

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*.

TERMINATION OF PETITIONERS AAA LIFE INSURANCE COMPANY and  
GERBER LIFE INSURANCE COMPANY  
Conduct of the Proceedings  
*37 C.F.R. § 42.74*

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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, Phoenix Licensing LLC (“Patent Owner”) and Petitioner AAA Life Insurance (“AAA”) filed joint motions requesting termination of CBM2015-00134 (Paper 12), CBM2015-00135 (Paper 12), CBM2015-00136 (Paper 13), and CBM2015-00140 (Paper 12) with respect to AAA, and joint requests to treat as confidential the submitted settlement agreement (CBM2015-00134 (Paper 13), CBM2015-00135 (Paper 13), CBM2015-00136 (Paper 14), and CBM2015-00140 (Paper 13)). In addition, Patent Owner and Petitioner Gerber Life Insurance (“Gerber”) filed joint motions 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. Pursuant to our October 14, 2015 Order (Paper 16<sup>2</sup>), Gerber and Patent Owner submitted Ex. 2002-A, which is a written memorialization of the oral agreement between Patent Owner and Geber regarding the termination of the CBM proceedings between Gerber and Patent Owner. Gerber and Patent Owner filed Joint Requests to treat Exhibit 2002-A as confidential. Paper 20. In addition, Patent Owner jointly with each AAA and Gerber submitted Joint Certifications (Papers 18, 19) stating that all agreements relating to the termination of AAA and Gerber from these proceedings have been filed with the Board.

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

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<sup>2</sup> The Orders, Motions, and supporting documents are identical in each case for the respective petitioning parties. 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

and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed. This matter is in its preliminary stage. Patent Owner Preliminary Responses were filed in the respective cases on various dates in September 2015. Decisions whether to institute a trial have not been issued. Thus, these proceedings with respect to AAA and Gerber are at a stage eligible for termination.

Pursuant to 35 U.S.C. § 327 and 37 C.F.R. § 42.74, Patent Owner and AAA state in the Joint Motion and Joint Certification that they have reached an agreement resolving the disputes in CBM2015-00134, CBM2015-00135, CBM2015-00136, and CBM2015-00140, and submitted Exhibit 2001 as evidence of their agreement. As to the other settling party, Gerber and Patent Owner originally submitted Exhibit 2002 as evidence of their agreement. This document, however, was not the complete agreement between the parties as required by 35 U.S.C. § 327(b) and 37 C.F.R. § 42.74(b). Section 327(b) requires that

**(b)Agreements in Writing.** – 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 a post-grant 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 post-grant review as between the parties.

Thus, the filing of Exhibit 2002 did not satisfy the requirements of this rule because, as the parties now admit in their Joint Certification, there was an oral agreement that had not been committed to writing. *See* Paper 19. We remind the parties of their obligation to fulfill the requirements of all applicable statutory provisions and regulations.

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

Exhibit 2002-A has been executed by Gerber and Patent Owner and it memorializes the oral agreement that previously had not been submitted or disclosed to the Board. Concurrent with the filing of Exhibit 2002-A, Gerber and Patent Owner certified that there are no other agreements regarding the termination of Gerber from these CBM proceedings and no other agreements between Gerber and Patent Owner regarding the patentability of the patents at issue in these proceedings. *Id.*

Based on the facts before us, we grant the Joint Motions and terminate CBM2015-00134, CBM2015-00135, CBM2015-00136, and CBM2015-00140 with respect to AAA and we terminate CBM2015-00134, CBM2015-00135, CBM2015-00136, CBM2015-00137, CBM2015-00138, CBM2015-00139, and CBM2015-00140 with respect to Gerber. 37 C.F.R. § 42.74. We also grant the Joint Requests to maintain Exhibit 2011 and Exhibit 2002-A as business confidential in accordance with 37 C.F.R. § 42.74(c).

## ORDER

Accordingly, it is:

ORDERED that the Joint Motions to Terminate with respect to AAA are *granted*;

FURTHER ORDERED that the Joint Motions to Terminate with respect to the Gerber are *granted*; and

FURTHER ORDERED that the parties' joint requests that the agreements submitted in support of the Joint Motions (Exs. 2001, 2002-A) be treated as business confidential information, to be kept separate from the files 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;

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

7,860,744 B2; or 5,987,434, and made available only under the provisions of  
35 U.S.C. § 327(b) and 37 C.F.R. § 42.74(c), are *granted*.

PETITIONER

Walter Renner  
Roberto Devoto  
Matthew M. Jakubowski  
FISH & RICHARDSON P.C.  
[axf@fr.com](mailto:axf@fr.com)  
[CBM38784-0006CP1@fr.com](mailto:CBM38784-0006CP1@fr.com)  
[CBM38784-0012CP1@fr.com](mailto:CBM38784-0012CP1@fr.com)  
[CBM38784-0003CP1@fr.com](mailto:CBM38784-0003CP1@fr.com)  
[CBM38784-0005CP1@fr.com](mailto:CBM38784-0005CP1@fr.com)  
[CBM38784-0010CP1@fr.com](mailto:CBM38784-0010CP1@fr.com)  
[CBM38784-0004CP1@fr.com](mailto:CBM38784-0004CP1@fr.com)  
[CBM38784-0002CP1@fr.com](mailto:CBM38784-0002CP1@fr.com)

PATENT OWNER:

Shawn Diedtrich  
PRUDENS LAW LLC  
[shawn@prudenslaw.com](mailto:shawn@prudenslaw.com)

Louis J. Hoffman  
LOUIS J. HOFFMAN, P.C.  
[louis@valuablepatents.com](mailto:louis@valuablepatents.com)

John J. Love  
TUMEY L.L.P.  
[jlove@tumeyllp.com](mailto:jlove@tumeyllp.com)