

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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**ORACLE CORPORATION**  
Petitioner,

v.

**COMMUNITY UNITED IP, LLC**  
Patent Owner.

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Case CBM2013-00015 (JL)  
Patent 5,862,223

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Before JAMESON LEE, and JONI Y. CHANG, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

**ORDER**  
Conduct of the Proceeding  
*37 C.F.R. § 42.5*

On July 15, 2013, a telephone conference call was held between respective counsel for the parties and Judges Lee and Chang. The parties sought authorization to file a joint motion to terminate this proceeding, on the basis that the parties have settled.

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement. *See, e.g., Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012).* The rule governing settlement indicates that any agreement between the parties made in connection with, or in contemplation of, the termination of a proceeding shall be in writing and filed with the Board. 37 C.F.R. § 42.74.

During the conference call, the parties sought guidance as to the procedure for filing their settlement agreement and to have the settlement agreement be treated as business confidential information under 37 C.F.R. § 42.74(c).

The Board indicated that filing of a joint motion to terminate this proceeding is authorized. The joint motion must (1) include an explanation as to why termination is appropriate, (2) identify all codefendants in any related district court litigation in which infringement or invalidity of the claims of Patent 5,862,223 has been alleged, and (3) specifically discuss the current status of each such related litigation with respect to each party to that litigation. Furthermore, the joint motion should indicate whether, and to what extent, each party will continue to participate in this proceeding, if the joint motion to terminate is not granted.

The joint motion to terminate must be accompanied by **a true copy** of the settlement agreement in connection with the termination of that proceeding, as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b). A redacted version of the settlement agreement is not a true copy of the settlement agreement.

With respect to having the settlement agreement treated as business confidential information under 37 C.F.R. § 42.74(c), the Board noted that the parties must file the confidential settlement agreement electronically via the Patent Review Processing System (PRPS) in accordance with the instructions provided on the Board's website (uploading as "Parties and Board Only"). The parties are

herein directed to FAQ G2 on the Board's website page at <http://www.uspto.gov/ip/boards/bpai/prps.jsp> for instructions on how to file their settlement agreement as confidential.

Accordingly, it is:

**ORDERED** that the parties are authorized to file a joint motion to terminate this proceeding on the basis that the parties have settled;

**FURTHER ORDERED** that the joint motion is due July 23, 2013;

**FURTHER ORDERED** that the joint motion must be accompanied by a true copy, labeled as an exhibit, of the settlement agreement as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b);

**FURTHER ORDERED** that the parties may file a separate joint motion requesting that the settlement agreement be treated as business confidential information as specified by 37 C.F.R. § 42.74(c); and

**FURTHER ORDERED** that any confidential settlement agreement must be filed electronically via PRPS in accordance with the instructions provided on the Board's website (uploading as "Parties and Board Only").

CBM2013-00015

Patent 5,862,223

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