

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VALVE CORPORATION,
Petitioner,

v.

IRONBURG INVENTIONS LTD.,
Patent Owner.

IPR2017-00136 (Patent 8,641,525 B2) ¹
IPR2017-00137 (Patent 9,089,770 B2)

Before PHILLIP J. KAUFFMAN, MEREDITH C. PETRAVICK, and
MITCHELL G. WEATHERLY, *Administrative Patent Judges*.

PETRAVICK, *Administrative Patent Judge*.

DECISION
Granting Motion to Terminate
37 C.F.R. § 42.71

¹ We use this caption to indicate that this Decision applies to, and is entered in, each case. The parties are not authorized to use this type of caption.

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IPR2017-00137 (Patent 9,089,770 B2)

Ironburg Inventions Ltd. (“Patent Owner”) seeks to terminate the instant *inter partes* reviews, because, pursuant to 35 U.S.C. § 315(e)(1), Valve Corporation (“Petitioner”) is estopped from maintaining the *inter partes* reviews. Paper 26² (“Mot.”). Section 315(e)(1) of the statute provides:

(e) Estoppel. —

(1) Proceedings before the office.—The petitioner in an inter partes review of a claim in a patent under this chapter that results in a final written decision under section 318(a) . . . may not request or maintain a proceeding before the Office with respect to that claim on any ground that the petitioner raised or reasonably could have raised during that inter partes review.

35 U.S.C. § 315(e)(1); *see* 37 C.F.R. 42.73(d).

Each of the claims challenged in the instant proceedings were subject to a final written decision under 35 U.S.C. § 318(a) in the earlier proceedings. In IPR2017-00136, Petitioner challenges claim 20 of U.S. Patent No. 8,641,525 B2 (Ex. 1001, “the ’525 patent”) as anticipated by Wörn³. In IPR2016-00948, Petitioner also challenged claim 20 of the ’525 patent and, on September 22, 2017, we issued a Final Written Decision finding claim 20 unpatentable. IPR2016-00948, Paper 44, 50.⁴ Likewise, in IPR2017-00137, Petitioner challenges claims 1–4, 12, 15–18, and 20 of U.S. Patent No. 9,089,770 B2 (Ex. 1002, “the ’770 patent”) as anticipated by Wörn. In IPR2016-00949, Petitioner also challenged claims 1–4, 12, 15–18,

² For the purposes of this Order, IPR2017-00136 is representative and all citations are to papers in IPR2017-00136 unless otherwise noted.

³ U.S. Patent No. 6,362,813 B1, issued Mar. 26, 2002 (Ex. 1003).

⁴ Although there is an outstanding request for rehearing in this case, it does not address claim 20. *See* Paper 45.

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and 20 of the '770 patent and, on September 22, 2017, we issued a Final Written Decision finding claims 1–4, 12, 15–18, and 20 unpatentable.

IPR2016-00949, Paper 45, 55.

Petitioner did not raise grounds based on Wörn in either IPR2016-00948 or IPR2016-00949. IPR2016-00948, Paper 1, 4–6; IPR2016-00949, Paper 1, 4–6. Patent Owner contends that Petitioner reasonably could have raised the grounds based on Wörn in these earlier *inter partes* reviews. *See Mot.*

The legislative history of the America Invents Act broadly describes what “could have been raised” to include “prior art which a skilled searcher conducting a diligent search reasonably could have been expected to discover.” 157 Cong. Rec. S1375 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl); *see id.* at S1376 (statement of Sen. Kyl) (“This [estoppel] effectively bars such a party . . . from later using inter partes review . . . against the same patent, since the only issues that can be raised in an inter partes review . . . are those that could have been raised in [an] earlier post-grant or inter partes review.”); 157 Cong. Rec. S951–52 (daily ed. Feb. 28, 2011)(statement of Sen. Grassley) (“It also would include a strengthened estoppel standard to prevent petitioners from raising in a subsequent challenge the same patent issues that were raised or reasonably could have been raised in a prior challenge.”); *see Dell Inc. v. Elecs. and Telecomms. Research Inst.*, IPR2015-00549, slip. op. 4–6 (PTAB Mar. 26, 2015) (Paper 10) (representative).

