UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Intel Corporation,
Petitioner,

v.

Qualcomm Incorporated,
Patent Owner

Case No: IPR2019-00047
U.S. Patent No. 9,154,356

PATENT OWNER'S MOTION TO TERMINATE

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

TABLE OF CONTENTS

Page

I. Introduction....1

II. Statement of Facts....1

III. Argument....2

A. Petitioner Is Estopped From Maintaining The Instant IPRs....2

B. Patent Owner Disclaimed Claim 9, Thus There Are No Remaining Claims In Dispute In The Instant IPRs....6

C. In The Interest Of Providing A Just, Speedy, and Inexpensive Resolution, The Instant IPRs Should Be Terminated....6

IV. Conclusion....10

DOCKET ALARM

Find authenticated court documents without watermarks at docketalarm.com.

TABLE OF AUTHORITIES

Page

CASES

Apple Inc. v. Papst Licensing GmbH & Co., KG,
IPR2016-01860, Paper 28 (Jan. 10, 2018).....4, 8, 9

Facebook, Inc. v. Uniloc USA, Inc.,
IPR2017-01427, Paper 30 (May 29, 2018).....4

Intuitive Surgical, Inc. v. Ethicon LLC,
IPR2018-01248, Paper 34 (Feb. 6, 2020).....3, 4, 5, 7

Kingston Tech. Co., Inc. v. Spex Techs., Inc.,
IPR2018-01002, Paper 12 (Nov. 6, 2018).....3

Medtronic, Inc. v. Robert Bosch Healthcare Sys., Inc.,
839 F.3d 1382 (Fed. Cir. 2016).....6

SK Hynix Inc. v. Netlist, Inc.,
IPR2018-00364, Paper 32 (Aug. 5, 2019).....7, 8

STATUTES

35 U.S.C. § 315(e)(1).....1, 2, 5

35 U.S.C. § 317(a).....7

OTHER AUTHORITIES

37 C.F.R. § 1.321(a).....6

37 C.F.R. § 42.1(b).....8

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

37 C.F.R § 42.2 9

37 C.F.R. § 42.72 6

PTAB TRIAL PRACTICE GUIDE UPDATE (July 2019).....9, 10

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

I. Introduction

Patent Owner requests that the Board terminate IPR2019-00047, IPR2019-00048, and IPR2019-00049 ("the instant IPRs").[1] As a result of final written decisions that address claims Petitioner challenged in IPR2019-00128 and IPR2019-00129 ("the related IPRs"), Petitioner is statutorily estopped under 35 U.S.C. § 315(e)(1) from maintaining the instant IPRs because Petitioner reasonably could have raised the grounds in the related IPRs.

Claim 9 in the 00048 IPR is the only claim not covered by the final written decisions in the related IPRs. To resolve Petitioner's challenge to this claim, Patent Owner filed a statutory disclaimer of claim 9.

Because there are no disputed issues remaining, the Board should terminate the instant IPRs. Doing so would be appropriate, given the Board's objective to deliver a "just, speedy, and inexpensive resolution of every proceeding." 37 C.F.R. §42.1(b).

II. Statement of Facts

Petitioner filed five IPR petitions challenging U.S. Patent No. 9,154,356 ("the '356 Patent"). The three instant IPRs were filed on November 8, 2018. The two related IPRs were filed one day later on November 9, 2018. The five IPRs proceeded under separate scheduling orders—one schedule track for the instant

[1] Patent Owner filed identical Motions To Terminate in each of the instant IPRs.

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

DOCKET ALARM

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.