

Kenneth Weatherwax

From: Kenneth Weatherwax
Sent: Wednesday, October 13, 2021 2:27 PM
To: Trials
Cc: Nathan Lowenstein; azra@tensegritylawgroup.com; Michael Ballanco; chrisyang@sjclawpc.com; mhopkins@sjclawpc.com; David Hoffman
Subject: RE: Request to Withdraw: IPR2016-01621, IPR2016-01622, IPR2017-00116 - Request to file motion to terminate
Attachments: 2021-09-22 Polaris v. Kingston 19-1202 CAFC Order remanding case.pdf; 18-1831 2021-09-22 CAFC Order remanding case.pdf; 18-1768 2021-09-17 CAFC Order remanding.pdf

Honorable Board:

Patent Owner Uniloc 2017 and Petitioner Kingston Technology have reached an agreement to settle their disputes in connection with IPR2016-01621, IPR2016-01622 and IPR2017-00116. The appeals of the Board decisions in these cases have now been remanded to the Board for the limited purpose of allowing the parties to seek further action by the Director. On behalf of Patent Owner, and in agreement with Petitioner, we would like to request authorization by the Board on behalf of the Director to file in each of these proceedings a Motion to Terminate under 35 U.S.C. § 317, along with filing of a copy of the settlement agreement and a Joint Request that the settlement agreement be treated as business confidential information and kept separate pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74.

35 U.S.C. § 317(a) provides that “[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 the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed,” and that “[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).” Before *United States v. Arthrex, Inc.*, 141 S. Ct. 1970 (2021), the Board’s final written decision under 35 U.S.C. § 318(a) in an IPR was, per the text of the AIA, deemed the Office’s final decision. In *Arthrex* the Supreme Court held that in IPR, Board APJs “lack[] the power under the Constitution to finally resolve the matter within the Executive Branch” and only the Director “may issue a final decision” of the Office. 141 S. Ct. at 1985, 1987. Accordingly, *Arthrex* 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. Therefore, the Office now offers Director review of the Board’s decisions in IPR pursuant to *Arthrex*. Here, the time to seek *Arthrex* review has not expired in these cases. Accordingly, Patent Owner submits that the Office has not yet finally decided the merits and the Director may terminate these reviews without a final decision of the Office under § 317(a) upon the joint request of petitioner and patent owner. Authorization of a Motion to Terminate is therefore respectfully requested.

Copies of the Court’s remand orders are attached. The parties can make themselves available for a conference call should one be deemed helpful.

Respectfully submitted,

Lead Counsel for Patent Owner

Kenneth Weatherwax | Lowenstein & Weatherwax LLP
1880 Century Park East, Suite 815
Los Angeles, California 90067
Mobile: 310.936.3088

From: Trials <Trials@USPTO.GOV>
Sent: Thursday, July 22, 2021 1:32 PM
To: Kenneth Weatherwax <weatherwax@lowensteinweatherwax.com>
Cc: Nathan Lowenstein <lowenstein@lowensteinweatherwax.com>; azra@tensegritylawgroup.com; Michael Ballanco <ballanco@fr.com>; chrisyang@sjclawpc.com <cyang@sjclawpc.com>; mhopkins@sjclawpc.com; David Hoffman <Hoffman@fr.com>
Subject: RE: Request to Withdraw: IPR2016-01621, IPR2016-01622, IPR2017-00116 - Request to file motion to terminate

Counsel,

Thank you for your email. Because these cases are currently pending at the Federal Circuit, we await action from the Federal Circuit before considering Patent Owner's request.

Re3gards,
Eric W. Hawthorne
Supervisory Paralegal Specialist
Patent Trial and Appeal Board

From: Kenneth Weatherwax <weatherwax@lowensteinweatherwax.com>
Sent: Thursday, July 15, 2021 10:05 AM
To: Trials <Trials@USPTO.GOV>
Cc: Nathan Lowenstein <lowenstein@lowensteinweatherwax.com>; azra@tensegritylawgroup.com; Michael Ballanco <ballanco@fr.com>; chrisyang@sjclawpc.com <cyang@sjclawpc.com>; mhopkins@sjclawpc.com; David Hoffman <Hoffman@fr.com>
Subject: RE: Request to Withdraw: IPR2016-01621, IPR2016-01622, IPR2017-00116 - Request to file motion to terminate

CAUTION: This email has originated from a source outside of USPTO. **PLEASE CONSIDER THE SOURCE** before responding, clicking on links, or opening attachments.

