

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VALVE CORPORATION,
Petitioner,

v.

IRONBURG INVENTIONS LTD.,
Patent Owner.

Case IPR2017-00858
Patent 9,289,688 B2

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

WEATHERLY, *Administrative Patent Judge*.

DECISION

Denying Petitioner's Request on Rehearing of Final Written Decision
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Valve Corporation ("Valve") filed a petition (Paper 1, "Pet.") to institute an *inter partes* review of claims 1–3, 9, 10, 18–22, and 26–30 (the "challenged claims") of U.S. Patent No. 9,289,688 B2 (Ex. 1001, "the '688 patent"). 35 U.S.C. § 311. Petitioner supported the Petition with a Declaration from David Rempel, M.D. (Ex. 1009). Ironburg Inventions Ltd.

(“Ironburg”) timely filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). On September 1, 2017, based on the record before us at the time, we instituted an *inter partes* review of claims 1–3, 9, 10, 20, 22, and 26–30. Paper 7 (“Institution Decision” or “Dec.”). On May 7, 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 1–3, 9, 10, 18–22, and 26–30 alleged in the Petition. Paper 28 (“SAS Order”). Accordingly, we conducted a trial on all challenges to the claims as summarized below:

References	Basis	Claims challenged
U.S. Patent App. Pub. 2015/0238855 A1 (Ex. 1002, “Uy”)	§ 102(a)(2)	1–3, 9, 10, 20, 22, 26–30
U.S. Patent No. D711,881 S (Ex. 1003, “Bellinghausen”) and Burns, David, Review: Scuf Xbox 360 Controller, https://www.xboxer360/features/review-scuf-xbox-360-controller/ (Ex. 1004, “Burns”)	§ 103	1, 26, 30
Burns and U.S. Patent No. D419,985 (Ex. 1005, “LaCelle”)	§ 103	1, 2, 18, 19, 21, 26, 28–30
Burns and U.S. Patent No. D502,468 S (Ex. 1007, “Knight”)	§ 103	1, 2, 9, 10, 21, 30
Butler, Harry, Razer Sabertooth Review, http://www.bit-tech.net/hardware/2013/03/11/razer-sabertooth-review/1 (Ex. 1008, “Butler”)	§ 102(a)(1)	1, 2, 9, 10, 20, 26, 28–30

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. 2001). Valve filed a Reply in support of the Petition. (Paper 19, “Reply”). With our authorization, Ironburg filed a Supplemental Patent Owner Response (Paper 39, “Supp. PO Resp.”) to address the challenges to claims reintroduced pursuant to the SAS Order. Valve filed a Supplemental Reply in support of the Petition and responding to the Supplemental Patent Owner Response (Paper 43, “Supp. Reply”), which was supported by another Declaration of Dr. Rempel (Ex. 1019). With our authorization, Ironburg filed a Sur-reply addressing arguments set forth in Valve’s Supplemental Reply. (Paper 50, “Ironburg Surreply”). Also with our authorization, Valve filed a brief responding to the Ironburg Sur-reply. (Paper 52, the “Valve Sur-reply”). Each party also submitted a brief addressing the relevance of deposition testimony from Simon Burgess (Exhibit 1046). Paper 59 (the “Burgess Brief”); Paper 62 (the “Burgess Resp.”). Ironburg did not move to amend any claim of the ’688 patent.

Ironburg filed three motions to exclude evidence (Papers 25, 48, 63), each of which was opposed by Valve (Papers 27, 51, 64) and supported by Ironburg with reply briefs (Papers 29, 53, 65).

We heard oral argument on September 7, 2018, a transcript of which has been entered in the record (Paper 66, “Tr.”).

We entered our Final Written Decision on February 28, 2019, Paper 68 (“Final Written Decision” or “Final Dec.”), in which we concluded that Valve had proven by a preponderance of evidence that claims 1, 2, 9, 10, 20, 22, and 27, 28, and 30 of U.S. Patent 9,289,688 B2 were unpatentable. Final Dec. 45–46. As part of our Decision, we concluded that

Valve had failed to prove that Burns was a prior art printed publication. *Id.* at 32–39.

Valve filed a timely Request for Rehearing in which it asks that we withdraw our finding that it did not establish that Burns is prior art and address the merits of the challenges to claims 1, 2, 9–17, and 21–24 based, in part, on Burns. Paper 69 (“Reh’g Req.” or “Request for Rehearing”).

II. ANALYSIS

“The burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.” 37 C.F.R. § 42.71(d). Therefore, Valve must demonstrate that we misapprehended or overlooked matters previously argued and specifically identify the location in its papers at which it made the argument that we misapprehended or overlooked in order to justify modifying our Final Decision. It has failed to do so.

