

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

AMERICAN MEGATRENDS, INC.,  
MICRO-STAR INTERNATIONAL CO., LTD,  
MSI COMPUTER CORP.,  
GIGA-BYTE TECHNOLOGY CO., LTD., AND  
G.B.T., INC.  
Petitioners,

v.

KINGLITE HOLDINGS INC.

Patent Owner

---

Case IPR2016-00114

U.S. Patent 5,937,200

---

**JOINT MOTION TO TERMINATE THE PROCEEDINGS**  
**UNDER 35 U.S.C. § 317(a)**

## Joint Motion to Terminate

As authorized in the Patent Trial and Appeal Board's (the "Board") November 23, 2016 e-mail, and pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. §§ and 42.74, Patent Owner Kinglite Holdings, Inc ("Patent Owner") and Petitioners American Megatrends, Inc., Micro-Star International Co., Ltd, MSI Computer Corp., Giga-Byte Technology Co., Ltd., and G.B.T., Inc. ("Petitioners") jointly and respectfully request that the *inter partes* review ("IPR") of U.S. Patent No. 5,937,200 be terminated.

### **1. Brief Explanation as to Why Termination is Appropriate**

The Board instituted trial in the instant *inter partes* review proceeding.

Although substantive briefing is complete, the parties have not yet participated in oral argument, where such oral argument is tentatively scheduled for January 24, 2017. (Scheduling order, paper 16). On November 21, 2016, Patent Owner and Petitioners settled their dispute and executed a confidential settlement agreement to terminate this proceeding and the parties' related district court litigations listed below. A Stipulation and Order of Dismissal agreed to by the parties in the related district court litigation has been filed in the district court.

Pursuant to 37 C.F.R. § 42.74(b), the parties' confidential settlement agreement is in writing, and a true and correct copy is being filed concurrently herewith as Exhibit 1021. The parties are also filing concurrently herewith a joint request to treat the confidential settlement agreement as business confidential information and keep it separate from the files of the IPR and the involved patent under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

Termination of this proceeding is proper under 35 U.S.C. § 317(a). The Board has terminated such proceedings in cases where “the matter was fully briefed and ready for final hearing.” *Medline Industries, Inc. v. Paul Hartmann AG*, IPR 2013-00173, paper 44 (PTAB 2014); *see also The Brinkman Corporation v. A&J Manufacturing, LLC*, IPR 2015-00056, paper 26, (PTAB 2015) (terminating trial when it “is at an advanced stage post-institution of trial [and] oral argument has not yet occurred”). Accordingly, the parties respectfully request that the Board terminate the instant *inter partes* review.

## **2. Related Litigations Involving the Patent-at-Issue**

The related litigations involving the patent at issue in this proceeding, as well as the defendants in each case, are set forth below.

1. *Kinglite Holdings, Inc. v. Micro-Star International Co., Ltd., et al.*, 14-cv-03009 (C.D. Cal.),
2. *Kinglite Holdings, Inc. v. Giga-Byte Technology Co., Ltd., et al.*, 14-cv-04989 (C.D. Cal.),
3. *Kinglite Holdings, Inc. v. Micro-Star International Co., Ltd., et al.*, 15-cv-09612 (C.D. Cal.),
4. *Kinglite Holdings, Inc. v. Giga-Byte Technology Co., Ltd., et al.*, 15-cv-09615 (C.D. Cal.), and
5. *Kinglite Holdings, Inc. v. EliteGroup Computer Systems Co., Ltd., et al.*, 16-cv-00912 (N.D. Cal.).

Joint Motion to Terminate

**3. Related Proceedings Currently Before the Office**

There are no related proceedings currently before the Office involving the patent-at-issue and Petitioners. The parties are likewise concurrently filing a similar motion to terminate with respect to Case No. IPR2015-01189.

**4. Conclusion**

For the foregoing reasons, the parties jointly and respectfully request termination of the present proceeding.

Date: November 25, 2016

Respectfully submitted,

/Vivek Ganti/

Vivek Ganti (Reg. No. 71,368)  
Lead Counsel for Petitioners  
HILL, KERTSCHER & WHARTON,  
LLP  
3350 Riverwood Pkwy, Suite 800  
Atlanta, GA 30339  
(770) 953-0995

/Christopher Frerking, reg. no. 42,557/

Christopher Frerking  
Lead Counsel for Patent Owner  
174 Rumford Street  
Concord, New Hampshire 03301  
Telephone: (603) 706-3127

**CERTIFICATION OF SERVICE**

The undersigned hereby certifies that the foregoing paper and any supporting materials were served via electronic mail on November 25, 2016, as agreed to by the parties pursuant to 37 C.F.R. § 42.105, in its entirety on the following:

Christopher Frerking  
[chris@ntknet.com](mailto:chris@ntknet.com)  
174 Rumford Street  
Concord, New Hampshire 03301  
Telephone: (603) 706-3127

George C. Summerfield  
[summerfield@stadheimgear.com](mailto:summerfield@stadheimgear.com)  
STADHEIM & GREAR, LTD.  
400 N. Michigan Ave.,  
Suite 2200  
Chicago, Illinois 60611  
Telephone: (312) 755-4400

Respectfully submitted,

**HILL, KERTSCHER & WHARTON,  
LLP**

Date: November 25, 2016

/Vivek Ganti/  
Vivek Ganti (Reg. No. 71,368)  
Lead Counsel for Petitioners

3350 Riverwood Pkwy, Suite 800  
Atlanta, GA 30339  
(770) 953-0995