

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTELLECTUAL VENTURES MANAGEMENT, LLC
Petitioner

v.

Patents of XILINX, INC.
Patent OWNER

Cases IPR2012-00018 (Patent 7,566,960)
IPR2012-00019 (Patent 8,062,968)
IPR2012-00020 (Patent 8,058,897) and
IPR2012-00023 (Patent 7,994,609)¹

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

MEDLEY, *Administrative Patent Judge*.

DECISION
Real Party in Interest
37 C.F.R. § 42.8

¹ This decision addresses an issue that is identical in all four cases. Therefore, we exercise discretion to issue one opinion to be filed in each of the four cases. The parties, however, are not authorized to use this style heading in subsequent papers since doing so may cause confusion.

INTRODUCTION

Intellectual Ventures Management, LLC (IVM) filed four separate petitions to institute *inter partes* reviews of U.S. Patent 7,566,960, U.S. Patent 8,062,968, U.S. Patent 8,058,897 and U.S. Patent 7,994,609. Each of the four patents is the subject of a separate proceeding.² The Patent Owner of all four patents is Xilinx, Inc. In each proceeding, Xilinx, Inc. filed a preliminary response, making an identical argument; that IVM's petitions should be denied or dismissed because each fails to identify all of the real parties in interest. (*See, e.g.*, IPR2012-00018, Paper 10 at 5-9). This decision addresses Xilinx's real party in interest argument by which we are not persuaded.^{3,4}

ANALYSIS

As part of its petition submission, Petitioner identifies Intellectual Ventures Management, LLC as the real party in interest. (Paper 3). In its patent owner preliminary response, Xilinx argues that IVM's petition should be denied or dismissed because it fails to identify all of the real parties in interest as required by 37 C.F.R. § 42.8(b)(1). (Paper 10 at 5-9).

A petition for *inter partes* review may be considered only if, among other requirements, the petition identifies all real parties in interest. 35 U.S.C. §

² As the style heading indicates, U.S. Patent 7,566,960 is the subject of IPR2012-00018, U.S. Patent 8,062,968 is the subject of IPR2012-00019, U.S. Patent 8,058,897 is the subject of IPR2012-00020 and U.S. Patent 7,994,609 is the subject of IPR2012-00023.

³ No other decision is made herein on the other issues raised in the corresponding petitions or patent owner preliminary responses for the four *inter partes* proceedings. Rather, those issues will be addressed in separate, forthcoming, decisions.

⁴ For the purpose of clarity and expediency, IPR2012-00018 is representative and all citations are to IPR2012-00018 unless otherwise noted.

312(a)(2). The Trial Practice Guide provides guidance regarding factors to consider in determining whether a party is a real party in interest. Considerations may include whether a non-party exercises control over a petitioner's participation in a proceeding. Other considerations may include whether a non-party is funding the proceeding or directing the proceeding. 77 Fed. Reg. 157 (August 14, 2012) 48759-60.

Xilinx directs attention to Exhibit 2005 as evidence that IVM is not the only real party in interest in the proceeding. (Paper 10 at 8). Exhibit 2005 is a copy of a certificate of interested entities or persons pursuant to Civil Local Rule 3-16 of the Northern District of California and Federal Rule of Civil Procedure 7.1, filed by six defendants (one of which is IVM) in an unrelated district court proceeding.⁵ Exhibit 2005 identifies 63 entities purportedly (i) having a financial interest in the subject matter in controversy or in a party to the proceeding, or (ii) having a non-financial interest in that subject matter or in a party that could be substantially affected by the outcome of the proceeding. (Ex. 2005 at 2).

Xilinx has not sufficiently shown the relevance of Exhibit 2005 to the facts of this case. Xilinx has not demonstrated that the considerations of whether a non-party is a real party in interest for an *inter partes* review proceeding are the same or even similar to those considerations or requirements of Civil Local Rule 3-16 and Federal Rule of Civil Procedure 7.1. For example, Federal Rule of Civil Procedure 7.1 requires, among other things, that a nongovernmental corporate party, in a civil action, file a disclosure statement that identifies any parent corporation and any publicly held corporation owning 10% or more of its stock. Fed. R. Civ. P. 7.1(a).

⁵ *Xilinx, Inc. v. Invention Investment Fund I LP, et al.*, N.D. Cal. Case No. 5:11-cv-00671-SI. The case is not listed by either IVM or Xilinx as a related matter to the proceeding before us. (Paper 3 at 1 and Paper 9 at 1).

Civil Local Rule 3-16 for the Northern District of California, requires a party to file a certificate of entities (i) having a financial interest in the subject matter in controversy or in a party to the proceeding, or (ii) having a non-financial interest in that subject matter or in a party that could be substantially affected by the outcome of the proceeding. Xilinx has not shown how the above requirements are the same or even similar in kind to the factors to consider outlined in the Trial Practice Guide regarding real parties in interest in proceedings such as the one before us. No analysis in that regard has been made.

Moreover, the subject matter and issues in the district court case are different than the subject matter and issues of the four *inter partes* review proceedings. (Exhibit 3001).⁶ The Board will not assume, as Xilinx seems to suggest, that the 63 listed entities (which includes Xilinx itself) and five other “similarly named” defendants in the district court proceeding should be named as real parties in interest for Petitioner. (Paper 10 at 8-9). Xilinx has not shown any basis for even one of the 63 entities being a real party in interest in the four proceedings. It would be speculative for the Board to attempt to sort it out without something more. IVM has disclosed their real party in interest. Xilinx challenges that disclosure and as such must come forward with sufficient evidence to demonstrate that IVM’s disclosure is inadequate. That Xilinx has failed to do.

For all of these reasons, Xilinx has failed to sufficiently demonstrate that IVM has not named all real parties in interest for any of the four proceedings.

⁶ Ex. 3001 at 3-32. Exhibit 3001 is a copy of the complaint which has been entered into the electronic record.

Petitioner:

Michael Specht

Lori Gordon

Robert Sterne

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

MSPECHT@skgf.com

LGORDON@skgf.com

RSTERNE@skgf.com

Patent Owner:

David L. McCombs

David O'Dell

Thomas B. King

HAYNES and BOONE, LLP

david.mccombs@haynesboone.com

david.odell@haynesboone.com

thomas.king@haynesboone.com