

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
Petitioners,

v.

SPEX TECHNOLOGIES, INC.
Patent Owner

CASE NO: IPR2018-00082
U.S. PATENT: 6,088,802

PETITIONER APRICORN'S NOTICE OF APPEAL

Mail Stop **Patent Board**
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Pursuant to 35 U.S.C. § 141 and 37 C.F.R. § 90.2, Petitioner Apricorn (“Petitioner”) hereby provides notice that it appeals to the United States Court of Appeals for the Federal Circuit from the Final Written Decision entered April 18, 2019 (Paper 40) and from all underlying orders, decisions, rulings, and opinions adverse to it regarding U.S. Patent 6,088,802 (“the ‘802 patent”) at issue in *Inter Partes* Review IPR2018-00082.

In accordance with and for the purpose of providing the Director with the information requested pursuant to 37 C.F.R. § 90.2(a)(3)(ii), Petitioner anticipates that the issues on appeal may include, but are not limited to the following, as well as any underlying findings, determinations, rulings, decisions, opinions, or other related issues:

- The Board violated *SAS Institute, Inc. v. Iancu*, 138 S. Ct. 1348 (2018), the Administrative Procedure Act, and/or Petitioner’s due process rights by denying Petitioner’s requests to: (i) supplement the record to include admissions made by Patent Owner’s experts that were made only after the Petition was filed, and (ii) file a reply, with respect to the patent claims for which the Board instituted review but did not find, based on the Petition, that Petitioner had a reasonable likelihood of prevailing.
- The Board violated *SAS Institute, Inc. v. Iancu*, 138 S. Ct. 1348 (2018), the Administrative Procedure Act, and/or Petitioner’s due process rights by limiting Petitioner’s arguments to issues raised in a Patent Owner’s response, where the Patent Owner did not file a Patent Owner Response and hence raised no issues with respect to the patent claims for which the Board instituted review but did not find, based on the Petition, that Petitioner had a reasonable likelihood of prevailing.
- The Board erred in holding that an invalidity argument based on disclosure found in a prior art reference relied upon in the Petition, in combination with

admissions by the Patent Owner's experts that were made after the Petition was filed, constitutes a new "ground" for unpatentability.

- Any and all findings or determinations supporting or related to the above identified issues, and all other issues decided adversely to Petitioner in any order, decision, ruling, or opinion by the Board in this Inter Partes Review.

Simultaneous with this filing and in accordance with 35 U.S.C. § 142 and 37 C.F.R. § 90.2(a)(1), this Notice is being filed with the Director of the United States Patent and Trademark Office, and a copy of this Notice is being concurrently filed with the Patent Trial and Appeal Board. In addition, a copy of this Notice along with the required docketing fees are being filed with the Clerk's Office for the United States Court of Appeals for the Federal Circuit via CM/ECF.

Respectfully submitted,

DATED: May 2, 2019

By: /Christopher D. Bright/

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CERTIFICATE OF SERVICE

The undersigned certifies that, in addition to being filed electronically through the Patent Trial and Appeal Board's End to End system (PTAB E2E), the foregoing Notice of Appeal was filed by Express Mail on May 2, 2019, with the Director of the United States Patent and Trademark Office, at the following address:

Director of the United States Patent and Trademark Office
c/o Office of the General Counsel
P.O. Box 1450
Alexandria, VA 22313-1450

The undersigned certifies that a copy of the foregoing Notice of Appeal, along with the required docket fee, was filed on May 2, 2019, with the Clerk's Office of the United States Court of Appeals for the Federal Circuit through the Court's CM/ECF filing system.

The undersigned certifies service pursuant to 37 C.F.R. § 42.6(e) of a copy of this Notice of Appeal by electronic mail on May 2, 2019, on the counsel of record for Patent Owner:

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DATED: May 2, 2019

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