

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

QUEST DIAGNOSTICS INCORPORATED,
Petitioner,

v.

UNM RAINFOREST INNOVATIONS,
Patent Owner.

IPR2020-01544 (Patent 7,572,639 B2)
IPR2020-01595 (Patent 7,666,683 B2)¹

Before CHRISTOPHER L. CRUMBLEY, JON B. TORNQUIST, and
JULIA HEANEY, *Administrative Patent Judges*.

HEANEY, *Administrative Patent Judge*.

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

¹ The parties are not authorized to use a multi-case caption.

I. INTRODUCTION

On January 21, 2021, in response to an Order mailed January 7, 2021, the parties filed a Corrected Joint Motion to terminate this proceeding. Paper 10² (“Mot.”). Along with the Joint Motion, the parties filed a copy of a “Settlement and License Agreement” they describe as a “true and correct copy of the written Settlement and License Agreement” (Ex. 1027), covering various matters involving the patent at issue in this proceeding, as well as a copy of a Licensing Agreement between the parties executed in 2006. Mot. 3–4. The parties also filed a Corrected Joint Request to treat their agreement as business confidential information, and to maintain said agreement separate from the public file under 37 C.F.R. § 42.74(c). Paper 11.

II. DISCUSSION

Petitioner filed a Petition requesting an *inter partes* review of claims 1–11 of U.S. Patent No. 7,572,639 (Ex. 1001, “the ’639 patent”). Paper 2, 3³. The proceedings are still in their preliminary stages. We have not entered a decision on whether to institute an *inter partes* review for either proceeding.

In the Corrected Joint Motion, the Parties represent the “basis for this Joint Motion is the settlement of all disputes between the parties relating to the ’639, ’683, and ’760 patents.” Mot. 2; *see also* Ex. 1027, § 2.

In view of the early stage of this proceeding and the settlement between the parties, we determine that good cause exists to terminate these

² We refer to the papers and exhibit filed in IPR2020-01544. Corresponding papers and exhibit also were filed in IPR2020-01595.

³ The Petition in IPR2020-01595 challenges claims 1–40 of US Patent No. 7,666,683.

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proceedings with respect to the parties. We also have reviewed the settlement agreement, and we determine that the settlement agreement contains business confidential information regarding the terms of the settlement and that good cause exists to treat the settlement agreement as business confidential information under 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

In consideration of the foregoing, it is hereby:

ORDERED that the parties' Joint Request (Paper 11) to treat the settlement agreement and license (Exhibits 1027 and 1028) as business confidential information under 37 C.F.R. § 42.74(c) is *granted*, and the Settlement Agreement and License Agreement shall be kept separate from the files of Patents 7,572,639 and 7,666,683, and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c); and

FURTHER ORDERED that the parties' Joint Motion to Terminate (Paper 10) is *granted*, and the proceeding is *terminated* with respect to Petitioner and Patent Owner.

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PETITIONER:

Jennifer Bush

RJ Shea

Jbush-ptab@fenwick.com

rshea@fenwick.com

PATENT OWNER:

Jay Kesan

Alfonso Chan

Ari Rafilson

jay@jaykesan.com

achan@shorechan.com

arafilson@shorechan.com