

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FORCEPOINT LLC,
Petitioner,

v.

SECURITYPROFILING, LLC,
Patent Owner.

IPR2023-00989 (Patent 10,609,063 B1)
IPR2023-00990 (Patent 10,893,066 B1)¹

Before GREGG I. ANDERSON, NATHAN A. ENGELS, and
SHARON FENICK *Administrative Patent Judges*.

FENICK, *Administrative Patent Judge*.

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

¹ This Decision addresses issues that are the same in each of these proceedings. We issue one Decision to be entered in each proceeding. The parties are not permitted to use this style of caption.

I. INTRODUCTION

With the Board’s authorization, Petitioner and Patent Owner (collectively “the Parties”) filed Joint Motions to Terminate *Inter Partes* Review Proceeding Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.72 the above captioned proceedings. Paper 6 (“Joint Motions”).² In support of the Joint Motions, the Parties filed copies of a Settlement and License Agreement (Ex. 1021 (“Settlement Agreement”)), as well as Joint Motions to File Settlement Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317 (Paper 7 (“Joint Requests”)).

II. DISCUSSION

In the Joint Motions, the Parties represent that they have reached an agreement to jointly seek termination of the above captioned *inter partes* review proceedings, and that the filed copies of the Settlement Agreement are true and complete copies.³ Paper 6, 4–5. The Parties further represent that their Settlement Agreement settles all disputes between the Parties involving the above captioned patents at issue. *Id.* at 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

² IPR2023-00989 and IPR2023-00990 include similar papers and exhibits. Unless otherwise noted, all citations are to papers and exhibits in IPR2023-00989 as representative. This Decision applies equally to each captioned proceeding.

³ We understand the Parties’ statement in the Joint Motions that the Settlement Agreement “constitutes the Parties’ entire understanding and agreement” (Paper 6, 5) to mean that the Settlement Agreement is complete and includes no collateral agreements. *See* 35 U.S.C. § 317(b).

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the merits of the proceeding before the request for termination is filed.” *See* 35 U.S.C. § 317(a). These proceedings are at an early stage, and we have not yet decided whether to institute a trial in the proceedings. In view of the early stage of the proceedings and the settlement between the Parties, we agree with the Parties and determine that good cause exists to terminate the proceedings with respect to the Parties. *See* Paper 6, 5.

The Parties also filed Joint Requests that the Settlement Agreement be treated as business confidential information and be kept separate from the file of the patents involved in these *inter partes* proceedings. Paper 7. After reviewing the Settlement Agreement between Petitioner and Patent Owner, we find that the Settlement Agreement contains confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Settlement Agreement between Petitioner and Patent Owner 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).

Accordingly, for the reasons discussed above, it is:

III. ORDER

ORDERED that the Joint Motions to Terminate *Inter Partes* Review Proceeding Pursuant to 35 U.S.C. § 317 and 37 C.F.R. §42.72 are *granted*, the petitions in IPR2023-00989 and IPR2023-00990 are dismissed, and IPR2023-00989 and IPR2023-00990 are *terminated*;

FURTHER ORDERED that the Joint Motions to File Settlement Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317 are *granted*, and the Settlement Agreement shall be kept

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separate from the files of Patent Nos. 10,609,063 B1 and 10,893,066 B1 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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