UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

MAXIM INTEGRATED PRODUCTS, INC.
Patent Owner

Case CBM2014-00039
Patent 5,949,880

PATENT OWNER MAXIM INTEGRATED PRODUCTS, INC.'S RESPONSE TO PETITIONER'S MOTION REQUESTING ADVERSE JUDGMENT AGAINST PNC PURSUANT TO 37 C.F.R. § 42.73(b)(4)

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EXHIBIT LIST	
Exhibit 2012	Conference Call Transcript, CBM2014-00038, -00039, -00040 & -00041 (P.T.A.B. Mar. 27, 2014)

Patent Owner Maxim's Preliminary Statement explained at length why the identities of the Petitioner and real parties-in-interest in this CBM review case bar its initiation under 35 U.S.C. § 325(a)(1). Two weeks ago, the Board affirmed in a related case that this statutory bar can apply to CBM patent reviews. Now, PNC and the JP Morgan entities ("Petitioner") request "adverse judgment" against PNC on special terms, in a blatant attempt to launder the original, barred Petition so that JP Morgan can carry on as if PNC had never participated. Petitioner's hope is that it can magically ***un***-declare PNC as a party and real party-in-interest and continue to harass Maxim with baseless, repetitive, and expensive CBM review arguments. Such an outcome is contrary to law and prejudicial to Maxim. The Board should not allow PNC to take judgment on the terms PNC and JP Morgan say they prefer.

Maxim would not object to a truly adverse judgment, one that preserves Petitioner's admission that PNC is a real party-in-interest, and the consequences that flow from PNC's past participation and ongoing interest in this case.

I. BACKGROUND OF PNC'S AND JP MORGAN'S JOINT PETITION.

PNC and JP Morgan are joined at the hip. They both participate in a joint defense group in litigation with Maxim over infringement of the Patent, and have both challenged the Patent in court.[1] Together they also decided to challenge the

[1] PNC's invalidity claim was a declaratory complaint, JP Morgan's a counterclaim.

Patent before this Board. They jointly prepared and filed a Petition for CBM patent review with common counsel. Petition at i, 3, 68-69. They did so even though they believed the statute "was not clear if DJ plaintiffs [like PNC] were able to file CBM." Ex. 2012 (3/27/14 Call) at 2012-005:10-14.

In its Preliminary Response, Maxim explained that PNC's prior suit challenging the Patent bars initiation of review under 35 U.S.C. § 325(a)(1)—and what is more, Petitioner cannot evade that bar now by reducing PNC's role. POPR at 1-2, 28-34. The Board later affirmed in a related case that § 325(a)(1) applies in CBM review. *BB&T v. Maxim*, CBM2013-00059, Paper 12 (Mar. 20, 2014).

Having waited to see what the Board would do in *BB&T*, and disliking what the Board did, PNC and JP Morgan now seek to evade § 325(a)(1) by reconstituting Petitioner to include only JP Morgan.[2] Their request is unprecedented: Maxim believes the Board has never granted "adverse judgment" against less than all of a Petitioner, let alone over any party's objection.

II. "ADVERSE JUDGMENT" CANNOT CONVENIENTLY ERASE THE EFFECTS OF PNC AND JP MORGAN'S JOINT PARTICIPATION.

Petitioner (now calling itself "Petitioners" for the first time) seeks to reconstitute itself and ***un***-declare PNC as a real party-in-interest in an effort to

[2] Petitioner at first told Maxim it wished to drop PNC due to "settlement." There is no settlement, however. And Petitioner's Motion never mentions or relies on one.

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