

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 CBM2015-00102
Patent No. 6,237,095

**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. CBM2015-00102,¹ 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 1021.

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 1022 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,

/David M. Tennant/
David M. Tennant, Reg. No. 48,362

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. No. 54,528
Parham Hendifar, Reg. No. 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

PETITIONER’S UPDATED EXHIBIT LIST

Exhibit	Description
Ex. 1001	U.S. Patent No. 6,237,095 (“095 Patent”)
Ex. 1002	File History for U.S. Patent No. 6,237,095
Ex. 1003	<p>INTEGRATED CIRCUIT CARDS, TAGS AND TOKENS (P.L. Hawkes <i>et al.</i> eds., 1990) (collectively, “Hawkes”):</p> <ul style="list-style-type: none"> <input type="checkbox"/> P.L. Hawkes, <i>Preface</i> (“Hawkes Preface”); <input type="checkbox"/> P.L. Hawkes, <i>Introduction to Integrated Circuit Cards, Tags and Tokens for Automatic Identification</i> (“Hawkes Ch. 1”); <input type="checkbox"/> David Eglise, <i>Electronic Coins</i> (“Hawkes Ch. 5”); <input type="checkbox"/> W.L. Price & B.J. Chorley, <i>Secure Transactions with an Intelligent Token</i> (“Hawkes Ch. 6”); and <input type="checkbox"/> D.W. Davies, <i>Cryptography and the Smart Card</i> (“Hawkes Ch. 8”)
Ex. 1004	U.S. Patent No. 5,485,520 (“Chaum”)
Ex. 1005	Steve Ciarcia, <i>Ciarcia’s Circuit Cellar: Build the BASIC-52 Computer/Controller</i> , BYTE MAGAZINE (“Ciarcia”)
Ex. 1006	John Forrest Brown, <i>Embedded Systems Programming in C and Assembly</i> (1994) (“Brown”)
Ex. 1007	Daniel H.H. Ingalls, <i>Design Principles Behind Smalltalk</i> , BYTE MAGAZINE (“Ingalls”)
Ex. 1008	Texas Instruments, <i>TMS7000 Family Microarchitecture</i> , User’s Guide, November 1982
Ex. 1009	Fernando Flischfish et al, <i>A Survey of the Electronic Payment Industry</i> (Mar. 12, 1994), http://web.mit.edu/ecom/Spring1997/gr5/epayment.htm
Ex. 1010	Douglass Reilly, Programmer’s Bookshelf – Book review of John Forrest Brown, <i>Embedded Systems Programming in C and</i>

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.