

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

KIOXIA CORPORATION and KIOXIA AMERICA, INC.
Petitioners,

v.

VIASAT, INC.
Patent Owner.

Case No. IPR2023-00408

Patent No. 8,615,700

**PETITIONER'S REPLY IN SUPPORT OF MOTION FOR JOINDER TO
INTER PARTES REVIEW IPR2022-01126**

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Viasat's arguments are not supported by the record or the Board's precedent, and the Board should grant joinder of Kioxia's Petition.

I. JOINDER WOULD FURTHER PUBLIC BENEFIT

Kioxia's Petition was submitted through the statutorily authorized joinder process and presents no efficiency concerns because it includes only substantively identical issues to the Western Digital ("WD") IPR and Kioxia has agreed to take an understudy role. Granting Kioxia's Motion for Joinder best achieves the public benefits of improving patent quality and patent-system efficiency, especially because WD's Petition has already resulted in institution. *Intel Corp. v. VLSI Tech.*, IPR2022-00366, Paper 14, at 9-11 (PTAB June 8, 2022) (finding substantive consideration of the merits of a petition is an important factor in the *General Plastic* analysis to address the public benefit of improving patent quality).

II. UNILOC DOES NOT APPLY TO KIOXIA'S PETITION

Viasat's opposition focuses entirely on the Board's precedential decision in *Apple v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9 (PTAB Oct. 28, 2020) ("*Uniloc*"). However, as the Board has clarified in numerous decisions, that decision does not apply to the circumstances of Kioxia's Petition.

Specifically, Viasat argues that *Uniloc* requires that joinder be denied for the Kioxia Petition under the *General Plastic* factors. Unlike Kioxia, however, the petitioner in *Uniloc* had its previous petition *denied institution on the merits*, and

filed a copycat petition based on an IPR petition that was drafted *with the benefit of* the institution decision and the patent owner preliminary response in the earlier failed petition. *Uniloc* at 6, 10. Here, Kioxia’s first petition was *instituted on the merits*. *Kioxia Corp. v. Viasat, Inc.*, IPR2022-01067, Paper 17 (PTAB Nov. 29, 2022). Moreover, this Petition is substantively identical to WD’s Petition, which was filed before, and therefore *without the benefit of*, the patent owner preliminary response or institution decision for Kioxia’s first petition. *Compare Western Digital Technologies, Inc. v. Viasat, Inc.*, IPR2022-01126, Paper 1 (PTAB June 10, 2022) *to Kioxia*, IPR2022-01067, Paper 15 (PTAB Sep. 7, 2022) *and Kioxia*, IPR2022-01067, Paper 17 (PTAB Nov. 29, 2022).

As the Board has clarified several times since *Uniloc* was made precedential, the *Uniloc* decision is limited to its unique factual circumstances. *See, e.g., STMicroelectronics, Inc. v. Ocean Semiconductor*, IPR2022-00681, Paper 10, at 10-11 (PTAB Sep. 2, 2022) (discussed below) (“*STMicroelectronics*”); *LG Electronics v. Gesture Technology*, IPR2022-00091, Paper 8, at 5 (PTAB, Mar. 17, 2022) (granting joinder motion after considering *Apple v. Uniloc* because the “unique facts in *Apple v. Uniloc*” were not present); *Intel Corp. v. VLSI Tech.*, IPR2022-00366, Paper 14, at 9, 19-20 (PTAB June 8, 2022) (granting joinder motion after considering *Apple v. Uniloc* because unlike in *Uniloc*, the earlier petitions at issue were not substantively denied) (“*Intel*”).

For example, as the Board explained in *STMicroelectronics*, *Uniloc* “addressed whether a petitioner who had a *first petition denied on the merits* would be allowed to join an already-instituted IPR through a second petition,” and does not apply to a petitioner who has not had a previous petition denied on the merits. *STMicroelectronics* at 10-11 (emphasis in original). Like the petitioner in *STMicroelectronics*, “[Kioxia] has not previously filed a petition that was denied on the merits, and properly filed its Petition and Joinder Motion within one month of the institution date of the [WD] IPR. Therefore, neither the rationale nor the outcome of [*Uniloc*] applies here.” *Id.* at 11.

