

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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Case IPR2017-01928  
Patent 9,352,229 B2

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

WEATHERLY, *Administrative Patent Judge*.

FINAL WRITTEN DECISION  
*35 U.S.C. § 318(a), 37 C.F.R. § 42.73*

I. INTRODUCTION

A. BACKGROUND

Valve Corporation (“Valve”) filed a petition (Paper 1, “Pet.”) to institute an *inter partes* review of claims 1–24 (the “challenged claims”) of U.S. Patent No. 9,352,229 B2 (Ex. 1001, “the ’229 patent”). 35 U.S.C. § 311. Petitioner supported the Petition with a Declaration from David Rempel, M.D. (Ex. 1008). Ironburg Inventions Ltd. (“Ironburg”) timely

filed a Preliminary Response. Paper 7 (“Prelim. Resp.”). On February 8, 2018, based on the record before us at the time, we instituted an *inter partes* review of claims 1, 2, 9–17, and 21–24. Paper 11 (“Institution Decision” or “Dec.”). On May 24, 2018, pursuant to *SAS Institute, Inc. v. Iancu*, 138 S.Ct. 1348 (2018), we modified our Institution Decision and reintroduced into this proceeding all challenges to the patentability of claims 1–24 alleged in the Petition. Paper 15 (“SAS Order”). Accordingly, we conducted a trial on all challenges to the claims as summarized below:

<b>References</b>	<b>Basis</b>	<b>Claims challenged</b>
U.S. Patent App. Pub. 2015/0238855 A1 (Ex. 1002, “Uy”)	§ 102(a)(2)	1, 2, 9–15, 18, and 20–24
Burns, David, Review: Scuf Xbox 360 Controller, <a href="https://www.xboxer360/features/review/scuf-xbox-360-controller/">https://www.xboxer360/features/review/scuf-xbox-360-controller/</a> (Ex. 1003, “Burns”) and Uy	§ 103	1, 2, 9, 10, 14–17, and 21–24
Burns and Paul, Ryan: “AlphaGrip AG-5 handheld keyboard and mouse,” published 15 March 2006 at <a href="http://arstechnica.com/gadgets/2006/03/alphagrip/">http://arstechnica.com/gadgets/2006/03/alphagrip/</a> (Ex. 1004 (“AlphaGrip”))	§ 103	1, 2, 9–17, 21, and 22
Uy and U.S. Patent 5,989,123 (Ex. 1007, “Tosaki”)	§ 103	3–8 and 19

After we instituted this review, Ironburg filed a Patent Owner Response in opposition to the Petition (Paper 14, “PO Resp.”) that was supported by a Declaration from Glen Stevick, Ph.D. (Ex. 2003). Ironburg also filed a Supplemental Patent Owner Response (Paper 17, “Supp. PO Resp.”) to address the challenges to claims reintroduced pursuant to the *SAS*

Order. Valve filed a Reply in support of the Petition and responding to both the Patent Owner Response and the Supplemental Patent Owner Response (Paper 20, “Reply”), which was supported by another Declaration of Dr. Rempel (Ex. 1019). With our authorization, Valve also filed a supplemental brief addressing the Deposition of Simon Burgess (Paper 24, the “Burgess Brief”). With our authorization, Ironburg filed a Surreply in response to Valve’s Reply (Paper 26, “Surreply”). Ironburg did not move to amend any claim of the ’229 patent.

Ironburg filed a Motion to Exclude Evidence (Paper 30, “Mot.” or “Motion”). Valve opposed the Motion (Paper 31, “Opp.” or “Opposition”). Ironburg filed a Reply in support of the Motion (Paper 32, “Mot. Reply”).

We heard oral argument on November 15, 2018. A transcript of the argument has been entered in the record (Paper 35, “Tr.”).

We have jurisdiction under 35 U.S.C. § 6. The evidentiary standard is a preponderance of the evidence. *See* 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d). This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73.

For the reasons expressed below, we conclude that Valve has failed to establish by a preponderance of evidence that any claim of the ’229 patent is unpatentable.

#### B. RELATED PROCEEDINGS

The parties have identified as a related proceeding the co-pending district court litigation of *Ironburg Inventions Ltd. v. Valve Corporation*, Case No. 1:15-cv-04219-MHC (N.D. Ga.). Paper 4, 1; Pet. 1. Valve also identifies *Ironburg Inventions Ltd. v. Collective Minds Gaming Co. Ltd.*, Case No. 1:16-cv-04110-MHC (N.D. Ga.). Pet. 2. Valve also identifies

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*inter partes* review proceedings IPR2016-00948, IPR2016-00949, IPR2017-00858, IPR2017-00136, and IPR2017-00137 as related because they collectively address related U.S. Patent No. 9,089,770 B2 (collectively, the “Related IPRs”).<sup>1</sup> *Id.* We have issued final written decisions in IPR2016-00948 and IPR2016-00949. We terminated IPR2017-00136 and IPR2017-00137 without issuing final written decisions in response to the joint motions of the parties after they settled their disputes.

### C. THE '229 PATENT

The '229 patent relates to “hand held controllers for game consoles.” Ex. 1001, 1:14–15. The Specification describes conventional controllers as having controls such as buttons, analog control sticks, bumpers, and triggers mounted to the top and front surfaces of the controller that are intended to be actuated by the user’s thumbs or index fingers. *Id.* at 1:19–50.

The Specification identifies and depicts twenty embodiments of game controllers in dozens of figures, *id.* at 6:36–9:12, including a first embodiment of controller 10 illustrated in Figure 2, reproduced below.

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<sup>1</sup> Valve mistakenly refers to IPR2016-00136 and IPR2016-00137 rather than IPR2017-00136 and IPR2017-00137. Pet. 1–2.

