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

Patent 8,269,523 B2

_____

**PATENT OWNER VENKAT KONDA'S REQUEST FOR REHEARING FINAL WRITTEN DECISION UNDER 37 C.F.R. § 42.71(c)**

# TABLE OF CONTENTS

## I. INTRODUCTION

Pursuant to 37 C.F.R. § 42.71(c), Patent Owner ("Patent Owner" or "PO") hereby respectfully requests that the Board reconsider its Final Written Decision in the *Inter Partes* Review of U.S. Patent No. 8,269,523 ("the '523 patent") entered July 29, 2021, (Paper 55, hereinafter "FWD").

## II. STATEMENT OF RELIEF REQUESTED

Patent Owner requests relief from the FWD for the reason that the Board abused its discretion in rendering its FWD because its decision was solely based on an erroneous application of the law and therefore justifies Patent Owner's request for review for good cause under 37 C.F.R. § 42.71(c). Specifically, the Board misapprehended in the FWD that once PCT Publication No. WO 2018/109756 A1 (the "'756 PCT") was published on September 12, 2008, Provisional Application No. 60/940,394 ("the '394 Provisional Application") that is incorporated by reference therein became available to the public for inspection as of September 12, 2008 pursuant to 37 C.F.R. § 1.14(a)(1)(vi) and 37 C.F.R. § 1.14(c) without a power to inspect, i.e., the permission of Patent Owner. Specifically the Board erred that "This sentence, however, is directed to the file history (i.e., paper file) of the unpublished application. It does not preclude access to the application alone." (*See*, FWD at 22.) To the contrary, the '394 Provisional was confidential and not available to the public as of the publication of the '756 PCT under applicable law.

Therefore, Patent Owner requests that the Board reconsider its FWD in the *inter partes* review as to all three grounds.

The '394 Provisional Application incorporated by reference in the '756 PCT was not open to the public for inspection on September 12, 2008. The '394 Provisional Application was pending at the time. Pursuant to 35 U.S.C. § 122, 37 C.F.R. § 1.14(a)(1)(vi), 37 C.F.R. § 1.14(c), and Manual of Patent Examining Procedure ("MPEP") § 103(VII)(8th ed. 2008) the '394 Provisional Application was confidential and a power to inspect, which had not been granted by Patent Owner, was required to get access or copies to it. Therefore, the '756 PCT does not qualify as prior art to the '523 Patent. Accordingly, the instituted Grounds 1, 2, and 3 in the Petition are improper under the law applicable at the time, and the Board should reconsider its FWD and deny Grounds 1, 2, and 3 in the Petition.

## III. LEGAL STANDARDS

A request for rehearing "must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or reply." 37 C.F.R. § 42.71(d) "When rehearing a decision on petition, the panel will review the decision for an abuse of discretion." 37 C.F.R. § 42.71(c). "An abuse of discretion occurs where the decision (1) is clearly unreasonable, arbitrary, or fanciful; (2) ***is based on an erroneous conclusion of law***; (3) rests on clearly erroneous fact findings; or

(4) involves a record that contains no evidence on which the Board could rationally base its decision." *Stevens v. Tamai*, 366 F.3d 1325, 1329 (Fed. Cir. 2004) (quoting *Eli Lilly & Co. v. Bd. of Regents of the Univ. of Wash.*, 334 F.3d 1264, 1266-67 (Fed. Cir. 2003) (emphasis added). Here, the Board abused its discretion in the FWD in this case is based on an erroneous conclusion of law.

Also, in *Moaec, Inc. v. Musicip Corporation*, 568 F.Supp.2d 978, 982 (W.D. Wis. 2008) the court held: Manual of Patent Examining Procedure, § 201.11(II)(B) (8th ed. 2006). The foreword of the PTO's manual [MPEP] makes it clear that "[t]he Manual does not have the force of law or the force of the rules in Title 37 of the Code of Federal Regulations." However, the frequent use of the Manual by patent lawyers in advising patent applicants and the frequency with which patent examiners cite the Manual when communicating with patent applicants entitles patent applicants "to rely not only on the statutes and Rules of Practice but also on the provisions of the [Manual of Patent Examining Procedure] in the prosecution of [their] patent application." *In re Kaghan*, 387 F.2d 398, 847-48 (C.C.P.A. 1967). In addition, the PTO's interpretation of the statute is entitled to some level of deference. *National Organization of Veterans' Advocates, Inc. v. Secretary of Veterans Affairs*, 260 F.3d 1365, 1378-79 (Fed. Cir. 2001) (in context of Department of Veterans Affairs' regulation, informal regulations not carrying force of law still entitled to some deference). Nevertheless, "`the courts are the final

DOCKET ALARM

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

**LAW FIRMS**

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

**FINANCIAL INSTITUTIONS**

Litigation and bankruptcy checks for companies and debtors.

**E-DISCOVERY AND LEGAL VENDORS**

Sync your system to PACER to automate legal marketing.