

IPR2023-00408
U.S. Patent No. 8,615,700

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.

Case No. IPR2023-00408
U.S. Patent No. 8,615,700

**PATENT OWNER'S OPPOSITION TO MOTION FOR JOINDER TO
INTER PARTES REVIEW IPR2022-01126**

TABLE OF CONTENTS

I.	The Board Should Exercise Its Discretion To Deny This Petition	2
A.	Factor One: Petitioner Previously Filed A Petition Directed To The Same Claims Of The Same Patent	4
B.	Factor Two: When It Filed Its First Petition, Petitioner Knew Or Should Have Known Of The Prior Art Asserted Here	4
C.	Factor Three: When It Filed Its Second Petition, Petitioner Had Already Received Patent Owner’s Preliminary Response And The Board’s Institution Decision	5
D.	Factors Four and Five: At Least Six Months Passed Between When Petitioner Learned Of The Prior Art And When It Filed The Second Petition.....	6
E.	Factors Six and Seven: The Board’s Resources Are Finite And Better Served Elsewhere	6

TABLE OF AUTHORITIES

Cases

<i>Apple Inc. v. Uniloc 2017 LLC</i> , IPR2020-00854, Paper 9 (PTAB October 28, 2020)	passim
<i>General Plastic Industrial Co. v. Canon Kabushiki Kaisha</i> , IPR2016-01357, (PTAB Sept. 6, 2017)	passim
<i>Kioxia Corp. v. Viasat, Inc.</i> , IPR2022-01067, Paper 1 (PTAB May 31, 2022)	1, 4
<i>Valve Corp. v. Elec. Scripting Prods., Inc.</i> , IPR2019-00064, -00065, -00085, Paper 10 (PTAB May 1, 2019)	6
<i>Western Digital Techs. v. Viasat, Inc.</i> , IPR2022-01126, Paper 1 (PTAB June 10, 2022)	1

Statutes

35 U.S.C. § 314(a)	2
--------------------------	---

Federal Regulations

37 C.F.R. § 42.122(b)	2
37 C.F.R. § 42.20(c)	2

Other Authorities

Consolidated Trial Practice Guide (Nov. 2019)	2
---	---

LIST OF EXHIBITS

Exhibit No.	Description
2001	Defendants' Preliminary Invalidity Contentions, <i>Viasat, Inc. v. Kioxia Corp.</i> (W.D. Tex. June 10, 2023)

Kioxia seeks another bite at the '700 patent. Petitioner's new petition lays bare the concerns Patent Owner raised in its preliminary response to IPR2022-01126, the Western Digital petition Kioxia now seeks to join. The two petitioners are coordinating serial, repetitive attacks on the '700 patent. Now that Western Digital has succeeded in getting its petition granted, Kioxia wants to be part of that petition as well. The Board should not allow it.

Patent Owner filed patent infringement suits against Western Digital and Kioxia in the Western District of Texas in November 2021. Patent Owner asserts the '700 patent against both. On May 31, 2022, Kioxia filed its first petition for inter partes review against the '700 patent, challenging claims 1-4, 8, 10-19, and 23-25 against various combinations of references Lee, Jo, Kim, and Yamaga. *See Kioxia Corp. v. Viasat, Inc.*, IPR2022-01067, Paper 1 at 13-14 (PTAB May 31, 2022). Just days later, Western Digital filed another petition to challenge claims 1, 2, 4, 8, 15, 17, and 19 based on references Wu, Jo, and Wan. *See Western Digital Techs. v. Viasat, Inc.*, IPR2022-01126, Paper 1 at 5 (PTAB June 10, 2022). And on the same day, Western Digital and Kioxia jointly served invalidity contentions in the district court—raising the art asserted in both petitions alongside other prior art references they could have raised in the petitions but chose not to.

Now, more than six months later, Kioxia has filed a second petition and asks the Board to join this new petition with Western Digital's IPR2022-01126. Kioxia

has little explanation for its actions other than that it wishes to serve in an understudy role to Western Digital in case of settlement. But this is precisely “the kind of serial attack that *General Plastic* was intended to address” and stop. *See Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9 at 4 (PTAB October 28, 2020).

The Board should deny Petitioner’s motion for joinder and decline to institute review of the challenged claims.

