

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FOUNDATION MEDICINE, INC.,
Petitioner,

v.

GUARDANT HEALTH, INC.,
Patent Owner.

IPR2019-00652
Patent 9,834,822 B2

Before SUSAN L. C. MITCHELL, TINA E. HULSE, and KRISTIL R.
SAWERT, *Administrative Patent Judges*.

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TERMINATION
Due to Settlement on Remand
35 U.S.C. § 317; 37 C.F.R. § 42.74

I. INTRODUCTION

Petitioner, Foundation Medicine, Inc., challenged claims 1–13 and 17–20 (“the challenged claims”) of U.S. Patent No. 9,834,822 B2 (Ex. 1001, “the ’822 patent”) in *inter partes* review IPR2019-00652. Paper 2. On August 18, 2020, we issued a Final Written Decision that was entered in this proceeding. Paper 47 (“Final Dec.”). In the Final Written Decision, we determined that Petitioner had established by a preponderance of the evidence that the challenged claims of the ’822 patent, with the exception of claim 12, are unpatentable. Final Dec. 67.

Patent Owner, Guardant Health, Inc., appealed to the U.S. Court of Appeals for the Federal Circuit. Paper 49. On appeal, the Federal Circuit vacated and remanded our Final Written Decision. *Guardant Health, Inc. v. Vidal*, No. 2021-1104, 2023 WL 3262962 (Fed. Cir. May 5, 2023); *see* Paper 51 (Federal Circuit Opinion).

On July 25, 2023, the parties filed a Joint Motion to Terminate this remanded proceeding. Paper 53 (“Motion” or “Mot.”). The parties also filed what they indicate is a true copy of a Settlement and License Agreement between the parties (Ex. 2043, “Agreement”) and a Joint Request to treat the Agreement as business confidential information. Paper 52 (“Joint Request” or “Req.”).

II. DISCUSSION

The parties indicate that they have reached “a settlement between Patent Owner and Petitioner.” Mot. 2. Specifically, the Motion states that the parties “have resolved their disputes regarding the ’822 Patent, including in this proceeding, the corresponding appeals to the Court of Appeals for the Federal Circuit (Case Nos. 21-1102, 1104), and in the related district court

litigation, *Guardant Health, Inc. v. Foundation Medicine, Inc.*, Case No. 1:17-cv-01616-LPS-CJB (D. Del.).” *Id.* at 1. The parties “submit a true copy of an” Agreement “between Patent Owner and Petitioner made in connection with, or in contemplation of, the termination of the proceeding under 37 CFR § 42.74(b) with this joint motion.” *Id.* Accordingly, “Patent Owner and Petitioner jointly request that the Board terminate this proceeding in its entirety.” *Id.* at 2.

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board already has decided the merits of the proceeding. PTAB Consolidated Trial Practice Guide, 86 (Nov. 2019).¹ Here, although the Board already has issued a Final Written Decision, the Federal Circuit vacated and remanded that decision for a further proceeding. 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 determine it is appropriate to grant the Motion and terminate the proceeding.

The parties also jointly request that the Agreement be treated as business confidential information and be kept separate from the files of the ’822 patent and this proceeding. Req. 1. We have reviewed the Agreement, which contains confidential business information regarding the settlement terms, and we determine that good cause exists to treat the Agreement as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) and keep it separate from the files of the ’822 patent and this proceeding. Accordingly, we grant this aspect of the parties’ Joint Request.

¹ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

The parties also “jointly request that the Board order that in the event a person or entity makes a written request, as stated in 37 C.F.R. § 42.74(c)(1)–(2), for access to the settlement agreement, that any such written request be served upon the parties on the day the written request is provided to the Board.” Req. 1. However, neither the statute nor the regulation provides for any such notification, and the parties have not provided any reason or special circumstance that would justify issuing an order that purports to impose an additional requirement. Accordingly, we deny that portion of the parties’ Joint Request.

III. ORDER

Accordingly, it is

ORDERED that the Joint Motion to Terminate *Inter Partes* Review (Paper 53) is *granted* in IPR2019-00652;

FURTHER ORDERED that the Joint Request (Paper 52) is *granted-in-part*;

FURTHER ORDERED that the Agreement (Ex. 2043) shall remain designated as “Parties and Board Only” in the Board’s electronic filing system, be treated as business confidential information, be kept separate from the file of U.S. Patent No. 9,834,822 B2, and 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 IPR2019-00652 is terminated.

IPR2019-00652
Patent 9,834,822 B2

PETITIONER:

Rolando Medina
Eric Marandett
Stephanie Schoenwald
Sophie Wang
CHOATE, HALL & STEWART LLP
Rmedina@choate.com
Emarandett@choate.com
Sschonewald@choate.com
Swang@choate.com

PATENT OWNER:

Michael Rosato
Steven Parmelee
Sonja Gerrard
WILSON, SONSINI, GOORDICH & ROSATI
Mrosato@wsgr.com
Sparmelee@wsgr.com
Sgerrard@wsgr.com