

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TRUIST BANK,
Petitioner,

v.

UNITED SERVICES AUTOMOBILE ASSOCIATION,
Patent Owner.

IPR2022-01593
Patent 9,818,090 B1

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

I. DISCUSSION

On October 10, 2023, with our authorization via an email dated October 6, 2023, Petitioner, Truist Bank, and Patent Owner, United Services Automobile Association (“USAA”), jointly filed the following: (1) a “Joint Motion of Petitioner and Patent Owner to Terminate *Inter Partes* Review [IPR] Proceeding Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.72” (Paper 20, “Mot.” or “Joint Motion”); (2) a true copy of the parties’ settlement agreement (Ex. 1029); and (3) a “Joint Request to Treat Settlement Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317(b)” (Paper 21). For the following reasons, we *grant* the parties’ Joint Motion to terminate this IPR, as well as the parties’ joint request to file their settlement agreement as business confidential information and keep it separate from the file of the involved patent.

On June 14, 2023, we entered a decision granting institution of an IPR of claims 1–19 of U.S. Patent No. 9,818,090 B1 (Ex. 1001, “the ’090 patent”). Paper 15. The trial, however, is still in an early stage because the parties have not completed substantive briefing and we have not yet decided the merits.

In the Joint Motion to terminate this IPR, the parties state “this Joint Motion is the settlement of all disputes between the parties relating to the ’090 patent,” “[t]he record lacks full briefing on the trial issues,” “oral argument has not occurred,” and “the [p]arties do not anticipate any further litigation between them concerning the ’090 patent.” Mot. 1–2. The parties clarify that all disputes between the parties includes the settlement of this IPR involving the ’090 patent, the related district court litigation, and three other related IPRs involving patents owned by USAA. *Id.* at 1. Lastly, the

parties represent that Exhibit 1029 is a true copy of the parties' settlement agreement that "constitutes the [p]arties' entire understanding and agreement," which we understand to mean that there are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of this IPR. *Id.* at 3.

Under these particular circumstances, we determine that it is appropriate to terminate the trial 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. 1029), 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 '090 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' joint request to file their settlement agreement as business confidential information and keep it separate from the file of the '090 patent is *granted*;

FURTHER ORDERED that Exhibit 1029 shall remain business confidential information, and shall be kept separate from the file of the '090 patent; and

FURTHER ORDERED that the parties' Joint Motion to terminate this IPR is *granted*.

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