

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AVI NETWORKS, INC.,
Petitioner,

v.

CITRIX SYSTEMS, INC.,
Patent Owner.

Case IPR2019-00844 (Patent 8,631,120 B2)
Case IPR2019-00845 (Patent 9,148,493 B2)¹

Before JUSTIN T. ARBES, PATRICK M. BOUCHER, and
FREDERICK C. LANEY, *Administrative Patent Judges*.

LANEY, *Administrative Patent Judge*.

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

¹ This Decision addresses issues pertaining to both cases.

Case IPR2019-00844 (Patent 8,631,120 B2)

Case IPR2019-00845 (Patent 9,148,493 B2)

Petitioner Avi Networks, Inc. and Patent Owner Citrix Systems, Inc. have requested jointly that the above-identified *inter partes* review proceedings be terminated due to a settlement. With our authorization in each proceeding, the parties filed a “Joint Motion to Terminate Proceeding Under 35 U.S.C. § 317” (Paper 24 (“Joint Motion”)).² Along with the Joint Motion, the parties filed a “Settlement Agreement” (Ex. 2013 (“Settlement Agreement”)), as well as a “Joint Motion to File Settlement Agreement as Business Confidential Information Under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.72(c)” (Paper 25).

Under 35 U.S.C. § 317(a), “[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 the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” The parties indicate that the submitted written confidential settlement agreement fully resolves the disputes between them regarding the challenged patents and that “there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of the present *inter partes* review[s].” Joint Motion 1–2. In addition, the parties indicate that, on December 30, 2019, the district court was notified of the settlement agreement, which also resolves the disputes regarding the challenged patents in Civil Action No. 1:17-cv-01843-LPS (D. Del.) and that the parties filed jointly a stipulation to dismiss all claims pending in that case. *Id.* at 3.

² The parties filed similar papers and exhibits in each of the instant proceedings. *See* IPR2019-00844, Papers 24, 25, Ex. 2013; IPR2019-00845, Papers 24, 25, Ex. 2013. We refer to those filed in Case IPR2019-00844 for convenience.

Case IPR2019-00844 (Patent 8,631,120 B2)

Case IPR2019-00845 (Patent 9,148,493 B2)

We instituted a trial in each of the above-identified proceedings on October 1, 2019. Paper 19. We have not yet decided the merits of the proceedings, and a final written decision has not been entered in either matter. Notwithstanding that the proceedings have moved beyond the preliminary stage, the parties have shown adequately that the termination of the proceedings is appropriate. Under these circumstances, we determine that good cause exists to terminate the proceedings in both matters. In addition, after considering the Settlement Agreement, we also conclude that it is appropriate to treat the Settlement Agreement (Ex. 2013) as business confidential information to be kept separate from the patent file in both matters. *See* 37 C.F.R. § 42.74(c).

ORDER

Therefore, it is

ORDERED that the joint motions to terminate the proceedings in IPR2019-00844 and IPR2019-00845 are *granted*; and

FURTHER ORDERED that the parties' joint request (Paper 25) to treat the parties' settlement agreement (Ex. 2013) as business confidential information is *granted*, and the settlement agreement shall be kept separate from the files of U.S. Patent Nos. 8,631,120 B2 and 9,148,493 B2, 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).

Case IPR2019-00844 (Patent 8,631,120 B2)

Case IPR2019-00845 (Patent 9,148,493 B2)

PETITIONER:

Y. Ernest Hsin

Josh Krevitt

Ryan Iwahashi

Gibson, Dunn & Crutcher LLP

EHsin@gibsondunn.com

JKrevitt@gibsondunn.com

RIwahashi@gibsondunn.com

PATENT OWNER:

Stephen J. Tyran

Lesley A. Hamlin

Citrix Systems, Inc.

Stephen.tytran@citrix.com

Lesley.hamlin@citrix.com

W. Karl Renner

David L. Holt

Craig E. Carlson

Fish & Richardson P.C.

IPR23652-0023IP2@fr.com

PTABInbound@fr.com