

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TURBONOMIC, INC.,
Petitioner,

v.

CIRBA IP INC.,
Patent Owner.

IPR2020-01340
Patent 8,209,687 B2

Before DAVID C. McKONE, TERRENCE W. McMILLIN, and
RUSSELL E. CASS, *Administrative Patent Judges*.

CASS, *Administrative Patent Judge*.

DECISION
Settlement Before Institution of Trial
37 C.F.R. § 42.74

With Board authorization, Turbonomic, Inc. (“Petitioner”) and Cirba IP, Inc. (“Patent Owner”) filed a Joint Motion to Terminate on January 13, 2021. Paper 9 (“Mot.”). Along with the Joint Motion, the parties filed a copy of a document they describe as “a true and complete copy” (*id.* at 1) of their written settlement agreement (Ex. 1032) that resolves all of their disputes concerning the patent at issue in this proceeding. The parties also filed a joint request to treat the settlement agreement as business confidential information under 37 C.F.R. § 42.74(c). Paper 10.

This proceeding is still in its preliminary stages. Petitioner filed a Petition requesting an *inter partes* review of claims 1, 3, 6–7, 12–13, and 18 of U.S. Patent No. 8,209,687 B2 (Ex. 1001, “the ’687 patent”) on July 21, 2020. Paper 2. Patent Owner filed a Preliminary Response on November 9, 2020. No decision on institution has been entered.

In their Joint Motion, the parties represent that the settlement agreement filed as Exhibit 1032 resolves the underlying disputes between the parties involving the ’687 patent, including the present *inter partes* review proceeding and all related district court proceedings. Mot. 1. The parties also state that the settlement agreement represents all agreements made in connection with, or in contemplation of, the termination of this proceeding, and that all such agreements have been filed with the Board as required by 35 U.S.C. § 317(a) and 37 C.F.R. §42.74(b). Mot. 2.

Under the circumstances of this case, we determine that it is appropriate to dismiss the Petition without rendering any further decisions, thereby terminating this proceeding. *See* 37 C.F.R. § 42.71(a). We also have reviewed the settlement agreement, and we determine that the settlement agreement contains business confidential information regarding

the terms of the settlement and that good cause exists to treat the settlement agreement as business confidential information under 37 C.F.R. § 42.74(c).

Accordingly, it is

ORDERED that the parties' joint request (Paper 10) to treat the parties' settlement agreement as business confidential information is *granted*;

FURTHER ORDERED that the settlement agreement (Exhibit 1032) shall be treated as business confidential information, kept separate from the file of the '687 patent, and made available only to Federal Government agencies on written request to the Board, or to any person on a showing of good cause, under the provisions of 37 C.F.R. § 42.74(c);

FURTHER ORDERED that the Joint Motion to Terminate (Paper 9) is *granted*; and

FURTHER ORDERED that the Petition is *dismissed*, resulting in termination of this proceeding.

PETITIONER:

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