

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FORESIGHT DIAGNOSTICS INC.,
Petitioner,

v.

PERSONALIS, INC.,
Patent Owner.

IPR2023-00545 (Patent 11,299,783 B2)
IPR2023-00546 (Patent 10,450,611 B2)¹

Before ULRIKE W. JENKS, ROBERT A. POLLOCK, and
TIMOTHY G. MAJORS, *Administrative Patent Judges*.

POLLOCK, *Administrative Patent Judge*.

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

¹ The combined caption is for administrative convenience only and does not indicate that IPR2023-00545 and IPR2023-00546 have been joined. The parties are not authorized to use this caption without express permission of the Board.

I. INTRODUCTION

With the Board’s authorization, Petitioner and Patent Owner (collectively referred to as “the Parties”) filed a Joint Motion to Terminate each of the above-identified proceedings due to settlement. Paper 36 (“Joint Motion” or “Mot.”).² In support of the Joint Motions, the Parties filed a confidential Settlement and License Agreement in each of the above-identified proceedings (Ex. 2022 (“Settlement Agreement”)), as well as a Joint Request to File Settlement Agreement as Business Confidential and to Keep it Separate from the Patent Files Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74 (Paper 37 (“Joint Request”)).

II. DISCUSSION

In the Joint Motions, the Parties represent that they have reached an agreement to jointly seek termination of the above-identified *inter partes* review proceedings, and that the filed copy of the Settlement Agreement is a true and complete copy. Mot. 1–2; Ex. 2022, 19. The Parties further represent that their settlement agreement resolves all disputes regarding the patents involved in these *inter partes* review proceedings, as well as the related district court litigation between Petitioner and Patent Owner. Mot. 1.

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.”

Section 35 U.S.C. § 317(a) also provides that if no petitioner remains in the

² The Motions in each of the above-captioned proceedings are substantively identical. For convenience, all citations are to IPR2023-00545 with the understanding that IPR2023-00546 includes papers having substantially the same substantive content.

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inter partes review, the Office may terminate the review.

We instituted a trial in the above-identified proceedings on August 8, 2023. Paper 13. Although oral hearings were held on May 7, 2024, 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 the termination of the proceedings is appropriate. Under these circumstances, we determine that good cause exists to terminate the proceedings with respect to the Parties.

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

III. ORDER

In view of the above, it is

ORDERED that the Joint Motions to Terminate are *granted*, and IPR2023-00545 and IPR2023-00546 are *terminated* with respect to Petitioner and Patent Owner pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72; and

FURTHER ORDERED that the Joint Request to File Settlement Agreement as Business Confidential and to Keep it Separate from the Patent Files Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74 in each proceeding

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is *granted*, and the Settlement Agreement shall be kept separate from the files of Patent 11,299,783 B2 and Patent 10,450,611 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).

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FOR PETITIONER:

Andrew Krause
IRELL & MANELLA LLP
akrause@irell.com

Amir Naini
NAINI P.C.
amir@nainipc.com

FOR PATENT OWNER:

Derek Walter
Adrian Percer
WEIL, GOTSHAL & MANGES LLP
derek.walter@weil.com
adrian.percer@weil.com