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Paper No. 13
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

SPEX TECHNOLOGIES, INC.,
Patent Owner.

Case IPR2018-01068
Patent 6,003,135

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

FISHMAN, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review and
Granting Petitioner's Motion for Joinder

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

I. INTRODUCTION

Toshiba Corporation, Toshiba America Electronic Components, Inc., and Apricorn (collectively "Toshiba" or "Petitioner"), filed a Petition (Paper 5, "Pet.") for *inter partes* review of claims 55–58 of U.S. Patent No. 6,003,135 ("the '135 Patent") (Ex. 1001) pursuant to 35 U.S.C. §§ 311–319. A few days after filing the Petition, Petitioner filed a Motion for Joinder. Paper 6 ("Joinder Motion" or "Mot.").

The Joinder Motion seeks to join Petitioner as parties to *Western Digital Corp. v. SPEX Technologies, Inc.*, Case IPR2018-00084 ("the 84 IPR"). Mot. 1. The Joinder Motion indicates Western Digital Corp. ("WDC"), Petitioner in the 84 IPR, does not oppose Toshiba's request to join the 84 IPR. Mot. 3. SPEX Technologies, Inc. ("SPEX" or "Patent Owner") filed an Opposition to the Motion. Paper 9 ("Opp." or "Opposition"). Petitioner filed a Reply to Patent Owner's Opposition. Paper 11 ("Reply").

As explained further below, we institute trial in this *inter partes* review on the same grounds as instituted in IPR2018-00084, and we grant Petitioner's Motion for Joinder.

II. DISCUSSION

A. Institution of Trial

In the 84 IPR, WDC challenged claims 55–58 of the '135 Patent on the following grounds:

References	Basis	Claims challenged
Harari[1] and Anderson[2]	§ 103	55–58
Harari, Anderson, and Dumas[3]	§ 103	56 and 57

IPR2018-00084 Paper 1, 2–3. After considering the Petition and the Patent Owner's Preliminary Response in the 84 IPR, we instituted trial for the above-identified grounds of unpatentability. *See* IPR2018-00084 Paper 14, 2, 37.

Prior to the 84 IPR, Kingston Technology Company, Inc. filed petitions in IPR2017-00825 and IPR2017-01021 challenging the same claims (55–58) of the '135 patent although applying different references in those challenges. We instituted trial in IPR2017-01021 (Case IPR2017-01021, Papers 7, 20) and denied institution in IPR2017-00825 (Case IPR2017-00825, Paper 8). After we instituted trial in the 84 IPR, Kingston Technology Company, Inc. filed a petition in IPR2018-01002 and a motion for joinder as a petitioner in the 84 IPR. We dismissed that Petition as estopped under 35 U.S.C. § 315(e)(1) in view of the final written decision issued in Case IPR2017-01021 (filed by Kingston Technology Company

[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. 6,199,163 B1 ("Dumas," Ex. 1005).

challenging the same claims based on different art). Case IPR2018-01002, Paper 12, 10.

Petitioner here (Toshiba Corporation, Toshiba America Electronic Components, Inc., and Apricorn) represents that this Petition is substantially identical to WDC's Petition in IPR2018-00084 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 substantially identical to the Petition in IPR2018-00084. *Compare* Pet., *with* IPR2018-00084 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 IPR2018-00084, 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 55–58 on the same grounds as in IPR2018-00084.

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). Section 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)."

Petitioner here argues good cause exists to join Petitioner in the 84 IPR because: (1) the Petition is substantially identical to the petition in the

84 IPR "so that the Board can efficiently resolve the common grounds" (Mot. 6), (2) the Petition presents no new grounds (*id.* at 7), (3) the 84 IPR is in early stages of the trial and Petitioner will participate in an "understudy role," therefore, joining Petitioner will not impact the schedule of the 84 IPR (*id.*), and (4) joining Petitioner will simplify discovery and briefing in the 84 IPR (*id.* at 7–9).

Patent Owner opposes the present Motion arguing:

> On October 16, 2017, after having reviewed two preliminary responses by SPEX and two institution decisions by the PTAB, Western Digital filed a third petition in case number IPR2018-00084 ("84-IPR") alleging that claims 55-58 of the '135 Patent were unpatentable over the Harari, Dumas, and PCMCIA System Architecture references. 84-IPR, Paper 1.

Opp. 2. Patent Owner further contends a "joint defense group," presumably including Toshiba, "has engaged in incremental petitioning which has allowed it to impermissibly benefit from SPEX's prior arguments and the Board's prior decisions" and, therefore, no efficiencies are gained by allowing the requested joinder. Opp. 2–3.

We are persuaded that there is efficiency in joining Petitioner as parties in the 84 IPR. We are not persuaded there is any prejudice to Patent Owner by granting Petitioner's motion for joinder. Patent Owner's arguments regarding incremental petitioning were essentially addressed in our Decision on Institution in the 84 IPR. Paper 14, 14–18 (addressing Patent Owner's arguments concerning exercising our discretion based on the *General Plastic* factors). We were not persuaded by Patent Owner's arguments in that Decision on Institution and we remain unpersuaded now.

Accordingly, we grant Petitioner's Motion for Joinder with the 84 IPR, subject to the condition that:

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