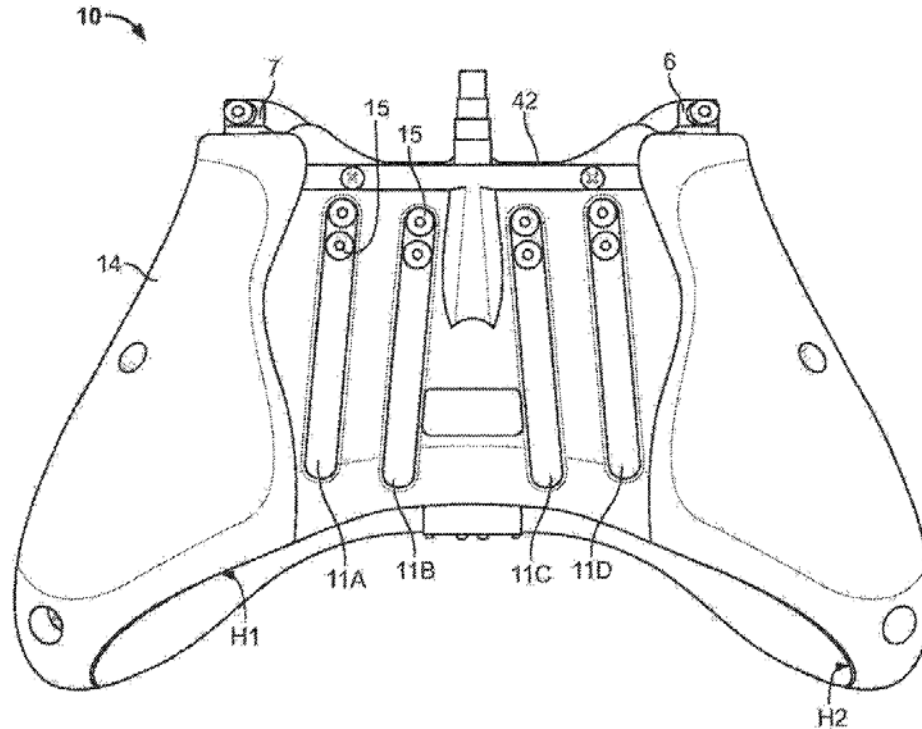


FIG. 2

Figure 2 is “a plan view from below of the rear of a games controller according to the first embodiment.” *Id.* at 6:38–39.

Controller 10 includes paddle levers 11A–D that a user may actuate with the middle, ring, and/or little fingers on the “rear” or underside of controller body 14. *Id.* at 9:24–35. Paddles 11A–D are “formed from a thin, flexible material such as . . . polyethylene . . . [and] are less than 10 mm thick, but may be less than 5 mm thick and more preferably are 3 mm thick or less.” *Id.* at 9:36–40. Paddles 11A–D include apertures on one end for receiving screws 15, which affix that end to the rear of controller 10. The other unsecured end of paddles 11A–D “is movable” and the paddles “can be bent or deformed temporarily” such that the “inherent resilience of the paddles . . . returns the paddles . . . substantially to their starting positions when released.” *Id.* at 9:57–62.

Claims 1 and 24, the only independent claims among those challenged, recite:

1. A hand held controller for a games console comprising:  
an outer case;  
a plurality of controls located on a front and a top of the outer case,

wherein the outer case is shaped to be held in both hands of a user such that the user's thumbs are positioned to operate controls located on the front of the outer case and the user's index fingers are positioned to operate controls located on the top of the outer case; and

at least one additional control located on a back of the outer case in a position operable by the user's middle finger,

the additional control comprising an elongate member which is inherently resilient and flexible such that it can be displaced by the user to activate a control function,

wherein the elongate member is at least partially disposed in a respective channel located on the back of the outer case, the channel being elongated along a longitudinal dimension of the elongate member.

*Id.* at 24:4–20 (with line breaks added for clarity).

24. A hand held controller for a games console comprising:  
an outer case;  
a plurality of controls located on a front and a top of the outer case,

wherein the outer case is shaped to be held in both hands of a user such that the user's thumbs are positioned to operate controls located on the front of the outer case and the user's index fingers are positioned to operate controls located on the top of the outer case;

at least one additional control located on a back of the outer case in a position operable by the user's middle finger,

the additional control comprising an elongate member which is inherently resilient and flexible such that it can be displaced by the user to activate a control function; and  
a mounting plate secured to the back of the outer case;  
the mounting plate comprising a channel; and  
wherein the elongate member is at least partially disposed in the channel.

*Id.* at 26:15–32 (with line breaks added for clarity).

## II. ANALYSIS

### A. CLAIM INTERPRETATION

“A claim in an unexpired patent that will not expire before a final written decision is issued shall be given its broadest reasonable construction in light of the specification of the patent in which it appears.” 37 C.F.R. § 42.100(b) (2016);<sup>2</sup> *see also* *Cuozzo Speed Techs., LLC v. Lee*, 136 S.Ct. 2131, 2144–46 (2016) (affirming that USPTO has statutory authority to construe claims according to Rule 42.100(b)). When applying that standard, we interpret the claim language as it would be understood by one of ordinary skill in the art in light of the specification, and absent any special definition, we give claim terms their ordinary and customary meaning. *See In re Suitco Surface, Inc.*, 603 F.3d 1255, 1260 (Fed. Cir. 2010); *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007) (“The ordinary and customary

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<sup>2</sup> Our recently changed version of this Rule, which requires that we interpret claims in the same manner used in a civil action under 35 U.S.C. § 282(b), does not apply here because the Petition was filed before the effective date of the new Rule, November 13, 2018. *See* Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board, 83 Fed. Reg. 51,340, 51,344 (Oct. 11, 2018).

meaning is the meaning that the term would have to a person of ordinary skill in the art in question.” (internal quotation marks omitted)). Only terms that are in controversy need to be construed, and then only to the extent necessary to resolve the controversy. *See Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999).

1. *Elongate member which is inherently resilient and flexible*

In IPR2016-00948 involving the ’525 patent,<sup>3</sup> we interpreted “inherently resilient and flexible” as applied to the claimed elongate member to mean that the elongate member itself “may be bent or flexed by a load, such as that from a user’s finger, and will then return to its unbiased position when not under load.” *Valve Corp. v. Ironburg Inventions, Ltd.*, IPR2016-00948 (the “’948 IPR”), Paper 10, 14 (PTAB Sept. 26, 2016); *see also* IPR2016-00948, Paper 44, 36–38 (maintaining interpretation stated in Decision Instituting Review). Here, Valve initially argued that we should simply maintain that interpretation for this proceeding. Pet. 7.

