

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TRUIST BANK,
Petitioner,

v.

UNITED SERVICES AUTOMOBILE ASSOCIATION,
Patent Owner.

IPR2023-00183
Patent 11,182,753 B1

Before KRISTEN L. DROESCH, STACEY G. WHITE, and
TERRENCE W. McMILLIN, *Administrative Patent Judges*.

DROESCH, *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 11, 2023, with our authorization via an email dated October 10, 2023, Petitioner, Truist Bank, and Patent Owner, United Services Automobile Association, jointly filed the following: (1) a “Joint Motion of Petitioner and Patent Owner to Terminate *Inter Partes* Review Proceeding Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.72” (Paper 21, “Mot.” or “Joint Motion”); (2) a true copy of the parties’ settlement agreement (Ex. 1028); and (3) a “Joint Request to Treat Settlement Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317(b)” (Paper 22, “Joint Request”). For the following reasons, we *grant* the parties’ Joint Motion to terminate this *inter partes* review proceeding, 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 May 18, 2023, we entered a decision granting institution *inter partes* review of claims 1–14 of U.S. Patent No. 11,182,753 B1 (Ex. 1001, “the ’753 Patent”). Paper 16. 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, the parties state “this Joint Motion is the settlement of all disputes between the parties relating to the ’753 patent,” “[o]ral argument has not occurred,” and “the [p]arties do not anticipate any further litigation between them concerning the ’753 patent.” Mot. 1–2. The parties clarify that all disputes between the parties includes the settlement of this proceeding involving the ’753 Patent, the related district court litigation, and three other related proceedings before the Board involving patents owned by Patent Owner. *Id.* at 1. Lastly, the parties represent that

Exhibit 1028 is a true copy of the parties' settlement agreement and "certify that there are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of this proceeding." *Id.* at 2–3.

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. 1028), and determine that good cause exists to treat this settlement agreement as business confidential information and keep it separate from the file of the '753 Patent. *See* 35 U.S.C. § 317(b); 37 C.F.R. § 42.74(c). This does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

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 U. S. Patent No. 11,182,753 B1 (Paper 22) is *granted*;

FURTHER ORDERED that Exhibit 1028 shall remain business confidential information, and shall be kept separate from the file of U.S. Patent No. 11,182,753 B1; and

FURTHER ORDERED that the parties' Joint Motion to terminate this proceeding (Paper 21) is *granted*.

IPR2023-00183
Patent 11,182,753 B1

PETITIONER:

Lionel Lavenue
Kara Specht
Robert High
Cory Bell
Xirui Zhang
Kai Rajan
Umber Aggarwal
Christina Ji-Hye Yang
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, LLP
Lionel.lavenue@finnegan.com
Kara.specht@finnegan.com
Robert.high@finnegan.com
Cory.bell@finnegan.com
Xirui.zhang@finnegan.com
Kai.rajan@finnegan.com
Umber.aggarwal@finnegan.com
Christina.yang@finnegan.com

Sharonmoyee Goswami
CRAVATH, SWAINE & MOORE LLP
Sgoswami@cravath.com

PATENT OWNER:

Anthony Rowles
Michael Fleming
IRELL & MANELL LLP
trowles@irell.com
m Fleming@irell.com