

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Oracle Corporation

Petitioner,

v.

Clouding IP, LLC

Patent Owner

IPR2013-00073

Patent 6,738,799

**JOINT MOTION TO TERMINATE PROCEEDING
PURSUANT TO 35 U.S.C. § 317**

Pursuant to 35 U.S.C. § 317(a) Petitioner Oracle Corporation (“Oracle”) and Patent Owner Clouding IP, LLC (“Clouding”) jointly request termination of IPR2013-00073, which is directed to Patent 6,738,799 (the “’799 Patent”).

This *inter partes* review has been instituted and Clouding filed its response to Oracle’s petition on June 24, 2013. No final written decision on the merits of this review proceeding has been entered. The parties have settled their dispute, and have reached agreement to terminate this *inter partes* review.

The parties’ Settlement Agreement has been made in writing, and a true copy of same is attached hereto as Exhibit 1.¹ The parties desire that the Settlement Agreement be maintained as business confidential information under 37 C.F.R. §42.74(c) and a separate joint request to that effect is being filed on even date herewith.

As stated in 35 U.S.C. § 317(a), because Oracle and Clouding jointly request this termination as to Petitioner Oracle, no estoppel under 35 U.S.C. 315(e) shall attach to Oracle.

1. Reasons Why Termination is Appropriate.

Termination with respect to Petitioner is proper under 35 U.S.C. § 317(a)

¹ The Settlement Agreement is being filed electronically via the Patent Review Processing System (PRPS) as “Parties and Board Only.”

because the parties are jointly requesting termination and the Office has not yet “decided the merits of the proceeding before the request for termination is filed.” Within the context of Section 317(a) a decision on the merits must be something beyond a decision instituting trial. Otherwise the quoted phrase would be rendered meaningless because every “*inter partes* review instituted under this chapter” originates with a decision instituting trial. Here, no decision on the merits has been made. Accordingly, the parties are entitled to terminate this proceeding as to Petitioner under Section 317(a) upon their joint request.

Petitioner takes no position on whether this review proceeding should be terminated with respect to Patent Owner.

Pursuant to the Board’s Order regarding the Conduct of the Proceeding dated July 15, 2013, Patent Owner is providing comments as to why termination with respect to Patent Owner is proper in *Patent Owner’s Explanation as to Why Termination Is Appropriate*, attached hereto as Exhibit 2.

2. Related District Court Litigations and Status.

The ‘799 Patent is the subject of the following pending litigations:

Case Name	Docket No.	Court	Defendants	Status
Clouding IP, LLC v. Google, Inc.	1-12-cv-00639	DED	Google, Inc.	Pending
Clouding IP, LLC v.	1-12-cv-00641	DED	Amazon.com, Inc. Amazon Web Services, LLC	Pending

Amazon.com Inc.				
Clouding IP, LLC v. Rackspace Hosting Inc.	1-12-cv-00675	DED	Rackspace Hosting, Inc. Jungle Disk, LLC Rackspace US, Inc.	Pending

3. Future Participation by the Parties.

Pursuant to the Settlement Agreement, Petitioner Oracle will not further participate in these proceedings, even if they are not terminated pursuant to this joint motion. Patent Owner's participation in any further proceedings would depend upon the conditions of same and Patent Owner reserves its right to so participate (including the right to seek exclusion of some or all the testimony of Petitioner's declarant), if necessary. Patent Owner notes, however, that in the absence of Petitioner, it is unclear how these proceedings could properly proceed.

Respectfully submitted,

OBLON SPIVAK

Dated: July 19, 2013

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