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<b>Application Data Sheet 37 CFR 1.76</b>		Attorney Docket Number	0905-002
		Application Number	
Title of Invention	CONTROLLER FOR VIDEO GAME CONSOLE		
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<b>Prefix</b>	<b>Given Name</b>	<b>Middle Name</b>	<b>Family Name</b>	<b>Suffix</b>	
	Simon		Burgess		
<b>Residence Information (Select One)</b> <input type="radio"/> US Residency <input checked="" type="radio"/> Non US Residency <input type="radio"/> Active US Military Service					
<b>City</b>	Loughborough	<b>Country Of Residence<sup>i</sup></b>	GB		
<b>Citizenship under 37 CFR 1.41(b)<sup>i</sup></b>		GB			
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<b>Application Data Sheet 37 CFR 1.76</b>		Attorney Docket Number	0905-002
		Application Number	
Title of Invention	CONTROLLER FOR VIDEO GAME CONSOLE		
Customer Number	52245		
Email Address	docteting@parksiplaw.com	<input type="button" value="Add Email"/>	<input type="button" value="Remove Email"/>

**Application Information:**

Title of the Invention	CONTROLLER FOR VIDEO GAME CONSOLE		
Attorney Docket Number	0905-002	Small Entity Status Claimed	<input checked="" type="checkbox"/>
Application Type	Nonprovisional		
Subject Matter	Utility		
Suggested Class (if any)		Sub Class (if any)	
Suggested Technology Center (if any)			
Total Number of Drawing Sheets (if any)	2	Suggested Figure for Publication (if any)	

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<b>Application Data Sheet 37 CFR 1.76</b>		Attorney Docket Number	0905-002
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Title of Invention	CONTROLLER FOR VIDEO GAME CONSOLE		

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Application Number	Country <sup>i</sup>	Parent Filing Date (YYYY-MM-DD)	Priority Claimed
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Organization Name Ironburg Inventions Ltd.

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Signature	/Collen Beard/		Date (YYYY-MM-DD)	2011-06-17
First Name	Collen	Last Name	Beard	Registration Number
				38824

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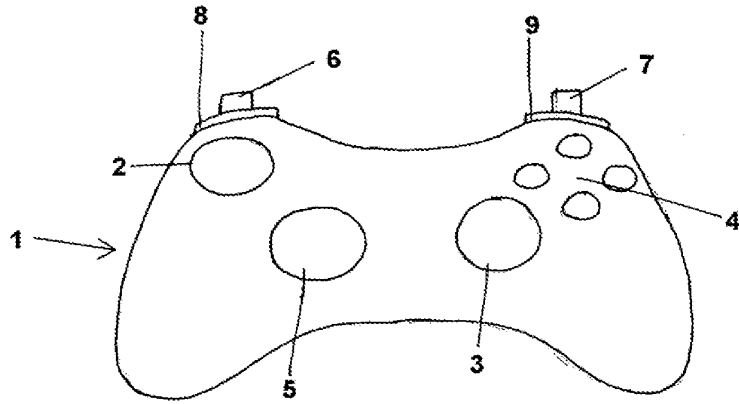


Figure 1

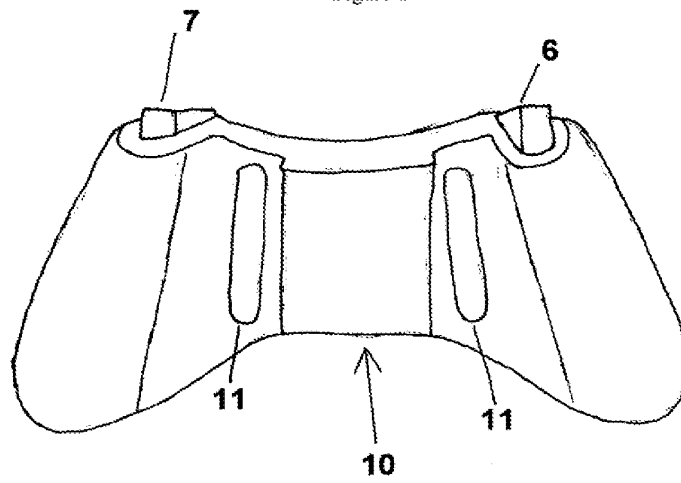


Figure 2

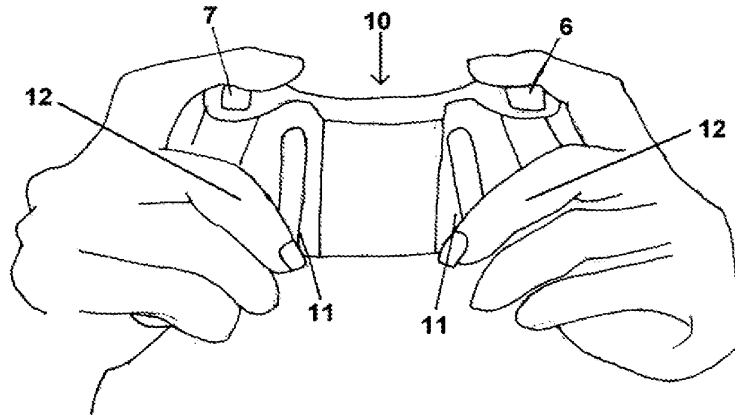


Figure 3

## Electronic Acknowledgement Receipt

<b>EFS ID:</b>	10327952
<b>Application Number:</b>	13162727
<b>International Application Number:</b>	
<b>Confirmation Number:</b>	8138
<b>Title of Invention:</b>	CONTROLLER FOR VIDEO GAME CONSOLE
<b>First Named Inventor/Applicant Name:</b>	Simon Burgess
<b>Customer Number:</b>	52245
<b>Filer:</b>	Collen Alana Beard/Virginia Keenan
<b>Filer Authorized By:</b>	Collen Alana Beard
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### File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Application Data Sheet	ADS.pdf	1031066 b44e46f164998531c502ff18c57b539d1bb3c17d5	no	4

### Warnings:

### Information:

2		Application.pdf	2588283	yes	10
			5bac2d586ad55c28bf5cd11a2283473a4c378b6		
<b>Multipart Description/PDF files in .zip description</b>					
		<b>Document Description</b>	<b>Start</b>	<b>End</b>	
		Specification	1	6	
		Claims	7	9	
		Abstract	10	10	
<b>Warnings:</b>					
<b>Information:</b>					
3	Drawings-only black and white line drawings	Drawings.pdf	231414	no	2
			a9510778a5d7d2a5416c3b410d366401c507cf09		
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## CONTROLLER FOR VIDEO GAME CONSOLE

### BACKGROUND OF THE INVENTION

The present invention relates to video game consoles, in particular to hand held controllers for video game consoles.

5 Conventional controllers for most game consoles are intended to be held and operated by the user using both hands. A conventional controller will generally comprise a hard outer case with a plurality of controls mounted about the controller. Typically the controls include buttons, analogue control sticks, bumpers, and triggers. An example of a conventional controller is shown in Figure 1.

10 As can be seen in Figure 1, all of the controls are mounted on the front and top edge of the controller 1. Specifically, there are left and right analogue thumb sticks 2, 3 which normally control movement and are intended to be operated by the user's left and right thumb respectively. There are four buttons 4, located on a front right portion of the controller 1 which normally control additional actions and are intended to be operated by the user's right thumb.

15 There is a direction pad 5 located on the lower portion of the front left of the controller 1. The direction pad 5 is intended to be operated by the user's left thumb, typically either as an alternative to the left thumb stick 2 or to provide additional actions. There is a left trigger 6, a right trigger 7, a left bumper 8, and a right bumper 9 located on the top edge of the controller 1. The left and right triggers 6, 7 are typically operated by the user's index fingers. The left and  
20 right bumpers 8, 9 may also be operated by the user's index fingers.

The only way to operate the four buttons 4 is for the user to remove his or her right thumb from the right thumb stick 3. This takes time and, in some games, can cause a loss of control. This is a particular problem in games where the right thumb stick 3 is used for aiming. A similar problem may arise in games where the direction pad 5 provides additional actions and the user  
25 has to remove his or her thumb from the left thumb stick 2 in order to operate the direction pad 5.

In light of the above, there is a need for an improved controller which removes the need for a user to remove his or her thumb from the left or right thumb stick 2, 3 in order to operate additional actions controlled by the four buttons 4 and/or the direction pad 5.

