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Paper 38
Entered: September 15, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTEL CORPORATION and XILINX, INC.[1],
Petitioner,

v.

FG SRC LLC,
Patent Owner.

IPR2020-01449
Patent 7,149,867 B2

Before KALYAN K. DESHPANDE, *Senior Lead Administrative Patent Judge*, GREGG I. ANDERSON and KARA L. SZPONDOWSKI, *Administrative Patent Judges*.

SZPONDOWSKI, *Administrative Patent Judge*.

PRELIMINARY GUIDANCE
PATENT OWNER'S MOTION TO AMEND

[1] Xilinx, Inc. filed a motion for joinder and petition in IPR2021-00633, which were granted, and, therefore, has been joined as petitioner in this proceeding.

I. INTRODUCTION

On March 3, 2021, we instituted trial of claims 1–19 of U.S. Patent No. 7,149,867 B2 (the "'867 patent"). Paper 13 ("Inst. Dec."). After institution, FG SRC LLC ("Patent Owner") filed a Patent Owner's Motion to Amend.[2] Paper 26 ("Motion" or "Mot."). In its Motion, Patent Owner proposes that we amend the '867 patent to replace claims 1–19 with substitute claims 20–38. Mot. 2, 4, 8, 10, 18. Patent Owner submitted a declaration of William Mangione-Smith, Ph.D., in support of its Motion. Ex. 2027. Intel Corporation ("Petitioner") filed an Opposition to the Motion to Amend. Paper 36 ("Opposition" or "Opp."). Petitioner submitted a declaration of Stanley Shanfield, Ph.D., in support of its Opposition. Ex. 1034.

In the Motion, Patent Owner requests that we provide preliminary guidance regarding the Motion in accordance with the Board's pilot program concerning motion to amend practice and procedures. Mot. 2; *see also* Notice Regarding a New Pilot Program Concerning Motion to Amend Practice and Procedures in Trial Proceedings under the America Invents Act before the Patent Trial and Appeal Board, 84 Fed. Reg. 9,497 (Mar. 15, 2019) (providing a patent owner with the option to receive preliminary guidance from the Board on its motion to amend) ("Notice"). We have considered Patent Owner's Motion and Petitioner's Opposition.

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[2] Patent Owner filed a timely Response on July 2, 2021, addressing the original claims of the '867 patent. *See* Paper 34; *see also* Paper 32 (revising due date No. 1). Accordingly, we construe Patent Owner's Motion to Amend to be contingent on a finding that the "a preponderance of the evidence establishes that the original patent claim it replaces is unpatentable." *Lectrosonics, Inc. v Zaxcom, Inc.*, Case IPR2018-01129, Paper 15 at 3 (PTAB Feb. 25, 2019) (precedential).

In this Preliminary Guidance, we provide information indicating our initial, preliminary, and non-binding views on whether Patent Owner has shown a reasonable likelihood that it has satisfied the statutory and regulatory requirements associated with filing a motion to amend in an *inter partes* review and whether Petitioner (or the entirety of the record) establishes a reasonable likelihood that the substitute claims are unpatentable. *See* 35 U.S.C. § 316(d) (2018); 37 C.F.R. § 42.121 (2019); *Lectrosonics*, Paper 15; *see also* Notice, 84 Fed. Reg. at 9,497 ("The preliminary guidance . . . provides preliminary, non-binding guidance from the Board to the parties about the [motion to amend].").

For purposes of this Preliminary Guidance, we focus on the proposed substitute claims, and specifically on the amendments proposed in the Motion. *See* Notice, 84 Fed. Reg. at 9,497. We do not address the patentability of the originally challenged claims. *See* Notice, 84 Fed. Reg. at 9,497. Moreover, in formulating our preliminary views on the Motion and Opposition, we have not considered the parties' other substantive papers on the underlying merits of Petitioner's challenges. We have considered, however, our Institution Decision (Paper 13) in determining whether the amendments "respond to a ground of unpatentability involved in the trial." *Lectrosonics*, Paper 15 at 5. We emphasize that the views expressed in this Preliminary Guidance are subject to change upon consideration of the complete record, including any revision to the Motion filed by Patent Owner. Thus, this Preliminary Guidance is not binding on the Board when rendering a final written decision. *See* Notice, 84 Fed. Reg. at 9,500.

