

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTELLECTUAL VENTURES MANAGEMENT, LLC
Petitioner

v.

XILINX, INC.
Patent Owner

Case IPR2012-00018 (SCM)
Patent 7,566,960

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

MEDLEY, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

On May 7, 2013, Xilinx filed a paper styled “PATENT OWNER’S
FIRST MOTION TO AMEND BY XILINX UNDER 37 C.F.R. § 42.121.”
Paper 19; “Motion to Amend.” The Motion to Amend fails to comply with

the rules and procedures governing *inter partes* reviews. As such, Administrative Patent Judges Medley, Arbes, and Easthom held a conference call on May 9, 2013, involving counsel for IVM and counsel for Xilinx, to explain the Motion to Amend defects and to provide Xilinx an opportunity to refile a substitute motion to amend.

A motion to amend claims must include a claim listing. 37 C.F.R. § 42.121(b). The rule contemplates that the claim listing be a part of the motion to amend, and not filed as a separate paper. Thus, the listing of claims is included in the 15 page limit set forth per 37 C.F.R. § 42.24 (a)(1)(v) for motions.

Xilinx's Motion to Amend does not include a claim listing. Rather, Xilinx filed the claim listing as an exhibit. Ex. 2009. However, by doing so, Xilinx circumvented the motion page limit. The Motion to Amend is *dismissed* without prejudice to refile a "Substitute Patent Owner's Motion to Amend." The Board recognizes that by including the 13 substitute claims as part of the substitute motion to amend, Xilinx will exceed the 15 page limit. Based on the facts of this case, and due to the number of substitute claims, Xilinx's request for a five page extension for its substitute motion to amend is granted. In addition, and as explained, the substitute motion to amend must indicate that the motion to amend is contingent upon a Board determination that the original patent claims 1-13 are unpatentable. Xilinx is not authorized to make any other changes to the substitute motion without Board authorization.

Lastly, counsel for IVM inquired whether it need file a motion to file supplemental information if IVM relies on "new evidence" in support of any opposition it files to Xilinx's motion to amend. Petitioners may respond to

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new issues arising from proposed substitute claims including evidence responsive to the amendment. This includes the submission of new expert declarations that are directed to the proposed substitute claims. *See Office Patent Trial Practice Guide*, 77 Fed. Reg. 48756, 48767 (August 14, 2012). Thus, IVM need not file a separate motion to file supplemental evidence, provided that the evidence in support of IVM's opposition is relied upon to respond to new issues arising from the proposed substitute claims.

It is

ORDERED that "PATENT OWNER'S FIRST MOTION TO AMEND BY XILINX UNDER 37 C.F.R. 42.121" (Paper 19) is *dismissed* without prejudice for Xilinx to file a "Substitute Motion to Amend" in compliance with this order; and

FURTHER ORDERED that the substitute motion to amend is due by May 15, 2013.

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Via electronic transmission:

PETITIONER:

Michael D. Specht

Robert G. Sterne

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

mspecht@skgf.com

rsterne@skgf.com

PATENT OWNER:

David L. McCombs

Thomas B. King

HAYNES AND BOONE, LLP

David.mccombs@haynesboone.com

Thomas.king@haynesboone.com