

Filed on behalf of Intellectual Ventures  
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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XILINX, INC.  
Petitioner

v.

INTELLECTUAL VENTURES I LLC  
Patent Owner

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Case IPR2013-00029  
Patent 5,632,545

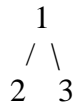
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**INTELLECTUAL VENTURES REQUEST FOR REHEARING  
(of the Board's Order of June 17, 2013)**

Patent owner Intellectual Ventures I LLC requests rehearing of the Board’s order of June 17, 2013 (Paper 19). Rehearing is permitted by Bd. R. 42.71(d), by the comment and response of 77 Fed. Reg. at 48624 and of 77 Fed. Reg. at 48687 (Aug. 12, 2012) (“the Board’s rehearing practice for proceedings under part 42 will be consistent with the . . . rehearing practice used in interference proceedings”), and by the Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012).

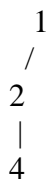
The order, Paper 19, resulted from a conference call among the APJs and counsel for the parties, during which counsel for patent owner sought guidance from the Board about a motion to amend the patent. What the Board wrote in its order must be understood in light of what was said during the call.

Patent owner’s patent has three claims. Dependent claims 2 and 3 each depend directly from independent claim 1. Here is a graphic representation of that relationship:



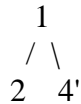
During the call, patent owner proposed a motion to amend that involved canceling dependent claim 3, and adding one of two alternative dependent claims 4. See Paper 19 at 3.

In the first alternative, the new claim would depend from claim 2 instead of directly from claim 1, and would add, say, three limitations but not the limitations of claim 3. Graphically:



In the second alternative, the substitute claim would depend directly from claim 1, and would include all the limitations of claim 3 as well as the three additional limitations.

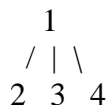
Graphically:



During the call, patent owner came to understand that the Board viewed the first alternative as not procedurally acceptable, at least because it would supposedly transgress the requirement of 35 USC § 316(d)(3) and Bd. R. 42.121(a)(2)(ii) that an amendment must not seek to enlarge “the scope of the claims of the patent.” That is, the Board’s view was a matter of policy or statutory/regulatory interpretation.

Patent owner respectfully submits that the Board has misapprehended or overlooked the law on enlarging or broadening the scope of the patent claims. As patent owner pointed out during the call, the claim of the first alternative is necessarily narrower in every respect than the independent claim from which it ultimately depends. In other words, there is nothing within the scope of the new dependent claim 4 that would not have been within the scope of the originally issued independent claim 1 or dependent claim 2.

In addition, patent owner submits that a Board ruling procedurally barring a claim of the first alternative runs counter to the agency’s notice and comment rulemaking expressed in the Trial Practice Guide. See, e.g., the “example of what may be included in a motion to amend.” 77 Fed. Reg. at 48767. In that example, claims 2, 3, and 4 each depended directly from claim 1.



All four original claims were cancelled. Claim 5 combined the limitations of and replaced claims 1-3, and claim 6 replaced claim 4. Dependent claim 7, however, did not substitute or replace any previous claim. Rather, it was “a proposed new claim reciting newly claimed subject matter.” *Id.* Claim 7 was properly dependent and did not enlarge the scope of the patent claims.

$$\begin{array}{c} 5 \\ / \ \backslash \\ 7 \ \ 6 \end{array}$$

That not-enlarging property of new claim 7 would not change had the patent owner in that example simply refrained from adding a claim to substitute for cancelled claim 4. In other words, new claim 7 did not include and did not need to include the volume limitation of original dependent claim 4.

So too here; patent owner respectfully submits that its first alternative claim is properly dependent and does not enlarge the scope of the patent claims. Just as new claim 7 in the Federal Register’s example was permissible, so too patent owner’s first alternative claim here ought to be permissible.

The Board’s order did not expressly bar patent owner from presenting a claim of its first alternative, but neither did the order expressly authorize patent owner to file it or grant patent owner’s request for guidance during the call that such a claim would be permissible. To be clear, patent owner does not seek “an advisory opinion on whether a motion to amend with the certain proposed hypothetical claims would be **granted**.” (Paper 19 at 4, emphasis added) Patent owner recognizes that the Board is not in a position to opine on the substantive merits of a motion it has not seen. So patent owner is not seeking a ruling now on whether its motion to amend would actually be granted on the merits. Rather, patent owner merely seeks a ruling that

a motion to amend presenting a claim of its first alternative would not for that reason be dismissed or denied.

Consequently, patent owner respectfully requests that the Board grant rehearing and clarify that a new claim of patent owner's first alternative is authorized and not procedurally barred.

Respectfully submitted,

Date: June 24, 2013

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