

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE UNITED
STATES PATENT AND TRADEMARK OFFICE

PATENT QUALITY ASSURANCE, LLC,
INTEL CORPORATION,
Petitioners,

v.

VLSI TECHNOLOGY LLC,
Patent Owner.

IPR2021-01229¹
Patent 7,523,373 B2

Before KATHERINE K. VIDAL, *Under Secretary of Commerce for
Intellectual Property and Director of the United States Patent and
Trademark Office.*

ORDER

Requests for Discovery, For Partial Reconsideration, To Seal, and
Order to Show Cause
37 C.F.R. §§ 42.5, 42.11, 42.51

¹ Intel Corporation (“Intel”), which filed a petition in IPR2022-00479, was joined as a party to this proceeding. Paper 30.

This Order resolves certain of the parties' requests relating to an anonymous ex parte communication previously sent to the USPTO. *See* Paper 111.

On February 3, 2023, Supervisory Paralegal Megan Carlson provided a copy of the ex parte communication to the parties and placed it on the record under seal as Exhibits 3029 and 3030 ("the submission"), and designated the submission as available to "Parties and Board" only. Paper 111. Ms. Carlson indicated that neither the Director nor the Board would consider the submission. *Id.* (citing 37 C.F.R. § 42.5(d)).

On February 9, 2023, I issued an Order denying the request of Petitioner Patent Quality Assurance, LLC ("PQA") to expunge the submission and denying the request of Patent Owner VLSI Technology LLC ("VLSI") to designate the submission as public instead of Parties and Board only. Paper 112. I explained that the steps of putting the submission on the record and putting it under seal, as Parties and Board only, were taken to balance the Office's interest in transparency with its interest in not further disseminating such communications. *Id.*

1. VLSI's Request for Discovery

On February 15, 2023, counsel for VLSI requested, via email (Ex. 3034), that the Director and/or the Board grant discovery, in view of the submission.² The email represented that PQA and Intel opposed the request. I construe VLSI's request as relating to my decision on Director Review of the Board's institution decision. *See* Paper 102, 6. I authorize VLSI to file a

² The emails indicated herein have been entered as Parties and Board only. The parties are requested to confer and jointly submit public versions of the emails which do not reflect the content of the submission. When public versions are available, they will be entered on the record.

motion for additional discovery pursuant to 37 C.F.R. § 42.51(b)(2), subject to the following caveats. First, VLSI's paper must be filed as Parties and Board only. Second, I will only consider admissible evidence in support of VLSI's motion. *See* 37 CFR § 42.62(a). Accordingly, I will only consider the request for discovery to the extent that it does not rely on information from the ex parte submission. *See* Paper 111. VLSI may not cite, repeat, or otherwise invoke information from that submission which, as has already been explained, I will not consider in this proceeding. *Id.* Third, in its paper VLSI should explain why this discovery is "necessary in the interest of justice," coming as it does so late in the proceeding. *See Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, Case IPR2012-00001, Paper 26 at 6 (PTAB March 3, 2013) (precedential). In particular, VLSI should explain why it could not have filed this motion sooner had it exercised reasonable diligence. Finally, VLSI should come forward with evidence "tending to show beyond speculation that in fact something useful will be uncovered," again without reference to the submission. *Id.*

VLSI's motion is due by March 2, 2023, but VLSI may self-expedite its request by filing the motion sooner. PQA and Intel are not authorized to file responsive briefing at this time, but I may authorize responsive briefing if I determine that it is warranted by VLSI's motion. I will not grant the motion without having received briefing by PQA and Intel.

2. VLSI's Request for Reconsideration

On February 17, 2023, VLSI also filed publicly a request (Paper 116) for reconsideration of the statement in Paper 111 that the ex parte submission will not be considered by me, on Director review, or by the

Board. I deny that request because the submission was made ex parte and anonymously, and was not authorized. *See* 37 CFR § 42.5(d).

3. PQA's Request to Seal

PQA has requested, via email (Ex. 3035), that Paper 116 be sealed as Parties and Board only because VLSI discloses the substance of Exhibit 3030 in Paper 116, wherein Exhibit 3030 is not publicly available. VLSI has responded, via email (Ex. 3036), that it has cited Exhibit 3032 (an email from VLSI to the Board), which is public, and that the information provided in Paper 116 is materially the same as that available in Exhibit 3032. However, VLSI's citations to Exhibit 3032 occur on page 1 of Paper 116, whereas PQA has pointed to other material on pages 2–3 of Paper 116. Moreover, I discern differences between the content of Paper 116 and the publicly available Exhibit 3032. *Compare* Paper 116, 2–3, *with* Ex. 3032. I grant PQA's request to designate Paper 116 as Parties and Board only because the underlying material in Exhibits 3029 and 3030, and referenced in Paper 116, is designated Parties and Board only.

4. Show Cause Order

Further, I order VLSI to show cause why it should not be sanctioned for publicly filing a paper containing information that was designated Parties and Board only in Paper 116. I note that VLSI was aware that the submission was Parties and Board only, that VLSI previously requested that the submission be designated public, and that I previously denied that request. Paper 112. This is not the first time VLSI has filed information publicly that should have been filed Parties and Board only. *See* Ex. 3012. In particular, VLSI should show cause as to why it should not be ordered to file all future filings as Parties and Board only, to provide compensatory

expenses to PQA for its request that Paper 116 be sealed, and/or to provide compensatory expenses to PQA and Intel for the costs of any briefing on the discovery requested by VLSI, including attorney's fees. *See* 37 C.F.R. §§ 42.12(b).

I emphasize that the motion for discovery and the order to show cause do not stay the underlying proceeding.

For the foregoing reasons, it is hereby:

ORDERED that VLSI is authorized to file a motion for additional discovery, designated as Parties and Board only, limited to 7 pages and due by March 2, 2023, and consistent with the instructions herein;

FURTHER ORDERED that PQA's request to seal is *granted*;

FURTHER ORDERED that VLSI's request for reconsideration of Paper 111 is *denied*; and

FURTHER ORDERED that VLSI is ordered to show cause why sanctions should not be imposed. VLSI is authorized to file a brief in response limited to 10 pages and due by March 2, 2023.

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