

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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 5,940,510

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

BEGLEY, *Administrative Patent Judge*.

DECISION

Joint Motion to Terminate Compass Bank's Participation in This Case;
Joint Request to File Settlement Agreement as Business Confidential
Information

35 U.S.C. § 327, 37 C.F.R. § 42.74

On November 24, 2015, Petitioner Compass Bank (“Compass Bank”) and Patent Owner Maxim Integrated Products, Inc. (“Maxim”) filed a joint motion to terminate Compass Bank’s participation in this proceeding. Paper 30 (“Mot.”). Along with the motion, Compass Bank and Maxim filed what they represent to be a “true and correct” copy of their Settlement Agreement, in accordance with 37 C.F.R. § 42.74(b). Ex. 1022; Mot. 1. The parties also submitted a joint request to file the Settlement Agreement as business confidential information, pursuant to 35 U.S.C. § 327(b). Paper 31.

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 Motion and Request 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)). We recently instituted trial in this proceeding. Maxim has not filed a Response to the Petition, 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 proceeding with respect to Compass Bank. *See* 35 U.S.C. § 327(a); 37 C.F.R. § 42.74(b). We note that termination of Compass Bank's involvement in this proceeding does not terminate the proceeding, because Discover Financial Services, Discover Bank, Discover Products Inc., and State Farm Mutual Automobile Insurance Company remain as petitioners. *See* Mot. 1 n.1.

Turning to the joint request to file the Settlement Agreement as business confidential information, we determine that Compass Bank and Maxim 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 Joint Motion to Terminate Compass Bank's Participation in this Case Pursuant to 35 U.S.C. § 327 (Paper 30) is *granted*;

FURTHER ORDERED that the proceeding continues with Discover Financial Services, Discover Bank, Discover Products Inc., and State Farm Mutual Automobile Insurance Company as petitioners;

FURTHER ORDERED that any subsequent papers filed in this case should not include Compass Bank in the caption; and

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FURTHER ORDERED that the Joint Request to File Settlement Agreement as Business Confidential Information Under 35 U.S.C. § 327(b) (Paper 31) is *granted*.

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