

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ACXIOM CORPORATION, and
ADVANCE AMERICA, CASH ADVANCE CENTERS, INC.,
Petitioner,

v.

PHOENIX LICENSING, LLC,
Patent Owner.

Case CBM2015-00180
Patent 8,352,317 B2

Before BARRY L. GROSSMAN, STACEY G. WHITE, and
PETER P. CHEN, *Administrative Patent Judges*.

GROSSMAN, *Administrative Patent Judge*.

TERMINATION OF PETITIONER
ADVANCE AMERICA, CASH ADVANCE CENTERS, INC.

Conduct of the Proceedings
37 C.F.R. § 42.74

Pursuant to authorization by the Board in an e-mail sent December 29, 2015, Patent Owner and Petitioner Advance America, Cash Advance Centers, Inc. (“Advance America”) filed a joint motion requesting termination of this proceeding with respect to Advance America. Paper 14 (“Joint Motion”).¹ Also before us is a joint request by Patent Owner and Advance America to treat as confidential the submitted settlement agreement (Ex. 2011) on which the requested termination is based. Paper 15 (“Joint Request”).²

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. This matter is in its preliminary stage. A Patent Owner Preliminary Response was filed on December 30, 2015 (Paper 16), the same day as the Joint Motion and the Joint Request. A decision whether to institute a trial has not been issued. Thus, this proceeding with respect to Advance America is at a stage eligible for termination.

¹ The Petition refers to Petitioner “Advance America, Cash Advance Centers, Inc. (‘Advance America’).” Pet.1. Advance America is identified in the Petition as a real party-in-interest. *Id.* at 4. The Motion refers to “Advance America *and* Cash Advance Centers, Inc. (‘AA Entities’).” Joint Motion 1 (emphasis added). The Joint Motion suggests that Cash Advance Centers, Inc. is a Petitioner separate and distinct from Advance America, which is inconsistent with the Petition. It is also inconsistent with the Settlement Agreement, which is with “Advance America, Cash Advance Centers, Inc. (‘Advance America’).” Ex. 2011, 1. We consider the Motion to be on behalf of the party identified in the Petition and the Settlement Agreement, which is Advance America.

² The Joint Request refers to “Advance America *and* Cash Advance Centers, Inc. (‘AA’).” Joint Request 1 (emphasis added). Based on the analysis above, we consider the Joint Request to be on behalf of the party identified in the Petition and the Settlement Agreement, which is Advance America.

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. In the Joint Motion, Patent Owner and Advance America certify that they reached an agreement resolving the dispute identified in the Petition (Joint Motion 1), and that the entire agreement between Advance America and Patent Owner related to termination of Advance America from CBM2015-00180 is memorialized in Ex. 2011 filed in this proceeding (*id.* at 1–2).

Based on the facts in the case before us, we grant the Joint Motion and terminate this proceeding with respect to Advance America. 37 C.F.R. § 42.74. We also grant the Joint Request to maintain Exhibit 2011 as business confidential in accordance with 37 C.F.R. § 42.74(c).

ORDER

Accordingly, it is:

ORDERED that the Joint Motion to Terminate the proceeding with respect to Advance America is *granted*; and

FURTHER ORDERED that the Joint Request that the agreement (Ex. 2011) submitted in support of the Joint Motion be treated as business confidential information, to be kept separate from the file of U.S. Patent No. 8,352,317, and made available only under the provisions of 35 U.S.C. § 327(b) and 37 C.F.R. § 42.74(c), is *granted*.

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