

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CISCO SYSTEMS, INC., FORESCOUT TECHNOLOGIES, INC.,
and HEWLETT PACKARD ENTERPRISE COMPANY,
Petitioners¹

v.

K.MIZRA LLC,
Patent Owner.

IPR2021-00593
U.S. Patent 8,234,705 B1

Before MITCHELL G. WEATHERLY, AARON W. MOORE, and
IFTIKHAR AHMED, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

ORDER

Terminating Due to Settlement After Institution of Trial
35 U.S.C. § 317; 37 C.F.R. § 42.74
Granting Joint Requests to Treat Settlement
Agreements as Business Confidential Information

¹ The petitioners in IPR2021-00081, Forescout Technologies, Inc., and IPR2021-00084, Hewlett Packard Enterprise Company, have joined this proceeding as petitioners via granted motions for joinder.

Termination

On September 19, 2022, the Board issued a Final Written Decision determining that Petitioners had not shown by a preponderance of the evidence that claims 1–3, 5–13, and 15–19 of the ’705 patent are unpatentable. *See* Paper 41. Petitioners Cisco Systems, Inc. (“Cisco”) and Hewlett Packard Enterprise Company (“HPE”) appealed to the United States Court of Appeals for the Federal Circuit. *See* Paper 41; IPR2021-00084, Paper 12.

The Federal Circuit issued a decision vacating the Final Written Decision and remanding this proceeding to the Board on August 16, 2024. *See Cisco Sys., Inc. v. K.Mizra LLC*, No. 2022-2290, 2024 WL 3841809, at *1 (Fed. Cir. Aug. 16, 2024). The mandate issued on November 19, 2024.

On remand, Patent Owner and Petitioner HPE filed a joint motion to terminate as to HPE. *See* Paper 46. Patent Owner and HPE represent that they “have settled their dispute, and have agreed to terminate HPE” and that “a true copy of the agreement made in connection with, or in contemplation of, the termination of this proceeding for *inter partes* review” has been filed as Exhibit 2014. *Id.* at 4–5.

Then, Patent Owner and Petitioner Cisco filed a joint motion to terminate as to Cisco. *See* Paper 49. Patent Owner and Cisco represent that they “have settled their dispute,” “have agreed to terminate Cisco from this proceeding,” and that the “Settlement Agreement has been made in writing” and filed as Exhibit 2015. *Id.* at 3–4.

Finally, on January 16, 2025, Patent Owner and Petitioner Forescout filed a joint motion to terminate as to Forescout. *See* Paper 49. Patent Owner and Forescout represent that “Forescout and Patent Owner have . . .

agreed to terminate Forescout from this proceeding” because “Patent Owner filed a notice of voluntary dismissal of its claims with prejudice” in the parallel litigation, “the Court ordered dismissal with prejudice on February 21, 2023,” and “[t]here are no other pending proceedings between Forescout and Patent Owner relating to the ’705 Patent.” *Id.* at 5.

Under 35 U.S.C. § 317(a), “[a]n *inter partes* review . . . shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” The Board has not yet decided the merits of this proceeding on remand, and all parties request termination. We accordingly terminate this proceeding.

Confidential Information

Patent Owner and Petitioners Cisco and HPE also filed requests that the Settlement Agreements filed as Exhibits 2014 and 2015 be treated as business confidential information and kept separate from the file of the ’705 patent. *See* Papers 47, 48. After reviewing the Settlement Agreements, we find that they contain confidential business information regarding the terms of the settlements, and we determine that good cause exists to treat the Settlement Agreements as business confidential information.

Accordingly, it is

ORDERED that the Joint Motions to Terminate are granted and that this proceeding is terminated; and

FURTHER ORDERED that Exhibit 2014 and Exhibit 2015 be treated as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) and be available only to the Board in the P-TACTS system.

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