

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.

IPR2021-00196
Patent 7,450,507 B2

Before TREVOR M. JEFFERSON, JOHN A. HUDALLA, and
SCOTT E. BAIN, *Administrative Patent Judges*.

JEFFERSON, *Administrative Patent Judge*.

TERMINATION
Due to Settlement After Institution of Trial
35 U.S.C. § 317; 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 14 (“Joint Motion”). In support of the Joint Motion, the Parties filed copies of: an Agreement between VMware, Inc. and Proven Networks, LLC (Ex. 1018, “VMware Agreement”); an Agreement between Dell Technologies and Proven Networks LLC (Ex. 1019, “Dell Agreement”); and a Schedule 1, Exhibit B to Agreement (Ex. 1020, “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 15 (“Joint Request”).

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.

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 2–3. The Parties further represent the dispute involving U.S. Patent 7,450,507 has been resolved. *Id* at 2.

We instituted a trial on the above-identified proceeding on May 21, 2021. Paper 11. We have not yet decided the merits of the proceeding, and a final written decision has not been entered. Even though the proceeding has moved beyond the preliminary stage, the Parties have shown adequately

that the termination of the proceeding is appropriate. Under these circumstances, 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. 7,450,507. Joint Request 2. 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 2. 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 IPR2021-00196 is *terminated* with respect to Petitioner and Patent Owner pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72; and

FURTHER ORDERED that the Joint Request is *granted*, and the

Agreements shall be kept separate from the file of U.S. Patent 7,450,507, and 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).

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Patent 7,450,507 B2

PETITIONER:

Peter DiChiara
Jason Kipnis
Chetan Chandra
Bin Li

WILMER CUTLER PICKERING HALE & DORR LLP

peter.dichiara@wilmerhale.com
jason.kipnis@wilmerhale.com
chetan.chandra@wilmerhale.com
bin.li@wilmerhale.com

PATENT OWNER:

Kent Shum
Neil Rubin
Reza Mirzaie
RUSS AUGUST & KABAT
kshum@raklaw.com
nrubin@raklaw.com
rmirzaie@raklaw.com