

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ABS GLOBAL, INC.,
GENUS, PLC,
Petitioner,

v.

CYTONOME/ST, LLC,
Patent Owner.

IPR2021-00088
Patent 10,583,439 B2

Before LYNNE H. BROWNE, SCOTT A. DANIELS, and
JAMES A. WORTH, *Administrative Patent Judges*.

WORTH, *Administrative Patent Judge*.

ORDER

Granting Motion to Withdraw and Substitute Counsel

TERMINATION

Due to Settlement After Institution of Trial and On Remand

35 U.S.C. § 317; 37 C.F.R. §§ 43.5, 42.74

I. BACKGROUND

This case is on remand from the U.S. Court of Appeals for the Federal Circuit, with respect to claims 2, 6, and 9. *See* Paper 41; Paper 42. There are four pending motions filed with authorization. On December 13, 2023, Petitioner filed an unopposed motion to withdraw and substitute counsel. Paper 43. On January 16, 2024, the parties filed a joint motion to terminate (Paper 48), a joint request that the settlement agreement be treated as confidential business information (Paper 49), and a joint motion to hold deadlines in abeyance (Paper 47). We address each in turn.

Motion to Withdraw and Substitute Counsel

Petitioner moves to designate Lauren Katzeff of Sidley Austin LLP as lead counsel. Paper 43. The motion also seeks to withdraw Scott Border as lead counsel and to withdraw Jason Greenhut as backup counsel, both of whom are formerly of Sidley Austin. Paper 43. The motion is unopposed and indicates that there would be no prejudice to any party. *Id.* The Board provisionally granted Petitioner's motion for purposes of any briefing to follow and instructed Petitioner to file mandatory notices and a power of attorney. *See* Paper 44. Petitioner has now filed the updated mandatory notices (Paper 46) and power of attorney (Paper 45). The motion to withdraw and substitute counsel is therefore granted.

Motion to Terminate

The parties filed a joint motion to terminate this proceeding pursuant to 35 U.S.C. § 317. Paper 48. The parties represent that they have reached a settlement agreement with respect to U.S. Patent No. 10,583,439 ("the '439 patent"), that there are no other IPRs against the '439 patent, that they have agreed to settle and dismiss the related district court litigation, and the Board

has not yet decided the merits of the proceeding in this remand. *Id.* at 1–2. The parties state that they have submitted with their motion a true and correct copy of the settlement agreement. *Id.* at 3 (citing Ex. 1056). The parties state that there are no collateral agreements. *Id.*

“An 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.” 35 U.S.C. § 317(a). The Office has not yet decided the merits of the proceeding on remand, which remains at an early stage of the remand. We determine that good cause exists to terminate the proceeding with respect to all parties without rendering a final written decision on remand.

Joint Request that the Settlement Agreement Be Treated as Business Confidential Information Pursuant to 35 U.S.C. § 317

The parties jointly request that the Board treat the settlement agreement (Ex. 1056) as business confidential information and keep the agreement separate from the file of the involved patent because the agreement comprises business confidential information under 37 C.F.R.

§ 42.54. Paper 49, 1. The relevant part of the AIA provides:

At the request of a party to the proceeding, the agreement or understanding shall be treated as business confidential information, shall be kept separate from the file of the involved patents, and shall be made available only to Federal Government agencies on written request, or to any person on a showing of good cause.

35 U.S.C. § 317(b).

After reviewing the parties' settlement agreement, we find that the settlement agreement contains confidential business information regarding the terms of the settlement. We determine that good cause exists to treat the settlement agreement as business confidential information pursuant to 35 U.S.C. § 317(b).

Joint Motion to Hold the Deadlines in Abeyance

The parties filed a joint motion to hold the deadlines in abeyance pending resolution of the joint motion to terminate. This motion is now moot.

II. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the unopposed motion to withdraw and substitute counsel is *granted*;

FURTHER ORDERED that the joint motion to terminate is *granted*;

FURTHER ORDERED that this proceeding is hereby terminated as to both Petitioner and Patent Owner;

FURTHER ORDERED that the joint request that the settlement agreement be treated as confidential business information is *granted*; and

FURTHER ORDERED that the filed settlement agreement (Ex. 1056) be treated as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) and also remain designated as "Parties and Board Only" in the Board's electronic filing system;

FURTHER ORDERED that the joint motion to hold the deadlines in abeyance is *moot*.

IPR2021-00088
Patent 10,583,439 B2

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