

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BICO GROUP AB,
Petitioner,

v.

MUSC FOUNDATION FOR RESEARCH DEVELOPMENT,
Patent Owner.

IPR2021-01544
Patent 9,752,116 B2

Before ULRIKE W. JENKS, JAMES A. WORTH, and
ROBERT A. POLLOCK, *Administrative Patent Judges*.

JENKS, *Administrative Patent Judge*.

DECISION
Settlement Prior to Institution of Trial
35 U.S.C. § 314

On September 21, 2021, BICO Group AB (“Petitioner”) filed a petition for *inter partes* review (Paper 2) of U.S. Patent 9,752,116 B2 (Ex. 1001 (“the ’116 Patent”)). MUSC Foundation for Research Development, (“Patent Owner”) timely filed a Preliminary Response (Paper 6) on December 28, 2021. On March 7, 2022, after receiving authorization from the Board (Ex. 1013), Petitioner filed an Unopposed Motion to Dismiss Petition for *Inter Partes* Review. Paper 9. We denied that Motion without prejudice because the motion was not accompanied by a copy of the parties’ settlement agreement. Paper 11. On March 18, 2022, with our authorization Petitioner filed the Renewed Unopposed Motion to Dismiss Petition for *Inter Parties* Review. Paper 12.

The Board’s decision on institution is due on or before March 28, 2022. The Board has not yet reached a decision regarding institution in this proceeding.

In the renewed motion, Petitioner states that good cause exists to dismiss Petitioner’s Petition and terminate this proceeding because *inter partes* review has not been instituted. Paper 12, 2. Petitioner explains that MUSC Foundation for Research Development (“MUSC”) and the Curators of the University of Missouri (“Missouri”) are co-owners of the ’116 patent. *Id.* Organovo, Inc. (“Organovo”) has an exclusive license to the ’116 patent, together with the right to grant a sublicense and resolve disputes concerning the ’116 patent. *Id.* Therefore, the settlement agreement between Organovo and Petitioner (Ex. 1016) resolves any dispute related to the ’116 patent. *Id.* (citing Ex. 1017, Ex. 1018, Ex. 1019). In addition, the related district court litigations involving the ’116 patent (*Cellink AB v. Organovo, Inc.*, No. 1:21-cv-00832-MN (D. Del.); *Organovo, Inc. v. Cellink AB*, No. 1:21-cv-01724-MN (D. Del.)) were dismissed on February 25, 2022, pursuant to a

Joint Stipulation of Dismissal filed by the parties. Paper 12, 2; Ex. 1014; Ex. 1015. Petitioner also states that Patent Owner does not oppose the motion. Paper 12, 1.

Under 37 C.F.R. § 42.71(a), “[t]he Board may take up petitions or motions for decisions in any order, [and] may grant, deny, or dismiss any petition or motion.” The parties have shown good cause for dismissal of the Petition under 37 C.F.R. § 42.71(a). The motion is unopposed, the disputes regarding the challenged patent in district court have been dismissed, the Board has not yet issued a decision on whether to grant the Petition, and the Board has not issued any other substantive decisions. Dismissing the Petition at this stage promotes the Board’s objective of achieving “just, speedy, and inexpensive resolution of every proceeding.” 37 C.F.R. § 42.1(b). Under these circumstances, we are persuaded that it is appropriate to dismiss the Petition and terminate the proceeding to promote efficiency and minimize unnecessary costs.

Pursuant to 37 C.F.R. § 42.74, Petitioner also requests that the settlement (Ex. 1016) and related licensing agreements (Ex. 1017, Ex. 1018, Ex. 1019) be treated as business confidential information and kept separate from the file of the involved patent. Paper 12, 1. We are persuaded that it is appropriate to treat the agreements as business confidential and to keep the requested document separate from the file of the ’116 patent.

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

Accordingly, it is

ORDERED that Petitioner’s Motion to Dismiss IPR2021-01544 is *granted*;

FURTHER ORDERED that Petitioner's request for the settlement agreement, Ex. 1016, and related licensing agreements, Ex. 1017, Ex. 1018, and Ex. 1019, to be treated as business confidential information and kept separate from the file of the involved patent under the provisions of 37 C.F.R. § 42.74(c) is *granted*; and

FURTHER ORDERED that the Petition in IPR2021-01544 is *dismissed* and IPR2021-01544 is *terminated*.

IPR2021-01544
Patent 9,752,116 B2

FOR PETITIONER:

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