

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PALO ALTO NETWORKS, INC.,

Petitioner,

v.

TAASERA LICENSING LLC,

Patent Owner.

Patent No. 8,955,038

Filing Date: August 16, 2012

Issue Date: February 10, 2015

Inventors: Blair Nicodemus and Billy Edison Stephens

Title: METHODS AND SYSTEMS FOR CONTROLLING ACCESS
TO COMPUTING RESOURCES BASED ON KNOWN
SECURITY VULNERABILITIES

JOINT MOTION TO TERMINATE PROCEEDING

Case No. IPR2023-00573

LIST OF EXHIBITS

Exhibit No.	Description
2001	Fifth Amended Docket Control Order, Dkt. 225, <i>In re: Taasera Licensing LLC, Patent Litigation</i> , No. 2:22-md-03042-JRG (E.D. Tex. May 19, 2023)
2002	Defendants' Joint Patent L.R. 3-3 Invalidity Contentions and Subject Matter Ineligibility Contentions, <i>In re: Taasera Licensing LLC, Patent Litigation</i> , No. 2:22-md-03042-JRG, served April 29, 2023
2003	Invalidity Contentions for U.S. Patent No. 8,955,038 Based on U.S. Patent No. 8,065,712 to Cheng et al. ("Cheng"), <i>In re: Taasera Licensing LLC, Patent Litigation</i> , No. 2:22-md-03042-JRG, served April 29, 2023
2004	Declaration of Eric Cole, Ph.D. ("Cole Decl."), dated November 9, 2023 and Exhibit A, Curriculum Vitae of Eric Cole, Ph.D.
2005	Deposition of John Black, taken in <i>Palo Alto Networks, Inc. v. Taasera Licensing, LLC</i> , IPR2023-00573 on October 3, 2023. ("Black Depo.")
2006	Confidential Settlement Agreement
2007	Confidential Release

Pursuant to 35 U.S.C. § 317(a), 37 C.F.R. § 42.74, and the Board’s email of December 19, 2023, Petitioner Palo Alto Networks, Inc. (“PAN” or “Petitioner”) and Patent Owner Taasera Licensing LLC (“Taasera” or “Patent Owner”) (collectively, the “Parties”) have reached a resolution and jointly move to terminate the above-captioned proceeding.

I. STATEMENT OF FACTS

The Parties have reached an agreement to resolve their disputes in the above-captioned *inter partes* review relating to U.S. Patent No. 8,955,038.

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), Petitioner and Patent Owner submit a true copy of the confidential settlement agreement in its entirety, filed herewith as Exhibit 2006. Petitioner and Patent Owner further submit a true copy of a confidential release signed by the Parties, filed herewith as Exhibit 2007. A “Joint Request to File Settlement Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74” is being filed concurrently with this Joint Motion to Terminate, to treat Exhibits 2006 and 2007 as business confidential information and to keep them separate from the files of the involved patent pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). There are no other collateral agreements between the Parties made in connection with, or in contemplation of, the termination sought.

II. RELIEF REQUESTED

Termination of this *inter partes* review is requested, and the Parties respectfully submit that such termination is justified. “There are strong public policy reasons to favor settlement between the parties to a proceeding.” Consolidated Trial Practice Guide 86 (Nov. 2019). “The Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding.” *Id.* (citing 35 U.S.C. §§ 317(a)).

The Board should terminate this proceeding, as the Parties jointly request, for the following reasons.

First, PAN and Taasera have met the statutory requirement that they file a “joint request” to terminate before the Office “has decided the merits of the proceeding.” 35 U.S.C. § 317(a). Under section 317(a), an *inter partes* review shall be terminated upon such joint request “unless the Office has decided the merits of the proceeding before the request for termination is filed.” There are no other preconditions recited in 35 U.S.C. § 317(a).

Second, PAN and Taasera have reached a resolution as to all the disputes in this proceeding and as to the '038 Patent. Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), the agreement made in connection with, or in contemplation of, the termination of the proceeding is in writing, and a true and correct copy is being

filed concurrently herewith as Exhibit 2006.¹ A true and correct copy of a confidential release is being filed concurrently herewith as Exhibit 2007.² The Parties are also filing concurrently herewith a joint request under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) to treat these agreements as business confidential information and keep them separate from the files of the '038 Patent. The Parties certify that there are no other agreements, oral or written, between the Parties made in connection with, or in contemplation of, the termination of this proceeding.

Third, termination would save significant further expenditure of resources by the Parties. Termination upon settlement, as requested, would also further the purpose of *inter partes* review proceedings, which seek to provide an efficient and less costly alternative forum for patent disputes. Further, maintaining the proceeding would discourage further resolutions, as patent owners in similar situations would have a strong disincentive to resolve the dispute if they perceived that an *inter partes* review would continue regardless of a resolution.

¹ The agreement is being filed via the Patent Trial and Appeal Board Case Tracking System (PTACTS) system with access to the “Board only.”

² The agreement is being filed via the Patent Trial and Appeal Board Case Tracking System (PTACTS) system with access to “Parties and Board.”

III. CONCLUSION

For the foregoing reasons, PAN and Taasera respectfully request termination of this *inter partes* review.

Dated: December 20, 2023

Respectfully submitted,

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CERTIFICATE OF SERVICE

A copy of the JOINT MOTION TO TERMINATE PROCEEDINGS and
Exhibit 2007 has been served on Petitioner's counsel of record as follows:

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December 20, 2023

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