

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 IPR2012-00023
Patent 7,994,609
Issue Date: August 9, 2011
Title: SHIELDING FOR INTEGRATED CAPACITORS

Before Sally C. Medley, Karl D. Easthom, and Justin T. Arbes
Administrative Patent Judges

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

TABLE OF CONTENTS

I. Statement of Relief Requested 1

II. Xilinx's First Motion to Amend is Procedurally Correct 1

III. Substitute Claims 20-34 Are Patentable..... 2

 A. Proposed Claims 20 and 22-29 are patentable..... 2

 B. Proposed Claim 21 is patentable..... 4

 C. Proposed Claims 30-34 are patentable 5

IV. Conclusion 6

Certificate of Service..... 7

TABLE OF AUTHORITIES

Cases

CFMT, Inc. v. Yieldup Intern. Corp...... 5

Idle Free Systems, Inc. v. Bergstrom, Inc., 1

Statutes

35 U.S.C. § 311 5

Rules

37 C.F.R. § 42.23 1

37 CFR 42.121(a)(2)(ii). 2

I. Statement of Relief Requested

Patent Owner Xilinx, Inc. (“Xilinx”) filed a Response (Paper No. 15) and a Motion To Amend (Paper No. 17) on May 7, 2013. On August 23, 2013, the Petitioner filed a Reply (Paper No. 22, “Reply”) and an Opposition to the Motion to Amend (Paper No. 21, “Opposition”). Xilinx provides this paper as a reply to Petitioner’s Opposition under 37 C.F.R. § 42.23. Xilinx’s Motion to Amend was and is procedurally correct, and presents the claims in a patentable form.

II. Xilinx’s First Motion to Amend is Procedurally Correct

Petitioner’s first argument is to assert that Xilinx did not affirmatively state that substitute claims 20 and 21 are patentably distinct over “prior art known to the patent owner.” Opposition at 1, citing *Idle Free Systems, Inc. v. Bergstrom, Inc.*, IPR2012-00027, Paper 26 at p. 7. First of all, Xilinx notes that substitute claims 20 and 21 include each and every element of issued independent claim 1, as well as elements from dependent claims 8 and 2, respectively. So, unlike the situation in *Idle Free*, substitute claims 20 and 21 do not present any new claim “features” that were not previously being considered in the *inter partes* review, only adding features from dependent claims into base claims. *Id.*

Petitioner’s second argument is directed to the support for each proposed substitute claim. Opposition at 2. Xilinx’s Motion to Amend identified original claims (which are part of the specification), along with paragraphs and drawings

from the application as originally filed, to support each of the proposed substitute claims as a whole. In its Opposition, the Petitioner did not identify any claim elements that were missing from the identified support.

Petitioner's third argument is that the claims fail to narrow the scope of the claims that they replace. To be clear, the rule is that a motion to amend should be denied when "the amendment seeks to enlarge the scope of the claims of the patent or introduce new subject matter." 37 CFR 42.121(a)(2)(ii). Substitute claims 20 and 21 do not enlarge the scope of the claims or introduce new subject matter. Substitute claims 20 and 21 each include every word and limitation of claim 1. Substitute claim 20 also includes limitations previously recited in dependent claim 8; substitute claim 21 also includes limitations previously recited in dependent claim 2. Thus, the substitute claims do not "enlarge the scope of the claims" of the '609 patent, per the former part of the rule. (As for the latter part of the rule, it is unquestioned that substitute claims 20 and 21 do not introduce new subject matter.)

III. Substitute Claims 20-34 Are Patentable

A. Proposed Claims 20 and 22-29 are patentable

As discussed in the Patent Owner's Motion to Amend, substitute claim 20 includes a layer of interleaved "conductive elements" that are connected to the first and second "capacitor nodes," and another layer of "conductive elements" that are connected only to the "first node" – thereby making the capacitor unbalanced.

The Petitioner presents a new argument in its Opposition, stating that “Paul teaches both ‘balanced’ and ‘unbalanced’ capacitors.” Petitioner’s Reply at 10, cited at Opposition at 4. Specifically, the Petitioner refers to FIG. 8 of Paul, which shows a shield portion on the left side (as shown in the figure) of the core capacitor. The Petitioner then argues that the existence of the shield makes the capacitor of FIG. 8 unbalanced (the shield is on the left side of the figure).

The capacitor in FIG. 8 of Paul is balanced. Paul explains that a shield that is connected to one of the nodes A or B only provides a minimal amount of “shunt capacitance,” and “does not affect value of the capacitance between nodes A and B.” Paul at 3:50-56.¹ That is, any “shunt capacitance” that is provided by the shields is “very small,” as compared to the core capacitance. *Id.* Furthermore, Xilinx’s counsel, Dr. Blanchard, has repeatedly asserted that FIG. 8 of Paul is balanced. Blanchard Decl. at ¶26; IVM1014 92:14-93:16. Thus, the capacitor of FIG. 8 of Paul is balanced.

Substitute claims 22-29 are patentable over the prior art for the reasons discussed with reference to substitute claim 20, upon which claims 22-29 depend.

¹ This section of Paul is discussing FIG. 4, which like FIG. 8, has shields around the capacitor core. Also in FIG. 4, like FIG. 8, the shields are connected to the capacitor nodes A and B.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.