

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 (SCM)
Patent 5,632,545

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

MEDLEY, *Administrative Patent Judge*.

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

On June 13, 2013, the following individuals participated in a
conference call:

- (1) Mr. David McCombs and Mr. Thomas King, counsel for Xilinx;
- (2) Mr. George Quillin and Mr. Paul Hunter, counsel for Intellectual

Ventures I, LLC (IV); and

(3) Sally Medley, Karl Easthom, and Justin Arbes, Administrative Patent Judges.

The purpose of the conference call was for IV to seek guidance regarding a motion to amend.

Motion to Amend

IV intends to file a motion to amend and sought guidance on how it should present its motion to amend. The parties were directed to the Trial Practice Guide and two recent Board decisions for further guidance on motions to amend: (1) IPR2012-00005, Paper 27 (June 3, 2013) and (2) IPR2012-00027, Paper 26 (June 11, 2013).

Counsel for IV inquired whether unchanged claims, *e.g.*, original patent claims, need to be included in the required listing in a motion to amend.¹ The listing in a motion to amend is to include those substitute claims which a party seeks to substitute for an original claim. The listing may also include an indication that an original claim is to be cancelled (*e.g.*, “Claim 1 (cancelled)”), for example, where a patent owner will not, in a patent owner response, contest the patentability of such a claim. The motion to amend listing should not include the text of the original claims.

Counsel for IV also inquired whether it should amend its original claims or propose substitute claims. The Board indicated preference for the latter and not the former. As further discussed, the Board would expect to see the changes (between an original claim and substitute claim) annotated,

¹ 37 C.F.R. § 42.121(b) requires that a motion to amend claims must include a claim listing.

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for example, by underlining additional language in a proposed substitute claim. The Board would not normally expect to see any deletions. *See, e.g.*, IPR2012-00027, Paper 26 at 5.

Various hypothetical proposed substitute claims were discussed. The Board discussed such hypothetical proposed substitute claims as best it could without providing an advisory opinion on whether a motion to amend with the certain proposed hypothetical claims would be granted. Providing such an advisory opinion at this juncture would be premature and possibly could prejudice Xilinx.

Lastly, counsel for the respective parties indicated that they had agreed to extend DUE DATE 1 by one week. Counsel for IV indicated that he would file such notification as soon as possible.

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