

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*.

DECISION

Denying Patent Owner's Requests for Rehearing of  
Final Written Decision Determining All Challenged Claims Unpatentable  
*37 C.F.R. § 42.71(d)*

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<sup>1</sup> This Decision addresses issues that are the same in both proceedings. The parties are not authorized to use this style heading for any subsequent papers.

## I. INTRODUCTION

Venkat Konda (“Patent Owner”) filed a Request for Rehearing of our Final Written Decision<sup>2</sup> finding that claims 1–7, 11, 15–18, 20–22, 32, and 47 (“the challenged claims”) of U.S. Patent No. 8,269,523 B2 (Ex. 1001, “the ’523 patent”) are unpatentable.<sup>3</sup> As explained below, we have considered the arguments presented by Patent Owner in his Request for Rehearing, but we discern no reason to modify the Decision. Accordingly, we deny Patent Owner’s Request for Rehearing.

## II. STANDARD OF REVIEW

The party challenging a decision in a request for rehearing bears the burden of showing that the decision should be modified. 37 C.F.R. § 42.71(d). 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, a reply, or a sur-reply.” *Id.* A request for rehearing, therefore, is not an opportunity to merely disagree with the Board’s assessment of the arguments or weighing of the evidence, or to present new arguments or evidence.

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<sup>2</sup> Petitioner challenged claims 1, 15–18, 20–22, 32, and 47 in IPR2020-00260 (Paper 1, 3–4), and claims 2–7 and 11 in IPR2020-00261 (Paper 1, 4). We exercised our discretion to issue a single Final Written Decision to be entered in both proceedings. IPR2020-00260, Paper 55, 1 n.1; IPR2020-00261, Paper 58, 1 n.1.

<sup>3</sup> See IPR2020-00260, Papers 55 (“Decision” or “Dec.”) and 56 (“Request” or “Req. Reh’g”); IPR2020-00261, Papers 58 and 59. Although the analysis herein applies to both proceedings, we refer to the papers and exhibits filed in IPR2020-00260 for convenience.

### III. ANALYSIS

In the Decision, we determined that Petitioner demonstrated, by a preponderance of the evidence, that: (1) claims 1–7, 16, 20–22, and 32 were anticipated by the '756 PCT;<sup>4</sup> (2) claims 11, 15, and 17 would have been obvious over the '756 PCT; and (3) claims 18 and 47 would have been obvious over the combined teachings of the '756 PCT and Wong.<sup>5</sup> Dec. 33. Petitioner's challenges largely relied on the disclosures of the '394 Provisional,<sup>6</sup> which is incorporated by reference in its entirety into the '756 PCT. *Id.* at 21 (citing Paper 1, 20–21; Ex. 1009, 2:14–17). We explained that the '394 Provisional qualifies as prior art to the '523 patent because

37 C.F.R. § 1.14(a)(1)(vi) provides, in relevant part, that if an unpublished application is incorporated by reference in an international publication of international application (such as the '756 PCT), a copy of “the unpublished pending application may be provided to any person upon written request and payment of the appropriate fee.” Accordingly, once the '756 PCT published, the '394 Provisional that is incorporated by reference therein became open to the public for inspection. *Therefore, the '394 Provisional is prior art by virtue of the fact that it became publicly available due to its incorporation into the '756 PCT, and in addition it is prior art because it is part of the '756 PCT itself.*

*Id.* at 21–22 (emphasis added).

In the Request, Patent Owner argues that we erred in determining that the '394 Provisional was available to the public as of the publication of the '756 PCT, and, therefore, qualifies as prior art against the '523 patent. Req.

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<sup>4</sup> WO 2008/109756, published September 12, 2008 (Ex. 1009).

<sup>5</sup> U.S. Patent No. 6,940,308, issued September 6, 2005 (Ex. 1008).

<sup>6</sup> Provisional App. No. 60/940,394, filed on May 25, 2007 (Ex. 1026).

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Reh’g 1–2. Specifically, Patent Owner argues that the ’394 Provisional, which was pending when the ’756 PCT published on September 12, 2008, was confidential “[p]ursuant 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) (8<sup>th</sup> ed. 2008),” and could only be accessed if Patent Owner granted a power to inspect. *Id.* at 2.

To support his position that the ’394 Provisional was not publicly available, Patent Owner points to MPEP § 103(VII), which, at the time the ’756 PCT was published, stated that access to provisional applications “will only be given to parties with written authority from a named inventor, the assignee of record, or the attorney or agent of record.” Req. Reh’g 13 (quoting MPEP § 103(VII) (8th ed. 2008)) (emphasis omitted). Patent Owner argues that, in contrast, 37 C.F.R. § 1.14(a)(1)(vi) only provides that a copy of a provisional application incorporated by reference or otherwise identified “*may* be provided to any person.” *Id.* (emphasis added).

Therefore, Patent Owner argues,

[t]he ’394 Provisional Application incorporated by reference in the ’756 PCT was **not** open to the public for inspection or to be copied on September 12, 2008 (while the ’394 Provisional 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 MPEP § 103(VII) because a power to inspect had not been granted by Patent Owner.

*Id.* at 15.

We are not persuaded by Patent Owner’s arguments. Patent Owner’s position that the ’394 Provisional was not available to the public is premised on a mistaken understanding of the rules governing access to unpublished

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pending applications that are incorporated by reference into a publication like the '756 PCT.

Section 1.14(a) of 37 C.F.R. provides several exceptions to the general rule that an unpublished patent application will be preserved in confidence pursuant to 35 U.S.C. § 122(a). In particular, Section 1.14(a)(1)(vi) relates to “unpublished pending applications (including provisional applications) that are incorporated by reference or otherwise identified.” 37 C.F.R. § 1.14(a)(1)(vi) (2008). As of the September 12, 2008 publication of the '756 PCT, § 1.14(a)(1)(vi) stated:

*A copy of the application as originally filed* of an unpublished pending application *may be provided* to any person, upon written request and payment of the appropriate fee (§ 1.19(b)), if the application is incorporated by reference or otherwise identified in in a U.S. patent, a statutory invention registration, a U.S. patent application publication, or an international patent application publications that was published in accordance with PCT Article 21(2). The Office will not provide access to the paper file of a pending application, except as provided in paragraph (c) or (i) of this section.

(Emphasis added). MPEP § 103(III), titled “Unpublished Abandoned and Pending Applications (Including Provisional Application) That are Identified,” addresses Section 1.14(a)(1)(vi) and explains that “[t]he incorporation by reference of a pending application in . . . a published international application published in accordance with PCT Article 21(2), . . . constitutes special circumstances under 35 U.S.C. 122 warranting that a copy of *the application-as-filed* be provided upon written request . . . .” MPEP § 103(III) (8th ed. rev. 7 July 2008) (emphasis added).

The '756 PCT is “an international patent application publication that was published in accordance with PCT Article 21(2),” and the '394

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