

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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FLEX LOGIX TECHNOLOGIES, INC.,  
Petitioner,

v.

VENKAT KONDA,  
Patent Owner.

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IPR2020-00260  
IPR2020-00261  
Patent 8,269,523 B2<sup>1</sup>

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

KOKOSKI, *Administrative Patent Judge*.

ORDER

Stay of Reissue Application No. 16/202,067  
37 C.F.R. § 42.3(a); 37 C.F.R. § 4.122(a)

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<sup>1</sup> This Order addresses issues that are common to both cases. The parties are not authorized to use this style heading for any subsequent papers.

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

We recently instituted *inter partes* review as to claims 1, 15–18, 20–22, 32, and 47 of U.S. Patent No. 8,269,523 B2 (“the ’523 patent,” Ex. 1001) in IPR2020-00260 (Paper 22), and claims 2–7 and 11 in IPR2020-00261 (Paper 22). On November 27, 2018, Patent Owner filed Reissue Application No. 16/202,067 (“the ’067 reissue application,” Ex. 2005) to reissue the ’523 patent. For the reasons discussed below, we determine that it is appropriate to stay the examination of the ’067 reissue application.

#### DISCUSSION

The Director has authority to stay a reissue proceeding pursuant to 35 U.S.C. § 315(d), which provides:

(d) **MULTIPLE PROCEEDINGS.**—Notwithstanding sections 135(a), 251, and 252, and chapter 30, during the pendency of an *inter partes* review, if another proceeding or matter involving the patent is before the Office, the Director may determine the manner in which the *inter partes* review or other proceeding or matter may proceed, including providing for stay, transfer, consolidation, or termination of any such matter or proceeding.

37 C.F.R. § 42.122(a) permits the Board to enter an order to effect a stay as follows:

(a) *Multiple Proceedings.* Where another matter involving the patent is before the Office, the Board may during the pendency of the *inter partes* review enter any appropriate order regarding the additional matter including providing for the stay, transfer, consolidation, or termination of any such matter.

*See also* 37 C.F.R. § 42.3 (providing the Board authority to exercise exclusive jurisdiction within the Office over an involved application and patent during the proceeding).

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

Office guidance outlines a number of factors that the Board may consider in deciding whether to stay a parallel reissue proceeding involving the same patent. *See* Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding, 84 Fed. Reg. 16,654, 16,657 (Apr. 22, 2019) (“Notice Regarding Amendment Options”). These factors include: (1) whether the claims challenged in the AIA proceeding are the same as or depend from claims at issue in the reissue proceeding; (2) whether the same grounds of unpatentability or the same prior art are at issue in both proceedings; (3) whether the concurrent Office proceedings could result in inconsistent results; (4) whether amending the claim scope in one proceeding would affect the claim scope in the other proceeding; (5) the respective timeline, stage, and statutory deadlines of the proceedings; and (6) whether a decision in one proceeding would likely simplify issues in the concurrent Office proceeding, or render it moot. *Id.*

Here, all of the claims challenged in the *inter partes* review proceedings are at issue in the '067 reissue application. Ex. 2005, 8–32.<sup>2</sup> At present, the '067 reissue application has not been examined, and no Office Actions have issued. Because the same claims are at issue in these proceedings and the '067 reissue application, allowing concurrent examination of the '067 reissue application would duplicate the efforts of the Office as to those overlapping claims, and raises the possibility of

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<sup>2</sup> We refer to the page numbers added to Ex. 2005 by Patent Owner in the top-left corner of the page.

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

inconsistent results. Both proceedings are at an early stage, but these *inter partes* review proceedings are subject to a statutory deadline that requires a final decision be issued within one year of institution, absent a rare extension. 35 U.S.C. § 316(a). The examination of the '067 reissue application, on the other hand, is not subject to a specific deadline. 35 U.S.C. § 251. Moreover, any final written decision in these proceedings with respect to the patentability of the challenged claims may simplify the issues in the '067 reissue application.

The facts here present good cause warranting a stay. *See* Notice Regarding Amendment Options, 84 Fed. Reg. at 16,656 (“Good cause for staying a case may exist if, for example, an ongoing AIA proceeding, which is subject to statutory deadlines, is addressing the same or overlapping claims of a patent at issue in a parallel Office proceeding.”). We also note that, although no party has filed a separate motion requesting a stay of the '067 reissue application, in a conference call with the Board held on May 22, 2020, Petitioner advocated for stay of the '067 reissue application, and Patent Owner responded to that argument. *See* Ex. 1049 (conference call transcript). In any event, the Board “may impose a stay *sua sponte*.” Notice Regarding Amendment Options, 84 Fed. Reg. at 16,657.

Based on the facts presented in these proceedings and in the '067 reissue application, the Board finds that there is good cause to exercise its discretion under 35 U.S.C. § 315(d) and 37 C.F.R. § 42.122(a), and therefore orders that the examination of the '067 reissue application be stayed pending the termination or completion of the these proceedings.

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

ORDER

In consideration of the foregoing, it is hereby

ORDERED that examination of Reissue Application No. 16/202,067, filed November 27, 2018, is stayed pending the termination or completion of IPR2020-00260 and IPR2020-00261; and

FURTHER ORDERED that all due dates in Reissue Application No. 16/202,067 are tolled.

For PETITIONER:

Naveen Modi  
Joseph Palys  
Paul Anderson  
Arvind Jairam  
PAUL HASTINGS LLP  
naveenmodi@paulhastings.com  
josephpalys@paulhastings.com  
paulanderson@paulhastings.com  
arvindjairam@paulhastings.com

For PATENT OWNER:

Venkat Konda  
Venkat@kondatech.com