I. The Board Should Exercise Its Discretion To Deny This Petition

As the moving party, Kioxia has the burden of proof to establish that its requested relief should be granted. 37 C.F.R. §§ 42.20(c), 42.122(b). “Factors that the Board may consider in deciding a motion for joinder include why joinder is appropriate, whether a new ground of unpatentability is raised in the second petition, how the cost and schedule of the first proceeding will be impacted if joinder is granted, and whether granting joinder will add to the complexity of briefing and/or discovery.” Consolidated Trial Practice Guide (Nov. 2019) at 76. “Also, consideration of the non-exclusive factors set out in *General Plastic Industrial Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, slip op. at 16 (PTAB Sept. 6, 2017) (Paper 19) (precedential as to § II.B.4.i), may support the exercise of the Board’s discretion to deny institution under 35 U.S.C. § 314(a).” *Id.* at 77.

The Board has made clear that the analysis set out in *General Plastic* applies in circumstances like these, in which a petitioner files a “me-too petition.” *Uniloc*,

IPR2020-00854, Paper 9 at 5 (precedential decision denying institution and joinder motion of a follow-on copycat petition under *General Plastic*). In *Uniloc*, the Board expressly rejected the petitioner’s argument that the *General Plastic* factors do not apply “where Petitioner seeks to join as a party to [an] IPR and take an inactive or understudy role.” *Id.* at 4. Rather, the Board found that argument “not persuasive here where the copied petition is Petitioner’s second challenge to the patent, and should [the other petitioner] settle, Petitioner would stand in to continue a proceeding that would otherwise be terminated.” *Id.* That would be no different than if Petitioner “had brought the second challenge to the patent in the first instance.” *Id.* This is the very situation that *General Plastic* addresses. *Id.*; see also *General Plastic*, IPR2016-01357, Paper 19 at 17 (“Multiple, staggered petitions challenging the same patent and same claims raise the potential for abuse.”).

Petitioner presents no argument for why joinder and institution are appropriate under *General Plastic*. Instead, Petitioner suggests—contradicting *Uniloc*—that “*General Plastic* does not apply here because the petitioner seeks to join an instituted IPR proceeding in an inactive role.” Petition at 5. Petitioner’s failure to present any argument or evidence about the *General Plastic* factors whatsoever should doom its joinder motion and this second petition. See, e.g., *Uniloc*, IPR2020-00854, Paper 9 at 9 (a petitioner’s “lack of explanation . . . weighs in favor of denying institution of

the proceeding”). And when considered, those factors weigh strongly in favor of denial as well.

A. Factor One: Petitioner Previously Filed A Petition Directed To The Same Claims Of The Same Patent

Kioxia’s new petition challenges only claims already addressed by its first petition. Kioxia’s first petition addresses the ’700 patent’s claims 1-4, 8, 10-19, and 23-25. Kioxia’s new petition challenges a subset of those: claims 1, 2, 4, 8, 15, 17, and 19. This factor weighs in favor of denying this motion for joinder and institution. *Uniloc*, IPR2020-00854, Paper 9 at 8.

B. Factor Two: When It Filed Its First Petition, Petitioner Knew Or Should Have Known Of The Prior Art Asserted Here

Kioxia undoubtedly knew of at least one of the references relied on in its second petition when it filed its first—that reference is used in both petitions. Both petitions rely on U.S. Patent Application Publication No. 2009/0063934 to Jo. *Compare* Petition at 5 to *Kioxia Corp. v. Viasat, Inc.*, IPR2022-01067, Paper 1 at 13-14 (PTAB May 31, 2022).

And the circumstances here suggest that Kioxia also knew about the other references in its second petition—Wu and Wan. Less than two weeks after it filed its first petition, Kioxia and Western Digital jointly relied on Wu and Wan in their preliminary invalidity contentions. *See* Ex. 2001 at 14. In fact, Wu and Wan were references for which Kioxia and Western Digital provided invalidity charts. *Id.* at

21. And Kioxia has never claimed that it was unaware of Wu and Wan at the time it filed its first petition. This factor also weighs in favor of denying this motion for joinder and institution. *Uniloc*, IPR2020-00854, Paper 9 at 9.

