

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VIVITRO LABS INC.,

Petitioner,

v.

BIOMEDICAL DEVICE CONSULTANTS & LABORATORIES OF
COLORADO, LLC,

Patent Owner.

IPR2024-00320
Patent 9,237,935 B2

Before JOHN F. HORVATH, JOHN A. HUDALLA, and
DONALD E. DAYBELL, *Administrative Patent Judges*.

DAYBELL, *Administrative Patent Judge*.

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

I. INTRODUCTION

On December 6, 2024, with Board authorization, the parties filed a “Joint Motion to Terminate.” Paper 19 (“Mot.”). Accompanying this motion is a confidential “Settlement Agreement.” Ex. 1040 (“Settlement Agreement”). The motion further includes a request to keep the Settlement Agreement confidential. Mot. 2.

II. DISCUSSION

On January 25, 2024, Petitioner filed a Petition requesting *inter partes* review of claims 1–4, 7–10, 12, and 13 of U.S. Patent No. 9,237,935 B2 (“the ’935 Patent”). Paper 1. On August 5, 2024, the Board instituted review of the ’935 Patent with respect to all challenged claims and grounds. Paper 12.

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 317(a) also provides that if no petitioner remains in the *inter partes* review, the Office may terminate the review.

In the motion, the parties represent that they “have agreed to resolve their disputes relating to U.S. Patent No. 9,237,935” and that “no dispute remains between the parties as to the challenged patent.” Mot. 1. The parties further represent that:

The parties have executed a confidential agreement; pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), that written agreement is submitted concurrently herewith as Exhibit 1040. There are no other agreements or understandings, oral or written, between the parties made in connection with, or in

contemplation of, the termination of the above-referenced proceeding.

Id.

We accept the parties' representations that the agreement reflected in Exhibit 1040 is the only agreement resolving the dispute between the parties, and that there are no other agreements, oral or written, between the parties relating to the '935 Patent.

This proceeding is still at an early stage. Patent Owner has not yet filed a Patent Owner Response. We have neither decided the merits nor entered a final written decision in this proceeding. In view of the early stage of the proceeding and the settlement between the parties, we determine that good cause exists to terminate the proceeding with respect to the parties.

The parties' motion also included a request that the Settlement Agreement be treated as business confidential information and be kept separate from the file of the patent involved in this *inter partes* review proceeding. Mot. 2. 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 consideration of the foregoing, it is hereby:

ORDERED that the Joint Motion to Terminate (Paper 19) is *granted*, the Petition is dismissed, and the above proceeding is *terminated*;

ORDERED that the parties' request to treat the Settlement Agreement as business confidential information (Paper 15) is *granted*, and the Settlement Agreement (Ex. 1040) shall remain designated as "Parties and Board Only" in the Board's filing system, shall only be made available pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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