

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LABORATORY CORPORATION OF AMERICA HOLDINGS,
Petitioner,

v.

QUEST DIAGNOSTICS INVESTMENTS LLC,
Patent Owner.

IPR2019-01618
Patent 7,972,868 B2

Before SUSAN L. C. MITCHELL, JENNIFER MEYER CHAGNON, and
AVELYN M. ROSS, *Administrative Patent Judges*.

ROSS, *Administrative Patent Judge*.

TERMINATION

Due to Settlement After Institution of Trial and
Granting Request to Treat Settlement Agreement as
Business Confidential Information
35 U.S.C. § 317; 37 C.F.R. §§ 42.72, 42.74(c)

On September 18, 2020, with our prior authorization, Laboratory Corporation of America Holdings (“Petitioner”) and Quest Diagnostics Investments LLC (“Patent Owner”) (collectively, “the parties”) filed a Joint Motion to Terminate the *Inter Partes* Review. Paper 19 (“Motion”). Together with the Motion, the parties filed a copy of their written Covenant Not To Sue (Ex. 1038, “Covenant Not To Sue”), the Joint Stipulation and Order of Voluntary Dismissal with Prejudice from the District of Delaware (Ex. 1039, “Dismissal with Prejudice”), and a Joint Request to File the Covenant Not To Sue as Business Confidential Information Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Paper 20 (“Joint Request”).

The Board generally expects that a case “will terminate after the filing of a settlement agreement, unless the Board has already decided the merits.” *Consolidated Trial Practice Guide*, 86 (Nov. 2019)¹; see 35 U.S.C. §317(a) and 37 C.F.R. § 42.72. We instituted an *inter partes* review in this case on March 20, 2020. Patent Owner filed a patent owner response but, as noted by the parties, “Petitioner has not yet filed a reply, and Patent Owner has not yet filed its Patent Owner’s Sur-Reply.” Motion 2. Additionally, there has not been an oral hearing before the Board. *Id.* The parties indicate that the agreement reached resolves all disputes regarding US Patent No. 7,972,868, including the instant *inter partes* review and the related district court litigation. Motion 1–2; Ex. 1038, 1–2; Ex. 1039, 1. The district court litigation has been dismissed with prejudice. Ex. 1039, 1.

Under these circumstances, we determine that it is appropriate to enter judgment and terminate this proceeding without rendering a final written decision. See 35 U.S.C. § 317(a); 37 C.F.R. §§ 42.5(a), 42.72. After

¹ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

reviewing the Agreement, we find that it contains confidential business information regarding the terms of the settlement and that good cause exists to treat the Agreement as business confidential information to be kept separate from the patent file. *See* 35 U.S.C. § 317(b); 37 C.F.R. § 42.74(c). This Paper does not constitute a Final Written Decision under 35 U.S.C. § 318(a).

ORDER

In view of the foregoing, it is

ORDERED that the Joint Request to File the Covenant Not To Sue as Business Confidential Information (Paper 20) is *granted*;

FURTHER ORDERED that the Covenant Not To Sue (Ex. 1038) shall be treated as business confidential information and shall be kept separate from the patent file; and

FURTHER ORDERED that the parties' Joint Motion to Terminate the *Inter Partes* Review (Paper 19) is *granted* and this proceeding is hereby terminated.

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