

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

QUEST DIAGNOSTICS INCORPORATED,
Petitioner,

v.

UNM RAINFOREST INNOVATIONS,¹
Patent Owner.

IPR2021-00021
Patent 7,314,760 B2

Before SUSAN L. C. MITCHELL, ZHENYU YANG, and
JON B. TORNQUIST, *Administrative Patent Judges*.

MITCHELL, *Administrative Patent Judge*.

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

¹ Patent Owner represents that “[e]ffective July 1, 2020, STC.UNM amended its Articles of Incorporation to now be known as UNM Rainforest Innovations.” Paper 4, 1 n.1.

On December 7, 2020, pursuant to 37 C.F.R. § 42.74 and 35 U.S.C. § 317(b), Petitioner and Patent Owner (collectively referred to as “the parties”) filed a Joint Motion to Terminate the above-identified proceeding (Paper 7 (“Joint Motion”)) and a Joint Request to file a Settlement and License Agreement as business confidential information and to keep the Settlement and License Agreement separate from the file of the involved patent (Paper 8 (“Joint Request”)), along with a copy of the confidential Settlement and License Agreement (Ex. 1029 (“Settlement and License Agreement”)).

In the 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 and License Agreement is a true and complete copy. Paper 7, 1–3. The parties further represent that their Settlement and License Agreement resolves all currently pending Patent Office proceedings between the parties involving U.S. Patent No. 7,314,760 B2. *Id.* at 2.

The above-identified proceeding is at an early stage. Patent Owner has not filed a preliminary response in the proceeding, and 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 and License 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 and

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License 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 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 Joint Motion (Paper 7) to terminate the above-identified proceeding is GRANTED, and IPR2021-00021 is TERMINATED with respect to both Petitioner and Patent Owner; and

FURTHER ORDERED that the Joint Request (Paper 8) that the Settlement and License Agreement (Ex. 1029) be treated as business confidential information and be kept separate from the files of the above-identified proceeding and from the file of Patent 7,314,760, under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), is GRANTED.

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