

Paper No. \_\_\_\_\_  
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Filed on behalf of: PNC Bank, N.A.,  
JP Morgan Chase & Co., and  
JP Morgan Chase Bank, N.A.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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PNC BANK, N.A. AND JP MORGAN CHASE & CO.  
AND JP MORGAN CHASE BANK, N.A.

Petitioner

v.

MAXIM INTEGRATED PRODUCTS, INC.

Patent Owner

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Case CBM2014-00038  
Patent No. 5,940,510

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**PETITIONERS' MOTION REQUESTING ADVERSE JUDGMENT  
AGAINST PNC PURSUANT TO 37 C.F.R. § 42.73(b)(4)**

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## **I. PRELIMINARY STATEMENT**

Petitioners request adverse judgment against PNC Bank, N.A. (“PNC”) per 37 C.F.R. § 42.73(b)(4). PNC filed four petitions for CBM review with JP Morgan Chase & Co. and JP Morgan Chase Bank, N.A. (“JP Morgan”) on November 22, 2013. At the time, the PTO allowed a declaratory judgment (DJ) plaintiff to petition for CBM review. *See* 37 C.F.R. § 42.302(a). Recently, however, the Board denied a CBM petition because the petitioner was a DJ plaintiff before it filed its CBM petition. *See BB&T v. Maxim Integrated Products, Inc.*, CBM2013-00059, paper 12 (March 20, 2014). In view of this decision, PNC—a DJ plaintiff before it filed the four CBM petitions—seeks to withdraw from the four CBM proceedings, as allowed by 37 C.F.R. § 42.73(b).

Although Maxim objects, the rules do not allow for an objection to adverse judgment.

## **II. PRECISE RELIEF REQUESTED**

Petitioners request adverse judgment against PNC per 37 C.F.R. § 42.73(b)(4).

## **III. BACKGROUND**

Consistent with Petitioners’ understanding of the statute and regulations governing CBM review, Petitioners filed four CBM petitions on November 22, 2013. Section 18(a)(1) of the AIA left open the question of whether a DJ plaintiff could petition for CBM review. But, the PTO regulations and practice expressly allowed a DJ plaintiff to petition for CBM review. *Compare* 37 C.F.R. § 42.201(a) (identifying who may petition for post-grant review and explicitly precluding DJ plaintiffs from doing so) *with* 37 C.F.R. § 42.302(a) (identifying who may petition for CBM review

and not addressing DJ plaintiffs); 77 Fed. Reg. 48693 (“This is consistent with section 18(a)(1) of the AIA, which provides that the transitional proceeding shall be regarded as, and shall employ the standards and procedures of, a post-grant review with certain exceptions.”); *SAP v. Pi-Net Int’l*, CBM2013-00013, Paper No. 15 (Sept. 19, 2013) (instituting CBM review despite Petitioner being a DJ plaintiff). In view of PTO regulations and practice, PNC’s filing of the CBM petitions was entirely in good faith.

However, on March 20, 2014, the Board issued an order in *BB&T*, holding for the first time that a petitioner’s filing of a DJ action bars institution of CBM review. Thus, PNC immediately requested a conference call with the Board to withdraw PNC from the four CBM proceedings. On March 28, 2014, the Board issued an Order on Conduct of the Proceedings, directing PNC to file this motion requesting adverse judgment.

#### **IV. ARGUMENT**

37 C.F.R. § 42.73(b)(4) explicitly permits PNC’s request for adverse judgment. Although PNC and JP Morgan jointly filed the CBM petitions-at-issue, the statutory and regulatory framework under 35 U.S.C. § 327 and 37 C.F.R. § 42.73(b) expressly allow for adverse judgment against PNC, and the Patent Owner has no basis to object to PNC’s request. Further, PNC’s request will cause no prejudice to the Patent Owner and will help “secure the just, speedy, and inexpensive resolution” of the proceedings. *See* 37 C.F.R. § 42.1(b). Therefore, Petitioners’ motion for adverse judgment against PNC pursuant to 37 C.F.R. § 42.73(b)(4) should be granted.

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