

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

STATE FARM MUTUAL AUTOMOBILE INSURANCE COMPANY,
Petitioner,

v.

MAXIM INTEGRATED PRODUCTS, INC.,
Patent Owner.

Case CBM2015-00098
Patent No. 5,940,510

**STATE FARM MUTUAL AUTOMOBILE INSURANCE COMPANY'S, AND
MAXIM INTEGRATED PRODUCTS, INC.'S
CORRECTED JOINT MOTION TO TERMINATE PROCEEDING WITH
RESPECT TO
STATE FARM MUTUAL AUTOMOBILE INSURANCE COMPANY
PURSUANT TO 35 U.S.C. § 327**

Pursuant to 35 U.S.C. § 327(a), Petitioner State Farm Mutual Automobile Insurance Company (“State Farm”) and Patent Owner Maxim Integrated Products, Inc. (“Maxim”) (collectively, “the parties”) jointly request termination of State Farm’s participation in this case, No. CBM2015-00098. Because no additional petitioners remain, the Board may choose to terminate this Covered Business Method (“CBM”) review.

I. Brief Explanation as to why Termination is Appropriate

State Farm and Maxim have settled their dispute with respect to the patent at issue. Because no final written decision has yet been entered and State Farm and Maxim are jointly making this motion, termination of this CBM review as to State Farm is appropriate, as the Board has not yet “decided the merits of the proceeding.” 35 U.S.C. § 327(a).

Terminating this CBM review as to State Farm promotes the congressional goal to establish a more efficient and streamlined patent system that, *inter alia*, limits unnecessary and counterproductive litigation costs. *See* “Changes to Implement Inter Partes Review Proceedings, Post-Grant Review Proceedings, and Transitional Program for Covered Business Method Patents,” Final Rule, 77 Fed. Reg., no. 157, p. 48680 (August 14, 2012). Moreover, terminating post-grant proceedings, such as this CBM review, upon settlement fosters an environment that promotes settlements, thereby creating a timely, cost-effective alternative to litigation. A decision to continue the

present CBM review as to State Farm would therefore be contrary to the congressional goal of speedy dispute resolution.

II. Status of Related Litigation

The related District Court litigation between the parties has been settled and the case has been dismissed with prejudice. A copy of the court's order dismissing the case was previously filed as Exhibit 1023.

The parties' settlement agreement has been made in writing, and a true and correct copy was previously filed as Exhibit 1024 pursuant to 35 U.S.C. § 327(b). Pursuant to 35 U.S.C. § 327(b) and 37 C.F.R. § 42.74(c), the parties respectfully request that this Exhibit be treated as business confidential information, which shall be kept separate from the file of the involved patent, and be made available only to federal government agencies on written request or to any other person on a showing of good cause.

III. Conclusion

Maxim joins the present Motion solely for purposes of terminating State Farm's participation in this case going forward. For at least these reasons, State Farm and Maxim respectfully request termination of this case as to State Farm.

Respectfully submitted,

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CBM2015-00098

U.S. Patent No. 5,940,510

Joint Motion to Terminate

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Maxim Integrated Products, Inc.

Date: February 2, 2016

PETITIONER'S UPDATED EXHIBIT LIST

Exhibit	Description
Ex. 1001	U.S. Patent No. 5,940,510
Ex. 1002	File History for U.S. Patent No. 5,940,510
Ex. 1003	Int'l Pub. No. WO 83/03018 to P.V. Cremin et al. ("Cremin")
Ex. 1004	<p>INTEGRATED CIRCUIT CARDS, TAGS AND TOKENS (P.L. Hawkes <i>et al.</i> eds., 1990) (collectively, the "Hawkes Chapters"):</p> <ul style="list-style-type: none">• P.L. Hawkes, <i>Preface</i> ("Hawkes Preface");• <i>Introduction to Integrated Circuit Cards, Tags and Tokens for Automatic Identification</i> ("Hawkes Ch. 1");• W.L. Price & B.J. Chorley, <i>Secure Transactions with an Intelligent Token</i> ("Hawkes Ch. 6"); and• D.W. Davies, <i>Cryptography and the Smart Card</i> ("Hawkes Ch. 8")
Ex. 1005	Rivest, et al., <i>A Method for Obtaining Digital Signatures and Public-Key Cryptosystems</i> , 21 COMMUNICATIONS OF THE ACM, 2, 120 (1978) ("Rivest")
Ex. 1006	Petition for CBM Review of US5940510, <i>JPMorgan Chase & Co. and JP Morgan Chase Bank, N.A., v. Maxim Integrated Products, Inc.</i> , CBM 2014-179, Paper No. 1, August 21, 2014.
Ex. 1007	Decision Institution, <i>JPMorgan Chase & Co. and JP Morgan Chase Bank, N.A., v. Maxim Integrated Products, Inc.</i> , CBM 2014-179, Paper No. 11, February 20, 2015
Ex. 1008	U.S. Patent No. 5,210,846 to R.D. Lee ("Lee")
Ex. 1009	Texas Instruments, <i>TMS7000 Family Microarchitecture</i> , User's Guide, November 1982
Ex. 1010	Special Master's Report and Recommendation re Claim Construction, <i>In re Maxim Integrated Products, Inc.</i> , Patent Litigation, No. 2:12-mc-00244-JFC (W.D. Pa.), Docket #691,

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