

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GROUPON INC.,

Petitioner

v.

MAXIM INTEGRATED PRODUCTS, INC.,

Patent Owner.

Case CBM2014-00090

U.S. Patent No. 5,805,702

**JOINT MOTION OF PETITIONER AND PATENT OWNER
TO TERMINATE PROCEEDING
PURSUANT TO 35 U.S.C. § 327**

STATEMENT OF PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 327, and the Board's Authorization provided on August 5, 2014 (Order, Paper No. 7), Petitioner Groupon Inc. (Groupon) and Patent Owner Maxim Integrated Products, Inc. (Maxim) jointly request termination of the covered business method patent review of U.S. Patent No. 5,805,702 ("the '702 patent"), Case No. CBM2014-00090.

STATEMENT OF FACTS

Groupon filed its petition for covered business method patent review on March 14, 2014. Paper No. 3. Maxim filed its Patent Owner's Preliminary Response on June 27, 2014. Paper No. 6. Review of CBM2014-00090 has not yet been instituted. Groupon and Maxim have settled their dispute with respect to the '702 patent. On July 31, 2014, Groupon and Maxim jointly filed a stipulation of dismissal in the corresponding litigation, *Maxim Integrated Products, Inc. v. Groupon Inc.*, No. 2:12-cv-881-JFC (W.D. Pa.). *See* Ex. 1012. The joint stipulation dismisses all claims against Groupon relating to the '702 patent with prejudice. *Id.* The joint stipulation serves as the written agreement between the parties to settle their dispute regarding the '702 patent. On August 1, 2014, the Court granted the stipulation of dismissal with prejudice. *See* Ex. 1013.

ARGUMENT

The Board should terminate CBM2014-00090 because the review is still in its early stages and the Office has not yet decided whether to institute covered business method review of the '702 patent. In addition, Groupon and Maxim have settled the corresponding litigation with respect to the '702 patent and all claims against Groupon with respect to the '702 patent have been dismissed with prejudice. *See* Ex. 1013. Further, Groupon and Maxim agree that this review should be terminated.

In addition, Maxim's claim against Starbucks Corp. regarding the '702 patent (*see* Patent Owner Mandatory Notices, Paper No. 5, at 1, identifying *Maxim Integrated Products, Inc. v. Starbucks Corp.*, No. 2:12-cv-00877-JFC) has been dismissed and there is no longer any pending litigation based on the '702 patent.

For at least the foregoing reasons, Groupon and Maxim respectfully request termination of Covered Business Method Patent Review No. CBM2014-00090 of U.S. Patent No. 5,805,702. Should the Board terminate this proceeding as jointly requested by Groupon and Maxim, no estoppel under 35 U.S.C. § 325(e) shall attach to Groupon. *See* 35 U.S.C. § 327(a).

Case CBM2014-00090
U.S. Patent No. 5,805,702

August 7, 2014

Respectfully submitted,

/s/ James C. Yoon

James C. Yoon
USPTO Reg. No. 43,297
WILSON SONSINI GOODRICH &
ROSATI
650 Page Mill Road
Palo Alto, CA 94304-1050
Tel.: 650-493-9300
Email: groupon-maxim@wsgr.com

/s/ Kenneth J. Weatherwax

Kenneth J. Weatherwax
USPTO Reg. No. 54,528
GOLDBERG, LOWENSTEIN &
WEATHERWAX LLP
11400 West Olympic Boulevard
Suite 400
Los Angeles, CA 90064
Tel. 310-307-4503
Email: weatherwax@glwllp.com

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6, the undersigned hereby certifies that service was made on Patent Owner as detailed below.

Date of Service: August 7, 2014

Manner of Service: Electronic Mail; and
The Patent Review Processing System.

Documents Served: JOINT MOTION OF PETITIONER AND PATENT
OWNER TO TERMINATE PROCEEDING
PURSUANT TO 35 U.S.C. § 327
EXHIBITS 1012 AND 1013

Persons Served:

Kenneth J. Weatherwax USPTO Reg. No. 54,528 GOLDBERG, LOWENSTEIN & WEATHERWAX LLP 11400 West Olympic Boulevard Suite 400 Los Angeles, CA 90064 Tel. 310-307-4503 Email: weatherwax@glwllp.com	Parham Hendifar USPTO Reg. No. 71,470 GOLDBERG, LOWENSTEIN & WEATHERWAX LLP 11400 West Olympic Boulevard Suite 400 Los Angeles, CA 90064 Tel. 310-307-4510 Email: hendifar@glwllp.com
---	---

Dated: August 7, 2014

/s/ James C. Yoon

James C. Yoon
USPTO Reg. No. 43,297
WILSON SONSINI GOODRICH &
ROSATI
650 Page Mill Road
Palo Alto, CA 94304-1050
Tel.: 650-493-9300
Email: groupon-maxim@wsgr.com