

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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VALVE CORPORATION  
Petitioner,

v.

IRONBURG INVENTIONS LTD.,  
Patent Owner.

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IPR2017-00136 (Patent 8,641,525 B2)  
IPR2017-00137 (Patent 9,089,770 B2)

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**PATENT OWNER REPLY IN SUPPORT OF  
MOTION TO TERMINATE**

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U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

Patent Owner hereby respectfully submits this Reply in support of its Motion to Terminate (Paper 26) the instant 136 and 137 IPR proceedings.

**I. Petitioner Has Not Demonstrated Why A Searcher Conducting A Diligent Search Reasonably Could Not Have Been Expected To Discover Wörn**

The Opposition (Paper 33) filed by Petitioner fails to address the sole inquiry – *whether a skilled searcher conducting a diligent search reasonably could have been expected to discover Wörn*. See *IBM Corp. v. Intellectual Ventures II LLC*, IPR2014-01465, Paper 32 at 5 (Nov. 6, 2015) (quoting 157 Cong. Rec. S1375 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl)) (emphasis added). Instead, Petitioner presents arguments and declarations to support its contention that its search was reasonably diligent, that it hired a skilled searcher, and despite doing so, did not discover Wörn. (Paper 33, EX1019 and EX1020.) These arguments and declarations are presented in support of Petitioner’s incorrect legal premise that if actual searches “are found to be reasonably diligent, that this is legally dispositive.” (Paper 33 at 3.)

The inquiry is not who Petitioner hired, what their credentials are, or what the searcher did or did not do for its search. Rather, the relevant inquiry, based on the legislative history, is whether a hypothetical “skilled searcher” conducting a diligent search reasonably could have been expected to discover Wörn.

Although seemingly acknowledging a burden “to explain why a reasonably diligent search could not have uncovered the newly applied art,” Petitioner failed to do so. (Paper 33 at 2 (quoting *General Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 20 (Sept. 6, 2017)(precedential) (petitioner failed to explain why a reasonably diligent search could not have uncovered U.S. patents)).) Like *General Plastic*, the record is devoid of any explanation why Petitioner **could not** have been expected to find Wörn.

Because Wörn is a U.S. patent, it is and has been readily accessible at the USPTO and online, and a skilled searcher conducting a diligent search reasonably could have been expected to discover it. Moreover, there are no issues with the date of the reference or its classification that would make it unreasonable to expect a skilled searcher to find it. Indeed, Petitioner did discover it.

Patent owner respectfully submits that Wörn is exactly the type of reference that Congress had in mind when it passed this section. Wörn is a U.S. Patent available online and at the USPTO and is being used as a section 102 reference in these IPRs. It is not an obscure reference located in some foreign library. *See Praxair Distribution, Inc. v. INO Therapeutics LLC*, IPR2016-00781, Paper 10 at 10 (Aug. 25, 2016) (concluding that a skilled searcher would have been expected to discover even textbooks that are catalogued in libraries or searchable on Google Books using keywords). Nor is the reference in the form of a hard copy brochure

stored in personal uncatalogued binders by an employee among thousands of employees worldwide. *See John Manville Corp. v. Knauf Insulation Inc.*, IPR2016-00130, Paper 35 at 6-8 (May 8, 2017)(cited in Petitioner's opposition brief). Notably, Petitioner presents no case law where the Board concluded that a skilled searcher conducting a reasonably diligent search could not have been expected to discover a *U.S. patent*.

Petitioner's *discovery* of Wörn during related searches compels the conclusion that a searcher conducting a diligent search reasonably could have been expected to discover Wörn. Petitioner's silence on this issue speaks volumes. But, there is more.

## **II. Dr. Rubinger's Declaration And Testimony Is Consistent With Statements Made By Petitioner's Prior Art Searcher**

As explained by search expert Dr. Rubinger in his declaration and deposition, a skilled searcher would have performed searches in class/subclass 345/169, which was one of the primary class/subclass that the examiner identified relevant prior art, and would have discovered Wörn. (EX2034, ¶¶6-11.) When repeatedly questioned on this issue in his deposition, Dr. Rubinger explained:

A. We basically will look at all of the important references on the front and where they were -- where they came from. In some cases, we'll have kickoff meetings with our client, and they'll tell us his perspective on which of the cited references are closer. But knowing where the cited art is coming from is really important, because the examiners are really specialists in terms of that core

technology and do lots of searching for patentability, and so the classes where they look tend to be pretty important classes.

(EX1018 at 23:6-24:16.) Not surprisingly, Petitioner's own searcher agrees with Dr. Rubinger, emphasizing that the "*classification code allows examiners and searchers to quickly narrow a search of the prior art to the particular subject matter of interest*" (EX2035 at 23 (emphasis added)) and that searchers should rely on patent examiners to find subclasses because of their technology area expertise:

**Finding Subclasses with the Help of a Patent Examiner** It is not widely known that U.S. patent examiners are available to the public for the purpose of providing assistance with classification searching. **This is the most effective and time-efficient way to identify classification areas for a search.**

Patent examiners are able to identify areas to search that are not entirely intuitive simply by reading the classification manual. Additionally, **they are experts in their assigned technology areas**, experts in using their assigned patent classes, and they can "translate" cryptic or ambiguous subclass names.

**We recommend that you contact an examiner for each class that is relevant in your cursory search to identify classification areas.** For the current

(EX1019, Appendix 1 at 45 (emphasis added).) Yet, despite this agreement, Petitioner is now attempting to run away from reasonable reliance on Examiners by contending that Dr. Rubinger's reliance on the Examiner's classification was premised on hindsight. (Paper 33 at 11.) Not only is such argument defies logic, but also runs afoul of its searcher's own search methods noted above.

Although the Williams Declaration indicates that the subject searches were conducted in general accordance with the methods outlined in the book (EX1019, ¶7), nowhere did the declarant state that it sought the help of the patent examiner in

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