The ’525 patent and ’229 patent, although commonly owned, do not claim priority to any common application for patent. *Compare* Ex. 2001, cover page (listing priority applications) *with* Ex. 1001, cover page (listing priority applications). Accordingly, we conclude that the ’525 patent and the ’229 patent are not “related” as having common priority applications, and we do not simply maintain our prior interpretation of the phrase from the ’948 IPR without considering the Specification before us in this proceeding.

In our Institution Decision, we determined “that ‘an elongated member which is inherently resilient and flexible’ as used in the claims of

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<sup>3</sup> The ’525 patent refers to U.S. Patent No. 8,641,525 B2. Ex. 2001.



the '229 patent refers to inherent characteristics of the elongate member itself.” Dec. 9. We also found “that ‘resilient’ and ‘flexible’ as used in the '229 patent both describe inherent properties of the material from which the elongate member is formed, and not other components in an assembly that may include an elongate member.” *Id.* at 9–10.

During the trial, Valve contends that we should alter our initial interpretation of “inherently resilient and flexible” in two ways. Reply 5–9. First, Valve contends that “inherently” modifies “resilient” but not “flexible.” *Id.* at 5–6. Valve contends that this interpretation is consistent with the Specification, which Valve contends never uses “inherent” to modify “flexible.” *Id.* at 6 (citing Ex. 1001, 9:41–43, 9:60–62, 19:50–53, 23:36–38 (discussing inherent resilience), 22:48–50 (discussing flexibility without referring to it as inherent)). Valve also argues that neither the claim language nor the Specification place any limitation on the process or material used to make the “inherently resilient and flexible” elongated member. Reply 5. Valve’s argument is unpersuasive.

Valve fails to explain how a structure can be inherently resilient without also being inherently flexible. Additionally, the Specification that Valve cites as describing a flexible elongated member without labeling that flexibility as being “inherent” supports our conclusion that the flexibility is also an inherent property of the elongated member.

The Specification states: “The paddles 2011A, 2011B, 2011C, 2011D each comprise a flexible region 2041 created by a recess in the surface of the paddles 2011A, 2011B, 2011C, 2011D. As shown in FIG. 45, the recess is disposed in the lower surface of the paddles 2011A, 2011B, 2011C, 2011D.”

Ex. 1001, 22:48–50. Figure 45 of the '229 patent, which is a cross-sectional view taken along line A-A of Figure 44, is reproduced below.

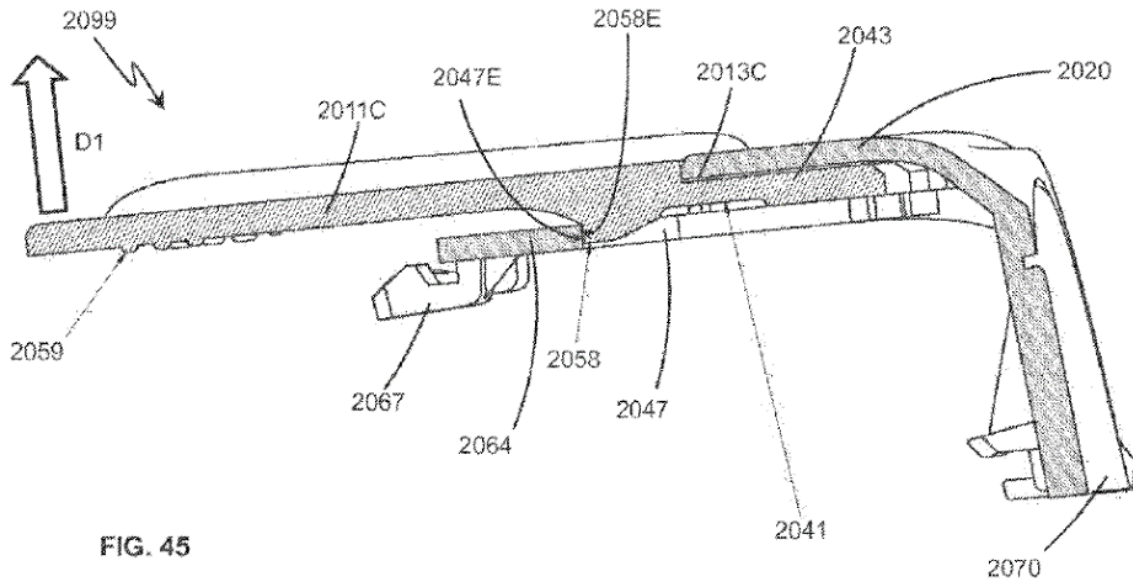


FIG. 45

Figure 45 illustrates the cross-sectional shape of paddle 2011C on the “twentieth embodiment” of the controller. *Id.* at 8:59–9:2.

From Figure 45, it is apparent that paddle 2011C is formed with flexible region 2041 created by the illustrated recess in the surface of the paddle, which results in a thinner cross section in region 2041. *Id.* at 22:48–52, Figure 45. Dr. Rempel agrees that even materials made of very stiff materials may be made flexible if made thin enough. Ex. 1019 ¶ 14. This testimony, and the Specification’s description of making the elongate member thin enough to render the member flexible contradicts Valve’s argument that the ’229 patent places no limits on the process or material used to make an “inherently resilient and flexible” elongate member.

We agree, however, with Valve that the resilience and flexibility of the claimed elongate member need not result solely from the material chosen to form the elongate member as we stated in our Institution Decision. Rather, the Specification indicates that the claimed “inherently resilient and

flexible” nature of the elongate member may be a result of the combination of the material from which the member is formed and the shape in which it is formed. We continue to disagree, however, with Valve’s contention that the claimed elongate member may encompass an assembly of components.

The Specification describes and illustrates elongate members and their relationship to switch 348 in Figure 19 (the pertinent portion of which we reproduce below right) as follows:

A user may displace or depress either of the paddles 11A [or 311A], 11B, 11C, 11D by engaging an outer surface thereof; such displacement causes the paddle 11A, 11B, 11C, 11D to activate a switch mechanism 348 as shown in FIGS. 19 and 20 mounted within the body of the controller 10.

Ex. 1001, 9:43–47.

