

NOTE: This order is nonprecedential.

**United States Court of Appeals  
for the Federal Circuit**

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**KINGSTON TECHNOLOGY COMPANY, INC.,**  
*Appellant*

v.

**SPEX TECHNOLOGIES, INC.,**  
*Appellee*

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2019-1342

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Appeal from the United States Patent and Trademark  
Office, Patent Trial and Appeal Board in No. IPR2018-  
01002.

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**KINGSTON TECHNOLOGY COMPANY, INC.,**  
*Appellant*

v.

**SPEX TECHNOLOGIES, INC.,**  
*Appellee*

**ANDREI IANCU, Director, U.S. Patent and Trade-  
mark Office,**  
*Intervenor*

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2019-1599

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Appeal from the United States Patent and Trademark Office, Patent Trial and Appeal Board in Nos. IPR2018-00084 and IPR2018-01068.

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**ON MOTION**

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Before MOORE, O'MALLEY, and HUGHES, *Circuit Judges*.  
MOORE, *Circuit Judge*.

**O R D E R**

Kingston Technology Company, Inc. appeals from a decision of the Patent Trial and Appeal Board rejecting its petition to institute inter partes review (IPR) and request to join a related IPR. It also appeals from the Board's decision that terminated the related IPR after all the parties to that case had reached a settlement agreement. We *dismiss* both appeals and *deny* all motions.

**BACKGROUND**

SPEX Technologies, Inc. owns U.S. Patent No. 6,003,135. In September 2016, SPEX sued Kingston, Western Digital Corporation, Apricorn, Toshiba Corporation, and Toshiba America Electronic Components, Inc., alleging infringement of that patent. In March 2017, Kingston filed its first petition for IPR of claims 55–58. The Board elected to institute review of those claims and issued a final written decision concluding that Kingston had only shown claim 58 to be unpatentable. Kingston appealed that decision (Appeal No. 2019-1256), which is pending before this court but not directly at issue here.

While Kingston's first IPR was pending, Western Digital filed its own petition, IPR2018-00084, to review claims

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55–58 of the patent based on references that were not cited in Kingston’s previous petition. A week after the Board instituted review in those proceedings, Kingston filed its second petition, IPR2018-01002, that was substantively identical to Western Digital’s petition, and moved to join IPR2018-00084. The Toshiba defendants and Apricorn also filed a similar petition and request for joinder with Western Digital’s case.

In November 2018, the Board dismissed Kingston’s second petition as barred under 35 U.S.C. § 315(e)(1). In concluding that Kingston reasonably could have raised the same grounds in its first IPR that it was seeking to assert in its petition underlying IPR2018-01002, the Board noted that Kingston “does not dispute having knowledge of these additional prior art references at the time of filing of its earlier petition” and “could have filed contemporaneously multiple petitions to argue persuasively additional grounds that it determined could not be effectively argued within the word limit of the first petition.” Kingston appeals that decision (Appeal No. 2019-1342).

Meanwhile, the Board instituted the Toshiba defendants’ and Apricorn’s petition and granted their request for joinder with IPR2018-00084. All the parties to that IPR (the Toshiba defendants, Apricorn, Western Digital, and SPEX) subsequently agreed to enter into a settlement agreement and jointly moved for the Board to terminate proceedings. On January 30, 2019, the Board granted the motion to terminate the IPR without reaching a final written decision on patentability. In doing so, the Board noted that Kingston had requested in an email message to the Board and in a conference call that the motion be dismissed or stayed pending its other appeals, but the Board denied that request because Kingston was not a party to the instant proceedings and no party supported that request. Kingston filed a notice of appeal from that decision (Appeal No. 2019-1599) and also moves to intervene in the very appeal it filed, a strange scenario indeed.

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## DISCUSSION

To exercise review over Kingston’s appeal from the Board decision dismissing its own IPR petition (IPR2018-01002) would be contrary to precedent. This court and the Supreme Court have distinguished between review of the Director’s decision not to institute review proceedings, which is “final and nonappealable” under 35 U.S.C. § 314(d), and the Board’s review and conduct after institution. *See Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016) (stating the “decision to deny a petition is a matter committed to the Patent Office’s discretion”); *St. Jude Med., Cardiology Div., Inc. v. Volcano Corp.*, 749 F.3d 1373, 1375–76 (Fed. Cir. 2014) (holding that review under 28 U.S.C § 1295(a)(4)(A) does not extend to appeals from Patent Office decisions not to institute IPR).<sup>1</sup>

In drawing that distinction, we have consistently resisted limiting § 314(d)’s bar on appellate review to the denial of a petition for failure to establish a reasonable likelihood of success. *See, e.g., St. Jude*, 749 F.3d at 1375–76 (dismissing appeal from Board’s decision denying petition on timeliness grounds); *Saint Regis Mohawk Tribe v. Mylan Pharm. Inc.*, 896 F.3d 1322, 1327 (Fed. Cir. 2018) (noting that “[w]hile [the Director] has the authority not to institute review on the merits of the petition, he could deny

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<sup>1</sup> *Arthrex, Inc. v. Smith & Nephew, Inc.*, 880 F.3d 1345 (Fed. Cir. 2018) is not to the contrary. *Arthrex* concerned the issue of whether a party could appeal from a final adverse judgment entered under 37 C.F.R. § 42.73(b) after institution. *Arthrex* itself distinguished *St. Jude*, stating that “*St. Jude* did not involve a similar situation, and the availability of appeal of final adverse judgment decisions was not directly addressed in that case.” *Id.* at 1349.

