

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTEL CORPORATION,
Petitioner

v.

QUALCOMM INCORPORATED,
Patent Owner.

IPR2019-00047
IPR2019-00048
IPR2019-00049¹
Patent 9,154,356 B2

Before MICHELLE N. WORMMEESTER, SCOTT B. HOWARD, and
AARON W. MOORE, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

ORDER
Authorizing Motion to Terminate
37 U.S.C. § 42.05

¹ This Order addresses an issue that is identical in each of the above identified cases. Accordingly, we exercise our discretion to issue one order to be filed in each case. The parties are authorized to use this style heading for the briefs authorized in this Order.

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By email communication of June 3, 2019, Patent Owner seeks Board authorization to file a Motion to Terminate in IPR2019-00047, IPR2019-00048, and IPR2019-00049 (the “Subject IPRs”), and to file a disclaimer of claim 9 of U.S. Patent No. 9,154,356 B2 in IPR2019-00048.

Patent Owner contends that, as a consequence of the issuance of Final Written Decisions concerning the ’356 patent in IPR2019-00128 and IPR2019-00129 on May 27, 2020, Petitioner is estopped from maintaining the Subject IPRs except as to claim 9 in IPR2019-00048, which Patent Owner proposes to disclaim. Patent Owner indicates that Petitioner disagrees with its position and requests to file a response to any motion to terminate.

We authorize Patent Owner to file a Motion to Terminate under 35 U.S.C. § 315(e)(1) and Petitioner to file an Opposition to Patent Owner’s Motion to Terminate. Because the Board must issue a Final Written Decision in IPR2019-00047 by July 9, 2020, Patent Owner’s Motion must be filed no later than Wednesday, June 10, 2020, and Petitioner’s Opposition must be filed no later than Wednesday, June 17, 2020. The Motion and Opposition shall not exceed ten pages each, and no further briefing is authorized.

The parties should consider addressing, at least, whether estoppel applies; if so, whether the Board *may* proceed without Peitioner; and, if so, whether the Board *should* proceed without Petitioner.

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Accordingly, it is:

ORDERED that Patent Owner is authorized to file a single Motion to Terminate, limited to not more than ten pages, in IPR2019-00047, IPR2019-00048, and IPR2019-00049 on or before Wednesday, June 10, 2020;

FURTHER ORDERED that Petitioner may file a single Opposition to Patent Owner's Motion, limited to not more than ten pages, on or before Wednesday, June 17, 2020; and

FURTHER ORDERED that no additional briefing is authorized.

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