

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FLEX LOGIX TECHNOLOGIES, INC.
Petitioner

v.

VENKAT KONDA
Patent Owner

Case IPR2020-00262
Patent No. 8,269,523

PETITIONER'S NOTICE IN RESPONSE TO MAY 28, 2020 ORDER

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I. INTRODUCTION

Flex Logix Technologies, Inc. (“Petitioner”) provides this Notice in response to the Board’s Order dated May 28, 2020 (Paper 9) and requests that the Board institute all three petitions.

II. PETITIONER’S RANKING OF PETITIONS

Petitioner concurrently filed three petitions challenging U.S. Patent No. 8,269,523 (“the ’523 patent”): IPR2020-00260 (Paper 1, “Petition 1”), -00261 (Paper 1 in IPR2020-00261, “Petition 2”), and -00262 (Paper 1 in IPR2020-00262, “Petition 3”). While all three petitions are meritorious and justified as explained below, Petitioner requests the Board to consider the petitions in the following order:

Rank	Petition	Challenged Claims	Grounds
1	Petition 1	1, 15-18, 20-22, 32, and 47	<u>Ground 1:</u> Claims 1, 16, 20-22 and 32 are anticipated by PCT Publication No. WO 2008/109756 (“Konda ’756 PCT”) (Ex. 1009) <u>Ground 2:</u> Claims 15 and 17 are obvious over Konda ’756 PCT <u>Ground 3:</u> Claims 18 and 47 are obvious over Konda ’756 PCT in view of Wong (Ex. 1008)
2	Petition 2	2-7 and 11	<u>Ground 1:</u> Claims 2-7 are anticipated by Konda ’756 PCT <u>Ground 2:</u> Claim 11 is obvious over Konda ’756 PCT in view of Wong
3	Petition 3	1, 15-18, 20-22, 32, and 47	<u>Ground 1:</u> Claims 1 and 20-22 are anticipated by Wong <u>Ground 2:</u> Claims 15-18, 32, and 47 are obvious over Wong

III. DIFFERENCES BETWEEN THE PETITIONS, WHY THEY ARE MATERIAL, AND WHY ALL SHOULD BE INSTITUTED

The '523 patent has previously been asserted against Petitioner in *Konda Technologies Inc. v. Flex Logix Technologies, Inc.*, No. 5:18-cv-07581-LHK (N.D. Cal.). (Petition 1 at 2-3.) Patent Owner Venkat Konda ("PO") voluntarily dismissed that litigation without prejudice on April 3, 2019, but the time bar forced Petitioner to file the petitions based on the complaint filed in December 2018 that was served in January of 2019. In the litigation, PO asserted infringement of one or more claims of the '523 patent. Given PO's previous broad assertion of infringement that did not narrow the set of asserted claims in litigation, the current circumstances are consistent with the updated Trial Practice Guide, which states that "the Board recognizes that there may be circumstances in which more than one petition may be necessary, including, for example, when the patent owner has asserted a large number of claims in litigation." Trial Practice Guide Update (July 2019) at 26.

Petitioner was justified in filing three separate petitions in response to PO's initiation of litigation and ongoing conduct before the Office, and Petitioner submits that consideration of all three petitions would not be a significant burden. Petitions 1 and 2 readily demonstrate the lack of priority of the '523 patent to the earlier-filed applications. (Pet. 1 at 4-20; Pet. 2 at 4-21.) In addition, the mapping of the relevant prior art to the challenged claims in each of Petitions 1, 2, and 3 clearly establishes that the unpatentability of the challenged claims. (Pet. 1 at 26-92; Pet. 2 at 27-90;

Pet. 3 at 10-105.) For at least these reasons, Petitioner submits that all three petitions should be instituted.

A. Each Petition Includes Unique Issues That Merit a Trial

Both Petitions 1 and 2 rely on severing the priority chain of the '523 patent, but each of Petitions 1 and 2 challenges a different subset of the claims of the '523 patent. Both Petitions 1 and 2 rely on the same prior art and assert that the challenged claims are anticipated or obvious based on PO's earlier-filed Konda '756 PCT application, alone or in combination with Wong. Given the number of challenged claims their length, Petitioner could not reasonably have challenged all of the claims in Petitions 1 and 2 in the same petition while complying with IPR word limits.

