

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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IPR2017-00858  
Patent 9,289,688 B2

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

WEATHERLY, *Administrative Patent Judge*.

JUDGMENT

Final Written Decision on Remand  
Determining No Challenged Claims Unpatentable  
*35 U.S.C. §§ 144, 318*

I. INTRODUCTION

A. Trial Background

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 "Inst. 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:

Claims Challenged	35 U.S.C. §	Reference(s)/Basis
1–3, 9, 10, 20, 22, 26–30	102(a)(2)	Uy <sup>1</sup>
1, 26, 30	103	Bellinghausen, <sup>2</sup> Burns <sup>3</sup>
1, 2, 18, 19, 21, 26, 28–30	103	Burns, LaCelle <sup>4</sup>
1, 2, 9, 10, 21, 30	103	Burns, Knight <sup>5</sup>
1, 2, 9, 10, 20, 26, 28–30	102(a)(1)	Butler <sup>6</sup>

<sup>1</sup> U.S. Patent App. Pub. 2015/0238855 A1 (Ex. 1002, "Uy").

<sup>2</sup> U.S. Patent No. D711,881 S (Ex. 1003, "Bellinghausen").

<sup>3</sup> Burns, David, Review: Scuf Xbox 360 Controller, <https://www.xboxer360/features/reviewscuf-xbox-360-controller/> (Ex. 1004, "Burns").

<sup>4</sup> U.S. Patent No. D419,985 (Ex. 1005, "LaCelle").

<sup>5</sup> U.S. Patent No. D502,468 S (Ex. 1007, "Knight").

<sup>6</sup> Butler, Harry, Razer Sabertooth Review, <http://www.bit-tech.net/hardware/2013/03/11/razer-sabertooth-review/1> (Ex. 1008, "Butler").

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 Surreply 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 Surreply. (Paper 52, the “Valve Surreply”). 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 a corrected Final Written Decision (Paper 68, “Decision” or “Dec.”) in which we concluded that Valve had demonstrated by a preponderance of evidence that Uy anticipated claims 1, 2, 9, 10, 20, 22, 27, 28, and 30 of the ’688 patent, but failed to do so for claims 3, 26, and 29.

Dec. 21–29. We also concluded that Valve had failed to demonstrate by a preponderance of evidence that Butler anticipated any claim of the ’688 patent. *Id.* at 29–32. Lastly, we also concluded that Valve had failed to prove by a preponderance of evidence that Burns was a prior art printed publication. *Id.* at 32–39. On this basis, we concluded that Valve’s collective challenges to the patentability of claims 1, 2, 9, 10, 18, 19, 21, 26, and 28–30 as being obvious over the combination of Burns in view of one of Bellinghausen, LaCelle, or Knight failed. *Id.*

#### B. The Appeal to the Federal Circuit

On August 17, 2021, the Federal Circuit affirmed-in-part, vacated-in-part, and remanded-in-part our prior Decision. *Valve Corp. v. Ironburg Inventions Ltd.*, 8 F.4th 1364, 1381 (Fed. Cir. 2021). Paper 76.<sup>7</sup> The Federal Circuit affirmed our determination that Uy anticipated claims 1, 2, 9, 10, 20, 22, 27, 28, and 30. *Valve*, 8 F.4th at 1381. The Federal Circuit also affirmed our determination that Uy did not anticipate claim 29. *Id.* at 1378–79. Valve did not appeal our Decision to the extent that we concluded that Uy did not anticipate claims 3 and 26 and that Butler did not anticipate claims 1, 2, 9, 10, 20, 26, and 28–30. *Id.* at 1368–69, n.1. The Federal Circuit reversed our determination that Burns was not prior art. *Id.* at 1381. The Federal Circuit also vacated our determination that claims 18, 19, 21, 26, and 29 had not been proven unpatentable as obvious in view of Burns in combination with various other prior art references. *Id.* Accordingly, the Federal Circuit remanded the case to us to consider Valve’s challenges to the patentability of claims 18, 19, 21, 26, and 29 of the

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<sup>7</sup> The Federal Circuit issued its mandate on October 8, 2021. Paper 75.

'688 patent as obvious based on the combinations of prior art listed in the table below.

Claim(s) <sup>8</sup>	35 U.S.C. §	References
18, 19, 21, 26, 29	103	Burns, LaCelle
21	103	Burns, Knight
26	103	Bellinghausen, Burns

*Id.*

### C. Remand Background

On remand, we authorized the parties to concurrently file an opening brief and then concurrently file responsive reply briefs. Paper 77, 4. The parties agreed, and we concurred, that no new evidence would be submitted during the remand proceeding. *Id.* Accordingly, we decide the issues on remand based on the record that was submitted during the original trial.

Valve filed an opening brief (Paper 79, “Valve Remand Br.”). Ironburg filed an opening brief (Paper 78, “Ironburg Remand Br.”). Valve filed a Reply responding to Ironburg’s opening brief (Paper 82, “Valve Remand Reply”). Ironburg filed a Reply responding to Valve’s opening brief (Paper 84, “Ironburg Remand Reply”).

During the original trial, the panel dismissed without prejudice as moot Ironburg’s motions to exclude evidence (Papers 48 and 63).<sup>9</sup> Dec. 45.

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<sup>8</sup> Because all the claims to be addressed on remand depend directly from claim 1, we instructed the parties to address on remand the manner in which the combinations of Burns with the references above teach or suggest the limitations recited in claim 1. Paper 77, 3, n.3.

<sup>9</sup> In Paper 48, Ironburg seeks to exclude evidence submitted with Valve’s Supplemental Reply included the Dr. Rempel’s Reply Declaration (Exhibit 1019). Paper 48. As explained in Part II.D below, we find that Valve, by

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