

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTEL CORPORATION,

Petitioner,

v.

VLSI TECHNOLOGY LLC,

Patent Owner.

Case IPR2018-01038

Patent 8,566,836 B2

Before BART A. GERSTENBLITH, MINN CHUNG, and
KIMBERLY McGRAW, *Administrative Patent Judges*.

McGRAW, *Administrative Patent Judge*.

ORDER
Conduct of the Proceedings
37 C.F.R. § 42.5

I. INTRODUCTION

On September 26, 2018, Judges McGraw, Gerstenblith, and Chung held a telephone conference call with counsel for Intel Corporation (“Petitioner”) and counsel for VLSI Technology LLC (“Patent Owner”) to address Petitioner’s request for authorization to file a reply brief to Patent Owner’s Preliminary Response. Specifically, Petitioner seeks authorization to file a reply to address assertions in Patent Owner’s Preliminary Response that the Petition contains statements about the Finkelstein reference (Ex. 1004) that are inconsistent with statements Petitioner made about Finkelstein during prosecution of U.S. Patent Application No. 13/830,157 (“the ’157 application”).

Patent Owner opposes Petitioner’s request, arguing, *inter alia*, the Petitioner was aware of the alleged inconsistent statements when it filed its Petition and that Petitioner has not shown that such a reply would be beneficial to the Board.

Having reviewed the record and considered the parties’ positions, we are persuaded that Petitioner has shown good cause justifying the filing of a reply. *See* 37 C.F.R. § 42.108(c). While Petitioner may have been aware of statements made during the prosecution of the ’157 application, we disagree that Petitioner should have foreseen the particular arguments made by Patent Owner in its Preliminary Response. We also find that a reply responding to Patent Owner’s Preliminary Response on this issue would be of assistance to the panel. Accordingly, we *grant* Petitioner’s request for authorization to file a reply limited to responding to Patent Owner’s argument that Petitioner has taken a contrary position and made conflicting statements in its

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discussion of Finkelstein (Ex. 1004) between the Petition and the prosecution history of the '157 application.

II. ORDER

In consideration of the foregoing, it is hereby
ORDERED that Petitioner's request for authorization to file a reply to Patent Owner's Preliminary Response is *granted*;

FURTHER ORDERED that the reply is limited to five pages and may only address Patent Owner's argument that Petitioner has taken a contrary position and made conflicting statements in its discussion of Finkelstein (Ex. 1004) between the Petition and the prosecution history of U.S. Patent Application No. 13/830,157; and

FURTHER ORDERED that no sur-reply is authorized at this time.

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