Paper No. 53

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VALVE CORPORATION,
Petitioner,

v.

IRONBURG INVENTIONS LTD.,
Patent Owner.

Case:

IPR2016-00948 (Patent 8,641,525)

REPLY RE: REQUEST FOR REHEARING UNDER 37 CFR § 42.71(d)

Ironburg incorrectly conflates the broadest reasonable interpretation (BRI) standard with ordinary meaning. *See,* Paper 51 at 4. For example, Ironburg complains that the petition's construction "was not asserted to be a plain or ordinary meaning of 'flexible' and was not asserted to be a special meaning of the term." *Id.* Hence, Ironburg essentially complains that the petition did not follow *Phillips v. AWH Corp.,* 415 F.3d 1303 (Fed. Cir. 2005) in construing "flexible."

But the Supreme Court has upheld the applicability of BRI in *inter-partes* review proceedings, relying in part on the same standard being applicable during patent examination. *See, Cuozzo Speed Technologies, LLC v. Lee,* 136 S. Ct. 2131, 2146 (2016). The BRI standard can properly lead to a substantially broader claim interpretation than ordinary meaning (the starting point for a construction under *Phillips*). *See, e.g., PPC Broadband, Inc. v. Corning Optical Commc'ns RF, LLC*, 815 F.3d 734, 741-743 (Fed. Cir. 2015) (holding that the Board's broader interpretation of "continuity member" was correct under *Cuozzo* as the BRI in light of the subject patent's specification, even though the ordinary meaning of the term under *Phillips* would have been significantly narrower).

Conflating BRI and ordinary meaning leads Ironburg to allege that Valve "studiously avoided" flexibility in its petition. Paper 51 at 4. But Valve expressly, broadly, and reasonably interpreted flexible "to mean that the elongated member can be moved to a biased position by a user's finger." Paper 4 at 14. Indeed, the teachings of the '525 specification support such a displaceability interpretation of

"flexible" in this case. *See,* Request for Rehearing (Paper 45) at 3-4, quoting the '525 Patent at 1:59-61, and at 4:17-20. Consistently, the '525 patent expressly defines "resilient" as returning "to an unbiased *position*" rather than returning to an unbiased *shape*. '525 Patent at 3:33-35.

Hence, Valve was never legally required to recite the well-known ordinary meaning of "flexible" in its original petition, and it was proper – and correct – for Valve to instead expressly assume a construction that corresponded to BRI. It was also proper for Valve's subsequent Reply (Paper 23) to react to arguments raised in the Patent Owner's Response (Paper 19) leveraging the Board's *sua sponte* adoption of a later-identified dictionary definition (Ex. 3001). *See,* 37 CFR § 42.23(b). Tellingly, only *after* the Board formulated its own narrower construction of "flexible" did the Patent Owner first allege deficiency in the petition's showing of how Enright met that claim term. *See,* Paper 19 at 39-41.

The Petitioner respectfully submits that the Board's construction of "flexible," which both parties recognize as an "ordinary meaning" (*see*, Paper 51, at 1-2, and 5), was in error because it is narrower than BRI in this case. *See,* Request for Rehearing (Paper 45) at 3-5. Even if the Board decides to maintain its construction of "flexible," the Petitioner requests that the Board reach the merits of the arguments (under the Board's construction) in section IV.D. of the Petitioner's Reply (Paper 23, pages 14-15). *See,* Request for Rehearing (Paper 45) at 8-9.

Dated: 08 January 2018

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that on 2018-01-08 a true copy of the foregoing PETITIONER'S REPLY TO THE PATENT OWNER RESPONSE was served on the Patent Owner electronically via PTAB E2E to:

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