

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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NANOCELLECT BIOMEDICAL, INC.,  
Petitioner,

v.

CYTONOME/ST, LLC,  
Patent Owner.

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Case IPR2020-00551  
Patent 10,065,188

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**JOINT MOTION TO TERMINATE AND  
JOINT NOTICE OF AGREEMENT PURSUANT TO  
35 U.S.C. § 317 AND 37 C.F.R. § 42.74**

## **I. Relief Requested**

Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74, and as authorized by the Board in an email dated February 10, 2021, Petitioner NanoCollect Biomedical, Inc. (“NanoCollect”) and Patent Owner Cytonome/ST, LLC (“Cytonome”), provide notice that they have reached a settlement and jointly request termination of Case No. IPR2020-00551, an *inter partes* review of U.S. Patent No. 10,065,188 (“the ’188 patent”). NanoCollect and Cytonome concurrently file a motion requesting that the Board treat the settlement agreement and attachments 1-4 to the settlement agreement as business confidential information and keep them separate from the file of the involved patent.

## **II. Reasons for the Relief Requested**

NanoCollect and Cytonome have reached a settlement agreement regarding their disputes relating to the ’188 patent. The parties have not completed their substantive or pre-hearing briefing and no oral argument has been held.

Termination will at the very least conserve the resources of the parties and the Board.

## **III. Related Litigation and PTAB Proceedings**

NanoCollect and Cytonome are involved in related litigation before the United States District Court for the District of Delaware under the caption *Cytonome/ST, LLC v. NanoCollect Biomedical, Inc.*, Case No. 1:19-cv-00301-

UNA, which concerns the Patent-in-Review. NanoCollect and Cytonome are contemporaneously seeking dismissal of the related proceeding.

#### **IV. Submission of the Settlement Agreement**

Submitted concurrently with this motion is a true copy of the settlement agreement between NanoCollect and Cytonome (Exhibit 1069), as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), and attachments 1-4 (Exhibits 1070-1073).

NanoCollect and Cytonome also concurrently file a joint motion that the settlement agreement and attachments 1-4 be treated as business confidential information and be 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). NanoCollect and Cytonome certify that there are no collateral agreements or understandings made in connection with, or in contemplation of, the requested termination.

#### **V. Conclusion**

For the reasons stated above, NanoCollect and Cytonome respectfully request that the Board terminate this proceeding.

Dated: February 10, 2021

Respectfully submitted,

/ Michael T. Rosato /

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Dated: February 10, 2021

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/ Kirt S. O'Neill /

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## LIST OF EXHIBITS

Exhibit No	Description
1001	U.S. Patent No. 10,065,188 to Johnson, <i>et al.</i>
1003	<i>Curriculum Vitae</i> of Bernhard H. Weigl, Ph.D.
1004	Prosecution History of U.S. Patent No. 10,065,188 to Johnson, <i>et al.</i>
1005	U.S. Patent No. 5,101,978 to Marcus (issued April 7, 1992)
1006	International PCT Publication No. WO 00/70080 to Wada, <i>et al.</i> , (published November 23, 2000)
1007	<i>Intentionally left blank</i>
1008	U.S. Patent Application Publication No. 2003/0196714 to Gilbert, <i>et al.</i> , (published October 23, 2003)
1009	U.S. Patent Application Publication No. 2003/0198523 to Bohm, <i>et al.</i> (published October 23, 2003)
1010	U.S. Patent No. 6,325,114 to Bevirt, <i>et al.</i> (issued December 4, 2001)
1011-13	<i>Intentionally left blank</i>
1014	Chapman, <i>Instrumentation for flow Cytometry</i> , J. IMMUNOL. METHODS 243 (2000) 3-12
1015	<i>Intentionally left blank</i>
1016	U.S. Patent No. 3,508,654 to Glaettli (issued April 28, 1970)
1017	Figeys, <i>et al.</i> , <i>Lab-on-a-Chip: A Revolution in Biological and Medicinal Sciences</i> , ANAL. CHEM. (2000) 330-35
1018	Deshpande, <i>et al.</i> , <i>Novel Designs for Electrokinetic Injection in <math>\mu</math>TAS</i> , MICRO TOTAL ANAL. SYS. (2000) 339-42

