

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WESTERN DIGITAL CORPORATION
Petitioner,

v.

SPEX TECHNOLOGIES, INC.
Patent Owner.

Case No. IPR2018-00082
Patent 6,088,802

**PETITIONER'S MOTION FOR LEAVE TO FILE A REPLY UNDER 37
C.F.R. § 42.5 IN THE ABSENCE OF PATENT OWNER'S RESPONSE (AS
AUTHORIZED BY CALL ON AUGUST 2, 2018)**

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The Board should waive its rules and permit Petitioner to submit argument and evidence to respond to the Institution Decision. Paper 22 at 3. The Board denied Petitioner’s previous request to supplement the record, but suggested that Petitioner could address the Board’s reasoning during the proceedings. *Id.* at 10. Absent waiver, Petitioner would not have had any opportunity to establish unpatentability during the trial based on the grounds instituted on claims 1, 2, 11 and 12. Depriving Petitioner of this opportunity would violate *SAS Institute, Inc. v. Iancu*, 138 S. Ct. 1348 (2018), the APA, and Petitioner’s Due Process rights.

I. GRANTING PETITIONER’S MOTION AVOIDS NEGATING *SAS INSTITUTE* AND VIOLATING THE APA AND DUE PROCESS

Due process dictates that Petitioner have an opportunity to address the Board’s preliminary determination that Petitioner had not shown a reasonable likelihood of success in proving that claims 1, 2, 11, and 12 are unpatentable. The Board’s rules were created pre-*SAS*, when only claims for which a reasonable likelihood of success was shown would be reviewed. In that paradigm, a patent owner that waived its response would lose on all instituted claims and thus had the burden to file a response. Post-*SAS*, if the Board does not allow Petitioner to file a Reply presenting evidence and arguments (which was not available when the Petition was filed) addressing the Institution Decision, the Institution Decision would become final. In that scenario, the Board would not have presented Petitioner an opportunity during the trial to have “the Board [] address every claim

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