

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ACXIOM CORPORATION, et al,

Petitioner,

v.

PHOENIX LICENSING, LLC,

Patent Owner.

Case CBM2015-00134 Patent 8,234,184 B2¹
Case CBM2015-00135 Patent 6,999,938 B1
Case CBM2015-00136 Patent 7,856,375 B2
Case CBM2015-00137 Patent 7,890,366 B2
Case CBM2015-00138 Patent 8,738,435 B2
Case CBM2015-00139 Patent 7,860,744 B2
Case CBM2015-00140 Patent 5,987,434

Before STACEY G. WHITE, PETER P. CHEN, ROBERT J. WEINSCHENK, and
ROBERT A. POLLOCK, *Administrative Patent Judges*.

WHITE, *Administrative Patent Judge*.

DECISION

Denying Institution of Covered Business Method Patent Review
37 C.F.R. § 42.208

¹ This order addresses a similar issue in the seven cases. Therefore, we exercise discretion to issue one order to be filed in each case. The parties, however, are not authorized to use this style of heading in subsequent papers.

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I. INTRODUCTION

A. Background

Acxiom Corporation (“Acxiom” or “Petitioner”), along with AAA Life Insurance Company (“AAA”) and/or Gerber Life Insurance Company (“Gerber”), filed a series of Petitions requesting covered business method patent reviews pursuant to § 18 of the Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284, 331 (Sept. 16, 2011) (“AIA”). The cases (“the Petitions”) are summarized in the table below.

| Case | Petitioning Parties | U.S. Patent No. |
|---------------|-------------------------|-----------------|
| CBM2015-00134 | Acxiom, Gerber, and AAA | 8,234,184 B2 |
| CBM2015-00135 | Acxiom, Gerber, and AAA | 6,999,938 B1 |
| CBM2015-00136 | Acxiom, Gerber, and AAA | 7,856,375 B2 |
| CBM2015-00137 | Acxiom and Gerber | 7,890,366 B2 |
| CBM2015-00138 | Acxiom and Gerber | 8,738,435 B2 |
| CBM2015-00139 | Acxiom and Gerber | 7,860,744 B2 |
| CBM2015-00140 | Acxiom, Gerber, and AAA | 5,987,434 |

AAA and Gerber settled with Phoenix Licensing, LLC (“Patent Owner”) and have been terminated from each of the proceedings. Paper 21.² Patent Owner filed a Preliminary Response. Paper 14 (“Prelim. Resp.”). We have jurisdiction under 35 U.S.C. § 324, which provides that a covered business method patent review may not be instituted “unless . . . it is more likely than not that at least 1 of the claims challenged in the petition is unpatentable.”

² For the purposes of this Decision, the Petitions, Preliminary Responses, and supporting documents in the seven cases do not differ in a material way. Thus, for ease of reference, we will refer to the filings in CBM2015-00134.

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Upon consideration of the Petition and Preliminary Response, we determine that Petitioner has not demonstrated that it has standing to file these Petitions for covered business method review under § 18(a)(1)(B) of AIA and 37 C.F.R. § 42.302. Accordingly, we deny institution of a covered business method patent review of the challenged claims of each of the challenged patents.

B. Related Matters

The parties indicate that the subject patents are at issue in more than three dozen district court cases in the United States District Court for the Eastern District of Texas. Paper 4 (“Pet.”), 4; Paper 8 (Patent Owner’s Listing of Related Matters); Paper 9 (Petitioner’s Updated Mandatory Notices).

II. ANALYSIS

A. Grounds for Standing

Section 18 of the AIA created a transitional program, limited to persons or their real parties-in-interest or privies that have been sued or charged with infringement of a “covered business method patent,” which does not include patents for “technological inventions.” AIA §§ 18(a)(1)(B), 18(d)(1); *see* 37 C.F.R. § 42.302. Of key importance in this case is the requirement that “*a person may not file a petition* for a transitional proceeding with respect to a covered business method patent *unless* the person or the person’s real party in interest or privy has been sued for infringement of the patent or has been charged with infringement under that patent.” AIA § 18(a)(1)(B) (emphases added); *see* 37 C.F.R. § 42.302(a). Regarding this requirement, Petitioner does not allege that it has been charged with or sued for infringement, but instead contends that its

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standing arises from its relationship to other entities that have been sued for infringement of the '184 patent.

Specifically, Petitioner argues that it is a real party-in-interest or privy to one or more entities that has been sued for infringement of the subject patent. Pet. 19. Gerber, a party that has settled with the Patent Owner and has been terminated from the proceedings, is cited as an example of such an entity. *Id.* Gerber was sued for infringement of the subject patent. *See* Ex. 1119. We, however, do not find Petitioner's evidence sufficient to show that Gerber is a real party-in-interest or privy of Petitioner.

