

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

Petitioners

v.

SPEX TECHNOLOGIES, INC.,

Patent Owner

CASE No.: IPR2018-01067

Patent No. 6,088,802

**PETITIONERS' REPLY TO PATENT OWNER'S OPPOSITION TO
PETITIONERS' MOTION FOR JOINDER**

Petitioners Toshiba Corporation, Toshiba America Electronic Components, Inc., and Apricorn (“Petitioners”) hereby respond to Patent Owner’s Opposition to Petitioners’ Motion for Joinder (“Opposition”). As explained below, the Opposition provides no basis for denying Petitioners’ Motion to Join (“Motion”). Petitioners’ Motion should therefore be granted.

I. PATENT OWNER’S ALLEGATIONS OF “ROAD MAPPING” ARE ERRONEOUS, MERITLESS, AND IRRELEVANT

Patent Owner does not contest that IPR2018-00082 filed by Western Digital (“WD IPR”)—which Petitioners seek to join—was timely filed, nor does Patent Owner dispute that Petitioner’s Motion is timely. Accordingly, Patent Owner does not, and cannot, point to anything procedurally improper with Petitioners’ Motion.

Instead, Patent Owner references IPR petitions filed by *other* parties, such as Unified Patents and Kingston, and vaguely insinuates that these petitions demonstrate that Petitioners engaged in what Patent Owner characterizes as “incremental petitioning.” Patent Owner’s allegations of improper and prejudicial conduct have no foundation in fact. Patent Owner does not dispute that these earlier-filed IPR petitions (1) were not filed by Petitioners, (2) were not joined by Petitioners, and (3) relied on different combinations of prior art than the WD IPR, which is the only IPR that Petitioners seek to join. Nor has Patent Owner provided any basis to allege that Petitioners had any involvement with any of the other IPR

petitions.

Patent Owner's attempts to associate Petitioners with the earlier-filed IPR petitions, and to allege that Petitioners have tried to "benefit from SPEX's prior arguments" in those IPRs, is unsupported. Patent Owner has failed to rebut Petitioners' showing that joinder with WD's IPR is warranted.

II. PETITIONER'S MOTION AMPLY DEMONSTRATES THAT JOINDER IS APPROPRIATE

Patent Owner's allegation that "Petitioners fail to identify a legitimate basis to join" the IPR is similarly incorrect. The Board has previously identified the existence of a well-defined "policy preference for joining a party that does not present new issues that might complicate or delay an existing proceeding," which Petitioners cited in their Motion. *Enzymotec Ltd. et al. v. Neptune Techs. & Bioresources, Inc.*, IPR2014-00556, Paper No. 19 at 6 (July 9, 2014); *Dell Inc. v. Network-1 Security Solutions, Inc.*, IPR2013-00385, Paper No. 17 at 10 (July 29, 2013) (The Board should "take into account the policy preference for joining a party that does not present new issues that might complicate or delay an existing proceeding."). In its Opposition, Patent Owner acknowledges that Petitioners' IPR petition does not identify any new arguments or issues. Accordingly, Petitioners' IPR Petition is precisely the type of petition that invokes the Board's stated policy preference for granting joinder, and the Opposition identifies no basis for the Board

to disregard this policy.¹ Because they are accused of infringing the same claims as Western Digital, Petitioners also explained that joinder is appropriate because it would allow the Board to efficiently resolve substantial questions of invalidity that are common to the Petitioners and Western Digital. Accordingly, Petitioners have identified multiple legitimate grounds for joining WD's IPR.

While Patent Owner alleges in a single sentence that joinder would “increase[e] expenses for SPEX,” it has offered nothing to substantiate its allegation of prejudice, nor can it, as Petitioners have expressly agreed: (1) to consolidate filings with Western Digital; (2) not to introduce any argument or discovery not already introduced by Western Digital; (3) to be bound by any agreement between Patent Owner and Western Digital concerning discovery; and (4) not to receive any direct, cross examination, or redirect time beyond that permitted for Western Digital. Patent Owner's unsupported allegations of added expense thus ring hollow. To the contrary, Petitioners would be substantially prejudiced by denial of the Motion, which would allow Patent Owner to evade the substantial questions of invalidity raised by WD's IPR in the event that WD settles with the Patent Owner prior to resolution of this proceeding.

¹The “Board routinely grants motions for joinder where the party seeking joinder introduces identical arguments and the same grounds raised in the existing proceeding.”) (internal quotations and citations omitted). *Samsung Elecs. Co., Ltd., et al. v. Raytheon Co.*, IPR2016-00962, Paper 12 at 9 (Aug. 24, 2016)

Finally, Patent Owner's speculative arguments regarding the alleged impact of its rehearing request in WD's IPR are moot given that the Board denied Patent Owner's request on July 10, 2018. IPR2018-00082, Paper 21. In rendering its decision, the Board noted that Patent Owner "failed to specifically identify in its Request any matter Patent Owner believes to have been misapprehended or overlooked in our Decision" and rejected Patent Owner's arguments that the Board had abused its discretion in instituting WD's IPR. *Id.* at 2-4.

III. CONCLUSION

Patent Owner has not rebutted Petitioners' showing that joinder is appropriate and will have no prejudicial impact on the proceedings in IPR2018-00082. Accordingly, Petitioners respectfully request that the Motion be granted.

Date: July 11, 2018

Respectfully submitted,

/s/ Douglas F. Stewart

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