

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

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

Petitioner

v.

MAXIM INTEGRATED PRODUCTS, INC.

Patent Owner

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

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

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I. MAXIM'S THREE REASONS TO DENY ADVERSE JUDGMENT TO PNC ARE NOT ONLY INCORRECT BUT CONTRARY TO LAW

Maxim presents three erroneous arguments why PNC may not seek adverse judgment: (1) the erroneous argument that one party from a multi-party petition may not withdraw, but 35 U.S.C. §§ 317 and 327 contemplate exactly that; (2) the erroneous argument that PNC remains a real-party-in-interest, even if it abandons, but 37 C.F.R. § 42.73(b) contradicts that argument; and (3) the erroneous argument that PNC's abandonment does not "erase" any commonality between PNC and JP Morgan, but *Fandango* confirms PNC may abandon under these circumstances.¹

II. IN DESPERATION, MAXIM IMPROPERLY AND BASELESSLY RAISES FALSE QUESTIONS OF PETITIONERS' GOOD FAITH

Maxim argues that PNC and JP Morgan somehow acted improperly by submitting the CBM petition, because PNC was a DJ plaintiff. But, before the Board issued the ruling in *BB&T*, the PTO had never resolved the issue whether a DJ plaintiff may seek a CBM. Thus, Maxim's argument that PNC and JP Morgan acted improperly (using JP Morgan as a "straw man") is ludicrous. Indeed, Maxim withholds the fact that JP Morgan was sued by Maxim. *See* Paper 3 at 2. And, Maxim provides no factual basis for its baseless allegations, ignoring that JP Morgan

¹ Maxim's contention that jurisdiction cannot be cured by removing a party contradicts 100 years of jurisprudence. *See Horn v. Lockhart et al.*, 84 U.S. 570, 21 L.Ed. 657 (1873) (dismissal of parties causing a jurisdiction problem obviated the issue).

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