Trials@uspto.gov
571.272.7822

Paper No. 9
Entered: August 10, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORP.,
Petitioner,

v.

PROVEN NETWORKS, LLC,
Patent Owner.

IPR2021-00889
Patent 8,812,454 B2

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

BOUCHER, *Administrative Patent Judge*.

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

On July 6, 2021, with the Board's authorization, Microsoft Corp. ("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 7 ("Joint Motion"). In support of the Joint Motion, the Parties filed copies of: a Patent License and License Option Agreement between RPX Corporation and Proven Networks, LLC (Ex. 2001, "Patent License and License Option Agreement"); and a Release Agreement between Microsoft Corp. and Proven Networks LLC (Ex. 2002, "Release Agreement") (collectively referred to as "Agreements"). In further support of the Joint Motion, the Parties also filed a Joint Request to Keep Separate. Paper 8 ("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 8,812,454 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. 8,812,454. 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).

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. 8,812,454 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).

PETITIONER:

James M. Heintz
DLA PIPER LLP (US)
jim.heintz@dlapiper.com

PATENT OWNER:

Reza Mirzaie
C. Jay Chung
RUSS AUGUST & KABAT
rmirzaie@raklaw.com
jchung@raklaw.com