

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ACXIOM CORPORATION, TIAA-CREF LIFE INSURANCE
COMPANY, and
TEACHERS INSURANCE AND ANNUITY ASSOCIATION
OF AMERICA,
Petitioner,
v.

PHOENIX LICENSING, LLC,
Patent Owner.

Cases CBM2016-00055 (Patent 5,987,434)
CBM2016-00057 (Patent 8,352,317 B2)
CBM2016-00058 (Patent 8,738,435 B2)
CBM2016-00059 (Patent 8,606,632 B2)
CBM2016-00067 (Patent 7,890,366 B2)
CBM2016-00069 (Patent 7,856,375 B2)
CBM2016-00084 (Patent 6,999,938 B1)
CBM2016-00085 (Patent 8,234,184 B2)¹

Before JUSTIN T. ARBES, FRANCES L. IPPOLITO, and ROBERT J.
WEINSCHENK, *Administrative Patent Judges*.

IPPOLITO, *Administrative Patent Judge*.

DECISION
Termination of the Proceedings
35 U.S.C. § 327 and 37 C.F.R. § 42.72

¹ This Decision addresses an issue that is identical in all eight cases. Therefore, we exercise discretion to issue one Decision to be filed in each of the eight cases. The parties, however, are not authorized to use this style heading in subsequent papers.

CBM2016-00055 (Patent 5,987,434)
CBM2016-00057 (Patent 8,352,317 B2)
CBM2016-00058 (Patent 8,738,435 B2)
CBM2016-00059 (Patent 8,606,632 B2)
CBM2016-00067 (Patent 7,890,366 B2)
CBM2016-00069 (Patent 7,856,375 B1)
CBM2016-00084 (Patent 6,999,938 B1)
CBM2016-00085 (Patent 8,234,184 B2)

On October 18, 2016, the parties filed a Joint Motion to Terminate the Proceeding in each of the eight identified proceedings. CBM2016-00055, Paper 9 (“Mot.”); CBM2016-00057, Paper 9, CBM2016-00058, Paper 9, CBM2016-00059, Paper 9; CBM2016-00067, Paper 9; CBM2016-00069, Paper 9; CBM2016-00084, Paper 9; CBM2016-00085, Paper 10. With the joint motion, the parties filed a true copy of their written settlement covering the challenged patent in each of the proceedings. The settlement has been filed as Exhibit 2001 in all eight proceedings. The parties have also filed a joint request to have their settlement agreement treated as confidential business information under 35 U.S.C. § 327(b) and 37 C.F.R. § 42.74(c) and, further, designated as “Parties and Board Only.” CBM2016-00055, Paper 10; CBM2016-00057, Paper 10, CBM2016-00058, Paper 10, CBM2016-00059, Paper 10; CBM2016-00067, Paper 10; CBM2016-00069, Paper 10; CBM2016-00084, Paper 10; CBM2016-00085, Paper 11.

Each of these proceedings is still in the preliminary stages. Patent Owner has filed its Preliminary Responses (*see, e.g.*, CBM2016-00055, Paper 8) in each proceeding; however, we have not yet determined whether to institute a covered business method patent review in any of the proceedings. Further, the parties represent that the settlement agreement is “the only agreement between Patent Owner and Petitioner regarding [these] proceeding[s],” and that “[i]n addition to settling this proceeding, the settlement agreement also settles related PTAB proceedings, CBM2016-

CBM2016-00055 (Patent 5,987,434)
CBM2016-00057 (Patent 8,352,317 B2)
CBM2016-00058 (Patent 8,738,435 B2)
CBM2016-00059 (Patent 8,606,632 B2)
CBM2016-00067 (Patent 7,890,366 B2)
CBM2016-00069 (Patent 7,856,375 B1)
CBM2016-00084 (Patent 6,999,938 B1)
CBM2016-00085 (Patent 8,234,184 B2)

00057, 00058, 00059, 00067, 00069, 00084, and 00085 and related litigation *Phoenix Licensing, L.L.C. et al. v. TIAA-CREF Life Insurance Co.*, No.

2:15-cv-01379 (E.D. Tex. July 30, 2015).” Mot. 2, 4. Under the circumstances, the Board determines that it is appropriate to terminate the proceedings without rendering a final written decision. See 37 C.F.R. § 42.72.

Accordingly, it is

ORDERED that the joint motions to terminate each of the eight identified proceedings are *granted*;

FURTHER ORDERED that each of the eight identified proceedings is *terminated*; and

FURTHER ORDERED that the settlement agreement (submitted as Exhibit 2001 in each of the eight proceedings) be treated as business confidential information, kept separate from the file of U.S. Patent Nos. 5,987,434; 8,352,317 B2; 8,738,435 B2; 8,606,632 B2; 7,890,366 B2; 7,856,375 B1; 6,999,938 B1; and 8,234,184 B2, respectively, and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, under the provisions 37 C.F.R. § 42.74(c).

CBM2016-00055 (Patent 5,987,434)
CBM2016-00057 (Patent 8,352,317 B2)
CBM2016-00058 (Patent 8,738,435 B2)
CBM2016-00059 (Patent 8,606,632 B2)
CBM2016-00067 (Patent 7,890,366 B2)
CBM2016-00069 (Patent 7,856,375 B1)
CBM2016-00084 (Patent 6,999,938 B1)
CBM2016-00085 (Patent 8,234,184 B2)

PETITIONER:

Walter Renner
Roberto Devoto
FISH & RICHARDSON P.C.
CBM38784-0010CP2@fr.com
PTABInbound@fr.com

PATENT OWNER:

Shawn Diedtrich
PRUDENS LAW LLC
shawn@prudenslaw.com

Louis Hoffman
LOUIS J. HOFFMAN, P.C.
louis@valuablepatents.com

John Love
TUMEY L.L.P.
jlove@tumeyllp.com