

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WESTERN DIGITAL CORPORATION,
TOSHIBA CORPORATION,
TOSHIBA AMERICA ELECTRONIC COMPONENTS, INC., and
APRICORN
Petitioner,

v.

SPEX TECHNOLOGIES, INC.,
Patent Owner.

Case IPR2018-00084¹
Patent 6,003,135

Before LYNNE E. PETTIGREW, DANIEL N. FISHMAN, and
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

FISHMAN, *Administrative Patent Judge*.

ORDER
Dismissing the Proceedings
35 U.S.C. § 317(a) and 37 C.F.R. §§ 42.5, 42.71(a), 42.72

¹ Toshiba Corporation, Toshiba America Electronic Components, Inc., and Apricorn, which filed a Petition in Case IPR2018-01068, have been joined as petitioners in this proceeding.

On January 11, 2019, Western Digital Corporation, Toshiba Corporation, Toshiba America Electronic Components, Inc., and Apricorn (collectively, “Petitioner”) and SPEX Technologies, Inc. (“Patent Owner”) filed a Joint Motion to Terminate. Paper 36 (“Motion” or “Mot.”).

For the reasons stated below, we grant the Motion.

BACKGROUND

Western Digital Corporation (“Western Digital”) filed a Corrected Petition (Paper 6), and Patent Owner filed a Preliminary Response (Paper 8). Responsive to requests by the parties, we authorized Western Digital to file a Reply to Patent Owner’s Preliminary Response and authorized Patent Owner to file a Sur-Reply to Petitioner’s Reply. Paper 9. Western Digital filed its authorized Reply to Patent Owner’s Preliminary Response (Paper 12), and Patent Owner filed its authorized Sur-Reply (Paper 13). Based on the preliminary record, we instituted *inter partes* review for all challenged claims and grounds. Paper 14.

Thereafter, Toshiba Corporation, Toshiba America Electronic Components, Inc., and Apricorn timely filed a petition (IPR2018-01068, Paper 5 (“Toshiba Petition”)) together with a motion for joinder with the instant case (IPR2018-01068, Paper 6). We instituted *inter partes* review for the Toshiba Petition and granted the motion for joinder with this case. Paper 31.

Kingston Technology Company, Inc. (“Kingston”) timely filed a petition (IPR2018-01002, Paper 2 (“Kingston Petition”)) together with a motion for joinder with the instant case (IPR2018-01002, Paper 3). We dismissed the Kingston Petition because Kingston was estopped from requesting or maintaining the Kingston Petition under 35 U.S.C. § 315(e)(1)

and in accordance with our rule 37 C.F.R. § 42.73(d)(1), in view of the Final Written Decision issued pursuant to an earlier petition filed by Kingston in IPR2017-01021. IPR2018-01002, Paper 12, 3–4. We further determined that Kingston admitted that it was aware of the references applied in the instant case at the time of filing its earlier petition in IPR2017-01021. *Id.* at 8–9. Accordingly, Kingston is not a party to this proceeding.²

As trial progressed, Patent Owner filed a Response (Paper 22) and Petitioner filed a Reply (Paper 30).

DISCUSSION

Under 35 U.S.C. § 317(a), “[a]n inter partes review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.”

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement, if the settlement agreement includes all parties. *See, e.g.*, Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). Furthermore, 35 U.S.C. § 317(b) requires that any agreement made in contemplation of termination shall be in writing and a true copy thereof must be filed.

² Kingston has appealed our dismissal of its petition in IPR2018-01002. In an e-mail message to the Board, and again in a recent conference call, counsel for Kingston requested that we either dismiss the Joint Motion to Terminate or at least stay our decision on the Joint Motion to Terminate until the Federal Circuit rules on its appeal of our dismissal in IPR2018-01002. In the conference call, the parties to the instant case indicated they did not support Kingston’s request. Because Kingston is not a party to the instant proceeding and the parties do not support Kingston’s request, we discern no reason to stay this decision on the parties’ Joint Motion for Termination.

In the Motion, the parties indicate that all parties have reached a “Settlement Agreement [that] would operate to resolve all disputes among the parties concerning the ’135 patent.” Mot. 2. The parties also filed Exhibit 2010 contending it is “a true copy of the Settlement Agreement that will resolve the dispute in the above-captioned *inter partes* review.” Mot. 3. Therefore, the parties request termination of this case with respect to all parties. Mot. 3–4.

Although the trial has progressed significantly, the Board has not reached a final decision on the merits of the proceeding. We have reviewed the Settlement Agreement filed by the parties (Ex. 2010) and are persuaded that the agreement resolves disputes regarding the ’135 patent at issue in this case. Under these circumstances, we are persuaded that it is appropriate to terminate this proceeding with respect to all parties.

ORDER

Accordingly, it is

ORDERED that the parties’ Joint Motion Motion to Terminate IPR2018-00084 is *granted*; and

FURTHER ORDERED that the proceeding in IPR2018-00084 is *terminated* with respect to all parties.

Case IPR2018-00084

Patent 6,003,135

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