

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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VALVE CORPORATION,  
Petitioner,

v.

IRONBURG INVENTIONS LTD.,  
Patent Owner.

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Case IPR2017-00137  
Patent 9,089,770 B2

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Before PHILLIP J. KAUFFMAN, MEREDITH C. PETRAVICK, and  
MITCHELL G. WEATHERLY, *Administrative Patent Judges*.

Opinion concurring filed by *Administrative Patent Judge* WEATHERLY.

KAUFFMAN, *Administrative Patent Judge*.

DECISION  
Denial of Joinder and Consolidation  
Institution of *Inter Partes* Review  
*37 C.F.R. § 42.108*

## I. INTRODUCTION

### A. OVERVIEW

Previously, Valve Corporation (“Petitioner”) filed a corrected Petition (Paper 4, “the first Petition”) requesting *inter partes* review of claims 1–20 of U.S. Patent No. 9,089,770 B2 (Ex. 1002, “the ’770 patent”). Ex. 2015, 4.<sup>1</sup> We instituted an *inter partes* review (IPR2016-00949) of claims 1–12 and 14–20 of the ’770 patent, but did not institute review of claim 13. Ex. 2016 (“Dec.”), 1.<sup>2</sup>

Petitioner filed a second Petition (Paper 1, “Pet.” or “the second Petition”) requesting *inter partes* review of claims 1–20 of the ’770 patent. Pet. 12. In conjunction with the second Petition, Petitioner filed a Motion (Paper 3, “Mot.”) seeking Joinder or Consolidation with IPR2016-00949.

Ironburg Inventions Ltd. (“Patent Owner”) filed a Preliminary Response (Paper 9, “Prelim. Resp.”) to the second Petition, and an Opposition to the Motion (Paper 7, “Opp.”). Petitioner filed a reply to Patent Owner’s Opposition (Paper 8, “Reply”).

Upon consideration of the record to this point, for the reasons explained below, Petitioner has demonstrated a reasonable likelihood of prevailing with respect to at least one of the challenged claims. We institute an *inter partes* review of claims 1–4, 12, 15–18, and 20 of the ’770 patent. We deny Petitioner’s Motion for Joinder or Consolidation.

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<sup>1</sup> Patent Owner filed a copy of the first Petition as Exhibit 2015.

<sup>2</sup> Patent Owner filed a copy of the Institution Decision in IPR2016-00949 (Paper 10) as Exhibit 2016.

B. RELATED PROCEEDINGS

The parties indicate that the '770 patent is at issue in: *Ironburg Inventions Ltd. v. Valve Corp.*, Case No. 1:15-cv-04219-MHC (N.D. Ga.). Pet. 1–2; Paper 6, 1.

Petitioner also filed a first and a second petition against U.S. Patent 8,641,525 B2 (“the '525 patent”) (IPR2016-00948 and IPR2017-00136).

The '770 and '525 patents are related. Specifically, the '770 patent issued from an application that was a continuation of application 13/162,727, now the '525 patent.

## II. THE CLAIMED SUBJECT MATTER

A. INTRODUCTION

The '770 patent relates to hand held controllers for video game consoles. Ex. 1002, 1:6–7.

As background, the '770 patent describes that conventional controllers were intended to be held and operated by the user using both hands, and the plurality of controls were mounted on the front and the top edge. *Id.* at 1:8–17; Fig. 1. The drawback of this design was that the user was required to remove his or her thumb from one control to operate another control, causing loss of control, such as aiming. *Id.* at 1:33–40. The '770 patent was intended to address this problem. *Id.* at 1:41–45.

Controller 10 of the '770 patent includes a plurality of controls on the front and the top edge like a conventional controller, and includes additional controls on the back, such as paddles 11, that are operable by fingers other than the thumb. *Id.* at 1:51–58; 3:14–17; Fig. 1 (front of conventional controller and controller 10), 2 (back of controller 10). Figures 1 and 2 follow:

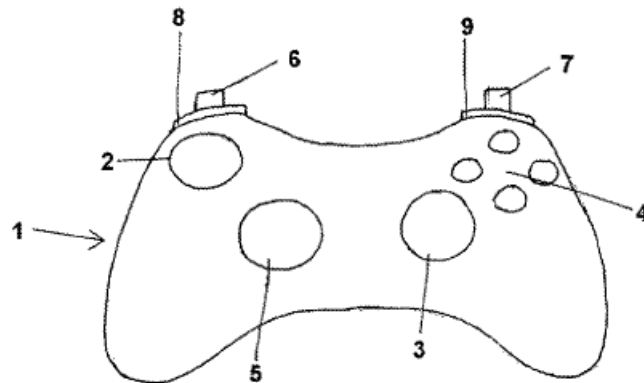


Figure 1

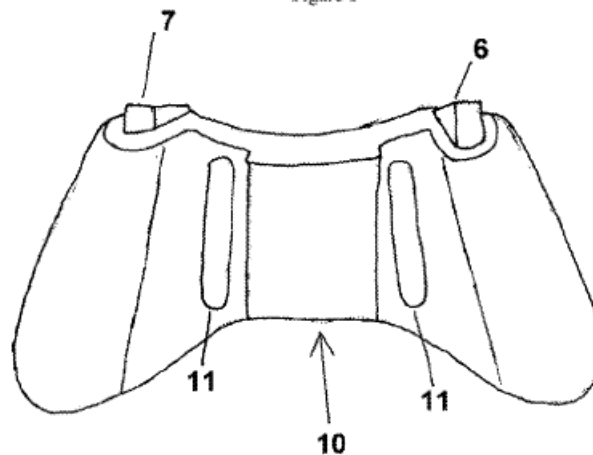


Figure 2

Figure 1 is a schematic illustration of the front of a conventional game controller according to the prior art, and Figure 2 is a schematic illustration of the back of game controller 10. *Id.* at 2:61–64.

B. ILLUSTRATIVE CLAIM

Claim 1 is the sole independent challenged claim and follows:

1. A video game controller, comprising:  
an outer case comprising:  
a front and a back, wherein the back is opposite the front;  
a top edge and a bottom edge, wherein the top edge is  
opposite the bottom edge;

first handle adjacent a first side edge and a second handle adjacent a second side edge, wherein the first side edge is opposite the second side edge; and

a first back control and a second back control, wherein each of the first back control and the second back control is located at the back of the controller, wherein the first back control includes a first elongate member and the second back control includes a second elongate member;

wherein the first elongate member extends along at least half of a first distance between the top edge and the bottom edge, the first distance being measured along a longitudinal axis of the first elongate member; and

wherein the second elongate member extends along at least half of a first distance between the top edge and the bottom edge, the first distance being measured along a longitudinal axis of the first elongate member.

Claims 2–20 depend from independent claim 1.

#### C. APPLICABLE STANDARD

In an *inter partes* review, the Board interprets claim terms in an unexpired patent according to the broadest reasonable interpretation in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144–46 (2016) (upholding the use of the broadest reasonable interpretation approach).

For the purposes of this decision, and on this record, we determine that only the claim terms discussed in section II.D., below, need express interpretation. See *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (only those terms which are in controversy need to be construed, and only to the extent necessary to resolve the controversy).

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