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6 UNITED STATES DISTRICT COURT  
WESTERN DISTRICT OF WASHINGTON  
7 AT SEATTLE

8 IRONBURG INVENTIONS LTD.,

9 Plaintiff,

10 v.

11 VALVE CORPORATION,

12 Defendant.

C17-1182 TSZ

MINUTE ORDER

13  
14 The following Minute Order is made by direction of the Court, the Honorable  
Thomas S. Zilly, United States District Judge:

15 (1) Plaintiff's motion in limine, docket no. 328, is GRANTED in part, DENIED in  
16 part, and DEFERRED in part as follows:

17 II. Motion to exclude at trial all evidence and argument of unenforceability,  
18 invalidity, prior invention and prior art is GRANTED in part as to  
invalidity and unforceability. The motion is DENIED as to prior invention  
and prior art.

19 III. Motion to exclude at trial all evidence and argument of irrelevant  
20 proceedings and patent claims is GRANTED as to the outcome of any IPR  
21 proceeding or decision issued by the PTAB, or settlement in other  
litigation. Except as granted, the motion is DEFERRED to the pretrial  
conference.

22 IV. Motion to exclude at trial all testimony, evidence, or argument relating to:  
23 (1) Valve's actions after receiving the cease and desist letter is DENIED;  
(2) Valve's decision to continue to produce the products is DENIED; and

1 (3) the witnesses' beliefs about infringement and validity formed after  
2 consultation with counsel is GRANTED in part as to any advice of counsel  
defense; and DEFERRED to trial as to any unprivileged factual testimony.

3 V. Motion to exclude at trial all testimony, evidence, or argument of non-  
4 infringement based on the intended use specified for the hand-held  
controller invention set forth in the preamble of Claim 1 is DENIED.

5 VI. Motion to exclude at trial all testimony, evidence, or argument related to  
6 inventor Simon Burgess or patent counsel for Ironburg and the inventors is  
DENIED as to Simon Burgess and DEFERRED to the pretrial conference  
as to patent counsel and other inventors.

7 VII. Motion to preclude at trial all use of derogatory or misleading  
8 characterizations of Ironburg's business is GRANTED except as to any  
reference to Ironburg as a "non-practicing entity."

9 VIII. Motion to exclude evidence and argument concerning noninfringing  
10 alternatives and design arounds is DENIED.

11 IX. Motion to exclude at trial all testimony, evidence, or argument related to  
prosecution history estoppel and ensnarement is GRANTED. Valve agrees  
to this exclusion if the Doctrine of Equivalents theory is also excluded.

12 X. Motion to preclude defendant's experts from opining on any theories of  
13 non-infringement, unenforceability, or validity that are not contained within  
their expert reports is GRANTED. This ruling will also apply to plaintiff's  
14 experts.

15 XI. Motion to preclude defendant's expert Dezmelyk from opining on the '525  
patent application, patent office practice and procedures is DENIED.

16 (2) Defendant's motion in limine, docket no. 326, is GRANTED in part, DENIED in  
17 part, and DEFERRED in part as follows:

18 1. Motion to preclude Ironburg from presenting any evidence or argument  
regarding the existence or outcome of IPR proceedings is GRANTED.

19 2. Motion to preclude Ironburg from presenting any evidence or argument that  
20 Valve infringes the '525 Patent under the Doctrine of Equivalents is  
GRANTED. Local Patent Rule ("LPR") 120(e) requires that parties  
21 disclose within fifteen (15) days of the scheduling conference "[w]hether  
each element of each asserted claim is claimed to be literally present and/or  
22 present under the doctrine of equivalents in the Accused Device." Pursuant  
to LPR 124, amendment of the infringement contentions may be made by  
23 order of the Court upon a timely showing of good cause. Ironburg neither

1 disclosed their intent to rely on the doctrine of equivalents pursuant to LPR  
2 120(e), nor moved the Court to amend its infringement contentions  
3 pursuant to LPR 124. Instead, Ironburg’s technical expert, Mr. Garry  
4 Kitchen, provided two sentences referencing the doctrine’s application to  
5 claim 6 in his July 6, 2018 report.<sup>1</sup> To support a finding of infringement  
6 under the doctrine of equivalents, a patentee must provide particularized  
7 testimony as to the insubstantiality of the differences between the claimed  
8 invention and the accused device, or with respect to the function, way,  
9 result test. *Texas Instruments Inc. v. Cypress Semiconductor Corp.*, 90  
10 F.3d 1558, 1567 (Fed. Cir. 1996). Generalized testimony as to the overall  
11 similarity between the claims and the accused device is insufficient. *Id.*  
12 Because Ironburg did not assert claims under the doctrine of equivalents in  
13 its infringement contentions and has not provided particularized testimony  
14 sufficient to assert claims under the doctrine of equivalents, it is precluded  
15 from asserting them at trial. *MEMC Elec. Materials v. Mitsubishi*  
16 *Materials Silicon Corp.*, 2004 WL 5363616, at \*5 (N.D. Cal. Mar. 2, 2004)  
17 (precluding patentee from asserting claims under the doctrine of equivalents  
18 where it was omitted from the infringement contentions and where patentee  
19 failed to provide the requisite particularized testimony).

11 3. Motion to preclude Ironburg from mentioning or discussing the Microsoft  
12 Elite Controller is DENIED.

13 4. Motion to preclude Ironburg from offering evidence or argument of Valve’s  
14 total or company-wide revenue and profit is DEFERRED to the pretrial  
15 conference.

14 (3) The Clerk is directed to send a copy of this Minute Order to all counsel of record.

15 Dated this 4th day of March, 2020.

16 William M. McCool  
17 Clerk

18 s/Karen Dews  
19 Deputy Clerk

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21 <sup>1</sup> See Ex. 1 to Schafer Decl., docket no. 256-1 at ¶ 103 (“[A]lthough the Valve members  
22 are joined by additional plastic, they directly correspond to the claims and perform substantially  
23 the same control function as the claimed element in substantially the same way to achieve  
substantially the same results. The middle finger of the user is positioned to flex and activate the  
back controls in the same manner as described in the patent, and the controls return to the  
unloaded position as described above.”)