C. Factor Three: When It Filed Its Second Petition, Petitioner Had Already Received Patent Owner’s Preliminary Response And The Board’s Institution Decision

Kioxia’s earlier petition had already been decided by the Board when it filed its second petition and motion for joinder. Viasat submitted its preliminary response to the petition on September 7, 2022, and the Board decided to institute on November 29, 2022. Kioxia filed the present petition a month later.

“[T]he third *General Plastic* factor addresses whether [Petitioner] had access to a Board decision or a preliminary response concerning its first petition, such that [Petitioner] would have been in a position to gain a benefit from having that information before filing its second petition.” *Uniloc*, IPR2020-00854, Paper 9 at 10. As in *Uniloc*, the timing of events here shows that Kioxia had significant information before it decided to file its second petition. Not only did Kioxia have the Viasat’s preliminary response and the Board’s institution decision for the first petition it filed, but it also had those for the petition Western Digital filed that it seeks to join. Those preliminary responses and Board decisions no doubt benefited and influenced Kioxia when it decided to file its second petition. This factor weighs

in favor of denying this motion for joinder and institution. *Uniloc*, IPR2020-00854, Paper 9 at 8.

D. Factors Four and Five: At Least Six Months Passed Between When Petitioner Learned Of The Prior Art And When It Filed The Second Petition

Even if Kioxia somehow did not learn of Wu and Wan until the day it served its preliminary invalidity contentions (an unlikely scenario, to say the least), it still waited more than six months to file this second petition. *See Valve Corp. v. Elec. Scripting Prods., Inc.*, IPR2019-00064, -00065, -00085, Paper 10 at 14 (PTAB May 1, 2019) (“there is no justification for it having waited [five months] for the Board’s institution decision”). These factors favor denying joinder and institution.

E. Factors Six and Seven: The Board’s Resources Are Finite And Better Served Elsewhere

Kioxia says that it “seeks to join the WD IPR proceeding in order to ensure that an accused infringer with an active interest in the proceeding remains a party to this Trial in the event that WD’s participation is terminated prior to completion.” Motion for Joinder at 4. The sixth *General Plastic* factor considers those circumstances—“the resources of the Board in the event [Western Digital] were to cease participation in the [Western Digital] IPR.” *Uniloc*, IPR2020-00854, Paper 9 at 11-12. And the seventh factor is also based on efficiency concerns. *See Valve Corp.*, IPR2019-00064, -00065, -00085, Paper 10 at 15-18.

The Board’s decision in *Uniloc* is instructive here, yet again. “[B]ecause this is [Kioxia]’s second petition, should [Western Digital] settle, [Kioxia] would stand in to continue a proceeding that would otherwise be terminated.” *Uniloc*, IPR2020-00854, Paper 9 at 12. That is, even after a Western Digital settlement, the Petition would continue to utilize the Board’s resources. “Joinder in this circumstance would allow [Kioxia] to continue a proceeding, even after settlement with the primary petitioner, based on a second attempt by [Kioxia].” *Id.* Joinder would expend—rather than conserve—the Board’s resources and have it preside over multiple instituted petitions brought against the same claims by the same petitioner. These factors too weigh in favor of denial.

* * *

Petitioner’s arguments for institution and joinder boil down to nothing more than that it has filed a copycat petition of Western Digital’s instituted IPR. The Board addresses those circumstances head on in *Uniloc* and concluded that the *General Plastic* factors counsel to deny the petition when the copycat petition is a second attack by the same petitioner. Viasat requests that the Board exercise its discretion to deny Kioxia’s second petition here for the same reasons.

Dated: January 27, 2023

Respectfully submitted,

By: /Meg E. Fasulo/

Meg E. Fasulo (Reg. No. 75,820)

BARTLIT BECK LLP

1801 Wewatta Street, Suite 1200

Denver, CO 80202

Counsel for Patent Owner

CERTIFICATE OF SERVICE

The undersigned certifies, that on this 27th day of January, 2023, the foregoing document is being served by e-mail on counsel of record for Petitioner as follows:

michael.silliman@bakerbotts.com
robinson.vu@bakerbotts.com

By: /Meg E. Fasulo/
Meg E. Fasulo (Reg. No. 75,820)
BARTLIT BECK LLP
1801 Wewatta Street, Suite 1200
Denver, CO 80202

Counsel for Patent Owner