Instead, Valve asks us to reconsider and reweigh evidence and consider new arguments advanced in its Request for Rehearing. At the center of Valve’s argument is a proposition that Burns as submitted as Exhibit 1004 is “the same” as other copies of what Petitioner asserts to be the same article that was available at the following URL:

<https://web.archive.org/web/20101022215104/www.xboxer360.com/features/review-scuf-xbox-360-controller> (the “Webarchive URL”). Reh’g

Req. 2–4, 6–7, 10–11. Petitioner asserts that Exhibits 1040,¹ 1041, and 1048 are copies of a document retrieved using the Webarchive URL and that those documents are the same as Exhibit 1004, the document submitted as the prior art reference relied upon by Petitioner. *Id.* at 2–4.

As explained in detail in our Final Decision, we do not consider Exhibit 1004 to be the same as the document accessible using the Webarchive URL. Final Dec. 32–39. The URL listed on Exhibit 1004 refers to a URL on the xboxer360.com domain, not the Webarchive URL on the web.archive.org domain. Ex. 1004, 1–10. Contrary to Valve’s contentions otherwise, URLs are not prior art materials themselves, but merely addresses that might permit a user to access information via the internet. In other words, URL’s tell where information is located, but do not identify what information is found at that address.

Valve argues that we impermissibly excluded the markings reading “Posted: 6 years ago” and “2/6/2017” from evidence because Ironburg waived its objection to that effect. Reh’g Req. 9 (citing Final Dec. 35; 5 U.S.C. § 554(b)(3) (arguing that the section requires “notice of ‘matters of fact and law asserted’ in a hearing”). In our Final Decision, we expressly recognized that Ironburg had waived its objection, and we explained that even if we were to consider the disputed markings in evidence, we found

¹ The cited pages of Exhibit 1040 (pp. 171–179) refer to a copy of the Burns article provided by the Examiner during prosecution of an unrelated but commonly owned patent that appears to have been retrieved from the “Wayback Machine” web archive. *See* Ex. 1040, 172 (referring to “WAYBACK MACHINE”). However, neither the cited pages nor the Examiner’s Notice of References Cited lists the Webarchive URL. *See id.* at 165, 171–179 (listing only URL to xboxer360.com domain as source of Burns article).

Valve's showing to be unavailing. Final Dec. 35. Nevertheless, to clarify the record for appeal, we expressly state that the markings on Exhibit 1004 remain in evidence. Because we explained that our decision did not rest upon the exclusion of the markings from evidence, we will not reweigh the evidence now.

Otherwise, Valve wholly fails to identify any specific argument or evidence that it advanced during the trial that we misapprehended or overlooked in reaching our decision on the issue of whether Valve had proven that Exhibit 1004 was a prior art printed publication.

Throughout the Request for Rehearing, Valve advances new arguments and relies upon newly identified or submitted evidence or newly cited legal authority in an attempt to prove that Exhibit 1004 qualifies as a prior art printed publication. Reh'g Req. 2–10. We do not consider those new arguments, evidence, and citations to authority to be properly before us under Rule 42.71(d), which requires Valve to identify the place in papers submitted during the trial where it previously addressed any such argument, evidence, and authority. *See* 37 C.F.R. § 42.71(d). Accordingly, we express no opinion on the persuasiveness of those new arguments, evidence, or citations to authority.

III. CONCLUSION

For all the reasons expressed above, we deny Valve's Request for Rehearing. Accordingly, our Final Decision remains unmodified, and the time period for seeking judicial review of that Decision runs from the date on which this Paper is entered as set forth in 37 C.F.R. § 90.3(b).

Outcome of Decision on Rehearing:

Claims	Title 35 §	Reference(s)/ Basis	Denied	Granted
1, 26, 30	103	Bellinghausen, Burns	1, 26, 30	
1, 2, 18, 19, 21, 26, 28-30		Burns, LaCelle	1, 2, 18, 19, 21, 26, 28-30	
1, 2, 9, 10, 21, 30		Burns, Knight	1, 2, 9, 10, 21, 30	
Overall Outcome			1, 2, 9, 10, 18, 19, 21, 26, 28-30	

Final Outcome of Final Written Decision after Rehearing:

Claims	Title 35 §	Reference(s)/ Basis	Claims Shown Unpatentable	Claims Not Shown Unpatentable
1-3, 9, 10, 20, 22, 26-30	102(a)(2)	Uy	1, 2, 9, 10, 20, 22, 27, 28, 30	3, 26, 29
1, 26, 30	103	Bellinghausen, Burns		1, 26, 30
1, 2, 18, 19, 21, 26, 28-30	103	Burns, LaCelle		1, 2, 18, 19, 21, 26, 28-30
1, 2, 9, 10, 21, 30	103	Burns, Knight		1, 2, 9, 10, 21, 30
1, 2, 9, 10, 20, 26, 28-30	102(a)(1)	Butler		1, 2, 9, 10, 20, 26, 28-30
Overall Outcome			1, 2, 9, 10, 20, 22, 27, 28, 30	3, 18, 19, 21, 26, 29

IV. ORDER

For the reasons given, it is:

ORDERED that Valve's Request for Rehearing is *denied*; and

FURTHER ORDERED that the time period for any party to seek judicial review of our Final Decision in this proceeding runs from the date on which this Order is entered under 37 C.F.R. § 90.3(b); and

FURTHER ORDERED that any party seeking judicial review of our Final Decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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