Petitioner argues that its standing arises from that of its customer, Gerber, because Gerber "sent Acxiom a demand for indemnification of costs and potential liabilities arising from the infringement suit, referencing a Services and Data Agreement between the two companies." Pet. 19. Petitioner provides two pieces of evidence to support its claim for standing, a heavily redacted Services and Data Agreement (the "Agreement," Ex. 1129), and the Declaration of Brian Williamson (Ex. 1128).

The Agreement is approximately a dozen pages, but only two paragraphs are reproduced in unredacted form. The first of these paragraphs indicates that Petitioner contracted with Gerber to provide "services" as "set forth in one or more documents executed by the parties and made subject to this Agreement." Ex. 1129, 1. Petitioner provides no evidence as to what services are contemplated under this Agreement. The second of these paragraphs indicates that there may be indemnity for alleged patent infringement provided that the indemnified party provides a proper written demand for indemnity. *Id.* at 6. If there is a proper demand for indemnity, "the indemnifying party shall have sole control and

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authority with respect to the defense, settlement, or compromise of any such claim.” *Id.* As to the Declaration, Brian Williamson, Senior Account Executive for Acxiom’s Gerber Account, declares that it is his “understanding that Gerber sent Acxiom notice of a demand for indemnification for costs and potential liabilities arising from the [patent infringement suits involving the subject patents] referencing the indemnification provision in the Services and Data Agreement.” Ex. 1128 ¶¶ 2, 6. We do not find this evidence to be sufficient to show that Petitioner has standing to bring this Petition. *See* 37 C.F.R. § 42.304(a) (stating that it is Petitioner’s burden to “demonstrate that the patent for which review is sought is a covered business method patent, and that the petitioner meets the eligibility requirements of § 42.302.”).

As Patent Owner points out, “the Petition does not supply the demand for indemnification, Acxiom’s response, or any correspondence regarding indemnification.” Prelim. Resp. 4; *cf. General Electric Co. v. Transdata, Inc.*, Case IPR2014-01380, slip op. at 7–8 (PTAB Apr. 15, 2015) (Paper 34) (an agreement to indemnify as to a specific lawsuit was sufficient evidence of privity). Similarly, the Williamson Declaration does not provide any details as to the purported demand for indemnity nor does it inform us of Petitioner’s view as to the merits of any such demand for indemnity. Nor does Mr. Williamson testify as to whether the Agreement was in force at the relevant time. Thus, Petitioner has not provided evidence sufficient to show that it has an obligation to indemnify Gerber or any other entity that may have been sued for infringement.³ Also, as discussed

³ AAA also is listed as a real party-in-interest. Pet. 3. Petitioner, however, provides no argument or evidence as to why it believes that AAA is a real party-in-interest of Petitioner. Thus, we have no basis to ascertain whether Petitioner may

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above, Petitioner has not provided evidence sufficient to show what services, if any, Petitioner provides to Gerber. Therefore, Petitioner does not provide us with evidence sufficient to show that Gerber is a real party-in-interest of Petitioner.

Also, the heavily redacted Agreement does not provide us with sufficient evidence regarding the relationship between these entities to show that Gerber is a privy of Petitioner sufficient to support Petitioner's argument for standing. Thus, we do not have sufficient evidence to show that Petitioner has proper standing to bring this Petition. Therefore, we deny Petitioner's request to institute a covered business method review of the challenged claims. *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, 48,709 (Aug. 14, 2012) (Response to Comment 102) (“Facially improper standing is a basis for denying the petition without proceeding to the merits of the decision.”).

B. Motion to Seal

Petitioner filed a Motion to Seal (Paper 5), in which it seeks entry of the Default Protective Order and moves to seal Exhibits 1128 and 1129, as confidential pursuant to the Default Protective Order. Paper 5, 1. These Exhibits, however, are cited extensively in the Decision. Confidential information relied upon in a decision to grant or deny a request to institute ordinarily will be made public. Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,760 (Aug. 14, 2012). We are not persuaded that there is sufficient reason to depart from that principle. Therefore, Petitioner's Motion to Seal is denied. Accordingly, we order Exhibits

base its standing on its relationship with AAA. *See Acxiom Corp. v. Phoenix Licensing, LLC*, Case CBM2015-00068, slip. op at 4–6 (PTAB Aug. 11, 2015) (Paper 23).

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1128 and 1129 to be UNSEALED forty-five (45) days after the entry date of this decision.

III. CONCLUSION

Petitioner has not established that it satisfies the standing requirement for filing a petition for covered business method patent review.

IV. ORDER

For the reasons given, it is:

ORDERED that the Petitions are denied; and

FURTHER ORDERED that no covered business method patent review is instituted; and

FURTHER ORDERED that Petitioner's Motion to Seal is denied; and

FURTHER ORDERED that Exhibits 1128 and 1129 shall be UNSEALED forty-five (45) days after the entry date of this decision.

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