

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

JP MORGAN CHASE & CO.
AND JP MORGAN CHASE BANK, N.A.
Petitioner

v.

MAXIM INTEGRATED PRODUCTS, INC.
Patent Owner

Case CBM2014-00180
Patent 5,949,880

**JOINT MOTION
TO TERMINATE PROCEEDING
PURSUANT TO 35 U.S.C. § 327**

Petitioner JP MORGAN CHASE & CO. and JP MORGAN CHASE BANK, N.A. (collectively “Petitioner” or “Chase”) and Patent Owner MAXIM INTEGRATED PRODUCTS, INC. (“Patent Owner” or “Maxim”) jointly request termination of this covered business method (“CBM”) patent review case.

STATEMENT OF PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 327, and the Board’s authorization provided on February 25, 2015, Petitioner and Patent Owner jointly request termination of case number CBM2014-00180, which is directed to U.S. Patent No. 5,949,880, pursuant to settlement.¹

STATEMENT OF FACTS

This is one of four pending CBM cases (collectively the “Cases”)² filed by Chase against Maxim, each involving one of four patents³ that were the subject of litigation claims between Chase and Maxim relating to infringement (“the Litigated Patents”).

¹ Substantially similar joint motions to terminate pursuant to settlement are being filed concurrently in this and each of the other Cases (defined below).

² Case Nos. CBM2014-00177, -00178, -00179, and -00180.

³ U.S. Patent Nos. 6,237,095, 6,105,013, 5,940,510, and 5,949,880, respectively.

Decisions instituting review (on at least one but not all requested grounds in each case) issued in Cases CBM2014-00179 (paper 11) and -00180 (paper 14) on February 20, 2015. Decisions on institution are believed to be due in Cases CBM2014-00177 and -00178 on February 28, 2015.

Chase and Maxim have reached an agreement that settles all of the Cases.

A “Joint Request to File Settlement Agreement as Business Confidential Information Under 35 U.S.C. § 327(b)” is being filed concurrently with this Joint Motion to Terminate to treat the settlement agreement as business confidential information and keep it separate from the file of the Involved Patent (U.S. Patent No. 5,949,880).

Pursuant to the settlement agreement, the lawsuit styled *Maxim Integrated Products, Inc. v. JP Morgan Chase & Co.*, originally filed as Civil Action No. 12-CV-1641 in the United States District Court for the Eastern District of Texas, and transferred for pre-trial proceedings to the United States District Court for the Western District of Pennsylvania as Civil Action No. 2:12-cv-1538-JFC, for consolidation in the MDL proceedings *In re Maxim Integrated Products, Inc. Patent Litigation*, identified by Civil Action No. 2:12-mc-244, has been settled between Chase and Maxim. A stipulated motion made jointly by Chase and Maxim for dismissal with prejudice of claims and counterclaims and proposed

order of dismissal was filed in the foregoing litigation February 18, 2015 and is pending entry. Ex. 2001.

The related proceedings listed below alleging infringement of the aforementioned U.S. Patent Nos. 6,237,095, 6,105,013, and 5,940,510, but not 5,949,880, remain pending. Chase is not a party to these related proceedings.

- *Maxim Integrated Prods., Inc. v. USAA Fed. Sav. Bank*, 4:12-cv-00369-RAS (W.D. Tex) (filed November 19, 2014);
- *Maxim Integrated Prods., Inc. v. Navy Fed. Credit Union*, 4:12-cv-00369-RAS (W.D. Tex) (filed November 19, 2014);
- *Maxim Integrated Prods., Inc. v. State Farm Mut. Auto. Ins. Co.*, 4:12-cv-00369-RAS (W.D. Tex) (filed November 19, 2014);
- *Maxim Integrated Prods., Inc. v. Discover Fin. Serv.*, 4:12-cv-00369-RAS (W.D. Tex) (filed November 19, 2014);
- *Maxim Integrated Prods., Inc. v. Am. Express Co.*, 4:12-cv-00369-RAS (W.D. Tex) (filed November 19, 2014);
- *Maxim Integrated Prods., Inc. v. Compass Bank, d/b/a BBVA Compass*, 4:12-cv-00369-RAS (W.D. Tex) (filed November 19, 2014).

ARGUMENT

A joint motion to terminate generally “must (1) include a brief explanation as to why termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue; (3) identify any related proceedings currently before the Office, and (4) discuss specifically the current status of each such related

litigation or proceeding with respect to each party to the litigation or proceeding.” *Heartland Tanning, Inc. v. Sunless, Inc.*, IPR2014-00018, Paper 26 at 2 (PTAB Jul. 28, 2014). The second, third and fourth of these requirements are included in the above statement of facts. The first of these requirements is satisfied below.

The Board should terminate this case as the parties jointly request, for the following reasons.

First, Petitioner and Patent Owner have met the statutory requirement that they file a “joint request” to terminate before the office “has decided the merits of the proceeding.” 35 U.S.C. § 327(a). Under section 327(a), a post-grant review shall be terminated upon such joint request “unless the Office has decided the merits of the proceeding before the request for termination is filed.” There are no other preconditions of 35 U.S.C. § 327(a). In Cases CBM2014-00177 and CBM2014-00178, a decision on institution has not issued. In each of Cases CBM2014-00179 and CBM2014-00180, a decision on institution and scheduling order issued February 20, 2015 granting review on at least one, but not all, proposed grounds, but no other filings or proceedings following institution have yet taken place. No prior motions are pending in any of the Cases.

Second, the parties have reached a settlement as to all the disputes in this proceeding, and as to the Involved Patent. A copy of the settlement agreement is

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