

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

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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 CBM2014-00040

Patent No. 6,105,013

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**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.<sup>1</sup>

**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

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<sup>1</sup> 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).

independently meets the CBM requirements, without PNC. *See* 37 C.F.R. § 42.302(a).  
Petitioners acted in good faith, and because Maxim offers no support of its  
outrageous allegations, it violates at least Rule 42.23 (in addition to the page limits).

### **III. MAXIM INTENTIONALLY MISREPRESENTS FACTUAL INFORMATION TO THE BOARD, AND PNC CAN PROVE IT**

During the telephone conference with the Board, PNC explained that, although PNC and Maxim had reached settlement terms, the written settlement was not complete, so PNC sought abandonment per 37 C.F.R. § 42.73(b). In Maxim's Opposition, however, Maxim asserts that "there is no settlement" as to PNC. *See* Paper 12 at 2, fn. 2. This directly contradicts filings in the district court, which state that "PNC and Maxim have agreed, in principle, to settle their respective claims ... [and] are currently diligently working to execute a settlement agreement." Ex. 1016.

### **IV. PNC SEEKS UNCONDITIONAL ABANDONMENT**

After admitting that PNC may abandon, Maxim then claims that PNC's request is conditional. 37 C.F.R. § 42.73(b) provides that "*a party* may request judgment against itself." (Emphasis added). Adverse judgment disposes of issues related to the requesting party, PNC, but not all issues. In *Fandango*, the Board denied the Petitioners' request because Apple was asking for a second bite at the apple by requesting leave to re-file after having received a preliminary response. PNC does not.

Respectfully submitted,

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/ Lionel M. Lavenue/  
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