

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NATIONAL BEEF PACKING COMPANY, LLC,
Petitioner,

v.

INSTITUTE FOR ENVIRONMENTAL HEALTH, INC.,
Patent Owner.

IPR2024-00183 (Patent 7,534,584 B2)
IPR2024-00185 (Patent 8,822,143 B2)
IPR2024-00186 (Patent 9,637,771 B2)
IPR2024-01156 (Patent 9,845,486 B2)¹

Before JEFFREY N. FREDMAN and RYAN H. FLAX,
Administrative Patent Judges.

FLAX, *Administrative Patent Judge.*

DECISION

Termination due to Settlement After Institution of Trial
37 C.F.R. § 42.74

¹ Because the above-identified proceedings share common parties and issues, we use this caption for efficiency. The parties are not authorized to do the same.

IPR2024-00183 – Patent 7,534,584 B2
IPR2024-00185 – Patent 8,822,143 B2
IPR2024-00186 – Patent 9,637,771 B2
IPR2024-01156 – Patent 9,845,486 B2

Institute for Environmental Health, Inc. (“Patent Owner”) is the owner of U.S. Patents 7,534,584 B2, 8,822,143 B2, 9,637,771 B2, and 9,845,486 B2 (the “challenged patents”). National Beef Packing Company, LLC (“Petitioner”) filed a respective Petition for *inter partes* review challenging the patentability of claims in each challenged patent. *See, e.g.*, IPR2024-00183, Paper 2. We instituted trial in each proceeding. *See, e.g.*, IPR2024-00183, Paper 8. We have not entered a final decision in any proceeding.

On March 3, 2005, in each proceeding, the parties filed a respective Joint Motion to Terminate the proceeding on the basis of a settlement. IPR2024-00183, Paper 10; IPR2024-00185, Paper 10; IPR2024-00186, Paper 10; IPR2024-01156, Paper 11 (“Motion” or “Mot.”; because the motions are each substantively the same, we refer to that of IPR2024-00183 henceforth as representative); *see* 35 U.S.C. § 317(a); 37 C.F.R. § 42.74.

35 U.S.C. § 317(b) states:

Any agreement or understanding between the patent owner and a petitioner, including any collateral agreements referred to in such agreement or understanding, 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 shall be filed in the Office before the termination of the inter partes review as between the parties.

Id. Pursuant to that statute, and in connection with each Joint Motion to Terminate, the parties filed a copy of their written settlement agreement resolving each *inter partes* review, and they certify “[t]he Settlement Agreement is in writing and constitutes the Parties’ entire understanding and agreement.” *See* Mot. 4; *see also* IPR2024-00183, Ex. 1065;

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IPR2024-01156 – Patent 9,845,486 B2

IPR2024-00185, Ex. 1065; IPR2024-00186, Ex. 1065; IPR2024-01156, Ex. 1036 (collectively the “Settlement Agreement”). Based on the language and execution date of the Settlement Agreement, this certification is sufficient.

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding. *See* 35 U.S.C. § 317(a) (“An 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.”); 37 C.F.R. § 42.72 (“The Board may terminate a trial without rendering a final written decision, where appropriate, including . . . pursuant to a joint request under 35 U.S.C. 317(a)”). As noted above, the Board has not yet rendered a final decision in any proceeding. Thus, we *grant* each Joint Motion to Terminate the respective proceeding.

The parties also, in each proceeding, jointly request that the Settlement Agreement be treated as confidential information and kept separate from the record in each respective challenged patent. IPR2024-00183, Paper 11; IPR2024-00185, Paper 11; IPR2024-00186, Paper 11; IPR2024-01156, Paper 12. Based on our review of the Settlement Agreement, we find good cause exists and this request is *granted*. *See* 37 C.F.R. § 42.74(c).

This Decision does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

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In accordance with the above, it is:

ORDERED that the respective Joint Motion to Terminate each above-captioned proceeding is *granted*, each respective Petition is *dismissed*, and each above-captioned proceeding is hereby *terminated* under 35 U.S.C. § 317(a) and 37 C.F.R. §§ 42.72, 42.74;

FURTHER ORDERED that each related Joint Request to Treat the Settlement Agreement as Confidential Information is *granted*; and

FURTHER ORDERED that no other relief is granted.

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IPR2024-00185 – Patent 8,822,143 B2
IPR2024-00186 – Patent 9,637,771 B2
IPR2024-01156 – Patent 9,845,486 B2

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