

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

Before LYNNE E. PETTIGREW, DANIEL N. FISHMAN, and
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

FISHMAN, *Administrative Patent Judge*.

DECISION

Institution of *Inter Partes* Review,
Granting Petitioner's Motion for Joinder, and
Dismissing Petitioner's Additional Motions

35 U.S.C. §§ 314(a), 315(c); 37 C.F.R. §§ 42.5, 42.108, 42.122

I. INTRODUCTION

Kingston Technology Company, Inc. (“Kingston” or “Petitioner”), filed a Petition (Paper 2, “Pet.”) for *inter partes* review of claims 1, 2, 6, 7, 11, 12, 23–25, 38, and 39 of U.S. Patent No. 6,088,802 (“the ’802 patent”) (Ex. 1001) pursuant to 35 U.S.C. §§ 311–319. On the same day as filing the Petition, Petitioner filed a Motion for Joinder. Paper 4 (“Joinder Motion,” “Motion,” or “Mot.”).

Initially we note a number of errors in the Motion. The caption and the body of the Motion refer to 35 U.S.C. § 325(c), which relates to joinder in post-grant reviews, rather than § 315(c), which relates to joinder in *inter partes* reviews as is the case here. Furthermore, the caption refers to Title 27 of the Code of Federal Regulations (“CFR”) rather than Title 37 thereof. Still further, the citations to CFR are to section 42.222, which, again, relates to joinder in post-grant reviews, rather than section 42.122, which relates to joinder in *inter partes* review. We find the errors harmless and presume the Motion intended to cite 35 U.S.C. § 315 and 37 C.F.R. § 42.122.

The Joinder Motion seeks to join Kingston as a party to *Western Digital Corp. v. SPEX Technologies, Inc.*, Case IPR2018-00082 (“the 82 IPR”). Mot. 1. The Joinder Motion indicates Western Digital Corporation (“WDC,” Petitioner in the 82 IPR), does not oppose Kingston’s request to join the 82 IPR. Mot. 7. SPEX Technologies, Inc. (“SPEX” or “Patent Owner”) filed an Opposition to the Motion. Paper 11 (“Opp.” or “Opposition”).

As explained further below, we institute trial in this *inter partes* review on the same grounds as instituted in IPR2018-00082, and we grant Petitioner’s Joinder Motion. Furthermore, we dismiss Petitioner’s additional

motions (incorporated with the Joinder Motion) as moot and as improperly filed without authorization.

II. DISCUSSION
A. *Institution of Trial*

In the 82 IPR, WDC challenged claims 1, 2, 6, 7, 11, 12, 23–25, 38 and 39 of the '802 Patent on the following grounds:

References	Basis	Claims challenged
Harari ¹ and Anderson ²	§ 103	1, 2, 6, 7, 11, 12, 23–25, 38, and 39
Harari, Anderson, and Wang ³	§ 103	1, 2, 11, 12, 23, and 39
Harari, Anderson, and Dumas ⁴	§ 103	1, 2, 11, 12, 23, and 39
Harari, Anderson, Dumas, and Wang	§ 103	1, 2, 11, 12, 23, and 39

IPR2018-00082 Paper 1, 2. After considering the Petition in the 82 IPR and Patent Owner's Preliminary Response in the 82 IPR, we instituted trial for the above-identified grounds of unpatentability. *See* IPR2018-00082 Paper 11, 2, 43.

Prior to filing the 82 IPR, Kingston filed a petition in IPR2017-00824 challenging the same claims (1, 2, 6, 7, 11, 12, 23–25, 38, and 39) and other claims of the '802 patent although applying different references in that challenge. We denied institution on Case IPR2017-00824.

¹ U.S. Patent No. 5,887,145 (“Harari,” Ex. 1004).

² Don Anderson, *PCMCIA System Architecture 16-Bit PC Cards, Second Edition*, 1995 (“Anderson,” Ex. 1006).

³ U.S. Patent No. 5,765,027 (“Wang,” Ex. 1019).

⁴ U.S. Patent No. 6,199,163 B1 (“Dumas,” Ex. 1005).

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Petitioner here (Kingston) represents that this Petition is substantively identical to WDC's Petition in IPR2018-00082 and challenges the same claims based on the same grounds. Mot. 1. We have considered the relevant Petitions and we agree with Petitioner's representation that this Petition is substantively identical to the Petition in IPR2018-00082. *Compare* Pet., with IPR2018-00082 Paper 1. Patent Owner did not file a Preliminary Response to this Petition.

Accordingly, for essentially the same reasons stated in our Decision to Institute in IPR2018-00082, we conclude Petitioner has established a reasonable likelihood of prevailing with respect to at least one challenged claim, and we institute trial in this proceeding for claims 1, 2, 6, 7, 11, 12, 23–25, 38, and 39 on the same grounds as in IPR2018-00082.

B. Motion for Joinder

Based on authority delegated to us by the Director, we have discretion to join a petitioner for *inter partes* review to a previously instituted *inter partes* review. 35 U.S.C. § 315(c). Subsection 315(c) provides, in relevant part, that “[i]f the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311.” *Id.* Furthermore, subsection 315(b) explains that the one year time bar thereof “shall not apply to a request for joinder under subsection (c).”

We agree with Patent Owner that, but for this Joinder Motion, Kingston would be barred under subsection 315(b) from proceeding in this review. Opp. 1 (“Kingston’s petition is time-barred absent joinder.”). Patent Owner opposes the joinder of Kingston to the 82 IPR, arguing:

On October 16, 2017, after having reviewed two preliminary responses by SPEX and two institution denials by

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the PTAB, Western Digital filed a third petition in case number IPR2018-00082 (“82-IPR”) alleging that claims 1-2, 6-7, 11-12, 23-25, and 38-39 of the ’802 Patent were unpatentable over Harari and other references. 82-IPR, Paper 1

Opp. 5.⁵ Patent Owner further contends “Kingston and its joint defense group have engaged in incremental petitioning which has allowed it to impermissibly benefit from SPEX’s prior arguments and the Board’s prior decisions.” *Id.* at 6.

Kingston admits knowledge of the references applied in the 82 IPR at the time of the earlier filed petition (IPR2017-00824) but argues that knowledge should not be determinative of granting or denying its motion to join as a party to the 82 IPR. Mot. 8. In particular, Kingston notes that the art applied in the 82 IPR is “wholly different” from that of its earlier petition and, thus, “there is no shift in position or correction by Petitioner of earlier-asserted arguments.” *Id.* Therefore, Kingston argues there is efficiency gained by the Board and by the parties in joining Kingston in the 82 IPR. *Id.*

We are persuaded that there is efficiency in joining Kingston as a Petitioner in the 82 IPR. We discern no prejudice to Patent Owner by granting Kingston’s motion for joinder. Patent Owner’s arguments regarding incremental petitioning were essentially addressed in our Decision on Institution in the 82 IPR. Paper 14, 16–20 (addressing Patent Owner’s arguments urging we exercise our discretion to deny the WDC Petition in the 82 IPR based on the *General Plastic* factors). We were not persuaded by

⁵ Patent Owner alleges Western Digital Corporation was aware of Kingston’s Case IPR2017-00824 as well as an earlier Case IPR2017-00430 filed by Unified Patents Inc. We denied review of the Petition in Case IPR2017-00430. IPR2017-00430, Paper 8.

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