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Paper 39
Entered: December 10, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NEUMODX MOLECULAR, INC.,
Petitioner,

v.

HANDYLAB, INC.,
Patent Owner.

IPR2020-01133
Patent 8,415,103 B2

Before SHERIDAN K. SNEDDEN, JO-ANNE M. KOKOSKI, and CHRISTOPHER G. PAULRAJ, *Administrative Patent Judges*.

KOKOSKI, *Administrative Patent Judge*.

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

Petitioner (NeuMoDx Molecular, Inc.) and Patent Owner (HandyLab, Inc.) (collectively referred to as "the parties") indicate that they have reached an agreement to settle the above-identified *inter partes* review proceeding. The Board authorized the parties to file a joint motion to terminate the proceeding on November 12, 2021.

On November 15, 2021, pursuant to 37 C.F.R. § 42.74 and 35 U.S.C. § 317(a), the parties filed a Joint Motion to Terminate the above-identified proceeding (Paper 35 ("Joint Motion")) and a Joint Request to treat the settlement agreement as business confidential information and to keep said settlement agreement separate from the public file (Paper 36 ("Joint Request")), along with a copy of the confidential settlement agreement (Ex. 1256 ("Settlement Agreement")). The parties represent that the Settlement Agreement is "[a] true copy of the settlement agreement" by which the parties "have settled this proceeding, all related litigation, and all related proceedings before the Patent Office." Paper 35, 4–5; *see* Ex. 1256. In their Joint Motion, the parties "certify that there are no other written or oral agreements or understandings, including any collateral agreements, between them, including but not limited to licenses, covenants not to sue, confidentiality agreements, payment agreements, or other agreements of any kind, that are made in connection with or in contemplation of, the termination of the instant proceeding." Paper 35, 5. The parties request that the "Settlement Agreement . . . (Ex. 1256) filed concurrently herewith . . . be treated as business confidential information, [and] be kept separate from the file of the involved patent" and "kept separate from the files of this proceeding." Paper 36, 1; Paper 35, 5.

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 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." Section 35 U.S.C. § 317(a) also provides that if no petitioner remains in the *inter partes* review, the Office may terminate the review. We have not yet decided the merits of this proceeding, and a final written decision has not been entered. Because this proceeding has not yet advanced to a stage where an oral hearing has been held, we determine that it is appropriate to terminate the proceeding. After reviewing the Settlement Agreement between Petitioner and Patent Owner, 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).

We accordingly determine that it is appropriate to terminate this proceeding without rendering a Final Written Decision as to the patentability of the challenged claims of U.S Patent 8,415,103 B2, and *grant* the Joint Motion and Joint Request.

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

Accordingly, it is:

ORDERED that the Joint Motion to Terminate (Paper 35) is *granted*, and IPR2020-01133 is hereby *terminated* as to all parties;

FURTHER ORDERED that the Joint Request (Paper 36) to treat the Settlement Agreement (Exhibit 1256) as business confidential information is

granted, and the Settlement Agreement (Exhibit 1256) shall be kept separate from the files of the above-identified proceeding and from the file of U.S. Patent 8,415,103 B2, under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c); and

FURTHER ORDERED that the filed Settlement Agreement (Exhibit 1256) remain designated as "Parties and Board Only" in the Board's E2E system.

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