Dear Trials,

On June 28, 2021, the above-captioned cases were [vacated and remanded](#) by the Supreme Court (No. 19-1459) for further proceedings in light of *United States v. Arthrex*, 594 U.S. ____ (2021).

Petitioner (Kingston) and Patent Owner (Polaris) have reached an agreement to settle these cases, and Patent Owner is the only party still participating in these cases. On September 3, 2020 and September 18, 2020, Petitioner sent the Office the emails below regarding Petitioner's withdrawal.

In light of the settlement and Petitioner's abandonment of these contests, Patent Owner requests authorization to file a motion to terminate these cases prior to final Office decision, and to withdraw its motions to amend and for rehearing (in IPR2016-01622) contingent upon such termination. Patent Owner observes that the Office has authorized and granted such termination motions in other such cases. *E.g.*, IPR2017-01797, Paper 39 (July 21, 2020) (*per curiam*) (terminating case on *Arthrex* remand due to settlement); IPR2017-01798 (same); IPR2017-01799 (same); IPR2017-01800 (same); IPR2017-01801 (same); IPR2017-01802 (same).

The proposed motion to terminate would be filed with a copy of the settlement agreement and a request that the settlement agreement be treated as business confidential information and kept separate pursuant to 35 U.S.C. § 317.

Patent Owner, the only remaining party participating in these proceedings, is available for a conference if a conference is deemed helpful.

Respectfully submitted,

Kenneth Weatherwax
Lead Counsel for Patent Owner

Kenneth Weatherwax | Lowenstein & Weatherwax LLP
1880 Century Park East, Suite 815
Los Angeles, California 90067
Office: 310.307.4503

From: David Hoffman [<mailto:Hoffman@fr.com>]
Sent: Friday, September 18, 2020 10:43 AM
To: trials@uspto.gov
Cc: Nathan Lowenstein; Kenneth Weatherwax; azra@tensegritylawgroup.com; Michael Ballanco; chrisyang@sjclawpc.com; mhopkins@sjclawpc.com
Subject: RE: Request to Withdraw: IPR2016-01621, IPR2016-01622, IPR2017-00116

Members of the Board,

Kingston respectfully requests a confirmation that it has been withdrawn from the proceedings listed above. If an additional filing is required, can the Board grant permission for Kingston to make those filings?

Thank you,

David Hoffman
Counsel for Kingston

From: David Hoffman
Sent: Thursday, September 3, 2020 3:24 PM
To: 'trials@uspto.gov' <trials@uspto.gov>
Cc: 'lowenstein@lowensteinweatherwax.com' <lowenstein@lowensteinweatherwax.com>; 'Kenneth Weatherwax' <weatherwax@lowensteinweatherwax.com>; 'azra@tensegritylawgroup.com' <azra@tensegritylawgroup.com>; Michael Ballanco <ballanco@fr.com>; chrisyang@sjclawpc.com <cyang@sjclawpc.com>; Martha Hopkins <mhopkins@sjclawpc.com>
Subject: Request to Withdraw: IPR2016-01621, IPR2016-01622, IPR2017-00116

Members of the Board,

Petitioner Kingston asks the Board's permission to withdraw from the above-listed IPR proceedings. Kingston understands that this request will be interpreted by the Board as an abandonment of the contest under 37 C.F.R. 42.73(b)(4).

Please let me know if any additional filings are necessary to effect Kingston's withdrawal. Counsel for Patent Owner is copied on this email.

Thank you,

David Hoffman
Counsel for Kingston

This email message is for the sole use of the intended recipient(s) and may contain confidential and privileged information. Any unauthorized use or disclosure is prohibited. If you are not the intended recipient, please contact the sender by reply email and destroy all copies of the original message.

