

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WELLS FARGO BANK, N.A.,
Petitioner,

v.

UNITED SERVICES AUTOMOBILE ASSOCIATION,
Patent Owner.

Case CBM2019-00002
Patent 9,818,090 B1

Before JONI Y. CHANG, RAMA G. ELLURU and STACEY G. WHITE,
Administrative Patent Judges.

ELLURU, *Administrative Patent Judge.*

DECISION
Dismissing Petition and Terminating Proceeding
37 C.F.R. §§ 42.5(a) and 42.71(a)

With authorization from the Board, (Paper 13), Petitioner moves to dismiss the Petition requesting a covered business method patent (“CBM”) review in CBM2019-00002 and terminate the proceeding. Paper 15, 1 (“Mot.”). Petitioner asserts that Patent Owner does not oppose the motion. *Id.* Petitioner further asserts that “Patent Owner will not be prejudiced by the dismissal and the dismissal will ‘secure the just, speedy, and inexpensive resolution’” in the instant proceeding. *Id.* (citing 37 C.F.R. § 42.1(b)).

Petitioner argues that “good cause” exists to dismiss the instant Petition, including that the motion is unopposed. Mot. 1. First, Petitioner notes that the instant CBM is in its “preliminary phase” because the Board has not issued a Decision on Institution. *Id.* Second, contends Petitioner, dismissal of the instant petition will preserve Board and party resources, while “epitomizing [the] Patent Office’s policy” of securing, a “just, speedy, and inexpensive resolution” in this case. *Id.* at 2 (citing § 42.1(b)). Petitioner states that “even if Petitioner abandons the above-captioned CBM (regardless of whether this Motion to Dismiss is granted), granting this Motion to Dismiss would relieve the Patent Owner of the substantial expense in preparing responses, presenting expert testimony, and participating in an oral hearing.” *Id.* Lastly, Petitioner alleges that dismissal of the Petition and termination of the instant proceeding is a “just and fair resolution” because Patent Owner will not be prejudiced by the dismissal. *Id.*

We dismiss the Petition in CBM2019-00002 for the following reasons. The instant proceedings is in the preliminary stage. We have not considered the merits of the Petition. Thus, dismissing the Petition will lead

to a “just, speedy, and inexpensive resolution” in this proceeding. § 42.1(b). Further, Patent Owner does not oppose Petitioner’s request to dismiss the Petition and terminate the instant proceeding. Under these circumstances, we determine that it is appropriate to dismiss the petitions without prejudice and to terminate the proceedings. 37 C.F.R. § 42.5(a); 37 C.F.R. § 42.71(a). This Decision does not constitute a final written decision pursuant to 35 U.S.C. § 318(a). Although the Petition in this proceeding is dismissed without prejudice, any subsequently filed Petition must comply with the statutory and regulatory requirements applicable to petitions. *See, e.g.*, 35 U.S.C. §§ 322–325 and 37 C.F.R. § 42.3. In other words, a dismissal without prejudice does not modify or otherwise alter the application of statutory and regulatory requirements to a filed petition, including the Board’s discretionary considerations when deciding whether to a post-grant review.

Accordingly, we dismiss the Petition in CBM2019-00002 without prejudice, and terminate the instant proceeding.

ORDER

In accordance with the foregoing, it is hereby:

ORDERED that the Petition in CBM2019-00002 is dismissed without prejudice; and

FURTHER ORDERED that the proceeding in CBM2019-00002 is terminated.

Case CBM2019-00002
Patent 9,818,090 B1

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