

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FLEX LOGIX TECHNOLOGIES, INC.
Petitioner

v.

VENKAT KONDA
Patent Owner

Case PGR2019-00042
Patent No. 10,003,553

PETITIONER'S RESPONSE TO AUGUST 19, 2019 ORDER

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I. INTRODUCTION

Petitioner provides this response to the Board’s Order dated August 19, 2019 (Paper 9) and requests that the Board institute all three petitions.

II. RANKING

Petitioner concurrently filed three petitions, challenging U.S. Patent No. 10,003,553 (“the ’553 patent”): PGR2019-00037 (Paper 1, “Petition 1”), -00040 (Paper 1, “Petition 2”), and -00042 (Paper 1, “Petition 3”). While all three petitions are meritorious and justified as explained below, Petitioner requests that the Board consider the petitions in the following order:

Rank	Petition	Challenged Claims	Grounds
1	Petition 1	1-20	<u>Ground 1:</u> Challenged Claims Are Indefinite under §112 <u>Ground 2:</u> Challenged Claims Do Not Satisfy Written Description Requirement under §112 <u>Ground 3:</u> Challenged Claims Do Not Satisfy Enablement Requirement under §112
2	Petition 2	1-7, 9-15, and 17-19	<u>Ground 1:</u> Challenged Claims Anticipated by Wong
3	Petition 3	1-7, 9-15, and 17-19	<u>Ground 1:</u> Challenged Claims Anticipated by Konda ’756 PCT <u>Ground 2:</u> Challenged Claims Obvious over Konda ’756 PCT and Wong

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

At the time of filing of the petitions, the '553 patent was asserted against Petitioner in *Konda Technologies Inc. v. Flex Logix Technologies, Inc.*, No. 5:18-cv-07581-LHK (N.D. Cal.). Patent Owner ("PO") has since voluntarily dismissed this litigation without prejudice. In the litigation, PO asserted that one or more claims of the '553 patent was infringed. Given PO's 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.

As explained in the petitions and below, the three petitions were filed because the claims are invalid at least under 35 U.S.C. §§ 112, 102, and 103. *See* Petition 1, 1-2; Petition 2, 1-2; Petition 3, 1-2. Petitioner submits that consideration of all three of the petitions would not be a significant burden given the claims apparent non-compliance with § 112 (Petition 1) and the clear mapping of the prior art to the claims (Petitions 2-3). As also discussed below, PO's admissions in the Preliminary Responses simplify the issues that will be contested after institution. For at least these reasons, Petitioner submits that all three petitions should be instituted.

A. Each Petition Includes Unique Issues That Merit a Trial

Petition 1 challenges all twenty claims of the '553 patent under § 112. The claims are rife with indefiniteness issues, lack written description support, and are not enabled. Petition 1, 1-2. Given the number of claims, the length thereof (totaling about 2,086 words), and the number of grounds under § 112 alone, Petitioner could not have raised both the § 112 grounds and prior art grounds in the same petition. Similarly, the length of the claims and requirement to demonstrate PGR eligibility (*See, e.g.*, Petition 1, 15-29; Petition 2, 17-33; Petition 3, 16-31) prevented Petitioner from combining all the prior art grounds in a single petition.¹

Petitioner ranks Petition 1 first because the § 112 grounds set forth therein may be dispositive and address all 20 claims. Indeed, there are other pending related

¹ PO does not contest that the “flip-flop” recited in claim 9 is never mentioned in the pre-AIA applications to which the '553 application claims priority. Instead, PO argues that a flip-flop is “an obvious circuit” that is “an equivalent of an SRAM cell or Flash Cell” and that “Controlling/Configuring Switches or Multiplexers by a Flip-flop [as opposed to the disclosed SRAM and Flash cells] is a well-known substitute to a POSITA.” Paper 5, 2, 16-20. Based on this concession, PGR-eligibility is readily apparent, thereby reducing the overall burden on the Board in addressing all of the petitions.

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applications with claims under examination with similar § 112 issues. Petition 1, 38-39. Resolving the § 112 issues with respect to the '553 patent may avoid the need to revisit them in future proceedings involving the pending applications.

While the § 112 issues of Petition 1 are ranked highest, the prior art grounds set forth in each of Petitions 2 and 3 are equally important for the Board to consider. For example, Wong's disclosure was not characterized correctly in a related patent application where the Examiner did not have the benefit of expert testimony. Petition 2, 6-7. Thus, Petition 2 warrants institution as the Board should consider Wong's disclosure as it relates to the challenged claims in Petition 2 in light of the supporting expert testimony. *Id.* PO has not disputed Petitioner's analysis of Wong in Petition 2, and Petitioner should be availed the opportunity to further highlight any prior misstatements during trial. *See generally* PGR2019-00040, Paper 5.

Petition 3 relies on disclosure of the '724 provisional application (incorporated by reference in Konda '756 PCT) and is premised on the public availability of the '724 provisional application as of the September 12, 2008 publication date of Konda '756 PCT. Petition 3, 33-35. While PO had the opportunity to narrow the issues and stipulate to the September 12, 2008 public availability date, PO did not do so in its POPR (PGR2019-00042, Paper 6). At a minimum, the Board should institute Petition 3 to confirm the public availability of the '724 provisional application. Moreover, given PO is the named inventor of the

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'724 application, the terminology and figures therein are substantially similar to the concepts covered by the challenged claims. Thus, the Board may expect to expend relatively less resources. The '724 provisional application's September 12, 2008 public availability date may also be dispositive with respect to invalidating other patents asserted by PO in litigation, thereby conserving the resources the Board, the courts, and the PTO examining corps in related pending patent applications.

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

Given that Petitioner did not have notice before filing that ranking its petitions would be required, both the Administrative Procedures Act and due process weigh against denying institution of any one of these petitions under 35 U.S.C. §§ 314(a) or 325(d). Indeed, the three petitions here do not constitute an abuse of the process because no petitioner has previously filed any petition challenging the '553 patent and each of Petitions 1-3 is justified. Moreover, had Petitioner been given notice, Petitioner would have had an opportunity to structure its petitions differently.

IV. CONCLUSION

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

Respectfully submitted,

Dated: August 26, 2019

By: Naveen Modi/
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CERTIFICATE OF SERVICE

I hereby certify that on August 26, 2019, I caused a true and correct copy of the foregoing Petitioner's Response to August 19, 2019 Order to be served via electronic means on the Patent Owner at the following correspondence address of record:

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Respectfully submitted,

Dated: August 26, 2019

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