

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VALVE CORPORATION,
Petitioner,

v.

IRONBURG INVENTIONS LTD.,
Patent Owner.

IPR2017-00136 (Patent 8,641,525 B2) ¹
IPR2017-00137 (Patent 9,089,770 B2)

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

PETRAVICK, *Administrative Patent Judge*.

DECISION
Granting Motion to Terminate
37 C.F.R. § 42.71

¹ 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.

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Ironburg Inventions Ltd. (“Patent Owner”) seeks to terminate the instant *inter partes* reviews, because, pursuant to 35 U.S.C. § 315(e)(1), Valve Corporation (“Petitioner”) is estopped from maintaining the *inter partes* reviews. Paper 26² (“Mot.”). Section 315(e)(1) of the statute provides:

(e) Estoppel. —

(1) Proceedings before the office.—The petitioner in an inter partes review of a claim in a patent under this chapter that results in a final written decision under section 318(a) . . . may not request or maintain a proceeding before the Office with respect to that claim on any ground that the petitioner raised or reasonably could have raised during that inter partes review.

35 U.S.C. § 315(e)(1); *see* 37 C.F.R. 42.73(d).

Each of the claims challenged in the instant proceedings were subject to a final written decision under 35 U.S.C. § 318(a) in the earlier proceedings. In IPR2017-00136, Petitioner challenges claim 20 of U.S. Patent No. 8,641,525 B2 (Ex. 1001, “the ’525 patent”) as anticipated by Wörn³. In IPR2016-00948, Petitioner also challenged claim 20 of the ’525 patent and, on September 22, 2017, we issued a Final Written Decision finding claim 20 unpatentable. IPR2016-00948, Paper 44, 50.⁴ Likewise, in IPR2017-00137, Petitioner challenges claims 1–4, 12, 15–18, and 20 of U.S. Patent No. 9,089,770 B2 (Ex. 1002, “the ’770 patent”) as anticipated by Wörn. In IPR2016-00949, Petitioner also challenged claims 1–4, 12, 15–18,

² For the purposes of this Order, IPR2017-00136 is representative and all citations are to papers in IPR2017-00136 unless otherwise noted.

³ U.S. Patent No. 6,362,813 B1, issued Mar. 26, 2002 (Ex. 1003).

⁴ Although there is an outstanding request for rehearing in this case, it does not address claim 20. *See* Paper 45.

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and 20 of the '770 patent and, on September 22, 2017, we issued a Final Written Decision finding claims 1–4, 12, 15–18, and 20 unpatentable.

IPR2016-00949, Paper 45, 55.

Petitioner did not raise grounds based on Wörn in either IPR2016-00948 or IPR2016-00949. IPR2016-00948, Paper 1, 4–6; IPR2016-00949, Paper 1, 4–6. Patent Owner contends that Petitioner reasonably could have raised the grounds based on Wörn in these earlier *inter partes* reviews. *See Mot.*

The legislative history of the America Invents Act broadly describes what “could have been raised” to include “prior art which a skilled searcher conducting a diligent search reasonably could have been expected to discover.” 157 Cong. Rec. S1375 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl); *see id.* at S1376 (statement of Sen. Kyl) (“This [estoppel] effectively bars such a party . . . from later using inter partes review . . . against the same patent, since the only issues that can be raised in an inter partes review . . . are those that could have been raised in [an] earlier post-grant or inter partes review.”); 157 Cong. Rec. S951–52 (daily ed. Feb. 28, 2011)(statement of Sen. Grassley) (“It also would include a strengthened estoppel standard to prevent petitioners from raising in a subsequent challenge the same patent issues that were raised or reasonably could have been raised in a prior challenge.”); *see Dell Inc. v. Elecs. and Telecomms. Research Inst.*, IPR2015-00549, slip. op. 4–6 (PTAB Mar. 26, 2015) (Paper 10) (representative).

Patent Owner and Petitioner dispute whether a skilled searcher conducting a diligent search reasonably could have been expected to discover Wörn. *See generally*, Mot.; Paper 33 (“Opp.”); Paper 34 (“Reply”).

