

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 5,940,510

Before TREVOR M. JEFFERSON, MITCHELL G. WEATHERLY, and
KERRY BEGLEY, *Administrative Patent Judges*.

BEGLEY, *Administrative Patent Judge*.

JUDGMENT

Termination of the Proceeding
35 U.S.C. § 327(a), 37 C.F.R. § 42.72

Petitioner State Farm Mutual Automobile Insurance Company (“Petitioner”), the only remaining petitioner in this proceeding, and Patent Owner Maxim Integrated Products, Inc. (“Maxim”) filed a Joint Motion to Terminate this proceeding with respect to Petitioner, pursuant to 35 U.S.C. § 327. Paper 39. Along with the motion, the parties filed what they

represent to be a “true and correct” copy of their settlement agreement, in accordance with 35 U.S.C. § 327(b) and 37 C.F.R. § 42.74(b). *Id.* at 3; Ex. 1024. The parties request that the settlement agreement be treated as business confidential information under 35 U.S.C. § 327(b) and 37 C.F.R. § 42.74(c). Paper 39, 3.

The Motion was filed without prior authorization from the Board and, thus, violates 37 C.F.R. § 42.20(b). Nevertheless, in the interests of justice and pursuant to 37 C.F.R. § 42.5(b), we waive the authorization requirement of 37 C.F.R. § 42.20(b) and consider the motion on its merits. For the reasons set forth below, the joint motion to terminate as well as the request to treat the settlement agreement as business confidential information are granted.

Under 35 U.S.C. § 327(a), an instituted covered business method patent review “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 proceeding before the request for termination is filed.” 35 U.S.C. § 327(a); *see* Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, § 18(a)(1), 125 Stat. 284, 329 (2011) (stating that chapter 32 of title 35, United States Code, which governs post-grant reviews, is applicable to covered business method patent reviews with the exception of 35 U.S.C. § 321(c), 35 U.S.C. § 325(b), (e)(2), (f)). Since institution of this proceeding, Patent Owner has not filed a Response, Petitioner has not filed a Reply, and no oral hearing has been held. As a result, the Board has not yet decided the merits of the proceeding. Upon consideration of the facts before us, we determine that it is appropriate to terminate this trial and

CBM2015-00098
Patent 5,940,510

enter judgment without rendering a final written decision. *See* 35 U.S.C. § 327(a); 37 C.F.R. § 42.72.

Turning to the joint request to file the Settlement Agreement as business confidential information, we determine that Petitioner and Patent Owner have complied with the requirements of 37 C.F.R. § 42.74(c) to have their settlement agreement treated as business confidential information that is kept separate from the files of the patent-at-issue. Accordingly, the agreement shall be made available only to a government agency on written request to the Board or to any other person upon a showing of good cause and compliance with the other requirements of 37 C.F.R. § 42.74(c)(2).

ORDER

For the foregoing reasons, it is:

ORDERED that the Corrected Joint Motion to Terminate Proceeding with Respect to State Farm Mutual Automobile Insurance Company Pursuant to 35 U.S.C. § 327 (Paper 39) is *granted*;

FURTHER ORDERED that the parties' joint request that the Board treat their settlement agreement as business confidential information under 35 U.S.C. § 327(b) and 37 C.F.R. § 42.74(c) is *granted*; and

FURTHER ORDERED that this proceeding is terminated pursuant to 35 U.S.C. § 327.

CBM2015-00098
Patent 5,940,510

PETITIONER:

William F. Long
DENTONS US LLP
bill.long@dentons.com

Truman Fenton
SLAYDEN GRUBERT BEARD PLLC
tfenton@sgbfirm.com

PATENT OWNER:

Kenneth J. Weatherwax
Nathan Lowenstein
LOWENSTEIN & WEATHERWAX LLP
weatherwax@lowensteinweatherwax.com
lowenstein@lowensteinweatherwax.com