

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FLEX LOGIX TECHNOLOGIES INC.,

Petitioner

V.

VENKAT KONDA,

Patent Owner

Case IPR2020-00262

Patent 8,269,523 B2

**PATENT OWNER'S SUR-REPLY TO PETITIONER'S REPLY TO
PATENT OWNER'S PRELIMINARY RESPONSE**

Pursuant to the Board's Order dated May 28, 2020, Patent Owner submits this Sur-reply to Petitioner's Reply to Patent Owner's Preliminary Response. The Board should not institute *inter partes* review ("IPR") IPR2020-00262 of U.S. Patent 8,269,523 ("the '523 Patent), since Petitioner Flex Logix Technologies Inc. ("Petitioner") filed its IPR Petition on December 16, 2019, Paper 1 ("Petition"), more than one year after Patent Owner's reissue application 12/202,067 ("the '067 application" or "the reissue application") for the '523 patent was filed on November 27, 2018. The sole inventor of the '553 Patent, Venkat Konda Ph.D., also submits his attached declaration in support of this Sur-reply (*See*, Ex. 2007). Patent Owner filed (*See*, Ex. 2012) after he learned during Conference call.

In October 2018, Petitioner first brought to Patent Owner's attention and argued, during settlement discussions, that the national stage entry basic national stage fee for the '523 Patent was paid one month late. Subsequently Patent Owner, based on the suggestions by Office of PCT Legal, specifically, Attorney Advisor Erin Thomson and her supervisor and Deputy Director, International Patent Legal Administration, USPTO, Richard Cole ("PCT Legal") and pursuant to 37 C.F.R § 1.495(g) (pre AIA) pointed out by PCT Legal, filed the reissue application to rectify the issue. (*See*, Ex. 2005 at 586, 600). Furthermore PCT Legal confirmed to the Patent Owner that the '523 Patent is still valid and enforceable in District Court until a reissue were to issue and the '523 Patent were to be surrendered.

Petitioner filed a motion to dismiss Patent Owner's District Court complaint on January 24, 2019 (*See*, Ex. 2008) and a second motion to dismiss Patent Owner's first amended complaint March 18, 2019 (*See*, Ex. 2009). Patent Owner dismissed his District Court action without prejudice on April 3, 2019. Because Patent Owner was informed that the '523 Patent continued in force, he believed that he did not need to inform Petitioner about the reissue application during the District Court proceedings, as the action never went beyond Petitioner's motions to dismiss, and certainly not to discovery stage.

In August 2019, PCT Legal advised Patent Owner that the reissue application was not appropriate, but that a petition for unintentional delay was sufficient to obviate the issue regarding payment of the basic national fee for the '523 Patent (*See*, Ex. 2010). Accordingly, Patent Owner filed a petition on August 8, 2019 to remedy the issue. Petitioner has knowledge of these facts which are in the file history of the '553 Patent (*See*, Ex. 1004 at 1-6). Yet, Petitioner continues its harassment of the Patent Owner, notwithstanding that the Office laid the issue to rest (*See*, Petition, Footnote 1 at 3) and Petitioner's Reply (Paper 10 at 1-2).

Then, Patent Owner has continued the prosecution of the reissue application by narrowing the claims of the '523 Patent. Patent Owner has narrowed the only independent claim by merging claims 1 and 3. All of the remaining dependent claims have either been deleted or merged with one another. Two new independent

claims, namely, Claims 49 and claim 50, have been added, which are distinct from the claims in the '523 Patent. More importantly in all claims § 112 issues are fixed.

Also, Petitioner misrepresented during the conference call that it came to know about the reissue application only on January 6, 2020 (*See*, Ex. 1049 at 8) after Patent Owner filed the mandatory notice, whereas in fact Petitioner itself mentioned in the Petition filed on December 16, 2019 that there is a related application claiming priority to the '523 Patent in the Petition as follows: "Pending U.S. Application No. 16/202,067 claims priority to the '275 application, according to the PTO PAIR database." (*See*, Paper 1 at 3). Clearly, Petitioner had notice that the '067 application is indeed a reissue application, as the PAIR database clearly shows it was available to the Public as it was published in USPTO Official Gazette on January 1, 2019 (*See*, Ex. 2011 at 3 & 1). Furthermore since Petitioner concedes that there are § 112 issues in the claims of the '523 patent (Petition, footnote 5 at 10), the reissue application will resolve them as well, so the IPR should be denied.

Under Patent Owner's attached declaration (*See*, Ex. 2007), he has no intent to withdraw the reissue application under any circumstances and will not use the reissue application as a sword and a shield. Accordingly, Patent Owner requests the Board to deny the institution of the Petition, which will eliminate duplication of effort, avoid wasting the resources of the Office and the parties, avoid the need for further proceedings in District Court, and avoid prejudice to Patent Owner.

Date: June 8, 2020

Respectfully submitted,

/Venkat Konda/

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