

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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FLUIDIGM, CORP.,  
Petitioner,

v.

THE BOARD OF TRUSTEES OF  
THE LELAND STANFORD JUNIOR UNIV.,  
Patent Owner.

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Case IPR2017-00013 (Patent 7,563,584 B2)  
Case IPR2017-00014 (Patent 7,695,926 B2) <sup>1</sup>

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Before ERICA A. FRANKLIN, GEORGIANNA W. BRADEN, and  
ZHENYU YANG, *Administrative Patent Judges*.

FRANKLIN, *Administrative Patent Judge*.

ORDER  
Conduct of the Proceeding  
37 C.F.R. § 42.5

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<sup>1</sup> This Order addresses issues common to each captioned cases. Thus, we enter the same Order in each case.

IPR2017-00013 (Patent 7,563,584 B2)

IPR2017-00014 (Patent 7,695,926 B2)

On June 8, 2017, in each of the above-captioned cases, with authorization of the Board, the parties filed a joint motion to terminate the proceeding pursuant to 37 C.F.R. §§ 42.5(a), 42.71, and 42.72. Paper 8, 2.<sup>2</sup> The parties also filed an exhibit in each proceeding, Ex. 2016, referred to as “the Settlement agreement between the Petitioner and Patent Owner.” Paper 9, 2. Additionally, citing to 37 C.F.R. § 42.74 (c), the parties filed a joint request in each proceeding that the settlement agreement be treated as business confidential information and “kept separate from the files of these proceedings and the involved patents.” *Id.*

With our authorization to file the joint motions to terminate the proceedings, we explained that any agreement(s) between the parties made in connection with the termination of the proceedings must be in writing and a true copy must be filed with the Board. 37 C.F.R. § 42.74(b). The settlement agreement filed by the parties in each proceeding states that “in exchange for good and valuable consideration, receipt and sufficiency of which are hereby acknowledged, the Parties have hereby agreed to settle the disputes arising in IPR2014-00013 and IPR2017-00014 and request that the Patent Trial and Appeal Board terminate both proceedings.” Ex. 1016, 1. That agreement, however, does not describe such “consideration,” or the precise terms of the settlement. Instead, it appears that Exhibit 1016 represents only a notice that a settlement agreement has been reached. Such notice does not comply with the requirement set forth in 37 C.F.R. § 42.74(b). Thus, the parties’ requests to terminate the proceedings are

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<sup>2</sup> Citations to paper and exhibit numbers in this Order refer to filings in IPR2017-00013. Similar documents were filed in each captioned case.

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incomplete.

The Joint Motions to Terminate IPR2017-00013 and IPR2017-00014 will be considered after the parties satisfy 37 C.F.R. § 42.74(b). The time to fulfill that requirement is extended to June 19, 2017. If the parties have questions regarding this Order, they are instructed to contact the Board and request a conference. Such a request shall include alternate dates and times that the parties are available for a conference.

Accordingly, it is hereby

ORDERED that any agreement(s) between the parties made in connection with the termination of the proceedings must be in writing and a true copy must be filed with the Board, as set forth in 37 C.F.R. § 42.74(b); and

FURTHER ORDERED that authorization for the parties to satisfy the requirements for requesting termination of the proceedings based upon settlement agreements is extended to June 19, 2017.

IPR2017-00013 (Patent 7,563,584 B2)

IPR2017-00014 (Patent 7,695,926 B2)

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