

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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Cases<sup>1</sup>

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

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

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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

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<sup>1</sup> 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 December 15, 2017, at Patent Owner's request, the Board held a call with the parties. Patent Owner requests authorization to file a three page list of those arguments in Petitioner's Reply that Patent Owner alleges exceed the proper scope of a rely. Specifically, Patent Owner alleges that trial was instituted based on a ground of unpatentability of anticipation by Wörn (with no reliance on inherency) and Petitioner's Reply includes arguments related to obviousness and inherency.

We deny this request for the following two reasons.

### *Need*

The proffered information is not needed because the Board will check to ensure there has not been an improper change in a ground of unpatentability. *See* 37 C.F.R. § 42.23(b); *see also* Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,767 (Aug. 14, 2012).

### *Timeliness*

Patent Owner requested a conference call on this issue more than three months after Petitioner filed the Reply (Paper 20).<sup>2</sup> We asked why Patent Owner did not request the call closer in time to when Petitioner filed the Reply. Patent Owner provided three reasons.

First, Patent Owner stated that in the related cases (IPR2016-00948 and IPR2016-00949) the scope of reply was addressed at the hearing,

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<sup>2</sup> Unless otherwise indicated, we refer to the papers and exhibits of IPR2017-00136. IPR2017-00137 contains similar papers. Petitioner filed the Reply on August 27, 2017, and Patent Owner requested a conference call on December 13, 2017.

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implying that the hearing was an appropriate time for raising such an issue.

We disagree with that characterization. At that hearing the following discussion took place.

MR. SAMUEL: So how do we object to the fact that they are improper as new arguments that are to be considered?

JUDGE KAUFFMAN: As I think I mentioned in the phone call, there are a couple ways that the Board has dealt with that. One way is people ask for a conference call, and then they authorize either a motion to strike or they authorize what I call a list motion, which is a list of those things you believe to be beyond the scope of a proper reply or should have been in the petition. And, typically, that's authorized that the other side will then have a chance to comment on that. There has not been a request for that --

JUDGE PETRAVICK: Well --

JUDGE KAUFFMAN: What I'm saying is the objections to the demonstratives are the wrong place for that objection.

Paper 36, 24:3–18.

This discussion illustrates that Patent Owner was told both in a conference call and at oral hearing that the hearing is not the right time or place to contest the scope of a petitioner's reply, and that a proper course of action would be to ask for a conference call to request authorization to file a motion to strike or a list. Consequently, this reason does not justify Patent Owner's delay in seeking relief.

Second, Patent Owner implied that part of the delay was due to our Scheduling Order (Paper 13). In particular, Patent Owner stated that: (1) the paper cited in the Schedule Order (Paper 41 of IPR2014-00148) does not exist, (2) the citation did not include a pinpoint cite, and (3) the guidance relates to a motion to exclude rather than the scope of a reply.

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We acknowledge that IPR2014-00148 does not include a Paper 41. When Patent Owner detected this error, a prudent course of action would have been to contact the Board for guidance. Our incorrect citation does not relieve Patent Owner of the duty to seek relief promptly after the need for relief is identified. 37 C.F.R. § 42.25(b).

Although the information in the Scheduling Order is in a paragraph titled, “Motion to Exclude,” the information applies to the scope of a reply. That paragraph states:

If an issue arises with regard to a paper being out of proper scope under 37 C.F.R. § 42.23(a), the parties shall contact the Board in a timely manner to raise the matter. *See, e.g.*, IPR2014-00148, Paper 41.

Paper 13, 5.

Consequently, our Scheduling Order is not the cause of Patent Owner’s inaction; rather, our Scheduling Order directs Patent Owner to contact the Board in a timely manner.

Third, Patent Owner stated they were focused on the Motion to Terminate. Often an *inter partes* review will require a party to focus on multiple aspects of the trial. We are not persuaded that the workload involved here was unusual or otherwise excuses Patent Owner’s inaction.

Our rules require Patent Owner to seek relief promptly after the need for that relief is identified. 37 CFR § 42.25(b). Beyond this, Patent Owner was told in our Scheduling Order, in a conference call, and at oral hearing in a related proceeding that the appropriate action is to promptly seek relief by requesting a conference call.

In these circumstances, Patent Owner’s request some three months after Petitioner filed the Reply is not prompt.

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Accordingly, it is

ORDERED that Patent Owner's request to file a list of arguments that exceed the scope of a proper reply relied is denied.

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