

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ACERA SURGICAL, INC.,
Petitioner,

v.

RESEARCH FOUNDATION OF STATE
UNIVERSITY OF NEW YORK,
Patent Owner.

IPR2022-01000
Patent 8,222,166 B2

Before ULRIKE W. JENKS, CHRISTOPHER M. KAISER, and
JULIA HEANEY, *Administrative Patent Judges*.

KAISER, *Administrative Patent Judge*.

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

I. INTRODUCTION

With the Board’s authorization (Ex. 3001), Petitioner Acera Surgical, Inc. and Patent Owner Research Foundation of State University of New York (collectively, “the Parties”) filed a Joint Motion to Terminate in the above-captioned proceeding. Paper 16 (“Joint Motion”). Along with the Joint Motion, the Parties filed a copy of the Settlement Agreement (Ex. 1023, “Agreement”), as well as a Joint Request that the Agreement be treated as business confidential information and kept separate from the files of the patents involved in the above-captioned proceedings. Paper 17 (“Joint Request”).

II. DISCUSSION

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.” 35 U.S.C. § 317(a) also provides that if no petitioner remains in the *inter partes* review, the Office may terminate the review.

In the Joint Motion, the Parties represent the Agreement as “fully resolving their disputes regarding the ’166 Patent, including in this proceeding, and Exclusive Licensee and Patent Owner’s assertion of the ’166 Patent in the related district court litigation, *Acera Surgical, Inc. et al. v. Nanofiber Solutions LLC et al.*, Case No. 20-980 (D. Del. Jul. 23, 2020).” Joint Motion 1. The Parties also represent “no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of the present proceeding.” *Id.*

We instituted trial for the above-identified *inter partes* review proceeding (see Paper 7), but we have not yet decided the merits of the

proceeding, and a final written decision has not been entered. Under these circumstances, we determine that it is appropriate to terminate the proceeding.

In the Joint Request, the Parties request that the Agreement be treated as business confidential information and kept separate from the file of the patent involved in the above-captioned proceeding. Joint Motion 1. After reviewing the Agreement, we determine that it is appropriate to treat the Settlement Agreement as business confidential information pursuant to 37 C.F.R. § 42.74(c).

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

III. ORDER

Accordingly, it is:

ORDERED that the Joint Motion to Terminate is *granted*, and IPR2022-01000 is terminated; and

FURTHER ORDERED that the Joint Request to treat the Agreement as business confidential information is *granted*, and the Agreement shall be kept separate from the file of U.S. Patent No. 8,222,166 B2, and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 37 C.F.R. § 42.74(c).

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Patent 8,222,166 B2

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