

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ASPECT BIOSYSTEMS LTD.,
Petitioner,

v.

THE UNIVERSITY OF TOKYO,
Patent Owner.

IPR2023-00026
Patent 8,785,195 B2

Before GRACE KARAFFA OBERMANN, SHERIDAN K. SNEDDEN,
and DEVON ZASTROW NEWMAN, *Administrative Patent Judges*.

OBERMANN, *Administrative Patent Judge*.

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

On June 15, 2023, Petitioner and Patent Owner filed a joint motion to terminate the *inter partes* review as a result of a settlement agreement that resolves all pending disputes between Petitioner and Patent Owner, and a joint request to treat the settlement agreement as business confidential information and to keep separate from the files of the involved patent, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). That same day, the parties also filed a copy of their settlement agreement. Ex. 1020. The settlement agreement was filed under seal as Board and Parties Only.

An *inter partes* review “shall be terminated with respect to any petitioner upon the joint request of the petitioner and 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). As explained in our Consolidated Trial Practice Guide (“CTPG”), issued in November 2019,¹ “[t]he Board expects that a proceeding will terminate” as to settling parties “after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding.” CTPG 86.

The Board has not decided the merits and, in fact, a final oral hearing is months away. See Paper 11, 11 (setting final oral argument for January 8, 2024). We determine that termination of the proceeding as to both Petitioner and Patent Owner is appropriate.

The content of the settlement agreement supports the parties’ requests to treat the settlement agreements as business confidential information. Ex. 1020. Accordingly, pursuant to Rule 42.74(c), we also grant the parties’ request to treat the settlement agreement as business confidential

¹ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

information, and to keep that agreement separate from the files of the patent-at-issue.

It is

ORDERED that the joint motion to terminate the proceeding
(Paper 14) is *granted*;

FURTHER ORDERED that the parties' settlement agreement
(Ex. 1020) shall be maintained as confidential business information and kept
separate from the files of the challenged patent.

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