

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

OPPOSITION TO THE MOTION TO TERMINATE

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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 IPR2017-00137. ("Rempel Reply Decl.")
1014	Prosecution history of U.S. Patent 8,641,525.
1015	Certified transcript of the deposition of Glen Stevick in IPR2017-00137 held 06 September 2017. ("Stevick Depo.")
1016	Excerpt of book entitled " <i>Patent Searching: Tools and Techniques</i> ," by David Hunt, et al., ISBN: 978-0-471-78379-4, John Wiley & Sons, 2007.
1017 (not filed)	Paper by Dr. Bruce Rubinger entitled "Locating Prior Art Gold: The Five Keys to Successfully Uncovering Strong Prior Art," published in <i>Intellectual Property Today</i> , July 2011.
1018	Certified transcript of the deposition of Dr. Bruce Rubinger in IPR2017-00136 and IPR2017-00137. ("Rubinger Depo.")
1019	Declaration of Jamila Williams in IPR2017-00136 and IPR2017-00137 ("Williams Decl.")
1020	Declaration of Professor Christopher Cotropia in IPR2017-00136 and IPR2017-00137 ("Cotropia Decl.")

I. INTRODUCTION

In its Motion to Terminate filed 13 October 2017, the Patent Owner (“Ironburg”) and its expert use hindsight to artificially trivialize the task of finding the Wörn prior art reference, suggesting that a competent prior art search prior to filing the petitions in IPR2016-00948 and IPR2016-00949 should have discovered it. However, pertinent historical facts demonstrate the opposite. The prior art searches commissioned by Petitioner – like the Patent Examiner’s own searches – were skilled and reasonably diligent yet did not discover Wörn.

II. THE PERTINENT LEGAL QUESTION IN THIS CASE.

A. “Reasonably could have raised.”

The Board recently considered the law applicable here, in *Johns Manville Corp. v. Knauf Insulation Inc.*, IPR2016-00130, Paper 35 at 9-10, as follows:

The plain language of section 315(e)(1) states that the estoppel applies to grounds a petitioner “*reasonably* could have raised.” [...] The word “reasonably” is not a mandatory word such as, “must,” or “shall.” The word “reasonably” is a qualifier that refers to the discretion applied by a qualified searcher in conducting an adequate search. This is consistent with the legislative history of section 315 [...] the prior art estopped is that which “a skilled searcher conducting a diligent search reasonably could have been expected to discover.” *Id.* Congress easily could have broadened the estoppel provision to extend to “any ground that the petitioner raised or [] could have raised during that inter partes review,” but it did not.

Ironburg simplistically asserts that such a legal inquiry may be satisfied merely because “Wörn is a US Patent.” *See*, Motion to Terminate (Paper 26) at 4.

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