

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ITM ISOTOPE TECHNOLOGIES MUNICH SE,
Petitioner,

v.

THE JOHNS HOPKINS UNIVERSITY,
Patent Owner.

PGR2025-00012
Patent 11,938,201 B2

Before JEFFREY N. FREDMAN, DEBRA L. DENNETT, and
JAMIE T. WISZ, *Administrative Patent Judges*.

DENNETT, *Administrative Patent Judge*.

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

With the Board’s prior authorization, Petitioner and Patent Owner (collectively “the Parties”) filed a Joint Motion to Terminate this proceeding. See Paper 18 (“Joint Motion”). In support of the Joint Motion, the Parties filed copies of a License and Settlement Agreement (Ex. 1037, “Settlement Agreement”) and Third-Party Side Agreement (Ex. 1038, “Upstream Consent”), as well as a Joint Request to Treat the Settlement Agreement and Upstream Consent as Business Confidential Information (Paper 19, “Joint Request”).

In the Joint Motion, the Parties represent they “have entered into a settlement agreement that resolves all underlying disputes between the parties, including PGR2025-00012 currently before the Board.” Joint Motion 2. The Parties further represent that the filed copies of the Settlement Agreement (Ex. 1037) and Upstream Consent (Ex. 1038) are “true copies” and that “[t]here are currently no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of the proceeding.” *Id.*

Under 35 U.S.C. § 327(a), “a post-grant 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.” The statute also provides that if no petitioner remains in the post-grant review, the Office may terminate the review. 35 U.S.C. § 327(a).

Petitioner filed its petition in this proceeding on December 24, 2024 (Paper 1), and we issued a decision granting institution on July 16, 2025 (Paper 12). In the Joint Motion, the parties state that “[t]ermination is

appropriate at this early stage in view of the settlement agreement.” Paper 18, 1.

We instituted a trial in this proceeding, but we have not yet decided the merits of the proceeding, and a final written decision has not been entered. Notwithstanding that the proceeding has moved beyond the preliminary stage, we determine that the Parties have shown adequately that termination of the proceeding is appropriate. Under these circumstances, we determine good cause exists to terminate the proceeding with respect to the Parties.

We also determine that the Parties have shown that the Settlement Agreement and Upstream Consent contain business confidential information, and that good cause exists to treat the Settlement Agreement and Upstream Consent as business confidential information under 37 C.F.R. § 42.74(c).

This Order does not constitute a final written decision pursuant to 35 U.S.C. § 328(a).

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Joint Motion to Terminate is granted; and

FURTHER ORDERED that PGR2025-00012 is terminated pursuant to 35 U.S.C. § 327(a) and 37 C.F.R. § 42.74; and

FURTHER ORDERED that the Joint Request for the Settlement Agreement (Exhibit 1037) and Upstream Consent (Exhibit 1038) to be treated as business confidential information and be kept separate from the files of U.S. Patent No. 11,938,201 B2, and be made available only to Federal Government agencies on written request, or to any person on a

PGR2025-00012
Patent 11,938,201 B2

showing of good cause, pursuant to 35 U.S.C. § 327(b) and 37 C.F.R.
§ 42.74(c), is granted.

PGR2025-00012
Patent 11,938,201 B2

PETITIONER:

David Kohn
LEWIS KOHN & WALKER LLP
dkohn@lewiskohn.com

Bryan Diner
Justin Hasford
Matthew Hlinka
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, LLP
bryan.diner@finnegan.com
justin.hasford@finnegan.com
matthew.hlinka@finnegan.com

PATENT OWNER:

Eldora Ellison
Olga Partington
Christopher Gallo
STERNE, KESSLER, GOLDSTEIN & FOX PLLC
eellison-ptab@sternekessler.com
opartington-ptab@sternekessler.com
cgallo-ptab@sternekessler.com