

PGR2019-00042
Patent 10,003,553

Paper No. 12

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 10,003,553 B2

**PATENT OWNER'S RESPONSE TO PETITIONER'S NOTICE TO
AUGUST 19, 2019 BOARD ORDER ON THE CONDUCT OF
PROCEEDING UNDER 37 C.F.R. § 42.5**

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I. INTRODUCTION

On the August 19, 2019 Board Order, Patent Owner submits this same response in all the three proceedings of Post Grant Review of U.S. Patent No. 10,003,553 (“the ‘553 patent”): PGR2019-00037 (Paper 1, “Petition 1”), PGR2019-00040 (Paper 1, “Petition 2”), and PGR2019-00042 (Paper 1, “Petition 3”).

II. THREE PGR PETITIONS ON THE ‘553 PATENT ARE NOT NECESSARY

Patent Owner is confused. As clearly shown in Patent Owner’s Preliminary Responses, the ‘553 patent is PGR-ineligible in view of prior decisions of the Board. Nevertheless, Patent Owner responds as follows.

1. In order to avoid duplication of effort by the Board, Patent Owner hereby states that his response to the Board’s August 19, 2019 Order in each of Cases PGR2019-00037, PGR2019-00040, and PGR2019-00042 is identical. Hence, the Board needs to review only one of Patent Owner’s responses filed in the Petitions to glean the Patent Owner’s response to the Board’s August 19, 2019 Order.

2. It appears clear that Petitioner to the Board’s August 19, 2019 Order used its responses to delve into the merits of each of the petitions. Patent Owner understands that such a maneuver was inappropriate, since Petitioner was not permitted to respond to Patent Owner’s Preliminary Responses to Petitioner’s Petitions on the issue of purportedly PGR-eligibility. Patent Owner strongly objects to Petitioner’s arguments purporting to support the merits of its Petitions in

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its responses to the Board's August 19, 2019 Order arguing, for example, on page 1 that Petitioner "...requests that the Board institute all three petitions" and "...all three petitions are meritorious and justified as explained below...."

3. Patent Owner maintains his position that Petitioner's Petitions should be dismissed because the '553 patent which claims priority to pre-AIA applications is clearly PGR-ineligible as fully set forth in Patent Owner's Preliminary Responses filed on June 26, 2019 in response to Petitioner's Petitions.

4. Nothing in this response by Patent Owner should be considered as an admission or a waiver of any of the substantive responses in Patent Owner's Preliminary Responses to Petitioner's Petitions showing PGR-ineligibility.

5. Without prejudice to his arguments that the '553 patent is PGR-ineligible, in response to Petitioner's arguments, Patent Owner concurs with Petitioner's "ranking," for the reason that if a PGR proceeds, which should not happen due to PGR-ineligibility, it is logical that a review of the claims of the '553 patent under 35 U.S.C. § 112 ("§ 112 ") should proceed before any assessment of the validity of the claims were to be undertaken under 35 U.S.C. § 102 ("§ 102 ") or 35 U.S.C. § 103 ("§ 103 ").

For this reason only one Petition is needed, as the claim analysis would inform the novelty and non-obviousness of the claims of the '553 patent. However, at most two Petitions would be needed, one to consider the issues under § 112 and the

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other to consider §§ 102 and 103 issues. But since an understanding of the claims after a § 112 analysis, including any amendment that would be made by Patent Owner, would be important to analyzing §§ 102 and 103 issues, there should be only one Petition, or at most two Petitions, but certainly not three Petitions. That would be extremely inefficient and costly and should be avoided for the reasons at the core of the Board’s August 19, 2019 Order.

6. Patent Owner objects to Petitioner’s contention regarding the Petitions that “...the patent owner has asserted a large number of claims in litigation.”¹ *See*, page 2 of Petitioner’s Notices to the Board’s August 19, 2019 Order. Here, there is one patent, the ‘553 patent, only three independent claims, and a total of only 20 claims, which required only the basic USPTO application fee when the application for the ‘553 patent was filed. The table on page 1 of Petitioner’s Notices to the Board’s August 19, 2019 Order shows that there are only 20 claims challenged under § 112 and only 17 claims challenged under §§ 102 and/or 103. In fact, Petitioner admits that there are only 20 claims at issue. *See*, page 3, line 2 of Petitioner’s Notices to the Board’s August 19, 2019 Order (“Petitioner challenges all twenty claims of the ‘553 patent under § 112.”).

¹ The Petitions were filed while *Konda Technologies Inc. v. Flex Logix Technologies, Inc.*, No. 5:18- cv-07581-LHK (N.D. Cal.) was pending.

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7. Petitioner's outlandish contention on page 2 of Petitioner's Notices to the Board's August 19, 2019 Order, that "...PO's admissions in the Preliminary Responses simplify the issues that will be contested after institution" is pure fantasy. Patent Owner made no "admissions" in his Preliminary Responses.

8. Petitioner's Notices to the Board's August 19, 2019 Order are wholly inappropriate in making the statement on page 4 that "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." Petitioner appears to assume that Petitioner has demonstrated PGR-eligibility, which is certainly *not* the case, and cannot be the case in view of previous decisions by the board on PGR eligibility as clearly shown in Patent Owner's Preliminary Responses. Any comments by Petitioner regarding the merits are strenuously objected to by Patent Owner². Similarly, the statement on page 4 of Petitioner's Notices to the Board's August 19, 2019 Order, that "While PO had the opportunity to narrow the issues and stipulate to the September 12, 2008 public availability

² In the March 26, 2019 Notice of Filing, on page 1 it was clearly instructed that "The preliminary response is limited to setting forth the reasons why the requested review should not be instituted." Accordingly Patent Owner limited PO's Preliminary Responses only to the PGR-ineligibility of the '553 patent.

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date, PO did not do so in its POPR....,” not only addresses the merits but in so doing concocts an issue that has never previously existed, and which Patent Owner disputes and would not stipulate to.

9. Petitioner’s argument that applying the guidelines of the updated Trial Practice Guide would violate the Administrative Procedures Act and deny Petitioner due process is not well-taken. The updated Trial Practice Guide simply adopts a common sense approach that should have been taken by Petitioner in the first place. After all, Petitioner admits it could have undertaken to “structure its petitions differently,” under such a common-sense approach. *See*, page 5 of Petitioner’s Notices to the Board’s August 19, 2019 Order.

III. CONCLUSION

In conclusion, all of the supposed reasons argued by Petitioner are unpersuasive to explain why more than one Petition is required. Having more than one Petition would proliferate the number of records in the Office and complicate the filings by the parties and the Office and cut against the grain of the common sense policies embodied in the updated Trial Practice Guide

Date: September 3, 2019

Respectfully submitted,

/Venkat Konda/

Venkat Konda
Pro Se Counsel
6278 Grand Oak Way
San Jose, CA 95135

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e)(4) and consent of the Petitioner, I certify that on September 2, 2019, a true and correct copy of Patent Owner's Response to Petition's Notice to the August 19, 2019 Board Order was served on counsel of record for Petitioner by email to PH-FlexLogix-Konda-PGR@paulhastings.com

/Venkat Konda/

Venkat Konda

Pro Se Counsel