

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

10X GENOMICS, INC.,
Petitioner,

v.

BRUKER SPATIAL BIOLOGY, INC.,
Patent Owner.

IPR2023-01298 (Patent 11,377,689 B2)
IPR2023-01300 (Patent 11,473,142 B2)¹

Before SUSAN L. C. MITCHELL, DEVON ZASTROW NEWMAN, and
JAMIE T. WISZ, *Administrative Patent Judges*.

NEWMAN, *Administrative Patent Judge*.

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

¹ This Order addresses issues that are the same in the identified cases. We exercise our discretion to issue one Order to be filed in each case. The parties, however, are not authorized to use this filing style in subsequent papers.

I. INTRODUCTION

With the Board’s authorization, Petitioner and Patent Owner (collectively referred to as “the Parties”) filed a Joint Motion to Terminate in each of the above-identified proceedings due to settlement (“Joint Motions”). Paper 55.² In support of the Joint Motions, the Parties filed a corresponding Settlement Agreement, Ex. 2054 (“Settlement Agreements”), as well as a corresponding Joint Request to File Settlement Agreement as Business Confidential and to Keep It Separate From the Patent Files pursuant to 37 C.F.R. § 42.74(c), Papers 56 (“Joint Requests”). The Settlement Agreements refer to certain License and Sublicense Agreements, Exs. 2055–2057 (“Collateral Agreements”) and the Parties filed a corresponding Joint Request to File Collateral Agreements as Business Confidential and to Keep It Separate From the Patent Files pursuant to 37 C.F.R. § 42.74(c), Paper 58 (“Collateral Joint Requests”).

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 copies of the Settlement Agreements and Collateral Agreements are true and correct copies. Joint Motions 1. The Parties further represent that their settlement agreements resolve all currently pending Patent Office proceedings between the Parties involving Patent 11,377,689 B2 and Patent 11,473,142 B2 and the related District Court

² For purposes of expediency, we cite to Papers and Exhibits filed in IPR2023-01298, unless otherwise noted. The Parties filed corresponding items in IPR2023-01300.

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proceeding (*Bruker Spatial Biology, Inc. et al. v. 10x Genomics, Inc.*, No. 1:22-cv-1375 (D. Del.)). *Id.* Accordingly, the Parties jointly request termination of these proceedings. *Id.* at 2.

The Board generally expects that a case “will terminate after the filing of a settlement agreement, unless the Board has already decided the merits.” *Consolidated Trial Practice Guide*, 86 (Nov. 2019)³; *see* 35 U.S.C. § 317(a); 37 C.F.R. § 42.72. Here, although the Board instituted *inter partes* review of the challenged patents, the Board has not decided the merits of these proceedings. Under these circumstances, therefore, we determine that it is appropriate to terminate these proceedings as to the Parties, without rendering a final written decision.

After reviewing the Settlement Agreements and Collateral Agreements between the Parties, we find that the Settlement Agreements and Collateral Agreements contain confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Settlement Agreements and Collateral Agreements between the Parties 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, for the reasons discussed above, it is:

ORDERED that the Joint Motions to Terminate are *granted*, and the

³ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

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above-identified proceedings are *terminated*;

kept separate from the files of Patent 11,377,689 B2 and Patent 11,473,142 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); and

FURTHER ORDERED that the Joint Requests to Treat the Collateral Agreements as Business Confidential are *granted*, and the Collateral Agreements shall be kept separate from the files of Patent 11,377,689 B2 and Patent 11,473,142 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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