

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
Patent 11,625,770 B1

Before KRISTEN L. DROESCH, MICHAEL R. ZECHER, and
TERRENCE W. McMILLIN, *Administrative Patent Judges*.

DROESCH, *Administrative Patent Judge*.

DECISION
Settlement Prior to Institution of Trial
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 6, “Mot.” or “Joint Motion”); (2) a true copy of the parties’ settlement agreement (Ex. 1024); and (3) a “Joint Request to Treat Settlement Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317(b)” (Paper 7, “Joint Request”). For the following reasons, we *grant* the parties’ Joint Motion to terminate this 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.

In the Joint Motion to terminate, the parties state “this Joint Motion is the settlement of all disputes between the parties relating to the ’770 patent,” “the proceeding is . . . in the preliminary stage,” “[an *inter partes* review] has not been instituted and no other motions or actions are outstanding,” and “the [p]arties do not anticipate any further litigation between them concerning the ’770 patent.” Mot. 1–2.

The parties clarify that all disputes between the parties includes the settlement of this proceeding involving the ’770 Patent patent, the related district court litigation, and three other related proceedings before the Board involving Patent Owner’s patents. *Id.* at 1. Lastly, the parties represent that Exhibit 1024 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 this proceeding prior to institution, and upon review of the the true copy of the parties' settlement agreement (Ex. 1024), determine that good cause exists to treat this settlement agreement as business confidential information and keep it separate from the file of U.S. Patent No. 11,625,770 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).

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. 11,625,770 B1 (Paper 6) is *granted*;

FURTHER ORDERED that Exhibit 1024 shall remain business confidential information, and shall be kept separate from the file of U.S. Patent No. 11,625,770 B1; and

FURTHER ORDERED that the parties' Joint Motion to terminate this proceeding (Paper 7) is *granted*.

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Patent 11,625,770 B1

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