#### SUMMARY OF THE INVENTION

5 The present invention provides a hand held controller for a video game console having a hard outer case and a plurality of controls located on the front and top edge of the controller. The controller is shaped to be held in both hands of the user such that the user's thumbs are positioned to operate controls located on the front of the controller and the user's index fingers are positioned to operate controls located on the top edge of the controller. The  
10 controller further includes one or more additional controls located on the back of the controller in a position to be operated by the user's other fingers.

In one embodiment, each additional control is an elongate member which is inherently resilient and flexible such that it can be displaced by a user to activate control function.

15 Preferably, each elongate member is mounted within a respective recess located in the case of the controller.

Preferably, each elongate member comprises an outermost surface which is disposed in close proximity to the outermost surface of the controller such that the user's finger may be received in said respective recess.

20 Preferably, each elongate member has a thickness less than 10mm thick, more preferably less than 5mm thick, and most desirably between 1mm and 3mm.

Preferably, there are two additional controls which are elongate members that are parallel to each another. In another embodiment, the elongate members converge towards the front end of the controller with respect to one another.

25 Optionally, a portion of each of the elongate members is in registry with a switch mechanism disposed within the controller, such that displacement of the elongate member activates the switch mechanism.

Optionally, a switch mechanism is disposed between the elongate members and an outer surface of the controller.

The controller of the present invention may be very similar to controllers according to the prior art. In particular, the outer case of the controller and the type, number and positioning of the controls located on the front and top edge of the controller may be the same as a controller  
5 according to the prior art, as described above and as illustrated in the figures.

The controller of the present invention is particularly advantageous over controllers according to the prior art as it comprises one or more additional controls located on the back of the controller in a position to be operated by middle fingers of a user. The additional controls may  
10 either replicate the functions of one or more of the controls located on the front or top edge of the controller or provide additional functionality.

In a preferred embodiment of the invention the additional controls replicate the function of a control located on the front of the controller. This means that a user does not need to remove his or her thumb from one of the thumb sticks in order to operate the buttons and/or direction  
15 pad located on the front of the controller and can instead perform the function by manipulating an additional control located on the back of the controller with a finger.

Alternatively, the additional controls may provide additional functionality in that they do not replicate the function of controls located on the front or top of the controller but may perform different functions. In this manner a controller according to the present invention may provide  
20 more functions than prior art controllers.

Preferably, the controls located on the back of the controller are paddle levers. Suitable paddle levers may be formed integrally with the outer case of the controller or may be substantially separate from the outer case. This may be done in any manner apparent to the person skilled in the art. However, it is to be appreciated that the additional controls may comprise any other  
25 control suitable for use by a hand held controller.

Advantageously, if the additional controls are paddle levers, they will be formed such that they are substantially vertically aligned with respect to the controller. This may allow the most ergonomically efficient activation of the paddle levers by the middle fingers of the user.

Further features and advantages of the present invention will be apparent from the specific  
5 embodiment illustrated in the drawings and discussed below.

#### BRIEF DESCRIPTION OF THE DRAWINGS

FIGURE 1 is a schematic illustration of the front of a conventional game controller according to the prior art.

FIGURE 2 is a schematic illustration of the back of a game controller according to the present  
10 invention.

FIGURE 3 is a schematic illustration of the back of a game controller according to the present invention as held and operated by a user.

#### DETAILED DESCRIPTION OF THE INVENTION

The particular embodiment described below and illustrated by Figures 2 and 3 serves to further  
15 illustrate the invention, to provide those of ordinary skill in the art with a complete disclosure and description of the devices claimed herein, and is not intended to limit the scope of the invention. For example, the additional controls are described below as two paddle levers but the term "control" as used in the claims, unless otherwise made clear in the claim, refers to paddle levers as well as other controls such as buttons, analogue control sticks, bumpers, and  
20 triggers.

The game controller 10 according to the present invention is illustrated in Figures 2 and 3. The front of the game controller 10 of Figures 2 and 3 is the same as a conventional controller 1, as illustrated in Figure 1 and as discussed above. Therefore, where appropriate the same reference numerals have been used to indicate the features of the controller according to the  
25 present invention 10 that are identical to the features of a conventional controller 1.



Game controller 10 differs from the conventional controller 1 in that it additionally comprises two paddle levers 11 located on the back of the controller. The paddle levers 11 are vertically orientated with respect to the controller 10 and are positioned to be operated by the middle fingers of a user 12, as shown in Figure 3.

5 In one embodiment the paddles 11 are formed from a thin flexible material such as a plastics material for example polyethylene. Preferably, the paddles 11 are less than 10mm thick, but may be less than 5mm thick, and more preferably are 3mm thick or less.

The paddles 11 are inherently resilient, which means that they return to an unbiased position when not under load. A user may displace or depress either of the paddles 11 by engaging an  
10 outer surface thereof; such displacement causes the paddle 11 to activate a switch mechanism mounted within the body of the controller 10. The paddles 11 are mounted within recesses located on the case of the controller 10; and are disposed in close proximity to the outer surface of the controller body. In this way a user may engage the paddles 11 with the tips of the fingers, preferably the middle fingers, without compromising the user's grip on the controller  
15 10. While the example shows the paddles 11 engaged by the middle fingers, they could also be engaged by the index, ring, or little fingers. The index fingers may also engage trigger style controls mounted on the top edge of the controller 10 while the thumbs may be used to activate controls on the front of the controller 10.

The paddles 11 are elongate in shape and substantially extend in a direction from the top edge  
20 to bottom edge of the controller 10. In one embodiment the paddles are orientated parallel with each other. In an alternative embodiment the paddles are orientated such that they converge towards the top edge with respect to each other. This elongate shape allows a user to engage the paddles with any of the middle, ring, or little finger; it also provides that different users having different size hands can engage with the paddles in a comfortable position thereby  
25 reducing the effects of prolonged or repeated use such as repetitive strain injury.

In one embodiment, the paddle levers 11 replicate the functions of two of the four buttons 4 located on the front of the controller 10 and thereby allow a user to operate the functions of the relevant buttons using his or her middle fingers 12, without the need to remove either of

his or her thumbs from the left or right thumb stick 2, 3. In alternative embodiments a paddle lever 11 may activate a new function not activated by a control on the front or top edge of the controller 10.

It is envisaged that the paddles 11 could be fitted to an existing controller 10. In such  
5 embodiments the paddles would be mounted on the outer surface of the controller body by means of a mechanical fixing such as a screw or bolt or alternatively bonded or welded to the controller body by adhesive or other suitable means. A switch mechanism would be mounted within the controller in vertical registry with a portion of each paddle. A portion of the switch mechanism may extend through the controller body and be disposed in close proximity or in  
10 contact with an innermost surface of the paddle 11.

In alternative embodiments it is envisaged that the paddles 11 would be integrally formed with the controller body, the paddles 11 being configured to be resilient and flexible such that they can be depressed by a user to activate a switch mechanism. This could be achieved by moulding the controller body to have a U-shaped slot extending through the controller body;  
15 alternatively a U-shaped slot could be cut into the controller body after the moulding process. Preferably, the paddles 11 would comprise a raised outermost surface with respect to the surrounding area such that a user may locate the paddles 11. This may be achieved by moulding the paddle such that is thicker than the surrounding area. It will be recognised that as used herein, directional references such as "top", "bottom", "front", "back", "end", "side",  
20 "inner", "outer", "upper", and "lower" do not limit the respective features to such orientation, but merely serve to distinguish these features from one another.

Modifications and variations of the present invention will be apparent to those skilled in the art from the forgoing detailed description. All modifications and variations are intended to be encompassed by the following claims. All publications, patents, and patent applications cited  
25 herein are hereby incorporated by reference in their entirety.

CLAIMS

1. A hand held controller for a game console comprising:  
an outer case; and  
a plurality of controls located on a front of the controller;  
5 wherein the controller is shaped to be held in the hand of a user such that the user's thumb is positioned to operate the controls located on the front of the controller;  
and wherein the controller further comprises one or more additional controls located on a back of the controller.
- 10 2. The controller of claim 1, further having controls located on the top edge of the controller and wherein the controller is shaped such that the user's index fingers are positioned to operate controls located on the top edge
3. The controller of claim 1 wherein each additional control is in a position to be operated  
15 by a finger of a user.
4. The controller of claim 1 wherein there are two additional controls on the back of the controller, each of which is positioned to be operated by a middle finger of a user.
- 20 5. The controller of claim 1 wherein each additional control comprises an elongate member which is inherently resilient and flexible such that it can be displaced by a user to activate control function.
6. The controller of claim 5 wherein each elongate member is mounted within a respective  
25 recess located in the case of the controller.
7. The controller of claim 6 wherein each elongate member comprises an outermost surface which is disposed in close proximity to the outermost surface of the controller such that a user's finger may be received in said respective recess.

