

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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TOSHIBA CORPORATION, TOSHIBA AMERICA ELECTRONIC  
COMPONENTS, INC., AND APRICORN,

Petitioners

v.

SPEX TECHNOLOGIES, INC.,

Patent Owner

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Case IPR2018-01067

Patent No. 6,088,802

**MOTION FOR JOINDER UNDER 35 U.S.C. § 315(C) AND  
37 C.F.R. §§ 42.22, 42.122(B)**

## I. STATEMENT OF RELIEF REQUESTED

Petitioners Toshiba Corporation, Toshiba America Electronic Components, Inc., and Apricorn (“Joinder Petitioners”) respectfully request joinder<sup>1</sup> pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. §§ 42.22 and 42.122(b) of the above-captioned petition for *inter partes* review (“Joinder Petition”)—filed contemporaneously with this Motion—with the pending *inter partes* review concerning the same claims of the same patent, captioned *Western Digital Corporation v. SPEX Technologies, Inc.*, Case No. IPR2018-00082, which was recently instituted on April 25, 2018. *See* IPR2018-00082, Paper No. 11.

The Joinder Petition is substantially identical to the petition in IPR2018-00082, and relies on the same grounds for which that IPR was instituted.<sup>2</sup> Moreover, Joinder Petitioners expressly agree to adhere to the schedule in IPR2018-00082 and take an “understudy” role in the proceedings. Accordingly,

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<sup>1</sup> Permission to file a motion for joinder is automatically granted by Rule 42.122(b). *Samsung Electronics Co., Ltd v. Fujinomaki*, IPR2017-01017, Paper 12 at 4 (May 26, 2017).

<sup>2</sup> While the petitions are not verbatim, they differ only in non-substantive respects. Specifically, the Joinder Petition has been updated to reflect the formalities of different petitioners and real parties in interest, and the related matters have been updated.

joinder is appropriate because it will promote efficient resolution of the validity of the involved patent, will not cause any undue delay, and will not prejudice or burden the parties in IPR2018-00082.

This Motion for Joinder is timely filed under 37 C.F.R. §§ 42.22 and 42.122(b) as it is submitted within (and no later than) one month after the April 25, 2018 institution date of IPR2018-00082.

## **II. STATEMENT OF MATERIAL FACTS**

On October 16, 2017, Petitioner Western Digital Corporation (“WD” or “Original Petitioner”) requested *inter partes* review of claims 1-2, 6-7, 11-12, 23-25, and 38-39 of U.S. Patent No. 6,088,802 (“the ‘802 patent”), citing four grounds of unpatentability. IPR2018-00082, Paper No. 1. Patent Owner, SPEX Technologies, Inc. (“SPEX” or “Patent Owner”), submitted a preliminary response on January 26, 2018, and WD submitted a reply to SPEX’s preliminary response on February 20, 2018. IPR2018-00082, Paper Nos. 6 and 9. SPEX submitted a sur-reply on February 26, 2018. IPR2018-00082, Paper No. 10.

On April 25, 2018, the Board issued an institution decision and scheduling order in IPR2018-00082. IPR2018-00082, Paper Nos. 11 and 12. In accordance with the Supreme Court’s recent decision in *SAS Institute, Inc. v. Iancu*, No. 16-969, 584 U.S. \_\_\_ (2018), because WD showed a reasonable likelihood of success in proving at least claims 38 and 39 unpatentable over the prior art, the Board

instituted IPR2018-00082 on all challenged claims (claims 1-2, 6-7, 11-12, 23-25, and 38-39) “with respect to all grounds set forth in the Petition.” IPR2018-00082, Paper No. 11, at 43.

The Joinder Petition that accompanies the present Motion for Joinder challenges the same claims on the same grounds as the petition in IPR2018-00082. *Compare* Joinder Petition at 1-68 *with* Petition in IPR2018-00082, Paper No. 1, at 1-67. Accordingly, as noted above, the Joinder Petition is substantially identical to WD’s petition in IPR2018-00082 and presents no new issues.

Original Petitioner WD has indicated that it does not oppose the joinder. Petitioners indicated to Patent Owner that Petitioners intended to file the instant motion on Monday, April 30, 2018, and contacted Patent Owner on Thursday, May 10, 2018 to determine Patent Owner’s position on the instant motion. As of Friday, May 2, 2018 at 3:00 PM PDT, Patent Owner has yet to respond.

### **III. STATEMENT OF REASONS FOR REQUESTED RELIEF**

#### **A. LEGAL STANDARD**

The Leahy-Smith America Invents Act (“AIA”) explicitly provides for joinder of *inter partes* review (“IPR”) proceedings. The statutory provision governing joinder of IPR proceedings is 35 U.S.C. § 315(c) that reads as follows:

(c) JOINDER.--If 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 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an *inter partes* review under section 314.

“Any request for joinder must be filed, as a motion under § 42.22, no later than one month after the institution date of any *inter partes* review for which joinder is requested.” 37 C.F.R. § 42.122(b).

In exercising its discretion to grant joinder, the Board considers the impact of substantive and procedural issues on the proceedings, as well as other considerations, while being “mindful that patent trial regulations, including the rules for joinder, must be construed to secure the just, speedy, and inexpensive resolution of every proceeding.” *See Dell Inc. v. Network-1 Security Solutions, Inc.*, Case IPR2013-00385, Paper No. 17, July 29, 2013 at 3. The Board should “also take into account the policy preference for joining a party that does not present new issues that might complicate or delay an existing proceeding.” *Id.* at 10.<sup>3</sup> Under this framework, joinder of the present IPR with IPR2018-00082 is

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<sup>3</sup> *Citing* 157 Cong. Rec. S1376 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl) (“The Office anticipates that joinder will be allowed as of right – if an *inter partes* review is instituted on the basis of a petition, for example, a party that files an

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