

## Valve Corporation v. Ironburg Inventions Ltd., 8 F.4th 1364 (2021)

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Valve Corporation petitioned for *inter partes* review (IPR) of two patents owned by Ironburg Inventions directed to hand held controllers for game consoles. The Patent Trial and Appeal Board (Board) determined that a key reference had not been properly authenticated and was thus unavailable as prior art under 35 U.S.C. § 102(a)(1). Valve appealed.

The IPR exhibit at issue was the “Burns article,” a printed copy of an online review of an Xbox 360 controller with an indicated publication date of October 20, 2010. The Burns article had been cited as prior art during prosecution of both patents involved in the IPR. Despite its use in prosecution, the Board found that the IPR exhibit failed to meet the standard for authentication under Fed. R. Evid. 901(a), which requires that a party authenticating or identifying an item of evidence “must produce evidence sufficient to support a finding that the item is what the proponent claims it is.” The U.S. Court of Appeals for the Federal Circuit disagreed, finding the record was sufficient to establish that the exhibit proffered in the IPR was substantively the same as the Burns article cited during prosecution.

The court explained that authentication of an exhibit routinely happens by comparison under Fed. R. Evid. 901(b)(3), where either an expert witness or the trier of fact compares the exhibit to an authenticated specimen. The same type of authentication by comparison had been accepted as evidence in *VidStream LLC v. Twitter, Inc.*, 981 F.3d 1060, 1066-67 (Fed. Cir. 2020), where a version of a reference proven to be prior art was evidence that the IPR version of the reference was also prior art. In this case, the IPR exhibit and the Burns article used in prosecution were nearly identical, with the same text, number of paragraphs, and images. The only difference was that the date of access for the exhibit, but the court dismissed this as an immaterial difference. Similarly, the court held that differences in imaging due to how a document is downloaded and printed are not sufficient to disqualify a reference. As to

**As the trier of fact, the Board has an obligation under Federal Rule of Evidence 901(b)(3) to assess document authenticity by “comparison with an authenticated specimen,” if a party so requests.**

the Board’s conduct, the court explained that the Board has an obligation under Federal Rule 901(b)(3) as the trier of fact to compare documents and determine an exhibit’s authenticity, particularly when the exhibits (here, nine and ten pages each) are not burdensome.

Ironburg argued in the alternative that the documents were not prior art, because Valve had not shown that the IPR exhibit or the Burns article were publicly accessible before the priority date of the patents at issue. The court disagreed. It found “overwhelming evidence” that the Burns article was publically accessible more than two years before the priority date. The evidence included a declaration and litigation testimony by a co-inventor of the two patents that he facilitated the publication of the Burns article with the purpose of reaching the general public, promoting the business, and selling controllers. The court also noted the lack of any dispute during prosecution that the Burns article was prior art: “If an examiner could access the article before the priority date, so could the general public.” Importantly for IPR practitioners, the court sanctioned the use of the “Wayback Machine,” a tool run by the nonprofit Internet Archive, as a means for the Board to determine when a web reference was first available on the Internet.

On the totality of the evidence, the Federal Circuit reversed and remanded for the Board to consider Valve’s unpatentability arguments based on the Burns article. The case has important lessons for both the Board and IPR practitioners when it comes to authenticating non-patent literature as prior art for use in IPR proceedings.