

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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Intel Corporation,  
Petitioner,

v.

Qualcomm Incorporated,  
Patent Owner

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Case No: IPR2019-00049  
U.S. Patent No. 9,154,356

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**PATENT OWNER'S MOTION TO TERMINATE**

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## **I. Introduction**

Patent Owner requests that the Board terminate IPR2019-00047, IPR2019-00048, and IPR2019-00049 (“the instant IPRs”).<sup>1</sup> 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

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<sup>1</sup> Patent Owner filed identical Motions To Terminate in each of the instant IPRs.

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