8. The controller of claim 1 wherein each elongate member has a thickness between about 1mm and 10mm.
9. The controller of claim 1 wherein each elongate member has a thickness between about  
5 1mm and 5mm.
10. The controller of claim 1 wherein each elongate member has a thickness between about 1mm and 3mm.
- 10 11. The controller of claim 5 wherein the elongate members are parallel to one another.
12. The controller of claim 5 wherein the elongate members converge towards the front end of the controller with respect to one another.
- 15 13. The controller of claim 1 wherein a portion of each additional control is in registry with a switch mechanism disposed within the controller, such that displacement of the additional control activates the switch mechanism.
14. The controller of claim 5 wherein a switch mechanism is disposed between each of the  
20 elongate members and an outer surface of the base of the controller.
15. The controller of claim 2 wherein the one or more additional controls replicate the function of one or more controls located on the front or top edge of the controller.
- 25 16. The controller of claim 2 wherein the one or more additional controls have functions in addition to the controls located on the front or top edge of the controller.
17. The controller of claim 1 wherein the one or more additional controls are paddle levers.

18. The controller of claim 1 wherein the additional controls are substantially vertically orientated with respect to the controller.

19. The controller of claim 1 wherein the one or more additional controls are formed as an  
5 integral part of the outer case.

20. The controller of claim 1 wherein the one or more additional controls are formed separate from the outer case of the controller.

**CONTROLLER FOR GAME CONSOLE**

**ABSTRACT**

An improved controller (10) for a game console that is intended to be held by a user in both hands in the same manner as a conventional controller (1), which has controls on the front operable by the thumbs (2), (3), (4), (5), and has two additional controls (11) located on the back in positions to be operated by the middle fingers of a user.

10



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Alexandria, Virginia 22313-1450
www.uspto.gov

Table with 7 columns: APPLICATION NUMBER, FILING or 371(c) DATE, GRP ART UNIT, FIL FEE REC'D, ATTY DOCKET NO, TOT CLAIMS, IND CLAIMS. Row 1: 13/162,727, 06/17/2011, 2612, 0.00, 0905-002, 20, 1

CONFIRMATION NO. 8138

FILING RECEIPT



52245
Parks IP Law LLC
1117 PERIMETER CENTER WEST
SUITE E402
ATLANTA, GA 30338

Date Mailed: 06/30/2011

Receipt is acknowledged of this non-provisional patent application. The application will be taken up for examination in due course. Applicant will be notified as to the results of the examination. Any correspondence concerning the application must include the following identification information: the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please submit a written request for a Filing Receipt Correction. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections

Applicant(s)

Simon Burgess, Loughborough, UNITED KINGDOM;
Duncan Ironmonger, Atlanta, GA;

Assignment For Published Patent Application

IRONBURG INVENTIONS LTD., Wincanton, UNITED KINGDOM

Power of Attorney: None

Domestic Priority data as claimed by applicant

Foreign Applications (You may be eligible to benefit from the Patent Prosecution Highway program at the USPTO. Please see http://www.uspto.gov for more information.)

If Required, Foreign Filing License Granted: 06/28/2011

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is US 13/162,727

Projected Publication Date: To Be Determined - pending completion of Missing Parts

Non-Publication Request: No

Early Publication Request: No

\*\* SMALL ENTITY \*\*

**Title**

CONTROLLER FOR VIDEO GAME CONSOLE

**Preliminary Class**

340

**PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES**

Since the rights granted by a U.S. patent extend only throughout the territory of the United States and have no effect in a foreign country, an inventor who wishes patent protection in another country must apply for a patent in a specific country or in regional patent offices. Applicants may wish to consider the filing of an international application under the Patent Cooperation Treaty (PCT). An international (PCT) application generally has the same effect as a regular national patent application in each PCT-member country. The PCT process **simplifies** the filing of patent applications on the same invention in member countries, but **does not result** in a grant of "an international patent" and does not eliminate the need of applicants to file additional documents and fees in countries where patent protection is desired.

Almost every country has its own patent law, and a person desiring a patent in a particular country must make an application for patent in that country in accordance with its particular laws. Since the laws of many countries differ in various respects from the patent law of the United States, applicants are advised to seek guidance from specific foreign countries to ensure that patent rights are not lost prematurely.

Applicants also are advised that in the case of inventions made in the United States, the Director of the USPTO must issue a license before applicants can apply for a patent in a foreign country. The filing of a U.S. patent application serves as a request for a foreign filing license. The application's filing receipt contains further information and guidance as to the status of applicant's license for foreign filing.

Applicants may wish to consult the USPTO booklet, "General Information Concerning Patents" (specifically, the section entitled "Treaties and Foreign Patents") for more information on timeframes and deadlines for filing foreign patent applications. The guide is available either by contacting the USPTO Contact Center at 800-786-9199, or it can be viewed on the USPTO website at <http://www.uspto.gov/web/offices/pac/doc/general/index.html>.

For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, <http://www.stopfakes.gov>. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific countries such as China, Korea and Mexico. For questions regarding patent enforcement issues, applicants may call the U.S. Government hotline at 1-866-999-HALT (1-866-999-4158).

**LICENSE FOR FOREIGN FILING UNDER**

**Title 35, United States Code, Section 184**

**Title 37, Code of Federal Regulations, 5.11 & 5.15**

**GRANTED**

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as



set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Bureau of Industry and Security, Department of Commerce (15 CFR parts 730-774); the Office of Foreign Assets Control, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

**NOT GRANTED**

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).

**PATENT APPLICATION FEE DETERMINATION RECORD**

Substitute for Form PTO-875

Application or Docket Number  
13/162,727

**APPLICATION AS FILED - PART I**

(Column 1)		(Column 2)	SMALL ENTITY		OR	OTHER THAN SMALL ENTITY	
FOR	NUMBER FILED	NUMBER EXTRA	RATE(\$)	FEE(\$)		RATE(\$)	FEE(\$)
BASIC FEE (37 CFR 1.16(a), (b), or (c))	N/A	N/A	N/A	82		N/A	
SEARCH FEE (37 CFR 1.16(k), (j), or (m))	N/A	N/A	N/A	270		N/A	
EXAMINATION FEE (37 CFR 1.16(o), (p), or (q))	N/A	N/A	N/A	110		N/A	
TOTAL CLAIMS (37 CFR 1.16(i))	20 minus 20 = *	*	x 26 =	0.00	OR		
INDEPENDENT CLAIMS (37 CFR 1.16(h))	1 minus 3 =	*	x 110 =	0.00			
APPLICATION SIZE FEE (37 CFR 1.16(s))	If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$270 (\$135 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).			0.00			
MULTIPLE DEPENDENT CLAIM PRESENT (37 CFR 1.16(j))				0.00			
* If the difference in column 1 is less than zero, enter "0" in column 2.			TOTAL	462		TOTAL	

**APPLICATION AS AMENDED - PART II**

(Column 1)		(Column 2)	(Column 3)	SMALL ENTITY		OR	OTHER THAN SMALL ENTITY	
AMENDMENT A	CLAIMS REMAINING AFTER AMENDMENT	HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE(\$)	ADDITIONAL FEE(\$)		RATE(\$)	ADDITIONAL FEE(\$)
Total (37 CFR 1.16(i))	*	Minus **	=	x	=	OR	x	=
Independent (37 CFR 1.16(h))	*	Minus ***	=	x	=	OR	x	=
Application Size Fee (37 CFR 1.16(s))						OR		
FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(j))						OR		
				TOTAL ADD'L FEE		OR	TOTAL ADD'L FEE	
AMENDMENT B	CLAIMS REMAINING AFTER AMENDMENT	HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE(\$)	ADDITIONAL FEE(\$)		RATE(\$)	ADDITIONAL FEE(\$)
Total (37 CFR 1.16(i))	*	Minus **	=	x	=	OR	x	=
Independent (37 CFR 1.16(h))	*	Minus ***	=	x	=	OR	x	=
Application Size Fee (37 CFR 1.16(s))						OR		
FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(j))						OR		
				TOTAL ADD'L FEE		OR	TOTAL ADD'L FEE	

\* If the entry in column 1 is less than the entry in column 2, write "0" in column 3.  
 \*\* If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20, enter "20".  
 \*\*\* If the "Highest Number Previously Paid For" IN THIS SPACE is less than 3, enter "3".  
 The "Highest Number Previously Paid For" (Total or Independent) is the highest found in the appropriate box in column 1.