II. PRELIMINARY GUIDANCE

A. *Statutory and Regulatory Requirements*

For the reasons discussed below, at this stage of the proceeding, and based on the current record, it appears that Patent Owner has not shown a reasonable likelihood that it has satisfied the statutory and regulatory requirements associated with filing a motion to amend.

1. Reasonable Number of Substitute Claims

Does Patent Owner propose a reasonable number of substitute claims? (35 U.S.C. § 316(d)(1)(B))
Yes. Patent Owner proposes no more than 1 substitute claim for each originally challenged claim. Mot. 2, 12–15, 18–22. Petitioner does not argue otherwise. *See generally* Opp.

2. Respond to Ground of Unpatentability

Does the Motion respond to a ground of unpatentability involved in the trial? (37 C.F.R. § 42.121(a)(2)(i))
Yes. Patent Owner responds to a ground of unpatentability at pages 5–11 of the Motion. At this stage of the proceeding, upon review of Patent Owner's arguments, we agree that proposed substitute independent claims 20, 28, and 32 recite new limitations and new combinations of limitations that directly respond to a ground of unpatentability involved in the trial. *See* Mot. App. A. Petitioner contends the Motion does not respond to a ground of unpatentability. *See* Opp. 6–7, 20, 22–23. In particular, Petitioner argues that the following added limitations proposed by Patent Owner do not respond to any ground of unpatentability: (1) for substitute claim 20, "the data prefetch unit transfer[ring] only computational data required by the algorithm from a second memory . . . and plac[ing] the computational data in the first memory"; (2) for substitute claim 28, "a data prefetch unit to read data, including computational data, and write only computational data required for computations by the algorithm between the data prefetch unit and the common memory"; and

(3) for substitute claim 32, "the computational unit and the data access unit, and the data prefetch unit . . . transfer[ring] only data necessary for computations by the computational unit to the data access units." Mot., App. A; *see* Opp. 6–7, 20, 22–23.

For example, Petitioner argues the above-mentioned limitations proposed by Patent Owner do not have "any relationship to the instituted grounds or prior art" and "cannot possibly be responsive to any ground of unpatentability." *See* Opp. 6, 20, 22–23.

On the current record, Petitioner's arguments are unpersuasive for the following reasons. In the Petition, Petitioner argued that original claims 1, 9, and 13 of the '867 patent were unpatentable because (i) the combination of Zhang and Gupta teaches claim 1's "data prefetch unit [that] retrieves only computational data required by the algorithm from a second memory . . . and places the retrieved computational data in the first memory" (Pet. 36–40), (ii) the Zhang-Gupta-Chien combination's reconfigurable processor teaches claim 9's "data prefetch unit to read and write only data required for computations by the algorithm between the data prefetch unit and the common memory" (Pet. 85), and (iii) the combination of Zhang and Gupta teaches claim 13's "computational unit and the data access unit, and the data prefetch unit . . . transfer only data necessary for computations by the computational unit" (Pet. 67, 69). In our Institution Decision, we determined, for purposes of institution, the combination of Zhang and Gupta teaches claim 1's "data prefetch unit retrieves only computational data required by the algorithm from a second memory . . . and places the retrieved computational data in the first memory" (*see* Inst. Dec. 53–57) and claim 13's "computational unit and the data access unit, and the data prefetch unit . . . transfer only data necessary for computations by the computational unit" (*see* Inst. Dec. 64–65), and further determined the combination of Zhang, Gupta, and Chien teaches claim 9's "data prefetch unit to read and write only data required for computations by the algorithm between the data prefetch unit and the common memory" (*see* Inst. Dec. 72–73). In the Motion, Patent Owner explains that the added limitations in proposed substitute claims 20, 28, and 32 are "responsive to . . . ground[s] for institution." Mot. 5, 7–11. Particularly, Patent Owner explains the added limitations in proposed substitute claims 20 and 32 (which modify the limitations of original claims 1 and 13 discussed *supra*) respond to Petitioner's ground of unpatentability based on Zhang and Gupta, and the added limitation in

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