

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

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**PATENT OWNER'S SUBMISSION  
RE: SCOPE OF PETITIONER'S REPLY**

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

Pursuant to the Board’s Order, Patent Owner makes this submission to identify new issues in Petitioner’s Reply (Paper No. 23 in the 948 IPR (“948 Reply”), and Paper No. 24 in the 949 IPR (“949 Reply”)) that exceed the proper scope of a reply and/or should have been in the Petition. 37 C.F.R. § 42.23; Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,767 (Aug. 14, 2012) (“a reply that raises a new issue or belatedly presents evidence will not be considered and may be returned. The Board will not attempt to sort proper from improper portions of the reply.”).

Specifically, Petitioner advanced the following new arguments:

- The entire section titled “Tosaki is analogous art” contains new arguments, including (1) that Tosaki has the same U.S. Classification and same Field of Search as the challenged patents, and (2) reference to the USPTO Manual of Classification. *See* 948 Reply at 19; 949 Reply at 20-21; and EX1024.
- Petitioner’s new argument that hand grips 14 are within the ordinary meaning of “handles.” *See* 948 Reply at 9; 949 Reply at 10; and Rempel Reply Decl. (EX1021), ¶9.
- Petitioner’s new argument that Enright’s ¶0032 refers to position of switches, but in view of Tosaki would “rationally suggest to a POSITA” to “lengthen,” and Petitioner’s attempt to support its new obviousness argument with UK Examiner’s statements *See* 948 Reply at 20-21; 949 Reply at 21-22; and

Rempel Reply Decl., ¶¶14-16.

- Petitioner’s new arguments (a) that the mode switches 32, 34 must include some flexible element such as a spring, (b) that Ironburg did not invent flexible materials, and (c) reliance on Oelsch to suggest the making of a switch from an elongate flexible beam. *See* 948 Reply at 15; and Rempel Reply Decl., ¶12.

- The entire section on “paddle levers were common knowledge” contains new arguments, including arguments made therein that (a) ‘paddle levers’ were common knowledge, (b) the challenged patent depicts them as “simple elongate oval outlines,” (c) specification “lacks description or guidance to distinguish a paddle lever from other types of controls, (d) Ironburg did not invent paddle levers, and (e) to be enabled and have written description support, paddle levers must have been assumed common knowledge. *See* 948 Reply at 24-25; 949 Reply at 25-26; and Rempel Reply Decl., ¶17.

As the Federal Circuit explained, “[o]nce the Board identifies new issues presented for the first time in reply, neither this court nor the Board must parse the reply brief to determine which, if any, parts of that brief are responsive and which are proper.” *Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016).

Date: July 10, 2017

Respectfully submitted,

By: /s/ Ehab M. Samuel

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

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

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