

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

INTELLECTUAL VENTURES' PATENT OWNER RESPONSE PURSUANT
TO 37 C.F.R. § 42.120

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I. INTRODUCTION

The petitioner Xilinx, Inc. has not carried its burden. Indeed, Xilinx's own witness Dr. Buckman has expressly admitted a fundamental "mistake" he made in telling the Board about the technology, i.e., about the teachings of the reference U.S. Patent No. 5,287,131 to Lee. In its petition, Xilinx argued that the claims of U.S. Patent No. 5,779,334 (hereinafter "the '334 patent") are unpatentable on three different grounds. On April 22, 2013, patent owner filed a patent owner preliminary response arguing that the references relied upon in Xilinx's petition fail to disclose or suggest several elements required by the claims of the '334 patent. In its decision of June 27, 2013 instituting trial, the Board granted Xilinx's petition only in part.

Both the Xilinx petition and the Board's decision rely on the declaration of Dr. Buckman. Whatever may be Dr. Buckman's amount of knowledge in other fields, it became apparent during Dr. Buckman's deposition in the present case and in the *inter partes* review of related U.S. Patent No. 5,632,545 (hereinafter "the '545 patent") that he has less experience in the field of video projector systems. Several of the assertions made by Dr. Buckman in his declaration are inaccurate or simply incorrect. At the appointed time, patent owner expects to be filing a motion to exclude Dr. Buckman's testimony; absent that testimony, there would be no adequate evidentiary basis for the petitioner to carry its burden. But even if Dr.

Buckman's testimony is not excluded, the Board should give his testimony no weight.

Claims 1-6 and 11-14 of the '334 patent are patentable over the sole Xilinx challenge authorized by the Board. Specifically, the applied references fail to disclose or suggest at least the claimed "light-shutter matrix system comprising a number of equivalent switching matrices" or "video controller adapted for controlling the light-shutter matrix system." For the reasons discussed herein, patent owner submits that Claims 1-6 and 11-14 of the '334 patent are patentable and requests that the Board issue a final decision to that effect.

II. MATERIAL FACTS

Xilinx in its petition did not include a statement of material fact. Under Board Rule 42.23, patent owner presents below its statement of material fact.

1. At his deposition on August 7, 2013, petitioner's witness Dr. Buckman admitted that he has not taught or wrote about the topic of "video projection." (Ex. 2010, page 44, lines 2-8).
2. At his deposition on August 7, 2013, petitioner's witness Dr. Buckman admitted that none of his publications have "focused on liquid crystal displays." (Ex. 2010, page 44, lines 9-13).

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