

Paper No. _____
Filed: April 7, 2014

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 CBM2014-00039
Patent No. 5,949,880

**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)**

TABLE OF CONTENTS

- I. MAXIM’S THREE REASONS TO DENY ADVERSE JUDGMENT TO PNC ARE NOT ONLY INCORRECT BUT CONTRARY TO LAW1
- II. IN DESPERATION, MAXIM IMPROPERLY AND BASELESSLY RAISES FALSE QUESTIONS OF PETITIONERS’ GOOD FAITH1
- III. MAXIM INTENTIONALLY MISREPRESENTS FACTUAL INFORMATION TO THE BOARD, AND PNC CAN PROVE IT2
- IV. PNC SEEKS UNCONDITIONAL ABANDONMENT2

TABLE OF AUTHORITIES

Page(s)

CASES

Horn v. Lockhart et al.,
84 U.S. 570, 21 L.Ed. 657 (1873) 1

STATUTES

35 U.S.C. §§ 317 and 327 1

OTHER AUTHORITIES

37 C.F.R. § 42.302(a)..... 2

37 C.F.R. § 42.73(b) 1, 2

37 C.F.R. § 42.23 2

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 3. 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).

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.