

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTELLECTUAL VENTURES MANAGEMENT, LLC
Petitioner,

v.

XILINX, INC.
Patent Owner.

Case No. IPR2012-00023
Patent 7, 994,609
Case No. IPR2012-00020
Patent 8,058,897

Held: November 7, 2013

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

RECORD OF ORAL HEARING

APPEARANCES:

ON BEHALF OF THE PETITIONER:

LORI A. GORDON, ESQUIRE
ROBERT GREENE STERNE, ESQUIRE
OMAR AMIN, ESQUIRE
Sterne Kessler Goldstein Fox

1100 New York Avenue, N.W.
Washington, D.C. 20005

1 ON BEHALF OF THE PATENT OWNER:
2 DAVID M. O'DELL, ESQUIRE
3 DAVID L. McCOMBS, ESQUIRE
4 Haynes and Boone, LLP
5 2323 Victory Avenue, Suite 700
6 Dallas, Texas 75219
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9 The above-entitled matter came on for hearing on Thursday,
10 November 7, 2013, commencing at 1:30 p.m., at the U.S. Patent and
11 Trademark Office, 600 Dulany Street, Alexandria, Virginia.
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15 P R O C E E D I N G S
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17 JUDGE MEDLEY: Good afternoon, everyone. This
18 is the hearing for IPR2012-0020 and IPR2012-00023. So, we'll
19 proceed first with the hearing in IPR2012-00020, and then we're
20 going to take a short break and let everybody reconvene and get
21 situated, and then we'll begin with the case for 00023.

22 So, at this time we would like the parties to please
23 introduce themselves, starting with the petitioner.

24 MS. GORDON: I'm Lori Gordon, I'll be arguing
25 today on behalf of the petitioner, Intellectual Ventures
26 Management. With me today is Robert Sterne, also from the law

1 firm of Sterne Kessler, and Omar Amin from the law firm of
2 Sterne Kessler.

3 JUDGE MEDLEY: Ms. Gordon, will you also be
4 arguing for 00023?

5 MS. GORDON: Yes.

6 JUDGE MEDLEY: For patent owner?

7 MR. O'DELL: Hello, my name is David O'Dell, I'm
8 with the law firm Haynes and Boone, I'll be representing the
9 patent owner XILINX. With me today is my co-counsel, David
10 McCombs, also with Haynes and Boone. Mr. McCombs will be
11 arguing for the first one, matter 00020, and then I will be
12 arguing for the second one, matter 00023.

13 JUDGE MEDLEY: Great. Okay, thank you.

14 So, as you recall from the order, each party gets 20
15 minutes total for the first case, for 00020, and each party may
16 reserve rebuttal time if they wish to.

17 So, we'll begin with the petitioner, and just let us
18 know would you like to reserve rebuttal time?

19 MS. GORDON: Yes, we would like to reserve ten
20 minutes.

21 JUDGE MEDLEY: Ten minutes, okay, great. You
22 may begin.

23 MS. GORDON: So, we've prepared demonstratives
24 that we may use to aid the discussion. We uploaded them, per

1 the order yesterday, to PRPS. We have extra copies if you need
2 them.

3 JUDGE MEDLEY: I think we're okay.

4 MS. GORDON: Okay, great, thank you.

5 So, there's two disputes that remain in this proceeding
6 between the parties. The first is whether dependent claims 2
7 through 7 are obvious over the Wennekamp reference. And the
8 second issue in dispute is whether independent claim 8 is
9 obvious over the combination of Wennekamp and Miller. Both
10 these issues are dispositive for all claims under review in this
11 proceeding.

12 So, turning to the first issue, whether claims 2
13 through 7 are obvious over Wennekamp. Claims 2 through 7
14 depend from claim 1. We'll put claim 1 up here for reference.
15 Patent owner does not dispute that claim 1 is unpatentable, based
16 on the grounds instituted for this trial; however, the only
17 distinction that patent owner is raising relative to dependent
18 claims 2 through 7 is that Wennekamp does not teach or suggest
19 a multi-die IC, and this is a limitation that's only recited in
20 independent claim 1, a claim that patent owner does not dispute
21 is unpatentable over either Wennekamp or the combination of
22 Wennekamp and Miller.

23 JUDGE MEDLEY: So, just let me interrupt you real
24 quickly. So, how should we reconcile that? So, we've read in
25 your papers that patent owner cancels claim 1 and then perhaps

1 they concede that claim 1 is unpatentable, but then they argue
2 that claims 2 through 7, which depend on 1, are patentable over
3 the prior art, based on a feature that is in the cancelled claim 1.
4 So, how is the Board to reconcile that?

5 MS. GORDON: Right, and we also struggle with how
6 to reconcile that. We note that claim 1, there were two grounds
7 of rejection to claim 1, whether it was obvious over Wennekamp,
8 standing alone, or obvious over Wennekamp in view of Miller.
9 Our only way we can make this have any sense is that patent
10 owner may be conceding that the combination of Wennekamp
11 and Miller renders claim 1 unpatentable; however, that they don't
12 believe that Wennekamp standing on its own renders claim 1
13 unpatentable.

14 JUDGE MEDLEY: Okay, and we'll, of course, have
15 an opportunity to ask patent owner their position on that. Thank
16 you.

17 MS. GORDON: So, we're proceeding to address the
18 substance of patent owner's position. So, as we said, the patent
19 owner isn't individually arguing any of the features of the
20 dependent claims 2 through 7.

21 The evidence of record in this case, both from
22 Intellectual Ventures Management's expert, Morgan Johnson, and
23 patent owner's expert establishes, in fact, that a person of
24 ordinary skill in the art would have and could have modified the
25 Wennekamp reference as set forth by the petitioner. So, there's

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