

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SLAYBACK PHARMA LLC,
Petitioner,

v.

EYE THERAPIES, LLC,
Patent Owner.

IPR2022-00142
Patent 8,293,742 B2

Before JOHN G. NEW, ZHENYU YANG, and RYAN H. FLAX,
Administrative Patent Judges.

FLAX, *Administrative Patent Judge.*

DECISION

Termination Due to Settlement on Remand
35 U.S.C. § 317; 37 C.F.R. §§ 42.72, 42.74

Eye Therapies, LLC (“Patent Owner”) is the owner of U.S. Patent 8,293,742 B2 (Ex. 1001, “the ’742 patent”). Paper 4, 2 (Patent Owner’s Mandatory Notices). Slayback Pharma, LLC (“Petitioner”) filed a Petition requesting *inter partes* review of claims 1–6 of the ’742 patent. Paper 2 (“Pet.”). On May 15, 2023, we issued a Final Written Decision under 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. Patent Owner appealed and the U.S. Court of Appeals for the Federal Circuit (“Federal Circuit”) reversed the Final Written Decision for an erroneous claim construction, vacated its obviousness finding(s), and remanded the case to the Board for further proceedings consistent with the Federal Circuit’s determination on claim construction. Paper 82 (Federal Circuit Decision entered June 30, 2025). On August 6, 2025, jurisdiction over this case was returned to the Board by mandate. Paper 81. We have not yet decided the merits of this proceeding and rendered a subsequent final decision.

The parties, with our authorization (by email on August 11, 2025), now jointly move and request that the Board to terminate this proceeding in light of their settlement of disputes over the ’742 patent. Paper 84 (“Motion to Terminate” or “Mot. Term.”); *see* 35 U.S.C. § 317(a); 37 C.F.R. § 42.74. A copy of the parties Settlement Agreement was filed (under seal) with the Motion to Terminate. Ex. 2217 (sealed).

35 U.S.C. § 317(b) states:

Any agreement or understanding between the patent owner and a petitioner, including any collateral agreements referred to in such agreement or understanding, made in connection with, or in contemplation of, the termination of an *inter partes* review under this section shall be in writing and a true copy of such agreement or understanding shall be filed in

the Office before the termination of the inter partes review as between the parties.

Id. The Settlement Agreement indicates it resolves the parties' disputes regarding, *inter alia*, this *inter partes* review, and that it is the entire and complete agreement of the parties with regard to its subject matter, including the settlement of this proceeding; the parties certify this in their Motion to Terminate. Ex. 2217; Mot. Term. 2.

The parties further jointly request that the Board maintain the confidentiality of the Settlement Agreement and keep it separate from the files of the '742 patent, to be made available only on a showing of good cause or to Federal Government agencies upon written request. Paper 85.

Generally, 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. *See* 35 U.S.C. § 317(a) ("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."); 37 C.F.R. § 42.72 ("The Board may terminate a trial without rendering a final written decision, where appropriate, including . . . pursuant to a joint request under 35 U.S.C. 317(a)").

As noted above, this case was remanded to the Board by a Federal Circuit decision and mandate and the Board has not yet decided the merits and entered a respective final decision pursuant to that mandate. Thus, we *grant* the Joint Motion to Terminate the proceeding.

Furthermore, based on our review of the Settlement Agreement and the parties' joint request that it be kept confidential, we find good cause exists to do so, and this request is *granted*. *See* 37 C.F.R. § 42.74(c).

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

Accordingly, it is:

ORDERED that the Joint Motion to Terminate (Paper 84) this proceeding is *granted*, the Petition is *dismissed*, and this proceeding is hereby *terminated* under 35 U.S.C. § 317(a) and 37 C.F.R. §§ 42.72, 42.74;

FURTHER ORDERED that the related Joint Request to Keep the Settlement Agreement Confidential and Separate from Patent Files is *granted*, and the Settlement Agreement shall be kept separate from the files of the '742 patent 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 no other relief is granted.

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PETITIONER:

Linnea Cipriano
Robert Frederickson III
GOODWIN PROCTER LLP
lcipriano@goodwinlaw.com
rfrederickson@goodwinlaw.com

Louis Weinstein
Patrick Pollard
WINDELS MARX LANE & MITTENDORF LLP
ppollard@windelsmarx.com
lweinstein@windelsmarx.com

PATENT OWNER:

Bryan Diner
Justin Hasford
Caitlin O'Connell
Christina Ji-Hye Yang
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, LLP
bryan.diner@finnegan.com
justin.hasford@finnegan.com
caitlin.o'connell@finnegan.com
christina.yang@finnegan.com