

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VMWARE, INC. and
DELL TECHNOLOGIES INC.,
Petitioner,

v.

PROVEN NETWORKS, LLC,
Patent Owner.

IPR2021-00194
Patent 8,165,024 B2

Before TREVOR M. JEFFERSON, PATRICK M. BOUCHER, and
JOHN A. HUDALLA, *Administrative Patent Judges*.

JEFFERSON, *Administrative Patent Judge*.

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

On August 4, 2021, with the Board’s authorization, VMware, Inc. and Dell Technologies Inc. (collectively “Petitioner”) and Proven Networks, LLC (“Patent Owner”) (collectively referred to as “the Parties”) filed a Joint Motion to Terminate the above-identified proceeding due to settlement. Paper 8 (“Joint Motion”). In support of the Joint Motion, the Parties filed copies of: an Agreement between VMware, Inc. and Proven Networks, LLC (Ex. 1022, “VMware Agreement”); an Agreement between Dell Technologies and Proven Networks LLC (Ex. 1023, “Dell Agreement”); and a Schedule 1, Exhibit B to Agreement (Ex. 1024, “Exhibit B”) (collectively referred to as “Agreements”). In further support of the Joint Motion, the Parties also filed a Joint Request to Treat the Agreements as Business Confidential And to Keep Separate. Paper 9 (“Joint Request”).

In the Joint Motion, the Parties represent that they have reached an agreement to jointly seek termination of this *inter partes* review proceeding, and that the filed copies of the Agreements are true and complete copies. Joint Motion 1–2. The Parties further represent the dispute involving U.S. Patent 8,165,024 has been resolved. *Id* at 1.

This proceeding is at an early stage, and we have not yet decided whether to institute a trial in the proceeding. In view of the early stage of the proceeding and the settlement between the Parties, we determine that good cause exists to terminate the proceeding with respect to the Parties.

The Parties also filed a Joint Request that the Agreements be treated as business confidential information and be kept separate from the file of U.S. Patent No. 8,165,024. Joint Request 1. After reviewing the Agreements, we find that the Agreements contain confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Agreements as business confidential information

pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

The Parties further request “[i]n the event that a third party submits a written request to the Board for a copy of either [of the Agreements] along with a purported showing of good cause, due to the highly sensitive nature of the Agreements, the Parties would like to be notified of such request and be given the opportunity to respond thereto.” Joint Request 1. We have no such procedure to serve upon the Parties a request for access to the Agreements, and, further, our regulations do not require us to do so. Therefore, we decline to issue an order regarding requests to access the Agreements.

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

Accordingly, for the reasons discussed above, it is:

ORDERED that the Joint Motion is *granted*, and the proceeding is *terminated*;

FURTHER ORDERED that the Joint Request is *granted*, and the Agreements shall be kept separate from the files of U.S. Patent No. 8,165,024 and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 37 C.F.R. § 42.74(c).

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