

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FLEX LOGIX TECHNOLOGIES, INC.,
Petitioner,

v.

VENKAT KONDA,
Patent Owner.

IPR2020-00260
IPR2020-00261
IPR2020-00262¹
Patent 8,269,523 B2

Before SALLY C. MEDLEY, THOMAS L. GIANNETTI, and
JO-ANNE M. KOKOSKI, *Administrative Patent Judges*.

KOKOSKI, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

¹ The parties are not authorized to use this style heading for any subsequent papers.

A telephone conference was held on May 22, 2020 between counsel for Petitioner Flex Logix Technologies Inc., *pro se* Patent Owner Venkat Konda, and Judges Medley, Giannetti, and Kokoski. A court reporter was on the line, and a copy of the transcript was filed as Exhibit 1049 in each of the above-identified proceedings.² The matters addressed during the call included (1) Petitioner's request for authorization to file a reply to Patent Owner's Preliminary Response; (2) Patent Owner's objections to evidence filed with the Petitions; and (3) Petitioner's filing of multiple Petitions challenging the same patent.

Petitioner's Request for Authorization to File a Reply

Petitioner seeks a reply to address Patent Owner's arguments regarding a pending reissue application that seeks reissue of U.S. Patent No. 8,269,523 B2 ("the '523 patent"), which is the patent challenged in these proceedings. Patent Owner opposes Petitioner's request.

After considering the parties' arguments (reflected in the reporter's transcript), we determined that Petitioner did show good cause for a reply to address Patent Owner's position that a denial of each Petition is warranted in light of the pending reissue application. Accordingly, we authorized Petitioner to file a reply, not to exceed three pages, by June 1, 2020. We also authorized Patent Owner to file a sur-reply, not to exceed three pages, by June 8, 2020. Patent Owner's sur-reply is limited to responding to arguments made in Petitioner's reply.

² This Order summarizes the statements made during the conference call. A more detailed record may be found in the transcript.

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During the call, Patent Owner confirmed that he had not notified the Central Reexamination Unit that the patent at issue in the pending reissue application is the subject of these Petitions. *See* 37 C.F.R. § 1.178(b) (“In any reissue application before the Office, the applicant must call to the attention of the Office any prior or concurrent proceedings in which the patent (for which reissue is requested) is or was involved, such as interferences or trials before the Patent Trial and Appeal Board, reissues, reexaminations, or litigations and the results of such proceedings.”). We informed Patent Owner that the Board will notify the Central Reexamination Unit of these proceedings.

Patent Owner’s Evidentiary Objections

On May 20, 2020, Patent Owner filed a paper entitled Patent Owner’s Objections to Evidence in each proceeding, in which Patent Owner objects to, and asks the Board to exclude, certain exhibits filed with the Petitions. We explained to Patent Owner that such evidentiary objections and requests to exclude evidence are not authorized at this point of the proceedings, and will be expunged from the record of each proceeding. We further explained that, pursuant to our rules, objections to evidence submitted during a preliminary proceeding (prior to institution of trial) must be served within ten business days of the institution of trial. 37 C.F.R. § 42.64(b)(1). We advised Patent Owner that the timeline for filing a motion to exclude evidence, which is necessary to preserve the objection (*see id.* § 42.64(c)), will be provided in the scheduling order that would accompany a decision to institute a trial in any of the proceedings. We also directed Patent Owner to

our Consolidated Trial Practice Guide³ for guidance on how to challenge the admissibility of evidence during trial.

Multiple Petitions

On December 16, 2019, Petitioner filed the three Petitions in the instant proceedings, each challenging claims of U.S. Patent No. 8,569,523 B2 (“the ’523 patent”). As the Consolidated Trial Practice Guide notes, Board experience demonstrates that one petition should be sufficient to challenge the claims of a patent in most situations, and that filing two or more petitions against the same patent at the same time “may place a substantial and unnecessary burden on the Board and the patent owner and could raise fairness, timing, and efficiency concerns.” Consolidated Trial Practice Guide, 59. The Board recognizes, however, that there may be some situations where more than one petition may be necessary, and, therefore, the Consolidated Trial Practice Guide instructs:

To aid the Board in determining whether more than one petition is necessary, if a petitioner files two or more petitions challenging the same patent, then the petitioner should, in its petitions or in a separate paper filed with the petitions, identify: (1) a ranking of the petitions in the order in which it wishes the Board 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 issues addressed by the differences are material, and why the Board should exercise its discretion to institute additional petitions if it

³ Available at:
<https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf>

identifies one petition that satisfies petitioner's burden under 35 U.S.C. § 314.

Id. at 59–60.

During the call, Petitioner confirmed that it did not provide this information in either the Petitions or in a separate paper filed with the Petitions. Accordingly, Petitioner is ordered to submit a Notice within seven days of this Order, not to exceed five pages, identifying its ranking of the three Petitions in the order in which it wishes the panel to consider the merits, providing an explanation of the differences between the Petitions, why those differences are material, and explaining why the Board should exercise its discretion to consider the additional Petitions, as described in the Consolidated Trial Practice Guide. The Board encourages the 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 days of the filing of Petitioner's Notice, provide a Response not to exceed five 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 the reasons are not material or in dispute, Patent Owner should clearly provide any necessary stipulations.

Petitioner and Patent Owner are instructed to file the same paper in all three proceedings.

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Improper Email Communications

On the day of the conference call, Patent Owner sent two emails to the Board containing communications between the parties that occurred prior to the conference call. The emails include substantive, off-the-record exchanges between the parties regarding their positions with respect to Petitioner's request to file a reply to the Preliminary Response, and Patent Owner's evidentiary objections. Patent Owner's purpose in sending these emails to the Board is unclear.

Patent Owner's emails are improper communications with the Board. The Trials@uspto.gov mailbox should not be used for substantive communications with the Board. *See* PTAB End to End Technical Issue 2 (describing the content of emails to Trials@uspto.gov), *available at* <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/trials/patent-trial-and-appeal-board-end>. Such emails are not entered into the record, and we do not consider the substantive arguments made therein. We direct Patent Owner's attention to the Consolidated Trial Practice Guide for additional guidance regarding email communications with the Board, and note that emails to the Board generally should be confined to arranging conference calls and for other ministerial, non-substantive matters. Consolidated Trial Practice Guide, 9–10.

We further remind Patent Owner that each party “must act with courtesy and decorum in all proceedings before the Board, including in interactions with other parties.” 37 C.F.R. § 42.1(c). Patent Owner does not exhibit proper decorum in his email communications with Petitioner

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submitted to the Board. We encourage Patent Owner to review the Board's rules and Consolidated Practice Guide, and request Patent Owner refrain from such behavior in the future.

It is therefore

ORDERED that Petitioner is authorized to file a reply to Patent Owner's Preliminary Response in each of the above-referenced proceedings, not to exceed three pages, by June 1, 2020;

FURTHER ORDERED that Patent Owner is authorized to file a sur-reply to Petitioner's Reply in each of the above-referenced proceedings, not to exceed three pages and limited to responding to Petitioner's reply, by June 8, 2020;

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

FURTHER ORDERED that, within seven days of Petitioner's Notice, if he so chooses, Patent Owner may file a Response consistent with the foregoing instructions; and

FURTHER ORDERED that Paper 9 in IPR2020-00260, Paper 10 in IPR2020-00261, and Paper 7 in IPR2020-00262 be expunged from the record of each proceedings.

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