

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HERU, INC.,
Petitioner,

v.

THE UAB RESEARCH FOUNDATION,
Patent Owner.

IPR2022-00905
Patent 8,795,191 B2

Before JAMES A. TARTAL, JAMES A. WORTH, and
ARTHUR M. PESLAK, *Administrative Patent Judges*.

PESLAK, *Administrative Patent Judge*.

DECISION

Granting Joint Motion to Dismiss Petition
Granting Joint Request to Maintain Confidentiality and to Keep Separate

37 C.F.R. § 42.74

I. INTRODUCTION

Petitioner and Patent Owner (collectively referred to as “the Parties”) filed a Joint Motion to Dismiss in the above-identified proceeding based on a settlement prior to institution. Paper 7 (“Joint Motion”). The Parties also filed a Joint Request to Maintain Confidentiality and to Keep Separate in connection with a Settlement Agreement. Paper 8 (“Joint Request”). The Parties filed the Settlement Agreement. Ex. 1016. The Parties request that the Settlement Agreement be treated as business confidential information and be kept separate from the file of the involved patent, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), in the above-identified proceeding. Joint Request, 1.

II. DISCUSSION

In the Joint Motion, the Parties represent that they have reached an agreement to jointly seek termination of the above-identified *inter partes* review proceeding, as set forth in the filed copies of the Settlement Agreement. Joint Motion 1–2. The Parties further represent that the Settlement Agreement resolves all currently pending Patent Office and District Court proceedings between the Parties involving the above-referenced patents. Joint Request, 1.

The above-identified proceeding is at an early stage, and we have not yet decided whether to institute trial. In view of the early stage of the proceeding and the settlement between the Parties, we determine that good cause exists to dismiss the petition and terminate the proceeding with respect to the Parties.

The Parties also request that the Settlement Agreement be treated as business confidential information and be kept separate from the file of the

respective patent involved in this *inter partes* review. Joint Request, 1. After reviewing the Settlement Agreement between Petitioner and Patent Owner, we find that the Settlement Agreement contains confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Settlement Agreement between Petitioner and Patent Owner as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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

III. ORDER

Accordingly, for the reasons discussed above, it is:

ORDERED that the Joint Motion to Dismiss in the above-identified proceeding is *granted*, and IPR2022-00905 is *terminated*; and

FURTHER ORDERED that the Joint Request to Maintain Confidentiality and to Keep Separate is *granted*, and the Settlement Agreement, Ex. 1016, shall be kept separate from the file of the above-referenced 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).

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