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

Table with 4 columns: APPLICATION NUMBER (13/162,727), FILING OR 371(C) DATE (06/17/2011), FIRST NAMED APPLICANT (Simon Burgess), ATTY. DOCKET NO./TITLE (0905-002)

CONFIRMATION NO. 8138

FORMALITIES LETTER

52245
Parks IP Law LLC
1117 PERIMETER CENTER WEST
SUITE E402
ATLANTA, GA 30338



Date Mailed: 06/30/2011

NOTICE TO FILE MISSING PARTS OF NONPROVISIONAL APPLICATION

FILED UNDER 37 CFR 1.53(b)

Filing Date Granted

Items Required To Avoid Abandonment:

An application number and filing date have been accorded to this application. The item(s) indicated below, however, are missing. Applicant is given TWO MONTHS from the date of this Notice within which to file all required items below to avoid abandonment. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a).

- The statutory basic filing fee is missing. Applicant must submit \$82 to complete the basic filing fee for a small entity.
The oath or declaration is missing. A properly signed oath or declaration in compliance with 37 CFR 1.63, identifying the application by the above Application Number and Filing Date, is required.
Note: If a petition under 37 CFR 1.47 is being filed, an oath or declaration in compliance with 37 CFR 1.63 signed by all available joint inventors, or if no inventor is available by a party with sufficient proprietary interest, is required.

The applicant needs to satisfy supplemental fees problems indicated below.

The required item(s) identified below must be timely submitted to avoid abandonment:

- A surcharge (for late submission of filing fee, search fee, examination fee or oath or declaration) as set forth in 37 CFR 1.16(f) of \$65 for a small entity in compliance with 37 CFR 1.27, must be submitted.

SUMMARY OF FEES DUE:

Total fee(s) required within TWO MONTHS from the date of this Notice is \$527 for a small entity

- \$82 Statutory basic filing fee.
\$65 Surcharge.
The application search fee has not been paid. Applicant must submit \$270 to complete the search fee.
The application examination fee has not been paid. Applicant must submit \$110 to complete the examination fee for a small entity in compliance with 37 CFR 1.27.

Replies should be mailed to:

Mail Stop Missing Parts  
Commissioner for Patents  
P.O. Box 1450  
Alexandria VA 22313-1450

Registered users of EFS-Web may alternatively submit their reply to this notice via EFS-Web.  
<https://portal.uspto.gov/authenticate/AuthenticateUserLocalEPF.html>

For more information about EFS-Web please call the USPTO Electronic Business Center at **1-866-217-9197** or visit our website at <http://www.uspto.gov/ebc>.

If you are not using EFS-Web to submit your reply, you must include a copy of this notice.

*/aabranys/*

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Office of Data Management, Application Assistance Unit (571) 272-4000, or (571) 272-4200, or 1-888-786-0101

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Inventors: Burgess et al.

Docket No.: 0905-002

Serial No.: 13/162,727

Art Unit: 2612

Filing Date: June 17, 2011

Confirmation No.: 8138

For: **CONTROLLER FOR VIDEO GAME CONSOLE**

Mail Stop: Missing Parts  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, Virginia 22313-1450

**RESPONSE TO NOTICE TO FILE MISSING PARTS OF  
NONPROVISIONAL APPLICATION**

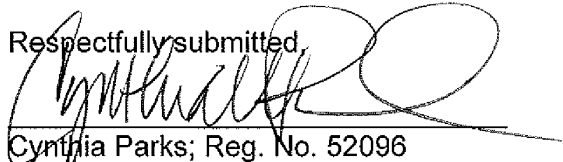
Sir:

In response to the Notice to File Missing Parts of Nonprovisional Application mailed June 30, 2011, enclosed are the following:

1. Executed Declaration by inventors Simon Burgess and Duncan Ironmonger;
2. Petition for Extension of Time (one month); and
3. Payment in the amount of \$527.00 (\$82.00 Basic filing fee; \$65.00 Surcharge; \$270.00 Search fee; \$110.00 Examination fee).

Applicant believes this to be a complete reply to the Notice and believe that no additional fees are due; however, the Commissioner is hereby authorized to charge any additional fees due to Deposit Account 50-3447.

Respectfully submitted,

  
Cynthia Parks; Reg. No. 52096

Parks IP Law LLC  
1117 Perimeter Center West  
Suite E402  
Atlanta, GA 30338



**DECLARATION AND POWER OF ATTORNEY**

Original       Supplemental       Substitute       PCT

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name.

I believe I am the original, first and sole inventor (if only one name is listed below), or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

**CONTROLLER FOR VIDEO GAME CONSOLE**  
(Title of the Invention)

the specification of which (check one)

- is attached hereto
- was filed on June 17, 2011 and assigned serial no. 13/162,727  
and was amended on \_\_\_\_\_ (if applicable)

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to the patentability of this application in accordance with Title 37, Code of Federal Regulations, § 1.56.

I hereby claim foreign priority benefits under Title 35, United States Code, § 119 (a) - (d) or § 365(b) of any foreign application(s) for patent or inventor's certificate, or § 365(a) of any PCT international application which designated at least one country other than the United States of America, listed below and have also identified, by checking the box below, any foreign application for patent or inventor's certificate, or of any PCT international application having a filing date before that of the application on which priority is claimed.

Prior Foreign Applications			Priority Claimed		Copy Attached	
Application Number	Country	Foreign Filing Date (MM/DD/YYYY)	YES	NO	YES	NO

As a named inventor, I hereby revoke all prior powers and appoint the attorney(s) and/or agent(s) associated with:

**Customer No. 52245**

to prosecute this application and transact all business in the Patent and Trademark Office connected therewith.

I acknowledge the above-listed attorneys and agents and their firm Parks IP Law LLC represent my employer (if I am an employee and this application has been or will be assigned to my employer) or the entity with which I have contracted (if I am an independent contractor and this application has been or will be assigned to such entity) and in such cases do not

Inventors: Simon Burgess and Duncan Ironmonger  
For: Controller for Video Game Console

Page 2 of 2

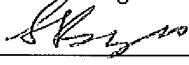
represent me individually. I further acknowledge I have not established, nor will I seek to establish, any personal attorney/client relationship with Parks IP Law LLC in connection with this application and understand that, should I require legal representation, I will obtain such, at my expense, other than through Parks IP Law LLC.

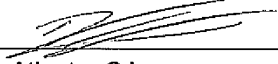
Send Correspondence to the Address associated with **Customer Number 52245**

Direct telephone calls to: Collen A. Beard, Esq. (678) 325-6601

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

---

Full name of first inventor Simon Burgess  
Inventor's signature  Date: July 23<sup>rd</sup> 2011  
Residence Loughborough, Leicestershire  
Citizenship United Kingdom  
Post Office Address 39 Jubilee Avenue, Sileby, Loughborough, Leicestershire LE12  
7TH United Kingdom

Full name of first inventor Duncan Ironmonger  
Inventor's signature  Date: July 23<sup>rd</sup> 2011  
Residence Atlanta, GA  
Citizenship United States of America  
Post Office Address 3820 Roswell Road, Suite 306, Atlanta, GA 30342



## Electronic Patent Application Fee Transmittal

<b>Application Number:</b>	13162727			
<b>Filing Date:</b>	17-Jun-2011			
<b>Title of Invention:</b>	CONTROLLER FOR VIDEO GAME CONSOLE			
<b>First Named Inventor/Applicant Name:</b>	Simon Burgess			
<b>Filer:</b>	Cynthia R. Parks/Virginia Keenan			
<b>Attorney Docket Number:</b>	0905-002			
Filed as Small Entity				
<b>Utility under 35 USC 111(a) Filing Fees</b>				
<b>Description</b>	<b>Fee Code</b>	<b>Quantity</b>	<b>Amount</b>	<b>Sub-Total in USD(\$)</b>
<b>Basic Filing:</b>				
Utility filing Fee (Electronic filing)	4011	1	82	82
Utility Search Fee	2111	1	270	270
Utility Examination Fee	2311	1	110	110
<b>Pages:</b>				
<b>Claims:</b>				
<b>Miscellaneous-Filing:</b>				
Late filing fee for oath or declaration	2051	1	65	65
<b>Petition:</b>				

