

From: [Trials](#)
To: [Modi, Naveen](#); [Venkat Konda](#); [Anderson, Paul M.](#); [FlexLogix-Konda-IPR](#)
Cc: [Trials](#)
Subject: RE: Requesting Board's authorization to withdraw Patent Owner's Contingent Motion to Amend in IPR2020-00260 & -00261
Date: Friday, February 19, 2021 3:56:44 PM

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
andrew.kellogg@uspto.gov
(571)272-7822

From: Modi, Naveen <naveenmodi@paulhastings.com>
Sent: Friday, February 19, 2021 11:14 AM
To: Trials <Trials@USPTO.GOV>; Venkat Konda <venkat@kondatech.com>; Anderson, Paul M. <paulanderson@paulhastings.com>; FlexLogix-Konda-IPR <PH-FlexLogix-Konda-IPR@paulhastings.com>
Subject: RE: Requesting Board's authorization to withdraw Patent Owner's Contingent Motion to Amend in IPR2020-00260 & -00261

Petitioner opposes Patent Owner's request to withdraw the Motions to Amend as such withdrawal would lead to an inefficient use of Petitioner's and the PTO's resources. As the Board is aware, Patent Owner has already filed a reissue application with respect to the '523 patent, and given the stage of the present IPR proceedings and the record established thus far, it would be more efficient for the Board to resolve the issues in these proceedings. As is evident, Patent Owner does not like the preliminary guidance provided by the Board in response to his Motions to Amend and is attempting to avoid an adverse ruling on his Motions.

If the Board decides to allow the withdrawal of the Motions to Amend, Petitioner requests leave to file a motion for fees or any other relief that the Board deems appropriate. See 37 C.F.R. § 42.12 (stating that "The Board may impose a sanction against a party for misconduct, including . . . [e]ngaging in dilatory tactics [and] [a]ny other improper use of the proceeding, including actions that harass or cause unnecessary delay or an unnecessary increase in the cost of the proceeding").

Respectfully,
Naveen Modi

Counsel for Petitioner Flex Logix

Naveen Modi
Partner & Global Vice Chair of IP
Paul Hastings LLP
(202) 551-1990

From: Trials <Trials@USPTO.GOV>
Sent: Thursday, February 18, 2021 3:39 PM
To: Venkat Konda <venkat@kondatech.com>; Modi, Naveen <naveenmodi@paulhastings.com>; Anderson, Paul M. <paulanderson@paulhastings.com>; FlexLogix-Konda-IPR <PH-FlexLogix-Konda-IPR@paulhastings.com>
Cc: Trials <Trials@USPTO.GOV>
Subject: [EXT] RE: Requesting Board's authorization to withdraw Patent Owner's Contingent Motion to Amend in IPR2020-00260 & -00261

Counsel,

The Board requests that Petitioner advise as to whether it opposes Patent Owner's request to withdraw the motions to amend.

Regards,

Andrew Kellogg,
Supervisory Paralegal
Patent Trial and Appeal Board
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From: Venkat Konda <venkat@kondatech.com>
Sent: Thursday, February 18, 2021 3:26 PM
To: Trials <Trials@USPTO.GOV>
Cc: Venkat Konda <venkat@kondatech.com>
Subject: Re: Requesting Board's authorization to withdraw Patent Owner's Contingent Motion to Amend in IPR2020-00260 & -00261

On Mon, Feb 15, 2021 at 11:52 PM Venkat Konda <venkat@kondatech.com> wrote:

As the Board is aware, Patent Owner filed Patent Owner's contingent Motion to Amend under 37 C.F.R. § 42.121 on October 26, 2020. Petitioner submitted its Opposition to PO's contingent Motion to Amend on January 19, 2021. Patent Owner appreciates the Preliminary Guidance provided by the Board regarding the

Patent Owner's contingent Motion to Amend (same guidance for both the proceedings) last week on February 11, 2021.

For the following reasons, Patent Owner respectfully requests the Board's authorization for Patent Owner to withdraw his contingent Motion to Amend. (That is, Patent Owner neither intends to pursue the Motion to Amend nor intends to file a Revised Motion to Amend. The reasons for withdrawal of Patent Owner's contingent Motion to Amend include:

1. The Board's Preliminary Guidance stated that the Patent Owner is not allowed to amend the unchallenged claims 8-10, 12-14, 19, 23-31, 33-46 and 48 in either of the proceedings.
2. The Board denied the concurrently filed petition IRP2020-00262 Under U.S.C. § 325(d), i.e., the challenged claims 1, 20-22 under § 102 as being anticipated by US Patent # 6,940,308 ("Wong") and claims 15-18, 32, 47 under § 103 as obvious over Wong. PO's contingent Motion to Amend narrows claim 1 (i.e., substitute contingent claim 49) where it is amended by replacing $y \geq 1$ with $y > 1$. However, Petitioner in its opposition nevertheless argues that claim 49 is anticipated by Wong. See, pages 20-28 of Petitioner's Opposition to Motion to Amend.

In light of the guidance provided in the Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding (April 2019), since Patent Owner is not allowed to amend dependent claims 8-10, 12-14, 19, 23-31, 33-46 and 48 in these IPR proceedings or add additional claims, Patent Owner intends not to pursue his contingent Motion to Amend.

1. Accordingly, Patent Owner respectfully requests the Board's authorization for Patent Owner to withdraw his contingent Motion to Amend in both the proceedings.

Patent owner requests the Board's prompt attention to this matter. Should the Board desire to have a call to discuss this issue, Patent Owner will provide both Patent Owner and Petitioner's available dates to have the call at the Board's convenience.

Very Respectfully,
Venkat Konda
Pro Se Patent owner

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