

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ORACLE CORP.,
Petitioner,

v.

GUADA TECHNOLOGIES LLC,
Patent Owner.

IPR2020-00598
Patent 7,231,379 B2

Before MIRIAM L. QUINN, KIMBERLY McGRAW, and
MATTHEW J. McNEILL, *Administrative Patent Judges*.

McNEILL, *Administrative Patent Judge*.

ORDER

Denying Without Prejudice Joint Motion to Terminate
Granting Request to Keep Agreement Confidential
35 U.S.C. §§ 317, 318; 37 C.F.R. § 42.5(a), 42.74

On May 29, 2020, the parties filed a Joint Motion to Terminate. Paper 6. The parties concurrently filed a joint request to treat the settlement agreement as business confidential information, and for it to be kept separate from the patent file, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 7), along with a copy of the written settlement agreement (Ex. 1027). The parties represent that Exhibit 1027 is a true and accurate copy of their settlement agreement. Paper 13, 2. The parties also “represent that there are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of the present proceeding.” *Id.*

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.”

However, 35 U.S.C. § 317(b) requires that:

Any agreement or understanding between the patent owner and petitioner, *including any collateral agreements referred to in such agreement or understanding*, made in connection with, or in contemplation of, the termination of an inter partes review under this section shall be in writing and a true copy of such agreement or understanding shall be filed in the Office before the termination of the inter partes review as between the parties.

(emphasis added). Based on our review of the settlement agreement, the Board has concerns that not all relevant collateral agreements have been filed. Accordingly, the parties’ motion for termination of the proceeding is *denied* without prejudice.

The parties may refile the Joint Motion to Terminate with any related collateral agreements. To the extent there are any confidentiality issues with

IPR2020-00598
Patent 7,231,379 B2

collateral agreements, the parties may file those agreements under seal along with a motion to treat them as business confidential information.

Alternatively, if the parties wish to discuss the issue with the Board, the parties may send an email to the Board proposing at least three dates and times that the parties are available for a conference call.

After reviewing the parties' settlement agreement, we find that the settlement agreement contains business confidential information regarding terms of the settlement and good cause exists to treat the settlement agreement as business confidential information pursuant to 37 C.F.R. § 42.74(c).

Accordingly, it is

ORDERED that the Joint Motion to Terminate IPR2020-00598 (Paper 6) as to both Petitioner and Patent Owner is *denied* without prejudice;

FURTHER ORDERED that the joint request (Paper 7) to treat the parties' settlement agreement (Ex. 1027) as business confidential information under 37 C.F.R. § 42.74(c), and for it to be kept separate from the patent file in the above-captioned proceeding, is *granted*.

IPR2020-00598
Patent 7,231,379 B2

For PETITIONER:

James M. Heintz
Alireza Babaei
DLA PIPER LLP
jim.heintz@dlapiper.com
alireza.babaei@dlapiper.com

For PATENT OWNER:

Isaac Rabicoff
RABICOFF LAW
isaac@rabilaw.com