Patent Owner and Petitioner dispute whether a skilled searcher conducting a diligent search reasonably could have been expected to discover Wörn. *See generally*, *Mot.*; Paper 33 (“Opp.”); Paper 34 (“Reply”).

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Patent Owner provides a Declaration of Bruce Rubinger to support its Motion. Ex. 2034; *see also* Ex. 1018 (cross-examination testimony of Bruce Rubinger). Petitioner provides a Declaration of Reynaldo C. Barcelo (Ex. 1012), a Declaration of Christopher A. Cotropia (Ex. 1020), and a Declaration of Jamila Williams (Ex. 1019) to support its Opposition.

Considering all of Patent Owner’s and Petitioner’s evidence, we determine that the evidence sufficiently establishes that a skilled searcher conducting a diligent search reasonably could have been expected to discover Wörn.

A skilled searcher performing a diligent search “begins with selecting one or more patent classifications and sub-classification” in the United States Patent Classification (“USPC”). Ex. 1020 ¶ 20; *see also* Ex. 1019, App. 1⁵, 25⁶ (“Since patent classification systems were designed to assist with patent searching, they are a good place to start.”); Ex. 1019 ¶¶ 8–9 (“Once the most pertinent search classes & sub-classes . . . were initially identified . . .”). “[A] professional search requires more than text searching. A systematic and exhaustive search of ‘core’ and ‘peripheral’ subclasses is imperative to a *reliable* search.” Ex. 1019, App. 1, 47–48.

The testimony of the declarants indicates that a skilled searcher would look to the class, subclass descriptions in the USPC to identify relevant

⁵ Appendix 1 of Exhibit 1019 includes excerpts of the book, “Patent Searching: Tools and Techniques,” by David Hunt et al., ISBN: 978-0-0471-78379-4, John Wiley & Sons, 2007. Exhibits 1016 and 2035 contain excerpts of the same book.

⁶ We reference the page numbers in the lower right corner rather than those in the upper right corner.

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searches. *See* Ex. 1020 ¶ 43; Ex. 2035 ¶¶ 42–43. The '525 patent and the '770 patent are classified in class 463, “Amusement Devices: Games” (Ex. 3001, 1). Ex. 1001, (58); Ex. 1002, (58). The '525 patent and the '770 patent are both classified in subclass 37, “Hand manipulated (e.g., keyboard, mouse, touch panel, etc.)” (Ex. 3001, 16). *Id.* In the USPC, Subclass 37 is indented under subclass 36, “Player-actuated control structure (e.g., brain-wave or body signal, bar-code wand, foot pedal, etc.,” which in turn is indented under subclass 1. Ex. 3001, 16. The USPC classification description for class 463/1 is “Including Means for Processing Electronic Data (e.g., Computer/Video Game, etc.)” and provides references to other classes. *Id.* at 4. It states:

SECTION III – REFERENCES TO OTHER CLASSES
SEE OR SEARCH CLASS:

...

345, Computer Graphics Processing and Selective Visual Display Systems, appropriate subclass for a selectively controlled visual display system which may either form part of a game or not be limited to a game.

Id. at 2.

A skilled searcher also would look to the classes, subclasses of pertinent prior art to identify relevant searches. Ex. 2034 ¶ 6; Ex. 1019, App. 1, 27–29. The '525 patent and the '770 patent cite multiple patents classified in class 345. Ex. 1001, (56); Ex. 1002, (56). Some of the cited patents are classified in class 345, subclass 169. *Id.*

The description for class 345 is “Computer Graphics Processing and Selective Visual Display Systems.” Ex. 3002, 1. Subclass 156 is “Display Peripheral Interface Input Device.” *Id.* at 20. Subclass 169 “Portable (i.e., handheld, calculator, remote controller),” is indented under subclass 168,

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