

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AGILENT TECHNOLOGIES, INC.,
Petitioner,

v.

ROCHE SEQUENCING SOLUTIONS, INC.,
Patent Owner.

Case IPR2018-01781
Patent 9,790,543 B2

Before JON B. TORNQUIST, WESLEY B. DERRICK, and
JACQUELINE T. HARLOW, *Administrative Patent Judges*.

DERRICK, *Administrative Patent Judge*.

TERMINATION
Due to Settlement After Institution of Trial
35 U.S.C. § 317; 37 C.F.R. § 42.74

I. INTRODUCTION

Petitioner, Agilent Technologies, Inc., and Patent Owner, Roche Sequencing Solutions, Inc., (collectively “the Parties”) have jointly requested the the above-identified *inter partes* review proceeding be terminated, pursuant to a settlement. Following an email request on November 7, 2019, by the Parties for authorization to file a joint motion to terminate this proceeding, Judges Tornquist and Derrick issued an Order authorizing the Parties to file a joint motion to terminate the proceeding and a joint request to treat the settlement agreement as business confidential information. Paper 24. On November 15, 2019, the Parties filed a joint motion to terminate (Paper 25), a copy of a settlement agreement (Ex. 2015, “the Settlement Agreement”), and a joint request to treat the Settlement Agreement as business confidential information (Paper 26, “Joint Request Regarding Settlement Agreement”). A Board email to the Parties dated November 20, 2019, emphasized certain requirements set forth in the Order for the joint motion to terminate, and extended the time period for filing to November 21, 2019. The Parties then timely filed, on November 21, 2019, a joint motion to terminate (Paper 27, “Joint Motion to Terminate”), a copy of a license agreement (Ex. 2016, “the License Agreement”), and a joint request to treat the License Agreement as business confidential information (Paper 28, “Joint Request Regarding License Agreement”).

II. DISCUSSION

In the Joint Motion to Terminate, the Parties represent that they have settled their dispute as to U.S. Patent No. 9,790,543 B2 (“the ’543 patent”), stating that “Petitioner and Patent Owner [have] reached an agreement

resolving the dispute in [IPR2018-01781]” and that “all disputes between the parties regarding [the ’543 patent] have been resolved.” Paper 27.

The Parties also represent that the Settlement Agreement filed as Exhibit 2015 on November 15, 2019, is “a true copy of the written Settlement Agreement resolving the dispute in the above-captioned *inter partes* review” and that the License Agreement filed as Exhibit 2016 on November 21, 2019, is “a true copy of the License Agreement referred to in the Settlement Agreement.” *Id.* The Parties also “certify that there are no other collateral agreements or understandings made in connection with, or in contemplation of, the termination of this proceeding, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b).” *Id.*

We instituted a trial on the above-identified proceeding on March 22, 2019. Paper 5. We have not yet decided the merits of the proceeding, and a final written decision has not been entered. 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 request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” Section 317(a) also provides that, “[i]f no petitioner remains in the *inter partes* review, the Office may terminate the review[.]” Further, the Board expects that a proceeding will terminate after the filing of a settlement agreement. *See, e.g.*, Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). Notwithstanding that this proceeding has moved beyond the preliminary stage, under these circumstances, we determine that good cause exists to terminate this proceeding with respect to both the Petitioner and the Patent Owner.

In the Joint Request Regarding Settlement Agreement and the Joint Request Regarding License Agreement, the Parties ask that the Settlement Agreement and License Agreement, respectively, be treated as business confidential information and be kept separate from the file of the '543 patent. Papers 26, 28. After reviewing the Settlement Agreement and License Agreement between Petitioner and Patent Owner, we determine that it is appropriate to treat both the Settlement Agreement and the License Agreement as business confidential information, and to keep the documents separate from the files of the '543 patent, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

Therefore, the Joint Motion to Terminate, the Joint Request Regarding Settlement Agreement to treat the Settlement Agreement as business confidential information, and the Joint Request Regarding License Agreement to treat the License Agreement as business confidential are *granted*.

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

III. ORDER

Accordingly, it is

ORDERED that, as was timely requested by the Parties, both the Settlement Agreement, Ex. 2015, and the License Agreement, Ex. 2016, shall be treated as business confidential information and kept separate from the file of U.S. Patent No. 9,790,543 B2 pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c);

IPR2018-01781
Patent 9,790,543 B2

FURTHER ORDERED that the Joint Motion to Terminate this proceeding is *granted*; and

FURTHER ORDERED that the proceeding is *terminated*.

IPR2018-01781
Patent 9,790,543 B2

For PETITIONER:

Lauren Robinson
John Beynon
BUNSOW DE MORY LLP
lrobinson@bdiplaw.com
jbeynon@bdiplaw.com

For PATENT OWNER:

John Alemanni
Matthew Hinsch
Kathryn Wade
KILPATRICK TOWNSEND STOCKTON LLP
jalemanni@kilpatricktownsend.com
mhinsch@kilpatricktownsend.com
kwade@kilpatricktownsend.com