

**From:** Venkat Konda <[venkat@kondatech.com](mailto:venkat@kondatech.com)>

**Sent:** Monday, March 8, 2021 2:16 PM

**To:** Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>

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Venkat Konda <[venkat@kondatech.com](mailto:venkat@kondatech.com)>

**Subject:** IPR2020-00260 & -00261 - Petitioner willful violation of USPTO's

Following up on the Board's authorization, Patent Owner filed PO's Motion to Withdraw PO's Contingent Motion to Amend on February 26, 2021. In the Petitioner's Opposition to Patent Owner's Motion to Withdraw PO's Contingent Motion to Amend filed on March 5, 2021 "March 5, 2021 Petitioner's Opposition to PO's Motion to Withdraw", the Exhibit 1058 and the corresponding arguments by Petitioner are improper. Patent Owner respectfully requests that the Board expunge Exhibit 1058 and all references to Exhibit 1058 in the March 5, 2021 Petitioner's Opposition to PO's Motion to Withdraw:

1. Exhibit 1058 - Office Action, U.S. Reissue Application No. 16/202,067 (Aug. 17, 2020).
  1. The Board instituted IPR2020-00260 & -261 on August 3, 2020. (See, Paper 22.) On August 7, 2020, the Board issued a Stay of Reissue Application No. 16/202,067 ("067 Reissue Application"). (See, Paper 24.) On the same day, the USPTO Examiner issued a "letter of suspension - Examiner initiated" stating that the Office stayed the '067 Reissue Application pending IPR trials. However notwithstanding the stay was in place, on August 17, 2020, the USPTO Examiner issued the Non-final Office Action in the '067 Reissue Application. On the same day, i.e., August 17, 2020, Patent Owner called the USPTO Examiner and informed her that the Non-final Office Action was issued in spite of the stay of the '067 Reissue Application, and inquired if Patent Owner had to respond to the Non-final Office Action within 3 months. The USPTO Examiner said the Office erroneously issued the Non-final Office Action and said she would call back after speaking to her Supervisory Examiner. On the same day, she called back the Patent Owner and said the Office was immediately withdrawing the Non-final Office Action. Accordingly, on the same day, i.e., August 17, 2020 the USPTO *sua sponte* vacated and expunged the Non-final Office Action stating: "A review of the record indicates that the non-final Office Action was mailed in error. Accordingly, non-final action that was mailed and entered into the file on August 17, 2020 is hereby vacated and expunged from the record by being designated "closed" and "not public" in the Information File Wrapper ("IFW"). The August 17, 2020 non-final Office action will form no part of the record and will not be available to the public. This decision will be made of record in the reexamination file." (See, the attached "Letter Withdrawing/Vacating Office Action & Miscellaneous Internal Document" as filed by USPTO Examiner in the '067 Reissue Application Docket on August 17, 2020).

1. Therefore, Petitioner improperly submitted the vacated and expunged Non-final Office Action regarding the '067 Reissue Application is a willful violation of USPTO's Rules.
2. Also, the filing of the Non-final Office Action as Exhibit 1058 in the March 5, 2021 Petitioner's Opposition to PO's Motion to Withdraw directly contradicts the arguments by Petitioner earlier that the '067 Reissue Application should be stayed to avoid inconsistent results by the Office. Because the '067 Reissue Application was stayed by the Board, Petitioner should not be permitted to refer to the vacated and expunged Non-final Office Action.
3. If the Non-final Office Action had not been vacated/expunged, Patent Owner submits that he would have responded to the Office Action within three months of the due date, i.e., by November 17, 2020 and successfully overcome any and all objections/rejections in that Office Action. Accordingly, the Patent Owner would be prejudiced if Petitioner's use of Exhibit 1058, which was vacated/expunged by the USPTO Examiner from the record of the Office, is allowed to be entered in the record of the present IPRs and given any consideration by the Board..

Accordingly, Patent Owner respectfully requests the Board to expunge Exhibit 1058 and the related arguments filed in the March 5, 2021 Petitioner's Opposition to PO's Motion to Withdraw.

Petitioner objects to the argumentative nature of Patent Owner's email to the Board and does not agree with the allegations in the email. Exhibit 1058, which is referenced in a single sentence in footnote 2 of the Opposition, is directly responsive to Patent Owner's position in the motion to withdraw that the Wong reference is not relevant to claims of the '523 patent. Whether or not the Examiner in the reissue application withdrew the office action (i.e., Ex. 1058) from that proceeding because of the suspension does not change the fact that the Examiner recognized the applicability of Wong to the pending claims.

Patent owner appreciates the Board's prompt attention to this matter. Should the Board desire to have a call to discuss this issue, Patent Owner and Petitioner can be available at the Board's convenience.

Very Respectfully,  
Venkat Konda  
Pro Se Patent Owner  
(408) 472-3273

On Fri, Feb 19, 2021 at 12:56 PM Trials <[Trials@uspto.gov](mailto:Trials@uspto.gov)> wrote:

Counsel,

Patent Owner is authorized to file, in each proceeding, a motion to withdraw the motion to amend. The motions are due no later than February 26, 2021, and must not exceed 5 pages. Petitioner is authorized to file an opposition to each motion. The oppositions are due one week after Patent Owner's motions are filed, and must not exceed five pages.

Regards,

Andrew Kellogg,

Supervisory Paralegal

Patent Trial and Appeal Board

USPTO

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