

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DANA-FARBER CANCER INSTITUTE, INC.,
Petitioner,

v.

BRISTOL-MYERS SQUIBB CO.,
Patent Owner.

IPR2023-00249 (Patent 10,323,092 B2)
IPR2023-00252 (Patent 10,138,299 B2)¹

Before JEFFREY N. FREDMAN, ERICA A. FRANKLIN, and
ZHENYU YANG, *Administrative Patent Judges*.

YANG, *Administrative Patent Judge*.

DECISION
Settlement Prior to Institution of Trial and
Granting Joint Request to Treat Settlement Agreement
as Business Confidential Information
37 C.F.R. § 42.74

¹ This Decision addresses the same issue for the above-identified cases. Therefore, we exercise our discretion to issue one decision to be filed in each case.

I. INTRODUCTION

With the Board’s authorization (Ex. 3001), Petitioner and Patent Owner (collectively, “the Parties”) filed a Joint Motion to Terminate each of the above-captioned *inter partes* review proceedings. Paper 9 (“Joint Motion”).² Along with the Joint Motion, the Parties filed a copy of a Settlement Agreement (Ex. 1073, “Settlement Agreement”), as well as a Joint Request to treat the Settlement Agreement as business confidential information and keep it separate from the files of the patents involved in the above-captioned proceedings. Paper 10 (“Joint Request”).

II. DISCUSSION

In the Joint Motion, the Parties represent that the Settlement Agreement resolves their disputes involving the patents at issue in the above-captioned proceedings. Joint Motion 1. The Parties also represent “[t]here are no other agreements or understandings, oral or written, including collateral agreements, made in connection with, or in contemplation of, the termination of the proceedings between the parties.” *Id.* at 3. The Settlement Agreement states that it “constitutes and contains the entire understanding and agreement of the Parties respecting the subject matter hereof and supersedes any and all prior or contemporaneous negotiations, correspondence, understandings, and agreements of the Parties, whether oral or written, regarding such subject matter.” Settlement Agreement 13.

The above-captioned proceedings are at an early stage. Patent Owner has not filed its Preliminary Response, and we have not yet decided whether

² The relevant papers and exhibits filed in the above-captioned proceedings are substantively the same. We cite to the record in IPR2023-00249, unless otherwise indicated.

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to institute a trial in the proceedings. In view of the early stage of the proceedings and the settlement between the Parties, we determine that good cause exists to terminate the above-captioned proceedings with respect to the Parties.

In the Joint Request, the Parties request that the Settlement Agreement be treated as business confidential information and kept separate from the files of the patents involved in the above-captioned proceedings. Joint Request 1. 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 37 C.F.R. § 42.74(c).

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

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III. ORDER

Accordingly, it is:

ORDERED that the Joint Motions to Terminate (IPR2023-00249, Paper 9; IPR2023-00252, Paper 9) are *granted*, the petitions in IPR2023-00249 and IPR2023-00252 are *dismissed*, and the proceedings are *terminated*; and

FURTHER ORDERED that the Joint Requests to treat the Settlement Agreement as business confidential information (IPR2023-00249, Paper 10; IPR2023-00252, Paper 10) are *granted*, and the Settlement Agreement (IPR2023-00249, Ex. 1073; IPR2023-00252, Ex. 1073) shall be kept separate from the files of U.S. Patent Nos. 10,138,299 B2 and 10,323,092 B2, and 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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