

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VALVE CORPORATION,
Petitioner,

v.

IRONBURG INVENTIONS LTD.,
Patent Owner.

Case IPR2016-00948
Patent 8,641,525

Before PHILLIP J. KAUFFMAN, MEREDITH C. PETRAVICK, and
MITCHELL G. WEATHERLY, *Administrative Patent Judges*.

KAUFFMAN, *Administrative Patent Judge*.

DECISION

Institution of *Inter Partes* Review

37 C.F.R. § 42.108

I. INTRODUCTION

A. OVERVIEW

Valve Corporation (“Petitioner”) filed a corrected Petition (Paper 4, “Pet.”) requesting *inter partes* review of claims 1–20 of U.S. Patent No. 8,641,525 B2 (Ex. 1001, “the ’525 patent”). Pet. 1. Ironburg Inventions Ltd. (“Patent Owner”) filed a Preliminary Response (Paper 7, “Prelim. Resp.”) to the Petition.

Upon consideration of the Petition and the Preliminary Response, for the reasons explained below, Petitioner has demonstrated a reasonable likelihood of prevailing with respect to at least one of the challenged claims. We institute an *inter partes* review of claims 1–11, 13, 14, and 16–20 of the ’525 patent. We do not institute review of claims 12 and 15.

B. RELATED PROCEEDINGS

The parties indicate that the ’525 patent is at issue in: *Ironburg Inventions Ltd. v. Valve Corp.*, Case No. 1:15-cv-04219-MHC (N.D. Ga.). Pet. 1; Paper 6, 1.

Petitioner also filed a petition against U.S. Patent 9,089,770 B2 (“the ’770 patent”), the subject of *inter partes* review IPR2016-00949 (“the ’949 IPR”). The ’770 patent issued from an application that was a continuation of application 13/162,727, now the ’525 patent.

II. PRELIMINARY MATTERS

A. PETITIONER'S CLAIM INTERPRETATIONS

Patent Owner asks that we dismiss the Petition because Petitioner's claim interpretations are the "bald conclusions of its expert," made without utilizing the intrinsic record as required. Prelim. Resp. 9–10, 16.

Pursuant to 37 C.F.R. § 42.104(b)(3), the Petition is to include a statement of how each challenged claim is to be construed. The Office Patent Trial Practice Guide ("Practice Guide") states that, "it may be sufficient for a party to provide a simple statement that the claim terms are to be given their broadest reasonable interpretation, as understood by one of ordinary skill in the art and consistent with the disclosure." 77 Fed. Reg. 48764 (Aug. 14, 2012). Here, Petitioner explicitly construes some terms and asserts that the remaining terms carry their ordinary and customary meaning. Pet. 11–17. Such an assertion is consistent with an assertion that the claims should be given their broadest reasonable interpretation. Consequently, we do not dismiss the Petition on this basis.

Somewhat relatedly, Patent Owner contends that the Petition should be denied because it argues that the written description requirement of 35 U.S.C. § 112 is not met. Prelim. Resp. 8 (citing Pet. 12, 15, and 43). We agree with Patent Owner that a petitioner in an *inter partes* review may not assert a ground of unpatentability based on 35 U.S.C. § 112. 35 U.S.C. § 311(b); Prelim. Resp. 8. Here, Petitioner addresses an alleged lack of written description in the context of construing claim limitations, and does not assert a ground of unpatentability based on 35 U.S.C. § 112. *See* Pet.

Accordingly, we do not deny the Petition for asserting an unauthorized ground of unpatentability because no such ground was asserted.

B. LEVEL OF SKILL IN THE ART

Petitioner contends that patent examiners are persons of ordinary skill in the relevant art, and provides a statement from Mr. Brendan Donohoe, a patent examiner in the United Kingdom (UK), regarding examination of the UK counterpart to the '770 patent. Pet. 9–11. In that statement, Mr. Donohoe contends that it was well known to modify gamepads to suit the requirements of a particular game or gamer, and that the features claimed were typical features. Ex. 1007 ¶¶ 5–7.

Patent Owner asks that we dismiss the Petition because Petitioner has failed to establish the level of skill in the art. Prelim. Resp. 28. According to Patent Owner, Petitioner's statements from a UK examiner are inadmissible hearsay and are not prior art.¹ *Id.* Patent Owner asks that we exclude this section of the Petition in its entirety. *Id.*

As an initial matter, we observe that Petitioner has not explained persuasively how observations from a UK patent examiner, which presumably are based on UK law and not United States law, are of use in our proceeding. Despite this shortcoming, we do not dismiss the Petition as

¹ We agree that Mr. Donohoe's statement is not a prior art publication. Nevertheless, Mr. Donohoe's statement, which appears to have been made on May 16, 2011, before the June 17, 2011, filing date of the '525 patent, may be probative of the level of skill in the art at the time of invention. Ex. 1007, 1; Ex. 1001 (22). We do not express any opinion at this time regarding the admissibility of Mr. Donohoe's statement as evidence.

Patent Owner requests, because an explicit definition of the level of skill is not required, where, as here, the prior art of record is indicative of the level of skill in the art. *See, e.g., Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001).

Patent Owner’s assertion that Dr. Donohoe’s statements are inadmissible hearsay is premature. Rule 42.64 provides the framework for Patent Owner to object to information proffered as evidence and move to exclude objectionable material from evidence during the trial. *See* 37 C.F.R. § 42.64.

If the parties further develop this issue, we ask that the parties focus on the role the level of skill in the art plays in an obviousness analysis. *See Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966); *Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (The “level of skill in the art is a prism or lens through which a judge, jury, or the Board views the prior art and the claimed invention.”); *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718 (Fed. Cir. 1991) (“The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry”).

III. THE CLAIMED SUBJECT MATTER

A. INTRODUCTION

The ’525 patent relates to hand held controllers for video game consoles. Ex. 1001, 1:6–7.

As background, the ’525 patent describes that conventional controllers were intended to be held and operated by the user using both hands, and the plurality of controls were mounted on the front and top edge. *Id.* at 1:8–17;

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