.*

On July 23, 2021, pursuant to 37 C.F.R. § 42.74 and 35 U.S.C. § 317(b), the parties filed a Joint Motion to Terminate each of the above-identified proceedings (Paper 18), along with copies of a Patent Assignment Agreement and an Amendment (Exs. 2002, 2003, collectively, “Agreements”). The parties also filed a Joint Request to keep the Agreements as business confidential information and to keep the Agreements separate from the files of the involved patents. Paper 19.

In the Joint Motion, the parties represent that they have reached an agreement to jointly seek termination of the above-identified proceedings, and that the filed copies of the Agreements are true and complete copies. Paper 18, 1, 3. The parties further represent that their Agreements resolve

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all currently pending disputes and proceedings (including Patent Office and district court proceedings) between the parties involving the above-identified patents at issue. Paper 18, 1–2.

The above-identified proceedings are at an early stage, as we have not yet decided whether to institute a trial in any of these proceedings. In view of the early stage of the above-identified proceedings and the settlement between the parties, we determine that good cause exists to terminate these proceedings with respect to the parties.

Additionally, upon review of the Joint Request that the Agreements be treated as business confidential information and be kept separate from the files of the respective patents, we determine that good cause exists to treat the Agreements between Petitioner and Patent Owner as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

Therefore, the Joint Motions and the Joint Requests are *granted*.

This Order does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

Accordingly, it is:

ORDERED that the Joint Motions (IPR2018-00948, Paper 18; IPR2018-00949, Paper 17) to terminate the above-identified proceedings are *granted*, and that IPR2018-00948 and IPR2018-00949 are *terminated* with respect to both Petitioner and Patent Owner;

FURTHER ORDERED that the Joint Requests (IPR2018-00948, Paper 19; IPR2018-00949, Paper 18) that the Agreements (IPR2018-00948,

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Exs. 2002, 2003; IPR2018-00949, Exs. 2002, 2003) be treated as business confidential information are *granted*; and

FURTHER ORDERED that the Agreements shall be kept separate from the files of the above-identified proceedings and from the files of the involved patents (U.S. Patent 8,728,806 and U.S. Patent 9,333,248).

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