IPR2017-00136 | US. Patent 8,641,525
IPR2017-00137 | US. Patent 9,089,770

Oral Argument

Valve Corp. v. Ironburg Inventions Ltd.

Trial Hearing
17 January 2018

US Patent & Trademark Office
Madison Building East, 9th floor
600 Dulany Street,
Alexandria, VA 22314.

Ironburg's Motion to Terminate Should be Denied *(if still pending)*

Contrary to Ironburg's arguments …

- Petitioner did not fail to argue: a skilled & diligent search could not reasonably have been expected to discover Wörn.
  See, Petitioner's Opposition, Paper 33, at 7-11.
  See also, Cotropia Decl. (Ex. 1020) at ¶ ¶ 61-67.

- Petitioner does not argue that Dr. Rubinger's ***reliance on*** the Examiner's classification was premised on hindsight, but rather that Dr. Rubinger's ***departure from*** the examiner's classification was premised on hindsight.
  See, Petitioner's Opposition, Paper 33, at 11-12.
  - The patent examiner searched the entire USPC 463 and USPC D14 classes (>100,000 prior art references), yet did not search USPC 345/169. *See, Cotropia Decl. (Ex. 1020) at ¶¶ 61-67.*

- For an *issued* patent, seeking "the help of the patent examiner in finding subclasses" = checking what subclasses the examiner *actually searched*.
  - Landon IP did that. *See, Cotropia Decl. (Ex. 1020) at ¶¶ 16, 32, 45, and 48-53.*
  - Examiner did ***not*** search USPC 345/169. *See, Id. at ¶¶ 61-67.*

"for a game console" & "video game" = non-limiting statements of intended use

USPTO:

➡ The Board already concluded that the preambles of '525 patent claim 20, and '770 patent claim 1, are not limiting.
See, IPR2017-00136, Paper 12 at 8-11; *see also,* IPR2017-00137, Paper 10 at 9.

Federal Circuit:

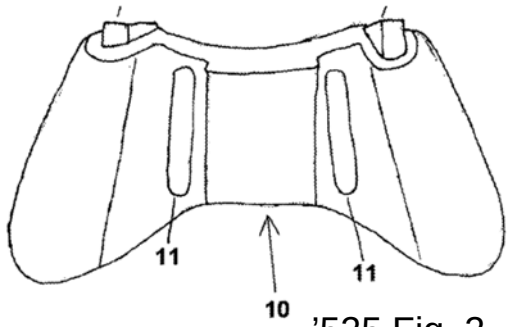
➡ Statements of intended use are not limiting, unless used during prosecution to distinguish prior art.
See, Catalina Marketing Int., Inc., v. Coolsavings.com, Inc., 289 F.3d 801, 1781, 1785 (Fed. Cir. 2002).
See also, C.R. Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340, 1348-49 (Fed. Cir. 1998).

'525 & '770 Patents:

- *preamble:* "for a game console" or "video game"
  - ✓ never used during prosecution to distinguish prior art
  - ✓ not referenced in the body of the claim
  - ✓ doesn't provide antecedent basis
- *body of claim:* positive limitations
  - ✓ describes a structurally complete device
  - ✓ understood without preamble
  - ✓ applicable to ergonomics of controllers for *any* use (not just games)

Broadest reasonable interpretation: "for a game console" & "video game" controller

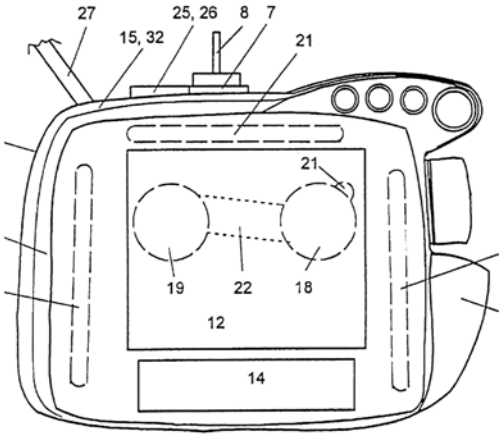
Assuming (counterfactually) **that preambles are limiting:**



'525 Fig. 2

- only the controller component is claimed
  - not the system being controlled
- requires only: *can* be used to control a video game
  - use for a game console may be primary or alternative use
  - if alternative use, may have different primary use
- does not say: "for *only* a game console"
- any controller that can control a downstream microprocessor, can also be used to control a video game
  - '525 and '770 patents are about hand ergonomics, not downstream electronics
  - makes no difference if downstream microprocessor operates a real robot or a virtual robot in a game

Wörn controller can be used to control a video game.



Wörn Fig. 6

Express disclosure: *Wörn* at 1:14-17

- Wörn device outputs "*control and* program data" = *controller*
- transmitted to a conventional personal computer

Inherent disclosure: *See,* Rempel Reply Declaration at ¶¶ 9-10

- Always true: a conventional personal computer can be programmed to run a video game = *game console*.

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