

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WESTERN DIGITAL CORPORATION, TOSHIBA CORPORATION, TOSHIBA
AMERICA ELECTRONIC COMPONENTS, INC., and APRICORN¹,
Petitioners

v.

SPEX TECHNOLOGIES, INC.,
Patent Owner

Case IPR2018-00082
U.S. Patent No. 6,088,802

NOTICE OF APPEAL

¹ Kingston Technology Company, Inc., which filed a Petition in Case IPR2018-01003, has been joined as a petitioner in this proceeding. Toshiba Corporation, Toshiba America Electronic Components, Inc, Apricorn, which filed a Petition in Case IPR2018-01068, have been joined as petitioners in this proceeding. (The official caption in this IPR was never corrected to reflect that Kingston is a party.)

Pursuant to 35 U.S.C. § 141 and 37 C.F.R. § 90.2, Petitioner Kingston Technology Company, Inc. (“Petitioner”) hereby provides notice that it appeals to the United States Court of Appeals for the Federal Circuit from the Final Written Decision entered April 18, 2019 (Paper 40) and from all underlying orders, decisions, rulings, and opinions adverse to it regarding U.S. Patent 6,088,802 (“the ‘802 patent”) at issue in *Inter Partes* Review IPR2018-00082.

In accordance with and for the purpose of providing the Director with the information requested pursuant to 37 C.F.R. § 90.2(a)(3)(ii), Petitioner anticipates that the issues on appeal may include, but are not limited to the following, as well as any underlying findings, determinations, rulings, decisions, opinions, or other related issues:

- The Board violated *SAS Institute, Inc. v. Iancu*, 138 S. Ct. 1348 (2018), the Administrative Procedure Act, and/or Petitioner’s due process rights by denying Petitioner’s requests to: (i) supplement the record to include admissions made by Patent Owner’s experts that were made only after the Petition was filed, and (ii) file a reply, with respect to the patent claims for which the Board instituted review but did not find, based on the Petition, that Petitioner had a reasonable likelihood of prevailing.
- The Board violated *SAS Institute, Inc. v. Iancu*, 138 S. Ct. 1348 (2018), the Administrative Procedure Act, and/or Petitioner’s due process rights by

limiting Petitioner's arguments to issues raised in a Patent Owner's response, where the Patent Owner did not file a Patent Owner Response and hence raised no issues with respect to the patent claims for which the Board instituted review but did not find, based on the Petition, that Petitioner had a reasonable likelihood of prevailing.

- The Board erred in holding that an invalidity argument based on disclosure found in a prior art reference relied upon in the Petition, in combination with 3 admissions by the Patent Owner's experts that were made after the Petition was filed, constitutes a new "ground" for unpatentability.
- Any and all findings or determinations supporting or related to the above identified issues, and all other issues decided adversely to Petitioner in any order, decision, ruling, or opinion by the Board in this Inter Partes Review.

Simultaneous with this filing and in accordance with 35 U.S.C. § 142 and 37 C.F.R. § 90.2(a)(1), this Notice is being filed with the Director of the United States Patent and Trademark Office, and a copy of this Notice is being concurrently filed with the Patent Trial and Appeal Board. In addition, a copy of this Notice along with the required docketing fees are being filed with the Clerk's Office for the United States Court of Appeals for the Federal Circuit via CM/ECF.

Respectfully submitted,

Date: June 7, 2019

/David Hoffman/

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CERTIFICATE OF SERVICE

In accordance with 37 CFR § 90.2(a)(1) and § 104.2, the undersigned hereby certifies that on June 7, 2019, in addition to being filed electronically through the Board's E2E System, the original version of the foregoing, Patent Owner's Notice of Appeal was filed by hand on the Director of the United States Patent and Trademark Office, at the following address:

Director of the United States Patent and Trademark Office
c/o Office of the General Counsel
Madison Building East, 10B20
600 Dulany Street
Alexandria, VA 22314-5793

The undersigned hereby certifies that on June 7, 2019, a true and correct copy of the foregoing, Patent Owner's Notice of Appeal, along with a copy of the Final Written Decision, was filed electronically with the Clerk's Office of the United States Court of Appeals for the Federal Circuit, at the following address:

United States Court of Appeals for the Federal Circuit
717 Madison Place, N.W., Suite 401
Washington, DC 20005

Pursuant to 37 CFR § 42.6(e)(1), the undersigned certifies that on June 7, 2019, a complete and entire copy of this Patent Owner's Notice of Appeal was provided via email, to the Petitioner by serving the email correspondence addresses of record as follows:

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