

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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AO KASPERSKY LAB,  
Petitioner,

v.

OPEN TEXT INC.,  
Patent Owner.

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IPR2023-00124 (Patent 9,578,045 B2)  
IPR2023-00126 (Patent 10,257,224 B2)  
IPR2023-00289 (Patent 8,418,250 B2)  
IPR2023-00556 (Patent 8,726,389 B2)<sup>1</sup>

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Before BARBARA A. PARVIS, GREGG I. ANDERSON, MICHELLE N.  
WORMMEESTER, GARTH D. BAER, and AARON W. MOORE,  
*Administrative Patent Judges.*<sup>2</sup>

WORMMEESTER, *Administrative Patent Judge.*

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<sup>1</sup> This Termination applies to each of the above-identified proceedings. We exercise our discretion to issue one Termination to be filed in each case. The parties may not use this style heading in any subsequent papers.

<sup>2</sup> This is not an expanded panel. The panel in IPR2023-00124, IPR2023-00126, and IPR2023-00289 is Judges Anderson, Wormmeester, and Moore. The panel in IPR2023-00556 is Judges Parvis, Baer, and Moore.

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TERMINATION  
Due to Settlement After Institution of Trial  
*35 U.S.C. § 317; 37 C.F.R. § 42.74*

I. INTRODUCTION

In each of the above-identified proceedings, the parties filed a joint motion to terminate the proceeding pursuant to a settlement agreement. Paper 37 (“Joint Motion to Terminate”).<sup>3</sup> The parties also filed a copy of their settlement agreement made in connection with the termination of the proceedings. Exs. 1038 & 1039 (collectively, “Agreement”). In a concurrently filed paper, the parties jointly request their Agreement to be treated as business confidential and to be kept separate from the files of the involved patents under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Paper 38 (“Joint Request”). We authorized the filing of these papers and exhibits in an e-mail dated April 9, 2024. Ex. 3002.

II. DISCUSSION

The Board has not decided the merits of any of the above-identified proceedings. In each proceeding, the parties represent that their Agreement “resolves all disputes between the Parties concerning the Challenged Patent,” and that Exhibits 1038 and 1039 collectively comprise a “true,” “correct,” and “complete” copy of the Agreement. Paper 37, 1, 4; Paper 38, 1. The parties further represent that “[n]o other such agreements, written or

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<sup>3</sup> We cite to papers and exhibits filed in IPR2023-00124. Similar papers and exhibits were filed in IPR2023-00126, IPR2023-00289, and IPR2023-00556.

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oral, exist between or among the Parties.” Paper 37, 2. In view of the foregoing, we determine that it is appropriate to dismiss each Petition and terminate each proceeding without rendering a final written decision. *See* 35 U.S.C. § 317(a).

Further, after reviewing the parties’ Agreement in each of the proceedings, we find that the Agreement contains confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Agreement as business confidential information and to keep it separate from the files of the above-identified patents pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

We note that the parties also “request that the Board inform [the parties] if anyone seeks production of the Agreement and afford the parties an opportunity to address whether such request is supported by good cause.” Paper 38, 2. The statute, however, does not provide for any such notification or opportunity to respond. *See* 35 U.S.C. § 317(b). Nor does the regulation. *See* 37 C.F.R. § 42.74(c). Moreover, we see no persuasive reason or special circumstance here that would justify issuing an order that imposes these additional requirements. Thus, we deny that part of the Joint Request by the parties in each of the proceedings.

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

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### III. ORDER

Accordingly, it is:

ORDERED that the Joint Motion to Terminate (Paper 37) in each of the above-identified proceedings is *granted*, and that each proceeding is *terminated*; and

FURTHER ORDERED that the Joint Request (Paper 38) in each of the above-identified proceedings is *granted-in-part*, and that the Agreement (Exhibits 1038 and 1039) in each proceeding shall be treated as business confidential information, kept separate from the files of the above-identified patents, 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).

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