

Paper No. \_\_\_\_\_

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.

Patent of INTELLECTUAL VENTURES MANAGEMENT, LLC,  
Patent Owner

Patent No. 5,632,545

Issue Date: May 27, 1997

Title: ENHANCED VIDEO PROJECTION SYSTEM

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*Inter Partes* Review No. IPR2013-00029

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PETITIONER XILINX, INC.'S OPPOSITION TO MOTION TO AMEND

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## **I. Introduction**

Pursuant to 35 U.S.C. §§ 316(a) and 326(a), Petitioner Xilinx, Inc. responds in opposition to Patent Owner's Motion to Amend that proposes to cancel claims 2 and 3 and add substitute claims 4 and 5. As will be shown below, Patent Owner's proposed claims fail to comply with 37 C.F.R. § 42.121 as clarified by the Board in *Idle Free Systems, Inc. v. Bergstrom, Inc.*, IPR2012-00027 (P.T.A.B. Jun. 11, 2013). Patent Owner has also not met its burden in showing how the claims are patentable over the prior art of record as required by 37 C.F.R. § 42.20. Further, Patent Owner's proposed claims are unpatentable under at least 35 U.S.C. § 103(a) over the prior art and supporting evidence provided herein.

## **II. Relief Requested**

Petitioner asks that the Board deny Patent Owner's motion to amend and not enter proposed claims 4 and 5 because Patent Owner failed to comply with 37 C.F.R. §§ 42.121 and 42.20. In the alternative, Petitioner asks that the Board cancel proposed claims 4 and 5 because they are unpatentable under 35 U.S.C. § 103(a) based on the prior art and supporting evidence provided herein.

## **III. Reasons for the Requested Relief**

### **A. Patent Owner's Motion to Amend Should Be Denied for Failing to Comply with 37 C.F.R. §§ 42.121 and 42.20.**

Patent Owner's motion to amend should be denied for failing to comply with 37 C.F.R. §§ 42.121 and 42.20 as clarified by the Board in *Idle Free*. Patent Owner failed to comply with 37 C.F.R. § 42.121 because the proposed amendments

include entirely new claim limitations that are unrelated to the existing limitations. These new limitations essentially propose a new claim strategy that is not appropriate for this proceeding. Patent Owner also failed to carry its burden as required by 37 C.F.R. § 42.20 by not including a claim construction for the new limitations that show how the claims are patentable over the prior art of record.

**1. Patent Owner’s Motion to Amend Should Be Denied for Failing to Comply with 37 C.F.R. § 42.121 and *Idle Free*.**

According to 37 C.F.R. § 42.121, a motion to amend can be denied where it “does not respond to a ground of unpatentability involved in the trial” or where it “seeks to enlarge to scope of the claims of the patent or introduce new subject matter.” These rules were clarified in *Idle Free* based on the Board’s goal of “streamlin[ing] and converg[ing] issues at all phases of the proceeding.” *Idle Free*, IPR2012-00027 at \*4.

In *Idle Free*, the Board stated that “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.” *Idle Free*, IPR2012-00027 at \*5. The Board also stated that claim amendments according to a different strategy are not appropriate for *inter partes* review proceedings. *Id.* at \*6. “If a patent owner desires a complete remodeling of its claim structure according to a different strategy, it may do so in another type of proceeding before the Office.” *Id.* In other words, a motion to amend that adds new

limitations to existing claims without narrowing any of the existing limitations is not appropriate for this proceeding and is not responsive under 37 C.F.R. § 42.121.

The proposed claims include the limitations of claims 2 and 3, respectively. They do not include any further narrowing of the existing limitations of claims 2 and 3, but instead include entirely new and unrelated limitations—a heat containment system, a second controller, and a control link. These new limitations do not appear in any claim of the '545 Patent and were never presented during original prosecution. By including new limitations and not narrowing the existing limitations, Patent Owner has failed to “either include or narrow each feature of the challenged claim being replaced,” as required by *Idle Free*. *See id.* at \*5.

Instead, Patent Owner is attempting to show patentability of the proposed claims based on entirely new grounds which is not appropriate for this forum. *See id.* at \*6. The proposed claims create entirely new issues that do not “streamline and converge” the existing issues in this proceeding. For example, in responding to the motion to amend, Petitioner has had to enter two new challenges that propose entirely new combinations of both existing and new prior art. To determine patentability of the proposed claims, the Board will be required to review these new references and supporting evidence as well as additional future arguments and evidence. This type of amendment is better suited for another proceeding such as *ex parte* reexamination or reissue. *See id.* at \*6.

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