

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GLAXOSMITHKLINE BIOLOGICALS SA,
Petitioner,

v.

PFENEX INC.,
Patent Owner.

IPR2020-00962
Patent 8,530,171 B2

Before ULRIKE W. JENKS, SHERIDAN K. SNEDDEN, and
SUSAN L. C. MITCHELL, *Administrative Patent Judges*.

MITCHELL, *Administrative Patent Judge*.

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

At the request of the parties, the Board, on October 23, 2020, authorized Petitioner and Patent Owner (collectively referred to as “the parties”) to file a motion to terminate, settlement agreement, and motion to keep the settlement agreement business confidential. On October 30, 2020, pursuant to 37 C.F.R. § 42.74 and 35 U.S.C. § 317(b), the parties filed a Joint Motion to Terminate the above-referenced proceeding (Paper 10) and a Joint Request to file settlement materials as business confidential information and to maintain said materials separate from the public file (Paper 11 (“Joint Request”)), along with a copy of the confidential settlement materials (Ex. 1036 (“Settlement Agreement”)). Pursuant to the Board’s authorization on November 6, 2020, the parties filed on November 11, 2020, an Amended Joint Motion to Terminate containing a certification that there are no other agreements or understandings between the parties made in connection with, or in contemplation of, the termination of the above-referenced proceeding (Paper 13 (“Amended Joint Motion”)).

In the Amended Joint Motion, the parties represent that they have reached an agreement to jointly seek termination of this *inter partes* review proceeding, and that the filed copy of the Settlement Agreement is a true and complete copy. Paper 13, 1–2. The parties further represent that their Settlement Agreement resolves all currently pending Patent Office proceedings between the parties involving the 8,530,171 patent. *Id* at 2–4.

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

Additionally, upon review of the Joint Request that the Settlement Agreement be treated as business confidential information and be kept separate from the file of the patent involved in this *inter partes* proceeding, we determine that good cause exists to treat the Settlement Agreement 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 Amended Joint Motion and the Joint Request 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 Amended Joint Motion (Paper 13) to terminate the above-referenced proceeding is GRANTED, and IPR2020-00962 is TERMINATED with respect to both Petitioner and Patent Owner; and

FURTHER ORDERED that the Joint Request (Paper 11) that the Settlement Agreement (Ex. 1036) be treated as business confidential information and be kept separate from the files of the above-referenced proceeding and from the file of U.S. Patent No. 8,530,171 B2, under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), is GRANTED.

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Patent 8,530,171 B2

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