Exhibit No	Description
1019	<i>Intentionally left blank</i>
1020	U.S. Patent No. 6,068,751 to Neukermans (issued May 30, 2000)
1021	<i>Intentionally left blank</i>
1022	Zeng, <i>Fabrication and characterization of electroosmotic micropumps</i> , SENS ACTUAT. B, 79 (2001) 107-14
1023	U.S. Patent Publication No. 2001/0054702 to Williams (published December 27, 2001)
1024-31	<i>Intentionally left blank</i>
1032	International PCT Publication No. WO 99/43432 to Dubrow, <i>et al.</i> (published September 2, 1999)
1033-38	<i>Intentionally left blank</i>
1039	U.S. Patent No. 6,877,528 to Gilbert, <i>et al.</i> (issued April 12, 2005)
1040	U.S. Provisional Patent Application No. 60/633,396 to Gilbert, <i>et al.</i> (filed December 3, 2004)
1041	U.S. Patent Application No. 11/295,183 to Gilbert, <i>et al.</i> (filed December 5, 2005)
1042	Plaintiff's Reply Claim Construction Brief, <i>Cytonome/ST, LLC v. NanoCollect Biomedical, Inc.</i> , C.A. No. 19-301 (RGA) (D. Del. filed Jan. 31, 2020)
1043	Exhibit A: Declaration of Giacomo Vacca, Plaintiff's Reply Claim Construction Brief, <i>Cytonome/ST, LLC v. NanoCollect Biomedical, Inc.</i> , C.A. No. 19-301 (RGA) (D. Del. filed Jan. 31, 2020)
1044	Complaint, <i>Cytonome/St, LLC v. NanoCollect Biomedical, Inc.</i> , C.A. No. 1:19-00301 (UNA) (D. Del., filed Feb. 12, 2019)

Exhibit No	Description
1045	Plaintiff's Opening Claim Construction Brief, <i>Cytonome/St, LLC v. NanoCollect Biomedical, Inc.</i> , C.A. No. 1:19-00301 (RGA) (D.Del.)
1046	Joint Claim Construction Statement, <i>Cytonome/St, LLC v. NanoCollect Biomedical, Inc.</i> , C.A. No. 1:19-00301 (RGA) (D.Del.).
1047	Transcript of May 18, 2020 Telephone Conference
1048	NanoCollect Biomedical, Inc.'s Stipulation of Invalidity Contentions, Case No. 1:19-cv-00301-RGA, D.I. 92 (June 18, 2020).
1049	June 16, 2020 Letter from Daniel Moffett to Adam Burrowbridge re Reduced List of Asserted Claims
1050	May 14, 2020 Letter from Daniel Moffett re COVID-19 Extension
1051	Memorandum Order, <i>Miics &amp; Partners Am., Inc. v. Toshiba Corp.</i> , No. 14-cv-00803-RGA, D.I. 82 (D. Del. Aug. 11, 2015).
1052	<i>Huvepharma EEOD v. Associated British Foods, PLC</i> , No. 18-cv-00129-RGA, 2019 U.S. Dist. LEXIS 139034, at *1-4 (D. Del. Aug. 12, 2019).
1053	Memorandum Order, <i>Callwave Commun's, LLC v. AT&amp;T Mobility, LLC</i> , No. 12-cv-1701-RGA (D. Del. Mar. 18, 2015)
1054	Standing Order, In re: Court Operations under Exigent Circumstances Created by COVID-19 (D. Del. March 18, 2020), available at <a href="https://www.ded.uscourts.gov/sites/ded/files/StandingOrder-03-17-20-Courthouse%20Access.pdf">https://www.ded.uscourts.gov/sites/ded/files/StandingOrder-03-17-20-Courthouse%20Access.pdf</a> (last visited June 16, 2020).
1055	Revised Standing Order, In re: Court Operations under Exigent Circumstances Created by COVID-19 (D. Del. April 17, 2020), available at <a href="https://www.ded.uscourts.gov/sites/ded/files/news/Revised%20Standing%20Order%20April%2017%202020%20%281%29.pdf">https://www.ded.uscourts.gov/sites/ded/files/news/Revised%20Standing%20Order%20April%2017%202020%20%281%29.pdf</a> (last visited June 16, 2020).

