Trials@uspto.gov
571-272-7822

Paper 20
Entered: November 19, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAP AMERICA INC.,
Petitioner,

v.

CLOUDING IP, LLC,
Patent Owner.

Case IPR2014-00308
Patent 5,825,891

Before JAMESON LEE, JUSTIN BUSCH, and KRISTINA M. KALAN, *Administrative Patent Judges*.

KALAN, *Administrative Patent Judge*.

JUDGMENT
Termination of the Proceeding
*37 C.F.R. § 42.72*

The parties have requested that the above-captioned proceeding be terminated pursuant to a settlement. In a conference call among the Board and the parties on November 7, 2014, the Board authorized the parties to file a joint request to terminate the above-captioned proceeding.

On November 12, 2014, and pursuant to 35 U.S.C. § 317, the parties filed a joint motion to terminate the above-captioned proceeding (Paper 17), along with a copy of the release agreement (Ex. 2003). The parties concurrently filed a joint request to file the release agreement as business confidential information, to be kept separate from the patent file pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 18).

Under 35 U.S.C. § 317(a), "[a]n inter partes review instituted under this chapter 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." The requirement for terminating review with respect to Petitioner is met.

Under 35 U.S.C. § 317(a), "[if] no petitioner remains in the inter partes review, the Office may terminate the review or proceed to a final written decision under section 318(a)." SAP America is the sole petitioner in this review. The Board has discretion to terminate this review with respect to Clouding IP as Patent Owner.

The joint motion to terminate indicates that the parties have settled their dispute, have reached agreement to terminate this proceeding, and have memorialized the parties' agreement with respect to termination of the underlying litigation involving the '891 patent in a release agreement. Paper 17, 1; Ex. 2003. The release agreement identifies the "Licensor Litigation" as *Clouding IP, LLC v.*

*SAP AG, et al.*, 13-cv-01456-LPS (D. Del) and *Clouding Corp. v. SAP AG, et al.*, 14-cv-01182-LPS (D. Del). Ex. 2003, 2.

Petitioner filed a Petition on December 27, 2013, and Patent Owner filed a Preliminary Response to the petition on April 14, 2014. The Board instituted *inter partes* review on July 10, 2014. Patent Owner filed a Patent Owner Response on September 10, 2014, but Petitioner has not yet filed a Reply. This proceeding has not resulted in a final decision on the merits.

Based on the facts of the case, it is appropriate to terminate the proceeding as to both Petitioner and Patent Owner. Therefore, the joint motion to terminate and the joint motion to file the release agreement as business confidential information are *granted*.

Accordingly, it is

ORDERED that the joint motion to file the release agreement as business confidential information, to be kept separate from the patent file, is *granted*;

FURTHER ORDERED that the joint motion to terminate the proceeding is *granted*;

FURTHER ORDERED that the proceeding is *terminated*.

For PETITIONER:

Frank C. Cimino, Jr.
Megan S. Woodworth
S. Gregory Herrman
DICKSTEIN SHAPIRO LLP
CiminoF@dicksteinshapiro.com
WoodworthM@dicksteinshapiro.com
HerrmanG@dicksteinshapiro.com

For PATENT OWNER

Tarek N. Fahmi
Amy Embert
ASCENDA LAW GROUP, PC
tarek.fahmi@ascendalaw.com
amy.embert@ascendalaw.com