

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NANOCELLECT BIOMEDICAL, INC.,
Petitioner,

v.

CYTONOME/ST, LLC,
Patent Owner.

IPR2020-00551
Patent 10,065,188 B2

Before LYNNE H. BROWNE, JO-ANNE M. KOKOSKI, and
JAMES A. WORTH, *Administrative Patent Judges*.

WORTH, *Administrative Patent Judge*.

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

Pursuant to our authorization, the parties filed a Joint Motion to Terminate and Joint Notice of Agreement Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74 (Paper 30, “Joint Motion to Terminate”) and a Joint Motion to File Settlement Agreement and Attachments 1–4 as Business Confidential Information Under 35 U.S.C. § 317(b) (Paper 31, “Joint Motion to File Settlement Agreement as Business Confidential”). The parties represent that NanoCollect Biomedical, Inc. (“NanoCollect” or “Petitioner”) and Cytonome/ST, LLC (“Cytonome” or “Patent Owner”) have reached a settlement agreement regarding their disputes relating to U.S. Patent 10,065,188. Paper 30, 1. The parties have submitted with their motions a true copy of the settlement agreement between Petitioner and Patent Owner and attachments. *Id.* at 2 (citing Ex. 1069–1073). The parties state that there are no collateral agreements. *Id.* The parties request that the Board treat this agreement as business confidential information and maintain the agreement separate from the file of the involved patent because the agreement comprises business confidential information. *Id.*; Paper 31, 1.

“An inter partes review instituted under this chapter shall be terminated with respect to any petitioner upon the joint 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.” 35 U.S.C. § 317(a). The Office has not yet decided the merits of the proceeding, which remains at an early stage. We determine that good cause exists to terminate the proceeding with respect to all parties without rendering a final written decision.

At the request of a party to the proceeding, the agreement or understanding shall be treated as business confidential information, shall be kept separate from the file of the involved patents, and shall be made available only to Federal Government agencies on written request, or to any person on a showing of good cause.

35 U.S.C. § 317(b). After reviewing the parties' settlement agreement, we find that the settlement agreement contains confidential business information regarding the terms of the settlement. We determine that good cause exists to treat the settlement agreement as business confidential information pursuant to 35 U.S.C. § 317(b).

It is

ORDERED that the Joint Motion to Terminate is *granted*;

FURTHER ORDERED that this proceeding is hereby terminated as to both Petitioner and Patent Owner;

FURTHER ORDERED that the Joint Motion to File Settlement Agreement as Business Confidential is *granted*; and

FURTHER ORDERED that the filed settlement agreement and attachments (Ex. 1069–1073) be treated as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) and also remain designated as “Parties and Board Only” in the Board’s electronic filing system.

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PETITIONER:

Michael T. Rosato

Lora Green

Douglas Carsten

Jad A. Mills

WILSON SONSINI GOODRICH & ROSATI

mrosato@wsgr.com

lgreen@wsgr.com

jmills@wsgr.com

dcarsten@wsgr.com

PATENT OWNER:

Kirt S. O'Neill

Daniel L. Moffett

Andy Rosbrook

Dorian Ojemen

AKIN GUMP STRAUSS HAUER & FELD LLP

koneill@akingump.com

dmoffett@akingump.com

arosbrook@akingump.com

dojemen@akingump.com

PETITIONER: