

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ILLUMINA, INC.,
Petitioner,

v.

TRUSTEES OF COLUMBIA UNIVERSITY
IN THE CITY OF NEW YORK,

Patent Owner.

IPR2020-00988 (Patent 10,407,458 B2)
IPR2020-01065 (Patent 10,407,459 B2)
IPR2020-01125 (Patent 10,457,984 B2)
IPR2020-01177 (Patent 10,435,742 B2)
IPR2020-01323 (Patent 10,428,380 B2)¹

Before SUSAN L. C. MITCHELL, ZHENYU YANG, JAMES A. WORTH,
ROBERT A. POLLOCK, MICHELLE N. ANKENBRAND, and
DEVON ZASTROW NEWMAN, *Administrative Patent Judges*.²

PER CURIAM

¹ This Order applies to each of the above-listed proceedings. We exercise our discretion to issue one Order to be filed in each proceeding. Unless otherwise authorized, the parties shall not use this heading style in any subsequent papers.

² This is not a decision by an expanded panel.

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DECISION

Denying Without Prejudice Joint Motion to Terminate Proceedings
Denying Without Prejudice Joint Request to File Settlement Agreement as
Business Confidential
35 U.S.C. § 317; 37 C.F.R. §§ 42.72, 42.74

I. INTRODUCTION

In each of the above-identified proceedings, the parties have filed a Joint Motion to Terminate the proceeding on the basis that the parties have reached a settlement. *See* 35 U.S.C. § 317; Paper 32 (“Motion”).³ Along with the Joint Motion to Terminate, the parties also filed a copy of their written settlement agreement (“Settlement Agreement”) (Ex. 1169), as well as a Joint Request to File the Settlement Agreement as Business Confidential Information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (“Joint Request”) (Paper 33).

II. DISCUSSION

Under the statute:

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

³ Unless otherwise noted, Paper and Exhibit numbers herein refer to IPR2020-00988. The parties have filed similar papers and exhibits in IPR2020-01065, IPR2020-01125, IPR2020-01177, and IPR2020-01323.

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the termination of the *inter partes* review as between the parties.

35 U.S.C. § 317(b) (emphasis added).

Similarly, 37 C.F.R. § 42.74(b) requires that “[a]ny agreement or understanding between the parties made *in connection with, or in contemplation of*, the termination of a proceeding shall be in writing and a true copy shall be filed with the Board before the termination of the trial” (emphasis added).

The Settlement Agreement the parties filed (Ex. 1169) does not appear to include all collateral agreements referred to, made in connection with, or in contemplation of, the termination of this proceeding. In particular, the Settlement Agreement states that “nothing in this Agreement shall be construed as replacing or superseding any of the terms of that certain Settlement Agreement, dated as of July 2017 . . .” Ex. 1169 ¶ 6.11. The parties, however, have not filed the referenced July 2017 settlement agreement with the Board.

Accordingly, we *deny without prejudice* the parties’ Joint Motion to Terminate each proceeding. *See DTN, LLC v. Farms Technology, LLC*, IPR2018-01412, Paper 21 (PTAB June 14, 2019) (precedential) (explaining that collateral agreements referenced in a settlement agreement must be filed before the proceeding may be terminated via settlement under 35 U.S.C. § 317). For the same reasons, we also *deny without prejudice* the parties’ Joint Request to File the Settlement Agreement as Business Confidential Information.

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The parties are authorized to file a renewed motion to terminate, together with a renewed joint request to treat the Settlement Agreement and the 2017 settlement agreement as business confidential.

III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Joint Motion to Terminate in each proceeding is *denied without prejudice*;

FURTHER ORDERED that the Joint Request to File the Settlement Agreement as Business Confidential in each proceeding is *denied without prejudice*;

FURTHER ORDERED that the parties are authorized to file a renewed joint motion to terminate the proceeding along with an updated settlement agreement, including the 2017 settlement agreement, within five business days of this ORDER; and

FURTHER ORDERED that the parties may request that the exhibit(s) that constitute the settlement agreement to be treated as business confidential information to be kept separate from the patent file, as specified in 37 C.F.R. § 42.74(c).

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