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Paper 46
Date: April 7, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INVESTORS EXCHANGE LLC,
Petitioner,

v.

NASDAQ, INC.,
Patent Owner.

CBM2018-00045 (Patent 7,647,264)
CBM2019-00001 (Patent 8,280,797)

Before MEREDITH C. PETRAVICK, JON B. TORNQUIST, and KRISTI L. R. SAWERT, *Administrative Patent Judges.*

PETRAVICK, *Administrative Patent Judge*.

JUDGMENT
Termination of the Proceeding Due to Settlement
35 U.S.C. § 327; 37 C.F.R. §§ 42.72, 42.74

On April 3, 2020, pursuant to our e-mail authorization, the parties filed Joint Motions to Terminate covered business method patent reviews of U.S. Patent No. 7,647,264 ("the '264 patent") and U.S. Patent No. 8,280,797 ("the '797 patent"). Paper 44[1]. With the Joint Motions, the parties filed a

[1] For efficiency, all citations are to CBM2018-00045.

copy of the written Settlement Agreement resolving all disputes between the parties with respect to the ’264 patent and the ’797 patent. Ex. 2026. The parties also filed a Joint Request to treat the Settlement Agreement as business confidential information and to keep separate under 35 U.S.C. § 327(b) and 37 C.F.R. § 42.74(c). Paper 45. The parties represent that the Settlement Agreement is a true copy of the agreement or understanding between the parties made in connection with or in contemplation of termination of these proceedings. Paper 44, 3; Paper 45, 1.

Under 35 U.S.C. § 327(a), a covered business method patent 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.” In these proceedings, we have not yet reached a decision on the merits with respect to the patentability of any involved claim. Accordingly, we terminate these reviews with respect to Petitioner.

Section 327(a) also provide that, “[i]f no petitioner remains . . . , the Office may terminate the review or proceed to a final written decision under section 328(a).” We, therefore, have discretion to terminate this review without issuing a final written decision. “The Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding,” as “[t]here are strong public policy reasons to favor settlement between the parties to a proceeding.” Consolidated Office Patent Trial Practice Guide, 86 (Nov. 2019)[2]. In the Joint Motion, the parties state that they have settled all

[2] Available at https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf

underlying disputes relating to the ’264 patent and the ’797 patent. Paper 44, 1.

Under these circumstances, we determine that it is appropriate to terminate these covered business method patent reviews as to both Petitioner and Patent Owner without rendering Final Written Decisions. *See* 35 U.S.C. § 327(a); 37 C.F.R. § 42.72 (“The Board may terminate a trial without rendering a final written decision, where appropriate”). We also grant the Joint Requests to maintain the Settlement Agreement as confidential business information in accordance with 35 U.S.C. § 327(b) and 37 C.F.R. § 42.74(c).

Accordingly, it is

ORDERED that the Joint Motions to Terminate and Joint Requests to treat the Settlement Agreement as business confidential information are *granted*; and

FURTHER ORDERED that these covered business method patent reviews are hereby *terminated*.

FOR PETITIONER:

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