

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ADVANCED ACCELERATOR APPLICATIONS USA, INC.,
Petitioner,

v.

MOLECULAR INSIGHT PHARMACEUTICALS, INC.,
Patent Owner.

PGR2021-00048
Patent 10,640,461 B2

Before JACQUELINE WRIGHT BONILLA, *Deputy Chief Administrative Patent Judge*, and CHRISTOPHER G. PAULRAJ and JAMIE T. WISZ, *Administrative Patent Judges*.

WISZ, *Administrative Patent Judge*.

TERMINATION
Due to Settlement After Institution of Trial
35 U.S.C. § 327; 37 C.F.R. § 42.74

I. INTRODUCTION

On February 2, 2022, with authorization of the Board, the parties filed a Joint Motion to Terminate the above-identified proceeding due to settlement. Paper 14. The parties also filed a copy of a Confidential Binding Term Sheet (“Confidential Binding Term Sheet”) (Ex. 1070) and a joint request that the Confidential Binding Term Sheet be treated as business confidential information (Paper 13).

On February 9, 2022, we denied the Joint Motion to Terminate without prejudice because we found that the Confidential Binding Term Sheet filed by the parties (Ex. 1070) did not appear to include all collateral agreements referred to, made in connection with, or in contemplation of, the termination of this proceeding as required by 35 U.S.C. § 327(b) and 37 C.F.R. § 42.74(b). Paper 16, 3. Specifically, the Confidential Binding Term Sheet referred to a Formal Settlement Agreement, which was to be executed by the parties within sixty (60) days after the execution of the Confidential Binding Term Sheet. Ex. 1070, 1, 4. We similarly denied without prejudice the Joint Motion to Keep Confidential and Separate, but we authorized the parties to file renewed motions along with the filing of the Formal Settlement Agreement, within sixty (60) days of the Order. Paper 16, 3–4.

On April 10, 2022, the parties filed a second Joint Motion to Terminate the above-identified proceeding due to settlement. Paper 18. The parties also filed a copy of a Formal Settlement Agreement (“Formal Settlement Agreement”) (Ex. 2001) governing their settlement, along with a Confidential Clinical Supply Agreement (“Clinical Supply Agreement”) (Ex. 2002). Additionally, citing to 35 U.S.C § 327(b) and 37 C.F.R. § 42.74(c), the parties filed a joint request that the Confidential Binding

Term Sheet, the Formal Settlement Agreement, the Clinical Supply Agreement, and their respective exhibits (Exhibits 1070, 2001, and 2002), be treated as business confidential information, maintained separate from the publicly available files of the above-captioned post grant review, and be made available only to Federal Government agencies on written request, or to persons showing good cause pursuant to 35 U.S.C. § 327(b) and 37 C.F.R. § 42.74(c). Paper 19.

II. DISCUSSION

The parties explain that termination of the proceeding is appropriate because they have settled their dispute regarding U.S. Patent No. 10,640,461 B2. Paper 18, 1. The parties also represent that they filed a true and accurate copy of the written Formal Settlement Agreement resolving their dispute as Exhibit 2001 and that there are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of the proceeding. *Id.* at 2, 5.

This proceeding has not yet advanced to the stage where an oral hearing has been held nor has the Board decided the merits of the proceeding. Under these circumstances, we determine that it is appropriate to enter judgment terminating the proceeding. Additionally, the parties' request for the Confidential Binding Term Sheet, the Formal Settlement Agreement, the Clinical Supply Agreement, and their respective exhibits (Exhibits 1070, 2001, and 2002), to be treated as business confidential information and kept separate from the file of the involved patent is granted.

III. ORDER

Accordingly, it is:

ORDERED that the Joint Motion to Terminate the above-identified proceeding is *granted*; and

FURTHER ORDERED that the joint request for the Confidential Binding Term Sheet, the Formal Settlement Agreement, the Clinical Supply Agreement, and their respective exhibits (Exhibits 1070, 2001, and 2002), to be treated as business confidential information and kept separate from the file of the involved patent under the provisions of 35 U.S.C. § 327(b) and 37 C.F.R. § 42.74(c) is *granted*.

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PETITIONER:

Thomas Fletcher
tfletcher@wc.com

David Berl
dberl@wc.com

PATENT OWNER:

John Rearick
jrearick@choate.com

Michael Shinall
mshinall@choate.com