

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

XILINX, INC.
Petitioner

v.

INTELLECTUAL VENTURES I LLC
Patent Owner

Case IPR2013-00029
Patent 5,632,545

Before SALLY C. MEDLEY, KARL D. EASTHOM, and
JUSTIN T. ARBES, *Administrative Patent Judges.*

ARBES, *Administrative Patent Judge.*

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

The initial conference call in the instant proceeding was held on April
11, 2013 between respective counsel for Petitioner and Patent Owner, and

Judges Medley, Easthom, and Arbes.¹ In preparation for the call, Petitioner Xilinx, Inc. (“Xilinx”) filed a Notice of Motions indicating that “it does not presently intend to file any motions.” Paper 13. Patent Owner Intellectual Ventures I LLC (“IV”) filed a List of Proposed Motions indicating that it anticipates filing (1) a motion to amend the subject patent, (2) a motion to exclude evidence, and (3) other motions “as the occasion arises.” Paper 14.

Regarding the proposed motion to amend, the parties were directed to the Trial Practice Guide for guidance. *See* Trial Practice Guide, 77 Fed. Reg. at 48766-67. Specifically, any motion to amend that IV files must explain how the proposed substitute claims obviate the grounds of unpatentability authorized in this trial and clearly identify where corresponding written description support in the specification of the patent can be found. 37 C.F.R. § 42.121. If the motion to amend includes a proposed substitution of claims beyond a one-for-one substitution, the motion must explain why more than a one-for-one substitution of claims is necessary. *Id.* Xilinx in its opposition may respond to new issues arising from proposed substitute claims, including the submission of evidence responsive to the amendment and new expert declarations directed to the proposed substitute claims. Trial Practice Guide, 77 Fed. Reg. at 48767.

Regarding the proposed motion to exclude evidence, IV indicated that authorization is not sought for any motion at this time but that IV may seek to file a motion based on evidence submitted by Xilinx in the future.

¹ The initial conference call is held to discuss the Scheduling Order and any motions that the parties anticipate filing during the trial. Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48765-66 (Aug. 14, 2012) (“Trial Practice Guide”).

During the call, IV also asked whether it may in its patent owner response challenge the claim interpretations in the Board's institution decision (Paper 11) and submit new evidence pertaining to claim interpretation. Xilinx pointed out that the time period for IV to request rehearing of the institution decision has expired. IV is not precluded from arguing claim interpretation in its patent owner response, and IV's patent owner response may include affidavits or additional factual evidence pertaining to claim interpretation. *See* 37 C.F.R. § 42.120; Trial Practice Guide, 77 Fed. Reg. at 48766. We also note that because the institution decision was a panel decision, a request for rehearing was not necessary to preserve any related issue for review. *See* 37 C.F.R. § 42.71; Rules of Practice for Trials Before the Patent Trial and Appeal Board, 77 Fed. Reg. 48612, 48624 (Aug. 14, 2012).

Finally, counsel for the respective parties indicated that they have no issues with the Scheduling Order (Paper 12) entered on March 12, 2013.

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