Trials@uspto.gov
571-272-7822

Paper No. 33
Entered: February 12, 2021

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.

IPR2020-00090 (Patent 9,177,197 B1)
IPR2020-00091 (Patent 9,177,198 B1)
IPR2020-00092 (Patent 9,569,756 B1)
IPR2020-00095 (Patent 7,974,899 B1)
IPR2020-00096 (Patent 7,962,411 B1)
IPR2020-00097 (Patent 7,885,880 B1) [1]

Before MICHAEL R. ZECHER, STACEY G. WHITE, and TERRENCE W. McMILLIN, *Administrative Patent Judges.*

ZECHER, *Administrative Patent Judge*.

TERMINATION
Due to Settlement After Institution of Trial
35 U.S.C. § 317; 37 C.F.R. § 42.74

[1] This Decision addresses an issue that is identical in all six proceedings. We, therefore, exercise our discretion to issue one Decision to be filed in each proceeding. The parties, however, may not use this style heading without seeking prior authorization from the Board.

I. DISCUSSION

On February 11, 2021, with our authorization (Paper 30), Petitioner, Wells Fargo Banks, N.A. ("Wells Fargo"), and Patent Owner, United Services Automobile Association ("USAA"), jointly filed the following in each of the proceedings identified above: (1) a revised "Joint Motion to Dismiss Proceedings" under 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74 (Paper 31, "Mot.")[2]; (2) a true copy of the parties' settlement agreement (Ex. 2042); and (3) a renewed "Joint Request to File Agreement as Business Confidential Information and Keep it Separate From the File of [the Involved Patent]" under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 32). For the following reasons, we *grant* the parties' revised "Joint Motion to Dismiss Proceedings," as well as their renewed "Joint Request to File Agreement as Business Confidential Information and Keep it Separate From the File of [the Involved Patent]," filed in each proceeding.

On May 11, 2020, we entered a decision instituting an *inter partes* review in the following three proceedings: (1) IPR2020-00090, Paper 7 (Decision Granting Institution as to claims 1–22 of U.S. Patent No. 9,177,197 B1); (2) IPR2020-00091, Paper 7 (Decision Granting Institution as to claims 1–3 and 5–20 of U.S. Patent No. 9,177,198 B1); and (3) IPR2020-00092, Paper 7 (Decision Granting Institution as to claims 1–7, 9–17, 19–27, 29, and 30 of U.S. Patent No. 9,569,756 B1). Less than a month later, on June 2, 2020, we entered a decision instituting an *inter partes* review in the following three proceedings: (1) IPR2020-00095,

[2] Unless otherwise noted, all citations are to the papers and exhibits filed in IPR2020-00090. Similar papers and exhibits were filed in IPR2020-00091, IPR2020-00092, IPR2020-00095, IPR2020-00096, and IPR2020-00097.

Paper 8 (Decision Granting Institution as to claims 1–4, 6–11, 13–18, 20, and 21 of U.S. Patent No. 7,974,899 B1); (2) IPR2020-00096, Paper 8 (Decision Granting Institution as to claims 1–3, 5–10, 12–17, and 19–21 of U.S. Patent No. 7,962,411 B1); and (3) IPR2020-00097, Paper 8 (Decision Granting Institution as to claims 1–18 of U.S. Patent No. 7,885,880 B1).

In each of these six proceedings, although the substantive briefing was completed, we cancelled the consolidated oral arguments for IPR2020-00090, IPR2020-00091, and IPR2020-00092 originally scheduled on February 10, 2021, upon learning that the parties had resolved their dispute regarding the involved patents (*see, e.g.*, IPR2020-00090, Paper 29, 3–4 (cancelling the consolidated oral arguments for IPR2020-00090, IPR2020-00091, and IPR2020-00092)). We have not yet decided the merits of these six proceedings.

In the revised "Joint Motion to Dismiss Proceedings," the parties indicate that they have resolved their dispute regarding the involved patents. *See* Mot. 3. More specifically, the parties state that, "[p]ursuant to the terms of the written settlement agreement, [USAA] has granted a license to [Wells Fargo] covering" the involved patents. *Id.* at 1. The parties also represent that Exhibit 2042 is "a true copy of the settlement agreement entered between the parties and executed on February 5, 2021," "[t]he settlement agreement was entered into in contemplation of terminating" these six proceedings, and the "settlement agreement is the only agreement or understanding between [Wells Fargo] and [USAA] made in connection with, or in contemplation, of terminating" these six proceedings. *Id.* at 3–4.

Under these particular circumstances, we determine that it is appropriate to terminate the trial in each proceeding without rendering a final written decision. *See* 37 C.F.R. § 42.72. We also have reviewed the true copy of the parties' settlement agreement (Ex. 2042), and we determine that good cause exists to treat this settlement agreement as business confidential information, and keep it separate from the file of the involved patent. *See* 35 U.S.C. § 317(b); 37 C.F.R. § 42.74(c).

II. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the parties' renewed "Joint Request to File Agreement as Business Confidential Information and Keep it Separate From the File of [the Involved Patent]" filed in each proceeding under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) are *granted*;

FURTHER ORDERED that the following documents shall remain business confidential information, and shall be kept separate from the file of the involved patent: (1) IPR2020-00090, Exhibit 2042; (2) IPR2020-00091, Exhibit 2043; (3) IPR2020-00092, Exhibit 2042; (4) IPR2020-00095, Exhibit 2021; (5) IPR2020-00096, Exhibit 2021; and (6) IPR2020-00097, Exhibit 2021;

FURTHER ORDERED that the parties' revised "Joint Motion to Dismiss Proceedings" filed in each proceeding under 35 U.S.C 35 U.S.C. 317(a) and 37 C.F.R. § 42.74 are *granted*, and these proceedings are hereby terminated; and

FURTHER ORDERED that, as a result of termination, the consolidated oral arguments for IPR2020-00095, IPR2020-00096, and IPR2020-00097 that are scheduled on March 10, 2021, at 1:00PM ET are *cancelled*.

For PETITIONER:

Robert Hirning
Tyler Nasiedlak
SCHWEGMAN LUNDBERG & WOESSNER, P.A.
rhirning@slwip.com
tnasiedlak@slwip.com

Louis Campbell
WINSTON & STRAWN LLP
llcampbell@winston.com

For PATENT OWNER:

Michael Fleming
Babak Redjaian
Anthony Rowles
IRELL & MANELLA LLP
mfleming@irell.com
bredjaian@irell.com
trowles@irell.com