

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VALVE CORPORATION,
Petitioner,

v.

IRONBURG INVENTIONS LTD.,
Patent Owner.

Cases¹

IPR2017-00136 (Patent 8,641,525 B2)

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

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

KAUFFMAN, *Administrative Patent Judge*.

Conduct of the Proceeding
37 C.F.R. § 42.5

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.

Case IPR2017-00136 (Patent 8,641,525 B2)

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

On October 4, 2017, at Patent Owner's request, Judge Kauffman held a call with counsel for each party. Patent Owner provided a court reporter for the call, and indicated that the transcript would be filed in both cases.

Patent Owner seeks authorization to file a Motion to Terminate these proceedings based on 35 U.S.C. § 315(e)(1). Specifically, Patent Owner contends that Petitioner is estopped from maintaining these proceedings because Petitioner reasonably could have raised the ground of unpatentability based on the prior art reference Wörn in both IPR2016-00948 and IPR2016-00949, and those proceedings have now resulted in final written decisions.² Patent Owner estimated ten pages and five to seven business days would be sufficient for preparation of the Motion. Patent Owner asked to have a reply to Petitioner's opposition.

Petitioner did not oppose the request for authorization to file the Motion or the amount of preparation time requested by Patent Owner. Petitioner indicated that given a ten page motion, a ten page opposition was sufficient. Petitioner asked for three weeks to a month to prepare the opposition, and asserted that such a time period would not negatively impact the schedule of these proceedings. As an alternative, Petitioner asked to brief the issue at oral argument as scheduled.

The Petition in each case addresses how and why Wörn was discovered. *See* IPR2017-00136, Paper 1, 4–12; IPR2017-00137, Paper 1, 3–11. For that reason, a great deal of time to prepare the opposition is not needed. Balancing Petitioner's request for more time against the need for

² The final written decisions were entered September 22, 2017.

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this proceeding to progress in a timely manner, we give Petitioner ten business days to prepare the Opposition.

Petitioner's request to deal with this issue at the oral hearing scheduled for December 4 is denied because that would leave this issue open for nearly two months.

We will evaluate the need for Patent Owner to reply to Petitioner's opposition after the Motion and Opposition are filed.

Accordingly, it is

ORDERED that Patent Owner is authorized to file a Motion to Terminate, limited to ten pages, no later than six business days from entry of this order; and

FURTHER ORDERED that Petitioner is authorized to file an opposition to Patent Owner's Motion, limited to ten pages, no later than ten business days from entry of the Motion.

Case IPR2017-00136 (Patent 8,641,525 B2)

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

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