

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*.

DECISION  
Granting Institution of *Inter Partes* Review  
37 C.F.R. § 42.108

## I. INTRODUCTION

### A. Background

Rubicon Communications, LP (“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”). Paper 1 (“Pet.”). Patent Owner, LEGO A/S, filed a Corrected Preliminary Response. Paper 20 (“Prelim. Resp.”).

We have authority to determine whether to institute an *inter partes* review. 35 U.S.C. § 314(a); 37 C.F.R. § 42.4(a). The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted “unless the Director determines . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”

After considering the Petition and Preliminary Response, we determine that Petitioner has established a reasonable likelihood of prevailing in showing the unpatentability of claims 1–8. Accordingly, we institute *inter partes* review of these challenged claims.

### 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.

*C. The Asserted Grounds of Unpatentability*

Petitioner contends that claims 1–8 of the '066 patent are unpatentable based on the following grounds:

Ground	Reference(s)	Statutory Basis	Challenged Claim(s)
I	Building Robots <sup>1</sup>	35 U.S.C. § 102(b)	1–6 and 8
II	Building Robots	35 U.S.C. § 103(a)	1–8
III	Philo <sup>2</sup>	35 U.S.C. § 102(b)	1–6 and 8
IV	Philo and Building Robots	35 U.S.C. § 103(a)	7 <sup>3</sup>
V	Philo, Building Robots, and Gasperi <sup>4</sup>	35 U.S.C. § 103(a)	2 and 3 <sup>5</sup>
VI	Shackleford <sup>6</sup>	35 U.S.C. § 102(b)	1–4, 6, and 8
VII	Anderson <sup>7</sup>	35 U.S.C. § 102(b)	1–4, 6, and 8

<sup>1</sup> Mario Ferrari et al., *Building Robots with Lego® Mindstorms™: The ULTIMATE Tool for Mindstorms Maniacs!*, published 2002 (Exhibit B1).

<sup>2</sup> Philo's Home page, [www.philohome.com](http://www.philohome.com) (Exhibit B2).

<sup>3</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.

<sup>4</sup> Dave Baum et al., Gasperi's Mindstorms RCX Sensor Input Page, [www.plazaeearth.com/usr/gasperilego.htm](http://www.plazaeearth.com/usr/gasperilego.htm) (Exhibit B3).

<sup>5</sup> Page 7 of the Petition indicates that this challenge addresses claims 2–4, but the substantive explanation of this challenge on pages 32–33 of the Petition discusses only claims 2 and 3.

<sup>6</sup> U.S. Patent No. 6,443,796 (Exhibit B4).

<sup>7</sup> U.S. Patent Publication 2002/0196250 A1 (Exhibit B5).

Ground	Reference(s)	Statutory Basis	Challenged Claim(s)
VIII	Anderson and Xbox Forums <sup>8</sup>	35 U.S.C. § 103(a)	8

*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. A1, 1:29–34.<sup>9</sup> The '066 patent discusses one example in connection with Figure 1, which is reproduced below.

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<sup>8</sup> Xbox Forums web page (Exhibit B6).

<sup>9</sup> For Petitioner’s future reference, as noted by Patent Owner (Prelim. Resp. 15), Petitioner’s exhibit-labeling scheme does not comply with 37 C.F.R. § 42.63(c). In this case, with the current record having extensive citations to Petitioner’s exhibits as initially labeled, we waive the requirements of 37 C.F.R. § 42.63(c). *See* 37 C.F.R. § 42.5(b)

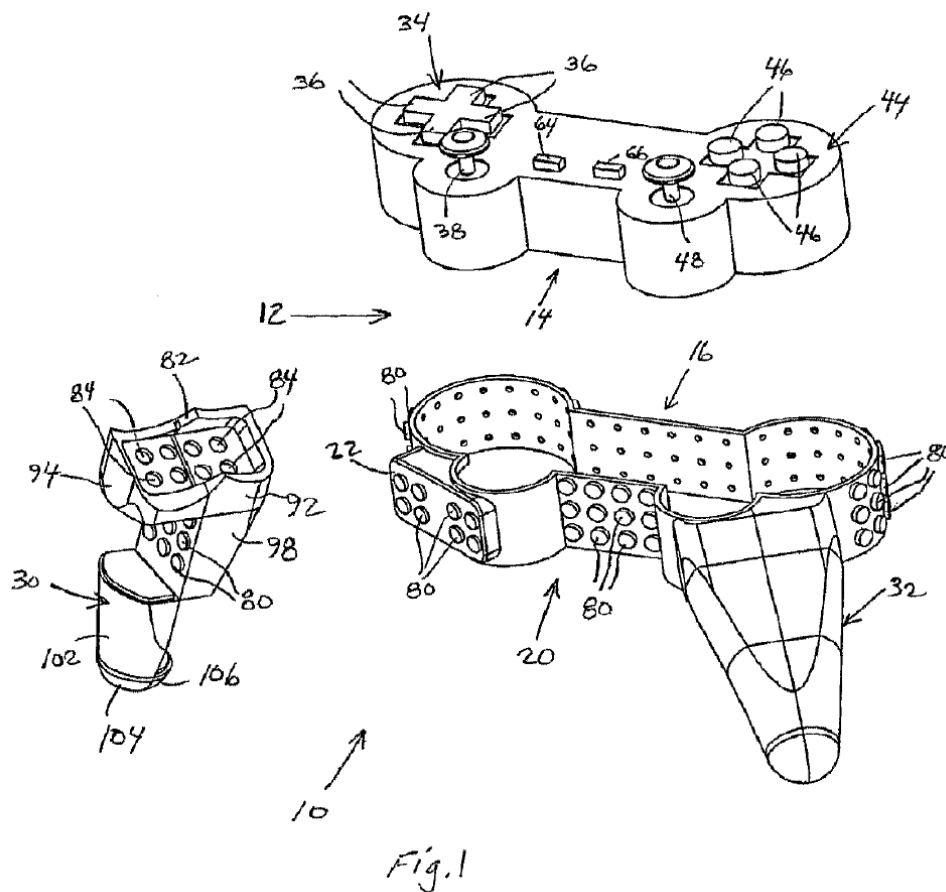


Figure 1 shows manual controller 10 left-hand grip 30, and right-hand grip 32. *Id.* at 3:5–7, 3:18–20. Manual controller 10 includes main housing 14 and main casing 16, which “conformably fits around the side surface of main housing 14.” *Id.* at 3:5–7. Main casing 16 includes patterned surface portion 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:

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