UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FLEX LOGIX TECHNOLOGIES INC.,

Petitioner

V.

VENKAT KONDA,

Patent Owner

Case IPR2020-00261

Patent 8,269,523 B2

PATENT OWNER'S CONTINGENT MOTION TO AMEND

UNDER 37 C.F.R. § 42.121

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I. INTRODUCTION AND STATEMENT OF RELIEF REQUESTED

Prior to filing this motion, Patent Owner Venkat Konda ("Patent Owner") complied with 37 C.F.R. § 42.121(a) by sending an email requesting a conference call with the Board. 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 33)

In the Order, the Board directed the parties to the Board's order in *Lectrosonics, Inc. v. Zaxcom, Inc.*, Case IPR2018-01129, Paper 15 (PTAB Feb. 25, 2019) (precedential), *Amazon.com Inc. v. Uniloc Luxembourg S.A.*, IPR2017-00948, Paper 34 (PTAB Jan. 18, 2019) (precedential), and the Office's November 2019 Consolidated Trial Practice Guide, which provide information and guidance on motions to amend, and to the *Notice Regarding a New Pilot Program Concerning Motion to Amend Practice and Procedures in Trial Proceedings under the America Invents Act before the Patent Trial and Appeal Board*, 84 Fed. Reg. 9497 (Mar. 15, 2019). Accordingly, Patent Owner is submitting this paper by following those directions.

Patent Owner respectfully files this Contingent Motion to Amend under 37 C.F.R. § 42.121 and requests that new claims 49-96 be treated as a contingent substitution for claims 1-48. See *Lectrosonics*, Paper 15 at 3. Consequently, this

Contingent Motion to Amend is contingent upon a finding in a final written decision by the Board that the challenged claims 1-48 are unpatentable. Therefore, this Motion to Amend under 37 C.F.R. § 42.121 is made on a contingent basis and is made in addition to Patent Owners' Response under 37 C.F.R. § 42.120, which is filed concurrently.

Patent Owner also respectfully requests preliminary guidance from the Board concerning this Motion, in accordance with the New Pilot Program Concerning Motion to Amend Practice. *See* 84 Fed. Reg. 9,497 (Mar. 15, 2019).

This Contingent Motion to Amend includes proposed substitute claims in place of the previously presented substitute claims and includes amendments and arguments. This Motion satisfies the requirements for a Contingent Motion to Amend. Claims 2-7, and 11 (the "Challenged Claims") are the challenged claims of U.S. Patent No. 8,269,523 (Ex. 1001, "the '523 Patent") in the Petition[1] filed by

[1] In addition to this IPR, the Board instituted another IPR2020-00260 filed by the same Petitioner concurrently on the '523 Patent. Patent Owner indicates to the Board that he intends to move for the same contingent amendments to the claims in both proceedings. Accordingly, the same contingent claims are submitted in both the proceedings, i.e. IPR2020-00260 and IPR2020-00261.

Flex Logix Technologies Inc. ("Flex Logix" or "Petitioner") on December 16, 2019 Paper 1 ("Petition"). Claim 1 is the only independent claim in the '523 Patent and Claims 2–48 are either directly or indirectly dependent on Claim 1.

Patent Owner proposes forty eight substitute claims (numbered 49-96), which are set forth below in the Appendix. Substitute claims 49-96 correspond, respectively, to original claims 1-48 of the '523 Patent. Substitute claim 49 is the only independent claim (like original claim 1 of the patent). Remaining substitute claims 50-96 depend, directly or indirectly, from substitute independent claim 49 in the same respective manner that original claims 2-48 depend from claim 1 of the '523 Patent.

As a result of this Contingent Motion set forth below, acceptance of all forty-eight proposed substitute claims would result in the cancellation of the forty-eight original claims (claims 1-48). This constitutes a "reasonable number of substitute claims." 35 U.S.C. § 326(d)(1)(B). Additionally, the substitute claims: (1) do not "enlarge the scope of the claims;" (2) do not "introduce new [subject] matter;" and (3) "respond to [the] ground[s] of unpatentability involved in the trial." 35 U.S.C. § 326(d)(3); 37 C.F.R. § 42.121(a)(2)(i), (ii). Patent Owner has therefore satisfied his burden of production.

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