

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

KINGSTON TECHNOLOGY COMPANY, INC.,
Petitioner,

v.

SPEX TECHNOLOGIES, INC.,
Patent Owner.

Case IPR2017-01021
Patent 6,003,135

Before LYNNE E. PETTIGREW, CHARLES J. BOUDREAU, and
NORMAN H. BEAMER, *Administrative Patent Judges*.

BOUDREAU, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

I. INTRODUCTION

A conference call was held in the above-referenced proceeding on April 30, 2020, between counsel for the parties and Judges Pettigrew, Boudreau, and Beamer. We initiated the conference call to discuss the procedure on remand following a decision by the U.S. Court of Appeals for the Federal Circuit in *Kingston Technology Co. v. SPEX Technologies, Inc.*, 798 F. Appx. 629, (Fed. Cir. 2020) (nonprecedential), in which the Court vacated and remanded the Board’s finding of no anticipation of claim 57 of U.S. Patent No. 6,003,135 (“the ’135 patent”) for consideration of supplemental briefing filed by Petitioner during the trial of this proceeding before the Board.

II. PROCEDURAL HISTORY

On October 1, 2018, the Board issued a Final Written Decision (Paper 39), in which the panel¹ concluded that Petitioner had established by a preponderance of the evidence that claim 58 of the ’135 patent is unpatentable as anticipated by Jones, PCT Application WO 95/16238 (Ex. 1003) but that Petitioner had not established that claims 55–57 of the ’135 patent are unpatentable on any asserted grounds. Paper 39, 58–59. Petitioner appealed the latter determination to the Federal Circuit.

On February 22, 2020, the Federal Circuit affirmed the Board’s finding of no anticipation for claims 55 and 56, but vacated and remanded our finding with respect to claim 57. *Kingston*, 729 F. Appx. at 632–36. In particular with regard to claim 57, the Federal Circuit held that we abused

¹ Due to unavailability, original panel member Administrative Patent Judge Daniel N. Fishman has been replaced by Administrative Patent Judge Norman H. Beamer. *See* Paper 41.

our discretion by declining to consider certain arguments made by Petitioner in supplemental briefing filed during trial (Paper 33) as improperly presenting a new theory of invalidity for claim 57, and remanded for our consideration of Petitioner's supplemental briefing. *Id.* at 634–36.

III. DISCUSSION

During the conference call, Petitioner expressed that, although it would be willing to provide additional briefing to address the effect of the Federal Circuit's decision if it would be helpful to the Board, Petitioner did not have any specific request. Patent Owner likewise expressed that it did not have a request for additional briefing at this time.

In view of the clarity of the Federal Circuit's remand, specifically for consideration of Petitioner's "arguments addressing claim 57 in its supplemental briefing"; the parties' representations on the conference call; and the fact that Patent Owner had the opportunity to file a response to Petitioner's supplemental briefing during trial (Paper 34), we expressed that we do not see a need for additional briefing at this time. We additionally note that neither party requested to file any additional evidence and that the parties had the opportunity to address the substance of Petitioner's supplemental briefing at the oral hearing held on July 23, 2018. *See* PTAB Standard Operating Procedure 9,² 6 (explaining that "[i]n most cases, it will not be necessary to re-open the evidentiary record to new testimonial or

² "Procedure for Decisions Remanded from the Federal Circuit for Further Proceedings," available at https://www.uspto.gov/sites/default/files/documents/sop_9_%20procedure_for_decisions_remanded_from_the_federal_circuit.pdf

IPR2017-01021
Patent 6,003,135

documentary evidence”), 7 (“In most cases, an additional oral hearing will not be authorized.”)

Accordingly, we do not authorize the filing of any additional briefing or evidence or foresee the need for additional oral argument at this time.

IV. ORDER

In consideration of the foregoing, it is

ORDERED that no briefing or new evidence is authorized to be filed at this time.

IPR2017-01021
Patent 6,003,135

For PETITIONER:

David Hoffman
Oliver Richards
FISH & RICHARDSON P.C.
hoffman@fr.com
richards@fr.com

Martha Hopkins
LAW OFFICES OF S. J. CHRISTINE YANG
mhopkins@sjclawpc.com

For PATENT OWNER:

Vincent J. Rubino, III
Alfred R. Fabricant
Enrique W. Iturralde
Peter Lambrianakos
BROWN RUDNICK
vrubino@brownrudnick.com
afabricant@brownrudnick.com
eiturralde@brownrudnick.com
plambrianakos@brownrudnick.com