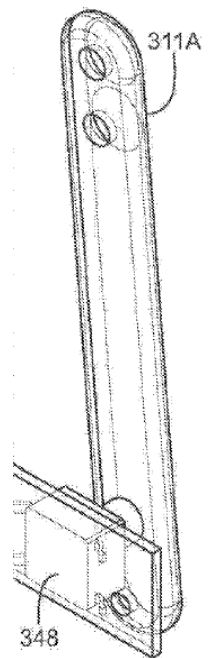
This quoted passage and the Figure reproduced at right indicate that paddle 311A is inherently flexible enough to permit the distal end of paddle 311A above switch 348 to be displaced.

A screw 15, having an external screw thread, is received in each of a pair of apertures provided in each of the paddles 11A, 11B, 11C, 11D. The apertures for receiving the screws are provided at one end of the paddles 11A, 11B, 11C, 11D; this is a fixed end. The other end of the paddles 11A, 11B, 11C, 11D is moveable. In this way, the paddles 11A, 11B, 11C, 11D can be bent or deformed temporarily. *The inherent resilience of the paddles 11A, 11B, 11C, 11D returns the paddles 11A, 11B, 11C, 11D substantially to their starting position when released.*

Ex. 1001, 9:53–62 (emphasis added). This quoted passage indicates that paddles like 311A are also inherently resilient.

Based on these portions of the Specification and the plain language of the claim, we determine that “an elongated member which is inherently resilient and flexible” as used in the claims of the ’229 patent refers to

FIG. 19



inherent characteristics of the elongate member itself. The separate recitation of a “switch mechanism” in dependent claims 19 and 20 and the illustration and description of switch mechanism 348 further supports our conclusion. *See Becton, Dickinson and Co. v. Tyco Healthcare Group, LP*, 616 F.3d 1249, 1253–54 (Fed. Cir. 2010) (When a claim called for a “spring means connected to said hinged arm” the spring means and the hinged arm were distinct structural elements.); *see generally Rambus Inc. v. Infineon Technologies AG et al.*, 318 F.3d 1081, 1091–1093 (Fed. Cir. 2003) (determining that dependent claims demonstrated that an element of the independent claim was distinct from an element first recited in a dependent claim). Accordingly, we determine that “resilient” and “flexible” both describe inherent properties of the elongate member, and not other components in an assembly that may include an elongate member.

#### B. LEGAL STANDARDS

Valve challenges the patentability of the ’229 patent claims as being anticipated and/or obvious. To prevail in its challenges to the patentability of the claims, Petitioner must establish facts supporting its challenges by a preponderance of the evidence. 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d). “In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)). This burden never shifts to Patent Owner. *See Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (citing *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d

1316, 1326–27 (Fed. Cir. 2008)) (discussing the burden of proof in *inter partes* review).

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987). The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007), reaffirmed the framework for determining obviousness as set forth in *Graham v. John Deere Co.*, 383 U.S. 1 (1966). The *KSR* Court summarized the four factual inquiries set forth in *Graham* that we apply in determining whether a claim is reasonably likely to be unpatentable as obvious under 35 U.S.C. § 103(a) as follows:

(1) determining the scope and content of the prior art, (2) ascertaining the differences between the prior art and the claims at issue, (3) resolving the level of ordinary skill in the pertinent art, and (4) considering objective evidence indicating obviousness or nonobviousness. *KSR*, 550 U.S. at 406 (citing *Graham*, 383 U.S. at 17–18). In an *inter partes* review, Petitioner cannot satisfy its burden of proving obviousness by employing “mere conclusory statements.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016). Thus, to prevail Petitioner must explain how the proposed combinations of prior art would have rendered the challenged claims unpatentable. With these standards in mind, we address each challenge below.

C. CLAIMS 1, 2, 9–15, 18, AND 20–24: ANTICIPATION BY UY

Valve argues that Uy anticipates claims 1, 2, 9–15, 18, and 20–24. Pet. 11–23. Valve cites the portions of Uy that allegedly describe every element of these claims. *Id.* at 12–23 (citing Ex. 1002 ¶¶ 98, 104–09,

112–14, Figures 1A, 5B, 5C, 6A, 6B, 8C, 8H). For example, Valve identifies levers 602, 604 as the elongate members of independent claims 1 and 24.<sup>4</sup> Pet. 13–14 (claim 1), 25–26 (claim 24). Valve contends that “the resilience and flexibility may be provided by spring 526 or 806.” *Id.* at 14, 26 (citing Ex. 1002 ¶¶ 104–09, Figure 8H; Ex. 1008 ¶¶ 17–18).

Accordingly, Valve identifies one component, lever 602, 604 as the elongate member, while identifying another component, spring 526 or 806, as providing the claimed resilience and flexibility.

Ironburg argues that Uy fails to anticipate independent claims 1 and 24 because Uy fails to describe an “inherently resilient and flexible” elongate member. Supp. PO. Resp. 7–10. As stated in Part II.A.1 above, we determine that “inherently resilient and flexible” refers to properties of the “elongate member” itself, not an assembly of components. Because springs 526, 806 are formed separately from Uy’s levers 500, 502, 602, 604, and Valve adduces no evidence that Uy’s levers alone are “inherently resilient and flexible,” we determine that Valve has failed to establish that Uy describes the elongate member recited in all challenged claims. For this reason, we conclude that Valve has failed to prove by a preponderance of evidence that Uy anticipates claims 1, 2, 9–15, 18, and 20–24.

#### D. CLAIMS 3–8 AND 19: OBVIOUSNESS IN VIEW OF UY AND TOSAKI

Claims 3 and 4 depend directly from claim 1, Ex. 1001, 24:24–32, and claims 5–8 depend directly or indirectly from claim 3, *id.* at 24:33–45. Claims 3 and 4 each recite a “cover portion” that Valve contends to be

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<sup>4</sup> Valve also implies that levers 500, 502 constitute the claimed elongate members by referring to these levers as an “additional control” as recited in claim 1.

described by Tosaki. Pet. 55–56 (citing Ex. 1007, Figures 6, 7). Claim 19 depends from claim 1 and further recites a “switch mechanism” comprising an “engaging surface being disposed in an aperture in the back of the outer case and arranged flush with an outer surface of the back of the outer case.” Ex. 1001, 25:27–31.

