

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

PATENT OWNER MOTION TO TERMINATE

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U.S. Patent and Trademark Office
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I. INTRODUCTION

Pursuant to the Board's Order dated October 5, 2017 (Paper 24), Patent Owner Ironburg Inventions Ltd. hereby respectfully requests the Board to terminate the instant proceedings, IPR2017-00136 ("the 136 IPR") and IPR2017-00137 ("the 137 IPR"), as Petitioner Valve Corporation is now estopped from maintaining these proceedings under 35 U.S.C. § 315(e)(1) and 37 C.F.R. § 42.73(d). Estoppel attached to Petitioner as a matter of law on September 22, 2017, when the Board issued final written decisions in co-pending proceedings before the Board involving the same parties and the same claims of the same patents at issue in the 136 and 137 IPRs. Those proceedings are *Valve Corp. v. Ironburg Inventions Ltd.*, IPR2016-00948 (Paper 44, "the 948 IPR") and IPR2016-00949 (Paper 45, "the 949 IPR").

As set forth in more detail below, estoppel applies as a matter of law as Petitioner reasonably could have raised the grounds in the instant 136 and 137 IPRs (*i.e.*, invalidity in view of U.S. Patent No. 6,362,813 by Wörn) in the earlier 948 and 949 IPR proceedings. Now that the 948 and 949 proceedings have resulted in final written decisions, the 136 IPR and the 137 IPR proceedings cannot be maintained and termination is mandated by statute. An order terminating these proceedings is therefore respectfully requested.

II. PETITIONER IS ESTOPPED FROM MAINTAINING THE 136 IPR AND THE 137 IPR PROCEEDINGS

As emphasized in *Praxair Distribution, Inc. v. Ino Therapeutics LLC*, IPR2016-00781, Paper 10 at 7-10 (P.T.A.B. Aug. 25, 2016), “[o]nce a Petitioner has obtained a final written decision, that Petitioner may not request or maintain subsequent proceedings on a ground that it ‘reasonably could have raised’ during the prior proceeding.” *Id.* (citing *Dell Inc. v. Elecs. and Telecomms. Research Inst.*, IPR2015-00549, Paper 10 at 4–6 (P.T.A.B. Mar. 26, 2015)).

Specifically, section 315(e)(1) of the Patent 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), or the real party in interest or privy of the petitioner, 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). Here, as explained below, the instant IPRs involve identical parties, patents and claims to those subject to the final written decisions, and petitioner reasonably could have raised the Wörn reference in the earlier IPRs. Thus, Petitioner is statutorily estopped from maintaining the instant proceedings under § 315(e).

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