

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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FEDERAL RESERVE BANKS<sup>1</sup>  
Petitioners

v.

LEON STAMBLER  
Patent Owner

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Case IPR2013-00341  
Case IPR2013-00344  
Case IPR2013-00406  
Case IPR2013-00409

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Before THOMAS L. GIANNETTI, BRYAN F. MOORE, and TRENTON A.  
WARD, *Administrative Patent Judges*.

WARD, *Administrative Patent Judge*.

ORDER  
Motion to Terminate  
*37 C.F.R. § 42.72*

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<sup>1</sup> Federal Reserve Bank of Atlanta, Federal Reserve Bank of Boston, Federal Reserve Bank of Chicago, Federal Reserve Bank of Cleveland, Federal Reserve Bank of Dallas, Federal Reserve Bank of Kansas City, Federal Reserve Bank of Minneapolis, Federal Reserve Bank of New York, Federal Reserve Bank of Philadelphia, Federal Reserve Bank of Richmond, Federal Reserve Bank of San Francisco, and Federal Reserve Bank of St. Louis.

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On December 6, 2013, the parties filed a joint motion to terminate the trial proceedings under 35 U.S.C. § 317(a) in the following four *inter partes* review proceedings: IPR2013-00341 (Paper 10); IPR2013-00344 (Paper 9); IPR2013-00406 (Paper 8); and IPR2013-00409 (Paper 9) (collectively the “Federal Reserve Cases”). Along with each motion, the parties filed a copy of a document they described as the written settlement agreement (IPR2013-00341, Ex. 1019; IPR2013-00344, Ex. 1017; IPR2013-00406, Ex. 1117; IPR2013-00409, Ex. 1119), as well as a separate joint request to treat the settlement agreement as business confidential information under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). IPR2013-00341, Paper 10; IPR2013-00344, Paper 9; IPR2013-00406, Paper 8; and IPR2013-00409, Paper 9.

Under 35 U.S.C. § 317(a), “[a]n *inter partes* review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” A trial has not been instituted in any of the Federal Reserve Cases. Furthermore, the parties stated in their motions that they “have settled their dispute, and have reached agreement to terminate these IPR Proceedings.” *See e.g.*, IPR2013-00341, Paper 10, 2.

The parties state in their joint motions that the settlement agreement will be “void *ab initio*” if the petition to institute is granted in any of these proceedings. *Id.* at 3. They, therefore, request that the joint motions “be granted or denied in full as to all of the Petitioners and all of the pending petitions.” *Id.*

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The joint motions identify other related litigation involving the patents at issue in the Federal Reserve Cases, and indicate that these actions have been pending for more than one year. *See e.g.*, IPR2013-00341, Paper 10, 7. One of these, involving Fifth Third Bank, is specifically addressed in the joint motions. As noted in the motions, on December 6, 2013, the Board received an email from counsel for Fifth Third Bank, a defendant in one of the related proceedings, seeking a conference regarding a motion for joinder. *Id.* at 4. Due to the fact that Fifth Third Bank is a third party and had not filed a separate petition against any of the patents at issue in the Federal Reserve Cases, the Board denied Fifth Third Bank's request for a conference. Subsequently, Fifth Third Bank filed such a petition, on December 9, 2013, and sought authorization by the Board to file a motion to join that new proceeding (IPR2014-00244) with IPR2013-00341. The Board held a telephone conference with Petitioner, Patent Owner, and Fifth Third Bank on December 11, 2013. As noted in their joint motions to terminate, both parties oppose Fifth Third Bank's "attempt to intervene after failing to take action to participate in the IPR Proceedings earlier." *Id.* at 3. Following the conference, the Board took Fifth Third Bank's request under advisement, and will issue a separate decision on that request in IPR2014-00244.

The parties are reminded that the Board is not a party to the settlement, and may independently identify any question of patentability. 37 C.F.R § 42.74(a). Generally, however, the Board expects that a proceeding will terminate after the filing of a settlement agreement. *See, e.g., Office Patent Trial Practice Guide*, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012). These proceedings are still in the

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preliminary stages, as the Board has not instituted a trial. The Board is persuaded that, under these circumstances, it is appropriate to terminate these proceedings without rendering a final written decision. 37 C.F.R. § 42.72. The Board does not consider the separate petition filed by Fifth Third Bank, and the possibility of joinder, as sufficient reasons to deny the parties' joint request to terminate the proceedings.

Accordingly, it is:

ORDERED that the joint motion to terminate in each of these proceedings (IPR2013-00341 (Paper 10); IPR2013-00344 (Paper 9); IPR2013-00406 (Paper 8); and IPR2013-00409 (Paper 9)) is GRANTED and each proceeding is hereby terminated;

FURTHER ORDERED that the parties' joint request in each of these proceedings that the settlement agreement (IPR2013-00341, Ex. 1019; IPR2013-00344, Ex. 1017; IPR2013-00406, Ex. 1117; IPR2013-00409, Ex. 1119) be treated as business confidential information, kept separate from the file of the involved patent, and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), is GRANTED.

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