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Paper No. 10
Entered: August 19, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FLEX LOGIX TECHNOLOGIES INC.,
Petitioner,

v.

VENKAT KONDA,
Patent Owner.

Cases PGR2019-00037, PGR2019-00040, and PGR2019-00042¹
Patent 10,003,553 B2

Before PATRICK M. BOUCHER, CHARLES J. BOUDREAU, and
NORMAN H. BEAMER, *Administrative Patent Judges*.

BOUCHER, *Administrative Patent Judge*.

ORDER

Conduct Of The Proceeding

37 C.F.R. § 42.5

¹ This Order addresses issues that are common to all cases. We exercise our discretion to issue on Order to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

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On March 18, 2018, Petitioner filed three Petitions, each requesting post-grant review of certain claims of U.S. Patent No. 10,003,553. As stated in the Trial Practice Guide Update (July 2019), 26–27²:

Based on the Board’s prior experience, one petition should be sufficient to challenge the claims of a patent in most situations. Two or more petitions filed against the same patent at or about the same time (e.g., before the first preliminary response by the patent owner) may place a substantial and unnecessary burden on the Board and the patent owner and could raise fairness, timing, and efficiency concerns. . . . In addition, multiple petitions by a petitioner are not necessary in the vast majority of cases. To date, a substantial majority of patents have been challenged with a single petition.

Nonetheless, the Board recognizes that there may be circumstances in which more than one petition may be necessary. . . . In such cases two petitions by a petitioner may be needed, although this should be rare. Further, based on prior experience, the Board finds it unlikely that circumstances will arise where three or more petitions by a petitioner with respect to a particular patent will be appropriate.

Accordingly, to aid the Board in determining whether more than one petition is necessary, Petitioner is ordered to submit a Notice within seven (7) days of this Order, not to exceed 5 pages, identifying (1) a ranking of the three Petitions in the order in which it wishes the panel to consider the merits, if the Board uses its discretion to institute any of the Petitions, and (2) a succinct explanation of the differences between the Petitions, why the differences are material, and why the Board should exercise its discretion to

² Available at <https://www.uspto.gov/sites/default/files/documents/trial-practice-guide-update3.pdf>.

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consider the additional Petitions if it identifies a Petition that satisfies Petitioner's burden under 35 U.S.C. § 324(a). The Board encourages Petitioner to use a table to aid in identifying the similarities and differences between the Petitions.

If he so chooses, Patent Owner may, within seven (7) days of the filing of Petitioner's Notice, provide a Response not to exceed 5 pages, stating his position with respect to any of the differences identified by Petitioner. In particular, Patent Owner should explain whether the differences identified by Petitioner are material and in dispute. If stating that reasons are not material or in dispute, Patent Owner should clearly proffer any necessary stipulations.

Petitioner and Patent Owner are instructed to file the same paper in all three proceedings. The panel will consider the parties' submissions in determining whether to exercise its discretion to institute post-grant review under 35 U.S.C. § 324(a).

It is

ORDERED that within seven (7) days of this Order, Petitioner shall file a Notice consistent with the foregoing instructions; and

FURTHER ORDERED that, within seven (7) days of Petitioner's Notice, if it chooses to, Patent Owner may file a Response consistent with the foregoing instructions.

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PETITIONER

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