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CBM2014-00177, Paper No. 10
CBM2014-00178, Paper No. 10
CBM2014-00179, Paper No. 9
CBM2014-00180, Paper No. 9

Entered: January 29, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

JP MORGAN CHASE & CO., and
JP MORGAN CHASE BANK, N.A.,
Petitioner,

v.

MAXIM INTEGRATED PRODUCTS, INC.,
Patent Owner.

Case CBM2014-00177, Patent 6,237,095 B1
Case CBM2014-00178, Patent 6,105,013
Case CBM2014-00179, Patent 5,940,510
Case CBM2014-00180, Patent 5,949,880

Before TREVOR M. JEFFERSON, MITCHELL G. WEATHERLY, and
KERRY BEGLEY, *Administrative Patent Judges*.

BEGLEY, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding, Request for Briefing
37 C.F.R. § 42.5

CBM2014-00177, -00178, -00179, -00180
Patents 6,237,095 B1; 6,105,013; 5,940,510; 5,949,880

A conference call was held on January 28, 2015. The conference was attended by Judges Weatherly and Begley; Andrea Reister and Gregory Discher for Petitioner JP Morgan Chase & Co. and JP Morgan Chase Bank, N.A. (collectively, “Petitioner”); Kenneth Weatherwax and Parham Hendifar for Patent Owner Maxim Integrated Products, Inc. (“Patent Owner”).

The Board scheduled the call to discuss the status of the district court cases related to these proceedings and any settlement discussions between the parties. In particular, each of the Petitions in these four proceedings states that Patent Owner is currently asserting the patent at issue (U.S. Patent Nos. 6,237,095 B1; 6,105,013; 5,940,510; 5,949,880) against Petitioner in a district court case filed in the U.S. District Court for the Western District of Pennsylvania, *Maxim Integrated Products, Inc. v. JP Morgan Chase & Co.*, No. 2:12-cv-01641-JFC (“the District Court Case”), which has been consolidated into a multidistrict litigation before the court. *E.g.*, CBM2014-00180, Pet. 4; *see, e.g.*, CBM2014-00180, Paper 8. Patent Owner’s Preliminary Responses, however, indicate in a footnote that U.S. Patent No. 5,949,880 (“the ’880 patent”), which is at issue in CBM2014-00180, is no longer “asserted in the litigation against [Petitioner].” *E.g.*, CBM2014-00180, PO Resp. 6 n.2. Neither party has provided any further information regarding the status of the District Court Case.

During the call, Petitioner and Patent Owner explained that counsel for each party in the District Court Case are different than the counsel in these proceedings before the Board. To the best of counsel’s knowledge, the merits of the claims involving the ’880 patent have been resolved and are no longer at issue in the District Court Case. A motion for attorney’s fees with

CBM2014-00177, -00178, -00179, -00180
Patents 6,237,095 B1; 6,105,013; 5,940,510; 5,949,880

respect to these claims, however, remains pending before the district court. The court has scheduled a hearing on this motion, as well as a status and scheduling conference, for February 5, 2015. The parties have not settled the District Court Case with respect to the three other patents at issue in these four proceedings before the Board. Similarly, the parties have not agreed to terminate any of the proceedings before the Board.

We directed the parties' attention to 37 C.F.R. §§ 42.8(a)(3), (b)(2), pursuant to which the parties have an ongoing obligation to file an updated mandatory notice "within 21 days of a change of the information" required in such notices, which includes "any other judicial or administrative matter that would affect, or be affected by, a decision in the proceeding." We instructed Petitioner and Patent Owner to file an updated mandatory notice in at least CBM2014-00180, involving the '880 patent.

In addition, we explained that the developments in the District Court Case regarding the '880 patent may or may not affect Petitioner's standing in CBM2014-00180 under Section 18(a)(1)(B) of the Leahy-Smith America Invents Act ("AIA") and 37 C.F.R. § 42.302(a). We, therefore, ordered briefing on this legal question. We also request that the briefing include a specific factual update regarding developments in the District Court Case with respect to the '880 patent (e.g., whether Patent Owner's claims against Petitioner involving the '880 patent were dismissed in the District Court Case, and if so, when the claims were dismissed and whether they were dismissed with or without prejudice). Given that Patent Owner is not required to file a Preliminary Response, we will not require Patent Owner to address standing at this stage of the proceeding, before a determination on

CBM2014-00177, -00178, -00179, -00180
Patents 6,237,095 B1; 6,105,013; 5,940,510; 5,949,880

whether to institute trial. *See* 37 C.F.R. § 42.207(a). Accordingly, Petitioner is required to file a brief addressing standing, whereas Patent Owner is authorized to do so. Each party's brief may be up to 10 pages and, given the upcoming statutory deadline for our determination of whether to institute trial, must be filed no later than February 4, 2015.

As an alternative to filing this briefing on standing, Petitioner requested authorization for the parties to file a joint motion to terminate CBM2014-00180. We granted authorization for the parties to file, instead of this briefing on standing, a joint motion to terminate the proceeding in CBM2014-00180 on or before the deadline for the briefing. If the parties file such a joint motion to terminate, they should be mindful of the requirements set forth in 35 U.S.C. § 327(b) and 37 C.F.R. § 42.74 that any agreement between the parties made in connection with the termination of the proceeding must be in writing and a copy must be filed with the Board. To the extent that the parties wish to maintain some level of confidentiality for such an agreement, the parties should refer to the procedures set forth in 37 C.F.R. § 42.74(c). Specifically, if the parties wish to have a settlement agreement treated as business confidential information under 37 C.F.R. § 42.74(c), the parties must file the confidential settlement electronically in the Patent Review Processing System ("PRPS") as an exhibit in accordance with the instructions provided on the Board's website (uploading as "Parties and Board Only"). The parties are directed to FAQ G2 on the Board's website at <http://www.uspto.gov/ip/boards/bpai/prps.jsp> for instructions on how to file a settlement agreement as confidential.

CBM2014-00177, -00178, -00179, -00180
Patents 6,237,095 B1; 6,105,013; 5,940,510; 5,949,880

ORDER

Accordingly, it is:

ORDERED that Petitioner and Patent Owner each file updated mandatory notices in CBM2014-00180, pursuant to 37 C.F.R. §§ 42.8(a)(3), (b)(2), by February 4, 2015;

FURTHER ORDERED that the parties are authorized to file a joint motion to terminate CBM2014-00180;

FURTHER ORDERED that unless Petitioner and Patent Owner have filed a joint motion to terminate the proceeding, Petitioner file a brief of no more than 10 pages addressing Petitioner's standing in CBM2014-00180 by February 4, 2015; and

FURTHER ORDERED that Patent Owner is authorized to file a brief of no more than 10 pages addressing Petitioner's standing in CBM2014-00180 by February 4, 2015.

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