

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CISCO SYSTEMS, INC.,
Petitioner,

v.

SECURITYPROFILING, LLC,
Patent Owner.

IPR2022-00035, Patent 10,893,066 B1
IPR2022-00259, Patent 10,609,063 B1

Before DEBRA K. STEPHENS, TREVOR M. JEFFERSON, and
SHARON FENICK, *Administrative Patent Judges*.

STEPHENS, *Administrative Patent Judge*.

TERMINATION¹
Due to Settlement After Institution of Trial
U.S.C. § 317; 37 C.F.R. § 42.74

¹ This Termination applies to the above-listed proceedings. The Parties are not permitted to use this format.

I. INTRODUCTION

Pursuant to our authorization by e-mail on July 18, 2022, the Parties filed, in each of the instant proceedings, a Joint Motion of Petitioner and Patent Owner to Terminate *Inter Partes* Review Proceeding Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74 on the basis of a settlement reached by Petitioner and Patent Owner (IPR2022-00035, Paper 10; IPR2022-00259, Paper 9) (“Motion”). With each of the Motions, the Parties filed a copy of a Settlement and License Agreement (IPR2022-00035, Exhibit 2007; IPR2022-00259, Exhibit 2007 (“Settlement Agreement”)) as “Filing Parties and Board Only” in the Board’s electronic filing system and filed a Joint Request to Treat the Settlement Agreement as Business Confidential Information Under 35 U.S.C. § 317(b) and 37 C.F.R. 42.74(c) that the agreement be treated as business confidential information (IPR2022-00035, Paper 11; IPR2022-00259, Paper 10).

II. DISCUSSION

In the Motions, the Parties represent that they have reached settlement of all disputes between the parties relating to the ’066 patent . . . and entered into a mutual release” of the above-identified *inter partes* review proceedings under 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74 (IPR2022-00035, Paper 11, 1; IPR2022-00259, Paper 9, 1). The Parties additionally represent “[t]he settlement agreement also requires the dismissal of the only litigation matter [(District Court case 6:21-cv-01106)] related to invalidity of the two challenged patents between the Parties” and “have agreed to settle and dismiss all other litigation between them and that there are no related proceedings in the U.S. Patent and Trademark Office” (IPR2022-00035,

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Paper 11, 2–3; IPR2022-00259, Paper 9, 2–3). The Parties have further represented “[t]he settlement agreement is in writing and constitutes the Parties’ entire understanding and agreement” (IPR2022-00035, Paper 11, 4; IPR2022-00259, Paper 9, 4).

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.” The Board has not decided the merits of these proceedings, oral argument has not yet occurred, and these proceedings involve no other parties.

Accordingly, under the circumstances present here, we deem it appropriate to terminate the instant proceedings without issuing a final written decision (*see* 35 U.S.C. § 317(a); 37 C.F.R. §§ 42.72(a, b), 42.74).

Further, we find that the Settlement Agreement contains confidential business information regarding the terms of settlement. Thus, we deem it appropriate to treat the Settlement Agreement between the parties as business confidential information and to keep them separate from the files of the patents in the above-captioned proceedings pursuant to 37 C.F.R. § 42.74(c).

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

III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Joint Motions to Terminate are *granted*, and the proceedings are terminated, are *granted*;

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FURTHER ORDERED that the Parties' requests that the Settlement Agreement (IPR2022-00035, Exhibit 2007; IPR2022-00259, Exhibit 2007)) between Petitioner and Patent Owner be treated as business confidential information and be kept separate from the files of U.S. Patents 10,893,066 B1 and 10,609,063 B1 under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c); and

FURTHER ORDERED that this paper does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

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