

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
Denying Motion to Terminate
37 C.F.R. § 42.5

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.

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Background

Petitioner filed IPR2019-00047 on November 8, 2018, presenting challenges to certain claims of U.S. Patent No. 9,154,356 B2 (the “’356 patent”) in which *Uehara* was the primary reference. Petitioner also filed IPR2019-00048 and IPR2019-00049 on November 8, 2018, presenting challenges to certain claims of the ’356 patent in which *Xiong* was the primary reference. The next day, November 9, 2018, Petitioner filed IPR2019-00128 and IPR2019-00129, presenting challenges to certain claims of the ’356 patent in which *Lee* was the primary reference.

On December 4, 2018, the Board issued notices establishing November 9, 2018 as the filing date for the 00128 and 00129 petitions. *See* IPR2019-00128, Paper 6; IPR2019-00128, Paper 6. On January 17, 2019, the Board issued notices establishing November 8, 2018 as the filing date for the 00047 and 00048 petitions. *See* IPR2019-00047, Paper 6; IPR2019-00048, Paper 6. On January 25, 2019, the Board issued a notice establishing November 8, 2018 as the filing date for the 00049 petition. *See* IPR2019-00049, Paper 6.

The 00128 and 00129 IPRs were instituted on May 29, 2019. *See, e.g.*, IPR2019-00128, Paper 9. The 00047 IPR was instituted on July 9, 2019. *See, e.g.*, IPR2019-00047, Paper 8. We found the 00047 petition not redundant of the other petitions because it relied on different art and arguments. *See id.* at 9–10. The 00048 and 00049 IPRs were instituted on July 10, 2019. *See, e.g.*, IPR2019-00048, Paper 8. We found those petitions not redundant or cumulative of the others because they “present[ed] both

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different primary references and a fundamentally different theory of unpatentability.” *Id.* at 10.

Because the filing date notices for the November 8, 2020 petitions (the “Earlier IPRs”) were issued more than a month after the November 9, 2020 petitions (the “Later IPRs”), the schedules for Earlier IPRs lagged those of Later IPRs, and Final Written Decisions in the Later IPRs issued on May 27, 2020, while the statutory deadlines to complete the Earlier IPRs fall on July 9, 2020 and July 10, 2020.

By email communication of June 3, 2019, Patent Owner sought Board authorization to file a Motion to Terminate the Earlier IPRs. We authorized the filing (*see* Paper 31²), Patent Owner filed a Motion to Terminate (Paper 32, the “Motion”), and Petitioner filed an Opposition to the Motion to Terminate (Paper 33, “Opp.”).

Patent Owner’s Arguments

Patent Owner argues that Petitioner is estopped from maintaining the the Earlier IPRs with respect to claims addressed in the Later IPRs by 35 U.S.C. § 315(e)(1), which provides that

[t]he petitioner in an inter partes review of a claim in a patent under this chapter that results in a final written decision . . . may not request or maintain a proceeding before the Office with respect to that claim on any ground that the petitioner raised or reasonably could have raised during that inter partes review.

Motion 2–3. According to Patent Owner, “Petitioner may not remain a party with respect to these claims and must be terminated from the proceedings.”

Id. at 3. Patent Owner argues that because “Petitioner filed the [Earlier

² The record citations in the rest of this decision are to IPR2018-00048.

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IPRs] *before* filing the [Later IPRs] . . . there can be no dispute that Petitioner had discovered the prior art supporting the grounds in the [Earlier IPRs], and therefore reasonably could have included those grounds in the [Later IPRs].” *Id.* at 3–4. In other words, Patent Owner argues that Petitioner is estopped because it could have raised the Uehara and Xiong grounds that are the subject of the Earlier IPRs as additional grounds in the Later IPRs that are based on Lee.

Patent Owner has also filed a disclaimer of the only claim in the Earlier IPRs not addressed in the final decisions in the Later IPRs (*see* Ex. 2031) and asserts that the “disclaimer resolves the dispute as to all instituted claims in each of the [Earlier IPRs],” such that “Petitioner has no further challenges remaining for the Board to address.” Motion 6.

Patent Owner acknowledges that “[t]he Board has previously held that it has discretion to continue an IPR even after terminating the petitioner due to estoppel” but argues that “because the estoppel provision does not expressly authorize the Board to proceed without a Petitioner, the statute should be read to mean the [Earlier IPRs] must be terminated.” Motion 7.

Patent Owner further argues that “[e]ven if this panel determines that it has discretion to proceed, the [Earlier IPRs] should be terminated” because “the task of completing three additional final written decisions would be an inefficient use of the patent system” and would not promote “the just, speedy, and inexpensive resolution of every proceeding,” that “[f]ollowing Petitioner’s termination due to estoppel, there is no longer a contested case for the Board to resolve,” and that “parallel petitions challenging the same patent are disfavored.” *Id.* at 8–9.

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Petitioner's Arguments

Petitioner argues that because it had already raised the Uehara and Xiong grounds in the Earlier IPRs, it “could not ‘reasonably’ have raised them for a second time the next day in the [Later IPRs].” Opp. 2. Petitioner contends that Section 325(d) “authorizes rejection of just such petitions” and that it is not aware of any Board rule or procedure under which it could have filed exactly the same grounds in petitions filed one day later. *Id.* at 2–3.

Petitioner points out that “[i]n all of the cases on which the Patent Owner relies, the petitioner filed its estopped petitions either later than or at the same time as the petitions giving rise to the estoppel” and “none of the cases upon which Patent Owner relies is precedential.” Opp. 3.

Petitioner also argues that “prior Board decisions recognize that ‘simultaneously’ filed IPR petitions do not give rise to an estoppel under 35 U.S.C. § 315(e)(1)” and that “[u]nder the logic of that rule, petitions filed one day apart should likewise not be subject to estoppel.” Opp. 4.

Petitioner further argues that “[e]ven if the Petitioner were estopped, the Board should proceed to a final written decision” because the Board has discretion to do so and “[g]iven the late stage of the proceedings and the fully developed record in the [Earlier IPRs], termination would not be appropriate.” Opp. 5–6.

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