

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FLEX LOGIX TECHNOLOGIES, INC.,
Petitioner,

v.

VENKAT KONDA,
Patent Owner.

IPR2020-00260
IPR2020-00261
Patent 8,269,523 B2¹

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 Decisions Granting Institution of *Inter Partes* Review
37 C.F.R. § 42.71(d)

¹ 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 Requests for Rehearing, along with Exhibits 2025–2027, of our Decisions instituting *inter partes* review of 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”) in each of the above-identified proceedings.² For the reasons that follow, Patent Owner’s Requests for Rehearing are denied.

II. ANALYSIS

A request for rehearing must identify specifically 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 a reply. 37 C.F.R. § 42.71(d). Patent Owner, as the party challenging the Decisions, has the burden of showing that the Decisions should be modified. *Id.* When rehearing a decision on a petition, the Board reviews the decision for an abuse of discretion. *Id.* § 42.71(c). An abuse of discretion may arise if a decision is based on an erroneous interpretation of the law, if a factual finding is not supported by substantial evidence, or if an unreasonable judgment is made in weighing relevant factors. *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000).

In its Rehearing Request, Patent Owner argues that the Board:
(1) erred in determining that testimony from Petitioner’s declarant, Dr. Baker, should not be disregarded (Req. 6–8); (2) erred in determining

² See IPR2020-00260, Papers 22 (“Decision” or “Dec.”) and 26 (“Request” or “Req.”) and IPR2020-00261, Papers 22 and 28. Although the analysis herein applies to both proceedings, we refer to the papers and exhibits filed in IPR2020-00260 for convenience.

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that the challenged claims are not entitled to claim priority³ to the May 25, 2007 filing date of the '394 provisional, or the May 22, 2008 filing date of the '605 PCT (*id.* at 8–11); and (3) erred in determining that the '394 provisional became publicly available as of the date the '756 PCT⁴ published (*id.* at 11–14).

We have reviewed Patent Owner's Request and carefully considered the arguments presented. For the following reasons, we are not persuaded that we abused our discretion in granting institution of *inter partes* review of the challenged claims of the '523 patent.

A. Exhibits 2025–2027

With the Rehearing Request, Patent Owner submitted Exhibits 2025–2027. Exhibit 2025 is a Declaration of Vipin Chaudhary, Ph.D., and Exhibit 2026 is Dr. Chaudhary's CV. Exhibit 2027 is a PTO form (highlighted by Patent Owner) for requesting access to abandoned applications. As an initial matter, we address whether Patent Owner followed the proper procedure for admitting Exhibits 2025–2027 into the record in these proceedings.

Exhibits 2025–2027 were not of record when the Decisions were entered on August 3, 2020. *Compare* Paper 26 (Patent Owner's exhibit list submitted

³ The '523 patent issued from U.S. Patent Application Serial No. 12/601,275 ("the '275 application"), which was filed on November 22, 2009 as the national phase entry of PCT Application No. PCT/US2008/064605 ("the '605 PCT"), filed on May 22, 2008. Ex. 1001, codes (21), (22); Ex. 1004, 150. The '275 application claims priority to Provisional Application No. 60/940,394 ("the '394 provisional"), which was filed on May 25, 2007. Ex. 1001, code (60).

⁴ Published PCT Application No. WO 2008/109756, published on September 12, 2008.

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on August 11, 2020) *with* Paper 19 (Patent Owner’s exhibit list submitted on June 11, 2020).

Rule 42.71(d) permits “[a] party dissatisfied with a decision . . . [to] file a single request for rehearing without prior authorization from the Board.” 37 C.F.R. § 42.71(d). Although this rule does not explicitly address whether the requesting party may also file new evidence with its rehearing request, the Consolidated Trial Practice Guide⁵ is instructive on the matter. In discussing the procedures applicable to a request for rehearing, the Consolidated Trial Practice Guide highlights the Board’s precedential decision in *Huawei Device Co., Ltd. v. Optis Cellular Tech., LLC*, IPR2018-00816, Paper 19 at 4 (PTAB Jan. 8, 2019), which states:

Ideally, a party seeking to admit new evidence with a rehearing request would request a conference call with the Board prior to filing such a request so that it could argue “good cause” exists for admitting new evidence. Alternatively, a party may argue “good cause” exists in the rehearing itself.

Consolidated Trial Practice Guide, 90. The Consolidated Trial Practice Guide goes on to state that “[a]bsent a showing of ‘good cause’ prior to filing the request for rehearing or in the request for rehearing itself, new evidence will not be admitted.” *Id.* (citing *Huawei*, Paper 19 at 4).

Here, Patent Owner did not request a conference call with the Board prior to submitting Exhibits 2025–2027 with its Request, nor did Patent Owner explain why these exhibits should be admitted in the Request itself. *See generally* Req. 1–12.

⁵ Available at:
<https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf>

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Petitioner filed objections to the new exhibits. Paper 28. We note that, in response to Petitioner’s objections,, Patent Owner filed a paper titled “Patent Owner Venkat Konda’s Supplemental Evidence in Response to Petitioner’s Objections to Patent Owner’s Exhibits Pursuant to 37 C.F.R. § 42.64(b)(2).” Paper 30. Although styled as “supplemental evidence,” this paper contains no evidence, but instead contains arguments that Patent Owner established good cause for the consideration of Exhibits 2025–2027 on rehearing. *See id.* at 1–6. This additional argument is not an appropriate use of supplemental evidence. Moreover, Patent Owner did not request or receive authorization to file additional arguments relating to the admissibility of Exhibits 2025–2027 with the Request for Rehearing, and for this reason we do not consider those arguments now.

Therefore, because Patent Owner failed to provide a showing of good cause prior to filing the Request or in the Request itself, Exhibits 2025–2027 are not entitled to consideration. Notwithstanding Patent Owner’s lack of compliance with our rules in submitting Exhibits 2025–2027, we do not expunge the exhibits. Instead, Patent Owner may either: (1) withdraw Exhibits 2025–2027 from the record, or (2) request that we consider Exhibits 2025–2027 in connection with its Patent Owner Response.

B. Dr. Baker’s Testimony

Patent Owner argues that “Dr. Baker’s declaration in support of the Petition presented a flawed definition of a person of ordinary skill in the art,” and “[i]t is apparent that the Decision did not consider (or did not give appropriate weight to) Venkat Konda’s Declaration and that the Board completely relied on Dr. Baker’s testimony in the Decision.” Req. 6 (citing Paper 8 (“Prelim. Resp.”), 6–15). Patent Owner argues that “the Board

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