

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZF FRIEDRICHSHAFEN AG, ZF ACTIVE SAFETY AND
ELECTRONICS US LLC, AND NISSAN MOTOR COMPANY, LTD.,
Petitioner,

v.

FORAS TECHNOLOGIES, LTC.,
Patent Owner.

IPR2024-00969
Patent 7,502,958 B2

Before CARL W. WHITEHEAD JR., THOMAS L. GIANNETTI and
KARA L. SZPONDOWSKI, *Administrative Patent Judges*.

WHITEHEAD JR., *Administrative Patent Judge*.

DECISION

Granting Joint Motion to Terminate Prior to Institution of Trial and Granting
Joint Request to Treat Settlement Agreement as Business Confidential
Information
35 U.S.C. § 42.74

I. INTRODUCTION

On October 25, 2024, with the Board’s authorization on October 24, 2024, Petitioners ZF Friedrichshafen AG, ZF Active Safety and Electronics US LLC and Nissan Motor Company, LTD. and Patent Owner Foras Technologies Ltd. (collectively “the Parties”) filed a “Joint Motion to Withdraw Petition For *Inter Partes* Review” (“Joint Motion to Withdraw”). Paper 9. In that Motion, the Parties request withdrawal of the Petition filed in the above-identified proceeding involving U.S. Patent 7,502,958 B2 (“the ‘958 patent”). *Id.* at 1. The Parties also filed a copy of a confidential “License and Settlement Agreement” (“Agreement”). Ex. 1031. The Parties further filed a “Joint Request That the Settlement Agreement Be Treated as Business Confidential Information and Kept Separate Under 35 U.S.C. § 317(b)” (“Joint Motion to Seal”). Paper 10.

II. DISCUSSION

On June 24, 2024, Petitioner filed a Petition requesting *inter partes* review of claims 9–12 and 23–25 of the ‘958 patent. Paper 4. Patent Owner filed a Preliminary Response to the Petition on October 16, 2024. Paper 8.

In the Joint Motion to Withdraw, the Parties represent that “Petitioners and Patent Owner have resolved their disputes regarding the ‘958 Patent, including both in this proceeding and Patent Owner’s assertion of the ‘958 Patent in the related district court litigation, 1:23-cv-00640-RP (W.D. Tex.).” Joint Motion to Withdraw 1. The Parties, therefore, “jointly request that the Board terminate this proceeding in its entirety.” *Id.* at 2. The Parties also “request to treat the agreement as business confidential information and keep the agreement (Exhibit 1031) separate from the file of the involved patent, pursuant to 37 C.F.R. § 42.74(c).” *Id.* at 2; Joint Motion

to Seal 1. The Parties state that the Agreement “contain[s] highly sensitive business confidential information that would substantially harm their business interests if publicly disclosed.” Joint Motion to Seal 1.

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 dismiss the Petition, and terminate the proceeding with respect to the parties.

After reviewing the Agreement between Petitioner and Patent Owner, we find that the Agreement contains confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Agreement between Petitioner and Patent Owner as business confidential information pursuant to 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

For the reasons discussed above, it is

ORDERED that the Joint Motion to Withdraw (Paper 9) is *granted*, the Petition is dismissed, and the above proceeding is *terminated*;

ORDERED that the parties’ Joint Motion to Seal (Paper 10) is *granted*, and the Agreement (Ex. 1031) shall remain designated as “Parties and Board Only” in Board’s filing system, shall made available only to Federal Government agencies on written request, or to any person on a showing of good cause, and shall be kept separate from the files of the involved patent and associated preliminary proceeding, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

IPR2024-00969
Patent 7,502,958 B2

For PETITIONER:

John R. Hutchins
Paul T. Qualey
Wesley W. Jones
Binal J. Patel
BANNER & WITCOFF, LTD.
jhutchins@bannerwitcoff.com
pqualey@bannerwitcoff.com
wjones@bannerwitcoff.com
bpatel@bannerwitcoff.com
ZFIPRService@bannerwitcoff.com

For PATENT OWNER:

Brett Cooper
Seth Lindner
BC LAW GROUP, P.C.
bcooper@bc-lawgroup.com
slindner@bc-lawgroup.com
Foras_Counsel@bc-lawgroup.com

Robert A. Auchter
AUCHTER PLLC
robert@auchterlaw.com