

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMMONWEALTH SCIENTIFIC AND INDUSTRIAL RESEARCH
ORGANISATION,
Petitioner,

v.

BASF PLANT SCIENCE COMPANY GMBH,
Patent Owner.

Case No. PGR2023-00007

U.S. Patent No. 11,260,095

Issued: March 1, 2022

JOINT MOTION TO TERMINATE POST GRANT REVIEW

I. STATEMENT OF REQUESTED RELIEF

Pursuant to 35 U.S.C. § 327 and 37 C.F.R. § 42.74, and the Board's authorization on January 24, 2023, Petitioner Commonwealth Scientific and Industrial Research Organisation ("CSIRO") and Patent Owner BASF Plant Science Company GmbH ("BASF") jointly move the Board to terminate this Post-Grant Review ("PGR") proceeding in its entirety as a result of a settlement agreement between these parties. The parties are concurrently filing a separate, joint request that their settlement agreement (Ex. 1016 (Confidential)), being filed herewith, be treated as business confidential information and be kept separate from the files of the involved patent.

II. STATEMENT OF MATERIAL FACTS

Petitioner filed a petition for Post-Grant Review on November 30, 2022 (Paper No. 1). Besides this initial filing of the petition, the parties have filed no papers. Importantly, the Board has not instituted a Post-Grant Review Proceeding.

On December 8, 2022, Petitioner and Patent Owner entered into a written settlement agreement resolving this proceeding between the parties. *See* Ex. 1016 (Confidential). Under the terms of that agreement, the parties agreed, *inter alia*, to jointly seek termination of any legal or administrative proceeding concerning U.S. Patent No. 11,260,095. *See* Ex. 1016 (Confidential), sections 1.25 and 5.1, and Exhibit C-9. This written agreement is the only agreement between the parties and

there are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of this proceeding. Further, there are no related proceedings involving the patent that is the subject of this proceeding. On January 24, 2023 the Board authorized the parties to file this motion.

III. ARGUMENT

Section 327(a) of 35 U.S.C. (Chapter 32) states that a “post-grant review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” It further states that “[i]f no petitioner remains in the post-grant review, the Office may terminate the post-grant review or proceed to a final written decision under section 328(a).” 35 U.S.C. § 327(a).

Similarly, 37 C.F.R. § 42.72 states that “[t]he Board may terminate a trial without rendering a final written decision, where appropriate, including where the trial is consolidated with another proceeding or pursuant to a joint request under 35 U.S.C. 317(a) or 327(a).” The Trial Practice Guide additionally explains that “[t]here are strong public policy reasons to favor settlement between the parties to a proceeding” and that 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.” *See* “Consolidated Trial Practice Guide,” at 86 (Nov. 2019).

A. The Board Should Terminate this PGR in its Entirety

The parties jointly move the Board to terminate this proceeding in view of their settlement agreement. Ex. 1016 (Confidential). They entered into the settlement agreement before the deadline for the Patent Owner to file its Patent Owner's Preliminary Response and well before institution of a Post-Grant Review Proceeding by the Board. Accordingly, termination of the instant PGR is appropriate under all relevant authorities and would save the Board resources in administering this proceeding and issuing a final written decision. Given these facts and because no petitioner will remain after termination with respect to CSIRO, the Board should exercise its discretion and terminate review in its entirety under 35 U.S.C. § 327.

B. The Parties Are Submitting a Written Settlement Agreement

Pursuant to 37 C.F.R. § 42.74(c), submitted herewith, as Exhibit 1016 (Confidential), is a true copy of the complete settlement agreement entered between the parties on December 8, 2022. The settlement agreement has been submitted for access by the "Parties and Board Only" due to the sensitive business confidential information it contains. The parties accordingly expect the Board and Patent Office to maintain that settlement agreement as business confidential information under 35 U.S.C. § 327(b) and 37 C.F.R. § 42.74(c). The parties' separate, joint request for the same accompanies this motion.

IV. CONCLUSION

This motion is being filed before the deadline for Patent Owner to file a Preliminary Response to the Petition for Post-Grant Review and before the Board's deadline to decide whether to institute a Post-Grant Review proceeding. The parties have settled their dispute, including disposition of this proceeding, and supplied a copy of their written settlement agreement. The Board should therefore grant this motion.

Respectfully submitted,

February 1, 2023

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that, pursuant to 37 C.F.R. § 42.6(e), a copy of the foregoing “JOINT MOTION TO TERMINATE POST GRANT REVIEW” is being electronically filed via the Patent Trial and Appeal Case Tracking System (P-TACTS) and served today, February 1, 2023, by e-mail to counsel for Patent Owner BASF at the email addresses listed below:

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Dated: February 1, 2023

/Darren Haber/

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