

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMERICAN EXPRESS TRAVEL RELATED SERVICES COMPANY,
INC.,
Petitioner,

v.

WILLIAM GRECIA,
Patent Owner.

Case: IPR2017-00799
Patent 8,402,555 B2

Before JAMESON LEE, MICHAEL W. KIM, and
MICHELLE N. WORMMEESTER, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

JUDGEMENT
Joint Motion to Terminate
37 C.F.R. §§ 42.72, 42.74

On April 4, 2017, we authorized American Express Travel Related Services Company, Inc. (“Petitioner”) and William Grecia (“Patent Owner”) to file a joint motion to terminate the above-identified proceeding. On April 10, 2017, Petitioner and Patent Owner filed a Joint Motion to terminate this *inter partes* review proceeding. Paper 6 (“Joint Motion” or “Joint Mot.”). Petitioner and Patent Owner also filed a copy of their settlement and license agreement covering, *inter alia*, Patent No. 8,402,555 B2, at issue in this *inter partes* review. Ex. 1017 (“Settlement Agreement”). The parties represent that the filed copy of the Settlement Agreement is a true copy. Joint Mot. 3.

Other than the Petition, no substantive papers have been filed. The Board has not yet decided the merits of any issue in this proceeding, and a decision on whether to institute review has not yet issued. Petitioner and Patent Owner represent that the related District Court litigation in the Southern District of New York has been dismissed with prejudice. Joint Mot. 3.¹ Petitioner and Patent Owner filed a copy of the District Court’s Order dismissing the action. Ex. 1016. Petitioner and Patent Owner further represent that they have settled their dispute with respect to the patent at

¹ The Joint Motion cites “[t]he related District Court litigation between the Parties, No. 1:15-cv-09059-RJS (S.D.N.Y.)” Joint Mot. 3. The Order referenced in the Joint Motion, and submitted as Exhibit 1016, however, refers to *William Grecia v. American Express Co.*, No. 1:15-cv-9217 (RJS) (S.D.N.Y.). Ex 1016; *see also* Paper 5, 2 (citing “*Grecia v. MasterCard Incorporated*, Case. No. 1:15-cv-9059 (S.D.N.Y.)” and “*Grecia v. American Express Company*, Case No. 1:15-cv-9217 (S.D.N.Y.)”). We regard the reference to “[t]he related District Court litigation between the Parties, No. 1:15-cv-09059-RJS (S.D.N.Y.)” in the Joint Motion as a reference to *William Grecia v. American Express Co.*, No. 1:15-cv-9217 (RJS) (S.D.N.Y.).

issue. Joint Mot. 2. Accordingly, we determine that it is appropriate to terminate this proceeding.

Petitioner and Patent Owner also filed a Joint Request to File Settlement Agreement as Business Confidential Information. Paper 7 (“Joint Request”). The parties requested that the Settlement Agreement be filed as business confidential information, and that the Settlement Agreement be kept separate from the file of the patent involved in the *inter partes* review and be made available only on a showing of good cause or to Federal Government agencies on a written request. *Id.*

“A party to a settlement may request that the settlement be treated as business confidential information and be kept separate from the files of an involved patent or application. The request must be filed with the settlement. If a timely request is filed, the settlement shall only be available: (1) To a Government agency on written request to the Board; or (2) To any other person upon written request to the Board to make the settlement agreement available, along with the fee specified in § 42.15(d) and on a showing of good cause.” 37 C.F.R. § 42.74(c). After reviewing the Settlement Agreement between Petitioner and Patent Owner, we find that the Settlement Agreement contains confidential business information regarding the terms of settlement. We determine that it is appropriate to treat the Settlement Agreement between Petitioner and Patent Owner as business confidential information pursuant to 37 C.F.R. § 42.74(c).

ORDER

It is

ORDERED that the Joint Motion to Terminate (Paper 6), as to both Petitioner and Patent Owner, is *granted*;

FURTHER ORDERED that the Joint Request (Paper 7) to treat the settlement agreement (Exhibit 1017) as business confidential information under 37 C.F.R. § 42.74(c) is *granted*; and

FURTHER ORDERED that this proceeding is terminated with respect to both Petitioner and Patent Owner.

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