

8 F.4th 1364
United States Court of
Appeals, Federal Circuit.

VALVE CORPORATION, Appellant

v.

IRONBURG INVENTIONS

LTD., Cross-Appellant

Andrew Hirshfeld, Performing
the Functions and Duties of the
Under Secretary of Commerce for
Intellectual Property and Director
of the United States Patent and
Trademark Office, Intervenor

2020-1315, 2020-1316, 2020-1379

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Decided: August 17, 2021

Synopsis

Background: Petitions for inter partes review were filed to challenge validity of patents directed to hand held controllers for game consoles. The Patent Trial and Appeal Board (PTAB), [2019 WL 494366](#), denied one petition, granted other petition in part, [2019 WL 994650](#), and denied rehearing, [2019 WL 5608329](#) and [2019 WL 5608310](#). Parties appealed.

Holdings: The Court of Appeals, Dyk, Circuit Judge, held that:

[1] testimony that exhibit and prior art article were identical was not required to authenticate exhibit;

[2] judicial notice could be taken of contents of webpages available through online digital

archive of web pages run by nonprofit library in San Francisco, California;

[3] “inherently resilient and flexible” limitation in patent was not anticipated by prior art;

[4] petitioner forfeited its Appointments Clause challenge;

[5] phrase, “first surface disposed proximate an outer surface of the case,” required first surface of additional control and outer surface of case to be arranged close or near to each other, but it did not require them to be facing each other;

[6] Court of Appeals could determine correct construction of disputed limitation; and

[7] “opposing” limitation in patent was met by two surfaces that faced each other or were opposite each other, but they did not have to be substantially flat.

Affirmed in part, reversed in part, vacated in part, and remanded.

West Headnotes (19)

[1] Patents 🔑 Inter partes review

On inter partes review of patent directed to hand held controllers for game consoles, testimony that exhibit and prior art article were identical was not required to authenticate exhibit, since comparison by trier of fact was sufficient, difference in dates did not bear on subject matter being

disclosed, which was identical in each document, dates were consistent with exhibit being later than article and did not suggest that exhibit was materially different, and difference in exhibit and article as result of how exhibit was printed did not amount to affirmative evidence challenging exhibit or article's material facts. 35 U.S.C.A. § 102(a)(1); Fed. R. Evid. 901(a).

[2] Patents ← Evidence

An inter partes review petitioner may provide evidence of public accessibility of a reference after the petition stage if the patent owner raises a challenge to public accessibility. 35 U.S.C.A. § 102(a)(1).

[3] Patents ← Questions of law or fact

Whether a reference qualifies as a “printed publication” under patent law is a legal conclusion based on underlying factual findings. 35 U.S.C.A. § 102.

[4] Patents ← Scope of Review

Court of Appeals reviews the Patent Trial and Appeal Board's (PTAB) legal determinations de novo, but reviews the PTAB's factual findings underlying those determinations for substantial evidence.

[5] Patents ← Evidence

In inter partes review, petitioner bears burden of establishing by preponderance of evidence that particular document is printed publication. 35 U.S.C.A. § 102.

[6] Patents ← Accessibility

For reference to qualify under patent law as printed publication, before critical date reference must have been sufficiently accessible to public interested in art. 35 U.S.C.A. § 102.

[7] Patents ← Evidence

Patent examiner's determination of a publication date is a factual finding from a legally authorized investigation and is supported by sufficient guarantees of trustworthiness to be admissible on inter partes review to determine whether a reference qualifies as a printed publication. 35 U.S.C.A. § 102; Fed. R. Evid. 803(8)(A)(iii), 807(a)(1).

[8] Evidence ← Historical facts

Contents of webpages available through online digital archive of web pages run by nonprofit library in San Francisco, California were facts that could be accurately and

readily determined from sources whose accuracy reasonably could not be questioned, as required to take judicial notice on inter partes review of patent directed to hand held controllers for game consoles. [Fed. R. Evid. 201](#).

[9] Patents → **Accessibility**

The standard for public accessibility, as required for a reference to be considered prior art, is one of reasonable diligence to locate the information by interested members of the relevant public. [35 U.S.C.A. § 102](#).

[10] Patents → **Computers and Software**

“Inherently resilient and flexible” limitation, in patent directed to hand held controllers for game consoles, was not anticipated by prior art directed to “game controller” with “lever disposed on a second side of the housing,” i.e., back of controller, wherein lever “is configured to pivot” between positions, such that pivoting of lever activated and deactivated switch, since spring of prior art was not part of elongate member of prior art, i.e., lever, and only spring provided flexibility and resilience. [35 U.S.C.A. § 102](#).

[11] Patents → **Persons entitled to seek review or assert arguments; parties; standing**

Petitioner on inter partes review forfeited its Appointments Clause challenge on appeal by affirmatively seeking ruling from members of Patent Trial and Appeal Board (PTAB), regardless of how they were appointed. [U.S. Const. art. 2, § 2, cl. 2](#).

[12] Patents → **Computers and Software**

Phrase, “first surface disposed proximate an outer surface of the case,” in patent directed to hand held controllers for game consoles, required first surface of additional control and outer surface of case to be arranged close or near to each other, but it did not require them to be facing each other.

