

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMERICAN EXPRESS COMPANY, AMERICAN EXPRESS TRAVEL
RELATED SERVICES COMPANY, INC., COMPASS BANK, DISCOVER
FINANCIAL SERVICES, DISCOVER BANK, DISCOVER PRODUCTS INC.,
AND STATE FARM MUTUAL AUTOMOBILE INSURANCE COMPANY,
Petitioner,

v.

MAXIM INTEGRATED PRODUCTS, INC.,
Patent Owner.

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

**AMERICAN EXPRESS COMPANY,
AMERICAN EXPRESS TRAVEL RELATED SERVICES COMPANY, INC.,
AND MAXIM INTEGRATED PRODUCTS, INC.'S
JOINT MOTION TO TERMINATE PROCEEDING WITH RESPECT TO
AMERICAN EXPRESS COMPANY AND AMERICAN EXPRESS TRAVEL
RELATED SERVICES COMPANY, INC. PURSUANT TO 35 U.S.C. § 327**

Pursuant to 35 U.S.C. § 327(a), Petitioner constituents American Express Company and American Express Travel Related Services Company, Inc. (collectively, “American Express”) and Patent Owner Maxim Integrated Products, Inc. (“Maxim”) (collectively, “the Parties”) jointly request termination of American Express’s participation in this case, No. CBM2015-00098,¹ as to American Express only. Because additional petitioners remain, the grant of this motion will not result in the termination of this Covered Business Method (“CBM”) review.

I. Brief Explanation as to why Termination is Appropriate

American Express and Maxim have settled their dispute with respect to the patent at issue. Because no final written decision has yet been entered and American Express and Maxim are jointly making this motion, termination of this CBM review as to American Express 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 American Express 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.,

¹ American Express is one of several petitioner constituents in this CBM review. This motion is not joined by, and does not affect the continued participation of, the other petitioner constituents in the CBM review.

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 American Express 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, No. 5:14-cv-1027-XR (W.D. Tx.), has been settled and that action has been dismissed with prejudice. A copy of the court's order dismissing that action is being filed concurrently herewith as Exhibit 1019.

III. Request to Treat Settlement Agreement as Confidential Information

The Parties' settlement agreement has been made in writing, and a true and correct copy is being filed concurrently herewith as Exhibit 1020 pursuant to 35 U.S.C. § 327(b), along with the Parties' joint request that the settlement agreement be treated as business confidential information, and be kept separate from the file of the involved patent.

IV. Conclusion

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

Express.

Respectfully submitted,

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Date: October 14, 2015

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	INTEGRATED CIRCUIT CARDS, TAGS AND TOKENS (P.L. Hawkes <i>et al.</i> eds., 1990) (collectively, the "Hawkes Chapters"): <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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