

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ORACLE CORPORATION,

Petitioner,

v.

COMPETITIVE ACCESS SYSTEMS, INC.,

Patent Owner.

IPR2023-00880

U.S. Patent No. 9,350,649

**JOINT MOTION TO TERMINATE PURSUANT
TO 35 U.S.C. § 317 AND 37 C.F.R. § 42.74**

**JOINT MOTION TO DISMISS PURSUANT
TO 37 C.F.R. § 42.71(a)**

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, Petitioner Oracle Corporation and Patent Owner Competitive Access Systems, Inc. jointly request termination of this inter partes review. This proceeding is at an early stage, and the Board has not yet instituted *inter partes* review. In accordance with 37 C.F.R. § 42.20(b), the parties received authorization from the Board to file this motion on October 23, 2023.

The parties have settled with respect to the challenged patent and have reached agreement to terminate this IPR. Termination of this proceeding is proper for several reasons.

First, this a joint request by parties that have settled their dispute. 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012) (“There are strong public policy reasons to favor settlement between the parties to a proceeding.”). Both Congress and the federal courts have expressed a strong interest in encouraging settlement in litigation. *See, e.g., Delta Air Lines, Inc. v. August*, 450 U.S. 346, 352 (1981) (“The purpose of [Fed. R. Civ. P.] 68 is to encourage the settlement of litigation.”); *Bergh v. Dept. of Transp.*, 794 F.2d 1575, 1577 (Fed. Cir. 1986) (“The law favors settlement of cases.”). The Federal Circuit places a particularly strong emphasis on settlement. *See Cheyenne River Sioux Tribe v. U.S.*, 806 F.2d 1046, 1050 (Fed. Cir. 1986) (noting that the law favors settlement to reduce antagonism and hostility

between parties). Here, no public interest or other factors weigh against termination of this proceeding.

Second, the Board has not yet “decided the merits of the proceeding before the request for termination is filed.” 35 U.S.C. § 317(a); 77 Fed. Reg. 48768 (“The Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding.”) Indeed, the Board has not yet made a decision on institution of this inter partes review. Petitioner filed its petition for inter partes review on May 8, 2023. No motions are outstanding in this proceeding. No other party’s rights will be prejudiced by the termination of this inter partes review. This supports the propriety of terminating this proceeding even though the settlement and termination provisions of 35 U.S.C. § 317, on their face, apply only to “instituted” proceedings. 77 Fed. Reg. 48680, 48686 (Aug. 14, 2012) (§ 317(a) provides that “[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.”). Indeed, the Board has terminated entire IPR proceedings based on joint motions to terminate before institution. *See Samsonite, LLC v. Otter Prods., LLC*, IPR2015-00507, Paper 13, at 2 (PTAB July 31, 2015) (granting motion to terminate pre-institution).

Third, the parties have filed a stipulation dismissing the parallel district court action with prejudice. *Competitive Access Systems, Inc. v. Oracle Corp.*, Case No. 1:23-cv-00286 (W.D. Tex.) (October 20, 2023) (ECF No. 86). The parties are unaware of any other IPR that is challenging the '649 patent.

As required by 35 U.S.C. § 317 and 37 C.F.R. § 42.74, the written agreement that contemplates the termination of this proceeding has been filed with this motion as Exhibit 1030, along with a separate request that the written agreement be kept separate as business confidential information. The parties certify that there are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of the proceeding.

Alternatively, Petitioner and Patent Owner jointly request dismissal of this inter partes review pursuant to 37 C.F.R. § 42.71(a). *See Ecobee, Inc. v. Lime Green Lighting, LLC*, IPR2019-00315, Paper 9 at 2-3 (PTAB March 19, 2019) (treating joint motion under 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74 as a motion to dismiss under 37 C.F.R. § 42.71(a) and granting motion to dismiss pre-institution). Dismissal under 37 C.F.R. § 42.71(a) is appropriate because the Board has not yet issued a decision whether to institute an *inter partes* review. This proceeding is still in a preliminary stage, the Board has not yet instituted *inter partes* review, and the parties are jointly requesting dismissal. Dismissal is warranted under these circumstances. *See* 37 C.F.R. § 42.71(a) (authorizing the

Board to dismiss a petition), *Sony Corp. v. Avago Tech's Gen. IP (Singapore) Pte. Ltd.*, IPR2017-00520, Paper 10 at 2-3 (PTAB June 22, 2017) (granting joint motion to dismiss pre-institution).

Date: October 24, 2023

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on October 24, 2023 a complete copy of the foregoing Joint Motion to Terminate was served via email to the attorneys of record for the Patent Owner as follows:

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Date: October 24, 2023

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