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Paper No. 8
Entered: August 17, 2017

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 IPR2017-00824
Patent 6,088,802

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

BOUDREAU, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

Kingston Technology Company, Inc. ("Petitioner") filed a Petition requesting *inter partes* review of claims 1–3, 6–8, 11–15, 23–28, and 36–39 of U.S. Patent No. 6,088,802 (Ex. 1001, "the '802 patent"). Paper 2 ("Pet."). SPEX Technologies, Inc. ("Patent Owner") filed a Preliminary Response. Paper 7 ("Prelim. Resp.").

Under 35 U.S.C. § 314, an *inter partes* review may not be instituted "unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." 35 U.S.C. § 314(a). For the reasons that follow, we are not persuaded, on this record, that Petitioner has established a reasonable likelihood of prevailing in showing the unpatentability of any of the challenged claims on the asserted grounds. Accordingly, we *deny* the Petition and decline to institute an *inter partes* review of claims 1–3, 6–8, 11–15, 23–28, and 36–39 of the '802 patent.

II. BACKGROUND

A. Related Matters

The parties indicate that the '802 patent is involved in *SPEX Technologies, Inc. v. Kingston Technology Co. Inc.*, No. 8:16-cv-01790 (C.D. Cal. Filed Sept. 27, 2016); *SPEX Technologies, Inc. v. Western Digital Corp.*, No. 8:16-cv-01799 (C.D. Cal. Filed Sept. 28, 2016); *SPEX Technologies, Inc. v. Toshiba America Electronics Components Inc.*, No. 8:16-cv-01800 (C.D. Cal. Filed Sept. 28, 2016); *SPEX Technologies, Inc. v. CMS Products, Inc.*, No. 8:16-cv-01801 (C.D. Cal. Filed Sept. 28, 2016); *SPEX Technologies, Inc. v. Integral Memory, PLC*, No. 8:16-cv-01805 (C.D. Cal. Filed Sept. 28, 2016); and *SPEX Technologies, Inc. v.*

Apricorn, No. 2:16-cv-07349 (C.D. Cal. Filed Sept. 28, 2016). Pet. 2; Paper 3, 2–3.[1]

The ’802 patent also was the subject of a petition for *inter partes* review filed December 14, 2016, by Unified Patents Inc. Case IPR2017-00430, Paper 2. A decision denying institution of *inter partes* review in that case was entered on July 5, 2017. Case IPR2017-00430, Paper 8.

B. The ’802 Patent

The ’802 patent is directed to a peripheral device that may be connected to a host computer, where the peripheral device performs security operations such as encryption and decryption on data communicated between the peripheral device and the host computer. Ex. 1001, 1:17–27, 1:35–38, 4:49–5:4. Figures 1, 2, and 3A of the ’802 patent are reproduced below.

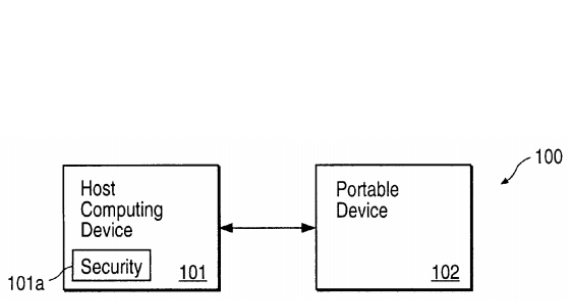

FIG. 1
(PRIOR ART)

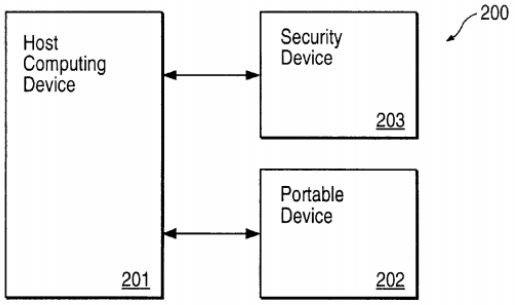

FIG. 2
(PRIOR ART)

[1] We note that Patent Owner’s Mandatory Notices Pursuant to 37 C.F.R. § 42.8(a)(2) (Paper 3) does not include page numbers. For ease of reference, the Parties are advised to include page numbers in all filings.

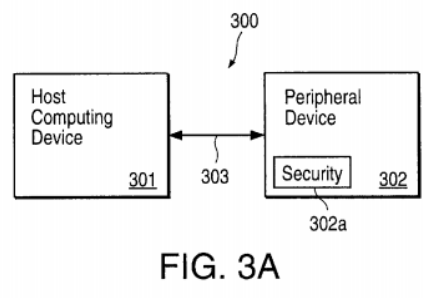

FIG. 3A

Figures 1 and 2 are block diagrams of prior art systems described in the '802 patent. *Id.* at 1:52–3:14, 4:14–19. Figure 3A is a block diagram of a system according to the claimed invention of the '802 patent. *Id.* at 4:20–21. The '802 patent explains that in the prior art, such security operations were either performed by the host computer, as illustrated in Figure 1 with security mechanism 101a included in host computing device 101, or by a standalone security device, as illustrated by security device 203 in Figure 2. *Id.* at 1:58–59, 2:22–32. According to the '802 patent, both of those arrangements were deficient in various ways. *Id.* at 2:10–21, 2:58–3:14.

C. Illustrative Claims

Of the challenged claims, claims 1, 6, 11, 23, 24, 36, 37, 38, and 39 are independent. Claims 1, 38, and 39, reproduced below, are illustrative of the claimed subject matter:

1. A peripheral device, comprising:

security means for enabling one or more security operations to be performed on data;

target means for enabling a defined interaction with a host computing device;

means for enabling communication between the security means and the target means;

means for enabling communication with a host computing device;

means for operably connecting the security means and/or the target means to the host computing device in response to an instruction from the host computing device; and

means for mediating communication of data between the host computing device and the target means so that the communicated data must first pass through the security means.

38. For use in a peripheral device adapted for communication with a host computing device, performance of one or more security operations on data, and interaction with a host computing device in a defined way, a method comprising the steps of:

receiving a request from a host computing device for information regarding the type of the peripheral device; and

providing to the host computing device, in response to the request, information regarding the type of the defined interaction.

39. For use in a peripheral device adapted for communication with a host computing device, performance of one or more security operations on data, and interaction with a host computing device in a defined way, a method comprising the steps of:

communicating with the host computing device to exchange data between the host computing device and the peripheral device;

performing one or more security operations and the defined interaction on the exchanged data; and

mediating communication of the exchanged data between the host computing device and the peripheral device so that the exchanged data must first [pass] through means for performing the one or more security operations.

Ex. 1001, 18:55–19:4, 22:13–38.

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