

Paper No. \_\_\_\_\_

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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INTELLECTUAL VENTURES MANAGEMENT, LLC  
Petitioner

v.

Patent of XILINX, INC.  
Patent Owner

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Case IPR2012-00023  
Patent 7,994,609  
Title: SHIELDING FOR INTEGRATED CAPACITORS

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**PATENT OWNER'S PRELIMINARY RESPONSE  
BY XILINX, INC. UNDER 37 C.F.R. §§ 42.107**

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## **INTRODUCTION**

Patent Owner Xilinx, Inc. (“Xilinx”) submits the following preliminary response to the Petition filed by Intellectual Ventures Management (“IVM”) on September 17, 2012 requesting *inter partes* review of claims 1-19 of U.S. Patent No. 7,994,609 (the “’609 Patent”). The Petition proposes six different Grounds of rejections. As will be shown below, several of these proposed Grounds are legally deficient, and should not be adopted in the present proceeding.<sup>1</sup> Furthermore, and as also shown below, IVM has not fully and completely identified the real party in interest, and for this reason alone, Xilinx respectfully requests that the Board decline to institute *inter partes* review of the ’609 patent.

### **I. Critical Failures in the Petition**

There are several critical failures in the Petition, addressed separately below.

#### **A. Ground 1 Fails For Neglecting To Address An Explicit Statement That Teaches-Away From the Proposed Obviousness Combination**

IVM asserts, as to Ground 1, that Claims 1, 3, 5, 6, and 10-12 are obvious under 35 U.S.C. § 103(a) by U.S. Patent No. 6,737,698 to Paul et al. (“Paul”). Specifically, IVM claims that the combination of two different embodiments of Paul renders the challenged claims obvious. As explained below, however, Paul explicitly states not to combine these two embodiments, making a finding of

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<sup>1</sup> Xilinx will address the merits of all of the Grounds that are adopted for the present proceeding in its Patent Owner Response.

obviousness highly unlikely, especially since IVM's petition does not acknowledge or address this teaching in Paul. Moreover, Paul was cited and considered during the original prosecution of the '609 patent. Thus, no trial is warranted because IVM's Petition fails to establish a likelihood of success on Ground 1.

**1. Prior Art Must be Considered In Its Entirety, Including Disclosures That Teach Away From the Claims**

The above heading for the present section of this response is the same as the heading for MPEP 2141.03.VI, which states the fundamental legal principal that “a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” *Id.*, citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). In the *W.L. Gore* case, the Court reversed the district court's finding of obviousness because the district court “disregarded” the fact that the prior art taught against the combination. *Id.* at 1550-1551. As will be shown below, the Petitioner did not address the prior art (Paul) as a whole, and has thus failed this fundamental principal of establishing an obviousness rejection under 35 U.S.C. § 103(a).

**2. Paul Teaches Separate Embodiments of a Capacitor, including those in FIGS. 8 and 13**

The claims of the '609 patent are directed to a capacitor with a unique shielding arrangement. Paul teaches several types of shielded capacitors, all of which are different from the claims of the '609 patent. One embodiment of Paul is

provided in FIG. 8 and illustrates a capacitor and shields, as annotated below. The shields of the capacitor of FIG. 8 are connected to “node A” or “node B”, which are nodes of the capacitor.<sup>2</sup>

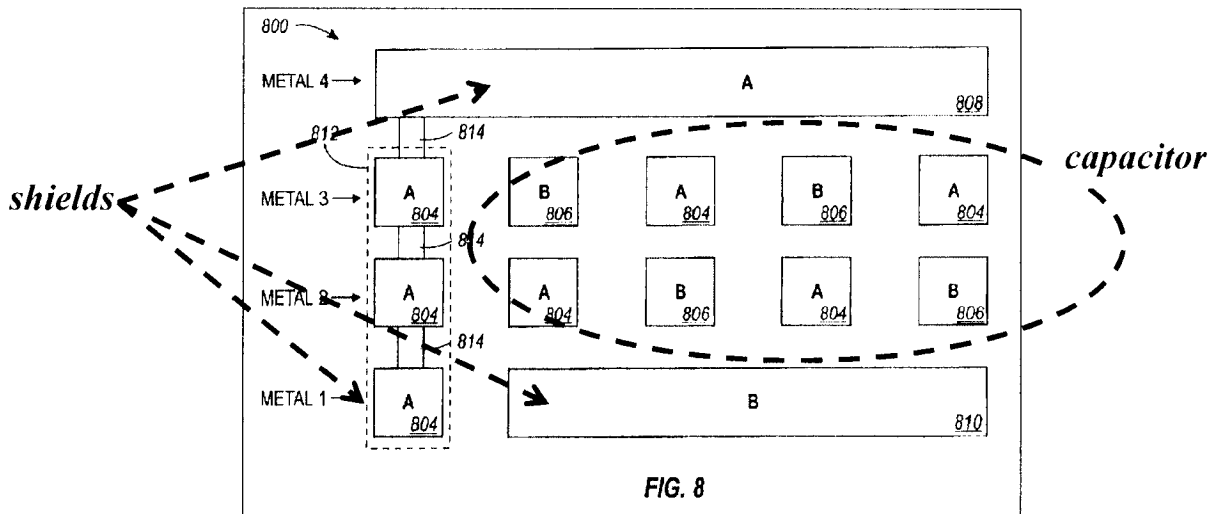


FIG. 13 shows another embodiment having, capacitor and shields, as annotated below.

<sup>2</sup> The Petition relies on yet another embodiment of Paul, FIG.12, to support its contention that the bottom plate 810 can be connected to node A rather than node B.

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