

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

ACXIOM CORPORATION,  
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*.

DECISION  
Denying Institution of *Inter Partes* Review  
*37 C.F.R. § 42.108*

DISH Network Corporation, DISH Network L.L.C. (collectively “the Dish Entities”), Advance America, Cash Advance Centers, Inc. (“Advance America”), and Acxiom Corporation filed a Corrected Petition (Paper 9, “Pet.”) to institute a covered business method review of claims 1, 9, 16, 18–25, 34, 49–52, and 57 (“the challenged claims”) of U.S. Patent No. 8,352,317 B2 (Ex. 1001, “the ’317 patent”). We granted a Joint Motion to Terminate this proceeding with respect to the Dish Entities (Paper 13). We also granted a Joint Motion to Terminate this proceeding with respect to Advance America (Paper 17). Thus, Acxiom Corporation (“Petitioner” or “Acxiom”) is the sole remaining Petitioner. Phoenix Licensing, LLC (“Patent Owner”) filed a Preliminary Response (Paper 16, “Prelim. Resp.”). We have jurisdiction under 35 U.S.C. § 324. *See* Section 18(a)(1) of the Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284, 329 (2011) (“AIA”) (“[t]he transitional proceeding implemented pursuant to this subsection shall be regarded as, and shall employ the standards and procedures of, a post-grant review under chapter 32 of title 35, United States Code,” subject to exceptions).

Upon consideration of the Petition and Preliminary Response, we determine that Acxiom does not have standing to file a Petition for a covered business method review of the ’317 patent under § 18(a)(1)(B) of the AIA and 37 C.F.R. § 42.302. Accordingly, we deny institution of a covered business method patent review of the challenged claims of the ’317 patent.

#### *A. Related Proceedings*

Petitioner and Patent Owner state the ’317 patent has been asserted in a substantial number of district court proceedings. Pet. 5; Paper 7, 1–3.

We denied for lack of standing a previous Petition by Acxiom and other petitioners seeking a covered business method review of the ’317 patent. *Acxiom*

*Corp. v. Phoenix Licensing, LLC*, Case CBM2015-00068 (PTAB Aug. 11, 2015) (Paper 23), *reh'g. denied* (PTAB Oct. 29, 2015) (Paper 26) (“*Acxiom I*”).

The parties also identify a substantial number of reexamination and covered business method proceedings within the Patent and Trademark Office for patents that are asserted to be related to the '317 patent. Pet. 5; Paper 7, 1–2. In each of cases CBM2015-00134 through 00140, directed to patents related to the '317 patent, and based on facts similar to those now before us, the petitions were denied based on lack of standing.

## II. ANALYSIS

### A. *Standing for Covered Business Method Patent Review*

The parties disagree as to whether Petitioner has standing to file a petition for a covered business method review of the '317 patent. *See* Pet. 20–23; Prelim. Resp. 9–19.

Standing to file a covered business method patent review is a threshold issue. Under § 18(a)(1)(B) of the AIA,

A person may not file a petition for a transitional proceeding with respect to a covered business method patent unless the person or the person's real party in interest or privy has been sued for infringement of the patent or has been charged with infringement under that patent.

*See also* 37 C.F.R. §§ 42.206, 42.302(a), 42.304(a) (trial rules on standing in a covered business method review). A petition for covered business method review must set forth the petitioner's grounds for standing. 37 C.F.R. § 42.304(a). Rule 42.304(a) states that it is Petitioner's burden to “demonstrate that the patent for which review is sought is a covered business method patent, and that the petitioner meets the eligibility requirements of § 42.302.” *Id.*

As explained in comments to the Final Rules governing covered business method patent review,

To establish standing, a petitioner, at a minimum, would be required to certify with explanation that the patent is a covered business method patent and that the petitioner meets the eligibility requirements of § 42.302. This requirement is to ensure that a party has standing to file the covered business method patent review and would help prevent spuriously instituted reviews. Facially improper standing is a basis for denying the petition without proceeding to the merits of the decision.

*Changes to Implement Inter Partes Review Proceedings, Post-Grant Review Proceedings, and Transitional Program for Covered Business Method Patents*, 77 Fed. Reg. 48,680, 48,709 (Aug. 14, 2012) (Response to Comment 102).

Consequently, the petition must show that the petitioner meets the requirements of 37 C.F.R. § 42.302, and such “[a] showing can only be made through sufficient proof.” *Id.* (Response to Comment 106). *Acxiom 1*, CBM2015-00068 (Paper 23, 3), *reh’g. denied* (Paper 26); *Global Tel\*Link Corp. v. Securus Technologies., Inc.*, Case CBM2014-00166, (PTAB Feb. 6, 2015) (Paper 17).

For the reasons discussed below, we conclude that the Petition fails to show sufficient proof of Acxiom’s standing to file the request for a covered business method review.

### *1. Petitioners as a “Single Legal Entity”*

The Petition asserts that “the Petitioner” is a “single legal entity consisting of” Acxiom, the Dish Entities, and Advance America. Pet. 1. Based on this assertion, Acxiom states that, at the time of filing the Petition, the “single legal entity” had been sued for infringement of the ’317 patent. *Id.* at 20–21 (citing Ex. 1803 and Ex. 1816). Exhibit 1803 is a complaint for patent infringement, filed July 30, 2015, asserting that Advance America infringes the ’317 patent.

Ex. 1803, 1, 16. Exhibit 1816 is a complaint for patent infringement, filed October 17, 2014, asserting that the Dish Entities infringe the '317 patent. Ex. 1816, 1, 5.

Acxiom has not asserted that it has been sued for infringement of the '317 patent, nor has Acxiom directed us to any evidence that it has been sued for infringing the '317 patent. Patent Owner states that it “has not sued Acxiom.” Prelim. Resp. 1.

In *Acxiom I*, we rejected the argument that multiple petitioners are treated as a “single legal entity” for purposes of standing to file a CBM petition. *Acxiom I*, CBM2015-00068 (Paper 23), *reh'g. denied* (Paper 26, 6). We held that “*each petitioner must have standing at time of filing*, and if instituted, the case will proceed procedurally with the multiple petitioners treated as a single entity.” *Id.* (emphasis added). In the case before us, Acxiom has not demonstrated that *it* was sued for infringement of the '317 patent or has been charged with infringement under the '317 patent. Thus, Acxiom does not have standing to file a CBM petition in this case on the basis that it has been sued.

## 2. *Suits Against Privies*

The fact that Acxiom itself has not been sued for infringement, or charged with infringement, does not preclude Acxiom from filing a CBM petition. The statute provides other grounds to establish standing. As explained in *Acxiom I*, Acxiom may acquire standing if a party sued for, or charged with, infringement is Acxiom's real party-in-interest; or if the party sued for, or charged with, infringement is a privy of Acxiom. *Acxiom I*, CBM2015-00068 (Paper 23, 5), *reh'g. denied* (Paper 26) (citing 37 C.F.R. § 42.302(a)).

Acxiom asserts standing because “several of Acxiom's customer[s] have been sued for infringement of the '317 Patent at the time of filing of this petition based on their use of Acxiom's software and services.” Pet. 21–22. Acxiom also

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.