

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 REQUEST TO FILE SETTLEMENT AGREEMENT AS BUSINESS
CONFIDENTIAL INFORMATION UNDER 35 U.S.C. § 327(b)**

I. Introduction

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”) have executed a Settlement and Patent Cross-Licensing Agreement (“Agreement”) regarding U.S. Patent No. 5,940,510. Pursuant to 35 U.S.C. § 327(b), the Parties jointly request to file the Agreement between American Express and Maxim (Ex.1020), as referenced in their Joint Motion to Terminate as to American Express filed concurrently herewith,¹ 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.

II. Statement of Precise Relief Requested

The Parties jointly request that the Board treat the Agreement (Ex. 1020) as business confidential information and keep it separate from the file of the involved patent. The Parties further request that the Board to not make the Agreement available to any third-party, except as provided for in 35 U.S.C. § 327(b) and 37

¹ Petitioner constituents have consented to waive the requirement of service of a copy of the settlement agreement in this case.

C.F.R. § 42.74(c).

III. Statement of Reasons for the Relief Requested

The Parties have settled their dispute involving U.S. Patent Nos. 5,940,510. The Agreement provides that its terms are confidential and the parties have treated them as such. The Parties have filed, concurrently herewith, a true and correct copy of the Agreement (Ex. 1020), as required by 35 U.S.C. § 327(b).

Respectfully submitted,

/David M. Tennant/
David M. Tennant, Reg. No. 48362

WHITE & CASE, LLP
701 13th St. NW, #600
Washington, DC 20005
(202) 626-3684
(202) 639-9355 (fax)
dtennant@whitecase.com

*Counsel for Petitioner American
Express Company and American
Express Travel Related Services
Company, Inc.*

/Kenneth J. Weatherwax/
Kenneth J. Weatherwax, Reg. 54,528
Parham Hendifar, Reg. 71,470

LOWENSTEIN & WEATHERWAX LLP
1880 Century Park East, Suite 815
Los Angeles, CA 90067
(310) 307-4503
(310) 307-4509 (fax)
weatherwax@lowensteinweatherwax.com

*Counsel for Patent Owner
Maxim Integrated Products, Inc*

Date: October 14, 2015