Valve relies upon its contention that Uy describes an inherently resilient and flexible elongate member. Pet. 55. Valve alleges that Tosaki’s disclosure of elastic deformation of its shift levers 125, 126 “reinforce[s]” Uy’s description of an allegedly “inherently resilient and flexible” elongate member. *Id.* However, Valve does not argue that an ordinarily skilled artisan would have been motivated to add resilience and flexibility to Uy’s levers 500, 502, 602, 604 themselves based on Tosaki’s teaching regarding its shift levers 125, 126. *Id.* For the reasons expressed in Part II.C above, we disagree that Uy describes the “inherently resilient and flexible” elongate member of claim 1. Valve’s challenge to claims 3–8 and 19 fails for this reason alone. Valve’s challenge fails for another reason, which we discuss below.

Ironburg argues that Valve fails to provide any reason or rationale for why an ordinarily skilled artisan would have been motivated to combine teachings of Uy and Tosaki to arrive at the invention of claims 3–8 and 19. Supp. PO. Resp. 13–17. In our Institution Decision, we found this argument to be persuasive enough to deny institution of a review on this challenge. Dec. 12–14. Valve has done nothing at trial to persuade us that the combination of Uy and Tosaki renders claims 3–8 and 19 obvious.

Valve argues that an ordinarily skilled artisan would have been motivated to combine teachings from Uy and Tosaki for three reasons and

solely supports its argument with testimony from Dr. Rempel. Pet. 55 (citing Ex. 1008 ¶ 39). First, Valve contends that an ordinarily skilled artisan would have been motivated to combine teachings of Uy and Tosaki because both references describe hand-held game controllers having front controls operated by a user's thumbs and rear controls operable by a middle finger. *Id.* The alleged similarity of Uy and Tosaki might suggest that they could be combined, but the similarity does not provide a reason for doing so or a reason for selecting specific teachings from each reference in combination.

Second, Valve argues that an ordinarily skilled artisan would be motivated to modify Uy because “a cover portion as taught by Tosaki *could be used* to help secure the pivot portion of the elongate members of Uy.” *Id.* (emphasis added). Dr. Rempel testifies to precisely the same thing using precisely the same language. Ex. 1008 ¶ 39. In its Reply, Valve restates the same argument and relies on precisely the same testimony from Dr. Rempel, but it excises the “could be used” language from the argument and testimony. Reply 21–22. Valve's argument remains unpersuasive for the reasons that follow.

Valve's contention that Tosaki “could be used” does not establish that an ordinarily skilled artisan would have used features from Tosaki in Uy. Rather, it merely establishes that Uy and Tosaki could be combined. “[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *KSR*, 550 U.S. at 418. A petitioner cannot demonstrate obviousness “by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal



conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). “To facilitate review, this analysis should be made explicit.” *KSR*, 550 U.S. at 418 (citing *Kahn*, 441 F.3d at 988).

Third, Valve argues that the combination of Uy with Tosaki “would have been expected to be readily practical and successful in this simple and predictable art, and the result would not have been unexpected.” *Id.* (citing Ex. 1008 ¶ 39). Valve’s argument suggests that an ordinarily skilled artisan would have expected that Uy and Tosaki could be successfully combined, but it fails to establish a reason that an ordinarily skilled artisan would have modified specific aspects of Uy based on Tosaki to arrive at the claimed controller.

For all these reasons, we determine that Valve has failed to prove by a preponderance of evidence that the combination of Uy and Tosaki renders any claim of the ’229 patent unpatentable as obvious.

E. CLAIMS 1, 2, 9–17, AND 21–24:

OBVIOUSNESS IN VIEW OF BURNS IN VIEW OF UY OR ALPHAGRIP

For the reasons expressed below, we conclude that Valve has failed to prove by a preponderance of evidence that Exhibit 1003 is a printed publication that qualifies as prior art to any claim of the ’229 patent. Valve’s challenges based on Exhibit 1003 therefore fail. Briefly, we find that Valve has failed to meet its evidentiary burden to prove that the version of an article purportedly authored by David Burns that it submits as alleged prior art, Exhibit 1003, was sufficiently accessible to the persons of ordinary skill before the earliest priority date of the ’229 patent, May 5, 2013.

Valve’s entire showing that Burns qualifies as prior art as set forth in the Petition reads: “Burns qualifies as prior art to the ’229 Patent, at least under 35 U.S.C. §102(a)(1) and 35 U.S.C. §103, because Burns was

published on 2010-10-20, more than one year before the earliest purported priority date of the '229 Patent (2013-05-22).” Pet. 5–6.

Valve must prove that Burns is a prior art printed publication by a preponderance of evidence. 35 U.S.C. § 316(e); *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378-80 (Fed. Cir. 2015). “Whether a reference qualifies as a prior art printed publication is a legal conclusion based upon underlying factual determinations.” *Blue Calypso, LLC v. Groupon, Inc.*, 815 F.3d 1331, 1348 (Fed. Cir. 2016). For a reference retrieved from the internet to qualify as prior art, it must have been made accessible in a way that persons of ordinary skill in the art exercising reasonable diligence could have located it at the relevant time. *Id.* at 1348–49. Ironburg argues that the admissible evidence proffered by Valve falls short of these standards. PO Resp. 8–10; Surreply 2–11. For the reasons that follow, we agree.

Valve responded to Ironburg’s contention that Valve had failed to demonstrate that Burns was prior art in two papers, the Reply and the Burgess Brief. Exhibit 1003 purports to be a review of a game controller authored by David Burns “6 years ago.” Ex. 1003, 1. Exhibit 1003 also includes a number of “comments,” which are indicated with labels such as “6 years ago” and “5 years ago” among others. *Id.* at 4–5. In the upper left corner of each page, Exhibit 1003 is marked with “2/6/2017.”<sup>5</sup> *Id.* at 1–10. The lower left corner of each page of Exhibit 1003 is marked with the following uniform resource locator (“URL”), which is commonly

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<sup>5</sup> Valve provides no evidence explaining the significance of this date or establishing who downloaded Exhibit 1003 or when the Exhibit was downloaded.

understood to be an internet address: <http://www.xboxer360.com/features/review-scuf-xbox-360-controller/>. *Id.* at 1–10.

