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Paper No. 21
Filed: October 20, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMPASS BANK, AMERICAN EXPRESS COMPANY, AMERICAN EXPRESS TRAVEL RELATED SERVICES COMPANY, INC., DISCOVER FINANCIAL SERVICES, DISCOVER BANK, DISCOVER PRODUCTS INC., and STATE FARM MUTUAL AUTOMOBILE INSURANCE COMPANY,,
Petitioner,

v.

MAXIM INTEGRATED PRODUCTS, INC.,
Patent Owner.

Case CBM2015-00102
Patent 6,237,095 B1

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

BEGLEY, *Administrative Patent Judge*.

DECISION
Joint Motion to Terminate Proceeding with Respect to American Express;
Joint Request to File Settlement Agreement as Business Confidential Information
35 U.S.C. § 327, 37 C.F.R. § 42.74

On October 14, 2015, Petitioners American Express Company and American Express Travel Related Services Company (collectively, "American Express") and Patent Owner Maxim Integrated Products, Inc. ("Maxim") filed a joint motion to terminate the proceeding with respect to American Express. Paper 18 ("Mot."). Along with the motion, American Express 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. 1022; Mot. 3. The parties also submitted a joint request to file the Settlement Agreement as business confidential information, pursuant to 37 C.F.R. § 42.74(c). Paper 19. 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, 331 (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 instituted trial in this proceeding less than one month before American Express and Maxim filed the present Motion. 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 American Express. *See* 35 U.S.C. § 327(a); 37 C.F.R. § 42.74(b). We note that termination of

American Express's involvement in this proceeding does not terminate the proceeding, because Compass Bank, Discover Financial Services, Discover Bank, Discover Products Inc., and State Farm Mutual Automobile Insurance Company remain as petitioners. *See* Mot. 2 & n.1.

Turning to the joint request to file the Settlement Agreement as business confidential information, we determine that American Express 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 Motion to Terminate Proceeding with Respect to American Express Company and American Express Travel Related Services Company, Inc. Pursuant to 35 U.S.C. § 327 (Paper 18) is *granted*;

FURTHER ORDERED that the proceeding continues with Compass Bank, Discover Financial Services, Discover Bank, Discover Products Inc., and State Farm Mutual Automobile Insurance Company as petitioners;

FURTHER ORDERED that any subsequent papers filed in this case should not include American Express Company and American Express Travel Related Services Company, Inc. in the caption; and

FURTHER ORDERED that the Request to File Settlement Agreement as Business Confidential Information Under 35 U.S.C. § 327(b) (Paper 19) is *granted*.

CBM2015-00102
Patent 6,237,095 B1

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