Description	Fee Code	Quantity	Amount	Sub-Total in USD(\$)
<b>Patent-Appeals-and-Interference:</b>				
<b>Post-Allowance-and-Post-Issuance:</b>				
<b>Extension-of-Time:</b>				
<b>Miscellaneous:</b>				
<b>Total in USD (\$)</b>				<b>527</b>

## Electronic Acknowledgement Receipt

<b>EFS ID:</b>	10968711
<b>Application Number:</b>	13162727
<b>International Application Number:</b>	
<b>Confirmation Number:</b>	8138
<b>Title of Invention:</b>	CONTROLLER FOR VIDEO GAME CONSOLE
<b>First Named Inventor/Applicant Name:</b>	Simon Burgess
<b>Customer Number:</b>	52245
<b>Filer:</b>	Cynthia R. Parks/Virginia Keenan
<b>Filer Authorized By:</b>	Cynthia R. Parks
<b>Attorney Docket Number:</b>	0905-002
<b>Receipt Date:</b>	16-SEP-2011
<b>Filing Date:</b>	17-JUN-2011
<b>Time Stamp:</b>	16:03:00
<b>Application Type:</b>	Utility under 35 USC 111(a)

### Payment information:

Submitted with Payment	yes
Payment Type	Credit Card
Payment was successfully received in RAM	\$527
RAM confirmation Number	2816
Deposit Account	503447
Authorized User	PARKS IP LAW LLC

The Director of the USPTO is hereby authorized to charge indicated fees and credit any overpayment as follows:

Charge any Additional Fees required under 37 C.F.R. Section 1.16 (National application filing, search, and examination fees)

Charge any Additional Fees required under 37 C.F.R. Section 1.17 (Patent application and reexamination processing fees)

Charge any Additional Fees required under 37 C.F.R. Section 1.19 (Document supply fees)  
 Charge any Additional Fees required under 37 C.F.R. Section 1.20 (Post Issuance fees)  
 Charge any Additional Fees required under 37 C.F.R. Section 1.21 (Miscellaneous fees and charges)

**File Listing:**

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Applicant Response to Pre-Exam Formalities Notice	ResponseMP.pdf	46543	no	1
			280b1da96c8aab1d12ce39a4e42d6e5f61ccf8f		
<b>Warnings:</b>					
<b>Information:</b>					
2	Extension of Time	EOT.pdf	73726	no	1
			568647a68b83d7037c9b339ac92b9f39bfe6700a		
<b>Warnings:</b>					
<b>Information:</b>					
3	Oath or Declaration filed	Declaration.pdf	114474	no	2
			5786f71ae312e38365651d3968fd19c1823d4c22		
<b>Warnings:</b>					
<b>Information:</b>					
4	Fee Worksheet (SB06)	fee-info.pdf	36932	no	2
			f482d677ed4ff1544ecae27f8bbdda4d6d49a243c		
<b>Warnings:</b>					
<b>Information:</b>					
<b>Total Files Size (in bytes):</b>			271675		

**This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.**

**New Applications Under 35 U.S.C. 111**

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

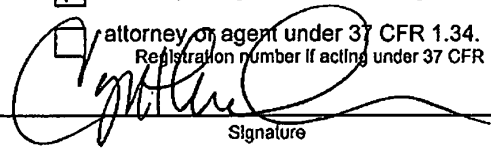
**National Stage of an International Application under 35 U.S.C. 371**

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

**New International Application Filed with the USPTO as a Receiving Office**

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

Under the paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<b>PETITION FOR EXTENSION OF TIME UNDER 37 CFR 1.136(a)</b> FY 2009 <i>(Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).)</i>		Docket Number (Optional) 0905-002	
Application Number <u>13/162,727</u>		Filed June 17, 2011	
For <b>CONTROLLER FOR VIDEO GAME CONSOLE</b>			
Art Unit 2612		Examiner TBD	
This is a request under the provisions of 37 CFR 1.136(a) to extend the period for filing a reply in the above identified application. The requested extension and fee are as follows (check time period desired and enter the appropriate fee below):			
		<u>Fee</u>	<u>Small Entity Fee</u>
<input checked="" type="checkbox"/>	One month (37 CFR 1.17(a)(1))	\$130	\$65     \$ <u>65</u>
<input type="checkbox"/>	Two months (37 CFR 1.17(a)(2))	\$490	\$245     \$ _____
<input type="checkbox"/>	Three months (37 CFR 1.17(a)(3))	\$1110	\$555     \$ _____
<input type="checkbox"/>	Four months (37 CFR 1.17(a)(4))	\$1730	\$865     \$ _____
<input type="checkbox"/>	Five months (37 CFR 1.17(a)(5))	\$2350	\$1175     \$ _____
<input checked="" type="checkbox"/>	Applicant claims small entity status. See 37 CFR 1.27.     09/23/2011 MTEKLEMI 00000018 503447 13162727		
<input type="checkbox"/>	A check in the amount of the fee is enclosed.     01 FC:2251     65.00 DA		
<input checked="" type="checkbox"/>	Payment by credit card. Form PTO-2038 is attached.		
<input type="checkbox"/>	The Director has already been authorized to charge fees in this application to a Deposit Account.		
<input checked="" type="checkbox"/>	The Director is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number <u>50-3447</u> .		
<b>WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.</b>			
I am the <input type="checkbox"/> applicant/inventor.			
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed (Form PTO/SB/96).			
<input checked="" type="checkbox"/> attorney or agent of record. Registration Number <u>52096</u>			
<input type="checkbox"/> attorney or agent under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____			
 _____ Signature		<u>16 Sept 2011</u> _____ Date	
<u>Cynthia Parks</u> _____ Typed or printed name		<u>678) 325-6601</u> _____ Telephone Number	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
<input type="checkbox"/> Total of _____ forms are submitted.			

This collection of information is required by 37 CFR 1.136(a). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 8 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

**PATENT APPLICATION FEE DETERMINATION RECORD**

Substitute for Form PTO-875

Application or Docket Number  
13/162,727

**APPLICATION AS FILED - PART I**

(Column 1)		(Column 2)	SMALL ENTITY		OR	OTHER THAN SMALL ENTITY	
FOR	NUMBER FILED	NUMBER EXTRA	RATE(\$)	FEE(\$)		RATE(\$)	FEE(\$)
BASIC FEE (37 CFR 1.16(a), (b), or (c))	N/A	N/A	N/A	82		N/A	
SEARCH FEE (37 CFR 1.16(k), (j), or (m))	N/A	N/A	N/A	270		N/A	
EXAMINATION FEE (37 CFR 1.16(o), (p), or (q))	N/A	N/A	N/A	110		N/A	
TOTAL CLAIMS (37 CFR 1.16(i))	20 minus 20 = *	*	x 26 =	0.00	OR		
INDEPENDENT CLAIMS (37 CFR 1.16(h))	1 minus 3 =	*	x 110 =	0.00			
APPLICATION SIZE FEE (37 CFR 1.16(s))	If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$310 (\$155 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).			0.00			
MULTIPLE DEPENDENT CLAIM PRESENT (37 CFR 1.16(j))				0.00			
* If the difference in column 1 is less than zero, enter "0" in column 2.			TOTAL	462		TOTAL	

**APPLICATION AS AMENDED - PART II**

(Column 1)		(Column 2)	(Column 3)	SMALL ENTITY		OR	OTHER THAN SMALL ENTITY	
AMENDMENT A	CLAIMS REMAINING AFTER AMENDMENT	HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE(\$)	ADDITIONAL FEE(\$)		RATE(\$)	ADDITIONAL FEE(\$)
Total (37 CFR 1.16(i))	*	Minus **	=	x	=	OR	x	=
Independent (37 CFR 1.16(h))	*	Minus ***	=	x	=	OR	x	=
Application Size Fee (37 CFR 1.16(s))						OR		
FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(j))						OR		
				TOTAL ADD'L FEE		OR	TOTAL ADD'L FEE	
AMENDMENT B	CLAIMS REMAINING AFTER AMENDMENT	HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE(\$)	ADDITIONAL FEE(\$)		RATE(\$)	ADDITIONAL FEE(\$)
Total (37 CFR 1.16(i))	*	Minus **	=	x	=	OR	x	=
Independent (37 CFR 1.16(h))	*	Minus ***	=	x	=	OR	x	=
Application Size Fee (37 CFR 1.16(s))						OR		
FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(j))						OR		
				TOTAL ADD'L FEE		OR	TOTAL ADD'L FEE	

\* If the entry in column 1 is less than the entry in column 2, write "0" in column 3.  
 \*\* If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20, enter "20".  
 \*\*\* If the "Highest Number Previously Paid For" IN THIS SPACE is less than 3, enter "3".  
 The "Highest Number Previously Paid For" (Total or Independent) is the highest found in the appropriate box in column 1.



