

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Oracle Corporation,
Petitioner

v.

Peter Pedersen,
Patent Owner

Case No. IPR2023-00867
Patent No. 6,965,920

JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.71(a), Petitioner Oracle Corporation (“Petitioner”) and Patent Owner Peter Henrik Pedersen (“Patent Owner”) (collectively, the “Parties”) jointly request termination of this *inter partes* review of U.S. Patent 6,965,920 (“the ’920 patent”), case no. IPR2023-00867.

The Parties note that the Decision on Institution is pending, and this Joint Motion is filed in accordance with the Board’s email of September 27, 2023, and prior to the statutory deadline for a decision on institution.

I. Background

On April 24, 2023, Petitioner filed a petition for *inter partes* review, challenging the ’920 patent. On August 23, 2023, Patent Owner filed its Preliminary Response, meaning that the Board’s deadline to issue a decision on institution is November 23, 2023.

The Parties have entered into an agreement (the “Agreement”) that fully resolves their dispute concerning the ’920 Patent. As a result of the Agreement, Patent Owner’s claims against Petitioner in the following related lawsuit have been dismissed with prejudice: *Peter Pedersen v. Oracle Corporation*, Case No. 1:23-cv-01020 (W.D. Tex. 2022) (transferred from Case No. 6:22-cv-00410 (W.D. Tex. 2022)). The Parties have also agreed to jointly request termination of the present *inter partes* review.

The Parties are concurrently filing a copy of the confidential Agreement as Ex. 2003 along with a request to treat it as confidential business information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Ex. 2003 is being filed as “Board and Parties Only.”

Pursuant to 37 C.F.R. § 42.74(b), there are no other collateral agreements or understandings, oral or written, between the parties made in connection with, or in contemplation of, the termination of the present proceeding, and Ex. 2003 represents a true and accurate copy of the agreement between the Parties that resolves the present proceeding.

II. Termination is Appropriate

The Parties respectfully submit that termination is appropriate. The relevant statutory provision on termination provides that an *inter partes* review “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.” 35 U.S.C. § 317(a).

Termination is appropriate as the Board has not yet “decided the merits of the proceeding.” Consolidated Trial Practice Guide, at 86. Petitioner filed its petition for *inter partes* review on April 24, 2023. Patent Owner filed a preliminary response on August 23, 2023. The proceeding is in its early stages; trial has not been instituted.

Termination further promotes the Congressional goal of establishing a more

efficient patent system by limiting unnecessary and counterproductive costs. *See* Changes to Implement Inter Partes Review Proceedings, Post-Grant Review Proceedings, and Transitional Program for Covered Business Method Patents, 77 Fed. Reg. 48,680 (Aug. 14, 2012). Permitting termination as to all parties provides certainty and fosters an environment that promotes settlements, creating a timely, cost-effective alternative to litigation.

As noted above, the Parties have reached an Agreement that fully resolves their dispute concerning the '920 patent, including the district court litigation and requesting termination of this *inter partes* review. The Board will conserve resources if it terminates this *inter partes* review now because termination will obviate the need for further proceedings such as an institution decision, briefing, depositions, and a hearing. Accordingly, under 35 U.S.C. § 317(a), the Parties respectfully submit that the proceeding should be terminated upon this joint request.

Additionally, the Parties respectfully submit that the concurrent request to treat the Parties' Agreement as confidential business information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) should be granted.

Respectfully submitted,

Date: September 27, 2023

/Patrick Colsher/

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Jacob B. Henry
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PATENT OWNER'S EXHIBIT LIST

Ex. 2001	Scheyer Declaration
Ex. 2002	Scheyer CV
Ex. 2003	[<i>Confidential</i>] Agreement

CERTIFICATE OF SERVICE

The undersigned certifies that, in accordance with 37 C.F.R. § 42.6(e) and 37 C.F.R. § 42.105, service was made on Petitioner as detailed below.

Date of service September 27, 2023

Manner of service Electronic mail

Documents served Joint Motion to Terminate the *Inter Partes* Review
Joint Request that the Parties' Agreement be Treated as
Business Confidential Information and be Kept Separate
under 35 U.S.C. § 317(b)
Patent Owner's Updated Exhibit List
Exhibit 2003

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