

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTEL CORPORATION,
Petitioner,

v.

VLSI TECHNOLOGY LLC,
Patent Owner.

IPR2019-01196
Patent 7,246,027 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

On Tuesday, October 23, 2019, Intel Corporation (“Petitioner”) submitted an email to the Board requesting authorization to file a reply to the Preliminary Response (Paper 7, “Prelim. Resp.”) filed by VLSI Technology LLC (“Patent Owner”). Ex. 3001. Specifically, Petitioner requests leave to respond to Patent Owner’s argument that the Board should exercise its discretion under 35 U.S.C. § 314(a) to deny institution. Patent Owner opposes the request. *Id.*

Patent Owner’s Preliminary Response argues the Board should exercise its discretion under 35 U.S.C. § 314(a) to deny institution because the present Petition challenges the same claims that are at issue in a co-pending district court litigation. *See* Prelim. Resp. 1. Patent Owner contends, *inter alia*, Petitioner timed the filing of the present Petition to circumvent the statutory estoppel in the America Invents Act to ensure that the Board’s final written decision will not issue until after the district court trial has concluded and that having two parallel proceedings challenging the same patent claims based on the same references under the same claim construction standard would be a waste of resources. *Id.* at 9–12.

Because we determine that a reply would be helpful in deciding whether the Board should exercise its discretion to deny institution in the present proceeding, we grant Petitioner’s request. *See* 37 C.F.R. §§ 42.20(d), 42.108(c). Petitioner’s reply shall be no longer than 5 pages, shall be limited to responding to the arguments presented in the Preliminary Response that institution of an *inter partes* review as requested in the Petition should be denied under 35 U.S.C. § 314(a), and is due no later than 10 days after the date of this Order. Patent Owner is authorized to file a sur-reply to Petitioner’s reply, if it so chooses. The sur-reply shall also be

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no longer than 5 pages, shall be limited to responding to the arguments presented in the reply, and is due 10 days after the filing of the reply.

No conference call is necessary at this time.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner may file a reply not to exceed 5 pages, no later than 10 days after the issuance of this Order, and limited to responding to the argument presented in the Preliminary Response that the Board should exercise its discretion pursuant to 35 U.S.C. § 314(a) and deny institution; and

FURTHER ORDERED that Patent Owner may file, if it so chooses, a sur-reply limited to responding to the arguments presented in the reply, not to exceed five pages, and no later than 10 days after the filing of Petitioner's reply.

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