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Table with 7 columns: APPLICATION NUMBER, FILING or 371(c) DATE, GRP ART UNIT, FIL FEE REC'D, ATTY DOCKET NO, TOT CLAIMS, IND CLAIMS. Row 1: 13/162,727, 06/17/2011, 2612, 527, 0905-002, 20, 1

CONFIRMATION NO. 8138

UPDATED FILING RECEIPT



52245
Parks IP Law LLC
1117 PERIMETER CENTER WEST
SUITE E402
ATLANTA, GA 30338

Date Mailed: 09/26/2011

Receipt is acknowledged of this non-provisional patent application. The application will be taken up for examination in due course. Applicant will be notified as to the results of the examination. Any correspondence concerning the application must include the following identification information: the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please submit a written request for a Filing Receipt Correction. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections

Applicant(s)

Simon Burgess, Loughborough, UNITED KINGDOM;
Duncan Ironmonger, Atlanta, GA;

Assignment For Published Patent Application

IRONBURG INVENTIONS LTD., Wincanton, UNITED KINGDOM

Power of Attorney: The patent practitioners associated with Customer Number 52245

Domestic Priority data as claimed by applicant

Foreign Applications (You may be eligible to benefit from the Patent Prosecution Highway program at the USPTO. Please see http://www.uspto.gov for more information.)

If Required, Foreign Filing License Granted: 06/28/2011

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is US 13/162,727

Projected Publication Date: 12/20/2012

Non-Publication Request: No

Early Publication Request: No

\*\* SMALL ENTITY \*\*

**Title**

CONTROLLER FOR VIDEO GAME CONSOLE

**Preliminary Class**

340

**PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES**

Since the rights granted by a U.S. patent extend only throughout the territory of the United States and have no effect in a foreign country, an inventor who wishes patent protection in another country must apply for a patent in a specific country or in regional patent offices. Applicants may wish to consider the filing of an international application under the Patent Cooperation Treaty (PCT). An international (PCT) application generally has the same effect as a regular national patent application in each PCT-member country. The PCT process **simplifies** the filing of patent applications on the same invention in member countries, but **does not result** in a grant of "an international patent" and does not eliminate the need of applicants to file additional documents and fees in countries where patent protection is desired.

Almost every country has its own patent law, and a person desiring a patent in a particular country must make an application for patent in that country in accordance with its particular laws. Since the laws of many countries differ in various respects from the patent law of the United States, applicants are advised to seek guidance from specific foreign countries to ensure that patent rights are not lost prematurely.

Applicants also are advised that in the case of inventions made in the United States, the Director of the USPTO must issue a license before applicants can apply for a patent in a foreign country. The filing of a U.S. patent application serves as a request for a foreign filing license. The application's filing receipt contains further information and guidance as to the status of applicant's license for foreign filing.

Applicants may wish to consult the USPTO booklet, "General Information Concerning Patents" (specifically, the section entitled "Treaties and Foreign Patents") for more information on timeframes and deadlines for filing foreign patent applications. The guide is available either by contacting the USPTO Contact Center at 800-786-9199, or it can be viewed on the USPTO website at <http://www.uspto.gov/web/offices/pac/doc/general/index.html>.

For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, <http://www.stopfakes.gov>. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific countries such as China, Korea and Mexico. For questions regarding patent enforcement issues, applicants may call the U.S. Government hotline at 1-866-999-HALT (1-866-999-4158).

**LICENSE FOR FOREIGN FILING UNDER**

**Title 35, United States Code, Section 184**

**Title 37, Code of Federal Regulations, 5.11 & 5.15**

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This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

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No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/162,727	06/17/2011	Simon Burgess	0905-002	8138
52245	7590	06/28/2012	EXAMINER	
Parks IP Law LLC 730 Peachtree Street, NE Suite 600 ATLANTA, GA 30308			HYLINSKI, STEVEN J	
			ART UNIT	PAPER NUMBER
			3717	
			MAIL DATE	DELIVERY MODE
			06/28/2012	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**1. Claims 1-7, 11, 13-14, and 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by US 6,394,906 to Ogata.**

#### **Re Claim 1,**

Ogata discloses a hand held controller for a game console (Abstract) comprising:  
an outer case (Fig. 1 and 4:35-40, main body unit 4 made up of upper half 2 and lower half 3 abutted and connected to each other by fasteners) and

a plurality of controls located on a front of the controller (Figs. 1-2, controls 9, 12, 16, 22-24 are all located on upper half 2 of controller 1)

wherein the controller is shaped to be held in the hand of a user such that the user's thumb is positioned to operate the controls located on the front of the controller (Fig. 7, the user's thumb's Lf1 and Rf1 are used to operate all controls 9, 12, 16, 22-24 located on upper half 2 of controller 1)

and therein the controller further comprises one or more additional controls located on a back of the controller (Figs. 1-8, trigger buttons 19b and 20b are located on lower half 3 of the controller body, facing away from the player as shown in Fig. 7 and therefore are on the back of the controller)

**Re Claim 2,**

Ogata discloses the controller of claim 1 further having controls located on the top edge of the controller and wherein the controller is shaped such that the user's index fingers are positioned to operate controls located on the top edge (Fig. 7, buttons 19a and 20a are buttons located on the top edge of upper half 2 of the main body unit 4 which are operated by the user's index fingers Lf2 and Rf2).

**Re Claim 3,**

Any of the plurality of controls shown in Figs. 1-8, which are additional controls relative to any other controls on the unit, is positioned to be operated by fingers Lf1-5 and Rf1-5 of the user's hands Lf, Rf as shown in Fig. 7.

**Re Claim 4,**

Fig. 7 shows two additional controls 19b and 20b positioned to be operated by middle fingers Rf3 and Lf3 of the user.

**Re Claim 5,**

The buttons 19a-b and 20a-b are depicted in Fig. 4 as being rectangular and are therefore elongate members, which because they are operated by depressing them into the housing renders them inherently resilient and flexible (13:13-25 describes buttons 19a-b and 20a-b as thrusting actuators that protrude from the housing and contact switch elements located inside the housing 4, and that the thrusting actuators may further be covered in an elastomer for improved operating feeling.)

**Re Claim 6,**

See Fig. 9 19a-b protruding from recesses in the housing 4, and also see 13:13-25.

**Re Claim 7,**

Figs. 7-8 show elongate members 19a-b and 20a-b comprising an outermost surface disposed in close proximity to the outermost surface of the controller housing 4 such that user's fingers Rf2,3 and Lf2,3 may be received in the recess depicted in Fig. 8 with respect to buttons 19a,b.

**Re Claim 11,**

Fig. 4 shows elongate members 19a,b and 20a,b being parallel to one another.

**Re Claims 13-14,**

See 13:19-21 which describes a portion of each additional control being in registry with a switch mechanism disposed within the controller and in between each of the elongate members and an outer surface of the base of the controller, such that displacement of the additional control activates the switch mechanism.

**Re Claim 17,**

The controls 19a-b and 20a-b that provide flat button surfaces, the exposed part of which face away from the user and are operated by the user's fingers wrapping around the controller body and depressing them as shown in Fig. 7, can be interpreted as paddle levers.

**Re Claim 18,**

Fig. 4 shows the additional controls 19a-b and 20a-b being substantially vertically oriented with respect to the controller.

**Re Claims 19-20,**

The additional controls 19a-b and 20a-b shown in Figs. 1-8 are placed such that they are integral with the case yet they are distinct components from the case body 4.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**2. Claims 8-10, 12, and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,394,906 to Ogata.**

**Re Claims 8-10 and 12,**

These claims recite alternative possible size and shape considerations for the same elongate members 19a-b and 20a-b disclosed by Ogata and visible in Figs. 1-8, without claiming any unexpected result of these size and shape considerations, especially in light of the several thickness ranges and the parallel vs. converging size and shape limitations being presented in the alternative, which indicates the function of the apparatus is unchanged as these parameters are varied.

