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Paper 36
Entered: August 9, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ILLUMINA, INC.,
Petitioner,

v.

TRUSTEES OF COLUMBIA UNIVERSITY
IN THE CITY OF NEW YORK,

Patent Owner.

IPR2020-00988 (Patent 10,407,458 B2)
IPR2020-01065 (Patent 10,407,459 B2)
IPR2020-01125 (Patent 10,457,984 B2)
IPR2020-01177 (Patent 10,435,742 B2)
IPR2020-01323 (Patent 10,428,380 B2)[1]

Before SUSAN L. C. MITCHELL, ZHENYU YANG, JAMES A. WORTH, ROBERT A. POLLOCK, MICHELLE N. ANKENBRAND, and DEVON ZASTROW NEWMAN, *Administrative Patent Judges*.[2]

PER CURIAM

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

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[1] This Order applies to each of the above-listed proceedings. We exercise our discretion to issue one Order to be filed in each proceeding. Unless otherwise authorized, the parties shall not use this heading style in any subsequent papers.

[2] This is not a decision by an expanded panel.

INTRODUCTION

With the Board's authorization, Petitioner and Patent Owner (collectively "the Parties") filed a Joint Motion to Terminate the above-identified proceedings due to settlement. Paper 32 ("Joint Motion").[3] In support of the Joint Motion, the Parties filed a Confidential Settlement Agreement (Ex. 1169 ("2021 Settlement Agreement")), as well as a Joint Request to File Settlement Agreement as Business Confidential Information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 33 ("Joint Request")). In our Order mailed July 23, 2021, we denied, without prejudice, the Joint Motion and the Joint Request because the 2021 Settlement Agreement refers to a collateral agreement, namely a 2017 Settlement Agreement, that had not been filed with the Board. Paper 35, 3. The Parties have now filed a copy of the 2017 Settlement Agreement (Ex. 1170 ("2017 Settlement Agreement")), as well as a Renewed Joint Motion to Terminate (Paper 37 ("Renewed Joint Motion")) and Renewed Joint Request to File Settlement Agreement as Business Confidential Information (Paper 38 ("Renewed Joint Request")).

II. DISCUSSION

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

[3] Unless otherwise noted, Paper and Exhibit numbers herein refer to IPR2020-00988. Similar papers and exhibits were filed in IPR2020-01065, IPR2020-01125, IPR2020-01177, and IPR2020-01323.

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.

In the Renewed Joint Motion, the Parties represent that they have reached an agreement to jointly seek termination of the above-identified *inter partes* reviews, and that the filed copies of the 2021 Settlement Agreement (Ex. 1169) and 2017 Settlement Agreement (Ex. 1170) constitute a true and complete copy of the agreement. Renewed Joint Motion 1. The Parties further represent that the 2021 Settlement Agreement and 2017 Settlement Agreement resolve "all disputes between the parties" involving Patent 10,407,458 B2, Patent 10,407,459 B2, Patent 10,457,984 B2, Patent 10,435,742 B2, and Patent 10,428,380 B2, including the pending Patent Office and District Court proceedings between the Parties. *Id*. at 1–2. The Parties further represent that "[n]o other petitioners remain in these *inter partes* review proceedings." *Id.* at 1.

We instituted trial in each of the above-identified proceedings between December 8, 2020 and January 13, 2021. IPR2020-00988, Paper 20; IPR2020-01065, Paper 19; IPR2020-01125, Paper 20; IPR2020-01177, Paper 19; IPR2020-01323, Paper 17. We have not yet decided the merits of any of the above-identified proceedings, and no final written decision has been entered in any case. Notwithstanding that each proceeding has moved beyond the preliminary stage, the Parties have shown adequately that the termination of these proceedings is appropriate. Under these circumstances,

we determine that good cause exists to terminate the above-identified proceedings with respect to the Parties.

The Parties also filed a Renewed Joint Request that the 2021 Settlement Agreement (Ex. 1169) and 2017 Settlement Agreement (Ex. 1170) each be treated as business confidential information and be kept separate from the file of the respective patents involved in these *inter partes* reviews. Renewed Joint Request 1. After reviewing the 2021 Settlement Agreement and 2017 Settlement Agreement between Petitioner and Patent Owner, we find that each agreement contains confidential business information regarding the terms of settlement. We determine that good cause exists to treat the 2021 Settlement Agreement (Ex. 1169) and 2017 Settlement Agreement (Ex. 1170) 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).

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

III. ORDER

Accordingly, for the reasons discussed above, it is:

ORDERED that the Renewed Joint Motion to Terminate (Paper 37) is *granted*, and IPR2020-00988, IPR2020-01065, IPR2020-01125, IPR2020-01177, and IPR2020-01323 are *terminated* with respect to Petitioner and Patent Owner pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72;

FURTHER ORDERED that the Renewed Joint Request (Paper 38) to File the 2021 Settlement Agreement (Ex. 1169) and 2017 Settlement Agreement (Ex. 1170) as Business Confidential Information is *granted*; and

FURTHER ORDERED that the 2021 Settlement Agreement and 2017 Settlement Agreement (IPR2020-00988, Ex. 1169 and 1170; IPR2020-01065, Ex. 1169 and 1170; IPR2020-01125, Ex. 1169 and 1170; IPR2020-01177, Ex. 1169 and 1170; and IPR2020-01323, Ex. 1169 and 1170) shall be kept separate from the files of Patent 10,407,458 B2, Patent 10,407,459 B2, Patent 10,457,984 B2, Patent 10,435,742 B2, and Patent 10,428,380 B2 and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 37 C.F.R. § 42.74(c).

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IPR2020-01125 (Patent 10,457,984 B2)
IPR2020-01177 (Patent 10,435,742 B2)
IPR2020-01323 (Patent 10,428,380 B2)

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