

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AO KASPERSKY LAB,
Petitioner,

v.

OPEN TEXT INC.,
Patent Owner.

Case IPR2024-00292
Patent 8,201,243 B2

Before BARBARA A. PARVIS, GREGG I. ANDERSON, and
GARTH D. BAER, *Administrative Patent Judges*.

BAER, *Administrative Patent Judge*.

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

I. INTRODUCTION

With the Board’s authorization, Petitioner and Patent Owner (collectively “the Parties”) filed a Joint Motion to Terminate Proceeding in the above-identified proceeding. Paper 7 (“Joint Motion”). In support of the Joint Motion, the Parties filed copies of a confidential settlement agreement (Ex. 1020) and confidential license agreement (Ex. 1021), as well as a Joint Request to Treat Agreement as Business Confidential Information (Paper 8, “Joint Request”) pursuant to 37 C.F.R. § 42.74.

II. DISCUSSION

In the Joint Motion, the Parties represent that they have reached an agreement (“Agreement”) to resolve their disputes and jointly move to terminate the above-identified *inter partes* review proceeding. The Parties represent that a true and correct copy of the Agreement is being filed as Exhibits 1020 and 1021, and no other agreements, written or oral, exist between or among the Parties. Joint Motion 1–2; Joint Request 1. The Parties further represent that their Agreement resolves all disputes in the above-identified proceeding and as to the ’243 patent. Joint Motion 2. “The Parties confirm that the Agreement resolves all disputes between the Parties concerning the Challenged [’243] Patent. Accordingly, no litigation or proceedings involving the Challenged [’243] Patent and the Parties is contemplated in the foreseeable future.” *Id.* at 4.

This proceeding is at an early stage, and we have not yet decided whether to institute a trial in the proceeding. In view of the early stage of the proceeding and the settlement between the Parties, we determine that good cause exists to terminate this proceeding with respect to the Parties.

The Parties also filed a Joint Request that Exhibits 1020 and 1021 be treated as business confidential information and be maintained separate from the publicly

available file of the patent involved in this *inter partes* proceeding. Joint Request 2. After reviewing Exhibits 1020 and 1021, we find Exhibits 1020 and 1021 contain confidential business information regarding the terms of settlement. We determine good cause exists to treat Exhibits 1020 and 1021 as business confidential information pursuant to 37 C.F.R. § 42.74(c).

The Parties also request the Board inform the Parties if anyone seeks production of Exhibits 1020 and 1021 and afford the Parties an opportunity to address whether such request is supported by good cause. Joint Request 2. We deny this portion of the Joint Request because neither statute nor rule includes such a provision.

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

III. ORDER

Accordingly, for the reasons discussed above, it is:

ORDERED that the Joint Motion to terminate is *granted*, and this proceeding is *terminated*;

FURTHER ORDERED that the Joint Request to treat Exhibits 1020 and 1021 as business confidential information is *granted*, and Exhibits 1020 and 1021 shall be kept separate from the files of Patent No. 8,201,243 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); and

FURTHER ORDERED that the Parties' request to be informed and provided an opportunity to respond in the event anyone seeks production of Exhibits 1020 and 1021 is *denied*.

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