

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 IPR2018-01003
Patent 6,088,802

**PETITIONER'S MOTION FOR JOINDER
UNDER 35 U.S.C. § 325(c) AND 27 C.F.R. § 42.222(b) OR, IN THE
ALTERNATIVE, FOR COORDINATION OF SCHEDULE, AND
REQUEST FOR SHORTENED RESPONSE TIME FOR
PATENT OWNER'S PRELIMINARY RESPONSE**

I. RELIEF REQUESTED

Pursuant to 35 U.S.C. § 325(c) and 37 C.F.R. § 42.222(b), Kingston Technology Company, Inc. (“Petitioner”) hereby moves for joinder of any proceeding resulting from its new Petition for *Inter Partes* Review (“IPR”) of United States Patent No. 6,088,802 (“the ’802 Patent”) — filed concurrently with this Motion—with the recently instituted IPR for the ’802 Patent, IPR2018-00082, naming Western Digital Corp. as petitioner.

In conjunction with this request for joinder or coordination, Petitioner respectfully requests that the Board specify a shortened response period in which Patent Owner SPEX Technologies, Inc. (“Patent Owner”) may file a Preliminary Response to this new Petition. The new Petition includes only the grounds instituted in IPR2018-00082 and is substantively identical on those grounds.¹ Given the identity of issues presented by this new Petition and those raised by Western Digital Corp. in the prior co-pending proceeding, the proposal for a shortened response period does not impose an undue burden on Patent Owner.

¹ The petitions, of course, are not wholly identical. The present Petition has been updated to account for the formalities of a different Petitioner and real parties in interest, the related matters have been updated, and there are nominal clerical changes.

Moreover, in establishing a shortened deadline, the Board will provide itself with more time before the institution decision is due to consider any additional information furnished by Patent Owner in its Preliminary Responses to the new Petition, if any are raised.

Even if the Board declines to establish the proposed shortened response deadline for the Preliminary Response, Petitioner nevertheless maintains its motion for joinder.

II. STATEMENT OF MATERIAL FACTS

1. On October 16, 2017, Western Digital Corp. filed a Petition for *Inter Partes* Review of U.S. Patent No. 6,088,802, challenging claims 1, 2, 6, 7, 11, 12, 23-25, 38, and 39 under §103(a) (IPR2018-00082). On January 26, 2018, Patent Owner filed its Preliminary Response in IPR2018-00082. On April 25, 2018, the Board issued an institution decision and scheduling order in IPR2018-00082.

2. On May 2, 2018, Petitioner filed this Petition for **Inter Partes** Review (“IPR”) of US Patent No. 6,088,802, challenging claims 1, 2, 6, 7, 11, 12, 23-25, 38, and 39 under §103(a).

3. This new Petition for IPR challenges the same claims of the ‘802 Patent using the same grounds as Western Digital Corp.’s previous Petition for IPR of the ‘802 Patent (i.e., IPR2018-00082). Moreover, as noted above, this new Petition is substantively identical as to those grounds, and presents no new issues.

4. It should be noted that Petitioner previously filed a Petition for IPR of claims 1-3, 6-8, 11-15, 23-28, and 36-39 of the '802 Patent, asserting wholly different prior art under §103(a) (IPR2017-00824). Institution was denied on August 17, 2017.

III. DISCUSSION

The requested joinder will serve to secure the just, speedy, and inexpensive resolution of these proceedings. Under 35 U.S.C. § 325(c):

If more than 1 petition for a post-grant [or covered business method] review under this chapter is properly filed against the same patent and the Director determines that more than 1 of these petitions warrants the institution of a post-grant review under section 324, the Director may consolidate such reviews into a single post-grant [or covered business method] review.

In addition, 37 C.F.R. § 42.222(b) provides that “[j]oinder may be requested by a patent owner or petitioner. Any request for joinder must be filed, as a motion under § 42.22, no later than one month after the institution date of any post-grant [or covered business method] review for which joinder is requested.”

This Motion is timely under § 42.222(b) because Western Digital Corp.’s Petition for IPR was instituted on April 25, 2018. Moreover, at the time of this filing, IPR2018-00082 is pending.

The Board has further provided that a motion for joinder should: (1) set forth the reasons why joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; (3) explain what impact (if any) joinder would have on the trial schedule of the existing proceeding; and (4) address specifically how briefing and discovery may be simplified. *See, e.g., Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (Apr. 24, 2013). Analysis of these factors here warrants the Board’s use of its discretion to grant the requested joinder. *See Protection One, Inc. v. MD Security Solutions, LLC*, IPR2016-01235, Paper 8 at 4-5 (Oct. 11, 2016).

A. Joinder is Appropriate Because Both Proceedings Involve the Same Prior Art, the Same Claims, and the Same Grounds of Unpatentability – No New Grounds Are Presented

The challenged claims and grounds of Petitioner’s petition are substantively identical to claims and grounds presented in the petition filed by Western Digital Corp. (IPR2018-00082). The same prior art, and even the same expert declarations and experts, are used in both proceedings. Petitioner proposes no new grounds of unpatentability. This strongly supports application of joinder.

Moreover, if joined, Petitioner agrees to take an “understudy” role as petitioners in other similarly joined proceedings have taken. *See IPR2015-01353*, Decision, Paper 11 at 6 (October 5, 2015), granting institution and joinder where

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