

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MILTENYI BIOMEDICINE GmbH and MILTENYI BIOTEC INC,
Petitioner,

v.

THE TRUSTEES OF THE UNIVERSITY OF PENNSYLVANIA,
Patent Owner.

IPR2022-00855
Patent 9,540,445 B2

Before ULRIKE W. JENKS, SUSAN L. C. MITCHELL, and
ROBERT A. POLLOCK, *Administrative Patent Judges*.

POLLOCK, *Administrative Patent Judge*.

TERMINATION

Due to Settlement After Institution of Trial and
Granting-in-part and Denying-in-part Joint Motion to Keep
Settlement Agreement Separate and Confidential
35 U.S.C. § 317; 37 C.F.R. §§ 42.72, 42.74

I. INTRODUCTION

On May 16, 2023, and with our authorization (Ex. 3003), Petitioner and Patent Owner (collectively, “the Parties”) filed a joint motion to terminate the above-captioned *inter partes* review proceeding. Paper 28 (“Joint Motion”). Along with the Joint Motion, the Parties filed a copy of a settlement and license agreement (Ex. 2083, “Settlement Agreement”), as well as a joint motion requesting that the Settlement Agreement be treated as business confidential information and kept it separate from the file of U.S. Patent No. 9,540,445 B2 (“the ’445 patent”). Paper 29 (“Joint Request”).

II. DISCUSSION

In the Joint Motion, the Parties represent that the Settlement Agreement resolves their underlying dispute involving the ’445 patent. Joint Motion 8. The Parties also represent that they have filed a true copy of the Settlement Agreement made in connection with, or in contemplation of, the termination of the above-captioned proceeding. *Id.* at 8–9. The Parties “certify that there are no other agreements, oral or written, between the Parties made in connection with, or in contemplation of, the termination of the proceeding.” *Id.* at 11.

We instituted trial for the above-captioned *inter partes* review proceeding on October 11, 2022. *See* Paper 10. 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, the Parties have shown adequately that the termination of the proceeding is appropriate. Under these circumstances, we determine that good cause exists to terminate the proceeding with respect to the Parties.

The Parties also request that the Settlement Agreement be treated as business confidential information and kept separate from the file of the '445 patent. Joint Request 8. After reviewing the Settlement Agreement, we find that it contains confidential business information regarding the terms of settlement. Thus, good cause exists to treat the Settlement Agreement as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Accordingly, we *grant* this portion of the Joint Request.

However, we *deny* the portion of the Joint Request specifying that, should there be filed a request for access to the Settlement Agreement, “the Parties be given the opportunity to comment on the request before a decision is made with respect to whether it should be granted or denied.” Joint Request 8. The Parties’ request is not supported by statute nor rule.

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

III. ORDER

Accordingly, it is:

ORDERED that the Joint Motion to terminate (Paper 28) is *granted*, and IPR2022-00855 is *terminated* with respect to Petitioner and Patent Owner; and

FURTHER ORDERED that the Joint Request to treat the Settlement Agreement as business confidential information under 35 U.S.C. § 317(b) (Paper 29) is *granted-in-part* and *denied-in-part*, in the manner noted above; and

FURTHER ORDERED that the Settlement Agreement (Ex. 2083) shall be kept separate from the file of U.S. Patent No. 9,540,445 B2, and

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made available only to Federal Government agencies on written request, or
to any person on a showing of good cause, pursuant to 37 C.F.R. § 42.74(c).

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PETITIONER:

Yite John Lu
Gary Frischling
ORRICK, HERRINGTON & SUTCLIFFE LLP
ptabdocketl2y7@orrick.com
ptabdocketg2f1@orrick.com

PATENT OWNER:

Brian Landry
Kathryn Doyle
Alireza Behrooz
SAUL EWING ARNSTEIN & LEHR LLP
blandry@saul.com
kathryn.doyle@saul.com
alireza.behrooz@saul.com

Thomas Fletcher
Jessamyn Berniker
David Krinsky
WILLIAMS & CONNOLLY LLP
tfletcher@wc.com
jberniker@wc.com
dkrinsky@wc.com