

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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PFENEX INC.,  
Petitioner,

v.

GLAXOSMITHKLINE BIOLOGICALS SA,  
Patent Owner.

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IPR2019-01028  
Patent No. 9,422,345 B2

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Before SHERIDAN K. SNEDDEN, JO-ANNE M. KOKOSKI, and  
RICHARD J. SMITH, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

ORDER DENYING JOINT MOTION TO TERMINATE, GRANTING  
LEAVE TO FILE AMENDED MOTION TO TERMINATE, AND  
GRANTING JOINT REQUEST THAT SETTLEMENT AGREEMENT BE  
TREATED AS BUSINESS CONFIDENTIAL INFORMATION AND BE  
KEPT SEPARATE

*35 U.S.C. § 317; 37 C.F.R § 42.74*

At the request of the parties, the Board authorized the parties to file a motion to terminate, settlement agreement, and motion to keep the settlement agreement business confidential. Ex. 3005. On October 30, 2020, the parties filed a Joint Motion to Terminate (Paper 57), and a Joint Request to File Settlement Materials as Business Confidential Information and to Maintain said Materials Separate from the Public File (Paper 58). The parties also filed a Confidential Settlement Agreement. Ex. 2049.

The parties state in the Joint Motion to Terminate that “Petitioner and Patent Owner concurrently file a true and complete copy of their confidential written settlement materials (Confidential Exhibit 2049) in connection with this matter as required by statute,” and that “the parties’ settlement completely resolves the controversy between Patent Owner and Petitioner relating to U.S. Patent No. 9,422,345.” Paper 57, 1, 2. However, the Joint Motion to Terminate does not certify that there are no other agreements or understandings, oral or written, between the parties made in connection with, or in contemplation of, the termination of the above-referenced proceeding. *See* 35 U.S.C. § 317(b). The parties are granted leave to file an Amended Motion to Terminate certifying that there are no such agreements or understandings.

Accordingly, for the foregoing reasons, it is hereby

ORDERED that the parties’ request that the settlement materials (Confidential Ex. 2049) be treated as business confidential information, to be kept separate from the files of U.S. Patent No. 9,422,345 B2, under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), is GRANTED;

FURTHER ORDERED that the Joint Motion to Terminate the above-referenced proceeding is DENIED; and

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FURTHER ORDERED that the parties are granted leave to file an Amended Joint Motion to Terminate containing a certification that there are other agreements or understandings no later than November 5, 2020.

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