

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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CARDLYTICS, INC.  
Petitioner

v.

TUITIONFUND, LLC  
Patent Owner

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Case CBM2014-00059  
Patent 7,899,704

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Before DEBRA K. STEPHENS, TRENTON A. WARD, and MITCHELL  
G. WEATHERLY *Administrative Patent Judges*.

WARD, *Administrative Patent Judge*.

ORDER  
Joint Motion to Terminate  
37 C.F.R. § 42.72

On April 17, 2014, the parties filed a joint motion to terminate the trial proceedings under 35 U.S.C. § 327(a). Paper 6. Along with the motion, the parties filed a copy of a document they described as the written settlement agreement (Paper 7), as well as a joint request to treat the settlement agreement as business confidential information under the provisions of 35 U.S.C. § 327(b) and 37 C.F.R. § 42.74(c). Paper 6, 2.

Under 35 U.S.C. § 327(a), “[a] post grant review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” The parties stated in their motion that they “have reached a settlement agreement that requires the parties to terminate all current disputes between them.” Paper 6, 2. The joint motion indicates that concurrent with the filing of this Joint Motion to Terminate, the parties filed a motion to dismiss with prejudice the related district court litigation between the parties involving the patents at issue in this proceeding, U.S. Patent No. 7,653,572 and U.S. Patent No. 7,899,704. Paper 6, 2-3. Furthermore, a trial has not been instituted in this proceeding.

The parties are reminded that the Board is not a party to the settlement, and may independently identify any question of patentability. 37 C.F.R. § 42.74(a). Generally, however, 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. 48,756, 48,768 (Aug. 14, 2012). These proceedings are still in the preliminary stages, as the time period for filing the Patent Owner’s Preliminary Response has not yet expired. The Board is persuaded that, under these circumstances, it is

appropriate to terminate this proceeding without rendering a final written decision. 37 C.F.R. § 42.72.

Accordingly, it is:

ORDERED that the joint motion to terminate this proceeding is GRANTED and this proceeding is hereby terminated;

FURTHER ORDERED that the parties' joint request that the settlement agreement (Paper 7) be treated as business confidential information, kept separate from the file of the involved patent, and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, under the provisions of 35 U.S.C. § 327(b) and 37 C.F.R. § 42.74(c), is GRANTED.

CBM2014-00059

Patent 7,899,704

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