

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

KIOXIA CORPORATION and KIOXIA AMERICA, INC.,
Petitioner,

v.

VIASAT, INC.,
Patent Owner.

IPR2023-00408
Patent 8,615,700 B2

Before THU A. DANG, KEVIN F. TURNER, and
ELIZABETH M. ROESEL, *Administrative Patent Judges*.

ROESEL, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314
Granting Motion for Joinder
35 U.S.C. § 315(c); 37 C.F.R. § 42.122

I. INTRODUCTION

A. *Background and Summary*

Kioxia Corporation and Kioxia America, Inc. (collectively, “Kioxia” or “Petitioner”) filed a Petition (Paper 1, “Pet.”) seeking an *inter partes* review of claims 1, 2, 4, 8, 15, 17, and 19 (the “challenged claims”) of U.S. Patent No. 8,615,700 B2 (Ex. 1001, “the ’700 Patent”). Concurrently with the Petition, Petitioner filed a Motion for Joinder with *Western Digital Technologies, Inc. v. Viasat, Inc.*, IPR2022-01126 (“1126 IPR”). Paper 3 (“Mot.”). Viasat, Inc. (“Patent Owner”) filed an opposition to the Motion for Joinder (Paper 6 (“PO Opp.”)), and Petitioner filed a reply (Paper 8, “Pet. Reply”).

For the reasons set forth below, we (1) institute *inter partes* review on the same grounds instituted in the 1126 IPR, and (2) grant Petitioner’s Motion for Joinder, subject to the conditions detailed herein.

B. *Related Matters*

The parties identify the following district court cases as related matters: *Viasat, Inc. v. Western Digital Corp.*, No. 6:21-CV-01230-ADA (W.D. Tex.) and *Viasat, Inc. v. Kioxia Corp.*, No. 6:21-CV-01231-ADA (W.D. Tex.) (collectively, the “parallel district court litigation”). Pet. 2–3; Paper 4, 1 (Patent Owner’s mandatory notices).

In a first challenge to the ’700 Patent, IPR2022-01067 (“1067 IPR”), Kioxia challenges claims 1–4, 8, 10–19, and 23–25 of the ’700 Patent, and we granted institution. 1067 IPR, Paper 17 (Nov. 29, 2022).

C. Asserted Grounds and Evidence

Petitioner asserts the following grounds of unpatentability, which are the same as the grounds of unpatentability on which we instituted *inter partes* review in the 1126 IPR.

Claims Challenged	35 U.S.C. § ¹	Reference(s)/Basis
1, 4, 8, 15, 17, 19	102(e)	Wu ²
1, 2, 4, 8, 15, 17, 19	103(a)	JO, ³ Wu
1, 2, 4, 8, 15, 17, 19	103(a)	JO, Wan ⁴

Pet. 5. Petitioner submits the declaration of Lara Dolecek, Ph.D. Ex. 1003.

II. INSTITUTION OF *INTER PARTES* REVIEW

A. Discretion Under 35 U.S.C. § 314(a)

Patent Owner argues that the Board should exercise its discretion to deny institution based on the factors set forth in the Board’s precedential decisions in *General Plastic Industrial Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017) (precedential in relevant part) (“*General Plastic*”) and *Apple Inc. v. Uniloc 2017 LLC*, IPR2020-

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), amended 35 U.S.C. § 103, effective March 16, 2013. Because the ’700 Patent was filed before this date, we refer to the pre-AIA version of § 103. Ex. 1001, code (22).

² Ex. 1004, US 2011/0126079 A1, filed November 24, 2009 and published May 26, 2011 (“Wu”).

³ Ex. 1005, US 2009/0063934 A1, filed August 27, 2008 and published March 5, 2009 (“JO”).

⁴ Ex. 1006, US 2010/0070681 A1, filed September 12, 2008 and published March 18, 2010 (“Wan”).

00854, Paper 9 (PTAB Oct. 28, 2020) (precedential) (“*Uniloc*”). *General Plastic* provides a non-exhaustive list of factors to be considered by the Board in evaluating whether to exercise discretion under 35 U.S.C. § 314(a) to deny a petition that challenges a patent that was previously challenged before the Board. *General Plastic*, 15–18.

