

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 B2

Before PHILLIP J. KAUFFMAN, MEREDITH C. PETRAVICK, and
MITCHELL G. WEATHERLY, *Administrative Patent Judges*.

KAUFFMAN, *Administrative Patent Judge*.

DECISION
Denying Petitioner's Request for Rehearing
37 C.F.R. § 42.71

I. INTRODUCTION

Valve Corporation (“Petitioner”) requests rehearing of our Final Written Decision (Paper 44, “Decision,” or “Dec.”) in this case. Paper 45 (“Reh’g Req.”). Specifically, Petitioner asks that we: (1) reconsider and adopt the construction of “flexible” proposed in the Petition, (2) consider Section IV.D. of the Petitioner’s Reply, (3) determine that claims 1–11, 13, 16, and 17 are obvious over Enright and Tosaki, and (4) correct three typographical errors.¹ *Id.* at 1.

Patent Owner submits a response asking that we deny Petitioner’s request, and Petitioner submits a reply. Paper 51 (“Resp.”); *see also* Paper 47 (authorizing Paper 51); Paper 53 (“Reply”); *see also* Paper 52 (authorizing Paper 53).

We reconsider whether Petitioner has demonstrated that claims 1–11, 13, 16, and 17 are obvious over Enright and Tosaki in light of the record, to include Section IV.D. of Petitioner’s Reply.

II. ANALYSIS

A. OVERVIEW

Claim 1 recites that each elongate member is “inherently resilient and flexible.” Claims 2–19 include this limitation by virtue of dependence from claim 1.

¹ We previously corrected the typographical errors pointed out by Petitioner. *See* Paper 46. Accordingly, we deny this portion of Petitioner’s request as moot.

In our Final Written Decision, we determined an elongate member as claimed is inherently resilient in that it will return to its unbiased position when not under load, and it is flexible in that it may be bent or flexed by a load (e.g., from a user’s finger).² Dec. 36. This meaning of flexible is the ordinary meaning that is consistent with the Specification. *Id.* In the Final Written Decision, we did not consider Section IV.D. of Petitioner’s Reply because Petitioner had not addressed in the Petition that the elongate members are flexible. *Id.* at 37–38.

Petitioner does not dispute our interpretation of “inherently resilient;” rather, Petitioner contests our interpretation of the term “flexible.”

In the Petition, Petitioner contends that the term “flexible” means that the elongated member “can be moved to a biased position by a user’s fingers.” Paper 1 (“Pet.”) 14. In the Request for Rehearing, Petitioner contends that the Petition correctly asserted that “flexible” as claimed is broad enough to “encompass merely allowing displacement.” Reh’g Req. 3. According to Petitioner, the Board’s construction of “flexible” does not have support in the intrinsic record because the ordinary meaning of “flexible” is not found in the language of ’525 patent or supported by the drawings. *Id.* at 4–5. Petitioner contends that the Petition made a *prima facie* case that Enright’s elongate members are “flexible” as claimed based on Petitioner’s claim interpretation, and for that reason we should have considered Section

² Our claim interpretation in the Final Written Decision is consistent with our interpretation in the institution decision, and for that reason, Petitioner’s analogy to *SAS Institute, Inc. v. ComplementSoft, LLC*, 825 F.3d 1341 (Fed. Cir. 2016) is unpersuasive. *Compare* Dec. 36–37 with Paper 10 (Institution Decision), 14; Reh’g Req. 7.

IV.D. of Petitioner’s Reply, which responds to arguments in Patent Owner’s Response. *Id.* at 5–8.

B. “FLEXIBLE”

For two reasons, we cannot agree with Petitioner’s contention that “flexible” means “can be moved to a biased position by a user’s fingers” and is broad enough to cover merely allowing displacement.

Petitioner asks that we deviate from the ordinary meaning of “flexible,” yet neither identifies a lexicographical definition nor alleges that the prosecution history warrants such a deviation. *See* Resp. 1–2, 4–5 (pointing out that Petitioner’s attempt to deviate from ordinary meaning is not well supported); *see also* Reply 2 (contending that the broadest reasonable interpretation of “flexible” is broader than its ordinary meaning, but not providing a reason for departing from ordinary meaning). Further, Petitioner’s suggestion that the ordinary meaning of a claim term must be expressly stated in the disclosure is incorrect and does not warrant deviation from the ordinary meaning of a term. The proper inquiry, as applied in both our Institution Decision and our Final Written Decision, is whether the ordinary meaning of a claim term is consistent with the specification. *See* Dec. 36–37; Paper 10, 13–14; *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989) (the words of the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification); Resp. 7.

Second, Petitioner agrees that “inherently resilient” as claimed means that the elongate member will return to its unbiased position when not under load. Being capable of returning to an unbiased position when not under load of necessity includes being capable of being moved to a biased position

under load. In other words, inherent resiliency requires that the elongate member may be moved to a biased position under load and then returns to an unbiased position when not under load. Inherent resiliency and flexibility as claimed are different characteristics. For example, an elongate member formed of hard plastic that could be biased/displaced by a user's finger to activate a switch mechanism and then return to an unbiased position would be inherently resilient. That same elongate member formed of hard plastic would not itself bend or flex, and therefore would not be flexible as required by claim 1.

C. "FLEXIBLE" IS A CHARACTERISTIC OF THE ELONGATE MEMBERS

Significantly, whatever the claim term "flexible" means, it is a characteristic of the elongate member, and an elongate member as claimed is a distinct element from a switch mechanism. We interpret that the term "inherently" modifies both "resilient" and "flexible," but even if it does not, for the reasons that follow, "flexible" is a characteristic of the elongate member itself.

Claim 1 is directed to a controller that has a first and a second back control, and those controls include an elongate member that is inherently resilient and flexible.

Dependent claims 9, 10, and 11 further limit the elongate member of claim 1 to a specified thickness.

Dependent claim 14 further limits claim 1 to require the first and second controls to each be in registry with a switch mechanism so that displacement of at least one control activates the switch mechanism.

Dependent claim 15 further limits claim 1 to add a switch mechanism

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