

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.

PGR2025-00065
Patent 12,115,233 B2

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

DENNETT, *Administrative Patent Judge*.

ORDER
Settlement Prior to Institution of Trial
37 C.F.R. § 42.74

On July 15, 2025, Petitioner filed a Petition requesting post-grant review of claim 1–4 of U.S. Patent No. 12,115,233 B2. Paper 1. On October 3, 2025, prior to the due date for a preliminary response, Petitioner and Patent Owner filed a Joint Motion to Terminate Proceeding. Paper 8 (“Joint Motion”). In support of the Joint Motion, the Parties filed copies of a License and Settlement Agreement (Ex. 1031, “Settlement Agreement”) and Third-Party Side Agreement (Ex. 1032, “Upstream Consent”).

In the Joint Motion, the Parties state that they have “entered into a settlement agreement that resolves all underlying disputes between the parties, including this PGR2025-00065 currently before the Board.” Paper 8, 2. The Parties also represent that “[t]here are no other agreements or understandings between Petitioner and Patent Owner, or collateral thereto, made in connection with, or in contemplation of, the termination of the proceeding.” *Id.*

This proceeding is at an early stage, and we have not yet issued a decision on whether to institute a trial. In view of the early stage of this proceeding, we determine that it is appropriate to terminate the proceeding to promote efficiency and minimize unnecessary costs. Therefore, the Parties’ Joint Motion to Terminate is granted.

The Parties also filed a Joint Request to Treat the Settlement Agreement and Upstream Consent as Business Confidential Information. Paper 9 (“Joint Request”). After reviewing the Settlement Agreement between Petitioner and Patent Owner, we find that the Agreement contains confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Settlement Agreement (Ex. 1031) and Upstream Consent (Ex. 1032) between Petitioner and Patent

PGR2025-00065
Patent 12,115,233 B2

Owner as business confidential information pursuant to 37 C.F.R.
§ 42.74(c).

This paper 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 PGR2025-00065 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 1031) and Upstream Consent (Exhibit 1032) to be
treated as business confidential information and be kept separate from the
files of U.S. Patent No. 12,115,233 B2, and be 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. § 327(b) and 37 C.F.R.
§ 42.74(c), is granted.

PGR2025-00065
Patent 12,115,233 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