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

_____

Case IPR2024-01394
U.S. Patent No. 9,438,615

_____

PETITIONER AND PATENT OWNER'S
JOINT MOTION TO TERMINATE

Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74, and the Board's authorization received on February 19, 2025, Petitioner NormShield, Inc. d/b/a Black Kite Inc. ("Petitioner") and Patent Owner BitSight Technologies, Inc. ("Patent Owner") jointly move to terminate IPR2024-01394.

I. LEGAL STANDARD

35 U.S.C. § 317(a) provides that "[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 patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed." 37 C.F.R. § 42.72 also provides that "[t]he Board may terminate a trial without rendering a final written decision, where appropriate, including … pursuant to a joint request under 35 U.S.C. 317(a)." Finally, the Consolidated Trial Practice Guide states that "[a] petitioner and a patent owner may terminate the proceeding with respect to the petitioner by filing a written agreement with the Board, unless the Board has already decided the merits of the proceeding before the request for termination is filed." Patent Trial and Appeal Board Consolidated Trial Practice Guide, Nov. 19 at 4.

II. FACTUAL BACKGROUND

Patent Owner commenced litigation against Petitioner asserting U.S. Patent No. 9,438,615 (the "'615 patent") in *BitSight Technologies, Inc. v. NormShield Inc.*, 1:23-cv-12055 (D. Mass.). On September 6, 2024, Petitioner filed a Petition

requesting *inter partes* review of the ’615 patent. *See* Paper 1. The Board has not yet issued an Institution Decision.

Patent Owner and Petitioner have agreed to settle their disputes and have reached a written agreement (the “Settlement Agreement”) to terminate this IPR proceeding, subject to the Board’s approval. Petitioner is filing, confidentially, a true and correct copy of the Settlement Agreement contemporaneously herewith as Exhibit 1050. There are no collateral agreements or understandings in connection with, or in contemplation of, the termination of this proceeding. Petitioner is also filing a joint request that the Settlement Agreement be treated as business confidential information and be kept separate from the file of the ’615 patent, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). It is understood that the Settlement Agreement as filed shall be available only pursuant to a Government agency on written request to the Board or as otherwise specified in 37 C.F.R. § 42.74(c). Petitioner and Patent Owner represent that they have complied with all requirements of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b).

III. ARGUMENT

Dismissal of the Petition is appropriate here because Petitioner and Patent Owner jointly request dismissal, and the proceeding is at an early stage. The Board has not yet issued any institution decision. Terminating the IPR “at this early juncture, promotes efficiency and minimizes unnecessary costs.” *Sony Corp. v.*

Straight Path IP Group Inc., IPR2014-00230, Paper 13, at 3 (PTAB May 2, 2013). Efficiency and the interest of justice are best served because dismissal will reduce the parties' expenses and conserve the Board's resources, which promotes judicial economy and furthers the policy of the Board. *See, e.g.,* Patent Trial and Appeal Board Consolidated Trial Practice Guide, Nov. 19 at 86.

IV. CONCLUSION

For the reasons discussed above, Petitioner and Patent Owner respectfully request that the Board grant this joint motion to terminate this proceeding.

Date: February 19, 2025

/s/ James M. Glass

James M. Glass
Registration No. 46,729
Quinn Emanuel Urquhart & Sullivan LLP
51 Madison Ave, 22nd Floor
New York, New York 10010
Tel: (212) 849-7142
Fax (212) 849-7100
Counsel for Petitioners

/s/ Douglas J. Kline

Douglas J. Kline
Registration No. 54-528
Goodwin Procter LLP
100 Northern Avenue.
Boston, MA 02210
Tel: (617) 570-1000
Fax: (617) 523-1231
Counsel for Patent Owner

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6, I hereby certify that on February 19, 2025 the foregoing paper was served via email on the following counsel of record for Patent Owner:

dkline@goodwinlaw.com

nbirbach@goodwinlaw.com

DG-BitSight-BlackKite@goodwinlaw.com

/s/ James M. Glass

James M. Glass
Registration No. 46,729