

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMERICAN EXPRESS TRAVEL RELATED SERVICES COMPANY, INC.,
Petitioner,

v.

WILLIAM GRECIA,
Patent Owner.

Case IPR2017-00797
Patent No. 8,887,308

**AMERICAN EXPRESS TRAVEL RELATED SERVICES COMPANY, INC.,
AND WILLIAM GRECIA'S
JOINT MOTION TO TERMINATE PROCEEDING
PURSUANT TO 35 U.S.C. § 327**

On April 4, 2017, the Board authorized Petitioner American Express Travel Related Services Company, Inc. (“American Express”) and Patent Owner William Grecia (“Grecia”) (collectively, “the Parties”) to file in IPR2017-00797, IPR2017-00799, and IPR2017-00801 the following: (i) a joint motion to terminate the IPRs, (ii) a true copy of the written settlement agreement, and (iii) a joint request that the settlement agreement be treated as business confidential information and be kept separate from the files of the involved patents under 35 USC 317(b) and 37 CFR 42.74(c). Thus, the Parties are jointly requesting termination of this case, No. IPR2017-00797.

I. Brief Explanation as to why Termination is Appropriate

American Express and Grecia have settled their dispute with respect to the patent at issue. Because no final written decision has yet been entered and American Express and Grecia are jointly making this motion, termination of this IPR 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 IPR review 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., no. 157, p. 48680 (August 14, 2012). Moreover, terminating post-grant proceedings, such as this IPR review, upon settlement fosters an environment that promotes settlements, thereby creating a timely, cost-effective alternative to litigation. A decision to continue the present IPR review 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. 1:15-cv-09059-RJS (S.D.N.Y), has been dismissed with prejudice. A copy of the court’s order dismissing that action is being filed concurrently herewith as Exhibit 1009.

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 1010 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

For at least these reasons, American Express and Grecia respectfully request termination of this case.

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

/Isaac Rabicoff/

Isaac Rabicoff , Reg. No. 74,147

Rabicoff Law LLC

73 W Monroe St

Chicago, IL 60603

isaac@rabilaw.com

(773) 669-4590

*Counsel for Petitioner American Express
Travel Related Services Company, Inc.*

*Counsel for Patent Owner
William Grecia*

Date: April 10, 2017

PETITIONER'S UPDATED EXHIBIT LIST

Exhibit	Description
Ex. 1001	U.S. Patent No. 8,887,308 (“308 patent”)
Ex. 1002	Declaration of Dr. Richard Kramer (“Kramer”)
Ex. 1003	<i>Grecia v. Amazon.com</i> , No. 2:14-cv-00530 (W.D. Wash. Dec. 22, 2014) (Joint claim construction statement by Patent Owner and Amazon), Ex. C
Ex. 1004	U.S. Pub. No. 2007/0156726 (“Levy”)
Ex. 1005	Business Wire, “Ivex Announces ViewOps Internet Video Service; Allows Business Managers to View and Manage Operations Online” (May 2, 2000)
Ex. 1006	Ivex, ViewOps – <i>User Manual</i> (2000)
Ex. 1007	Excerpts of File History of U.S. Patent No. 8,402,555 (“555FH”)
Ex. 1008	File History of U.S. Patent No. 8,887,308 (“308 FH”)
Ex. 1009	Order of Dismissal With Prejudice, <i>William Grecia v. American Express Company</i> , Civil Action No. 1:15-cv-09059-RJS
Ex. 1010	“Board Only” Confidential Settlement and Patent License Agreement between William Grecia and American Express Company

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.