

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DANISCO US INC. and DUPONT NUTRITION BIOSCIENCES ApS,
Petitioner,

v.

NOVOZYMES A/S,
Patent Owner.

IPR2021-00188 (Patent 10,058,107 B2)
IPR2021-00189 (Patent 10,555,541 B2)¹

Before JAMES A. WORTH, ROBERT A. POLLOCK, and
RYAN H. FLAX, *Administrative Patent Judges*.

PER CURIAM, *Administrative Patent Judge*.

TERMINATION

Due to Settlement After Institution of Trial and
Granting Joint Request to Treat Settlement Agreement as
Business Confidential Information

35 U.S.C. § 317; 37 C.F.R. § 42.74

¹ Substantially identical copies of Paper 17, Paper 18, and Exhibit 2002, discussed *infra*, are of record in both of the above-referenced proceedings and this order applies to both cases. We exercise our discretion to issue one Order to be docketed in each case. The parties, however, are not authorized to use this caption for any subsequent papers.

I. INTRODUCTION

Petitioner and Patent Owner (collectively “the Parties”) have requested that the above-identified *inter partes* review proceedings be terminated pursuant to a settlement. On August 27, 2021, the Parties filed an authorized Joint Motion to Terminate Proceeding (“Joint Motion”). Paper 17. The Parties also filed a copy of a settlement agreement and collateral agreements (Ex. 2002, “Agreements”) and filed a Joint Request to Keep Agreements Confidential and Separate Under 37 C.F.R. § 42.74(c) (Paper 18, “Joint Request”) in the proceeding.

II. DISCUSSION

Under 35 U.S.C. § 317(a), “[a]n *inter partes* 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.” It is also provided in 35 U.S.C. § 317(a) that if no petitioner remains in the *inter partes* review, the Office may terminate the review.

In the Joint Motion, the Parties represent that they have reached an agreement to jointly seek termination of the *inter partes* review proceedings, that the filed copies of the Agreements are true copies and “there are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of this proceeding.” Joint Motion 1.

We instituted a trial in each proceeding on May 17, 2021. Paper 10 (in each). We have not yet decided the merits of the proceedings, and a final written decision has not been entered in either proceeding. Notwithstanding that the proceedings have moved beyond the preliminary stage, the Parties

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have shown adequately that the termination of the proceedings is appropriate. Under these circumstances, we determine that good cause exists to terminate the proceedings with respect to the Parties.

The Parties also requested that the Agreements be treated as business confidential information and be kept separate from the file of Patents 10,555,541 and 10,058,107. Joint Request 1–2. After reviewing the Agreements between the Parties, we find that the Agreements contain confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Settlement Agreement (Exhibit 2002 in each proceeding) as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

This Order does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

III. ORDER

Accordingly, for the reasons discussed above, it is:

ORDERED that the Joint Motion is *granted*, and IPR2021-00188 and IPR2021-00189 are *terminated* with respect to Petitioner and Patent Owner, pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72; and

FURTHER ORDERED that the Joint Request is *granted*, and the Settlement Agreement (Exhibit 2002) shall be kept separate from the file of Patent 10,555,541 and Patent 10,058,107, and 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. § 317(b) and 37 C.F.R. § 42.74(c).

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For PETITIONER:

Michael J. Flibbert
Pier D. DeRoo
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, LLP
michael.flibbert@finnegan.com
pier.deroo@finnegan.com

For PATENT OWNER:

Dorothy P. Whelan
Robert C. Sullivan, Jr.
Michael T. Zoppo
Kathryn Grey
FISH & RICHARDSON P.C.
whelan@fr.com
rsullivan@fr.com
zoppo@fr.com grey@fr.com