

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SIEMENS MEDICAL SOLUTION USA, INC,
Petitioner,

v.

CORNELL RESEARCH FOUNDATION, INC,
Patent Owner.

Case IPR2021-01245
Patent 7,003,343 B2

Before JAMES A. TARTAL, KIMBERLY McGRAW, and
DAVID COTTA, *Administrative Patent Judges*.

McGraw, *Administrative Patent Judge*.

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

Siemens Medical Solution USA, Inc. (“Petitioner”)¹ filed a petition seeking *inter partes* review of US Patent 7,03,343 B2. Paper 1. Cornell Research Foundation, Inc. (“Patent Owner”)² did not file a preliminary response.

On January 6, 2022, the parties filed a Joint Motion to Dismiss Pursuant to 37 C.F.R. § 42.71 (Paper 6 (“Motions to Dismiss” or “Mot.”)) and a Joint Submission of Confidential Settlement Agreement Pursuant to 35 U.S.C. § 317 (Paper 7). Both papers were filed under seal with a designated availability for “Parties and the Board” only.

In the Motion to Dismiss, the parties state that there is good cause to grant the joint motion to dismiss as the parties have settled their dispute, a preliminary response to the petition has not been filed, the Board has not decided whether to institute *inter partes* review, and granting the motion would promote a speedy and inexpensive resolution to the dispute. Mot. 1. The parties also state that the parties’ settlement agreement related to this dispute is in writing, that no other such agreements, written or oral, exist between or among the parties regarding this proceeding, and that a true and correct copy of the parties’ agreement is submitted with the Joint Submission of Confidential Settlement Agreement. Mot. 2. The parties request, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), that the settlement agreement be treated as business confidential information, be kept separate from the files of this proceeding, and be made available to Federal

¹ Siemens Medical Solutions USA, Inc. identifies itself as the real party-in-interest in this proceeding. Pet. 68.

² Cornell Research Foundation, Inc. states that it is the Patent Owner and the real-party-in-interest in this proceeding. Paper 4, 2.

Government agencies only on written request, or to any person on a showing of good cause and upon payment of the required fee. *Id.*

In view of the parties’ representations, under the circumstances presented, we determine that it is appropriate to dismiss the Petition. *See* 37 C.F.R. §§ 42.5(a), 42.71(a); *see also* Consolidated Trial Practice Guide³ (“CTPG”), 86 (stating the “Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding”).

After reviewing the parties’ settlement agreement submitted with Paper 7, we find that the settlement agreement contains confidential business information regarding the terms of settlement and good cause exists to treat the settlement agreement as business confidential information pursuant to 35 U.S.C. § 317(b). As such, the settlement agreement submitted with Paper 7 shall be treated as confidential information pursuant to 35 U.S.C. § 317(b). Paper 7 will remain under seal.

We also note that the parties have not filed a motion to seal Paper 6 (i.e., the parties’ joint motion to dismiss) nor articulated any reason why Paper 6 should remain filed under seal. The parties are reminded that under 37 C.F.R. § 42.14, the record of a proceeding shall be made available to the public, except as otherwise ordered. *See, e.g.*, CTPG, 21–22 (stating that there is “an expectation that information will be made public where the existence of the information is referred to in a decision to . . . deny a request to institute”). Unless either party filed a motion to seal Paper 6 by January

³ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

26, 2022, the designated availability of Paper 6 shall be changed from “Board and Parties Only” to “Publically Accessible.”

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

Accordingly, it is

ORDERED that the Petition is *dismissed*;

FURTHER ORDERED that the parties’ settlement agreement submitted with Paper 7, shall be treated as business confidential information and kept separate from the files of U.S. Patent No. 7,003,343 B2 and that Paper 7 shall remain designated as “Parties and Board Only;” and

FURTHER ORDERED that unless either party filed a motion to seal Paper 6 by January 26, 2022, the designated availability of Paper 6 shall be changed from “Board and Parties Only” to “Publically Accessible.”

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