

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 IPR2013-00112  
Patent 5,779,334

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INTELLECTUAL VENTURES' PATENT OWNER REPLY TO XILINX'S  
OPPOSITION TO MOTION TO AMEND

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## I. THE MOTION COMPLIES WITH THE LAW

### A. A Substitute Claim Can “Either Include or Narrow” Each Feature

In Paper 31, Xilinx argues that the amendment “adds new limitations to existing claims without narrowing any of the existing limitations.” (Opp. at 3).

However, *Idle Free* held that a substitute claim can “**either** include **or** narrow each feature of the challenged claim being replaced.” (*Idle Free* at 5; emphasis added).

Here, Xilinx concedes that proposed “claim 15 **includes** the limitation of claim 3.”

(Opp. at 3; emphasis added). Thus, *Idle Free*’s “either . . . or” requirement is

satisfied because proposed claim 15 includes each element of original claim 3. As

for proposed claim 16, Xilinx argues that patent owner’s motion should be denied

because claim 16 “does not even include any of the limitations of claim 12.” (Opp.

at 3). Nevertheless, proposed claim 16 depends from original claim 11 and is thus

necessarily narrower than that independent claim. Xilinx does not argue otherwise.

Claim 16 does “not enlarge the scope” of the patent claims, and thus complies with

the statute, 35 U.S.C. § 316(d)(3), which non-precedential *Idle Free* cannot trump.

### B. Patent Owner’s “Ordinary Meaning” Statement Suffices

Xilinx wrongly asserts that a motion to amend “must include” a claim construction for new terms. (Opp. at 6). But no Board rule so requires (*see, e.g.*,

Bd. R. 42.20 and 22) and *Idle Free* states merely that a patent owner “should . . .

includ[e] construction of new claim terms.” *Idle Free* at 7. The Board did not say

that new terms must be construed in all cases. Indeed, the Board’s “should” stands in marked contrast to Xilinx’s “must.” The Board’s Trial Practice Guide clarifies that a party “should provide” a proposed construction “where a party believes that a specific term has meaning other than its plain meaning.” 77 Fed. Reg. 48756, 48764, item 6 (Aug. 14, 2012) (Emph. added). Where, as here, a party believes that the plain meaning suffices, no claim construction is required. Rather, the focus of the Board’s inquiry is on whether a patent owner has “sufficient[ly] . . . persuade[d] the Board that the proposed substitute claim is patentable.” *Idle Free* at 7.

Here, in Paper 27, patent owner’s motion explicitly states that “the claim elements should receive the broadest reasonable construction in accordance with their plain and ordinary meaning to a person of ordinary skill in the art, in light of the specification and prosecution history.” (Mot. at 9). In addition, patent owner cited to and quoted specific portions of the original disclosure showing how the inventor used the claim terms in the context of his invention. *Id.* at 9-11. These citations, along with the motion’s detailed comparison of the claims and the prior art (Mot. at 11-15), are sufficient to enable the Board to decide that the prior art fails to disclose elements from proposed claims 15 and 16.

## II. CLAIMS 15 AND 16 ARE PATENTABLE

### A. Claim Construction

Xilinx’s proposed claim constructions are unsupported and overbroad – not

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