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 IPR2019-00648
Patent No. 9,063,850 B2

JOINT MOTION TO TERMINATE
PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R. § 42.74

Pursuant to 35 U.S.C. § 317, 37 C.F.R. §§ 42.72 and 42.74, and the Board's authorization of September 5, 2019, Petitioner Kingston Technology Company, Inc. and Patent Owner Memory Technologies, LLC jointly move to terminate the present *inter partes* review proceeding with respect to Petitioner in light of Patent Owner's and Petitioner's settlement of their dispute regarding U.S. Patent No. 9,063,850 ("the '850 Patent").

Petitioner and Patent Owner are concurrently filing a true copy of their written Settlement Agreement (Confidential Exhibit 1021) in connection with this matter as required by the statute. Petitioner and Patent Owner certify that there are no other agreements or understandings, oral or written, between the parties, including any collateral agreements, made in connection with, or in contemplation of, the termination of the present proceeding with respect to Petitioner. A joint request to treat the Settlement Agreement as business confidential information kept separate from the file of the involved patent pursuant to 35 U.S.C. § 317(b) is being filed concurrently.

LEGAL STANDARD

An *inter partes* review proceeding "shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination

is filed." 35 U.S.C. § 317(a). A joint motion to terminate generally "must (1) include a brief explanation as to why termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue; (3) identify any related proceedings currently before the Office, and (4) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding." *Heartland Tanning, Inc. v. Sunless, Inc.*, IPR2014-00018, Paper No. 26, at *2 (P.T.A.B. July 28, 2014).

The Board has consistently granted a request to terminate a proceeding for both the petitioner and patent owner when the request is filed before briefing has completed, which is the case here, as the Institution Decision was just issued on September 5, 2019 (Paper 8). *See, e.g.*, *Itron, Inc. v. Certified Measurement*, IPR 2015-00570, Paper 28, at 2-3 (P.T.A.B. February 16, 2016) (terminating the proceedings for both Patent Owner and Petitioner while noting that since "Petitioner has not yet filed a Reply in any of the cases, … if we do not terminate these proceedings with respect to Patent Owner, … [the Board] will be required to determine patentability on less than a full record"); *CB Distributors, Inc. and DR Distributors, LLC v. Fontem Holdings 1 B.V.*, IPR2014-01529, Paper 41, at 4 (P.T.A.B. December 7, 2015) (terminating the proceedings for both Patent Owner and Petitioner where a reply to the Patent Owner Response had yet to be filed).

ARGUMENT

Termination of the present *inter partes* review proceeding is appropriate because (1) Petitioner and Patent Owner have resolved their dispute regarding the '850 Patent and have agreed to terminate this proceeding, (2) the Office has not yet decided the merits of the proceeding, and (3) public policy favors the termination.

Although the Board has instituted trial (Paper 8), the Office has not decided the merits of the proceeding. Moreover, the current record is incomplete because briefing is still open. The Institution Decision was just issued on September 5, 2019. (Paper 8.) This strongly favors termination. *See, e.g.*, *Itron, Inc.*, IPR 2015-00570, Paper 28, at 2-3; *CB Distributors*, IPR2014-01529, Paper 41, at 4.

Public policy also favors the termination. As recognized by the rules of practice before the Board:

> There are strong public policy reasons to favor settlement between the parties to a proceeding. The Board will be available to facilitate settlement discussions, and where appropriate, may require a settlement discussion as part of the proceeding. The Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding.

Patent Office Trial Practice Guide, Fed. Register, Vol. 77, No. 157 at 48768 (Aug. 14, 2012). Moreover, no public interest or other factors militate against termination of this proceeding.

As to the remaining *Heartland Tanning* requirements regarding the identification and status of related proceedings, Petitioner and Patent Owner represent that there are not any other proceedings before the Board on the '850 Patent. There is one related district court litigation, in which Petitioner and Patent Owner are both parties, *Memory Technologies, LLC v. Kingston Technology Corporation et al.*, No. 8-18-cv-00171 (C.D. Cal. Jan. 31, 2018). The parties to this related litigation have filed a motion to dismiss the action in its entirety, including all claims regarding the '850 Patent, which has been granted. As such, there are no parties that would obtain any benefit by the continuance of this proceeding.

CONCLUSION

For the foregoing reasons, Petitioner and Patent Owner jointly and respectfully request that the instant proceeding be terminated.

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