

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WESTERN DIGITAL CORPORATION,
Petitioner,

v.

SPEX TECHNOLOGIES, INC.,
Patent Owner.

Patent No. 6,088,802
Filing Date: June 4, 1997
Issue Date: July 11, 2000
Title: PERIPHERAL DEVICE WITH INTEGRATED SECURITY
FUNCTIONALITY

**PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION FOR
SUBMISSION OF SUPPLEMENTAL INFORMATION**

Case No. IPR2018-00082

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I. PETITIONER SHOULD NOT BE PERMITTED TO SUBMIT THE PROPOSED SUPPLEMENTAL INFORMATION BECAUSE IT IS NOT RELEVANT TO ANY THEORY OF INVALIDITY PRESENTED IN THE PETITION

Petitioner admits that the proposed supplemental information is intended to support the invalidity argument that Figure 4 of Harari discloses structures that are at least equivalent to the interface control device 910 of the '802 Patent, which is the corresponding structure for the claimed “means for mediating” as construed by the Board. Paper 17 at 1. However, *the Petition does not argue that Harari discloses the interface control device 910*. In the Decision on Institution, the Board found that Petitioner had not compared the structure of the interface control device 910 to the structure in Harari that Petitioner contended performed the function of the means for mediating, which were the comprehensive controller 41 or the functional module 42:

[T]he Petition does not persuade us that the identical or equivalent structure for this means, as disclosed in the '802 patent, is disclosed by the proposed combinations of references. In accord with the District Court construction, interface control device 910 is disclosed in the '802 patent as the structure corresponding to the function of the means for mediating. Ex. 2003, 31–38. Patent Owner argues the Petition fails to show where this or an equivalent structure is disclosed in the combination of references. Prelim. Resp. 5. Although Petitioner notes this construction by the District Court (Pet. 14 (citing Ex. 1014,

24–25)), *Petitioner does not apply the District Court’s interpretation of this element to compare the structure of interface control device 910 to controller 41 or functional module 42 of Harari (see id. at 43–45) or to the ASIC/FPGA of Wang (see id. at 59–64). Instead, based on a construction proffered by Patent Owner that the District Court rejected, in which the structure for this means is disclosed as an FPGA (see Ex. 2003, 33–36), Petitioner compares the FPGA structure of Wang with an FPGA structure in Figure 8 of the ’802 patent. Id. at 61–64.*

Paper 11 at 35-36 (emphasis added).

The supplemental evidence should not be admitted because it can only support a new theory of invalidity that is not in the Petition and, therefore, cannot be introduced into the proceedings at this time by any mechanism. “It is of the utmost importance that petitioners in the IPR proceedings adhere to the requirement that the initial petition identify ‘with particularity’ the ‘evidence that supports the grounds for the challenge to each claim.’” *Intelligent BioSystems, Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) (quoting 35 U.S.C. § 312(a)(3)). “Unlike district court litigation—where parties have greater freedom to revise and develop their arguments over time and in response to newly discovered material—the expedited nature of IPRs bring with it an obligation for petitioners to make their case in their petition to institute.” *Id.* A reply brief filed in response to any patent owner response could not rely on an argument supported

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