

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.

IPR2024-00028
Patent 11,091,794 B2

Before DEBORAH KATZ, MICHAEL J. FITZPATRICK, and
JAMIE T. WISZ, *Administrative Patent Judges*.

FITZPATRICK, *Administrative Patent Judge*.

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

On March 20, 2025, and pursuant to 35 U.S.C. § 317(a), Petitioner, Pacific Biosciences of California, Inc., and Patent Owner, The Chinese University of Hong Kong, filed a Joint Motion to Terminate the instant proceeding. Paper 36 (“Mot.”). The parties inform the Board that they have settled the dispute between them and have filed, in U.S. District Court, a joint stipulation for dismissal of related lawsuit *Take2 Technologies Limited et al. v. Pacific Biosciences of California, Inc.*, No. 5:23-cv-041661 (N.D. Cal.). Mot. 1–2.

As required by law, the parties filed two settlement documents, an “Assignment and Settlement Agreement” (Ex. 2061) and a “Mutual Release” (Ex. 2062). *See* 35 U.S.C. § 317(b) (requiring the filing of such agreements, “including any collateral agreements”).

The Motion is granted. *See* 37 C.F.R. § 42.72 (“The Board may terminate a trial without rendering a final written decision . . . pursuant to a joint request under 35 U.S.C. 317(a).”).

On the same day, March 20, 2025, and pursuant to 35 U.S.C. § 317(b), the parties also filed a Joint Request that the settlement documents be treated as business confidential information and kept separate from the file of the involved patent. Paper 37 (“Req.”).

The Request is granted. *See* 35 U.S.C. § 317(b) (“At the request of a party to the proceeding, the agreement or understanding shall be treated as business confidential information, shall be kept separate from the file of the involved patents, and shall be made available only to Federal Government agencies on written request, or to any person on a showing of good cause.”).

Accordingly, it is:

ORDERED that the Joint Motion to Terminate is granted; the *inter partes* review is terminated; and

FURTHER ORDERED that the Joint Request is granted; the settlement agreements (Ex. 2061 and Ex. 2062) shall be treated as business confidential information, kept separate from the file of U.S. Patent No. 11,091,794, and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

PETITIONER:

Michael Rosato
Sonja Gerrard
Patrick Medley
WILSON SONSINI GOODRICH & ROSATI
mrosato@wsgr.com
sgerrard@wsgr.com
pmedley@wsgr.com

FOR PATENT OWNER:

Michael Wise
Joseph Hamilton
Yingli Wang
PERKINS COIE LLP
wise-ptab@perkinscoie.com
hamilton-ptab@perkinscoie.com
wang-ptab@perkinscoie.com