

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VALVE CORPORATION,
Petitioner,

v.

IRONBURG INVENTIONS LTD.,
Patent Owner.

Cases

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

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

Before PHILLIP J. KAUFFMAN and MITCHELL G. WEATHERLY,
Administrative Patent Judges.

KAUFFMAN, *Administrative Patent Judge.*

Conduct of the Proceeding
37 C.F.R. § 42.5

IPR2016-00948 (Patent 8,641,525 B2)
IPR2016-00949 (Patent 9,089,770 B2)

This order discusses issues common to each case.¹

Additional Briefing

The panel held a conference call with the parties on June 2, 2017, to discuss objections to demonstrative exhibits. *See* Paper 36, 5:12–19. During this call, Patent Owner expressed a desire to enter the institution decisions from IPR2017-00136 and IPR2017-00137 as supplemental information.² *Id.* During further discussion at the oral hearing, Patent Owner conceded that the reason for seeking entry of the institution decisions was to address claim construction of the preamble in the cases at hand. *Id.* at 13:1–7. We asked Patent Owner how many pages were needed to address the claim construction issue, and Patent Owner replied that two pages would be sufficient.³ *Id.* at 14:14–16.

Petitioner contends that additional briefing regarding claim construction is unnecessary. *Id.* at 15–22.

As pointed out during oral argument, Patent Owner had ample opportunity to address claim construction (e.g., the Preliminary Response and the Response). Despite this, we authorize each side two pages to address whether the preamble of claims 1 and 20 is limiting. Given that Patent Owner's request for authorization to file supplemental information was driven by a desire to address the interpretation of the preambles of the

¹ We reference the papers of IPR2016-00948, but IPR2016-00949 contains similar papers.

² IPR2017-00136 and IPR2017-00137 were instituted on additional petitions directed to the patents at issue in the current proceedings.

³ The cover page, signature block, and certificate of service do not count against the page limits for the post-hearing papers permitted by this Order.

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independent challenged claims (1 and 20) and that we are granting such additional briefing, we deny Patent Owner's request for authorization to file a motion for supplemental information as moot.

Scope of Petitioner's Reply

Patent Owner's objections to Petitioner's demonstrative exhibits include an assertion that slides 2, 3, 8, 11, and 12 include improper argument in that the arguments were either beyond the scope of a reply under 37 C.F.R. § 42.23(b) or should have been included in the Petition.⁴ *See* Paper 34. From oral argument, it appears that Patent Owner did not understand how to properly make such an assertion. *Id.* at 30:14–32:11.

We authorize Patent Owner to file, in each proceeding, a two-page⁵ submission, specifically identifying what issue(s) in the Reply allegedly exceeds the proper scope of a reply or should have been in the Petition. We authorize Petitioner to file a two-page response to Patent Owner's submission.

⁴ Regarding arguments that should have been included in the Petition, *see generally Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1080 (Fed. Cir. 2015) (applying a similar standard in inter partes review as in prosecution: “this court has determined whether the Board relied on a ‘new ground of rejection’ by asking ‘whether applicants have had fair opportunity to react to the thrust of the rejection.’”).

⁵ Patent Owner asserted that two pages was sufficient. *See* Paper 36, 31:5–32:11.

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ORDER

In view of the foregoing, it is hereby:

ORDERED that Patent Owner's request for authorization to file a motion for supplemental information is denied as moot; and

FURTHER ORDERED that Patent Owner may file, each no later than four business days from entry of this order, a two-page paper on claim construction and a two-page paper regarding the scope of Petitioner's Reply, as outlined above; and

FURTHER ORDERED that Petitioner may file a response to each paper, as outlined above, no later than four business from entry of entry of each of Patent Owner's papers.

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