

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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KINGSTON TECHNOLOGY COMPANY, INC.,  
Petitioner,

v.

SPEX TECHNOLOGIES, INC.,  
Patent Owner.

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IPR2017-01021  
Patent 6,003,135

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Before LYNNE E. PETTIGREW, CHARLES J. BOUDREAU, and  
NORMAN H. BEAMER, *Administrative Patent Judges*.

BOUDREAU, *Administrative Patent Judge*.

TERMINATION  
Due to Settlement on Remand  
*35 U.S.C. § 317; 37 C.F.R. § 42.74*

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This case is before us on remand from the U.S. Court of Appeals for the Federal Circuit. *Kingston Tech. Co. v. SPEX Techs., Inc.*, 798 F. Appx. 629 (Fed. Cir. 2020). On November 5, 2020, with our authorization, the parties filed a “Joint Motion to Terminate Pursuant to 35 U.S.C. § 317 and Joint Request to Keep Separate Pursuant to [35] U.S.C. § 317(b) and 37 C.F.R. § 42.74.” Paper 45 (“Motion”). The parties represent in the Motion that they “have settled with respect to [U.S. Patent No. 6,003,135 (“the ’135 patent”)] and have reached agreement to terminate this IPR,” that “[t]he settlement agreement between the parties has been made in writing,” that “a true and correct copy of the settlement agreement . . . will be filed with this request as Exhibit 3001,” and that “[t]he parties have filed a copy of the settlement agreement with the Board, as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74.” Motion 1, 3, 4.<sup>1</sup> Indeed, a copy of the parties’ settlement agreement, labeled as “Exhibit 3001,” was filed along with the Motion as Exhibit 2005 in the record of this case.

The parties have not identified any other proceedings currently pending before the Office involving challenges to the subject ’135 patent, and the parties further indicate in the Motion that “[n]o other party’s rights will be prejudiced by the termination of this *inter partes* review” and that “[t]he District court in the action of *SPEX Technologies, Inc. v. Kingston Technology Corporation, et al.*, Case No. 8:16-cv-1790 . . . pending in the Central District of California has dismissed the claims that relate to the ’135 patent.” Motion 3.

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<sup>1</sup> The Motion does not include page numbers. We reference page numbers with page 1 being the first page after the title page.

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Under the present circumstances, we determine that it is appropriate to terminate this proceeding without rendering a final written decision on remand pursuant to 35 U.S.C. § 318(a). *See* 35 U.S.C. § 317; 37 C.F.R. §§ 42.72, 42.74. We also grant the parties' request to treat the settlement agreement as business confidential information to be kept separate from the files of this proceeding and the files of the '135 patent. Motion 3.

### ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Joint Motion to Terminate Pursuant to 35 U.S.C. § 317 and Joint Request to Keep Separate Pursuant to [35] U.S.C. § 317(b) and 37 C.F.R. § 42.74 is granted;

FURTHER ORDERED that this proceeding is accordingly terminated as to all parties; and

FURTHER ORDERED that Exhibit 2005 is accordingly to be kept separate from the file of the involved U.S. Patent No. 6,003,135 under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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