

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 (SCM)  
Patent 5,632,545

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

MEDLEY, *Administrative Patent Judge*.

DECISION  
Request for Rehearing  
*37 C.F.R. § 42.71(d)*

A conference call was held on June 13, 2013 with counsel for the respective parties and a panel of administrative patent judges. The purpose of the conference call was for Intellectual Ventures I, LLC (IV) to seek guidance regarding a motion to amend. The Board entered an order into the record memorializing the conference call. Paper 19; “Order.” IV seeks rehearing of the Order. Paper 20.<sup>1</sup>

### *Analysis*

IV requests “that the Board grant rehearing and clarify that a new claim of patent owner’s first alternative” of a set of proposed claims “is authorized and not procedurally barred.” Paper 20. The Order is a memorialization of a discussion which transpired during the conference call and does not include a decision or ruling made by the Board that a proposed claim, discussed during the call, would be procedurally barred. Indeed, the Board specifically avoided making any such ruling. The Order provides that:

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.

Order at 3.

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<sup>1</sup> The parties are reminded of the general format requirements set forth in 37 C.F.R. § 42.6(a). The text of IV’s rehearing request appears to be smaller than 14-point.

IV appears to recognize that no such decision was made, but suggests that the Board made a ruling or decision during the call that was not included per the Order. Specifically, IV recalls that the Board ruled that a certain hypothetical proposed claim would not be “procedurally acceptable.” Paper 20 at 2.

The Board does not recall making an oral ruling or decision. The Board’s recollection is consistent with the Order which also makes no such ruling or decision. Since there was no “decision” made by the Board<sup>2</sup> that a proposed hypothetical claim would be “procedurally barred,” there is nothing for us to reconsider and therefore IV’s request for rehearing is *dismissed*.

The Board, however, exercises its discretion to provide the following guidance regarding “a new claim of patent owner’s first alternative” and whether such claim would be “procedurally barred.” Paper 20 at 4.

IV proposes, per its hypothetical first alternative, canceling dependent claim 3 and adding a new claim 4 that would depend from original claim 2. Paper 20 at 1. The new claim 4 would include “three limitations but not the limitations of [original] claim 3.” *Id.* As we did during the conference call, the Board directs attention to IPR2012-00027, Paper 26 at 5-6, which provides the following:

Specifically, with regard to 37 C.F.R. § 42.121(a)2(i), a proposed substitute claim is not responsive to an alleged ground of unpatentability of a challenged claim if it does not either include or narrow each feature of the challenged claim being replaced. *A patent owner may not seek to broaden a challenged claim in any respect, in the name of responding to an alleged*

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<sup>2</sup> A party dissatisfied with a *decision* may file a request for rehearing, without prior authorization from the Board. 37 C.F.R. § 42.71(d).

*ground of unpatentability. A proper substitute claim under 37 C.F.R. § 42.12(a)(2)(i) must only narrow the scope of the challenged claim it replaces. Similarly, under 37 C.F.R. § 42.121(a)(2)(ii), a substitute claim may not enlarge the scope of the challenged claim it replaces by eliminating any feature.*

IPR2013-00027, Paper 26 at 5-6 (emphasis added).

Based on the above paragraph of the IPR2013-00027 decision, and with regard to rule 37 C.F.R. § 42.121(a)(2)(i), a patent owner may not broaden a challenged claim in any respect, for example by eliminating any feature.

However, as also provided for in the IPR2013-00027 decision, an amendment that appears to be beyond what is contemplated by rule 37 C.F.R. § 42.121(a)(2)(i), would not be “procedurally barred” *per se* provided that the patent owner shows that such an amendment is justified by special circumstances. *Id.*

For the above reasons, it is

ORDERED that IV’s Request for Rehearing is *dismissed*.

Case IPR2013-00029

Patent 5,632,545

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