*1. Evidence Supplied with the Petition*

Valve argues that evidence submitted with the Petition establishes that Burns is prior art and submits additional evidence attempting to bolster its showing with its Reply and the Burgess Brief. We analyze each item of evidence below.

a) The Face of the '229 Patent

Valve argues that the '229 patent itself proves that Burns is a printed publication because the patent lists the “Burns publication” under “Other Publications” along with a publication date of “Oct. 20, 2010.” Reply 1 (citing Ex. 1001). The '229 patent describes the “Burns publication” as follows: “Review: ScufXbox 360 Controller, Dave Burns, pp. 5, Oct. 20, 2010 source: [archive.org/web20/20101022215104/http://www.xboxer360.com/features/review-scuf-xbox-360-controller/](http://archive.org/web20/20101022215104/http://www.xboxer360.com/features/review-scuf-xbox-360-controller/).” Ex. 1001, cover page. Ironburg argues that the listing on the '229 patent fails to prove a date of publication, sufficient accessibility, or the manner in which an ordinarily skilled artisan could have located Exhibit 1003. Surreply 3. We agree. The listing on the '229 patent relates to a different document than Exhibit 1003, one that was apparently cited by the Examiner during prosecution of the '229 patent. *See* Ex. 1001, p. 2 (stating that asterisk after listing of article indicates “cited by examiner”). Valve fails to adduce credible evidence that the article described on the face of the '229 patent could have been accessed by an ordinarily skilled artisan in the relevant time frame or that the article is the same as Exhibit 1003.

b) Markings on Exhibit 1003

Valve next argues that “public comments that were dated approximately ‘6 years ago’ as of the download date shown as 06 February 2017”<sup>6</sup> prove that Exhibit 1003 was published “well before the ’229 patent’s earliest priority date.” Reply 1–2. Valve contends that one of the comments was posted by Simon Burgess, one of the inventors named on the ’229 patent. *Id.*

Valve, however, cites no admissible evidence to prove any of these facts. *Id.* Rather, Ironburg contends, and we agree, that Valve merely relies on markings on Exhibit 1003 itself, all of which are hearsay to prove the truth of the facts that Valve seeks to prove. Mot. 7. We grant Ironburg’s Motion to Exclude Evidence to the extent that it seeks to preclude Valve from relying upon the markings of “2/6/2017,” “6 years ago,” and “Simon Burgess” on Exhibit 1003 to prove the truth of the facts that Valve attempts to prove by referring to those markings.

Valve argues that the exception to the hearsay rule set forth in Federal Rule of Evidence 803(6), the so-called business records exception, permits it to rely upon (1) “2/6/2017” as proof that Exhibit 1003 was downloaded on that date, (2) “6 years ago” as proof that comments were posted six years prior to February 6, 2017, and (3) “Simon Burgess” as proof that Mr. Burgess made comments on the article. Opp. 5–6. Valve’s reliance on the business records exception in Federal Rule of Evidence 803(6) is unavailing. That Rule states:

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<sup>6</sup> Exhibit 1003 is marked on each page with “02/06/2017,” not “06 February 2017.” Ex. 1003, *passim*.

(6) Records of a Regularly Conducted Activity. A record of an act, event, condition, opinion, or diagnosis if:

(A) the record was made at or near the time by — or from information transmitted by — someone with knowledge;

(B) the record was kept in the course of a regularly conducted activity of a business, organization, occupation, or calling, whether or not for profit;

(C) making the record was a regular practice of that activity;

(D) all these conditions are shown by the testimony of the custodian or another qualified witness, or by a certification that complies with Rule 902(11) or (12) or with a statute permitting certification; and

(E) the opponent does not show that the source of information or the method or circumstances of preparation indicate a lack of trustworthiness.

Fed. R. Evid. 803(6). Valve argues that the exception applies because “Exhibit 1003 qualifies . . . as an opinion of author Dave Burns that was reported according to the regular practice of Xboxer360.com (an ‘online magazine’).” Opp. 5–6.

Valve proffers no evidence to establish any of the foundational facts listed in subparts (A)–(C) of the Rule. Valve also fails to proffer testimony from a custodian or “qualified witness” or a certification as set forth in subpart (D) to establish the facts listed in in subparts (A)–(C). Instead, Valve cites testimony of Simon Burgess as apparently establishing that Xboxer360.com was an “online magazine.” Opp. 6 (citing Ex. 1050, 110:13–111:14). Valve’s reliance on Mr. Burgess’s testimony is unpersuasive for two reasons.

First, Valve fails to demonstrate that Mr. Burgess is a custodian or otherwise qualified witness as set forth in Fed. R. Evid. 803(6)(D). Second, even if Mr. Burgess were such a witness, his testimony fails to establish that Rule 803(6) applies to Exhibit 1003. Mr. Burgess testifies as follows:

Q. Do you know somebody by the name of David Burns?

A. Yes.

Q. Who is Mr. Burns?

A. Mr. Burns was the -- I can't remember his title. He worked for an online magazine, which I presumed he owned, called Xboxer360.

Q. Did he also review video game controllers?

A. He reviewed our video game controller, yes.

Q. Did he review other video game controllers?

A. I do not know.

Ex. 1050, 110:13–111:2. At best, Mr. Burgess testifies that he was personally aware of Mr. Burns's review of one video game controller for an "online magazine, which [Mr. Burgess] presumed [Mr. Burns] owned called Xboxer360." *Id.* This testimony does not establish that Xboxer360 was a business having regularly conducted activity or that Xboxer360 kept records in the course of any such activity as set forth in the Rule.

We find that Valve has failed to demonstrate that the business record exception applies to Exhibit 1003. Without such an exception, we find that the markings on Exhibit 1003 are inadmissible hearsay for proving publication date, comment date, or the identity of the alleged author of any comment.

