

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'S RESPONSE UNDER 37 C.F.R. § 42.120

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I. INTRODUCTION

Patent Owner Venkat Konda (“Patent Owner” or “PO”) submits this Patent Owner’s Response pursuant to 37 C.F.R. § 42.120 in opposition to the petition for *inter partes* review (“IPR”) IPR2020-00260 filed by Flex Logix Technologies Inc. (“Flex Logix” or “Petitioner”) regarding claims 1, 15-18, 20-22, 32 and 47 (the “Challenged Claims”) of U.S. Patent No. 8,269,523 (Ex. 1001, the “‘523 Patent”) on December 16, 2019 Paper 1 (“Petition”). Patent Owner previously filed a Preliminary Response to the Petition on May 6, 2020 after the due date was extended by the Patent Trial and Appeal Board (“Board”) due to the COVID-19 Pandemic in response to PO’s request. On August 3, 2020, the Board instituted this IPR¹.

In response to the Decision Granting Institution of IPR entered August 3, 2020 (Paper 22) and pursuant to 37 C.F.R. § 42.71(c), on August 10, 2020 Patent Owner submitted a Request for Rehearing and Exhibits 2025-2027 for the Board to reconsider its decision granting institution of the IPR. On September 16, 2020, the

¹ In addition to this IPR, the Board instituted another IPR2020-00261 based on a petition concurrently filed by the same Petitioner on the ‘523 Patent. Patent Owner indicates to the Board that the same Patent Owner’s Response is submitted in both proceedings, i.e. IPR2020-00260 and IPR2020-00261.

Board denied Patent Owner's Request for Rehearing and ordered Patent Owner to either withdraw or request the Board to consider Exhibits 2025-2027 in Patent Owner Responses.

On September 23, 2020, Patent Owner sent an email to the Board stating that Patent Owner intended to file Patent Owner's Response relying on Exhibits 2025-2027, as well as a Contingent Motion to Amend, and requesting the Board for the mandatory conference call. In response, the Board issued an order stating: "Based on the information provided by Patent Owner, we determine that a conference call is not necessary, and the conference requirement is deemed satisfied." (Paper 32) Furthermore in an email response, the Board confirmed that Patent Owner satisfied the Board's order to advise that Patent Owner intended to rely on Exhibits 2025-2027 in connection with Patent Owner's Responses.

This Patent Owner's Response is supported by the Declaration of Professor Vipin Chaudhary, Ph.D., Endowed Kranzusch Professor and Inaugural Chair, Department of Computer and Data Sciences, Case School of Engineering, Case Western Reserve University, Cleveland, Ohio ("Dr. Chaudhary") (Exhibit 2025)

and Curriculum Vitae of Dr. Chaudhary (Exhibit 2026)². Dr. Chaudhary's declaration establishes that the Challenged Claims in the '523 Patent are entitled to the benefit of the May 25, 2007 filing date of the '394 Provisional application. Accordingly, since the '523 Patent is entitled to the priority date of May 25, 2007, the publication of Konda '756 PCT on September 12, 2008, i.e. more than 15 months after May 25, 2007 is irrelevant. For this reason alone, the grounds 1, 2, and 3 in the Petition are not valid.

Furthermore, the '394 Provisional application incorporated by reference in the Konda '756 PCT was not open to the public for inspection on 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 granted by Patent Owner. Therefore, the Konda '756 PCT does not qualify as prior art to the '523 Patent. Also, for this reason alone, the instituted

² Patent Owner submitted Exhibits 2025-2027 in support of PO's Request for Rehearing. In the Board decision of denial of PO's Request for Rehearing, the Board ordered that "Patent Owner shall advise the Board whether it intends to rely on Exhibits 2025–2027 in connection with its Patent Owner Responses." Patent Owner satisfied this requirement that he intends to rely on Exhibits 2025–2027 in connection with its Patent Owner Responses, as approved by the Board's email (Exhibit 2028).

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