

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

Granting Motion to Terminate
Granting Request to Keep Agreements Confidential
35 U.S.C. §§ 317, 318; 37 C.F.R. § 42.5(a), 42.74

On July 1, 2020, the parties filed a joint Motion to Terminate. Paper 11. The parties concurrently filed a joint request to treat the settlement agreement and a related collateral agreement as business confidential information, and for them 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 12). The parties also filed a copy of the written settlement agreement (Ex. 2001) and collateral agreement (Ex. 2002). The parties represent that Exhibit 2001 is a true and accurate copy of their settlement agreement and that Exhibit 2002 is the only related collateral agreement. Paper 11.

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.” 35 U.S.C. § 317(b) requires that:

Any agreement or understanding between the patent owner and a 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.

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement, if the settlement agreement includes all parties to the proceeding and the parties file all collateral agreements as required by 35 U.S.C. § 317(b), unless the Board has already decided the merits of the proceeding. *See, e.g.*, Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). The parties filed such a settlement agreement. Ex. 2001. The parties also filed a related collateral agreement

and represent that it is the only such related agreement. Ex. 2002, Paper 11. Moreover, this proceeding is at a preliminary stage and no trial has been instituted. Under these circumstances, we determine that it is appropriate to terminate this proceeding.

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

Accordingly, it is

ORDERED that the Motion to terminate IPR2020-00598 (Paper 11) as to both Petitioner and Patent Owner is *granted*;

FURTHER ORDERED that the joint request (Paper 12) to treat the parties' settlement agreement (Ex. 2001) and the collateral agreement (Ex. 2002) as business confidential information under 37 C.F.R. § 42.74(c), and for them to be kept separate from the patent file in the above-captioned proceeding, is *granted*; and

FURTHER ORDERED that the Petition is dismissed under 37 C.F.R. § 42.71(a), and this proceeding is *terminated* with respect to both Petitioner and Patent Owner.

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