[13] Patents → **Scope of Review**

Court of Appeals could determine correct construction of disputed limitation in patents directed to hand held controllers for game consoles, since Patent Trial and Appeal Board (PTAB) on inter partes review did not rely on extrinsic evidence as to claim construction.

[14] **Patents** 🔑 Expert and inventor testimony

Where the patent documents are unambiguous, expert testimony regarding the meaning of a claim is not entitled to any weight.

[15] **Patents** 🔑 Computers and Software

“Opposing” limitation, in patent directed to hand held controllers for game consoles, was met by two surfaces that faced each other or were opposite each other, but they did not have to be substantially flat.

[16] **Patents** 🔑 In general; utility
US Patent 8,641,525. Cited.

[17] **Patents** 🔑 In general; utility
US Patent 5,989,123. Cited as Prior Art.

[18] **Patents** 🔑 In general; utility
US Patent 9,289,688. Unpatentable in Part.

[19] **Patents** 🔑 In general; utility
US Patent 9,352,229. Patentable in Part.

***1366** Appeals from the United States Patent and Trademark Office, Patent Trial and Appeal Board in Nos. IPR2017-00858, IPR2017-01928.

Attorneys and Law Firms

Sharon A. Israel, Shook, Hardy & Bacon, LLP, Houston, TX, argued for appellant. Also represented by Kyle E. Friesen; Patrick A. Lujin, Kansas City, MO; Reynaldo Barcelo, Joshua Charles Harrison, Barcelo, Harrison & Walker, LLP, Newport Beach, CA.

Robert David Becker, Manatt, Phelps, & Phillips, LLC, San Francisco, CA, argued for cross-appellant.

Kakoli Caprihan, Office of the Solicitor, United States Patent and Trademark Office, Alexandria, VA, argued for intervenor. Also represented by Daniel Kazhdan, Thomas W. Krause, Farheena Yasmeen Rasheed.

Before Newman, Lourie, and Dyk, Circuit Judges.

Opinion

Dyk, Circuit Judge.

***1367** Valve Corporation (“Valve”) appeals two final written decisions of the Patent Trial and Appeal Board (“Board”) determining that claims of U.S. Patent No. 9,289,688 (“the ’688 patent”) and U.S. Patent No. 9,352,229 (“the ’229 patent”) were not shown to be unpatentable. Ironburg Inventions Ltd. (“Ironburg”), the owner of the ’688 patent and the ’229 patent, cross-appeals the Board’s

determination that other claims of the '688 patent were shown to be unpatentable. We affirm in part, reverse in part, vacate in part, and remand.

Background

This appeal involves two inter partes review (“IPR”) proceedings. One concerned the '688 patent, and the other concerned the '229 patent. The '688 patent and the '229 patent have the same inventors (Simon Burgess and Duncan Ironmonger), are both owned by Ironburg, and are directed to similar subject matter, but they are otherwise not related.

In the first IPR proceeding, Valve petitioned for review of claims 1–3, 9, 10, 18–22, and 26–30 of the '688 patent on February 7, 2017. The '688 patent is directed to “[a]n improved controller ... for a games console that is intended to be held by a user in both hands in the same manner as a conventional controller” that “comprises additional controls ... located on the rear of the controller.” '688 patent, Abstract. Figure 5 of the '688 patent is a rear view of an embodiment of the controller with the additional controls (numbered 11A–11D) shown as “paddle levers,” *see id.* col. 3 l. 63, col. 5 ll. 48–50, one end of which is fixed to the back of the controller by a screw (numbered 15) while the other end is moveable, *see id.* col. 6 ll. 16–21.

***1368**

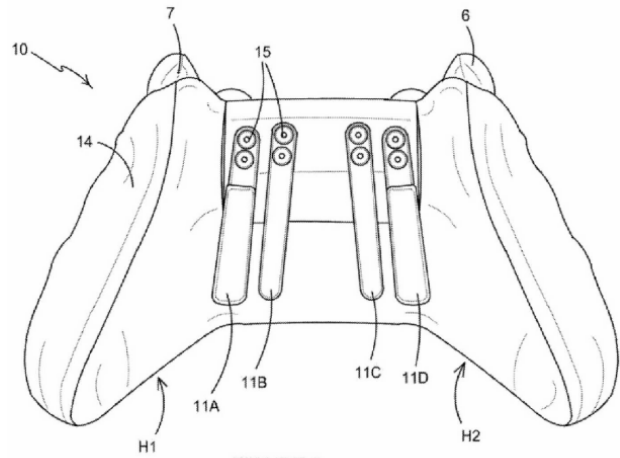


FIGURE 5

Id., fig. 5. Independent claim 1 of the '688 patent, relevant to the cross-appeal, claims:

1. A games controller comprising:

a case; and

a plurality of controls located on a front end and a top of the case;

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

the games controller further comprises at least one first additional control located on a back of the case in a position operable by a middle, ring or little finger of the user, the first additional control comprising a first elongate member displaceable by the user to activate a control function, wherein the first elongate member comprises a first surface disposed proximate an outer surface of the case and the first elongate member comprises a second surface opposing the first surface, the second surface being configured and arranged to be non-parallel with a

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