Contrary to Viasat’s arguments, absent the specific circumstances in *Uniloc*, copycat petitions like Kioxia’s do not present concerns of “serial attacks” after a failed petition, but rather represent a petitioner, facing litigation filed by the patent owner, availing themselves of the statutorily-authorized joinder procedure. *See, e.g., STMicroelectronics* at 11; *see also Google v. Express Mobile*, IPR2022-00791, Paper 15, at 9 (PTAB Oct. 7, 2022) (“*Express Mobile*”); 35 U.S.C. § 315 (c).

III. THE *GENERAL PLASTIC* FACTORS FAVOR JOINDER

When taken together with Kioxia’s commitment to an understudy role, the *General Plastic* factors weigh in favor of joinder and institution. Viasat bases its arguments for every *General Plastic* factor on either the inapplicable *Uniloc*

decision or another distinguishable decision, *Valve Corp. v. Elec. Scripting Prods., Inc.*, IPR2019-00064, -00065, -00085, Paper 10 (PTAB May 1, 2019) (“*Valve*”). Opp. at 6-7. Unlike Kioxia, the petitioner in *Valve* had filed an original petition (not a copycat), did not seek joinder to an existing proceeding, and did not agree to an understudy role. *Valve* at 8-18.

Viasat argues that the “understudy” role of Kioxia no longer affects the *General Plastic* factors after *Uniloc* (Opp. at 3), but the Board has already rejected this argument. See, e.g., *Advanced Micro Devices Inc. v. Monterey Research LLC*, IPR2021-00776, Paper 13 at 17-18 (PTAB Oct. 13, 2021) (rejecting the argument that understudy role has no bearing after *Uniloc* and finding several *General Plastic* factors did not weigh in favor of denying institution where petitioner took understudy role) (“*Advanced Micro*”).

In addition to Kioxia’s understudy role, several *General Plastic* factors weigh strongly in favor of joinder and institution. For example, factors six and seven relate to board resources and efficiency. *General Plastic Industrial Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19, at 16 (PTAB Sept. 6, 2017). The Board has recognized numerous times since *Uniloc* that “Board resources are not a concern [where a new party joins a pending petition] because this panel has the capacity to see the [Western Digital] IPR to its conclusion regardless of the constitution of the petitioner.” See *Express Mobile* at 12; *Advanced Micro* at 17-

18. Moreover, there is no reason (nor does Viasat offer any) why Kioxia joining the WD IPR as an understudy would significantly affect the Board's ability to timely issue a final written decision. *See Express Mobile* at 13; *Advanced Micro* at 18. No changes in the schedule will be necessary, and the limited participation, if at all, of Kioxia will not impact the timeline of the ongoing proceeding.

Additionally, the third *General Plastic* factor—whether Petitioner used preliminary responses or institution decisions in prior petitions to gain an advantage in the second petition—does not weigh against joinder. *See General Plastic* at 9. As discussed above, Kioxia's Petition is substantively identical to WD's Petition, which was filed before the institution decision and preliminary response in Kioxia's previous petition. Because WD's Petition did not gain any advantage, Kioxia's copycat petition did not either. *See Intel* at 10-11; *Express Mobile* at 9. Although some of the other *General Plastic* factors may be neutral or weigh in favor of institution, on balance the factors—when taken together with Kioxia's understudy role—clearly favor joinder and institution.

Kioxia acted within the statutory time frame set forth in 35 U.S.C. § 315(c) and 37 C.F.R. § 41.122(b), and Kioxia's Petition presents no efficiency or fairness concerns due to Kioxia's substantively identical petition and understudy role. For the reasons herein and in Kioxia's Motion for Joinder, Kioxia respectfully requests that the Board institute review and grant joinder.

Dated: February 27, 2023

Respectfully submitted,

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CERTIFICATE OF SERVICE

In accordance with 37 C.F.R. § 42.6(e), the undersigned certifies that on February 27, 2023, a complete and entire copy of Petitioner's

**REPLY IN SUPPORT OF MOTION FOR JOINDER TO *INTER PARTES*
REVIEW IPR2022-01126**

("Reply") was served on Patent Owner counsel of record via electronic mail at the following correspondence addresses:

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February 27, 2023

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