Exhibit No	Description
1056	Revised Standing Order, In re: Court Operations under Exigent Circumstances Created by COVID-19 (D. Del. May 27, 2020), available at <a href="https://www.ded.uscourts.gov/sites/ded/files/Modified%20Standing%20Order%20May%2027%202020.pdf">https://www.ded.uscourts.gov/sites/ded/files/Modified%20Standing%20Order%20May%2027%202020.pdf</a> (last visited June 16, 2020).
1057	District of Delaware Re-Opening Guidelines (June 15, 2020), available at <a href="https://www.ded.uscourts.gov/sites/ded/files/news/Reopening%20Guidelines%20District%20of%20Delaware.pdf">https://www.ded.uscourts.gov/sites/ded/files/news/Reopening%20Guidelines%20District%20of%20Delaware.pdf</a> (last visited June 16, 2020).
1058	Mukherjee, S., Can a Vaccine for Covid-19 Be Developed in Record Time?, NY TIMES (June 9, 2020), available at <a href="https://www.nytimes.com/interactive/2020/06/09/magazine/covid-vaccine.html">https://www.nytimes.com/interactive/2020/06/09/magazine/covid-vaccine.html</a> (last visited June 13, 2020).
1059	Report of the Jury Subgroup: Conducting Jury Trials and Convening Grand Juries During the Pandemic, United States Courts' Covid-19 Judicial Task Force (June 4, 2020), available at <a href="https://www.uscourts.gov/sites/default/files/combined_jury_trial_post_covid_doc_6.10.20.pdf">https://www.uscourts.gov/sites/default/files/combined_jury_trial_post_covid_doc_6.10.20.pdf</a> (last visited June 16, 2020).
1060	Scheindlin, S., 2 Tested Alternatives to Unavoidable Court Delays, Law360 (June 4, 2020), available at <a href="https://www.law360.com/commercialcontracts/articles/1278447/2-tested-alternatives-to-unavoidable-court-delays">https://www.law360.com/commercialcontracts/articles/1278447/2-tested-alternatives-to-unavoidable-court-delays</a> (last visited June 16, 2020).
1061	June 12, 2020 Email Authorizing Additional Briefing.
1062	Transcript of July 14, 2020 Teleconference
1063	NanoCollect Biomedical, Inc.'s Amended Stipulation of Invalidity Contentions, Case No. 1:19-cv-00301-RGA, D.I. 94 (July 1, 2020).
1064	SERVED, NOT FILED – Ferris, <i>et al.</i> , <i>Rapid enumeration of respiratory viruses</i> , ANAL. CHEM., 74, 1849-56 (2002).



Exhibit No	Description
1065	SERVED, NOT FILED - Mao, <i>et al.</i> , <i>Design and Characterization of Immobilized Enzymes in Microfluidic Systems</i> , ANAL. CHEM., 74, 379-85 (2002).
1066	SERVED, NOT FILED - Kirby, <i>et al.</i> , <i>Voltage-addressable on/off microvalves for high-pressure microchip separations</i> , J. CHROMATOGR. A., 979, 147-54 (2002).
1067	SERVED, NOT FILED – Chovan, <i>et al.</i> , <i>Microfabricated devices in biotechnology and biochemical processing</i> , TRENDS BIOTECHNOL., 20(3), 116-22 (2002).
1068	SERVED, NOT FILED – Baldock, <i>et al.</i> , <i>Novel variable volume injector for performing sample introduction in a miniaturized isotachophoresis device</i> , J. CHROMATOGR. A, 1042, 181-88 (2004).
1069	Confidential Settlement Agreement
1070	Confidential Attachment 1 to Settlement Agreement
1071	Confidential Attachment 2 to Settlement Agreement
1072	Confidential Attachment 3 to Settlement Agreement
1073	Confidential Attachment 4 to Settlement Agreement

## **CERTIFICATE OF SERVICE**

I certify that, on February 10, 2021, the foregoing Joint Motion to Terminate Proceeding pursuant to 35 U.S.C. § 317(A), Joint Notice of Settlement Pursuant to 35 U.S.C. § 317(B) and 37 C.F.R. § 42.74, and Exhibits 1069-1073 were served on the Patent Owner at the following electronic service addresses:

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Respectfully submitted,

Dated: February 10, 2021

/ Michael T. Rosato /  
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