Even if these markings were not inadmissible hearsay, they would still fail to establish that an ordinarily skilled artisan exercising reasonable

diligence could have located the article during the relevant time frame. Instead, they would establish only that Mr. Burns posted an article on the internet and that some people, including a person claiming to be named Simon Burgess, one of the inventors named on the '229 patent, commented on the article.

c) The URL as Evidence of Public Accessibility

Valve argues that the presence of the following internet address on Exhibit 1003—“<http://www.xboxer360.com/features/review-scuf-xbox-360-controller/>”—proves that Exhibit 1003 was publicly accessible by an ordinarily skilled artisan during the relevant timeframe, citing Dr. Rempel’s testimony in support. Reply 20 (citing Ex. 1019 ¶ 13). Dr. Rempel testifies that “[i]n the video game industry in 2013, a POSITA was adroit at finding and accessing publications of interest, for example using an internet address.” Ex. 1019 ¶ 13.

Ironburg argues that an internet address alone fails to establish sufficient accessibility by an ordinarily skilled artisan during the relevant timeframe. Surreply 7–8. The Federal Circuit has found that an address for an online reference alone does not prove sufficient accessibility to justify a finding that the reference is a printed publication. *Blue Calypso*, 815 F.3d at 1348–50. The *Blue Calypso* decision dealt with a reference that was “available via a hyperlink” on the personal webpage of the author. *Id.* at 1348. The Federal Circuit agreed with the Board’s conclusion that the petitioner failed to establish that “an interested party exercising reasonable diligence would have located” the reference. *Id.* at 1349–50. The analysis focused on whether the evidence proved that interested parties either

downloaded the reference or could have found the reference via a search query, index, or other means. *Id.*

Dr. Rempel's testimony, when examined closely, merely indicates that an ordinarily skilled artisan in 2013 could have used a URL to access publicly available material on the internet. Although Dr. Rempel testifies that an ordinarily skilled artisan in 2013 was "adroit" at "finding" a reference using, for example, a URL, he does not explain how URLs enable "finding" a reference in the sense of discovering the reference via a search. Instead, we understand his testimony to reflect that, if a person were supplied with a URL, that person would be able to "find" and "access" material associated with the URL if that material were on a public server. He also does not testify that the URL itself rendered the reference more amenable to searches or caused the reference itself to be indexed in a manner that an ordinarily skilled artisan would have been able to locate it using reasonable diligence. He also does not testify that anyone was, in fact, supplied with the URL appearing on Exhibit 1003 during the relevant timeframe or that the URL on Exhibit 1003 linked to material that was publicly accessible.

After careful consideration of the evidence adduced by Valve, we determine that the presence of the URL shown on Exhibit 1003 does not demonstrate that an ordinarily skilled artisan who exercised reasonable diligence would have been able to locate Exhibit 1003 during the relevant timeframe.

## *2. Evidence Supplied After the Petition*

First, Valve argues that actions by the applicants during prosecution of the '229 patent and the '525 patent prove that Exhibit 1003 was a printed



publication as of October 20, 2010. Reply 2–3. Valve argues that the applicant for the '229 patent “provided the same Burns publication date (October 20, 2010)” to the Office “via an IDS that listed the Burns publication along with other prior art.” *Id.* at 2 (citing Ex. 1012, 280, 418, 441–461; Ex. 1011 ¶¶ 2–4; Ex. 1014 ¶¶ 4–7).

Exhibit 1012 is a copy of the file history for the '229 patent. Ex. 1012. The IDS supplied by the applicant at page 280 does not provide a publication date of October 20, 2010, but instead states: “Burns, ‘Review: Scuf Xbox 360 Controller,’ Xboxer360.com (2010).” Ex. 1012, 280. The Federal Circuit has explained that “mere submission of an IDS to the USPTO does not constitute the patent applicant’s admission that any reference in the IDS is material prior art.” *ResQNet.com, Inc. v. Lansa, Inc.*, 594 F.3d 860, 866 (Fed. Cir. 2010) (quoting *Abbott Labs. v. Baxter Pharm. Prods., Inc.*, 334 F.3d 1274, 1279 (Fed.Cir.2003)). As such, the IDS alone is insufficient to prove that Exhibit 1003, apparently downloaded years after 2010,<sup>7</sup> was published as of October 20, 2010, or accessible to the relevant public as of that date or any other date.

Exhibits 1011 and 1014 are declarations from Dr. Rempel and counsel for Valve, Mr. Barceló, respectively in which they compare Exhibit 1003 with a version of the Burns article entered into the prosecution record by the Examiner as non-patent literature along with a Notice of Allowability.<sup>8</sup> Ex. 1011 ¶¶ 2–4; Ex. 1014 ¶¶ 4–7. The NPL version of Burns is marked

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<sup>7</sup> As we have already noted, Valve supplies no admissible evidence establishing how or when it obtained Exhibit 1003.

<sup>8</sup> *See* Ex. 1012, 414 (describing Burns article relied upon by Examiner), 441–461 (copy of Burns article relied upon by Examiner).

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“October 20, 2010 by Dave Burns.” Ex. 1012, 441. Both witnesses frame their testimony relating to Exhibit 1003 in a manner that undermines their credibility and renders their testimony unreliable.

Dr. Rempel testifies: “I have carefully reviewed Exhibit 1003 of IPR2017-01928, ‘Review: Scuf Xbox 360 Controller’ by Dave Burns, published 20 October 2010 at <https://web.archive.org/web/20101022215104/www.xboxer360.com/features/review-scuf-xbox-360-controller>.” Ex. 1011 ¶ 2. Even a cursory review of Exhibit 1003 reveals that it neither states that it was published on “20 October 2010” nor includes a reference to the URL specified by Dr. Rempel. Ex. 1003, 1. Exhibit 1003 states: “Review: Scuf Xbox 360 Controller[,] Words by: Dave Burns | Posted: 6 years ago | Filed under: Features.” *Id.* Exhibit 1003 does include a URL, but not the one identified by Dr. Rempel. Instead, the URL appearing on Exhibit 1003 reads: “<http://www.xboxer360.com/features/review-scuf-xbox-360-controller/>.” *Id.* We conclude that Dr. Rempel’s claim that he “carefully reviewed Exhibit 1003” is inconsistent with the Exhibit itself, and we give little weight to his testimony for that reason.

