UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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VALVE CORPORATION,

Petitioner,

v.

IRONBURG INVENTIONS LTD.,

Patent Owner.

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Cases

IPR2016-00948 (Patent 8,641,525 B2)

IPR2016-00949 (Patent 9,089,770 B2)

PATENT OWNER'S OBJECTIONS TO EVIDENCE RELIED UPON IN PETITIONER'S REPLY

Pursuant to 37 C.F.R. § 42.64(b)(1), Patent Owner Ironburg Inventions Ltd. ("Patent Owner") submits the following objections to evidence relied upon by Petitioner Valve Corporation ("Petitioner") in Petitioner's Reply to the Patent Owner Response, which was filed on March 28, 2017.

Patent Owner's objections are as follows:

EXHIBIT 1007 – Hearsay (FRE 802), Authentication (FRE 901), Relevance (FRE 402), Confusion/Misleading (FRE 403)

Patent Owner objects to Exhibit 1007 as containing inadmissible hearsay, pursuant to Fed. R. Evid. 802. If, as here, an exception does not apply, the rule against hearsay operates to prohibit out-of-court statements from being offered to prove the truth of the matter asserted. Fed. R. Evid. 801–803.

Here, Exhibit 1007 is inadmissible hearsay evidence including specific statements by a UK examiner, Mr. Donohue, in an unrelated application. Petitioner quotes the UK examiner's statements as follows:

> "***It is extremely well known in the art to modify gamepads to suit the requirements of a particular game or gamer.*** […] The features defined in your claims are typical features of gamepad controls/buttons. As evidenced by the documents listed above, the skilled person would consider them as nothing more than routine modifications or variations to literally any gamepad. Moreover, ***the skilled person would find it entirely obvious to modify or tailor a given conventional gamepad to suit the needs of any individual, and***

> ***would possess (or have ready access to) the skills and knowledge required to do so***." Petitioner's Reply to the Patent Owner Response, IPR2016-00949, Paper 24 at 22 (March 28, 2017) (emphasis in original); Petitioner's Reply to the Patent Owner Response, IPR2016-00948, Paper 23 at 21 (March 28, 2017) (emphasis in original).[1]

In reliance on this out-of-court statement, Petitioner concludes in its Reply that "[e]vidently such modifications were typically obvious to a POSITA without hindsight, and implemented successfully. That is corroborated by a timely description of the state of the video game controller art by Mr. Donohoe, a POSITA speaking for the UK Intellectual Property Office …" *Id.*

Petitioner offered the statement to prove the truth of the matter asserted therein. Specifically, this Exhibit 1007 is hearsay because Petitioner is using the out-of-court statements to prove what was known in the art at the time of the invention. Here, the UK examiner's statement is not prior art, not from before the application was filed, not sworn testimony, and is therefore hearsay not subject to any hearsay exception. *See, e.g., Standard Innovation Corp. v. Lelo, Inc.*, IPR2014-00148, Paper 41 at 13-15 (April 23, 2015) (hearsay statements not subject to exceptions were found inadmissible in PTAB proceeding).

Patent Owner also objects to Exhibit 1007 as lacking proper authentication

[1] This statement was previously objected to by Patent Owner on November 1, 2016 under hearsay (FRE 802), authentication (FRE 901), and relevance (FRE 402). Petitioner re-stated the UK Examiner's out-of-court statements in its Reply, which Patent Owner now objects to under 37 C.F.R. § 42.64(b)(1).

as required by Fed. R. Evid. 901. Petitioner has not established this exhibit as self-authenticating, nor has Petitioner authenticated these documents, for example, by testimony from a witness with personal knowledge that the documents are what they are claimed to be.

Patent Owner further objects to Exhibit 1007 is also irrelevant, misleading, and confusing. Fed. R. Civ. 401, 403. Exhibit 1007 is irrelevant, misleading, and confusing because the statements were not made in the context of the Challenged Claims nor in the context of applicable U.S. law. The statements are not relevant to the patentability of the Challenged Claims, particularly to the extent it has not been shown to be prior art or evidence of the level of ordinary skill in the art at the relevant time period. It is also irrelevant because Petitioner failed to carry its burden of establishing the UK Examiner qualifies as a POSITA. Petitioner makes no effort to present the UK Examiner's educational background, whether the UK Examiner even had any prior experience in video game controller technology, or even if he did, how the UK Examiner's prior experience was relevant to the video game controller industry. Petitioner also failed to explain how a UK Examiner, presumably trained under UK Patent Law, and not US Patent Law or video game technology, is actually a skilled artisan with respect to the technology of the '770 Patent and the '525 Patent.

Date: April 4, 2017

Respectfully submitted,

By: /s/ Ehab M. Samuel

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