

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VALVE CORPORATION,
Petitioner,

v.

IRONBURG INVENTIONS LTD.,
Patent Owner.

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*.

SCHEDULING ORDER ON REMAND

Conduct of Proceeding

37 C.F.R. § 42.5

I. DISCUSSION

On August 17, 2021, the Federal Circuit affirmed-in-part, vacated-in-part, and remanded-in-part the Final Written Decision in this proceeding

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(Paper 68 (“Dec.” or “Decision”)). *Valve Corp. v. Ironburg Inventions Ltd.*, 8 F.4th 1364, 1381 (Fed. Cir. 2021). Paper 76.¹

We conducted a trial to address Valve’s challenges to the patentability of claims 1–3, 9, 10, 18–22, and 26–30 of U.S. Patent 9,289,688 B2 (the “688 patent”), which are summarized in the table 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

Dec. 2.

¹ The Federal Circuit issued its mandate on October 8, 2021. Paper 75.

The Federal Circuit affirmed our determination that Uy anticipated claims 1, 2, 9, 10, 20, 22, 27, 28, and 30.² *Valve*, 8 F.4th at 1381. The Federal Circuit reversed our determination that Burns was not prior art. *Id.* 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 listed in the table above. *Id.* Accordingly, the Federal Circuit remanded the case for us to consider Valve’s challenges to the patentability of claims 18, 19, 21, 26, and 29 of the ’688 patent as obvious based on the combinations of prior art listed in the table below.

References	Claim(s) ³ challenged as obvious
Bellinghausen and Burns	26
Burns and LaCelle	18, 19, 21, 26, 29
Burns and Knight	21

On October 27, 2021, Judges Weatherly and Kauffman conducted a conference call with the parties to explore their preferences on the

² The Federal Circuit also affirmed our determination that Uy did not anticipate claim 29. *Valve*, 8 F.4th 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.

³ We note that, because all the claims to be addressed on remand depend directly from claim 1, we expect 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.

procedures to govern the remand proceedings.⁴ Before that conference, the parties had indicated via email to the Board that they had conferred and agreed that no new evidence shall be submitted during the remand and that each party should concurrently file an opening brief and then concurrently file a reply brief. The panel adopts these agreed upon procedures.

Based upon discussion with the parties during the teleconference, the panel specifies the following additional procedures that shall govern the remand proceeding:

1. Opening briefs of up to fifteen (15) pages shall be concurrently filed on November 23, 2021;
2. The opening briefs shall address the effect of the Federal Circuit's decision in *Valve Corporation v. Ironburg Inventions Ltd.*, 8 F.4th 1364 (Fed. Cir. 2021) on the PTAB's Corrected Final Written Decision (Paper 68) regarding the patentability of claims 18, 19, 21, 26, and 29 of the '688 patent in view of Valve's challenges to the patentability of those claims as set forth in the table above;
3. Each party may file a reply brief of up to five (5) pages that responds to the opposing party's opening brief by no later than December 14, 2021; and
4. The panel will defer deciding the issue of whether an oral argument is warranted until after briefing is completed.

The panel also instructed the parties to confer and determine which motions, if any, filed during the original proceeding addressed issues that remain pertinent to the issues on remand. During the original proceeding, the panel dismissed without prejudice as moot Ironburg's motions to exclude evidence (Papers 48 and 63). Dec. 45. In a joint e-mail on November 5,

⁴ Judge Petravick joins this order after conferring with Judges Weatherly and Kauffman.

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2021, the parties agreed that both of these motions were pertinent, at least in part, to the issues remaining on remand. Exhibit 3001. Ironburg is only authorized to renew these motions by indicating a desire to do so in its opening brief. No additional briefing by either party will be permitted on these motions.

II. ORDER

Accordingly, it is:

ORDERED that the parties shall not file new evidence during the remand proceeding;

FURTHER ORDERED that each party shall concurrently file an opening brief of up to fifteen (15) pages on November 23, 2021;

FURTHER ORDERED that, except as otherwise indicated, each opening brief may only address the effect of the Federal Circuit's decision in *Valve Corp. v. Ironburg Inventions Ltd.*, 8 F.4th 1364, 1381 (Fed. Cir. 2021) on the PTAB's Corrected Final Written Decision (Paper 68) regarding the patentability of the remanded claims 18, 19, 21, 26, and 29 of the '688 patent in view of Valve's challenges to the patentability of those claims as set forth in the table above;

FURTHER ORDERED that Ironburg is authorized to renew one or more of the motions to exclude evidence filed during the trial as Paper Nos. 48 and 63 by expressly indicating in its opening brief which of these motions it renews;

FURTHER ORDERED that no additional briefing by either party on any such renewed motion to exclude evidence is authorized;

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