

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Oracle Corporation
Petitioner

v.

Clouding IP, LLC
Patent Owner

Case IPR2013-00261 (JL)
Patent 6,738,799

Before JAMESON LEE, JONI Y. CHANG, MICHAEL W. KIM, and
RAMA G. ELLURU, *Administrative Patent Judges*.

KIM, *Administrative Patent Judge*.

JUDGMENT
Termination of Proceeding
37 C.F.R. § 42.73

On July 19, 2013, the parties filed a joint motion to terminate this proceeding with respect to the petitioner (“Oracle”). (Paper 7.) With the joint motion, the parties filed a copy of their written settlement agreement covering Patent 6,738,799 involved in this proceeding. (Paper 9.) The parties also filed, on

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July 19, 2013, a joint request to have their settlement agreement treated as confidential business information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). (Paper 8.)

In a telephone conference call conducted on July 11, 2013, counsel for the parties represented that they have reached an agreement resolving the dispute in the instant proceeding and will also move to dismiss related district court litigation between the parties and involving Patent 6,738,799. The Board asked the parties to indicate in their joint motion to terminate this proceeding whether there will be codefendants remaining in such related litigation. The joint motion indicates none.

The joint motion identifies other related litigation involving Patent 6,738,799 but not Oracle. The defendants in such other related litigation have not filed a petition for *inter partes* review of Patent 6,738,799.

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement. *See, e.g., Office Patent Trial Practice Guide*, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012). Oracle's petition was filed on May 2, 2013, and Clouding has not yet filed its Preliminary Response. The Board has not yet determined whether an *inter partes* review should be instituted.

Oracle represents that it will no longer participate, even if the Board institutes an *inter partes* review and commences a trial. That means even if an *inter partes* review is instituted, Oracle will not file a reply to any Patent Owner Response or an opposition to any Motion to Amend Claims. Oracle also will not be conducting any cross examination of Clouding's witnesses. Also, because of non-participation of Oracle, Clouding may not have an opportunity to cross examine Oracle's witnesses whose testimony are relied on by Oracle's petition.

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As no trial has been instituted based on Oracle's petition, this proceeding is in the preliminary proceeding stage.¹ Based on the facts of this case, it is appropriate to enter judgment.²

Accordingly, it is

ORDERED that the joint motion to terminate IPR2013-00261 is GRANTED, and this proceeding is hereby terminated as to all parties including petitioner Oracle and patent owner Clouding; and

FURTHER ORDERED that the parties's joint request to have their settlement agreement treated as business confidential information under the 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) is also GRANTED.

¹ A preliminary proceeding begins with the filing of a petition for instituting a trial and ends with a written decision as to whether a trial will be instituted. 37 C.F.R. § 42.2.

² A judgment means a final written decision by the Board, or a termination of a proceeding. 37 C.F.R. § 42.2.

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