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Paper 14
Entered: March 18, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTELLECTUAL VENTURES MANAGEMENT, LLC
Petitioner

v.

XILINX, INC.
Patent Owner

Case IPR2012-00023
Patent 7,994,609

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 March 14, 2013, the following individuals participated in the

initial conference call:[1]

(1) Ms. Lori Gordon and Mr. Robert Sterne, counsel for IVM;

(2) Mr. David O'Dell, Mr. David McCombs and Mr. Thomas King, counsel for Xilinx; and

(3) Sally Medley, Justin Arbes, and Karl Easthom, Administrative Patent Judges.

In preparation for the initial call, patent owner Xilinx filed a motions list. Paper 13. During the call, and consistent with the list, counsel for Xilinx represented that Xilinx intends to file a motion to amend. The parties were directed to the Patent Trial Practice Guide for guidance on motions to amend. *See*, Office Patent Trial Practice Guide, 77 Fed. Reg. 48766-48767.

More specifically, in any motion to amend Xilinx files, the motion must explain how the proposed substitute claims obviates the grounds of unpatentability authorized in this trial and clearly identify where corresponding written description support in the specification can be found. If the motion to amend includes a proposed substitution of claims beyond a one-for-one substitution, the motion must explain why more than a one-for-one substitution of claims is necessary. 37 C.F.R. § 42.121. In addition and in response to inquiry from counsel for IVM, the parties were directed to the Patent Trial Practice Guide that explains that petitioners may respond to new issues arising from proposed substitute claims including evidence responsive to the amendment. 77 Fed. Reg. 48766, 48767.

IVM indicated that they do not seek authorization to file any motions

[1] The initial conference call is held to discuss the Scheduling Order and any motions that the parties anticipate filing during the trial. Office Patent Trial Practice Guide, *77 Fed. Reg.* 48756, 48765 (Aug. 14, 2012).

at this time.

Counsel for the respective parties indicated that they have no issues with the Scheduling Order (Paper 12) entered on February 12, 2013. Lastly, the parties represented that they have no report regarding settlement.

PETITIONER:

Via electronic transmission:

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