

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

KINGSTON TECHNOLOGY COMPANY, INC.,
Petitioner,

v.

POLARIS INNOVATIONS LIMITED,
Patent Owner.

IPR2016-01621
Patent 6,438,057 B2

Before SCOTT R. BOALICK, *Chief Administrative Patent Judge*.

BOALICK, *Chief Administrative Patent Judge*.

ORDER

On September 15, 2021, the United States Court of Appeals for the Federal Circuit issued an order in the appeal of IPR2016-01621 remanding the case to the Office “for the limited purpose of allowing the parties to seek further action by the Director.” *Polaris Innovations Ltd. v. Kingston Technology Co.*, No. 2018-1768, ECF No. 136, at 2 (Sept. 15, 2021).

On October 13, 2021, Polaris Innovations Limited (“Patent Owner”) sent an email to the Board requesting to file, in agreement with Petitioner Kingston Technology Company, Inc., *inter alia*, a motion to terminate the proceeding.

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Ex. 3002.¹ Patent Owner’s email states that the United States Supreme Court’s decision in *United States v. Arthrex, Inc.*, 141 S. Ct. 1970 (2021), “establishes it is unconstitutional for the Board’s final written decision under § 318(a), without more, to constitute the Office’s final determination deciding the merits under the AIA.” *Id.* Patent Owner represents that the time to seek Director review has not expired in this case and “submits that the Office has not yet finally decided the merits and the Director may terminate [this] review[] without a final decision of the Office under § 317(a) upon the joint request of petitioner and patent owner.” *Id.*

Under 35 U.S.C. § 317(a), “[i]f no petitioner remains in the inter partes review, the Office may terminate the review or proceed to a final written decision under section 318(a).” The Board already has proceeded to a final written decision in this case and, therefore, under the plain language of the statute, a motion to terminate without a final written decision is not available under § 317(a).² Instead, the appropriate course of action on remand is to allow Patent Owner to request Director review consistent with the Office’s interim guidance.³ Patent Owner may file a request for Director review within 14 days of this Order. If Patent Owner

¹ Patent Owner’s email also references IPR2016-01622 and IPR2017-00116. Patent Owner, however, subsequently requested Director review in those cases. IPR2016-01622, Ex. 3100; IPR2017-00116, Ex. 3100.

² The Federal Circuit’s limited remand order denied a motion to vacate the Board’s final written decision that Patent Owner filed in the appeal. *See Polaris*, No. 2018-1768, ECF No. 136, at 2 (Sept. 15, 2021) (“Polaris’s motion to vacate the final written decision is denied.”).

³ *See USPTO implementation of an interim Director review process following Arthrex*, <https://www.uspto.gov/patents/patent-trial-and-appeal-board/procedures/uspto-implementation-interim-director-review>; *see also Arthrex Q&As*, <https://www.uspto.gov/patents/patent-trial-and-appeal-board/procedures/arthrex-qas> (updated July 20, 2021) (setting forth more details about the interim Director review process).

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does not file a request for Director review within the allotted time, then the Board's final written decision will remain the final agency decision.

Accordingly, it is:

ORDERED that Patent Owner's request to file a motion to terminate is denied;

FURTHER ORDERED that Patent Owner shall have 14 days to file a request for Director review; and

FURTHER ORDERED that the Board's final written decision will remain the final agency decision if Patent Owner does not file a request for Director review within 14 days.

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