Trials@uspto.gov
Tel: 571-272-7822

Paper 9
Date: March 3, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NORMSHIELD INC. d/b/a BLACK KITE INC.,
Petitioner,

v.

BITSIGHT TECHNOLOGIES, INC.
Patent Owner.

IPR2024-01392 (Patent No. 10,805,331 B2)
IPR2024-01393 (Patent No. 9,973,524 B2)
IPR2024-01394 (Patent No. 9,438,615 B2)
IPR2024-01395 (Patent No. 11,652,834 B2)[1]

Before CHRISTOPHER L. OGDEN, IFTIKHAR AHMED, and MARY C. HOFFMAN, *Administrative Patent Judges*.

PER CURIAM.

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

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[1] This Order addresses issues that are the same in all four cases. We therefore exercise our discretion to issue one Order to be filed in each case. The parties may not use this style heading for any subsequent papers without authorization.

I. INTRODUCTION

With the Board's authorization, Petitioner and Patent Owner (collectively "the Parties") filed a Joint Motion to Terminate *inter partes* review in each of the above-identified proceedings. Paper 8 ("Joint Motion").[2] In support of the Joint Motion, the Parties filed a copy of a confidential Settlement Agreement (Ex. 1050, "Settlement Agreement"), as well as a Joint Request to Maintain Confidentiality Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74 (Paper 7, "Joint Request").

II. DISCUSSION

In the Joint Motion, the Parties request that the Board terminate these proceedings. Joint Motion 4. The Parties represent that the Parties "have agreed to settle their disputes and have reached a written agreement" to terminate these IPR proceedings. *Id.* at 3. The Parties further represent that the filed Settlement Agreement is a true and correct copy and there are no collateral agreements or understandings in connection with, or in contemplation of, the termination of these proceedings. *Id.*

The Parties also filed a Joint Request that the Settlement Agreement be treated as business confidential information and be kept separate from the file of the patent involved in each of the *inter partes* proceeding. Joint Request 2. The Parties represent that, "[p]ursuant to the Settlement

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[2] Unless otherwise indicated, references to exhibits and papers numbers herein refer to IPR2024-01392. The Parties filed similar papers and exhibits in each of the above-identified proceedings. Further, we expunged an incorrect version of the Joint Motion (Paper 6) filed in IPR2024-01392 at Petitioner's request.

Agreement, Petitioner and Patent Owner must keep its terms confidential." *Id.*

These proceedings are in the preliminary phase and we have not yet entered a decision on institution. In view of the early stage of the proceedings and the settlement between the Parties, we determine that good cause exists to terminate these proceedings.

Additionally, we find that the Settlement Agreement contains confidential business information regarding the terms of settlement and grant the Joint Request pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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

III. ORDER

Accordingly, it is:

ORDERED that the Joint Motion to Terminate is *granted* in each of the identified proceedings;

FURTHER ORDERED that the Joint Request to Maintain Confidentiality Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74 is *granted* in each of the identified proceedings;

FURTHER ORDERED that Settlement Agreement (Exhibit 1050) be treated as business confidential information, kept separate from the file of the challenged patent, and 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); and

FURTHER ORDERED that IPR2024-01392, IPR2024-01393 IPR2024-01394, and IPR2024-01395 are *terminated*.

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IPR2024-01394 (Patent No. 9,438,615 B2)
IPR2024-01395 (Patent No. 11,652,834 B2)

FOR PETITIONER:

James Glass
David Elihu
Quincy Lu
Brett Watkins
QUINN EMANUEL URQUHART & SULLIVAN, LLP
jimglass@quinnemanuel.com
davidelihu@quinnemanuel.com
quincylu@quinnemanuel.com
brettwatkins@quinnemanuel.com

FOR PATENT OWNER:

Douglas Kline
Naomi Birbach
GOODWIN PROCTER LLP
dkline@goodwinprocter.com
nbirbach@goodwinlaw.com