

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WELLS FARGO BANK, N.A.,
Petitioner,

v.

UNITED SERVICES AUTOMOBILE ASSOCIATION,
Patent Owner.

IPR2020-00090 (Patent 9,177,197 B1)
IPR2020-00091 (Patent 9,177,198 B1)
IPR2020-00092 (Patent 9,569,756 B1)
IPR2020-00095 (Patent 7,974,899 B1)
IPR2020-00096 (Patent 7,962,411 B1)
IPR2020-00097 (Patent 7,885,880 B1)
IPR2020-01516 (Patent 10,402,638 B1)¹

Before MICHAEL R. ZECHER, STACEY G. WHITE, and
TERRENCE W. McMILLIN, *Administrative Patent Judges*.

ZECHER, *Administrative Patent Judge*.

ORDER

Denying Joint Motions to Terminate
35 U.S.C. § 317; 37 C.F.R. § 42.74

¹ This Order addresses an issue that is identical in all seven proceedings. We, therefore, exercise our discretion to issue one Order to be filed in each proceeding. The parties, however, may not use this style heading without seeking prior authorization from the Board.

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I. INTRODUCTION

On February 9, 2021, with our authorization, Petitioner, Wells Fargo Banks, N.A., and Patent Owner, United Services Automobile Association, jointly filed the following in each of the proceedings identified above: (1) a “Joint Motion to Dismiss Proceedings” under 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74² (Paper 27, “Mot.”)³; (2) a copy of the parties’ settlement agreement with a redaction (Ex. 2042); and (3) a “Joint Request to File Agreement as Business Confidential Information and Keep it Separate From the File of [the Involved Patent]” under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 28).

II. APPLICABLE STATUTE AND RULES

“The parties may agree to settle any issue in a proceeding” pursuant to a written agreement, “*a true copy* [of which] shall be filed with the Board before the termination of trial.” 37 C.F.R. 42.74 (a)–(b) (emphasis added). “Any agreement or understanding between the patent owner and a petitioner, including any collateral agreements referred to in such agreement or understanding, made in connection with, or in contemplation of, the termination of an inter partes review . . . shall be in writing and *a true copy*

² For purposes of IPR2020-01516, only 37 C.F.R. § 42.74 is applicable to this proceeding because we have not yet determined whether to institute a trial.

³ Unless otherwise noted, all citations are to the papers and exhibits filed in IPR2020-00090. Similar papers and exhibits were filed in IPR2020-00091, IPR2020-00092, IPR2020-00095, IPR2020-00096, IPR2020-00097, and IPR2020-01516.

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of such agreement or understanding shall be filed in the Office before the termination of the inter partes review as between the parties.” 35 U.S.C. § 317(b) (emphasis added).

III. ANALYSIS

The parties represent that they filed “a true copy of the settlement agreement . . . executed on February 5, 2021.” Mot. 3. The parties, however, filed a redacted version of the settlement agreement. *See generally* Ex. 2042. Consequently, the settlement agreement filed by the parties that is Exhibit 2042 is not a “true copy” of the entire agreement, as required by the governing statute and rules. Because the parties did not comply with 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), the “Joint Motion to Dismiss Proceedings” filed in each proceeding are *denied*. The settlement agreement (Ex. 2042) will be expunged from each proceeding pursuant to 37 C.F.R. § 42.7(a). *See* Paper 29, 3 (ordering the parties to file “a true copy of the settlement agreement”). As a result, the “Joint Request to File Agreement as Business Confidential Information and Keep it Separate From the File of [the Involved Patent]” filed in each proceeding are *dismissed* as moot.

Nevertheless, under these particular circumstances, we recognize that “there are strong public policy reasons to favor settlement between the parties to a proceeding.” *See* Patent Trial and Appeal Board Consolidated Trial Practice Guide⁴ at 86 (discussing the Board’s role in facilitating settlement between parties to a proceeding); *see also* 84 Fed. Reg. 64,280

⁴ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

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(Nov. 21, 2019). Given the strong public policy reasons favoring settlement, we authorize the parties to file a revised joint motion to terminate in each proceeding. As required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), each joint motion to terminate must be accompanied by a true (non-redacted) copy of the settlement agreement and must include a statement certifying that there are no other collateral agreements or understandings made in connection with, or in contemplation of, the termination the proceedings between the parties. To have the settlement agreement treated as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), the parties must file the confidential settlement agreement electronically in Patent Trial and Appeal Board End-to-End (“PTAB E2E”) as an exhibit in accordance with the instructions provided on the Board’s website (uploading as “Parties and Board Only”). The parties are directed to FAQ G2 on the Board’s website at <https://www.uspto.gov/patents/ptab/ptab-e2e-frequently-asked-questions> for guidance on how to file their settlement agreement as confidential.

IV. ORDER

Accordingly, it is

ORDERED that the “Joint Motion to Dismiss Proceedings” filed in each proceeding are *denied* without prejudice;

FURTHER ORDERED that the following documents are expunged pursuant to 37 C.F.R. 42.7(a): (1) IPR2020-00090, Exhibit 2042; (2) IPR2020-00091, Exhibit 2042; (3) IPR2020-00092, Exhibit 2042;

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(4) IPR2020-00095, Exhibit 2021; (5) IPR2020-00096, Exhibit 2021;
(6) IPR2020-00097, Exhibit 2021; and (7) IPR2020-01516, Exhibit 2011.

FURTHER ORDERED that the “Joint Request to File Agreement as Business Confidential Information and Keep it Separate From the File of [the Involved Patent]” filed in each proceeding are *dismissed* as moot;

FURTHER ORDERED that the parties are authorized to file a revised joint motion to terminate in each proceeding, which must be accompanied by a true (non-redacted) copy of the parties’ settlement agreement, pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74; and

FURTHER ORDERED that the parties also are authorized to file a joint request to treat the settlement agreement as business confidential information in each proceeding pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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For PETITIONER:

Gregory Stark
Tyler Nasiedlak
SCHWEGMAN LUNDBERG & WOESSNER, P.A.
gstark@slwip.com
tnasiedlak@slwip.com

Louis Campbell
WINSTON & STRAWN LLP
llcampbell@winston.com

For PATENT OWNER:

Michael Fleming
Babak Redjaian
Anthony Rowles
IRELL & MANELLA LLP
mfleming@irell.com
bredjaian@irell.com
trowles@irell.com