

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MICROSOFT CORPORATION,  
Petitioner,

v.

PARUS HOLDINGS, INC.,  
Patent Owner.

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IPR2022-00804  
Patent 8,185,402 B2

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Before THU A. DANG, PATRICK M. BOUCHER, and  
JAMES J. MAYBERRY, *Administrative Patent Judges*.

DANG, *Administrative Patent Judge*.

TERMINATION

Due to Settlement After Institution of Trial and  
*Granting* Joint Request to File Confidentially  
*35 U.S.C. § 317; 37 C.F.R. §§ 42.72, 42.74*

## I. INTRODUCTION

On February 22, 2023, with the Board's authorization (*see* Paper 13, 4), Petitioner and Patent Owner (collectively, "the Parties") filed (1) a "Renewed Joint Motion to Terminate *Inter Partes* Review" (Paper 14, "Joint Motion") and (2) a "Renewed Joint Request to File Confidentially" (Paper 15, "Joint Request"). The Parties also filed a copy a "Settlement and Release Agreement." Ex. 1030 ("Settlement Agreement").

## II. DISCUSSION

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."

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 resolved their dispute involving the '402 patent. Paper 14, 1. The Parties represent that the Settlement Agreement is a true copy, and "[t]here are no other collateral agreements or understandings made in connection with, or in contemplation of, the termination of the proceedings between the [P]arties." *Id.* The Settlement Agreement states that it "constitutes the entire agreement between the Parties concerning the subject matter hereof and supersedes all written and oral prior agreements and understandings with respect thereto." Ex. 1030, 6.

We instituted trial for the above-identified *inter partes* review proceeding on November 4, 2022. *See* Paper 7. We have not yet decided the merits of the proceeding, and a final written decision has not been

entered. Notwithstanding that the proceeding has moved beyond the preliminary stage, the Parties have shown adequately that termination of the proceeding is appropriate. Under these circumstances, we determine that good cause exists to terminate the proceeding with respect to the Parties.

In the Joint Request, the Parties request that the Settlement Agreement be treated as business confidential information and kept separate from the file of the '402 patent. Paper 15, 1. We have reviewed the Settlement Agreement and find that it contains confidential business information regarding the terms of settlement. Thus, good cause exists to treat the Settlement Agreement as business confidential information 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

Accordingly, it is:

ORDERED that the Joint Motion to Terminate (Paper 14) is *granted*, and IPR2022-00804 is *terminated* with respect to Petitioner and Patent Owner; and

FURTHER ORDERED that the Joint Request (Paper 15) to treat the Settlement Agreement (Ex. 1030) as business confidential information is *granted*, and the Settlement Agreement shall be kept separate from the file of U.S. Patent No. 8,185,402 B2, 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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