In *Uniloc*, the petitioner (Apple) sought to join an instituted *inter partes* review by filing a petition that was substantially the same as the petition on which a trial had been instituted. *Uniloc*, 2–3. In that case, it was the petitioner’s second petition challenging the patent, and the panel applied the *General Plastic* factors and denied the petition. *Id.* at 8–13.

Citing *Uniloc*, Patent Owner argues that the *General Plastic* factors apply when a petitioner seeks to join an instituted proceeding in an understudy role and that these factors favor denial when a copycat petition is petitioner’s second challenge to the patent. PO Opp. 2–3. For the reasons explained below, we find the present circumstances are distinguishable from *Uniloc*, and we do not deny the Petition based on the *General Plastic* factors.

1. Factor 1: Whether the Same Petitioner Previously Filed a Petition Directed to the Same Claims of the Same Patent

This is Petitioner’s second petition challenging claims of the ’700 Patent. Petitioner filed its first petition on May 31, 2022, challenging claims 1–4, 8, 10–19, and 23–25. 1067 IPR, Paper 1; Pet. 3; PO Opp. 1, 4. Petitioner’s second petition challenges a subset of the claims challenged in the first petition. Pet. 1 (requesting *inter partes* review of claims 1, 2, 4, 8, 15, 17, and 19 of the ’700 Patent). Accordingly, the first *General Plastic* factor favors denial. *See Uniloc*, 8.

2. *Factor 2: Whether at the Time of Filing of the First Petition the Petitioner Knew of the Prior Art Asserted in the Second Petition or Should Have Known of It*

Petitioner's second petition relies on Wu, JO, and Wan. *See* Section I.C. *supra*. Petitioner's first petition also relied on JO (1067 IPR, Paper 1 at 13–14), which establishes that, at the time of filing of the first petition, Petitioner knew of at least one of the prior art references asserted in the second petition.

Patent Owner argues that the circumstances suggest that Petitioner also knew about Wu and Wan at the time it filed the first petition because, less than two weeks later, Petitioner provided claim charts for these references as part of its preliminary invalidity contentions in the parallel district court litigation. PO Opp. 4–5; Ex. 2001, 14, 21. Petitioner does not assert that it was unaware of Wu or Wan at the time it filed its first petition. Accordingly, the second *General Plastic* factor favors denial. *See Uniloc*, 9 (determining that this factor favors denial where petitioner failed to set forth facts or offer an explanation concerning its knowledge of the prior art asserted in the second petition).

3. *Factor 3: Whether at the Time of Filing of the Second Petition the Petitioner Already Received the Patent Owner's Preliminary Response to the First Petition or Received the Board's Decision on Whether to Institute Review in the First Petition*

“[F]actor 3 is directed to Petitioner's potential benefit from receiving and having the opportunity to study Patent Owner's Preliminary Response, as well as our institution decisions on the first-filed petitions, prior to its filing of follow-on petitions.” *General Plastic*, 17. “The absence of any restrictions on follow-on petitions would allow petitioners the opportunity to strategically stage their prior art and arguments in multiple petitions, using

our decisions as a roadmap, until a ground is found that results in the grant of review.” *Id.*

In *Uniloc*, the petitioner sought to join a proceeding filed by Microsoft, and the petitioner’s copycat petition (the petitioner’s second petition) was filed after two Board decisions concerning the petitioner’s first petition—a decision denying institution and a decision denying rehearing of that decision. *Uniloc*, 10. The timeline in *Uniloc* also shows that the Microsoft petition was likewise filed after the two Board decisions rejecting petitioner’s first petition. *Id.* at 6 (Uniloc’s first petition was denied on April 29, 2019; rehearing was denied on July 15, 2019; and Microsoft’s petition was filed on October 11, 2019).

In contrast to the circumstances in *Uniloc*, Petitioner seeks to join the 1126 IPR, which was filed by Western Digital Technologies, Inc. (“Western Digital”) **before** the Board issued a decision whether to institute Petitioner’s first petition and **before** Patent Owner filed a preliminary response to that petition. Unlike the timeline in *Uniloc*, this sequence does not present the same concerns about unfair advantage and using our decisions as a roadmap, as were expressed in *General Plastic*. We agree with Petitioner that “[b]ecause [Western Digital]’s Petition did not gain any advantage, Kioxia’s copycat petition did not either.” Pet. Reply 5.

