

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

XILINX, INC.,
Petitioner,

v.

INTELLECTUAL VENTURES I LLC,
Patent Owner.

Case IPR2013-00112
Patent 5,779,334

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

ARBES, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. BACKGROUND

Petitioner Xilinx, Inc. (“Xilinx”) filed a Petition (Paper 2) (“Pet.”) seeking *inter partes* review of claims 1–14 of U.S. Patent No. 5,779,334 (“the ’334 patent”) pursuant to 35 U.S.C. §§ 311–319. On June 27, 2013, we instituted an *inter partes* review of claims 1–6 and 11–14 on one ground of unpatentability (Paper 14) (“Dec. on Inst.”).

Subsequent to institution, Patent Owner Intellectual Ventures I LLC (“IV”) filed a Patent Owner Response (Paper 26) (“PO Resp.”), and Xilinx filed a Reply (Paper 30) (“Pet. Reply”). Along with its Patent Owner Response, IV filed a Motion to Amend (Paper 27) (“Mot. to Amend”), proposing substitute claim 15 if the Board determines claim 3 to be unpatentable, and substitute claim 16 if the Board determines claim 12 to be unpatentable. Xilinx filed an Opposition to the Motion to Amend (Paper 31) (“Pet. Opp.”), and IV filed a Reply (Paper 35) (“PO Reply”).

IV filed a Motion for Observation (Paper 41) (“Obs.”) on the cross-examination testimony of Xilinx’s declarant, A. Bruce Buckman, Ph.D., and Xilinx filed a Response (Paper 45) (“Obs. Resp.”). IV also filed a Motion to Exclude (Paper 42) (“Mot. to Exclude”) certain testimony of Dr. Buckman. Xilinx filed an Opposition to the Motion to Exclude (Paper 44) (“Exclude Opp.”), and IV filed a Reply (Paper 47) (“Exclude Reply”).

An oral hearing was held on January 28, 2014, and a transcript of the hearing is included in the record (Paper 50) (“Tr.”).

The Board has jurisdiction under 35 U.S.C. § 6(c). This final written decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73.

For the reasons that follow, we determine that Xilinx has shown by a preponderance of the evidence that claims 1–6 and 11–14 of the '334 patent are unpatentable, and we deny IV's Motion to Amend.

A. The '334 Patent

The '334 patent¹ relates to a “color video projector system” having “separate light sources for producing separate beams of light which are passed each first through color filters to provide separate color beams before being processed by video-controlled light shutter matrices and then combined into a single beam projectable to provide a full-color video display with superimposed color spots.” Ex. 1001, Abstract. In another embodiment, “a single white-light source is used, and the beam of white light is split by a prism system into separate color beams.” *Id.* The '334 patent describes how prior art video projector systems, such as color Liquid Crystal Display (LCD) projectors, were expensive and had difficulty providing adequate light levels. *Id.* at col. 1, ll. 15–25. Later systems based on “active matrix color LCD's (AM-LCD's)” were less expensive, but still had limited brightness and resolution. *Id.* at col. 1, ll. 26–37. The '334 patent addresses these problems by “pre-coloring” the input light and “using a triple monochrome LCD structure instead of a color AM-LCD.” *Id.* at col. 2, ll. 7–19. The resulting arrangement, according to the '334 patent, provides better light output because less light is absorbed than in a color AM-LCD, and results in better resolution due to the superposition of color

¹ The '334 patent is a continuation-in-part of U.S. Patent Application No. 08/686,809, which issued as U.S. Patent No. 5,632,545 (“the '545 patent”). The '545 patent is the subject of related Case IPR2013-00029.

spots on the display. *Id.* It also is less expensive because monochrome LCDs are less expensive than color LCDs, and precise alignment of the components is less critical than with a color AM-LCD. *Id.*

Figure 1 of the '334 patent is reproduced below.

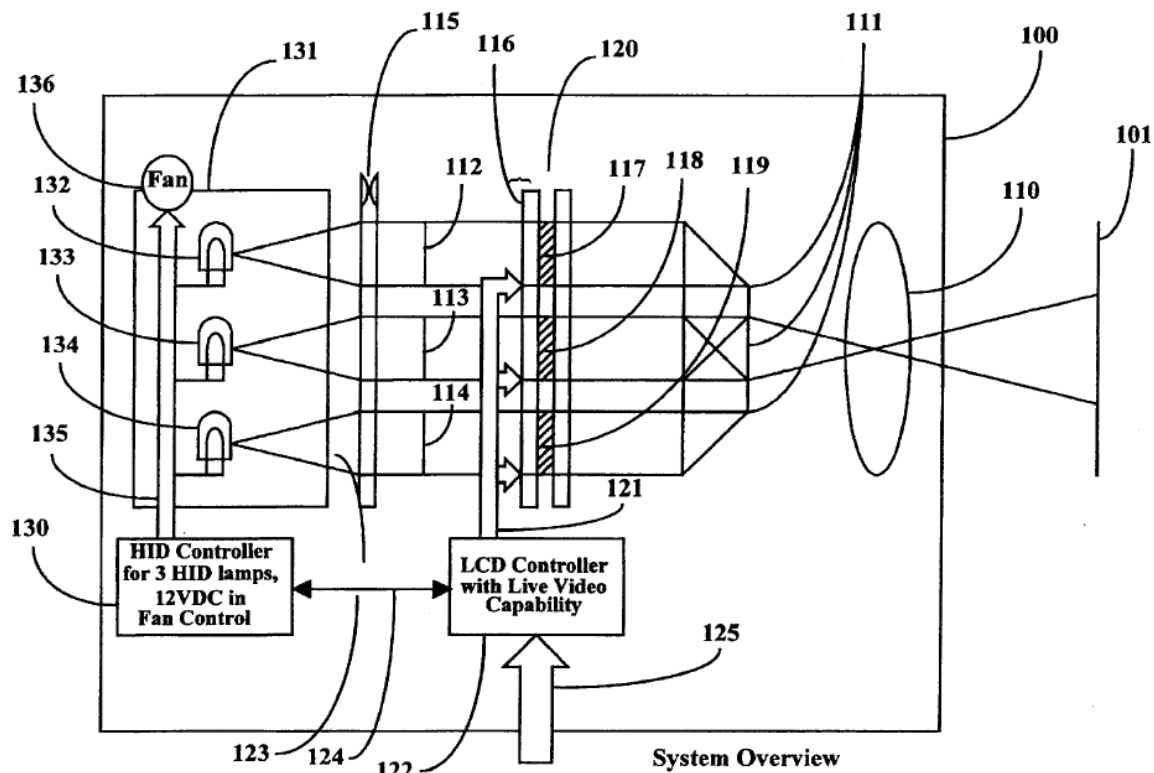


Fig. 1

Figure 1 depicts a video projector system comprising, *inter alia*, (A) lamps 132–134, which emit light; (B) condenser lens system 115, which focuses the three light beams emitted by the lamps; (C) red/green/blue filters 112–114, through which the respective light beams pass; (D) monochrome LCD arrays 117–119 in LCD unit 120; (E) controller 122, which controls the arrays; and (F) mirror and prism system 111, which combines the separate beams into a single beam for projection onto surface 101. *Id.* at col. 3, ll. 5–60.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.