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review for other reasons” and “[i]f the Director decides not to institute, for whatever reason, there is no review”).

In arguing against application of § 314(d)’s appeal bar, Kingston seizes on the fact that the Board referenced in its decision “dismiss[ing]” the petition rather than declining review. But, under the circumstances, this is a distinction without a difference. *See GTNX, Inc. v. INTTRA, Inc.*, 789 F.3d 1309, 1311–12 (Fed. Cir. 2015) (refusing to distinguish for purposes of § 314(d) between the Patent Office’s initial decision to institute and the Patent Office’s decision to reconsider and vacate its decision to institute proceedings). As even Kingston recognizes, the Board’s bottom line was to not institute the IPR petition. *See* Kingston’s Resp. in Appeal No. 2019-1342 at 5 (acknowledging that “the Board denied institution”).<sup>2</sup>

We also conclude that Kingston can make no non-frivolous argument that it should have been permitted to join the Western Digital IPR (IPR2018-00084) after the Board dismissed Kingston’s own petition. The provision on which Kingston requested joinder, 35 U.S.C. § 315(c), states that the Director may “join as a party to that inter partes review any person who properly files a petition under section 311 that the Director . . . determines warrants the institution of an inter partes review under section 314.” Because the Board determined that Kingston’s petition did not warrant institution under § 314 and we must take that

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<sup>2</sup> Kingston alternatively contends that we should treat its notice of appeal as a petition for a writ of mandamus. But even if we were to do so, we would have to deny such a request because Kingston cannot demonstrate a clear and indisputable right to relief. *See In re Dominion Dealer Sols., LLC*, 749 F.3d 1379, 1381 (Fed. Cir. 2014) (denying mandamus based on the absence of a clear and indisputable right to relief in view of the statutory scheme precluding review of non-institution decisions).

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determination to be final and conclusive, it follows from the plain terms of § 315(c) that joinder also had to be denied.

It also follows that we must reject Kingston's attempts to appeal from the Western Digital IPR and intervene for purposes of appeal. Kingston's right to appeal, if any, comes from 35 U.S.C. § 141(c), which states that "[a] party to an inter partes review . . . who is dissatisfied with the final written decision of the Patent Trial and Appeal Board under section 318(a) . . . may appeal the Board's decision only to the United States Court of Appeals for the Federal Circuit" (emphasis added); *see also* 35 U.S.C. § 319 ("A party dissatisfied with the final written decision . . . may appeal the decision pursuant to [§ 141].").

Because Kingston is absolutely not a party under section 141, it has no right to appeal. *Cf. Mylan Pharm. Inc. v. Research Corp. Techs., Inc.*, 914 F.3d 1366, 1373 (Fed. Cir. 2019) (holding that a petitioner that was joined may appeal the Board's decision in part because "party" in §§ 141 and 315(c) should be given the same meaning); *see also Ala. Power Co. v. FCC*, 311 F.3d 1357, 1366 (11th Cir. 2002) ("A 'party aggrieved' [within the meaning of 28 U.S.C. § 2344] is one who participated in the agency proceeding."); *In re Chi., Milwaukee, St. Paul & Pac. R.R. Co.*, 799 F.2d 317, 335 (7th Cir. 1986) ("The statute limits review to petitions filed by parties, and that is that.").

The cases cited by Kingston do not involve a similar statutory scheme and in any event are distinguishable. In *Searcy v. Philips Electronics North America Corp.*, 117 F.3d 154, 157–58 (5th Cir. 1997), the court held that the unique structure of the False Claims Act in giving the United States the right to veto a settlement entered into by a qui tam relator justified the unusual step of allowing an appeal even though the United States was never formally made a party in the district court. Kingston does not suggest it has

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a similar stake in the outcome of this appeal.<sup>3</sup> Kingston's reliance on *Kenny v. Quigg*, 820 F.2d 665, 668 (4th Cir. 1987), and *Carhart v. Carhart-Halaska International, LLC*, 788 F.3d 687, 690 (7th Cir. 2015), is similarly misplaced because, unlike in those cases, Kingston was not treated as a de facto party.

Accordingly,

IT IS ORDERED THAT:

(1) The stay of the briefing schedule in these appeals is lifted.

(2) The official caption for Appeal No. 2019-1599 has been revised to reflect that the Director of the United States Patent and Trademark Office has intervened in that appeal.

(3) The appeals are dismissed, and all pending motions are denied.

(4) Kingston shall bear costs.

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<sup>3</sup> In fact, Kingston appears to have filed this appeal merely to preserve its attempted challenges to the Board's denial of its own IPR and request for joinder. *See* Kingston's Resp. in Appeal No. 2019-1599 at 8 (arguing that "the Board's premature dismissal [of the Western Digital IPR] threatens the viability of [Kingston's] earlier appeal"); 11 ("At most, Kingston seeks in this appeal to have the Board's decision dismissing the [Western Digital] IPR stayed until adequate resolution of Kingston's earlier appeal."); and 19 ("The only way for Kingston to protect its interests is for Kingston to be allowed to intervene to appeal the Board's decision dismissing the Western Digital IPR while Kingston's request to join that IPR is still pending on appeal to this Court.").

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FOR THE COURT

July 19, 2019  
Date

/s/ Peter R. Marksteiner  
Peter R. Marksteiner  
Clerk of Court

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