Both Petitions 1 and 2 demonstrate that claim 1 is not entitled to priority to either of the earlier-filed '605 PCT and '394 provisional applications, and therefore, the '523 patent is not entitled to an effective filing date any earlier than November 22, 2009.¹ (Pet. 1 at 4-20; Pet. 2 at 4-21.) Because the '523 patent is not entitled to

¹ PO's Preliminary Response does not attempt to show support for a single stage network having "a plurality of forward connecting links" and "a plurality of backward connecting links" as is encompassed by the full scope of claim 1 of the '523 patent. Instead, PO admits that a single stage network will have no "horizontal

earlier priority, Konda '756 PCT, which was published September 12, 2008 (more than a year before November 22, 2009), is prior art to the '523 patent. (Pet. 1 at 20-21; Pet. 2 at 21-22.) Konda '756 PCT incorporates the '394 provisional application by reference, and therefore the publication of Konda '756 PCT on September 12, 2008 also made public the disclosure of the '394 provisional.² The terminology and figures included in Konda '756 PCT, including those of the '394 provisional application to which the '523 patent purports to claim priority, are substantially similar to the subject matter of the challenged claims, and the Board may expect to expend relatively less resources addressing the grounds raised in Petitions 1 and 2.

Both Petition 1 and Petition 2 include a section demonstrating that the '523 patent is not entitled to priority to the earlier-filed applications, thereby limiting the

shuffle exchange links” and no “vertical shuffle exchange links.” (See '262 Prelim. Resp. (Paper No. 6), 35, 38-39.) PO's admission concedes that the full scope of claim 1 is not disclosed in the '523 patent or the priority applications.

² PO continues to dispute whether publication of Konda '756 PCT makes the provisional applications incorporated by reference in Konda '756 PCT publicly available. ('260 Prelim. Resp. (Paper No. 8 in IPR2020-00260), 40-44; '262 Prelim. Resp., 50.) That issue has already been resolved in co-pending PGR proceeding PGR2019-00042. (See PGR2019-00042 Institution Decision (Paper 14), 26-27 n.5.)

space available for showing disclosure of the claimed features in the prior art. Moreover, while claim 1 is not challenged in Petition 2, Petition 2 still demonstrates how claim 1 is anticipated by Konda '756 PCT in order to show that the challenged dependent claims, which include all of the features of claim 1 from which they depend, are unpatentable.

Petition 3 relies on Wong, whose prior art status does not depend on the challenge to the priority chain raised by Petitions 1 and 2. As demonstrated in Petition 3, while Wong was previously considered by the Office, PO's characterization of Wong's disclosure was incorrect and the Examiner did not have the benefit of the expert testimony provided with Petition 3. (*See, e.g.* Pet. 3, 76-78, 84-86.) Institution of Petition 3 would allow for PO's previous misrepresentations regarding Wong's disclosure to be fully understood by the Office.

**B. The Administrative Procedures Act and Due Process
Weigh Against Discretionary Denial of Petitions 1, 2, and 3**

The three petitions here do not constitute an abuse of the process because no petitioner has previously filed any petition challenging the '523 patent and each of Petitions 1-3 is justified.

IV. CONCLUSION

For the reasons given above, the Board should institute all three petitions.

Respectfully submitted,

Dated: June 4, 2020

By: /Naveen Modi/
Naveen Modi (Reg. No. 46,224)
Counsel for Petitioner

CERTIFICATE OF SERVICE

I hereby certify that on June 4, 2020, I caused a true and correct copy of the foregoing Petitioner's Notice in Response to May 28, 2020 Order to be served via electronic means on the Patent Owner at the following correspondence address of record:

Venkat@kondatech.com

Respectfully submitted,

Dated: June 4, 2020

By: /Naveen Modi/
Naveen Modi (Reg. No. 46,224)
Counsel for Petitioner