

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BRUKER SPATIAL BIOLOGY, INC.,
Petitioner,

v.

PRESIDENT AND FELLOWS OF HARVARD COLLEGE and
10X GENOMICS,
Patent Owner.

Case IPR2024-00526
Patent 11,542,554 B2

Before ZHENYU YANG, TAWEN CHANG, and CYNTHIA HARDMAN,
Administrative Patent Judges.

CHANG, *Administrative Patent Judge.*

TERMINATION

Due to Settlement After Institution of Trial
35 U.S.C. § 317; 35 C.F.R. §§ 42.72, 42.74

ORDER

Granting Joint Requests to File Agreements as Business Confidential
35 U.S.C. § 317(b); 35 C.F.R. § 42.74(c)

I. INTRODUCTION

On May 14, 2025, with the Board’s authorization (*see* Ex. 3004), Petitioner and Patent Owner¹ (collectively, “the Parties”) filed (1) a “Joint Motion to Terminate” (Paper 40, “Joint Motion”) and (2) a “Joint Request to File Settlement Agreement as Business Confidential” (Paper 41, “Joint Request”). The Parties also filed a copy of a “Settlement Agreement.” Ex. 1087 (“Settlement Agreement”).

On May 19, 2025, with the Board’s authorization (*see* Ex. 3005), the Parties also filed copies of collateral agreements (Exs. 1088–1090, “Collateral Agreements”) referenced in the Settlement Agreement and a “Joint Request to File Collateral Agreements as Business Confidential” (Paper 43, “Second Joint Request”).

II. JOINT MOTION TO TERMINATE

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 “[i]f no petitioner remains in the inter partes review, the Office may terminate the review.”

¹ As noted in our Decision Granting Institution of *Inter Partes* Review, “[r]eferences to Patent Owner in this proceeding are to 10x Genomics and/or Harvard as appropriate in the particular context of the proceeding.” Paper 14, 2, n.1.

Under 35 U.S.C. § 317(b), “[a]ny agreement or understanding between the patent owner and a petitioner . . . made in connection with, or in contemplation of, the termination of an inter partes review under this section shall be in writing,” and “a true copy of such agreement or understanding,” including “any collateral agreements referred to in such agreement or understanding,” “shall be filed in the Office before the termination of the inter partes review as between the parties.”

In the Joint Motion, the Parties represent that they have settled their dispute involving U.S. Patent No. 11,542,554 (“’554 patent”), the patent at issue in this *inter partes* review. Paper 40, 1. The Parties represent that the Settlement Agreement is “[a] true and correct copy of the written Settlement Agreement . . . in connection with this matter.” *Id.* Based on the Parties’ representations and our review of the filed exhibits, we also understand the Collateral Agreements are true and correct copies of collateral agreements referenced in the Settlement Agreement and that the Settlement Agreement and Collateral Agreements constitute the entire agreement and understanding made in connection with, or in contemplation of, the termination of this inter partes review. *See* Ex. 1087, 1, 11; Exs. 1088–1090; Ex. 3005.

We instituted trial for this proceeding on August 23, 2024. Paper 14. No hearing has been held, and we have not entered a final written decision or otherwise decided the merits of the case. Notwithstanding that the proceeding has moved beyond the preliminary stage, the Parties have shown adequately that termination of the proceeding is appropriate. Under these

circumstances, we determine that good cause exists to terminate the proceeding with respect to the Parties. Because no petitioner remains in the proceeding, we also terminate this *inter partes* review.

III. JOINT REQUESTS TO FILE SETTLEMENT AND COLLATERAL AGREEMENTS AS BUSINESS CONFIDENTIAL

In the Joint Request and the Second Joint Request (collectively “Joint Requests”), the Parties seek to treat the Settlement Agreement (Ex. 1087) and Collateral Agreements (Exs. 1088–1090) as business confidential information to be kept separate from the file of the ’554 patent. Paper 41, 1; Paper 43, 1.

Under 35 U.S.C. § 317(b), “[a]t the request of a party to the proceeding, the agreement or understanding” between the patent owner and a petitioner made in connection with the termination of an *inter partes* review as part of a settlement “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.” We have reviewed the Settlement Agreement and the Collateral Agreements and find that they contain confidential business information regarding the terms of settlement. Thus, good cause exists to treat the Settlement Agreement and Collateral Agreements as business confidential information pursuant to 37 C.F.R. § 42.74(c).

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Joint Motion to Terminate (Paper 40) is *granted*, and IPR2024-00526 is *terminated*; and

FURTHER ORDERED that the Joint Requests (Papers 41 and 43) to file the Settlement Agreement (Ex. 1087) and Collateral Agreements (Exs. 1088–1090) as business confidential information are *granted*, and the Settlement Agreement and Collateral Agreements shall be kept separate from the file of U.S. Patent No. 11,542,554 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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