Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VALVE CORPORATION,

Petitioner,

v.

IRONBURG INVENTIONS LTD.,

Patent Owner.

Case IPR2017-00136

Patent 8,641,525

PETITIONER'S REPLY TO THE PATENT OWNER'S RESPONSE

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EXHIBIT LIST

Exhibit No.	Description
1001	U.S. Patent 8,641,525 to Burgess et al.
1002	U.S. Patent 9,089,770 to Burgess et al.
1003	U.S. Patent 6,362,813 to Wörn et al.
1004	U.S. Patent App. Pub. 2010/0073283 to Enright
1005	U.S. Patent 6,153,843 to Date, et al.
1006	U.S. Patent 6,364,771 to Lee
1007	U.S. Patent 4,032,728 to Oelsch
1008	UK Search and Examination Report for Patent App. No. GB1011078.1, 16 May 2011, at 2.
1009	Expert Declaration of David Rempel, M.D., in Support of Valve Corporation's Second Petition for Inter-Partes Review of U.S. Patent 8,641,525.
1010	Curriculum Vitae of David Rempel, M.D. (also denominated as Ex. 1 to Ex. 1009).
1011	- not used -
1012	Declaration of Reynaldo C. Barceló.
1013	Expert Declaration of David Rempel, M.D., in Support of Petitioner's Replies to the Patent Owner Responses in IPR2017-00136 and IPR2017-00136. (Rempel Reply Declaration)
1014	Prosecution history of U.S. Patent 8,641,525.

I. INTRODUCTION

In the Patent Owner Response in IPR2017-00136 ("PO Response"), the Patent Owner ("Ironburg") interprets its own patent narrowly – attempting to effectively carve away a substantial portion of the scope of claim 20 of U.S. Pat. No. 8,641,525 (the "'525 patent") because of alleged limitations in the claim's short preamble. In this reply, the Petitioner exposes that as an improper result-oriented tactic, rather than being a fair reading of the subject patent under the law.

II. CLAIM CONSTRUCTION

A. The statement of intended use "for a game console," in the preamble of claim 20, is not limiting.

As explained fully below, the language "for a game console" in the preamble of claim 20 of the '525 patent is merely a statement of intended use that is not exclusive or properly limiting in this case.

1. Statements of intended use are not limiting, unless used during prosecution to distinguish prior art.

The Federal Circuit has explained why longstanding and consistent precedent holds that statements of intended use are almost never limiting in apparatus or composition claims, as follows:

> [P]reambles describing the use of an invention generally do not limit the claims because the patentability of apparatus or composition claims depends on the claimed structure, not on the use or purpose of that

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