

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FORCEPOINT LLC,
Petitioner,

v.

SECURITYPROFILING, LLC,
Patent Owner

Case No. IPR2023-00990
U.S. Patent No.
10,893,066

**JOINT MOTION TO TERMINATE
INTER PARTES REVIEW PROCEEDING PURSUANT TO
35 U.S.C. § 317 AND 37 C.F.R § 42.72**

EXHIBIT LIST

EX-1001	U.S. 10,893,066
EX-1002	Prosecution History of U.S. 10,893,066
EX-1003	Declaration of A.L. Narasimha Reddy, Ph.D. under 37 C.F.R. § 1.68
EX-1004	<i>Curriculum Vitae</i> of A.L. Narasimha Reddy, Ph.D.
EX-1005	U.S. 7,359,962 to Willebeek-LeMair et al.
EX-1006	U.S. Pub. 2003/0004689 to Gupta et al.
EX-1007	U.S. 7,237,264 to Graham et al.
EX-1008	Intentionally Left Blank
EX-1009	Intentionally Left Blank
EX-1010	Intentionally Left Blank
EX-1011	IPR2017-02191, Granting Request for Adverse Judgment, Paper 18, September 26, 2018
EX-1012	IPR2017-02192, Final Written Decision, Paper 31, April 8, 2019
EX-1013	Intentionally Left Blank
EX-1014	IPR2022-00035, Institution Decision, Paper 7, (April 19, 2022)
EX-1015	Intentionally Left Blank.
EX-1016	U.S. Pat. No. 6,088,804 (Hill)
EX-1017	Intentionally Left Blank.
EX-1018	Intentionally Left Blank

EX-1019	Intentionally Left Blank
EX- 1020	Intentionally Left Blank
EX-1021	<i>Applying Mobile Agents to Intrusions Detection and Response</i> Jansen, et al, NIST Interim Report (IR) (October 1999) (“Jansen”)
EX-1022	Settlement and License Agreement - Confidential

STATEMENT OF PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.72, and the Board's authorization provided on October 16, 2023, Petitioner Forcepoint LLC ("Forcepoint" or "Petitioner") and Patent Owner SecurityProfiling, LLC ("SecurityProfiling" or "Patent Owner") (collectively, the "Parties") hereby provide notice that they have reached a settlement agreement and jointly request termination of IPR2023-00990 challenging U.S. Patent No. 10,893,066 ("the '066 Patent").

I. Termination Is Appropriate

The basis for this Joint Motion is the settlement of all disputes between the parties relating to the '066 Patent. Pursuant to that settlement, the Parties have also entered into a mutual release. An *inter partes* review 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 proceedings before the request for termination is filed. 37 U.S.C. § 317(a). Further, "no estoppel under section 315(e) shall attach to the petitioner, or to the real party in interest or privy of the petitioner." *See id.*

In January 2023, Patent Owner filed suit in district court against Petitioner asserting patent infringement based on the functionality of certain endpoint security products. *SecurityProfiling, LLC v. Forcepoint, LLC*, Civ. No. 6:23-cv-14-ADA-

DTG (W.D. Tex. Jan. 10, 2023). The asserted patents in that action included U.S. Patent No. 10,893,066 (“the ’066 Patent”); U.S. Patent No. 10,873,595 (“the ’595 Patent”); U.S. Patent No. 10,609,063 (“the ’063 Patent”); U.S. Patent No. 10,154,055 (“the ’055 Patent”); U.S. Patent No. 10,547,631 (“the ’631 Patent”); U.S. Patent No. 10,075,466 (“the ’466 Patent”); U.S. Patent No. 9,118,711 (“the ’711 Patent”); and U.S. Patent No. 9,100,431 (“the ’431 Patent”).

On June 8, 2023, Petitioner filed IPR2023-00990 challenging the ’066 Patent. A Patent Owner Preliminary Response is due November 28, 2023. No other motions or actions are outstanding. The proceeding is thus in the preliminary stage, the record lacks full briefing on the trial issues, and the Board has accordingly not decided the merits of the proceedings.

The settlement agreement requires the dismissal of IPR2023-00990.

II. Agreement in Writing Submitted to the Board

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), a true copy of the Parties’ settlement agreement is being submitted as Exhibit 1022. The settlement agreement is in writing and constitutes the Parties’ entire understanding and agreement. Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), in a separate paper filed concurrently herewith, the Parties jointly request that the settlement agreement be treated as business confidential information and be kept separate from the underlying patent file.

III. Conclusion

For at least the foregoing reasons, the Parties respectfully request that the Board terminate Inter Partes Reviews IPR2023-00990.

Respectfully submitted,

Dated: October 18, 2023

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*ATTORNEY FOR PATENT
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CERTIFICATE OF SERVICE

I hereby certify that on October 18, 2023, a copy of Petitioner's Joint Motion to Terminate Proceedings was served by filing this document through the PTAC's System as well as delivering a copy via electronic mail upon the following:

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