

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RUBICON COMMUNICATIONS, LP
Petitioner,

v.

LEGO A/S
Patent Owner.

Case IPR2016-01187
Patent 8,894,066

PATENT OWNER'S RESPONSE

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I. INTRODUCTION

Patent Owner, LEGO A/S, respectfully submits its Response to Petitioner's Petition for *inter partes* review of U.S. Patent No. 8,894,066 (the "'066 Patent"). The Board considered the Petition (Paper 1) and Patent Owner's Corrected Preliminary Response (Paper 20) and instituted trial on three out of eight asserted grounds of unpatentability. Institution Decision, Paper 38. The remaining grounds challenging the '066 Patent are: III—alleged anticipation of Claims 1–6 and 8 by Philo's Home page;¹ IV—alleged obviousness of Claim 7 over Philo and Building Robots;² and VII—alleged anticipation of Claims 1–4, 6, and 8 by Anderson.³ *Id.* at 3. The cited references, however, do not disclose each and every element of the challenged claims nor do they render obvious the subject matter of the '066 Patent. Because Petitioner failed to meet its burden of proving a proposition of unpatentability under 35 U.S.C. § 316(e),⁴ Patent Owner respectfully requests the

¹ Philo's Home page, www.philohome.com (Exhibit B2).

² Mario Ferrari et al., *Building Robots with Lego® Mindstorms™ : The ULTIMATE Tool for Mindstorms Maniacs!*, published 2002 (Exhibit B1).

³ U.S. Patent Publication 2002/0196250 A1 (Exhibit B5).

⁴ In addition, Patent Owner reiterates that Petitioner failed to identify all real parties-in-interest and disobeyed § 312(a). *See* Paper 56.

Board deny the grounds not already dismissed and confirm the validity of the claims of the '066 Patent.

II. OVERVIEW OF THE '066 PATENT AND CITED REFERENCES

The '066 Patent claims methods for creating a user-designed controller for manipulating displayed images or symbols during play activity. The user-designed controller includes a housing that contains the controller electronics, and a main casing that conformably fits around a portion of the housing and thereby receives the housing. '066 Patent Claim 1. The casing has a patterned surface that allows a user to attach building elements to transform the controller into a replica of at least a portion of a play item. *Id.*

The Specification of the '066 Patent describes two embodiments directed to methods of configuring the controller. The '066 Patent explicitly claims one of the two embodiments directed to methods having a housing of the controller, with an exterior surface and an interior region confining electrical components, and providing a separate main casing, configured to conformably fit around a portion of the exterior surface of and thereby receive the housing. *Id.* With matable attachments, such as well-known LEGO[®] building elements, various handles, grips, and other items can be appended to a patterned surface portion of the main casing

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