

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
Patent 9,350,649 B2

Before BARBARA A. PARVIS, STEVEN M. AMUNDSON, and
JASON M. REPKO, *Administrative Patent Judges*.

PARVIS, *Administrative Patent Judge*.

DECISION

Settlement Prior to Institution of Trial

Granting-In-Part and Denying-In-Part Joint Request to Treat Settlement

Agreement as Business Confidential Information

37 C.F.R. § 42.74

I. INTRODUCTION

On October 24, 2023, with the Board’s authorization, Petitioner Oracle Corporation and Patent Owner Competitive Access Systems, Inc. (collectively referred to as “the Parties”) filed a Joint Motion to Terminate or Dismiss the above-identified proceeding due to settlement. Paper 10 (“Joint Motion”). In support of the Joint Motion, the Parties filed a Settlement Agreement (Ex. 1030 (“Settlement Agreement”)), as well as a Joint Request to Keep Separate the Settlement Agreement pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 9 (“Joint Request”)).

II. DISCUSSION

In the Joint Motion, the Parties represent that they “have settled with respect to the challenged patent and have reached agreement to terminate this IPR.” Paper 10, 2. The Parties further represent that they “have filed a stipulation dismissing the parallel district court action with prejudice.” *Id.* at 4 (citing *Competitive Access Systems, Inc. v. Oracle Corp.*, No. 1:23-cv-00286 (W.D. Tex.) (October 20, 2023) (ECF No. 86)). The Parties also represent that they “are unaware of any other IPR that is challenging” the above-identified patent at issue. *Id.* The Parties represent that “the written agreement that contemplates the termination of this proceeding has been filed with this motion as Exhibit 1030,”¹ and “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.” *Id.*

This proceeding is at an early stage, and we have not yet decided whether to institute a trial in the proceeding. In view of the early stage of

¹ The Parties state that Ex. 1030 is “a true copy of the parties’ written agreement that contemplates the termination of this proceeding.” Paper 9, 2.

the proceeding and the settlement between the Parties, we determine that good cause exists to terminate the proceeding with respect to the Parties.

The Parties also filed a Joint Request that the Settlement Agreement be treated as business confidential information and be kept separate from the file of the patent involved in this *inter partes* proceeding. Paper 9, 2. After reviewing the Settlement Agreement between Petitioner and Patent Owner, we find that the Settlement Agreement contains confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Settlement Agreement between Petitioner and Patent Owner as business confidential information, to keep it separate from the file of the involved patent, and to limit its availability pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

In the Joint Request, the parties “jointly request that the Board order that in the event a person or entity makes a written request, as stated in 37 C.F.R. § 42.74(c)(1)-(2), for access to the settlement agreement, that any such written request be served upon the parties on the day the written request is provided to the Board.” Paper 9, 1. Our rules do not provide for any written request to the parties, and the parties have provided no basis for doing so. Thus, we deny this part of the parties’ request.

This Order does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

III. ORDER

Accordingly, for the reasons discussed above, it is:

ORDERED that the Joint Motion to Terminate (Paper 10) is *granted*;

FURTHER ORDERED that the Petition (Paper 2) is *dismissed*;

FURTHER ORDERED that IPR2023-00880 is *terminated*; and

FURTHER ORDERED that the Joint Request to Keep Separate

(Paper 9) is *granted-in-part* and *denied-in-part*, and the Settlement Agreement shall be kept separate from the file of Patent 9,350,649 B2 and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), but no written request will be served upon the parties.

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