

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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RUBICON COMMUNICATIONS, LP,  
Petitioner,

v.

LEGO A/S,  
Patent Owner.

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Case IPR2016-01187  
Patent 8,894,066 B2

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Before SCOTT A. DANIELS, NEIL T. POWELL, and  
TIMOTHY J. GOODSON, *Administrative Patent Judges*.

POWELL, *Administrative Patent Judge*.

FINAL WRITTEN DECISION  
*35 U.S.C. § 318(a) and 37 C.F.R. § 42.73*

## I. INTRODUCTION

### A. Background

Petitioner filed a Petition requesting an *inter partes* review of claims 1–8 of U.S. Patent No. 8,894,066 B2 (Ex. 1001, “the ’066 patent”). Papers 1, 41, 89 (“Pet.”).<sup>1</sup> Patent Owner, LEGO A/S, filed a Corrected Preliminary Response. Paper 20 (“Prelim. Resp.”). In view of those submissions, we instituted an *inter partes* review of claims 1–8. Paper 38 (“Institution Decision” or “Inst. Dec.”). Subsequently, Patent Owner filed a Patent Owner Response (Paper 70, “PO Resp.”), and Petitioner followed with a Reply (Paper 72, “Pet. Reply”). An oral hearing was held on October 11, 2017 and a copy of the transcript was entered into the record (Paper 92, “Tr.”).

We have jurisdiction under 35 U.S.C. § 6. This Decision is a Final Written Decision under 35 U.S.C. § 318(a) as to the patentability of the challenged claims. For the reasons that follow, we determine that Petitioner has shown by a preponderance of the evidence that claims 1, 4, 6, and 8 of the ’066 patent are unpatentable, but has not shown by a preponderance of the evidence that claims 2, 3, 5, and 7 are unpatentable.

### B. Related Matters

The ’066 patent has been asserted in *Lego Systems A/S v. Rubicon Communications, LP dba Smallworks and Smallworks, LLC*, Case No. 3:15-cv-00823 (VLB) (D. Connecticut). *See* Pet. 5; *see* Paper 5, 2.

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<sup>1</sup> Papers 1, 41, and 89 differ from one another only in the parties identified as real parties-in-interest.

*C. The Pending Grounds of Unpatentability*

The pending grounds of unpatentability include:

Reference(s)	Statutory Basis	Challenged Claim(s)
Philo <sup>2</sup>	35 U.S.C. § 102(b)	1–6 and 8
Philo and Building Robots <sup>3</sup>	35 U.S.C. § 103(a)	7 <sup>4</sup>
Anderson <sup>5</sup>	35 U.S.C. § 102(b)	1–4, 6, and 8

Petitioner also relies on a declaration from Jay P. Kesan, Ph.D. (Ex. 1036). Patent Owner relies on a declaration from Elizabeth B. Knight (Ex. 2026).

*D. The '066 Patent*

The '066 patent “relates to a manual controller for manipulating images or symbols on a visual display and, in particular, to a controller that can be constructed with user-arranged matable building elements to exhibit a customized shape and style depending on user game-inspired, ergonomic, or appearance preferences.” Ex. 1001, 1:29–34. The '066 patent discusses one example in connection with Figure 1, which is reproduced below.

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<sup>2</sup> Philo’s Home page, [www.philohome.com](http://www.philohome.com) (Exhibit 1017).

<sup>3</sup> Mario Ferrari et al., *Building Robots with Lego® Mindstorms™: The ULTIMATE Tool for Mindstorms Maniacs!*, published 2002 (Exhibit 1016).

<sup>4</sup> On page 7, the Petition identifies claims 1–8 as challenged based on Philo in combination with Building Robots. The Petition’s substantive discussion of this challenge, however, only discusses claim 7. Pet. 31. Consequently, the ground as instituted only included claim 7. See Inst. Dec. 20–21, 27.

<sup>5</sup> U.S. Patent Publication 2002/0196250 A1 (Exhibit 1020).