There is no evidence supporting Patent Owner’s assertion that Kioxia and Western Digital “are coordinating serial, repetitive attacks on the ’700 patent.” PO Opp. 1. When instituting the 1126 IPR, we found no evidence of a significant relationship between Western Digital and Kioxia and determined that *General Plastic* factor 3 favored institution. 1126 IPR, Paper 13 at 15 (PTAB Nov. 29, 2022). Patent Owner does not point to any

evidence or argument that we overlooked or misapprehended when making that finding and determination.

Although Petitioner might, in the end, benefit from the filing of Western Digital's petition, there is no reason to conclude that Petitioner or Western Digital used Patent Owner's preliminary response or the Board's decision in the 1067 IPR to obtain an unfair advantage in this Petition, which is substantively the same as the earlier petition filed by Western Digital. For these reasons, the third *General Plastic* factor does not favor denial.

4. *Factors 4 and 5: The Length of Time that Elapsed Between the Time the Petitioner Learned of the Prior Art Asserted in the Second Petition and the Filing of the Second Petition; and Whether the Petitioner Provides Adequate Explanation for the Time Elapsed Between the Filings of Multiple Petitions Directed to the Same Claims of the Same Patent*

Even assuming Petitioner knew of the prior art asserted in the second petition at the time Petitioner filed the first petition, we do not view the present situation as one in which Petitioner should have filed a joinder petition earlier than it did. Petitioner filed the Petition and Motion for Joinder within one month of institution of the 1126 IPR, as required under our Rules. 37 C.F.R. § 42.122(b).

On the other hand, Patent Owner asserts that Petitioner "waited more than six months to file this second petition." PO Opp. 6. Petitioner does not dispute that assertion. As in *Uniloc*, Petitioner provides no explanation for the time elapsed between learning of the prior art asserted in the Petition and the filing of the Petition. *Uniloc*, 11 (concluding that the fourth and fifth *General Plastic* factors favor denial where petitioner failed to explain when it learned of the asserted prior art).

Accordingly, consistent with *Uniloc*, we find that the fourth and fifth *General Plastic* factors favor denial.

5. *Factors 6 and 7: The Finite Resources of the Board; and the Requirement Under 35 U.S.C. § 316(a)(11) to Issue a Final Determination Not Later Than 1 Year After the Date on Which the Director Notices Institution of Review*

Patent Owner argues that these factors favor denial because, if Western Digital settles, “the Petition would continue to utilize the Board’s resources,” and the Board would need to “preside over multiple instituted petitions brought against the same claims by the same petitioner.” PO Opp. 7. We disagree. In the 1126 IPR, we found that the sixth and seventh *General Plastic* factors favor institution “[b]ecause the Petition was filed only ten days after the petition in IPR2022-01067 and challenges some of the same claims and asserts one of the same references, [and] the petitions can be efficiently considered by the Board.” 1126 IPR, Paper 13 at 15. Joining Kioxia as a petitioner in the 1126 IPR will not lessen the efficiency with which the Board can decide the petitions in the 1067 IPR and the 1126 IPR. The Board’s resources are not a concern because we have the capacity to preside over the 1126 IPR and issue a timely final written decision, regardless of who is the petitioner. For these reasons, the sixth and seventh *General Plastic* factors do not favor denial.

6. *Conclusion*

In summary, while some of the *General Plastic* factors favor discretionary denial of the Petition, others do not. On the particular facts of this case, we give greater weight to the third, sixth, and seventh factors, which do not favor denial, than we give to the remaining factors. Although Patent Owner relies on the Board’s precedential decision in *Uniloc*, that case

is distinguishable from the facts presented here. In *Uniloc*, Apple’s first petition was denied on the merits, and Apple’s joinder motion was viewed as an “end run around its failed petition.” *Uniloc*, 6 (quoting the patent owner’s argument). Unlike the circumstances in *Uniloc*, Petitioner’s first petition in the 1067 IPR was **granted**, and trial in the 1067 IPR is proceeding on the same schedule as the 1126 IPR that Kioxia seeks to join. In this respect, Kioxia is not seeking “another bite at the ’700 patent,” as argued by Patent Owner. POOpp. 1. Kioxia is merely seeking to join an already instituted proceeding filed by Western Digital just ten days after Kioxia filed the petition in the 1067 IPR.

