

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ABB INC.,
Petitioner,

v.

NORTHWESTERN UNIVERSITY,
Patent Owner.

Case IPR2022-00521
Patent 6,928,336 B2

Before KEN B. BARRETT, MEREDITH C. PETRAVICK, and
PAUL J. KORNICZKY, *Administrative Patent Judges*.

KORNICZKY, *Administrative Patent Judge*.

TERMINATION
Due to Settlement After Institution of Trial
35 U.S.C. § 317; 37 C.F.R. § 42.74

On October 24, 2022, with our permission, Petitioner ABB Inc. and Patent Owner Northwestern University (“Parties”) filed a “Joint Motion to Terminate” this proceeding (Paper 9) and a “Joint Request to Maintain Confidentiality and to Keep Separate Pursuant to 35 U.S.C. § 327(b)¹ and 37 C.F.R. § 42.74” (Paper 10), requesting that the Parties’ settlement agreement be treated as business confidential information and kept separate from the public file. The Parties also filed a copy of their written settlement agreement as Exhibit 1010. The Board authorized the filing of the Motions on October 24, 2022.

Under 35 U.S.C. § 317(a), “[a]n *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.” Additionally, the Board expects that a proceeding will terminate after the filing of a settlement agreement. *See, e.g.*, Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012).

The Parties must also comply with 37 C.F.R. § 42.74(b), which requires that “[a]ny agreement or understanding between the parties made in connection with, or in contemplation of, the termination of a proceeding shall be in writing and a true copy shall be filed with the Board before the termination of the trial.”

Here, the Parties represent that, pursuant to their settlement

¹ 35 U.S.C. § 327 references settlements in post grant reviews. Because this proceeding is an *inter partes* review, we understand that the Parties refer to 35 U.S.C. § 317 which refers to settlements in *inter partes* reviews.

agreement, they have agreed to terminate not only this proceeding but also the underlying district court litigation between them (*Northwestern University v. ABB Inc., et al.*, 1:21-cv-00150 (MN) (D. Del., filed Feb. 4, 2021) and a related *inter partes* proceeding (*ABB Inc. v. Northwestern University*, IPR2022-00296 (PTAB, filed Dec. 10, 2021). Paper 9, 1. The Parties confirm they “agreed to dismiss the litigations with prejudice and to terminate the related proceedings.” *Id.* (citing Ex. 1010).

The Parties certify that “the Parties’ agreements are in writing, and the Parties submit true copies of the Parties’ agreements made in connection with, or in contemplation of, the termination of the proceedings.” Paper 10, 1 (citing Ex. 1010). The Parties’ settlement agreement states that “this Agreement embodies the entire and only understanding of each of them with respect to the subject matter of the Agreement.” Ex. 1010 ¶ 6.13.

We instituted trial in this proceeding on September 9, 2022. Paper 7. Patent Owner and Petitioner have not yet filed their Response and Reply, respectively. We have not yet decided the merits of this proceeding, and a final written decision has not been entered in this proceeding. Notwithstanding that this proceeding has moved beyond the preliminary stage, the Parties have shown adequately that the termination of this proceeding is appropriate. Under these circumstances, we determine that good cause exists to terminate this proceeding with respect to the Parties. *See* 37 C.F.R. §§ 42.5(a), 42.72.

The Parties also request that their Settlement Agreement (Ex. 1010) be treated as business confidential information and be kept separate from the files of the ’336 patent. Paper 10, 1. After reviewing the Settlement Agreement, we find that the Settlement Agreement contains confidential

business information regarding the terms of settlement. Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), we determine that good cause exists to treat the Settlement Agreement between the Parties as business confidential information and keep them separate from the files of the involved patent.

Therefore, the Joint Motion to Terminate and the Joint Motion to treat the settlement agreement as business confidential information 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 9) to Terminate IPR2022-00521 is *granted*;

FURTHER ORDERED that the Joint Motion (Paper 10) to treat the settlement agreement (Ex. 1010) as business confidential information is *granted*;

FURTHER ORDERED that the Settlement Agreement (Ex. 1010) shall be treated as business confidential information, kept separate from the file of the involved patent identified in the caption, 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 IPR2022-00521 is *terminated* with respect to both Petitioner and Patent Owner pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72.

IPR2022-00521
Patent 6,928,336 B2

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