

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VALVE CORPORATION
Petitioner,

v.

IRONBURG INVENTIONS LTD.,
Patent Owner.

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

**PATENT OWNER'S SUBMISSION
RE: PREAMBLE IS LIMITING**

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

This submission is made in support of Patent Owner's position that the preamble of the challenged claims is limiting.

Antecedent basis, present here, provides a separate and independent basis to conclude that the preamble is limiting "because it indicates a reliance on both the preamble and claim body to define the claimed invention." *Catalina Marketing Int'l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 808 (Fed. Cir. 2002); *see also Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999) (identifying antecedent basis in the alternative).

Separately, a determination of whether a preamble "breathes life and meaning" into the claim requires "review of the entirety of the patent to gain an understanding of what the inventors actually invented and intended to encompass by the claim." *General Elec. Co. v. Nintendo Co.*, 179 F.3d 1350, 1361-62 (Fed. Cir. 1999) (limiting claim scope to a particular display rather than all display systems in view of specification's focus on the prior art problem). Like *General Elec.*, the preamble is limiting here because the inventors sought to solve a particular problem in prior art hand held video game controllers.

Schumer v. Lab Computer Sys., Inc., 308 F.3d 1304 (Fed. Cir. 2002), cited in the 136/137 Institution Decisions, is inapplicable because the preamble did not provide antecedent basis to any limitations in the body of the claim. Meanwhile, the cases that Patent Owner cited are applicable because, as present here, the preamble did provide antecedent basis to express limitations in the body of the

claim. *Pacing Techs. LLC v. Garmin Intern. Inc.*, 778 F.3d 1021, 1024 (Fed. Cir. 2015)(“user” and “repetitive motion pacing system”); *Eaton Corp. v. Rockwell Int’l Corp.*, 323 F.3d 1332, 1339 (Fed. Cir. 2003)(the “vehicle engine” limitation in the preamble provided antecedent basis to “the engine” in the body).

Patent Owner respectfully submits that the Board’s opinion that “the preamble term ‘controller’ is not necessary to understand any limitation in the body of the claim” effectively reads out the positive limitation of “the controller” in the body and is inconsistent with *General Elec.* Further, the Board’s opinion that “the body of the claim recites a structurally complete device” is respectfully inaccurate because it does not account for the essential structural limitations of “hand held”, “game console” or “video game” in the preamble. *See, e.g., Samsung Elects. Co. Ltd. v. IXI IP, LLC*, IPR2015-01442, Paper 8 at 9 (PTAB 2015)(“hand held” in preamble limiting); *Chevron N. Am., Inc. v. Milwaukee Elec. Tool. Corp.*, IPR2015-00595, Paper 24 at 7 (PTAB 2015)(same); *VSR Indus., Inc. v. Cole Kepro Int’l, LLC*, IPR2015-00182, Paper 33 at 10-11 (PTAB April 28, 2016)(construing “gaming controller”); *Xilinx, Inc. v. Intellectual Ventures I LLC*, IPR2013-00029, Paper 11 at 9-10 (PTAB 2013) (construing “video controller”); *Lindsay Corp. v. Valmont Indus., Inc.*, IPR2015-01039, Paper 37 at 6-8 (PTAB 2016)(construing “hand held”); *Dataquill Ltd. v. Huawei Techs. Co. Ltd.*, 2015 WL 363994, *4-6 (E.D.Tex. 2015) (same).

Finally, Petitioner agrees that the preamble is limiting. *Paper 36* at 65:11-17.

Date: July 10, 2017

Respectfully submitted,

By: /s/ Ehab M. Samuel

Ehab Samuel

Reg. No. 57,905

Yasser El-Gamal

Reg. No. 45,339

Attorneys for Patent Owner

CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e))

The undersigned hereby certifies that the foregoing **PATENT OWNER'S SUBMISSION RE: PREAMBLE IS LIMITING RESPONSE** was served in its entirety electronically via PTAB E2E to Petitioner's counsel of record at the following address:

Joshua C. Harrison, Reg. No. 45,686, josh@bhiplaw.com
Reynaldo C. Barcelo, Reg. No. 42,290, rey@bhiplaw.com

Date: July 10, 2017

Respectfully submitted,

By: /s/ Ehab M. Samuel
Ehab Samuel
Attorney for Patent Owner
Reg. No. 57,905