

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTELLECTUAL VENTURES MANAGEMENT, LLC
Petitioner

v.

XILINX, INC.
Patent Owner

Case IPR2012-00023
Patent 7,994,609

**PETITIONER'S OPPOSITION TO PATENT OWNER'S
FIRST MOTION TO AMEND**

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Cases

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I. Statement of Relief Requested

Petitioner opposes Patent Owner's Motion to Amend for the reasons set forth in its Petition (Paper No. 3), in its Reply to Patent Owner Response, and below.

II. Xilinx's First Motion to Amend is Procedurally Deficient

Xilinx's First Motion to Amend is procedurally deficient for at least three reasons. First, Xilinx fails to show "patentable distinction over the prior art of record and *also prior art known to the patent owner.*" *Idle Free Systems, Inc. v. Bergstrom, Inc.*, Case IPR2012-00027, Paper 26 (June 11, 2013), p. 7 (emphasis added). On page 15 of its motion, Xilinx argues that proposed substitute claims 20 and 21 are patentable over the *cited* prior art for reasons explained in the Xilinx's Patent Owner's Response. But, neither in its Patent Owner's Response nor in the Motion to Amend does Xilinx even assert, much less make an adequate showing, that proposed substitute claims 20 and 21 are patentable over all prior art known to Xilinx.

As for proposed substitute claim 30, Xilinx asserts that it is "patentably distinct from the prior art because fourth conductive layer is part of the shield capacitor portion, which is connected to and part of the second node of the capacitor and the second plurality of conductive elements." (First Motion to Amend, Paper No. 17, p. 15.) Xilinx does not specify what "prior art" it is referring

to or whether the “prior art” it references includes both the prior art of record and the prior art known to Xilinx. Further, Xilinx does not even assert that the feature it relies on—the “fourth conductive layer is part of the shield capacitor portion, which is connected to and part of the second node of the capacitor and the second plurality of conductive elements”—is not disclosed in the prior art. Even if Xilinx’s statement is interpreted as asserting that this feature is not disclosed in the prior art of record and known to Xilinx, it is merely a conclusory allegation with no support on the record. Such conclusory statements are insufficient to meet required burden for a motion to amend. *Idle Free Systems, Inc. v. Bergstrom, Inc.*, Case IPR2012-00027, Paper 26 (June 11, 2013), p. 7.

Second, Xilinx’s motion fails to set forth support for each proposed substitute claim. *See* 37 C.F.R. § 42.121(b)(1). On pages 12 and 13 of its Motion, Xilinx asserts that isolated elements of proposed substitute claims 20-34 are supported in the original disclosure. This is insufficient. A Patent Owner is required to show where the claim as *a whole* is supported in the original disclosure. *See Nichia Corp. v. Emcore Corp.*, Case IPR2012-00005, Paper 27 (June 3, 2013), p. 4. Xilinx did not make the required showing to support its proposed amendment.

Third, several of the claims fail to narrow the scope of the claims that they replace. For example, claim 20 was presented as a replacement for claims 1 and 8. Specifically, Xilinx alleges that “[t]he limitations presented in proposed claim 20

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