

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CANFIELD SCIENTIFIC, INC.,
Petitioner,

v.

MELANOSCAN LLC,
Patent Owner.

IPR2017-02125
Patent 7,359,748 B1

Before MICHAEL W. KIM, *Vice Chief Administrative Patent Judge*, and
LYNNE H. BROWNE and SCOTT C. MOORE, *Administrative Patent
Judges*.

MOORE, *Administrative Patent Judge*.

TERMINATION

Due to Settlement After Remand

35 U.S.C. § 317(a),(b); 37 C.F.R. §§ 42.72, 42.74

I. INTRODUCTION

Petitioner Canfield Scientific, Inc. requested an *inter partes* review of claims 1–8, 11, 30, 32–34, 46, and 51 of U.S. Patent No. 7,359,748 B1 (Ex. 1001, the “748 patent”). Paper 9 (“Petition”).¹ On May 26, 2019, we issued a final written decision determining that Petitioner had failed to demonstrate by a preponderance of the evidence that any of the challenged claims was unpatentable. Paper 62. Petitioner appealed to the Court of Appeals for the Federal Circuit (“Federal Circuit”). Paper 63. On appeal, the Federal Circuit reversed our final written decision as to independent claims 1 and 51, vacated our final written decision as to dependent claims 2–8, 11, 30, 32–34, and 46, and remanded the case to us for a determination as to the patentability of these dependent claims. *Canfield Scientific, Inc. v. Melanoscan, LLC*, Case No. 19-1927, D.I. 51 (Fed. Cir. Feb. 18, 2021).

On January 7, 2022, Petitioner and Patent Owner Melanoscan, LLC (collectively “the Parties”) filed a “Joint Request to Terminate *Inter Partes* Review.” See Paper 67 (“Motion”). The Parties also filed a true copy of a Settlement Agreement (Paper 69, “Settlement Agreement”) and a “Joint Request That the Office Treat [the Settlement Agreement] as Confidential Business Information.” See Paper 68 (“Request”).²

¹ Reference to the Petition herein refers to the Corrected Petition, entered November 27, 2017.

² The Parties filed the Settlement Agreement as a Paper rather than as an Exhibit. We deem this to be harmless error; however, the Parties are reminded that a document such as an agreement between the parties must be filed as an Exhibit. See 37 C.F.R. § 42.63(a) (“Evidence consists of affidavits, transcripts of depositions, documents, and things. All evidence must be filed in the form of an exhibit.”).

II. DISCUSSION

The Motion states: “Petitioner and Patent Owner have reached a settlement regarding this matter.” Motion 1. The Motion further states that: “[f]iled concurrently herewith is (i) a true and complete copy of the settlement agreement between the parties.” *Id.* Accordingly, the Motion states that “Petitioner and Patent Owner request that the Office terminate this *inter partes* review at the earliest opportunity.” *Id.*

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding. PTAB Consolidated Trial Practice Guide, 86 (November 2019)³; 35 U.S.C. § 317(a). Here, although the Board has already issued a final written decision, part of that decision was vacated and remanded by the Federal Circuit. The Board has not issued a decision on remand and, thus, has not decided the merits of the issues that were remanded to the Board. Under these circumstances, we grant the Motion and terminate this proceeding.

The Parties also “jointly request that the Office treat the settlement agreement as business confidential information, and keep the settlement agreement confidential and separate from the Office’s files involving the patent that is the subject of this *inter partes* review.” Request 1.

After reviewing the Settlement Agreement between the Parties, we find that the Settlement Agreement contains confidential business information regarding the terms of settlement. Thus, we determine that good cause exists to treat the Settlement Agreement (Paper 69) between the Parties as business confidential information under 35 U.S.C. § 317(b) and

³ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

37 C.F.R. § 42.74(c), and to keep it separate from the files of the involved patent and associated proceeding, as requested by the Parties.

III. ORDER

In view of the foregoing, it is:

ORDERED that the Joint Request to Terminate *Inter Partes* Review (Paper 67) is *granted*, and that this proceeding is *terminated*;

FURTHER ORDERED that the Joint Request That the Office Treat the Settlement Agreement as Confidential Business Information (Paper 68) is *granted*; and

FURTHER ORDERED that the Settlement Agreement shall remain designated as “Parties and Board Only” in the Board’s electronic filing system, be kept separate from the files of U.S. Patent No. 7,359,748 B1, and be made available only under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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