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Paper No. 112
Date: February 9, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

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PATENT QUALITY ASSURANCE, LLC,
INTEL CORPORATION,
Petitioners,

v.

VLSI TECHNOLOGY LLC,
Patent Owner.

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IPR2021-01229[1]
Patent 7,523,373 B2

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Before KATHERINE K. VIDAL, *Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office*.

ORDER
*37 C.F.R. § 42.5*

[1] Intel Corporation ("Intel"), which filed a petition in IPR2022-00479, was joined as a party to this proceeding. Paper 30.

On February 3, 2023, Supervisory Paralegal Megan Carlson provided a copy of an ex parte communication to the parties and placed it on the record under seal as Exhibits 3029 and 3030 ("the submission"), and designated as available to "Parties and Board" only. Paper 111. Ms. Carlson indicated that neither the Director nor the Board would consider the submission. *Id.* (citing 37 C.F.R. § 42.5(d)).

On February 6, 2023, counsel for Petitioner Patent Quality Assurance, LLC ("PQA") requested, via email (Ex. 3031), that the Director and/or the Board expunge Exhibits 3029 and 3030 from the record. PQA argues that the submission was not authorized by 37 C.F.R. Part 42 or a Board order; that the submission contains false, unsupported, and libelous allegations; and that putting the submission on the record would encourage future parties to file similar improper submissions. *See id.* (citing 37 C.F.R. § 42.7). The email represented that Intel agreed with PQA and that Intel further argued that it was unclear whether the submission was made by someone who stands to gain from disrupting the proceeding. *Id.* The email also represented that VLSI opposed the request. *Id.*

On February 7, 2023, counsel for Patent Owner VLSI Technology LLC ("VLSI") further responded, via email (Ex. 3032), that Ex. 3030 should not be expunged. VLSI argues that Ex. 3030 is not an ex parte communication under 37 C.F.R. § 42.5(d) because it was not a communication with a Board member but rather was a communication to the Chair and Ranking Member of the House Oversight Committee, which appears to have been forwarded by Senate Judiciary committee staffers to the Patent Ombuds Office at the USPTO, and then, by VLSI's unsupported assumption, "presumably to the Director." *See id.* VLSI argues that Ex.

3030 is already of record; that it raises new, material information directly relevant to the proceeding; and that VLSI plans to request additional discovery in light of the information. *Id.*

In addition, VLSI requests that the submission (Exs. 3029 and 3030) be made part of the public record because the submission was not marked as confidential, and was possessed by multiple members of the House Oversight Committee, multiple additional staffers on the Senate Judiciary Committee, and the Patents Ombuds Office of the USPTO, all without any apparent confidentiality restrictions. *Id.* VLSI also argues that there is a public interest in the proceeding. *See id.*

As stated above, Ms. Carlson issued a paper indicating that an unsolicited anonymous ex parte communication was received by the Patents Ombuds Office, and a copy of the communication was placed on the record under seal, limiting access to the Parties and Board only. These steps were taken to balance the Office's interest in transparency with its interest in not further disseminating such communications. As such, I deny both Petitioner's request to expunge the submission from the record, as well as Patent Owner's request to make Exhibits 3029 and 3030 publicly available.

For the foregoing reasons, it is hereby:

ORDERED that PQA's request to expunge Exs. 3029 and 3030 is *denied*; and

FURTHER ORDERED that VLSI's request to designate Exs. 3029 and 3030 as public instead of Parties and Board only is *denied*.

PETITIONER:

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