Paper No. 23

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

PETITIONER'S REPLY TO THE PATENT OWNER'S RESPONSE

Mail Stop: PATENT BOARD Patent Trial and Appeal Board U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450

DOCKET A L A R M Find authenticated court documents without watermarks at <u>docketalarm.com</u>.

TABLE OF CONTENTS

	Exhi	Exhibit Listv	
I.	INTI	INTRODUCTION1	
II.	CLAIM CONSTRUCTION1		
	A.	Relevant law1	
	B.	Technology overview1	
	C.	"Hand-held" should be afforded the full scope of its ordinary meaning1	
	D.	The Patent Owner unnecessarily and improperly imports a hand-held requirement from different claim language into the phrase "located at the back of the controller."	
	E.	The Patent Owner improperly imports description about a particular embodiment into the claim term "recess."	
	F.	The Board should decline to correct the erroneous claim phrase: "elongate members converge towards the front end of the controller with respect to one another."	
III.	PATENT OWNER'S ARGUMENTS DO NOT NEGATE ANTICIPATION BY TOSAKI7		
	A.	Tosaki discloses a hand-held controller that is held in and operated by both hands of a user7	
	B.	Tosaki discloses elongate members located on a back of the controller	
	C.	Tosaki discloses elongate members that converge in the same manner as in the only disclosed embodiment of the '525 patent	

DOCKET A L A R M Find authenticated court documents without watermarks at <u>docketalarm.com</u>.

IV.	CLAIMS 1-11, 13, 16, 17, AND 20 ARE UNPATENTABLE OVER ENRIGHT IN VIEW OF TOSAKI		
	A.	Legal standard for combining references12	
	B.	Level of Ordinary Skill in the Art12	
		1. The Patent Owner confirms a senseless qualification to be considered as a POSITA	
		2. The UK Examiner is a POSITA	
	C.	Patent Owner mischaracterizes Petitioner's challenge, by assuming whole Tosaki structures need be transplanted into Enright	
	D.	Enright discloses elongate back controls that are inherently resilient and flexible14	
	E.	Patent Owner mischaracterizes Petitioner's challenge, by assuming whole Tosaki structures need be transplanted into Enright	
		1. The instituted challenge does not require the arched openings of Tosaki to be transplanted into Enright	
		2. Petitioner's challenge relies upon the existing structure of Enright's mode switches, and uses Tosaki only for the suggestion to make them longer	
		3. Tosaki is analogous art19	
		4. Petitioner's challenge is not based on impermissible hindsight20	
	F.	Petitioner's proposed modification of Enright would not change its principle of operation, nor render it inoperable	
	G.	For enablement and written description support, the '525 patent applicants relied upon the optional "paddle lever" being common	

	knowledge.	24
V.	CLAIM 18 IS UNPATENTABLE OVER ENRIGHT IN VIEW OF TOSAKI, AND FURTHER IN VIEW	
	OF OELSCH	25
VI.	CONCLUSION	

EXHIBIT LIST

Exhibit No.	Description
1001	U.S. Patent 8,641,525 to Burgess et al. (" '525 patent")
1002	U.S. Patent 5,989,123 to Tosaki et al. ("Tosaki")
1003	U.S. Patent App. Pub. 2010/0073283 to Enright ("Enright")
1004	U.S. Patent App. Pub. 2001/0025778 to Ono
1005	"Rapid Fire Mod for Wireless Xbox 360 Controller, Step by Step
	Tutorial with Pictures," posts 341-346 by Jimakos Sn, published
	08 July 2008 at http://forums.xbox-
	scene.com/index.php?/topic/643928-rapid-fire-mod-for-wireless-
	xbox-360-controller/page-23.
1006	U.S. Patent 4,032,728 to Oelsch ("Oelsch")
1007	UK Search and Examination Report for Patent App. No.
	GB1011078.1, 16 May 2011, at 2.
1008	Expert Declaration of David Rempel, M.D., in Support of Valve
	Corporation's Petition for Inter-Partes Review of U.S. Patent
	8,641,525.
1009	Curriculum Vitae of David Rempel, M.D. (also denominated as
	Ex. 1 to Ex. 1012).
1010	Photo of the Wireless Xbox 360 Controller, published on 13 May
	2005 at http://www.ign.com/articles/2005/05/13/xbox-360-
	wireless-controller-tour.
1011	U.S. Patent 9,089,770 to Burgess et al. (" '770 patent")
1012	Expert Declaration of David Rempel, M.D., in Support of Valve
	Corporation's Petition for Inter-Partes Review of U.S. Patent
1012	9,089,770.
1013	Declaration of Joshua C. Harrison.
1014	Diagram used in deposition of Dr. Glen Stevick, 09 March 2017.
(not filed)	
1015	Shape 1, used in deposition of Dr. Glen Stevick, 09 March 2017.
(not filed)	
1016	Shape 2, used in deposition of Dr. Glen Stevick, 09 March 2017.
(not filed)	

DOCKET A L A R M



Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.