

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TRUIST BANK,
Petitioner,

v.

UNITED SERVICES AUTOMOBILE ASSOCIATION,
Patent Owner.

IPR2023-00829
Patent 11,544,944 B1

Before KRISTEN L. DROESCH, MICHAEL R. ZECHER, and
JULIET MITCHELL DIRBA, *Administrative Patent Judges*.

DIRBA, *Administrative Patent Judge*.

DECISION
Settlement Prior to Institution of Trial
37 C.F.R. § 42.74

With our authorization, Truist Bank (“Petitioner”) and United Services Automobile Association (“Patent Owner”) filed 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 7 (“Joint Motion”). The parties also filed a settlement agreement (Ex. 1026) and a “Joint Request to Treat Settlement Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317(b)” (Paper 8; “Joint Request”).

In the Joint Motion, the parties state that they have settled all disputes relating to the challenged patent and jointly request termination of this proceeding. Joint Motion 1. The parties contend that “terminating this proceeding serves the interests of judicial economy as well as the mutual interests of the Parties.” *Id.* at 2. The parties also represent that they have filed “a true copy of the settlement agreement between the parties . . . as Ex. 1026” “[i]n accordance with 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b).” *Id.* at 1. In addition, the Joint Request states:

[P]ursuant to 37 C.F.R. § 42.74(c) and 35 U.S.C. § 317(b), the Parties jointly request that the Office treat the settlement agreement filed concurrently herewith as Ex. 1026 as business confidential information, that the agreement be kept separate from the file of the involved patent, and that the agreement be made available only to Federal Government agencies on written request, or to other persons only on a showing of good cause.

Joint Request 2.

We *grant* the Joint Motion and the Joint Request. We are persuaded that it is appropriate to terminate the proceeding, and we determine that good cause exists to treat Exhibit 1026 (the parties’ settlement agreement) as business confidential information and keep it separate from the file of U.S. Patent No. 11,544,944 B1. *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).

Accordingly, it is:

ORDERED that the “Joint Motion of Petitioner and Patent Owner to Terminate *Inter Partes* Review Proceeding” (Paper 7) is *granted*, and this proceeding is terminated; and

FURTHER ORDERED that the “Joint Request to Treat Settlement Agreement as Business Confidential Information” (Paper 8) is *granted*, and Exhibit 1026 shall be treated as business confidential information, shall be kept separate from the file of U.S. Patent No. 11,544,944 B1, and shall be made available only to Federal Government agencies on written request, or to any person on a showing of good cause.

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