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Patent Owner provides a Declaration of Bruce Rubinger to support its Motion. Ex. 2034; *see also* Ex. 1018 (cross-examination testimony of Bruce Rubinger). Petitioner provides a Declaration of Reynaldo C. Barcelo (Ex. 1012), a Declaration of Christopher A. Cotropia (Ex. 1020), and a Declaration of Jamila Williams (Ex. 1019) to support its Opposition.

Considering all of Patent Owner's and Petitioner's evidence, we determine that the evidence sufficiently establishes that a skilled searcher conducting a diligent search reasonably could have been expected to discover Wörn.

A skilled searcher performing a diligent search “begins with selecting one or more patent classifications and sub-classification” in the United States Patent Classification (“USPC”). Ex. 1020 ¶ 20; *see also* Ex. 1019, App. 1⁵, 25⁶ (“Since patent classification systems were designed to assist with patent searching, they are a good place to start.”); Ex. 1019 ¶¶ 8–9 (“Once the most pertinent search classes & sub-classes . . . were initially identified . . .”). “[A] professional search requires more than text searching. A systematic and exhaustive search of ‘core’ and ‘peripheral’ subclasses is imperative to a *reliable* search.” Ex. 1019, App. 1, 47–48.

The testimony of the declarants indicates that a skilled searcher would look to the class, subclass descriptions in the USPC to identify relevant

⁵ Appendix 1 of Exhibit 1019 includes excerpts of the book, “Patent Searching: Tools and Techniques,” by David Hunt et al., ISBN: 978-0-0471-78379-4, John Wiley & Sons, 2007. Exhibits 1016 and 2035 contain excerpts of the same book.

⁶ We reference the page numbers in the lower right corner rather than those in the upper right corner.

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searches. *See* Ex. 1020 ¶ 43; Ex. 2035 ¶¶ 42–43. The ’525 patent and the ’770 patent are classified in class 463, “Amusement Devices: Games” (Ex. 3001, 1). Ex. 1001, (58); Ex. 1002, (58). The ’525 patent and the ’770 patent are both classified in subclass 37, “Hand manipulated (e.g., keyboard, mouse, touch panel, etc.)” (Ex. 3001, 16). *Id.* In the USPC, Subclass 37 is indented under subclass 36, “Player-actuated control structure (e.g., brain-wave or body signal, bar-code wand, foot pedal, etc.,” which in turn is indented under subclass 1. Ex. 3001, 16. The USPC classification description for class 463/1 is “Including Means for Processing Electronic Data (e.g., Computer/Video Game, etc.)” and provides references to other classes. *Id.* at 4. It states:

SECTION III – REFERENCES TO OTHER CLASSES
SEE OR SEARCH CLASS:

...

345, Computer Graphics Processing and Selective Visual Display Systems, appropriate subclass for a selectively controlled visual display system which may either form part of a game or not be limited to a game.

Id. at 2.

A skilled searcher also would look to the classes, subclasses of pertinent prior art to identify relevant searches. Ex. 2034 ¶ 6; Ex. 1019, App. 1, 27–29. The ’525 patent and the ’770 patent cite multiple patents classified in class 345. Ex. 1001, (56); Ex. 1002, (56). Some of the cited patents are classified in class 345, subclass 169. *Id.*

The description for class 345 is “Computer Graphics Processing and Selective Visual Display Systems.” Ex. 3002, 1. Subclass 156 is “Display Peripheral Interface Input Device.” *Id.* at 20. Subclass 169 “Portable (i.e., handheld, calculator, remote controller),” is indented under subclass 168,

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“Including keyboard,” which is described as: “Subject matter wherein the operator uses plural keys for selectively inputting information data to control the display device.” *Id.* at 21–22. Subclass 168 is indented under subclass 156. *Id.* at 21. The USPC classification description for class 345 states:

SECTION III – REFERENCES TO OTHER CLASSES

SEE OR SEARCH CLASS:

...

463, Amusement Devices: Games, subclasses 1 through 47, where there is a recited method or apparatus for moving or processing information specified as game or content information (e.g., a video game, etc.) . .

Id. at 3.

Given the above, we determine that a skilled searcher performing a diligent search would have searched class 345 and, in particular, subclass 169. As can be seen from the quoted portions of the USPC above, the USPC cross-references class 345 and class 463 and the descriptive titles of class 463, subclass 37 and class 345, subclass 169 are similar. *See also* Ex. 1020 ¶ 53 (“The Landon IP search even went beyond the USPC classes searched by the ’525 Patent examiner, to include searches in more USPC subclasses of classes 273 and 345”); Ex. 1019, App. 2, 44 (including a search in class 345, subclass 156 at line 22).

