UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

KINGSTON TECHNOLOGY COMPANY, INC.,
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

SPEX TECHNOLOGIES, INC.'S OPPOSITION TO PETITIONER'S MOTION FOR JOINDER, COORDINATION, AND A SHORTENED TIME TO FILE A PRELIMINARY RESPONSE

Case No. IPR2018-01003

I. Introduction

Petitioner Kingston's motion exceeds the scope of a request for joinder and requests relief for which the rules expressly require prior authorization. Absent authorization, which Kingston neither sought nor received, the Board must deny entry of this omnibus motion. Should the Board grant authorization notwithstanding the violation of the Board's rules, the Board should deny each of Kingston's three requests. First, the Board should deny Kingston's request for coordination of proceedings because Kingston's petition is time-barred absent joinder. Second, the Board should deny Kingston's request for a shortened preliminary response period because Kingston has not met its burden to show a sufficient need or any entitlement to impose such an unfairly prejudicial limitation on SPEX. Third, the Board should exercise its discretion to deny joinder because Kingston has not identified a legitimate reason why it should be given a second bite at the '802 Patent when (a) Kingston's own challenges to the '802 Patent have been denied institution; and (b) Petitioners' serial challenges to the '802 Patent used this Board's prior institution decisions as a road map to ultimately attain institution. Thus, for the reasons set forth herein, SPEX respectfully submits that the motion should be denied in its entirety.

II. Kingston's Omnibus Motion Must Be Denied Entry

Kingston's motion must be denied entry in its entirety because it requests

relief for which it did not seek authorization. 37 C.F.R. § 42.20(a)-(b) ("Relief, other than a petition requesting the institution of trial, must be requested in the form of a motion. . . . A motion will not be entered without Board authorization."). Without obtaining SPEX's position and the Board's prior authorization, Kingston moved for two forms of relief that require prior authorization: a coordination of parallel proceedings and a shortened preliminary response period. Neither motion constitutes the kind for which authorization is automatically granted. Seeking authorization would not have been impractical, because at the time of filing this petition, Kingston's counsel was aware of SPEX's representation by the same counsel in case numbers IPR2017-00430 (institution denied), IPR2017-00824 (institution denied), IPR2017-00825 (institution denied), IPR2017-01021 (pending), IPR2018-00082 (pending), and IPR2018-00084 (pending), and Kingston's counsel knew that the same Panel presided over the preceding pending IPRs, particularly the IPR to which Kingston seeks to join. The rules are clear: without prior authorization, this motion will not be entered into the record. Because Kington's motion must be denied entry, the Petition must be denied institution as time-barred under 35 U.S.C. 315(b).

III. Kingston's Motion to Shorten the Time to File a Preliminary Response Is Improper and Should Be Denied

Kingston's request to shorten the time to file a preliminary response should be denied because it is improper, and Kingston has failed to meet its burden to

show any entitlement to the requested relief. Despite being in regular contact with SPEX's counsel in related proceedings (e.g., IPR2017-01021), Kingston did not seek SPEX's position or attempt to contact the Panel regarding this request. Additionally, Kingston cites no authority supporting its request and identifies no urgency that sufficiently merits deprivation of the full three months typically prescribed to patent owners under similar circumstances. Petitioner's arguments regarding the similarity of petitions are irrelevant. *See, e.g.*, IPR2018-00090, Paper 12 at 2.

SPEX does not waive any portion of the 3-month period to file a preliminary response as prescribed by 37 C.F.R. § 42.107(b) and intends to file a preliminary response[1] by August 10, 2018. In addition to addressing whether institution should be denied under the *General Plastic* factors, SPEX may file a preliminary response raising additional arguments responding to the records relating to the '802 Patent and presenting additional evidence in the form of expert testimony. Accordingly, Kingston's motion places an undue burden and unfairly prejudices SPEX and should be denied.

IV. Kingston's Motion for Coordination Is Improper and Should Be Denied

Kingston's alternative motion for coordination incorrectly presumes that institution is proper without joinder to an instituted proceeding. However, absent

[1] Patent Owner acknowledges the Board's discretion to deny these motions and to deny institution of the accompanying petition prior to the filing of a preliminary response, and Patent Owner would not oppose such action by the Board.

joinder, Kingston's petition is time-barred under 35 U.C.S. § 315(b), and Kingston identifies no authority to the contrary. Accordingly, Kingston has not shown any entitlement to coordination as an alternative form a relief absent joinder, and the motion should be denied.

V. Kingston's Motion for Joinder Should Be Denied

Joinder may be authorized **when warranted**, but the decision to grant joinder is discretionary. 35 U.S.C. § 315(c); 37 C.F.R. § 42.122(b). When exercising that discretion, the Board construes the relevant authorities to secure the just, speedy, and inexpensive resolution of every proceeding. 37 C.F.R. § 42.1(b). As shown herein, the circumstances here warrant a denial of joinder.

A. The '802 Patent's History at the PTAB Identifies a Clear Trend of Improper Road-Mapping at the Expense of Patent Owner and the Board

In September 2016, SPEX *concurrently* filed seven complaints alleging infringement of the '802 Patent by certain defendants, including Kingston and Western Digital. Paper 9 at 2. Shortly thereafter, defendants embarked on what will amount to a two-and-a-half-year road-mapping campaign against the '802 Patent before the PTAB.

On December 14, 2016, Unified Patents filed a petition in case number IPR2017-00430 ("430-IPR") alleging that claims 1-39 of the '802 Patent were unpatentable, in part, over **Jones** and **Harari**. 430-IPR, Paper 2 at 3-4. The Board

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