Trials@uspto.gov
571-272-7822

Paper 21
Entered: January 9, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PALO ALTO NETWORKS, INC.,
Petitioner,

v.

TAASERA LICENSING LLC,
Patent Owner.

IPR2023-00573 (Patent 8,955,038 B2)
IPR2023-00574 (Patent 9,923,918 B2)

Before WILLIAM V. SAINDON, ARTHUR M. PESLAK, and KRISTI L. R. SAWERT, *Administrative Patent Judges*.

SAINDON, *Administrative Patent Judge*.

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

Petitioner (Palo Alto Networks, Inc.) and Patent Owner (Taasera Licensing LLC) have indicated that they have reached an agreement to settle each of the above-identified *inter partes* review proceedings. The Board authorized Petitioner and Patent Owner (collectively referred to as "the parties") to file joint motions to terminate the proceedings on December 19, 2023.

On December 20, 2023, pursuant to 37 C.F.R. § 42.74 and 35 U.S.C. § 317(a), the parties filed joint motions to terminate each of the above-identified proceedings (collectively "Joint Motions") (Paper 20[1]) and joint requests (collectively "Joint Requests") (Paper 21[2]) to treat a confidential Settlement Agreement and a confidential Release (collectively, "Agreements") as business confidential information and to keep the Agreements separate from the files of the involved patents, along with copies of the confidential Agreements (Ex. 2006 and Ex. 2007[3]). The parties describe the filed copies of the confidential Agreements as comprising "a true and correct copy [of the Settlement Agreement]" and "[a] true and correct copy of [the] confidential release." Paper 20, 2–3. The parties represent that their Agreements "resolve the[] [parties'] disputes in the above-captioned *inter partes* review [IPR2023-00573] relating to U.S. Patent No. 8,955,038" and the parties' "disputes in the above-captioned *inter*

[1] For purposes of expediency, we cite to Papers filed in IPR2023-00573. The parties submitted a similar Joint Motion in IPR2023-00574 (Paper 19).
[2] The parties submitted a similar Joint Request regarding the Agreements in IPR2023-00574 (Paper 20).
[3] We cite to Exhibits filed in IPR2023-00573. The parties also submitted copies of the confidential Agreements in IPR2023-00574 (Ex. 2006 and Ex. 2007).

partes review [IPR2023-00574] relating to U.S. Patent No. 9,923,918," and the Agreements evidence the parties' "agree[ment] to terminate this proceeding [(i.e., each of IPR2023-00573 and IPR2023-00574)] and the Parties' related district court proceeding." *See* Joint Motions at 1, Joint Requests at 1. The parties further represent that "[t]here are no other collateral agreements between the Parties made in connection with, or in contemplation of, the termination sought," and "certify that there are no other agreements, oral or written, between the Parties made in connection with, or in contemplation of, the termination [sought]." Paper 20, 1–3.

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. The above-identified proceedings are at an intermediate stage. We have not yet decided the merits of these proceedings, and final written decisions have not been entered in these proceedings. Furthermore, there are strong public policy reasons to favor settlement between the parties to a proceeding. *Patent Trial and Appeal Board Consolidated Trial Practice Guide*, 84 Fed. Reg. 64,280 (Nov. 21, 2019). Under these circumstances, and in view of the parties' settlement and representations, we determine that good cause exists to terminate these proceedings. Accordingly, we *grant* the Joint Motions.

The parties also request "the Board treat as business confidential information, the true copy of the executed agreement resolving the Parties' disputes . . . (Exhibit 2006), and the related release agreement between the

Parties (Exhibit 2007)." Paper 21, 1. The parties further request that Exhibits 2006 and 2007 be kept "separate from the files of the involved patent[s] pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c)." Paper 20, 1, 3; *see also* Paper 21, 1. The parties additionally request that the Agreements "shall be 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). Paper 21, 1–2. We have reviewed the Agreements, which contain confidential business information regarding the terms of settlement, and we determine that good cause exists to treat the Agreements as business confidential information and to keep them separate from the files of the respective patents involved in the above-identified proceedings pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Accordingly, we *grant* this aspect of the parties' Joint Requests.

The parties further request "that the Board inform [the Parties] if anyone seeks production of Exhibits 2006 or 2007 and afford the Parties an opportunity to address whether such request is supported by good cause." Paper 21, 2. However, neither the statute nor the regulation provides for any such notification to the parties or opportunity to address whether a request is supported by good cause, and the parties have not provided any special circumstance that would justify issuing an order that purports to impose additional requirements. Accordingly, we *deny* this portion of the parties' Joint Requests.

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

Accordingly, it is:

ORDERED that the Joint Motions (IPR2023-00573, Paper 20;

IPR2023-00574, Paper 19) to terminate the above-identified proceedings are *granted*, and that IPR2023-00573 and IPR2023-00574 are *terminated*;

FURTHER ORDERED that the Joint Requests (IPR2023-00573, Paper 21; IPR2023-00574, Paper 20) are *granted-in-part*, and the Agreements (IPR2023-00573, Ex. 2006 and Ex. 2007; IPR2023-00574, Ex. 2006 and Ex. 2007) shall be treated as business confidential information, shall be kept separate from the files of the involved patents (U.S. Patent 8,955,038 and U.S. Patent 9,923,918), and shall be made available only to Federal Government agencies on written request, or to any person on a showing of good cause on written request, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c); and

FURTHER ORDERED that Exhibit 2006 in IPR2023-00573 and Exhibit 2006 in IPR2023-00574 shall remain designated as "Board Only" in the Board's P-TACTS system, and Exhibit 2007 in IPR2023-00573 and Exhibit 2007 in IPR2023-00574 shall remain designated as "Parties and Board Only" in the Board's P-TACTS system.

IPR2023-00573 (Patent 8,955,038 B2)
IPR2023-00574 (Patent 9,923,918 B2)

PETITIONER:

Juan C. Yaquian
James C. Lin
Michael Rueckheim
WINSTON & STRAWN LLP
jyaquian@winston.com
jalin@winston.com
mrueckheim@winston.com

PATENT OWNER:

Peter Lambrianakos
Vincent Rubino
Joseph Mercadante
FABRICANT LLP
plambrianakos@fabricantllp.com
vrubino@fabricantllp.com
jmercadante@fabricantllp.com