Paper No. ____
Filed: March 5, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FLEX LOGIX TECHNOLOGIES, INC.
Petitioner

v.

VENKAT KONDA
Patent Owner

Case: IPR2020-00260
U.S. Patent No. 8,269,523

PETITIONER'S OPPOSITION TO
PATENT OWNER'S MOTION TO WITHDRAW MOTION TO AMEND

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I. INTRODUCTION

Flex Logix Technologies, Inc. ("Petitioner") submits this opposition to Patent Owner's ("PO's") Motion to Withdraw his Motion to Amend ("MTA"). PO should not be allowed to escape an adverse ruling on his MTA and resulting estoppel. PO's Motion to Withdraw is yet another example of PO's abuse of process and improper use of judicial resources that has resulted in undue prejudice and unnecessary costs to Petitioner. Ruling on PO's MTA will ensure efficient use of judicial and Petitioner's resources, both with respect to PO's reissue application for U.S. Patent No. 8,269,523 ("the '523 patent") as well as other related applications and patents.

II. BACKGROUND

The '523 patent issued on September 18, 2012. (*See* Ex. 1001 at 1.) On November 27, 2018, after PO became aware that he had failed to timely pay a fee that led to the '523 patent, PO filed a reissue application declaring that the '523 patent is "wholly or partially inoperative or invalid" because of his late payment. (Ex. 2005 at 586, 589-590.) Despite knowing the patent was defective, on December 17, 2018, PO sued Petitioner alleging infringement of the '523 patent and four other patents ("the Asserted Patents"). (Ex. 1050 at 1-2, 7-26.) The complaint represented that "[t]he '523 patent is valid and enforceable" (*id*. at 8) and "was duly and lawfully issued" (*id*. at 7). PO did not inform the district court or Petitioner of the reissue application and his representation to the PTO that the '523 patent was defective.

What's more, while PO was seeking to amend the claims of the '523 patent in the reissue application in response to issues raised in litigation and co-pending PGRs involving U.S. Patent 10,003,553 ("the '553 patent"), as of the May 22, 2020, teleconference with the Board, PO had not informed the reissue examiner of the '523 IPR and '553 PGRs or the litigation. *See* PGR2019-00037, -00042 ("the '553 PGRs"); Ex. 1050; Ex. 2005. The Board recognized as much in its May 28, 2020, order, noted that it would notify the examiner of this proceeding (*see* Paper 11 at 3[1]), and subsequently, *sua sponte*, stayed the reissue application (*see* Paper 24).

Similar to PO's conduct above and as far as Petitioner can tell, PO has not informed the examiners of applications related to the '523 patent, including continuations of the Asserted Patents, of this IPR or the '553 PGRs even though those applications include similar claim language and are likely to be impacted by determinations in this IPR and the '553 PGRs. (*See, e.g.*, U.S. Patent Application Nos. 15/859,726, 15/884,911, 15/984,408, 16/029,645, 16/562,450, 16/671,177, 16/671,191, 16/671,193, and 17/167,093.) Some of these applications have issued, while others are not accessible to the public or Petitioner.

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[1] The Board also noted PO's other improper behavior (*see* Paper 11 at 6-7), which has continued. (*See* Ex. 1057 (email correspondence) (highlighting added).)

III. PO's Motion to Withdraw Should Be Denied

PO's Motion to Withdraw does not provide any meaningful reason for withdrawal and instead argues the merits of the MTA.[2] PO's argument regarding the MTA being "contingent" such that PO is free to withdraw it at any time is wrong, as "contingent" relates to patentability of the as-issued claims. Even if PO can withdraw his MTA, he should not be allowed to do so for at least three reasons.

First, a decision on the MTA, including resolution as to issues raised by the MTA (e.g., whether the prior art discloses certain claim features), ensures that those issues will not have to be revisited during prosecution of the reissue or in any subsequent proceedings involving any resulting patent. The Board and Petitioner have already invested significant resources in addressing the issues raised by the MTA, and resolving those issues here would be more efficient.

Second, a decision on the MTA conserves judicial resources with respect to the related patents and pending applications. There is a great deal of overlap between the '523 patent claim language and that used in PO's other patents and applications, and therefore determinations made here are likely to have ramifications with respect

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[2] PO's Motion fails to mention adverse facts, including that the reissue examiner rejected amended claims in the reissue based on *Wong*. (Ex. 1058, 20-31.)

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