

Filed: October 11, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TRUIST BANK,
Petitioner,

v.

UNITED SERVICES AUTOMOBILE ASSOCIATION,
Patent Owner.

IPR2023-01326
U.S. Patent 11,625,770

**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**

STATEMENT OF PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.72, and the Board’s authorization provided on October 10, 2023, Petitioner Truist Bank (“Truist” or “Petitioner”) and Patent Owner United Services Automobile Association (“USAA” or “Patent Owner”) (collectively, the “Parties”) hereby provide notice that they have reached a settlement agreement and jointly request termination of *inter partes* review (“IPR”), Case No. IPR2023-01326, involving U.S. Patent No. 11,625,770 (“the ’770 patent”).

I. Termination Is Appropriate

The basis for this Joint Motion is the settlement of all disputes between the parties relating to the ’770 patent and other patents in dispute, including this IPR proceeding, the related district court litigation, *United Services Automobile Association v. Truist Bank*, No. 2:22-cv-00291 (E.D. Tex.), and the following related IPR proceedings currently before the U.S. Patent and Trademark Office:

1. Case No. IPR2022-01593, challenging U.S. Patent No. 9,818,090 (“the ’090 patent”)
2. Case No. IPR2023-00183 challenging U.S. Patent No. 11,182,753 (“the 753 patent”);
3. Case No. IPR2023-00829 challenging U.S. Patent No. 11,544,944 (“the 944 patent”).

Pursuant to that settlement, the Parties have also entered into a mutual release. An IPR shall be terminated with respect to any petitioner upon the joint request of the Petitioner and the Patent Owner, unless the Office has decided the merits of the proceedings before the request for termination is filed. 37 U.S.C. § 317(a). Further, “no estoppel under section 315(e) shall attach to the petitioner, or to the real party in interest or privy of the petitioner.” *Id.*

Here, Petitioner filed a Petition requesting IPR of the ’770 patent on April 16, 2023. Patent Owner’s Preliminary Response is due by November 28, 2023. The IPR has not been instituted and no other motions or actions are outstanding. The proceeding is thus in the preliminary stage, the record lacks full briefing on the trial issues, and the Board has accordingly not decided the merits of the proceeding.

Further, the Parties do not anticipate any further litigation between them concerning the ’770 patent and the other patents in dispute. Thus, terminating this proceeding serves the interests of judicial economy as well as the mutual interests of the Parties.

II. Agreement in Writing Submitted to the Board

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), a true copy of the Parties’ settlement agreement is being submitted as Exhibit 1024. The settlement agreement is in writing and constitutes the Parties’ entire understanding and agreement.

The Parties are also filing concurrently herewith a joint request under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) to treat this settlement agreement as business confidential information and be kept separate from the files of the '770 patent. The Parties certify that there are no other agreements or understanding, oral or written, between the Parties made in connection with, or in contemplation of, the termination of this proceeding.

III. Conclusion

For at least the foregoing reasons, the Parties respectfully request that the Board terminate *Inter Partes* Review IPR2023-01326.

Date: October 11, 2023

Respectfully Submitted,

/Anthony Q. Rowles/

Anthony Q. Rowles
Counsel for Patent Owner
United Services Automobile Association

/Lionel M. Lavenue/

Lionel M. Lavenue
Counsel for Petitioner
Truist Bank

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **JOINT MOTION OF PETITIONER AND PATENT OWNER TO TERMINATE *INTER PARTES* REVIEW PROCEEDING** was served on October 11, 2023, via email directed to counsel of record for the Patent Owner at the following:

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