

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 PETITIONER'S EVIDENCE**

**PURSUANT TO 37 C.F.R. § 42.64**

Patent Owner Ironburg Inventions Ltd. (“Patent Owner”) submits the following objections to evidence served by Petitioner Valve Corporation (“Petitioner”) in its Petition. Patent Owner appreciates the Board’s authorization to file objections under 37 C.F.R. § 42.64. *See* Conduct of Proceedings, Paper 13 (October 27, 2016). The Board’s notice via PTAB E2E was sent to only one of the two counsel’s of record for Patent Owner, Ehab Samuel, who was traveling during the 2-day period authorized by the Board for filing the objections. Patent Owner kindly requests that future notices are also emailed to Patent Owner’s back-up counsel of record, Danielle Mihalkanin at: [DMihalkanin@manatt.com](mailto:DMihalkanin@manatt.com). *See*, e.g., Power of Attorney, Paper No. 8 at IPR2016-00949. Further, the email for Patent Owner’s lead counsel, Ehab Samuel, has changed to [esamuel-PTAB@manatt.com](mailto:esamuel-PTAB@manatt.com).

Patent Owner’s objections is as follows:

**EXHIBIT 1007 – Hearsay (FRE 802), Authentication (FRE 901), Relevance (FRE 402)**

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. This is prevalent both on a professional basis (as represented by the 'Firestorm' and 'RND' documents), and on an amateur basis (as represented by the 'Mod' document). Indeed, the 'Mod' document should be understood as purely representative of a thriving 'modding' community, in which gamers modify their gamepads on an almost adhoc basis according to personal preference.

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. 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.

With this in mind, I am having great difficulty seeing anything in your application which could form the basis of a novel and inventive claim.” Corrected Petition, IPR2016-00949, Paper 4 at 9-10 (May 2, 2016) (underlining in the Corrected Petition); Corrected Petition, IPR2016-00948, Paper at 10-11 (May 2, 2016) (underlining in the Corrected Petition).

In reliance on this out-of-court statement, Petitioner concludes that “[a]ccordingly, the UK counterpart to the US ‘525 Patent (UK Patent App. No. GB1011078.1) was duly refused by the UK Intellectual Property Office on 27 April 2015.” *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 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 as lacking relevance, under Fed. R. Evid. 402. Exhibit 1007 is 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.

Date: November 1, 2016

Respectfully submitted,

By: /s/ Ehab M. Samuel

Ehab Samuel

Attorney for Patent Owner

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