

Petitioners' Opposition to Patent Owner's Motion to Terminate
IPR2019-00047, -00048, -00049

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
U.S. Patent No. 9,154,356

**PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION TO
TERMINATE**

¹ The Board has authorized this style heading for briefs authorized by the Order Authorizing Motion to Terminate. IPR2019-00047, Paper 31, at 1.

I. INTRODUCTION

After the completion of briefing and the oral hearing in IPR2019-00047, IPR2019-00048, and IPR2019-00049 (“the instant IPRs”), Patent Owner now seeks to terminate, arguing that issuance of final written decisions in a second set of IPR petitions (“second-filed IPRs”), filed later in time, estops Intel from maintaining the instant IPRs under 35 U.S.C. § 315(e)(1). Patent Owner’s motion should be denied because the estoppel provision of § 315(e)(1) does not apply, since the grounds of the instant IPRs could not “reasonably” have been raised in the second-filed IPRs. Moreover, termination of the instant IPRs would not be appropriate even if Petitioner were estopped under § 315(e)(1).

II. STATEMENT OF FACTS

Petitioner filed the instant IPRs challenging claims of U.S. Patent No. 9,154,356 on November 8, 2018. The following day, Petitioner filed the second-filed IPRs (IPR2019-00128 and IPR2019-00129). The Board accorded a filing date to the second-filed IPRs on December 4, 2019, but did not accord a filing date to the instant IPRs until January 17, 2020, more than six weeks later. Both the instant IPRs and the second-filed IPRs were assigned to the same panel. Because of their different dates of Notices of Filing Date Accorded, the two sets of IPRs were subject to significantly different pre-institution statutory deadlines for briefing and institution decisions.

The Board instituted the second-filed IPRs on May 29, 2019 and the instant IPRs on July 9, 2019. It set procedural schedules for the two sets of proceedings that included an oral hearing in the second-filed IPRs on February 27, 2020 and an oral hearing in the instant IPRs on April 7, 2020. On May 27, 2020, more than six weeks after the conclusion of both oral hearings, the Board issued a final written decision in the second-filed IPRs, holding none of the challenged claims unpatentable. The Board has not yet issued its final written decision in the instant IPRs. Patent Owner has moved to terminate, arguing estoppel under § 315(e)(1).

III. ARGUMENT

A. Estoppel Does Not Apply Under § 315(e)(1)

The estoppel provision of § 315(e)(1) does not apply to the instant IPRs. *First*, Petitioner could not reasonably have raised the grounds asserted in the instant IPRs in the second-filed IPRs. Section 315(e)(1) states that the petitioner in an IPR that results in a final written decision on a claim of a patent “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*.” (emphasis added). Here, Petitioner had already raised the grounds in the instant IPRs *before* it filed the second-filed IPRs. Petitioner could not “reasonably” have raised them for a second time the next day in the second-filed IPRs. 35 U.S.C. § 325(d) authorizes rejection of just such petitions: “the

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Director may ... reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.” Nor is Petitioner aware of any Board rule or procedure under which it could have filed exactly the same grounds in petitions filed one day later.

In 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. In *Kingston Technology Co. v. Spex Technologies, Inc.*, the second filed petition was filed months after the first. IPR2018-01002, Paper 12 (Nov. 6, 2018) (“*Kingston*”). Similarly, in *Facebook, Inc. v. Uniloc USA, Inc.* and *Apple Inc. v. Papst Licensing GmbH & Co.*, the issued final written decision was the result of an earlier filed petition, even though the estopped party did not join the earlier filed IPR until after it filed its own separate petition. See *Facebook, Inc. v. Uniloc USA, Inc.*, IPR2017-01427, Paper 30 (May 29, 2018); *Apple Inc. v. Uniloc Luxembourg S.A.*, IPR2017-00225, Paper 29 (May 23, 2018); *Apple Inc. v. Papst Licensing GMBH*, IPR2016-01860, Paper 28 (Jan. 10, 2018) (“*Papst*”); *Canon Inc. v. Pabst Licensing GmbH & Co.*, IPR2016-01212, Paper 32 (Dec. 11, 2017). Finally, in *Intuitive Surgical, Inc. v. Ethicon LLC*, the petition giving rise to estoppel was filed simultaneously with the estopped petition. IPR2018-01248, Paper 34, at 10-11 (Feb. 6, 2020) (“*Intuitive Surgical*”). Thus, in all of those

proceedings, the petitioner could “reasonably” have raised the estopped grounds at the time that it filed the other IPRs—but elected not to do so. *See Papst*, IPR2016-01860, Paper 28 at 6 (emphasizing the importance of Apple’s choice as to the timing and manner in which it raised the grounds it did). But here, at the time Petitioner filed the second-filed IPRs, it could not reasonably have raised the grounds in the instant IPRs, which were already pending before the Board. Thus, the predicate for creating estoppel under § 315(e)(1)—that petitioner raised or reasonably could have raised the ground during its other IPR proceeding—is not satisfied.

Second, prior Board decisions recognize that “simultaneously” filed IPR petitions do not give rise to an estoppel under 35 U.S.C. § 315(e)(1). In *SK Hynix Inc. v. Netlist, Inc.*, IPR2018-00364, Paper 32, at 9 (Aug. 5, 2019) (“*SK Hynix*”), the Board explained that given the word limits on petitions, “whether grounds are raised in one petition or more than one petition on the same day ***will not have estoppel effect*** on other grounds raised in a petition filed the same day.” (emphasis added). *See also Kingston*, IPR2018-01002, Paper 12 at 8-9. Under the logic of that rule, petitions filed one day apart should likewise not be subject to estoppel. The same concerns regarding word count that the Board recognized in *SK Hynix* apply equally. Similarly, Petitioner faced the same concerns regarding groupings of grounds, filing logistics, and efficiency with respect to multiple petitions.

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