

Paper No. _____

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTELLECTUAL VENTURES MANAGEMENT, LLC
Petitioner

v.

Patent of XILINX, INC.
Patent Owner

Case IPR2012-00018
Patent 7,566,960
Title: INTERPOSING STRUCTURE

**PATENT OWNER'S REPLY TO PETITIONER'S OPPOSITION TO
PATENT OWNER'S SECOND SUBSTITUTE MOTION TO AMEND**

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INTRODUCTION

Patent Owner Xilinx, Inc. (“Xilinx”) submits this reply to Petitioner’s Opposition to Patent Owner’s Second Substitute Motion to Amend (Paper 29).

I. The Second Substitute Motion Complies with the Board’s Order

A. Added Features Were Removed to Comply with *Idle Free*

Idle Free states that “[a] desire to obtain a new set of claims having a hierarchy of different scope typically would not constitute a sufficient special circumstance” to permit a Patent Owner to present amendments to dependent claims. P. 6. Patent Owner’s Second Substitute Motion to Amend (“Second Substitute Motion”; Paper 26) removed dependent claim amendments that would have provided a hierarchy of different scope originally proposed in Patent Owner’s Substitute Motion to Amend (“First Substitute Motion”; Paper 22). Therefore, the changes comply with the Board’s Order (Paper 24).

B. Claims 14 & 22 Were Reworded to Comply with *Idle Free*

Patent Owner’s First Motion to Amend (Paper 19) included amendments that both added and removed language from the claims. The First Substitute Motion (Paper 22) included those same amendments, but also included a processing error that removed the strike-through font relative to the First Motion to Amend. *See* Paper 22; XLNX-2009. *Idle Free* states that “[a] patent owner may not seek to broaden a challenged claim in any respect” and that “a substitute claim

may not enlarge the scope of the challenged claim it replaces by eliminating any feature.” *Idle Free*, P. 5. To comply with *Idle Free*, the Second Substitute Motion reworded claims 14 and 22 in a manner that avoided elimination of any feature. Therefore, the changes comply with the Board’s Order.

C. Elastomer was Moved to Claims 14 & 22 to Comply with *Idle Free*

Idle Free states, “if the patent owner also proposes to add further features into proposed [dependent] substitute claims 5 and 6, the patent owner should provide meaningful reasons to establish a special circumstance for adding these features.” P. 9. As indicated above, a desire for a hierarchy of different claim scope typically is not a special circumstance. *See id.* at 6. The elastomer feature was introduced in substitute claims 15 and 23 in the First Substitute Motion. Since these were dependent claims, and in order to comply with *Idle Free*, Patent Owner moved the feature to the proposed independent claims in the Second Substitute Motion. Therefore, the changes comply with the Board’s Order.

II. Substitute Claims 14-20 are Sufficiently Clear to be Valid

Claim 14 recites “an interposing structure” and later refers back to it as “the interposer” consistent with issued claim 1. Since the use of “the interposer” to refer to “the interposing structure” was not a ground of unpatentability involved in the trial, it could not be corrected in the substitute claim. *See* 37 C.F.R. § 42.121. The Patent Office did not address the limitation during prosecution and therefore

appears to have had no difficulty understanding that the “interposer” refers back to the “interposing structure.” *See* XLNX-2001. Further, Dr. Niekirk understood it to refer back to the “interposing structure.” *See* IVM-1013, p. 37, ll. 14-21.

III. Alexander Has No Bearing on Patentability (Grounds 10-13)

A. The Second Substitute Motion Complies With *Idle Free*

The petitioner suggests that Patent Owner failed to comply with *Idle Free* by not including a representation of “the specific technical disclosure” of Alexander (IVM-1016). *Idle Free* indicates that Patent Owner should provide reasons why “the proposed substitute claim is patentable over the prior art of record, and over prior art not of record but known to the patent owner.” *Idle Free*, p. 7.

Patent Owner complied with *Idle Free* when it identified and discussed Chakravorty '362, Siniaguine, and Ma as the most relevant, or closest prior art. Alexander does not anticipate the substitute claims under 35 U.S.C. § 102 because it does not teach at least “an array of solder balls disposed on an outside surface of the integrated circuit package” and “an interposing structure disposed inside the integrated circuit package.” Also, this Reply makes clear that Alexander cannot be used to preclude patenting under 35 U.S.C. § 103. *See infra*, Section III.B. Therefore, Alexander has no bearing on whether the Patent Holder is entitled to entry and allowability of the substitute claims. As such, the Patent Holder complied with *Idle Free* when it identified and discussed Chakravorty '362,

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