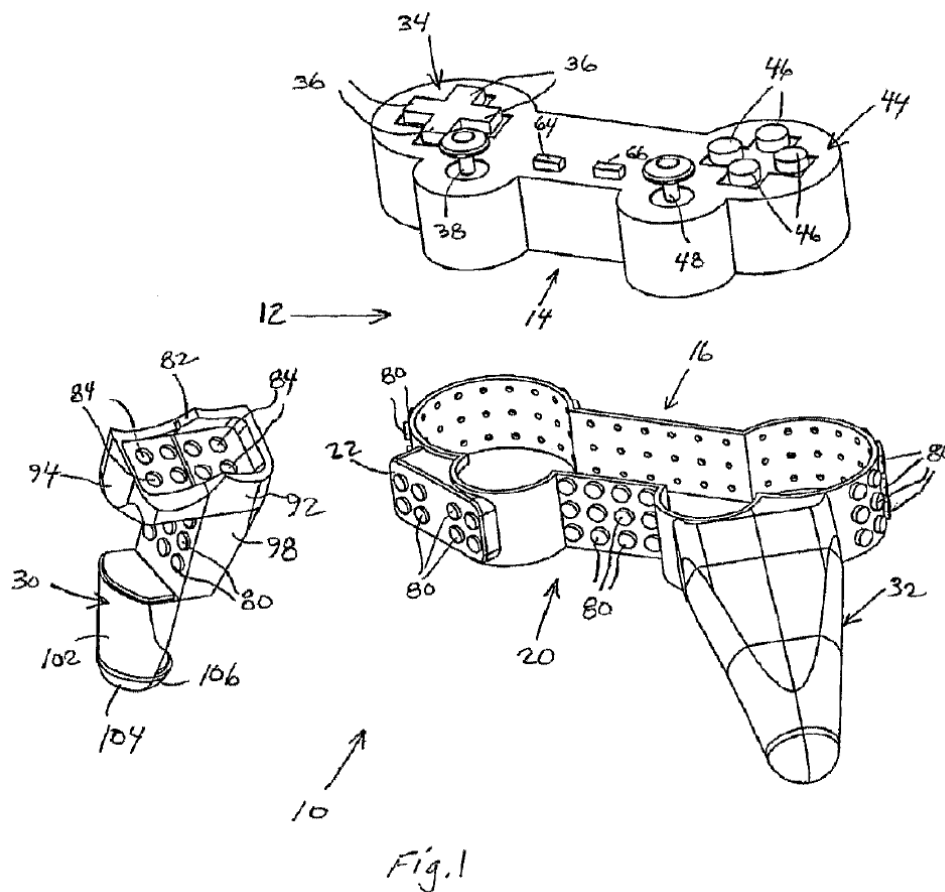


Figure 1 shows manual controller 10, left-hand grip 30, and right-hand grip 32. *Id.* at 3:5–7, 3:18–20. Manual controller 10 includes main housing 14 and main casing 16, which “conformably fits around the side surface of main housing 14.” *Id.* at 3:5–7. Main casing 16 includes patterned surface portion 20, which includes cylindrical mating features or bosses 80. *Id.* at 3:11–12, 3:35–38. Each hand grip 30, 32 has corresponding recesses 84 for snugly attaching hand grips 30, 32 to bosses 80 on main casing 16. *Id.* at 3:38–45.

*E. Illustrative Claim*

Claim 1 is independent. Each of the other challenged claims depends from claim 1. Claim 1 is illustrative and recites:

1. A method of facilitating user preference in creative design of a controller for manipulating images or symbols on a display, the controller having a housing with an exterior surface and an interior region confining electrical components for producing signals for manipulating image or symbols on the display, comprising

providing a main casing configured to conformably fit around a portion of the exterior surface of and thereby receive the housing of the controller, the main casing having a patterned surface portion configured to support a set of building elements that are configurable for mating to the patterned surface portion; and

providing in the set of building elements a subset of building elements that are matable to one another and configured for a user to build on the patterned surface portion of the main casing a customized replica of at least a portion of a play item and thereby transform the exterior surface of the housing of the controller to a customized shape and appearance in accordance with the user's preference.

Ex. 1001, 6:52–7:4.

## II. ANALYSIS

### A. *Claim Construction*

We interpret claims of an unexpired patent using the broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b). We presume a claim term carries its “ordinary and customary meaning,” which is “the meaning that the term would have to a person of ordinary skill in the art in question” at the time of the invention. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007) (citation and quotations omitted). This presumption, however, is rebutted when the patentee acts as his own lexicographer by giving the term a particular meaning in the specification with “reasonable clarity,

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