

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 No. CBM2015-00102

Patent No. 6,237,095 B1

**DISCOVER FINANCIAL SERVICES', DISCOVER BANK'S, DISCOVER
PRODUCTS INC.'S, AND MAXIM INTEGRATED PRODUCTS, INC.'S
JOINT MOTION TO TERMINATE THE DISCOVER ENTITIES'
PARTICIPATION IN THIS CASE PURSUANT TO 35 U.S.C. § 327**

EXHIBIT LIST	
Exhibit 2001	Order of Dismissal With Prejudice, <i>Maxim Integrated Prods., Inc. v. Navy Fed. Credit Union</i> , Civil Action No. 5:14-cv 01032-XR (W.D. Tex. May. 18, 2015)
Exhibit 2002	Confidential Settlement Agreement between Maxim Integrated Products and Navy Federal Credit Union
Exhibit 2003	Disclaimer in Patent Under 37 CFR 1.321(a), U.S. Pat. No. 6,237,095, cl. 7 (09/003,541 Jul. 8, 2015)
Exhibit 2004	U.S. Patent No. 5,805,702 to Curry et al.
Exhibit 2005	Disclaimer in Patent Under 37 CFR 1.321(a), U.S. Pat. No. 5,940,510, cl. 2 (08/594,975 Jun. 19, 2015)
Exhibit 2006	Restriction Requirement, U.S. Patent No. 5,805,702 (08/595,014 Jul. 21, 1997)
Exhibit 2007	Originally-filed claims, U.S. Patent No. 5,805,702 (08/595,014 Jan. 31, 1996)
Exhibit 2008	Hearing Transcript, In re Maxim Integrated Products, Inc., Misc. No. 12-244 (MDL No. 2354) (W.D. Pa. Mar. 20, 2013) (excerpt)
Exhibit 2009	Declaration of Nathan Lowenstein in support of Patent Owner Maxim Integrated Products, Inc.'s Motion For Pro Hac Vice Admission Of Nathan Lowenstein Under 37 C.F.R. § 42.10(c)
Exhibit 2010	Order of Dismissal With Prejudice, No. 5:14-cv-01029-XR (W.D. Tex. Nov. 12, 2015)
Exhibit 2011	Confidential Settlement Agreement between Maxim Integrated Products and Discover Financial Services

Pursuant to 35 U.S.C. § 327(a), Petitioner constituents Discover Financial Services, Discover Bank, and Discover Products Inc. (collectively, “Discover”) and Patent Owner Maxim Integrated Products, Inc. (“Maxim”) jointly request termination of Discover’s participation in this case, No. CBM2015-00102.¹

Discover and Maxim (collectively, the “Parties”) have settled their dispute with respect to the patent at issue. The Parties have submitted a joint stipulated motion to dismiss the related matter in the District Court (*see* Petition § I.B) with prejudice as to Discover, which was granted on November 12, 2015. A copy of the order of dismissal is filed concurrently herewith as Exhibit 2010.

The Parties’ settlement agreement has been made in writing, and a true and correct copy is being filed concurrently herewith as Exhibit 2011 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.

Maxim joins the present Motion solely for the purposes of terminating Discover’s participation going forward.

¹Discover is one of several Petitioner constituents in this case. This motion is not joined by, and does not affect the continued participation of, the other Petitioner constituents in the case.

Therefore, Discover and Maxim respectfully request termination of this case as to Discover.

Respectfully submitted,

 /Daniel M. Lechleiter/
Daniel M. Lechleiter
Reg. No. 58,254

Trevor Carter
Reg. No. 40,549

FAEGRE BAKER DANIELS LLP
300 N. Meridian St., Suite 2700
Indianapolis, IN 46204
(317) 237-0300
Daniel.Lechleiter@FaegreBD.com
Trevor.Carter@FaegreBD.com

*Counsel for Petitioner, constituents
Discover Financial Services, Discover
Bank, Discover Products Inc.*

Dated: November 24, 2015

 /Kenneth J. Weatherwax/
Kenneth J. Weatherwax
Reg. No. 54,528

Nathan Lowenstein
admitted *pro hac vice*

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

*Counsel for Patent Owner,
Maxim Integrated Products, Inc.*

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned hereby certifies that pursuant to agreement by Petitioner and Patent Owner, the foregoing Joint Motion to Terminate Proceeding Pursuant to 35 U.S.C. § 327 and Exhibit 2010 was served on the following by electronic mail, as a PDF attachment, on November 24, 2015:

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

Truman H. Fenton
SLAYDEN GRUBERT BEARD PLLC
tfenton@sgbfirm.com

Pursuant to agreement by Petitioner and Patent Owner, Exhibit 2011 was served on that same day on only the following in order to preserve confidentiality:

Daniel M. Lechleiter
FAEGRE BAKER DANIELS LLP
Daniel.Lechleiter@FaegreBD.com

Trevor Carter
FAEGRE BAKER DANIELS LLP
Trevor.Carter@FaegreBD.com

/Kenneth J. Weatherwax/
Reg. No. 54,528