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Paper No. 36
Filed: December 3, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DISCOVER FINANCIAL SERVICES, DISCOVER BANK,
DISCOVER PRODUCTS INC., and
STATE FARM MUTUAL AUTOMOBILE INSURANCE COMPANY,
Petitioner,

v.

MAXIM INTEGRATED PRODUCTS, INC.,
Patent Owner.

Case CBM2015-00098
Patent 5,940,510

Before TREVOR M. JEFFERSON, MITCHELL G. WEATHERLY, and KERRY BEGLEY, *Administrative Patent Judges*.

BEGLEY, *Administrative Patent Judge*.

DECISION

Joint Motion to Terminate the Discover Entities' Participation in This Case;
Joint Request to File Settlement Agreement as Business Confidential Information
35 U.S.C. § 327, 37 C.F.R. § 42.74

On November 24, 2015, Petitioners Discover Financial Services, Discover Bank, and Discover Products Inc. (collectively, "Discover") and Patent Owner Maxim Integrated Products, Inc. ("Maxim") filed a joint motion to terminate Discover's participation in this proceeding. Paper 32 ("Mot."). Along with the motion, Discover and Maxim filed what they represent to be a "true and correct" copy of their Settlement Agreement, in accordance with 37 C.F.R. § 42.74(b). Ex. 2007; Mot. 1. The parties also submitted a joint request to file the Settlement Agreement as business confidential information, pursuant to 35 U.S.C. § 327(b). Paper 33. For the reasons set forth below, the Motion and Request are granted.

Under 35 U.S.C. § 327(a), an instituted covered business method patent review "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." 35 U.S.C. § 327(a); *see* Leahy-Smith America Invents Act ("AIA"), Pub. L. No. 112-29, § 18(a)(1), 125 Stat. 284, 329 (2011) (stating that chapter 32 of title 35, United States Code, which governs post-grant reviews, is applicable to covered business method patent reviews with the exception of 35 U.S.C. § 321(c), 35 U.S.C. § 325(b), (e)(2), (f)). We recently instituted trial in this proceeding. Maxim has not filed a Response to the Petition, Petitioner has not filed a Reply, and no oral hearing has been held. As a result, the Board has not yet decided the merits of the proceeding.

Upon consideration of the facts before us, we determine that it is appropriate to terminate this proceeding with respect to Discover. *See* 35 U.S.C. § 327(a); 37 C.F.R. § 42.74(b). We note that termination of Discover's involvement in this proceeding does not terminate the

proceeding, because State Farm Mutual Automobile Insurance Company remains as a petitioner. *See* Mot. 1 n.1.

Turning to the joint request to file the Settlement Agreement as business confidential information, we determine that Discover and Maxim have complied with the requirements of 37 C.F.R. § 42.74(c) to have their Settlement Agreement treated as business confidential information that is kept separate from the files of the patent-at-issue. Accordingly, the Agreement shall be made available only to a government agency on written request to the Board or to any other person upon a showing of good cause and compliance with the other requirements of 37 C.F.R. § 42.74(c)(2).

ORDER

For the foregoing reasons, it is:

ORDERED that the Joint Motion to Terminate the Discover Entities' Participation in this Case Pursuant to 35 U.S.C. § 327 (Paper 32) is *granted*;

FURTHER ORDERED that the proceeding continues with State Farm Mutual Automobile Insurance Company as petitioner;

FURTHER ORDERED that any subsequent papers filed in this case should not include Discover Financial Services, Discover Bank, and Discover Products Inc. in the caption; and

FURTHER ORDERED that the Joint Request to File Settlement Agreement as Business Confidential Information Under 35 U.S.C. § 327(b) (Paper 33) is *granted*.

PETITIONER:

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