Regarding claims 8-10, In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the

claimed device was not patentably distinct from the prior art device. See also MPEP 2144.04 Section IV A.

Regarding claim 12, MPEP 2144.04 Section IV B States that a change in shape of an apparatus would be obvious to one having ordinary skill in the art absent persuasive evidence that the particular shape is significant.

**Re Claims 15-16,**

Although 5:45-51 of Ogata states that the controls 19a-b and 20a-b have functions that affect the game characters in ways that correspond to programming of the game, Ogata does not go into detail as to whether the button mapping of his controller is such that one or more controls replicate the functions of other controls, or whether one or more controls have functions different from other controls on the front or top edge of the controller. Because claims 15 and 16 present duplicating vs. not duplicating button mapping functions as alternatives, and because there is further no claimed specific purpose, problem being solved by, or advantage caused by replicating button mapping or not doing so, it would have been an obvious matter of design choice to one having ordinary skill in the art at the time the invention was made whether to map the preprogrammed button functions for the controller shown in Figs. 1-8 of Ogata such that functions are replicated or not. One of skill in the art would have expected Ogata's controller to function well regardless of what specific software command mapping is applied by the game designer to the button controls.

***Conclusion***



The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and is included in the Notice of References Cited. Any inquiry concerning this communication or earlier communications from the examiner should be directed to STEVEN J. HYLINSKI whose telephone number is (571)270-1995. The examiner can normally be reached on Mon-Fri 9am-7pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Melba Bumgarner can be reached on (571)272-4709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/STEVEN J HYLINSKI/  
Primary Examiner, Art Unit 3717

<b>Notice of References Cited</b>	Application/Control No. 13/162,727	Applicant(s)/Patent Under Reexamination BURGESS ET AL.	
	Examiner STEVEN J. HYLINSKI	Art Unit 3717	Page 1 of 4

**U.S. PATENT DOCUMENTS**

*	Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
*	A	US-4,552,360 A	Bromley et al.	463/38
*	B	US-5,551,693 A	Goto et al.	463/37
*	C	US-5,670,988 A	Tickle, James Dexter	345/157
*	D	US-5,716,274 A	Goto et al.	463/37
*	E	US-5,853,326 A	Goto et al.	463/37
*	F	US-5,874,906 A	Willner et al.	341/22
*	G	US-5,984,548 A	Willner et al.	400/472
*	H	US-6,001,014 A	Ogata et al.	463/37
*	I	US-6,019,680 A	Cheng, Chiu Hao	463/37
*	J	US-6,135,886 A	Armstrong, Brad A.	463/37
*	K	US-6,171,191 B1	Ogata et al.	463/38
*	L	US-6,231,444 B1	Goto et al.	463/37
*	M	US-6,261,180 B1	Lebensfeld et al.	463/49

**FOREIGN PATENT DOCUMENTS**

*	Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N				
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\*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)  
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<b>Notice of References Cited</b>	Application/Control No. 13/162,727	Applicant(s)/Patent Under Reexamination BURGESS ET AL.	
	Examiner STEVEN J. HYLINSKI	Art Unit 3717	Page 2 of 4

**U.S. PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
*	A	US-6,280,327 B1	08-2001	Leifer et al.	463/39
*	B	US-6,288,709 B1	09-2001	Willner et al.	345/169
*	C	US-6,342,009 B1	01-2002	Soma, Masahiro	463/38
*	D	US-6,394,906 B1	05-2002	Ogata, Hiroki	463/38
*	E	US-6,512,511 B2	01-2003	Willner et al.	345/169
*	F	US-6,524,187 B2	02-2003	Komata, Nobuhiro	463/37
*	G	US-6,524,186 B2	02-2003	Takatsuka et al.	463/37
*	H	US-6,682,426 B2	01-2004	Goto et al.	463/37
*	I	US-2004/0063502 A1	04-2004	HUSSAINI et al.	463/056
*	J	US-6,760,013 B2	07-2004	Willner et al.	345/169
*	K	US-2004/0224768 A1	11-2004	Hussaini et al.	463/037
*	L	US-6,887,158 B2	05-2005	Goto et al.	463/37
*	M	US-2005/0215321 A1	09-2005	Hussaini et al.	463/037

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	Examiner STEVEN J. HYLINSKI	Art Unit 3717	Page 3 of 4

**U.S. PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
*	A	US-2005/0269769 A1	12-2005	Naghi et al.	273/148.00B
*	B	US-2006/0025217 A1	02-2006	Hussaini et al.	463/036
*	C	US-2006/0040740 A1	02-2006	DiDato, Richard C.	463/037
*	D	US-2006/0116204 A1	06-2006	Chen et al.	463/037
*	E	US-2007/0021209 A1	01-2007	Hussaini et al.	463/036
*	F	US-7,235,012 B2	06-2007	DiDato, Richard C.	463/38
*	G	US-D547,763 S	07-2007	Hayes et al.	D14/454
*	H	US-7,377,851 B2	05-2008	Goto et al.	463/37
*	I	US-7,407,439 B1	08-2008	Ochoa, Justin J.	463/37
*	J	US-2008/0261695 A1	10-2008	Coe, Adam Wesley	463/37
*	K	US-7,471,216 B2	12-2008	Chen et al.	341/20
*	L	US-7,473,180 B2	01-2009	Himoto et al.	463/37
*	M	US-7,488,254 B2	02-2009	Himoto et al.	463/37

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<b>Notice of References Cited</b>	Application/Control No. 13/162,727	Applicant(s)/Patent Under Reexamination BURGESS ET AL.	
	Examiner STEVEN J. HYLINSKI	Art Unit 3717	Page 4 of 4

**U.S. PATENT DOCUMENTS**

*	Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
*	A	US-7,596,466 B2	Ohta, Keizo	702/152
*	B	US-7,753,786 B2	Ishimaru et al.	463/36
*	C	US-D620,939 S	Suetake et al.	D14/401
*	D	US-7,774,155 B2	Sato et al.	702/127
*	E	US-D623,649 S	Claussen, Seth A.	D14/401
*	F	US-7,804,484 B2	Martinez et al.	345/156
*	G	US-7,859,514 B1	Park, Young	345/156
*	H	US-7,927,216 B2	Ikeda et al.	463/38
*	I	US-7,942,745 B2	Ikeda et al.	463/38
*	J	US-D659,140 S	Ikeda et al.	D14/401
	K	US-		
	L	US-		
	M	US-		


**FOREIGN PATENT DOCUMENTS**

*	Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
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*	Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
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	X

\*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)  
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

<b><i>Index of Claims</i></b> 	<b>Application/Control No.</b> 13162727	<b>Applicant(s)/Patent Under Reexamination</b> BURGESS ET AL.
	<b>Examiner</b> STEVEN J HYLINSKI	<b>Art Unit</b> 3717

✓	<b>Rejected</b>	-	<b>Cancelled</b>	N	<b>Non-Elected</b>	A	<b>Appeal</b>
=	<b>Allowed</b>	÷	<b>Restricted</b>	I	<b>Interference</b>	O	<b>Objected</b>

Claims renumbered in the same order as presented by applicant
  CPA
  T.D.
  R.1.47

CLAIM		DATE							
Final	Original	06/16/2012							
	1	✓							
	2	✓							
	3	✓							
	4	✓							
	5	✓							
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	18	✓							
	19	✓							
	20	✓							

