

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NANOBEBE US INC.,
Petitioner,

v.

MAYBORN (UK) LIMITED,
Patent Owner.

IPR2023-00465 (Patent 11,207,244 B2)
IPR2023-00467 (Patent 10,952,930 B2)¹

Before ULRIKE W. JENKS and MICHAEL L. WOODS,
Administrative Patent Judges.

JENKS, *Administrative Patent Judge.*

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

¹ We exercise our discretion and issue a single order that has been entered in each case. The parties are not authorized to use this style of caption.

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I. INTRODUCTION

On February 2, 2024, and with our authorization (Ex. 3004²), Petitioner and Patent Owner (collectively, “the Parties”) filed a joint motion to terminate the above-captioned *inter partes* review proceedings. Paper 32 (“Joint Motion”). Along with the Joint Motion, the Parties filed a copy of a settlement and license agreement (Ex. 1031, “Settlement Agreement”), as well as a joint motion requesting that the Settlement Agreement be treated as business confidential information and kept separate from the file of U.S. Patent No. 11,207,244 B2 (“the ’244 patent”) and U.S. Patent No. Patent 10,952,930 B2 (“the ’930 patent”). Paper 33, 1 (“Joint Request”).

II. DISCUSSION

In the Joint Motion, the Parties represent that the Settlement Agreement resolves their underlying dispute involving the ’244 patent and the ’930 patent. Joint Motion 1, 5. The Parties also represent that they have filed a true copy of the Settlement Agreement made in connection with, or in contemplation of, the termination of the above-captioned proceedings. *Id.* at 2. The Parties certify that “[t]here are no other agreements, written or oral, between the Parties made in connection with, or in contemplation of, the termination of this proceeding.” *Id.*; *see also* Paper 33, 2 (“Exhibit 1031 is the entire agreement or understanding between the Parties made in connection with, or in contemplation of, the termination of this proceeding, and further, Exhibit 1031 is a true and accurate copy of the agreement between the parties that resolves the present proceeding.”).

² All references in this order are to papers and exhibits from IPR2023-00465. IPR2023-00467 contains similar papers and exhibits.

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We instituted trial for the above-captioned *inter partes* review proceedings on June 16, 2023. *See* Paper 11. We have not yet decided the merits of the proceedings, and final written decisions have not been entered. Notwithstanding that the proceedings have moved beyond the preliminary stage, the Parties have shown adequately that termination of the proceedings is appropriate. Under these circumstances, we determine that good cause exists to terminate the proceedings with respect to the Parties.

The Parties also request that the Settlement Agreement be treated as business confidential information and kept separate from the file of the '244 patent and the '930 patent. Joint Request 2. After reviewing the Settlement Agreement, we find that it contains confidential business information regarding the terms of settlement. Thus, good cause exists to treat the Settlement Agreement as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Accordingly, we *grant* the Joint Request.

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 (Paper 32) is *granted*, and IPR2023-00465 and IPR2023-00467 are *terminated* with respect to Petitioner and Patent Owner;

FURTHER ORDERED that the Joint Request to treat the Settlement Agreement as business confidential information (Paper 33) is *granted*;

FURTHER ORDERED that the Settlement Agreement (Ex. 1031) shall be kept separate from the file of U.S. Patent No. 11,207,244 B2 and

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10,952,930 B2, 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 this paper does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

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