

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AGILENT TECHNOLOGIES, INC.,
Petitioner,

v.

THERMO FISHER SCIENTIFIC INC. and
THERMO FISHER SCIENTIFIC (BREMEN) GMBH,
Patent Owner.

Cases

IPR2018-00297 (Patent RE45,553 E)
IPR2018-00298 (Patent RE45,386 E)
IPR2018-00299 (Patent 7,230,232 B2)
IPR2018-00313 (Patent RE45,386 E)

Before MICHAEL R. ZECHER, JOHN F. HORVATH, and
DANIEL J. GALLIGAN, *Administrative Patent Judges*.

GALLIGAN, *Administrative Patent Judge*.

DECISION

Granting the Parties' Joint Motions to Terminate
35 U.S.C. § 317, 37 C.F.R. §§ 42.72 and 42.74

IPR2018-00297 (Patent RE45,553 E) IPR2018-00298 (Patent RE45,386 E)
IPR2018-00299 (Patent 7,230,232 B2) IPR2018-00313 (Patent RE45,386 E)

I. DISCUSSION

On October 3, 2018, with Board authorization, the parties filed in each of these proceedings a Joint Motion to Terminate¹ along with what they indicate is a true copy of their settlement agreement.² In the Joint Motions to Terminate, the parties represent that they have settled their disputes regarding the patents at issue in these proceedings.³ In each of these proceedings, the parties also request to have their settlement agreement treated as business confidential information and kept separate from the file of the involved patent pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).⁴

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 patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” Further, under 35 U.S.C. § 317(b),

[a]ny 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 the termination.

¹ IPR2018-00297, Paper 32; IPR2018-00298, Paper 32; IPR2018-00299, Paper 27; IPR2018-00313, Paper 30.

² IPR2018-00297, Ex. 1045; IPR2018-00298, Ex. 1046; IPR2018-00299, Ex. 1045; IPR2018-00313, Ex. 1046.

³ IPR2018-00297, Paper 32, 1; IPR2018-00298, Paper 32, 1; IPR2018-00299, Paper 27, 1; IPR2018-00313, Paper 30, 1.

⁴ IPR2018-00297, Paper 33; IPR2018-00298, Paper 33; IPR2018-00299, Paper 28; IPR2018-00313, Paper 31.

IPR2018-00297 (Patent RE45,553 E) IPR2018-00298 (Patent RE45,386 E)
IPR2018-00299 (Patent 7,230,232 B2) IPR2018-00313 (Patent RE45,386 E)

We instituted trial in each of these proceedings on June 18, 2018. A hearing in each proceeding is currently scheduled for March 13, 2019, and we have not yet entered a final written decision in any of the proceedings. Based on the circumstances of these proceedings, we determine that it is appropriate to terminate them without rendering any further decisions. *See* 35 U.S.C. § 317; 37 C.F.R. §§ 42.72, 42.74.

Accordingly, the Joint Motions to Terminate the above-identified proceedings and the parties' requests to treat the settlement agreement as business confidential information are granted. As requested by the parties, the settlement agreement will be treated as business confidential information and will be kept separate from the file of the patent at issue in each proceeding. 35 U.S.C. § 317(b); 37 C.F.R. § 42.74(c). This paper does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

II. ORDER

Therefore, it is

ORDERED that the parties' requests that their settlement agreement be treated as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) are GRANTED;

FURTHER ORDERED that the settlement agreement be kept separate from the files of U.S. Patent Nos. RE45,386 E, RE45,553 E, and 7,230,232 B2; and

FURTHER ORDERED that the parties' Joint Motions to Terminate these proceeding are GRANTED, and these proceedings are hereby terminated.

IPR2018-00297 (Patent RE45,553 E) IPR2018-00298 (Patent RE45,386 E)
IPR2018-00299 (Patent 7,230,232 B2) IPR2018-00313 (Patent RE45,386 E)

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