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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Patent Trial and Appeal Board

P.O. Box 1450

Alexandria, VA 22313-1450

**DECLARATION OF REYNALDO  
C. BARCELO**

I, Reynaldo C. Barceló, hereby declare as follows:

1. I am a patent attorney, representing Valve Corporation (“Valve”) on various district court and other matters, including *inter partes* review proceedings numbered IPR2016-00948 and IPR2016-00949, which were filed on April 22, 2016, and are currently pending before the Patent Trial and Appeal Board (“PTAB”) of the United States Patent and Trademark Office (“USPTO”).

2. I make this declaration based on my own personal knowledge. Nothing in this declaration should be construed as a waiver of the attorney-client privilege or any other applicable privileges.

3. I am registered to practice as a patent attorney before the USPTO (Reg. No. 42,290), and I am admitted in good standing to practice as an attorney in the State of California (Cal. Bar. No. 199,741).

4. I have been awarded a Bachelor of Science degree in Electrical Engineering (*magna cum laude*) from Loyola Marymount University (1989), a Master of Science Degree in Electrical Engineering from the University of Southern California (1991), and a Doctor of Jurisprudence degree (with distinction) from the Leland Stanford Junior University (1998).

5. In 1991, I was awarded the Most Promising Engineer award by the Hispanic Engineer National Achievement Awards.

6. During law school, I was the President of the Stanford Law and Technology Association, an Executive Editor on the Stanford Law Review, and co-founder of the Stanford Technology Law Review.

7. From 2000 to 2001, I served as a law clerk to the Honorable Raymond C. Clevenger III on the United States Court of Appeals for the Federal Circuit.

8. I have worked continuously as a patent professional since 1996, and as a patent attorney since 1998. I have performed, supervised, and/or

commissioned dozens of prior art searches in the electrical and mechanical arts during that time.

9. Additional details regarding my background and experience are available on-line at <http://www.bhiplaw.com/ReynaldoC.Barcelo.html>.

10. On December 3, 2015, Ironburg Inventions Ltd., a U.K. Corporation, the purported assignee of the U.S. Patent Nos. 8,641,525 (“the ’525 patent”) and 9,089,770 (“the ’770 Patent”), filed a complaint against Valve for alleged infringement of the ’525 and ’770 Patents in the U.S. District Court for the Northern District of Georgia (Case Docket No. 1:15-cv-04219-TWT).

11. Without waiving any attorney-client communication privileges, attorney work product privileges, or any other applicable privileges, I declare that Valve commissioned prior art searches for the ’525 and ’770 Patents. Among other searching activities, I was involved in hiring a professional, experienced, and respected prior art search company (Landon IP Patent Search, or “Landon IP”) that conducted reasonably diligent searches to the best of its ability with respect to those two patents. In addition, multiple experienced attorneys and other experienced patent professionals working on behalf of Valve, including myself, spent dozens of hours on prior art searching for those two patents. A true and correct copy of some of the search strings and strategies used by Landon IP for those two patents is attached as Appendix A to this declaration. The primary prior art search analysis at Landon IP who performed some of the relevant searches was Mr. Gino Bautista, and experienced searcher in the mechanical and electrical arts.

12. On April 22, 2016, Valve filed *inter partes* review Petitions with respect to the ’525 and ’770 Patents, which resulted in recently-

instituted proceedings numbered IPR2016-00948 and IPR2016-00949, respectively.

13. Despite its reasonably diligent search efforts, Valve did not discover U.S. Patent 6,362,813 to Wörn et al. (hereinafter “Wörn”), prior to filing its first IPR petitions in IPR2016-00948 and IPR2016-00949. Thus, the Wörn reference was not available to Valve at the time of filing of its Petition in IPR2016-00948 and IPR2016-00949. The Wörn reference was only recently discovered, as a direct result of actions by the Patent Owner taken after the filing of the previous petitions in IPR2016-00948 and IPR2016-00949.

14. The claims of the ’525 and ’770 Patents do not require any “channel” or “conduit.” Therefore, there was previously no reason for Valve to include the search term “groove” in its search strings, and accordingly Valve’s professional search vendor (Landon IP) did not include that search term. *See* Appendix A hereto.

15. Only after the Patent Owner subsequently amended its District Court complaint to assert U.S. Patent No. 9,352,229 (“the ’229 Patent”), did Valve have any reason to include the search term “groove” in its search strings. That is because the ’229 patent claims a “channel” and a “conduit,” and “groove” is a synonym for channel or conduit. Therefore, Valve’s professional search vendors subsequently included the synonym “groove” in their search strings, and this inclusion led to the discovery of the Wörn reference because Wörn includes the uncommon and unique word “grooves” at the bottom of column 4. A true and correct copy of some of the search strings and strategies used by one of Valve’s professional prior art search firms for the ’229 patent (*i.e.*, Maxval Group, with the search supervised by experienced search analysis Mr. Mark O’Donnell, Vice President of Search & Analytics) is attached as Appendix B to this declaration.

16. It is well-known that it is very difficult and unreliable to search for patents based only on features that are shown in the drawings but that are not described in the text. Whereas text is computer-searchable, the characteristics of each drawing must be visually inspected by a human, and there are thousands of potentially-relevant patents in the USPTO database, including many thousands of drawings.

17. In this particular case, the drawings of the Wörn prior art reference show that the length limitations (for the elongate members of the back controls) of the claims of the '525 and '770 Patents are met (as shown subsequently herein). However, the Wörn reference nowhere describes in its searchable text that such length limitations are met.

18. In the process of preparing Valve's IPR Petitions being filed today, which cite the Wörn prior art reference, it became apparent for the first time that additional prior art references (*i.e.*, U.S. Patent No. 6,153,843 to Date et al. and U.S. Patent No. 6,364,771 to Lee, as well as U.S. Patent Nos. 4,032,728 to Oelsch and U.S. Patent Pub. No. 2010/0073283 to Enright, the latter two of which were already cited in IPR2016-00948 and IPR2016-00949) should be combined with the Wörn reference for the purpose of presenting obviousness arguments as to certain of the claims in Valve's IPR Petitions being filed today.

19. Pursuant to 28 U.S.C. § 1746, I declare under penalty of perjury that the foregoing is true and correct.

Executed on: October 25, 2016

  
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Reynaldo C. Barceló

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