Mr. Barceló testifies: “Petitioner’s Exhibit 1003 to the IPR petition in instituted trial IPR2017-01928 is a true and correct copy of the non-patent literature (NPL) publication “Review: Scuf Xbox 360 Controller” by Dave Burns, published 20 October 2010 at <https://web.archive.org/web/20101022215104/www.xboxer360.com/features/review-scuf-xbox-360-controller>.” Ex. 1014 ¶ 4. Just as with Dr. Rempel’s discredited testimony above, Mr. Barceló’s testimony is plainly inconsistent with the face of Exhibit 1003 regarding the critical points of the publication date and URL that actually appear on Exhibit 1003. Accordingly, we give little weight to

Mr. Barceló's testimony that Exhibit 1003 is a "true and correct copy" of Exhibit 1003. Mr. Barceló's testimony in the following paragraph recognizes that Exhibit 1003 is not a true and correct copy of the NPL when he testifies that exhibit matches "in all material aspects the version available for public download at the Internet URL listed in the previous paragraph."<sup>9</sup> *Id.* ¶ 5. Matching in "all material aspects" does not address specifically any date and URL differences that may exist between Exhibit 1003 and the alleged NPL version of Burns referenced by Mr. Barceló, which is not of record.

Second, Valve argues that "Mr. Burgess' recognition of the fact of Burns' publication carries considerable weight, because Mr. Burgess was a contributor with first-hand knowledge of the Burns article." Reply 3 (citing Ex. 1035, 1–2). The evidence relied upon is a declaration from Mr. Burgess submitted during prosecution of the '525 patent, Exhibit 1035. It is unclear what Valve means by "recognition of the fact of Burns' publication." Regardless, we reject any implication that Exhibit 1035 demonstrates that Mr. Burgess admitted that the Burns article was a prior art printed publication. Exhibit 1035 establishes only that, in November 2011, Mr. Burgess had reviewed a copy of the Burns article that the Office cited as prior art under pre-AIA § 102(e). Ex. 1035 ¶ 2.

However, Mr. Burgess did not testify that the cited article was published on October 20, 2010. Instead, Mr. Burgess testified that he had supplied the controller that was the subject of that review and that he was in possession of his invention before the alleged date of publication of the

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<sup>9</sup> Mr. Barceló does not attach a copy of any document downloaded from the specified URL or testify that he ever downloaded such a copy.

Burns article. *Id.* ¶ 7. At no point in his declaration, did Mr. Burgess testify about the accessibility of the version of the Burns article that was the basis of the rejection of claims or admit that the article was a prior art printed publication. To the contrary, Mr. Burgess merely supplied testimony sufficient to establish that the version of the Burns article before the Office at the time was not prior art to the invention at issue under pre-AIA § 102(a).<sup>10</sup> Mr. Burgess offered no testimony on the degree to which the Burns article relied upon by the Examiner was disseminated publicly or could have been located by an ordinarily skilled artisan.

Valve also argues that Mr. Burgess “recognizes the 10/20/2010 publication by David Burns in Xboxer360 (Exhibit 64 of the Burns deposition [*and Exhibit 1003 in IPR2017-01928*]).” Burgess Brief 3. We disagree that Mr. Burgess “recognizes the 10/20/2010 publication” of “Exhibit 1003” because Exhibit 1003 was not before Mr. Burgess as implied by the bracketed statement in the quoted portion of the Burgess Brief. Instead, Mr. Burgess testified about deposition Exhibit 64, which is also marked as Exhibit 1048 in this proceeding. Ex. 1048, 1. No evidence of record establishes that Mr. Burgess has ever seen or testified about Exhibit 1003. Valve also states that it is not relying upon any date

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<sup>10</sup> It is unclear how Burns could have qualified as prior art under pre-AIA § 102(e) as indicated by the Examiner, Ex. 1040, 159, because Burns was neither a patent nor a published patent application but instead was characterized as an “NPL document,” *id.* at 158. Rather, Burns may have been prior art as a printed publication under pre-AIA § 102(a). However, the applicant supplied the Office with the Burgess Declaration to overcome the rejection posed by the Examiner by demonstrating that Burgess had possession of the invention before the alleged publication of the Burns article. *Id.* at 190.

information on Exhibit 1048 for the purposes of establishing when Exhibit 1003 was published or who would have been able to find or access it.

Opp. 6. Accordingly, we find that Mr. Burgess' testimony does not establish that Exhibit 1003 was a printed publication.

### *3. Conclusion*

Based upon our careful review of each argument and item of evidence submitted by Valve and Ironburg's countervailing arguments, we conclude that Valve has failed to establish by a preponderance of evidence that Exhibit 1003 is a printed publication. Without Exhibit 1003 as a prior art reference, Valve's challenges to claims 1, 2, 9, 10, 14–17, and 21–24 as being obvious over the combination of Burns and Uy and to claims 1, 2, 9–17, 21, and 22 as being obvious over the combination of Burns and AlphaGrip fail.

### III. MOTION TO EXCLUDE

Ironburg moves to exclude numerous exhibits or specific portions of exhibits from evidence on numerous grounds. For the reasons expressed in Part II.E.1.b) above, we grant Ironburg's Motion in part to exclude from evidence the markings on Exhibit 1003 as they relate to proving (1) the date on which Exhibit 1003 was published, (2) the date on which any person commented on the Burns article, and (3) the identity of the alleged author of any such comment. We have otherwise considered all the evidence that is subject to the Motion and found that the evidence fails to establish that Exhibit 1003 is a prior art printed publication. To the extent that the other evidence subject to the Motion relates to other issues, we find it unnecessary to resolve those issues or the admissibility of the related evidence.

Therefore, we dismiss the Motion in all other respects without prejudice as being moot.

#### IV. CONCLUSION

Valve has failed to demonstrate by a preponderance of the evidence that any challenged claims are unpatentable.

#### V. ORDER

For the reasons given, it is:

ORDERED that Valve has not established by preponderance of evidence that any claim of U.S. Patent 9,352,229 B2 is *unpatentable*;

FURTHER ORDERED that Ironburg's Motion to Exclude Evidence is granted-in-part to the extent described above and otherwise dismissed without prejudice as moot in all other respects; and

FURTHER ORDERED because this is a final written decision, the parties to this proceeding seeking judicial review of our Decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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