

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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In re U.S. Patent No. 6,240,376	Trial No.:	IPR 2012-00042
Application No.:	09/127,587	
Filed:	July 31, 1998	
Issued:	May 29, 2001	
Inventors:	Alain Raynaud Luc M. Burgun	Atty. Dkt. No. 007121.00004
Patent Owner:	Mentor Graphics Corporation	
For:	METHOD AND APPARATUS FOR GATE- LEVEL SIMULATION OF SYNTHESIZED REGISTER TRANSFER LEVEL DESIGNS WITH SOURCE-LEVEL DEBUGGING	

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United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PATENT OWNER'S LISTING OF ANTICIPATED MOTIONS FOR  
DISCUSSION IN INITIAL CONFERENCE CALL**

An initial conference call is scheduled in this matter for Thursday, March 21, 2013 at 2:00pm EDST. Pursuant to the Office Patent Trial Practice Guide (OPTPG), Fed. Reg., Vol.77, No. 157 (August 14, 2012) at 48765, the Patent Owner submits this initial listing of motions it may bring during this trial. This listing is without prejudice to Patent Owner's right to seek authorization to bring additional motions, or to decide not to bring motions as indicated, as circumstances may warrant.

**1. Motion to Take Discovery Relating Petitioner Synopsys' Lack of Standing in this IPR Under 35 U.S.C. § 315(b)**

Patent Owner filed on March 8, 2013 a Request for Rehearing on the Board's decision to institute the instant *inter partes* review (IPR). That request is currently pending. Contingent on the Board's decision on the Request for Rehearing, or in the event the Board desires additional information or evidence pertaining to the pending Request for Rehearing, the Patent Owner may move to take additional discovery<sup>1</sup> of Petitioner Synopsys regarding:

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<sup>1</sup> This includes, potentially, a reasonable number of requests for production, interrogatories, requests for admission and depositions of persons knowledgeable of the relevant facts.

- ❖ Synopsys’ privity relationship with EVE<sup>2</sup>, including:
  - Synopsys’ acquisition of EVE consummated on or about October 4, 2012 and activities leading up to that acquisition, including but not limited to the acquisition agreement entered into by Synopsys and EVE on September 27, 2012, and joint business activities leading up to and relating to that agreement, including the business of “using, importing, selling, offering for sale and/or supporting the ZeBu Products in the United States, which line of products was previously accused by Mentor Graphics [in 2006] of infringing the . . . [‘376 patent] and which products share structures and functionality that Mentor Graphics alleged are relevant to the claims of the . . . [‘376 patent].” Preliminary Response at 6 (quoting the September 27, 2012 Declaratory Judgment Complaint (MG 2004) filed jointly by EVE and Synopsys, at ¶13).
  - The relationship of Synopsys and EVE in and around the time in 2006 when Patent Owner Mentor Graphics served on EVE a complaint alleging infringement of the `376 patent.

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<sup>2</sup> EVE-USA, Inc. and Emulation and Verification Engineering, S.A., the defendants served by Patent Owner with a complaint alleging infringement of the subject `376 patent in 2006 (as referenced in the Request for Rehearing) will be referred to together as “EVE.”

- Evidence of when Petitioner Synopsys actually served a copy of the Petition in the instant IPR on Patent Owner's counsel of record Banner & Witcoff, Ltd. at its correct address of record with the USPTO, including any correct Certificate of Service.
- ❖ The role of EVE as a real party-in-interest to the Petition filed by Synopsys in the present IPR, including but not limited to:
  - EVE's or its counsel's involvement in preparing the Petition and/or the grounds asserted therein, pursuing this IPR, and/or paying of costs, including attorney and filing fees, associated with the foregoing;
  - The relationship of (1) the work undertaken by co-plaintiffs EVE and Synopsys, and their counsel (including Orrick, Herrington & Sutcliff, LLP), in connection with filing and litigating the Declaratory Judgment Action initiated by the September 27, 2012 Complaint (MG 2004) filed jointly by EVE and Synopsys, to (2) the work undertaken by Petitioner Synopsys and its counsel (including again Orrick, Herrington & Sutcliff, LLP) in preparing and filing the Petition in the instant IPR.

**2. Motion to Take Discovery Relating to Assignor Estoppel Barring EVE, and Hence its Privy Petitioner Synopsys, from Challenging the Validity of the '376 Patent in this IPR**

Assignor estoppel arises by virtue of named inventor of the '376 patent, Luc M. Burgun, assigning his rights in the '376 patent to Patent Owner Mentor

Graphics and subsequently founding EVE as its co-founder. Up to the time that Synopsys acquired EVE, Mr. Burgun led EVE, serving as President, Chief Executive Officer, and shareholder, and was intimately involved in EVE's efforts to offer emulation services and products. EVE, now under Synopsys' control as a wholly owned subsidiary, continues to manufacture the products Burgun helped design and develop under the Synopsys brand. In his current role as Synopsys' Vice President of Emulation, Mr. Burgun continues to direct the design and development of these products.

Contingent on the Board's decision on the pending Request for Rehearing, the Patent Owner may move to take additional discovery<sup>3</sup> of Petitioner Synopsys (including its wholly owned subsidiary EVE) regarding facts relevant to the applicability of assignor estoppel as a bar to the instant IPR, including facts relating to Burgun's current roles with Synopsys and his previous roles with EVE.

### **3. Motion to Amend the Claims**

Patent Owner has no present intention to move to amend the claims, but its study of the Board's Decision granting a trial in this matter is ongoing. In the event the Board denies the pending Request for Rehearing of the decision granting a trial, Patent Owner may choose to move to amend one or more of the claims for which a trial has been granted, at the time of filing its Patent Owner's Response as

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<sup>3</sup> See n. 1, *supra*.

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