For these reasons, we do not exercise our discretion to deny the Petition under 35 U.S.C. § 314(a).

B. Reasonable Likelihood Under 35 U.S.C. § 314(a)

Petitioner represents that the Petition is “substantively identical” to the petition in the 1126 IPR. Mot. 3. According to Petitioner, the Petition “challenges the same claims of the same patent, relies on the same expert declaration, and is based on the same grounds and combinations of prior art submitted in the [Western Digital] Petition” in the 1126 IPR. Mot. 4.

Patent Owner did not file a preliminary response to the Petition and does not respond to Petitioner’s arguments about unpatentability of the challenged claims.

After considering the Petition and the record as a whole and for the same reasons as stated in the institution decision in the 1126 IPR, we determine that there is a reasonable likelihood that Petitioner would prevail with respect to at least one of the claims challenged in the Petition. *See* 1126 IPR, Paper 13 at 15–36.

III. MOTION FOR JOINDER

Petitioner requests joinder pursuant to 35 U.S.C. § 315(c), which provides as follows:

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.

Section 315(c) “authorizes joinder of a person as a party, not ‘joinder’ of two proceedings” and “does not authorize the joined party to bring new issues from its new proceeding into the existing proceeding.” *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1335 (Fed. Cir. 2020).

Here, Petitioner’s Motion for Joinder requests no more than the statute allows. Petitioner represents that the Petition “involves the same claims of the same patent, the same grounds of unpatentability, and the same supporting evidence” as presented in the 1126 IPR. Mot. 1. Furthermore, Petitioner agrees that, if joined to the 1126 IPR, Petitioner will take an “understudy” role and no changes to the schedule will be needed. Mot. 1–2, 6–7. Petitioner states that it will assume an active role only if the petitioner in the 1126 IPR ceases to participate. Mot. 7 & n.1.

As discussed above, Patent Owner argues that the Board should exercise its discretion to deny the Petition. PO Opp. 1–7. Aside from its arguments in support of discretionary denial, Patent Owner presents no other argument in opposition to Petitioner’s Motion for Joinder. Petitioner indicates that Western Digital does not oppose the Motion for Joinder. Mot. 2.

We find that Petitioner’s Motion for Joinder is timely under 37 C.F.R. § 42.122(b). After considering the motion, we are persuaded that joinder is appropriate and will have little to no impact on the timing, cost, or presentation of the trial on the instituted grounds. In consideration of the foregoing, and in the manner set forth in the following Order, the Motion for Joinder is *granted*.

IV. ORDER

It is

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review of claims 1, 2, 4, 8, 15, 17, and 19 of the ’700 Patent is instituted;

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of trial;

FURTHER ORDERED that the Motion for Joinder is *granted*, and Kioxia Corporation and Kioxia America, Inc. (collectively, “Kioxia”) is hereby joined as a petitioner in IPR2022-01126;

FURTHER ORDERED that the grounds on which trial was instituted in IPR2022-01126 are unchanged, and no other grounds are added;

FURTHER ORDERED that Kioxia’s role in IPR2022-01126 shall be limited as stated in the Motion for Joinder (Mot. 6–7), unless and until Western Digital Technologies, Inc. is terminated from that proceeding;

FURTHER ORDERED that the Scheduling Order in place for IPR2022-01126 (Paper 14), as modified by the parties’ stipulation in IPR2022-01126 (Paper 17), shall continue to govern the proceeding after the joinder of Kioxia as a petitioner;

FURTHER ORDERED that all future filings are to be made only in IPR2022-01126;

FURTHER ORDERED that the case caption in IPR2022-01126 shall be changed to reflect the joinder of Kioxia in accordance with the example below; and

FURTHER ORDERED that a copy of this Decision shall be entered into the record of IPR2022-01126.

Example Caption

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WESTERN DIGITAL TECHNOLOGIES, INC.,
KIOXIA CORPORATION, and KIOXIA AMERICA, INC.,
Petitioner,

v.

VIASAT, INC.,
Patent Owner.

IPR2022-01126⁵
Patent 8,615,700 B2

⁵ Kioxia Corporation and Kioxia America, Inc. filed a petition and a motion for joinder in IPR2023-00408 and have been joined as petitioners in this proceeding.

IPR2023-00408
Patent 8,615,700 B2

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