

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ACXIOM CORPORATION, et al.  
Petitioner,

v.

PHOENIX LICENSING, LLC,  
Patent Owner.

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Case CBM2015-00134 Patent 8,234,184 B2<sup>1</sup>  
Case CBM2015-00135 Patent 6,999,938 B1  
Case CBM2015-00136 Patent 7,856,375 B2  
Case CBM2015-00137 Patent 7,890,366 B2  
Case CBM2015-00138 Patent 8,738,435 B2  
Case CBM2015-00139 Patent 7,860,744 B2  
Case CBM2015-00140 Patent 5,987,434

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Before STACEY G. WHITE, PETER P. CHEN, ROBERT J. WEINSCHENK, and  
ROBERT A. POLLOCK, *Administrative Patent Judges*.

WHITE, *Administrative Patent Judge*.

ORDER TO CLARIFY MOTIONS TO TERMINATE  
Conduct of the Proceeding  
*37 C.F.R. § 42.5*

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<sup>1</sup> This order addresses a similar issue in the seven cases. Therefore, we exercise discretion to issue one order to be filed in each case. The parties, however, are not authorized to use this style of heading in subsequent papers.

CBM2015-00134 Patent 8,234,184 B2      CBM2015-00135 Patent 6,999,938 B1  
CBM2015-00136 Patent 7,856,375 B2      CBM2015-00137 Patent 7,890,366 B2  
CBM2015-00138 Patent 8,738,435 B2      CBM2015-00139 Patent 7,860,744 B2  
CBM2015-00140 Patent 5,987,434

Pursuant to authorization by the Board, Patent Owner and Petitioner Gerber Life Insurance (“Gerber”) filed a joint motion requesting termination of CBM2015-00134 (Paper 11), CBM2015-00135 (Paper 11), CBM2015-00136 (Paper 12), CBM2015-00137 (Paper 10), CBM2015-00138 (Paper 10), CBM2015-00139 (Paper 10), and CBM2015-00140 (Paper 11) with respect to Gerber.<sup>2</sup>

Under 35 U.S.C. § 327(a), applicable to post-grant review proceedings for review of the patentability of covered business method patents, a proceeding 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. These matters are in the preliminary stage. Patent Owner Preliminary Responses were filed September 11, 2015, and September 15, 2015. Decisions whether to institute trial have not been issued in any of the cases. Thus, these proceedings with respect to Gerber are at a stage eligible for termination.

Under 35 U.S.C. § 327(b), 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 the proceeding shall be in writing, and a true copy of such agreement or understanding shall be filed in the Office.

The parties filed a brief termination agreement that does not describe any terms of the parties’ agreement. Ex. 2002. Gerber and Patent Owner do not represent that they have filed a true copy of all agreements between the parties as required by 35 U.S.C. § 327.

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<sup>2</sup> The Motions and supporting documents are identical in each case. Thus, for ease of reference we will refer to the filings in CBM2015-00134.

CBM2015-00134 Patent 8,234,184 B2      CBM2015-00135 Patent 6,999,938 B1  
CBM2015-00136 Patent 7,856,375 B2      CBM2015-00137 Patent 7,890,366 B2  
CBM2015-00138 Patent 8,738,435 B2      CBM2015-00139 Patent 7,860,744 B2  
CBM2015-00140 Patent 5,987,434

Within FIVE BUSINESS DAYS of this Order, Gerber and Patent Owner are required to file a Joint Statement addressing whether any agreements exist, other than Ex. 2002, resolving the patentability disputes in CBM2015-00134, CBM2015-00135, CBM2015-00136, CBM2015-00137, CBM2015-00138, CBM2015-00139, and CBM2015-00140, and if any such agreements exist, to submit a true copy of all such agreements with the Joint Statement. Any such agreements may be filed with a request that they be treated as business confidential information under 37 C.F.R. § 42.74(c).

If Gerber and Patent Owner assert that no such agreements exist, Gerber and Patent Owner must jointly certify in writing that there are no other written or oral agreements or understandings between them made in connection with, or in contemplation of, the termination of patentability disputes in CBM2015-00134, CBM2015-00135, CBM2015-00136, CBM2015-00137, CBM2015-00138, CBM2015-00139, and CBM2015-00140 or the challenge to the patentability of U.S. Patent Nos. 8,234,184 B2; 6,999,938 B1; 7,856,375 B2; 7,890,366 B2; 8,738,435 B2; 7,860,744 B2; or 5,987,434.

The Joint Certification should be in the following form.

### **JOINT CERTIFICATION**

The parties hereby jointly certify that there are no other written or oral agreements or understandings, including any collateral agreements, between them, including but not limited to licenses, covenants not to sue, confidentiality agreements, payment agreements, or other agreements of any kind that have been made in connection with or in contemplation of the termination of Gerber Life Insurance Company from Cases CBM2015-00134, CBM2015-00135, CBM2015-00136, CBM2015-00137, CBM2015-00138, CBM2015-00139, and CBM2015-

CBM2015-00134 Patent 8,234,184 B2      CBM2015-00135 Patent 6,999,938 B1  
CBM2015-00136 Patent 7,856,375 B2      CBM2015-00137 Patent 7,890,366 B2  
CBM2015-00138 Patent 8,738,435 B2      CBM2015-00139 Patent 7,860,744 B2  
CBM2015-00140 Patent 5,987,434

00140 pending before the Patent Trial and Appeal Board or in regards to any challenge to the patentability of U.S. Patent Nos. 8,234,184 B2; 6,999,938 B1; 7,856,375 B2; 7,890,366 B2; 8,738,435 B2; 7,860,744 B2; or 5,987,434. The entire agreement between the Gerber and Patent Owner related to termination of Gerber from CBM2015-00134, CBM2015-00135, CBM2015-00136, CBM2015-00137, CBM2015-00138, CBM2015-00139, and CBM2015-00140 is memorialized in Exhibit 2002 filed in CBM2015-00134, CBM2015-00135, CBM2015-00136, CBM2015-00137, CBM2015-00138, CBM2015-00139, and CBM2015-00140.

#### ORDER

Accordingly, it is:

ORDERED that Gerber and Patent Owner shall file with the Board within FIVE BUSINESS DAYS of this Order a Joint Statement addressing whether any agreements exist, other than Ex. 2002, resolving the patentability dispute in CBM2015-00134, CBM2015-00135, CBM2015-00136, CBM2015-00137, CBM2015-00138, CBM2015-00139, and CBM2015-00140, and if any such agreements exist, to submit a true copy of all such agreements with the Joint Statement;

FURTHER ORDERED that, in accordance with 35 U.S.C. § 327 and 37 C.F.R. § 42.74, Gerber and Patent Owner are authorized to file a Joint Request that any agreements submitted with the Joint Statement be treated as business confidential; and

FURTHER ORDERED, that if no such agreements exist, Gerber and Patent Owner shall file with the Board within FIVE BUSINESS DAYS of this Order a Joint Certification so stating in the form provided in this Order.

CBM2015-00134 Patent 8,234,184 B2  
CBM2015-00136 Patent 7,856,375 B2  
CBM2015-00138 Patent 8,738,435 B2  
CBM2015-00140 Patent 5,987,434

CBM2015-00135 Patent 6,999,938 B1  
CBM2015-00137 Patent 7,890,366 B2  
CBM2015-00139 Patent 7,860,744 B2

The Parties are reminded of the Duty of Candor that applies in proceedings before the Office. 37 C.F.R. § 42.11.

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