Petitioner’s declarant, Mr. Cotropia, testifies, “most skilled searchers would consider the relative applicability of the descriptive titles of the classes and subclasses, and on that basis USPC 345/169 would not be searched.” Ex. 1020 ¶ 20. Mr. Cotropia, however, does not provide a persuasive explanation why a skill searcher would not search class 345, subclass 169, as the descriptive titles of class 463, subclass 37 and class 345, subclass 169 are similar.

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The testimony of the declarants indicates that a skilled searcher would manually search patents having a date prior to the critical date of the '525 patent and '770 patent in identified class, subclasses. Ex. 2034 ¶¶ 8, 10; *see also* Ex. 1019 ¶ 9 (indicating that “[s]everal manual searches” were performed), App. 1, 37 (“You should search the drawings in technical fields where images are essential to the description of the invention.”); Ex. 1020 ¶ 36 (“the key point of novelty of the Subject Patents appears to be a comparison of the length of a back control relative to a greater dimension of a housing. Such a feature is likely to be located only in the drawings . . .”). Wörn is a patent having an appropriate date and classified in class 345, subclass 169. Ex. 1003, (52). The testimony indicates that a skilled searcher would have identified Wörn as pertinent prior art when manually searching class 345, subclass 169. *See e.g.*, Ex. 1012 ¶ 17 (“the drawings of the Wörn prior art reference show the length limitations (for the elongate members of the back controls) of the claims of the '525 and '770 Patents are met”).

Additionally, the testimony of the declarants indicates that a skilled searcher would search prior art in the identified classes, subclasses using keywords. Ex. 1019, App. 1, 27; Ex. 2034 ¶¶ 8, 10; Ex. 1020 ¶ 22. Dr. Rubinger’s testimony indicates that a skilled searcher would have identified Wörn as pertinent prior art using a pertinent keyword search. Ex. 2034 ¶ 8. Dr. Rubinger testifies that the results of the following keyword search, performed using Derwent Innovation, found Wörn: “(remote* OR controller*) AND (middle finger) AND ((button* OR push* OR depress* OR swith *) SAME (back* OR under* OR behind OR rear* OR posterior*)).” Ex. 2034, ¶ 10; *see also* Ex.1012 ¶ 15, App. 2. (indicating

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that a search that discovered Wörn⁷ used similar keywords); Ex. 1019, App. 2 (indicating that searches used similar keywords). This search identified Wörn as one of only 49 patents that could have then been identified with a manual review. Ex. 2034, ¶ 10; Mot. 6.

Given the above, we determine that the preponderance of evidence establishes that a skilled searcher conducting a diligent search reasonably would have been expected to discover Wörn and that Petitioner reasonably could have raised the grounds based on Wörn in the earlier *inter partes* reviews. We, thus, determine that Petitioner is estopped under 35 U.S.C. § 315(e)(1) from maintaining the instant *inter partes* reviews.

Rule 42.72 states: “The Board may terminate a trial without rendering a final written decision, where appropriate” 37 C.F.R. § 42.72. The rules are construed to “secure the just, speedy, and inexpensive resolution of every proceeding.” 37 C.F.R. § 42.1(b); *see* 36 U.S.C. § 316(b). At this stage of the proceeding, an oral hearing, which was requested by Patent Owner (*see* Paper 31 27; 35 U.S.C. § 316(a)(10) (“providing either party with the right to an oral hearing as part of the proceeding”)), has not yet been held and a decision on the merits has not yet been reached.

Considering all of the circumstances of the proceedings, we determine it is appropriate to terminate these *inter partes* reviews as to both Petitioner and Patent Owner and not render a final written decision.

⁷ Wörn was discovered during a search performed after Patent Owner amended its District Court complaint to assert related U.S. Patent No. 9,352,229. *See* Ex. 1012.

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Accordingly, it is:

ORDERED that IPR2017-00136 and IPR2017-00137 are terminated;

FURTHER ORDERED that the oral argument scheduled for February 1, 2018 is canceled.

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