UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TREND MICRO INC.
Petitioner

v.

KAJEET, INC.
Patent Owner

Case IPR2023-00178
Patent 7,899,438

JOINT MOTION TO TERMINATE PROCEEDING

Petitioner Trend Micro Inc. and Patent Owner Kajeet, Inc. (collectively "Parties") hereby jointly move for an order terminating the *inter partes* review filed November 10, 2022, directed to Patent No. 7,899,438 ("the '438 patent") and assigned case number IPR2023-00178. The Board authorized the instant motion by e-mail on August 21, 2023.

Patent Owner filed a preliminary response. The PTAB has granted institution, but Patent Owner has not yet filed the Patent Owner Response.

The Parties have settled their dispute, and have reached agreement to terminate this proceeding. The Parties' Settlement Agreement has been made in writing. The Parties executed the Settlement Agreement in counter-signed copies, true copies of which are attached as Exhibits 2002 and 2003, respectively.

In addition, the Parties desire the Settlement Agreement be maintained as business confidential under 37 C.F.R. § 42.74(c), and a separate joint request to that effect is being filed concurrently herewith.

1. Reasons Why Termination Is Appropriate

Termination is proper because the Parties are jointly requesting termination, the review is still in its early stages, and the Office has not yet "decided the merits of the proceeding before the request for termination is filed." As noted in the Patent Office Trial Practice Guidelines, "there are strong public policy reasons to favor settlement between the parties to a proceeding. . . . The Board expects that a

proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding."[1] Accordingly, termination is appropriate here.

The Parties understand that if the Board terminates this petition for inter partes review, no estoppel under 35 U.S.C. § 315(e) or 37 C.F.R. § 42.73(d)(1) will attach to Petitioners. The Parties understand that if the Board terminates this petition for inter partes review before a final written decision on patentability, no preclusion will attach to Patent Owner under 37 C.F.R. § 42.73(d)(3).

As authorized by email on August 21, 2023, a true copy of the agreement made in connection with, or in contemplation of, the termination of this petition for inter partes review is being contemporaneously filed herewith as Exhibits 2002 and 2003.

2. Status of Related District Court Litigation

The '438 patent is the subject of the following pending litigation:

- *Kajeet, Inc. v. Trend Micro Inc.,* No. 6:21-cv-00389 (W.D. Tex.).

On August 18, 2023, Patent Owner and Petitioner filed a joint motion to dismiss their respective claims and counterclaims with prejudice in the *Kajeet, Inc. v. Trend Micro Inc.,* No. 6:21-cv-00389, proceeding, and the Court ordered

[1] *See* Federal Register Vol. 77, No. 157 at 48768.

dismissal with prejudice on August 18, 2023. There are no other pending proceedings between the Petitioners and Patent Owner relating to the '438 patent.

For the foregoing reasons, the Parties jointly request termination of IPR2023-00178.

Respectfully submitted,

Date: August 23, 2023

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(1), the undersigned certifies that, on August 23, 2023, a copy of Joint Motion to Terminate Proceeding, Joint Request to File Settlement Agreement as Business Confidential Information Pursuant to 37 C.F.R. § 42.74(c), and accompanying exhibits were provided via email, to Petitioner by serving the email correspondence addresses of record as follows:

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