

IPR2019-00644
Patent RE45,542

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

KINGSTON TECHNOLOGY COMPANY, INC.,
Petitioner

v.

MEMORY TECHNOLOGIES, LLC,
Patent Owner

Case IPR2019-00644
Reissued Patent RE45,542

**PETITIONER'S RESPONSE TO ORDER ON THE CONDUCT OF
PROCEEDINGS UNDER 37 C.F.R. § 42.5 (PAPER 7)**

Kingston Technology Company, Inc. (“Petitioner” or “Kingston”) hereby respectfully responds to the Board’s Order on the Conduct of Proceedings, entered on July 25, 2019 (Paper 7). Per that Order and 37 C.F.R. § 42.104(a), Petitioner Kingston certifies that Reissued U.S. Patent No. RE45,542 (the “RE542 Patent”) for which review is sought is available for *inter partes* review and that Petitioner is not barred or estopped from requesting an *inter partes* review challenging the patent claims on the grounds identified in the Petition (Paper 1).

This express certification was inadvertently omitted from the Petition. The Petition represents that:

Patent Owner Memory Technologies, LLC (“MTL”) has asserted the Challenged Claims of the RE542 Patent, as well as claims from seven other patents, against Kingston in a co-pending litigation, *Memory Technologies, LLC v. Kingston Technology Co., Inc.*, 8:18-cv-00171 (C.D. Cal.). MTL’s original Complaint was filed on January 31, 2018, and served, at the earliest, on February 1, 2018.

In addition to this Petition, Kingston has or will be filing petitions for *inter partes* review of the other seven patents that MTL has asserted against it.

(Paper 1 at 2.) Petitioner included the statement quoted above in the Petition regarding when Petitioner was served with Patent Owner’s Complaint asserting the RE542 Patent and seven other patents to show that Petitioner had filed the instant Petition—filed on January 30, 2019—within the statutory time period and,

IPR2019-00644
Patent RE45,542

therefore, that Petitioner was not barred or estopped from requesting *inter partes* review of the RE542 Patent (or of any of the other seven patents that Patent Owner has asserted against Petitioner in the related litigation) on the grounds identified in the Petition. Petitioner included a certification in the first Petition it filed on the eight patents that Patent Owner has asserted in the related litigation—on U.S. Patent No. 7,827,370—that Petitioner is in compliance with 37 C.F.R. § 42.104. (Case IPR2019-00638, Paper 1 at 4.) This certification applies to all eight patents that Patent Owner has asserted against Petitioner in the related litigation and that Kingston has challenged with Petitions for *inter partes* review. (See IPR2019-00638, IPR2019-000642, IPR2019-00643, IPR2019-00644, IPR2019-00645, IPR2019-00648, IPR2019-00651, IPR2019-00654.) However, the express certification was inadvertently omitted from the Petition in this case, for which Petitioner respectfully seeks leave from the Board to include in the file by way of this Paper.

Petitioner respectfully requests that the Board accept Petitioner's certification under 37 C.F.R. § 42.104(a) contained herein and its apologies for the inadvertent omission of the same in the Petition.

IPR2019-00644
Patent RE45,542

Dated: July 26, 2019

Respectfully submitted,

/Robert C.F. Pérez/

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true copy of the foregoing

PETITIONER'S RESPONSE TO ORDER ON THE CONDUCT OF

PROCEEDINGS UNDER 37 C.F.R. § 42.5 (PAPER 7) has been served in its

entirety this 26th of July 2019, by e-mail on counsel for Patent Owner:

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