

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MIM SOFTWARE INC.,
Petitioner,

v.

EXINI DIAGNOSTICS AB,
Patent Owner.

IPR2025-00827
Patent 11,941,817 B2

Before BARRY L. GROSSMAN, CHRISTOPHER G. PAULRAJ, and
RYAN H. FLAX, *Administrative Patent Judges*.

GROSSMAN, *Administrative Patent Judge*.

TERMINATION
Due to Settlement After Institution of Trial
35 U.S.C. § 317; 37 C.F.R. § 42.74

ORDER
Granting-in-Part Joint Request to Keep the Settlement Agreement
Business Confidential and Separate
35 U.S.C. § 317(b)

I. INTRODUCTION

MIM Software, Inc. (“Petitioner”) and EXINI Diagnostics AB (“Patent Owner”) have indicated that they have reached an agreement to settle the above-identified *inter partes* review proceeding. The Board authorized Petitioner and Patent Owner (collectively “the Parties”) to file a joint motion to terminate the proceeding on February 25, 2026.

On March 2, 2026, pursuant to 37 C.F.R. § 42.74 and 35 U.S.C. § 317, the Parties filed a Joint Motion to Terminate the above-identified proceeding. Paper 24 (“Joint Motion”). The Parties also filed a confidential Settlement Agreement (Ex. 1043 (“Settlement Agreement”)) together with a Joint Motion to Keep the Settlement Agreement Business Confidential and Separate pursuant to 35 U.S.C. § 317(b). Paper 25 (“Joint Request”).

II. DISCUSSION

In the Joint Motion, the Parties represent that they have reached a settlement and agreement to jointly seek termination of the above-identified proceeding, and that “[a] true copy of the Confidential Settlement Agreement” has been concurrently filed as Exhibit 1043. Joint Motion 3. The Parties further represent that the “true and correct copy [of the Settlement Agreement] . . . filed as Ex1043 . . . is the only agreement made in connection with or in contemplation of the requested termination” and “[t]here are no other collateral agreements in connection with the settlement.” *Id.* at 2–3.

The Parties submit that, in addition to reaching an agreement resolving the dispute in the above-identified proceeding, “[t]he Parties have further settled and will move to dismiss the parallel litigation, *Progenics*

Pharmaceuticals, Inc. et al. v. MIM Software Inc., 1:24-cv-10437-PBS, District of Massachusetts, concerning the patent-at-issue” in the above-identified proceeding. Joint Motion 1–2.

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 the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” Section 35 U.S.C. § 317(a) also provides that if no petitioner remains in the *inter partes* review, the Office may terminate the review.

The above-identified proceeding is at an intermediate stage. We have not yet decided the merits of this proceeding, and a final written decision has not been entered in this proceeding. Terminating this proceeding will save the Board administrative and judicial resources, e.g., in conducting an oral argument and issuing a final written decision to decide the patentability issues raised in the Petition. Furthermore, there are strong public policy reasons to favor settlement between the parties to a proceeding. *Patent Trial and Appeal Board Consolidated Trial Practice Guide*, 84 Fed. Reg. 64,280 (Nov. 21, 2019). Under these circumstances, and in view of the Parties’ settlement and representations, we determine that good cause exists to terminate this proceeding. Accordingly, we *grant* the Joint Motion.

The parties also request that “the Settlement Agreement (Ex1043) . . . be treated as business confidential information” and “be kept separate from the file of the involved patent.” Joint Request, 1. The parties additionally request that “the Settlement Agreement shall be made available only to Federal Government agencies on written request, or to any person on a showing of good cause pursuant to 35 U.S.C. § 317(b) and 37 C.F.R.

§ 42.74(c).” *Id.* We have reviewed the Settlement Agreement, which appears to contain confidential business information regarding the terms of settlement, and we determine that good cause exists to treat the Settlement Agreement as business confidential information and to keep it separate from the file of the patent in the above-identified proceeding pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Accordingly, we *grant* this aspect of the Parties’ Joint Request.

The Parties further request “that the Board inform the Parties if anyone seeks production of the agreement and afford the parties an opportunity to address whether such request is supported by good cause.” Joint Request, 1. However, neither the statute nor the regulation provides for any such notification to the parties or an opportunity to address whether a request is supported by good cause, and the parties have not provided any special circumstance that would justify issuing an order that purports to impose additional requirements. Accordingly, we *deny* this portion of the Parties’ Joint Request. *See Palo Alto Networks, Inc., v. Taasera Licensing LLC*, IPR2023-00704, Paper 16, 4 (PTAB Jan. 8, 2024).

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

III. ORDER

Accordingly, it is

ORDERED that the Joint Motion to Terminate (Paper 24) is *granted*, and that IPR2025-00827 is *terminated*;

FURTHER ORDERED that the Joint Request (Paper 25) is *granted-in-part*, and the Settlement Agreement (Ex. 1043) shall be treated as business confidential information, shall be kept separate from the file of the

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involved U.S. Patent No. 11,941,817, and shall be made available only to Federal Government agencies on written request, or to any person on a showing of good cause on written request, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c); and

FURTHER ORDERED that Exhibit 1043 shall remain designated as “Parties and Board Only” in the Board’s P-TACTS system.

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