

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PACIFIC BIOSCIENCES OF CALIFORNIA, INC.,
Petitioner

v.

THE CHINESE UNIVERSITY OF HONG KONG,
Patent Owner

Case **IPR2024-00028**
Patent No. **11,091,794 B2**

**JOINT REQUEST THAT THE SETTLEMENT AGREEMENT BE
TREATED AS BUSINESS CONFIDENTIAL INFORMATION AND BE
KEPT SEPARATE UNDER 35 U.S.C. § 317(b)**

Patent Owner the Chinese University of Hong Kong (“Patent Owner”) is depositing concurrently herewith a true and correct copy of the two agreements listed below (collectively the “Confidential Settlement, Assignment and Mutual Release Agreements”):

1. PacBio – CUHK Assignment and Settlement Agreement. Confidential Exhibit 2061.
2. PacBio – Take2 Mutual Release. Confidential Exhibit 2062.

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), and Petitioner Pacific Biosciences of California, Inc. (“Petitioner”) jointly request that the true copy of the Confidential Settlement, Assignment and Mutual Release Agreements (Confidential Exhibits 2061-2062) be treated as business confidential information and be kept separate from the file of the involved patent.

Concurrently with the filing of this Request, Patent Owner and Petitioner are filing a Joint Motion to Terminate, due to the settlement between the parties.

Patent Owner and Petitioner consider the Confidential Settlement, Assignment and Mutual Release Agreements governing the resolution of the *inter partes* review and underlying litigation to contain highly sensitive business confidential information that would substantially harm their business interests if publicly disclosed. As such, Patent Owner and Petitioner hereby jointly request that the Confidential Settlement, Assignment and Mutual Release Agreements be kept as

a separate paper to be made available only under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). The Confidential Settlement, Assignment and Mutual Release Agreements have been filed for access “Available only to board.” *See* Confidential Exhibits 2061-2062. Patent Owner and Petitioner further jointly request that the Board order that in the event a person or entity makes a written request, as stated in 37 C.F.R. § 42.74(c)(1)-(2), for access to the settlement agreement, that any such written request be served upon the parties on the day the written request is provided to the Board.

Respectfully submitted,

Dated: March 20, 2025

/Michael J. Wise /

Michael J. Wise, Reg. No. 34,047
Perkins Coie LLP
1888 Century Park East, Suite 1700
Los Angeles, CA 90067
Phone: 310-788-3271

Counsel for Patent Owner

Respectfully submitted,

Date: March 20, 2025

/Michael T. Rosato /

Michael T. Rosato (Reg. No. 52,182)
Wilson Sonsini Goodrich & Rosati
701 Fifth Avenue, Suite 5100
Seattle, WA 98104-7036
Phone: 206-883-2500

Counsel for Petitioner

CERTIFICATE OF SERVICE

The undersigned hereby certifies that service on Petitioner was made as follows, in accordance with 37 C.F.R. § 42.6(e):

Date of service: Mach 20, 2025
Manner of service: 1. Electronic submission through the USPTO Patent Trial and Appeal Board P-TACTS System
2. Electronic mail
Document(s) served: **JOINT REQUEST THAT THE SETTLEMENT AGREEMENT BE TREATED AS BUSINESS CONFIDENTIAL INFORMATION AND BE KEPT SEPARATE UNDER 35 U.S.C. § 317(b)**
Persons served: Michael T. Rosato (Reg. No. 52,182)
mrosato@wsgr.com

Sonja R. Gerrard (Reg. No. 72,802)
sgerrard@wsgr.com

Patrick M. Medley (Reg. No. 74,735)
pmedley@wsgr.com

/ Amy Candeloro /
Paralegal
Perkins Coie LLP