## EAST Search History

## EAST Search History (Prior Art)

Ref #	Hits	Search Query	DBs	Default Operator	Plurals	Time Stamp
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L4	118	463/37.ccls. and (replicat\$5 or duplicat\$5)	US-PGPUB; USPAT	OR	OFF	2012/06/16 16:55
L5	39	463/37.ccls. and ((replicat\$5 or duplicat\$5) with (control\$3 or button))	US-PGPUB; USPAT	OR	ON	2012/06/16 16:56
L9	374	"463"/\$.ccls. and ((replicat\$5 or duplicat\$5) with (control\$3 or button))	US-PGPUB; USPAT	OR	ON	2012/06/16 17:01
L10	28	"463"/\$.ccls. and ((replicat\$5 or duplicat\$5) with (control\$3 or button)) same assign\$5	US-PGPUB; USPAT	OR	ON	2012/06/16 17:02
L11	263	"463"/\$.ccls. and (different with button with (function\$5 or assign\$5))	US-PGPUB; USPAT	OR	ON	2012/06/16 17:04
L12	6	"463"/\$.ccls. and (trigger with button with function with assign\$5)	US-PGPUB; USPAT	OR	ON	2012/06/16 17:04
L13	131	"463"/\$.ccls. and (trigger with button with function)	US-PGPUB; USPAT	OR	ON	2012/06/16 17:06
L14	95	"463"/\$.ccls. and (trigger with button with command)	US-PGPUB; USPAT	OR	ON	2012/06/16 17:06
L15	53	"463"/\$.ccls. and (disabl\$4 with button with	US-	OR	ON	2012/06/16

		control\$5)	PGPUB; USPAT			17:08
L16	49	"463"/\$.cls. and controller same (mapping with button)	US- PGPUB; USPAT	OR	ON	2012/06/16 17:12
L17	37	"463"/\$.cls. and (buttons with (duplicate or replicate) with (command or function))	US- PGPUB; USPAT	OR	ON	2012/06/16 17:16
L18	37	"463"/\$.cls. and (buttons with (duplicate or replicate) with (command or function or mapping or assignment))	US- PGPUB; USPAT	OR	ON	2012/06/16 17:16
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S3	701	S1 and ((front or top) and (back or bottom) and button and controller)	US- PGPUB; USPAT	OR	ON	2012/06/15 16:38
S4	2	burgess-simon\$20.in. or ironmonger-duncan\$20.in.	US- PGPUB; USPAT	OR	ON	2012/06/15 16:40
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EAST Search History


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S35	1	"6394906".pn.	USPAT	OR	OFF	2012/06/16 15:47
S36	1	S35 and 19a	USPAT	OR	OFF	2012/06/16 15:48

**EAST Search History (Interference)**

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**6/ 16/ 2012 5:36:08 PM**

**C:\Users\shylinski\Documents\EAST\Workspaces\13162727.wsp**

<b>Search Notes</b>  	<b>Application/Control No.</b>  13162727	<b>Applicant(s)/Patent Under Reexamination</b>  BURGESS ET AL.
	<b>Examiner</b>  STEVEN J HYLINSKI	<b>Art Unit</b>  3717

<b>SEARCHED</b>			
<b>Class</b>	<b>Subclass</b>	<b>Date</b>	<b>Examiner</b>
463	37	06/16/2012	SJH

<b>SEARCH NOTES</b>		
<b>Search Notes</b>	<b>Date</b>	<b>Examiner</b>
See EAST search history.	06/16/2012	SJH

<b>INTERFERENCE SEARCH</b>			
<b>Class</b>	<b>Subclass</b>	<b>Date</b>	<b>Examiner</b>

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## CERTIFICATE OF ELECTRONIC TRANSMISSION

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Oct. 29, 2012  
Transmission Date

Sheri E. Price  
Sheri Price

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Inventor(s): Simon Burgess et al.      Conf. No.: 8138  
App No.: 13/162,727                      Filing Date: June 17, 2011  
Art Unit: 3717                              Examiner: Hylinski, Steven J.  
Title:                      CONTROLLER FOR VIDEO GAME CONSOLE  
Docket No.: 0905-002

Mail Stop: AMENDMENT  
Commissioner for Patents  
U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

**RESPONSE TO NONFINAL OFFICE ACTION**

This Response is filed in reply to the non-final Office Action mailed June 28, 2012. The Assignee requests consideration of the following amendments and remarks.

Amendments to the Claims begin on page 2.

Remarks begin on page 6.

### CLAIM LISTING

The following set of claims replaces all previous versions of the claims.

1. (Currently Amended) A hand held controller for a game console comprising:
  - an outer case comprising a front, a back, a top edge, and a bottom edge, wherein the back of the controller is opposite the front of the controller and the top edge is opposite the bottom edge; and
  - a ~~plurality of~~ front control[[s]] located on the [[a]] front of the controller;  
wherein the controller is shaped to be held in the hand of a user such that the user's thumb is positioned to operate the front control[[s]] ~~located on the front of the controller;~~ and
  - ~~wherein the controller further comprises one or more additional~~ a back control[[s]] located on [[a]] the back of the controller, wherein the back control is an elongate member that extends between the top edge and the bottom edge and is inherently resilient and flexible.
  
2. (Currently Amended) The controller of claim 1, further having a top edge control[[s]] located on the top edge of the controller and wherein the controller is shaped such that the user's index finger[[s are]] is positioned to operate the top edge control[[s located on the top edge]].
  
3. (Canceled)
  
4. (Currently Amended) The controller of claim 1, wherein there are two ~~[[additional]]~~ back controls on the back of the controller, each of which is positioned to be operated by a middle finger of a user.
  
5. (Canceled)

6. (Currently Amended) The controller of claim 1, [[5]] wherein each the elongate member is mounted within a respective recess located in the case of the controller.
  
7. (Currently Amended) The controller of claim 6, wherein each the elongate member comprises an outermost surface which is disposed in close proximity to the outermost surface of the controller such that a user's finger may be received in said respective recess.
  
8. (Currently Amended) The controller of claim 1, wherein each the elongate member has a thickness between about 1mm and 10mm.
  
9. (Currently Amended) The controller of claim 1, wherein each the elongate member has a thickness between about 1mm and 5mm.
  
10. (Currently Amended) The controller of claim 1, wherein each the elongate member has a thickness between about 1mm and 3mm.
  
11. (Currently Amended) The controller of claim 4, [[5]] wherein the elongate members are parallel to one another.
  
12. (Currently Amended) The controller of claim 4, [[5]] wherein the elongate members converge towards the front end of the controller with respect to one another.

13. (Currently Amended) The controller of claim 1, wherein a portion of each additional the back control is in registry with a switch mechanism disposed within the controller, such that displacement of the additional back control activates the switch mechanism.

14. (Currently Amended) The controller of claim 4, ~~[[5]]~~ wherein a switch mechanism is disposed between each of the elongate members and an outer surface of the base of the controller.

15. (Currently Amended) The controller of claim 2, wherein the ~~one or more~~ additional back control~~[[s]]~~ replicates the function of one or more of the top edge control and the front control ~~controls located on the front or top edge of the~~ controller.

16. (Currently Amended) The controller of claim 2, wherein the ~~one or more~~ additional back control~~[[s]]~~ have has functions in addition to the top edge control and the front control ~~controls located on the front or top edge of the~~ controller.

17. (Currently Amended) The controller of claim 1, wherein the ~~one or more~~ additional back control~~[[s]]~~ are is a paddle lever~~[[s]]~~.

18. (Currently Amended) The controller of claim 1 wherein the additional back control~~[[s]]~~ are is substantially parallel to the front of ~~vertically orientated with~~ respect to the controller.

19. (Currently Amended) The controller of claim 1, wherein the ~~one or more~~ additional back control~~[[s]]~~ is are formed as an integral part of the outer case.



20. (Currently Amended) The controller of claim 1, wherein the ~~one or more~~ additional back control[[s]] are is formed separate from the outer case of the controller.

21. (New) The controller of claim 2, wherein the top edge is substantially perpendicular to the front.

22. (New) A hand held controller for a game console comprising:  
an outer case comprising a front, a back, a top edge, and a bottom edge, wherein the back of the controller is opposite the front of the controller and the top edge is opposite the bottom edge;  
a front control located on the front of the controller, wherein the controller is shaped to be held in the hand of a user such that the user's thumb is positioned to operate the front control; and  
a back control located on the back of the controller, wherein the back control is an elongate member that extends between the top edge and the bottom edge.

\* \* \*

**REMARKS**

SUMMARY OF THE CLAIMS

The application has been carefully reviewed in light of the Office Action dated June 28, 2012. This communication is believed to be a complete response to that Office Action. Claims 1-20 were pending in the present application prior to entry of the present amendments. By the present Office Action, claims 1-20 have been rejected.

By the present amendment, claims 1-2, 4, and 6-20 have been amended. Claims 3 and 5 have been canceled. New claims 21-22 have been submitted for entry. Upon entry of the present amendment, claims 1-2, 4, and 6-22 are present.

Support for these amendments can be found in the original specification, and thus, no new matter has been added. Applicant reserves the right to pursue all original claims in this or other patent applications. Reconsideration and reexamination of the present application is respectfully requested in light of the foregoing amendments and in view of the following remarks, which establish that the pending claims are directed to allowable subject matter.

SECTION 102 REJECTIONS

Claims 1-7, 11, 13-14, and 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 6,394,906 (Ogata). Claims 1, 2, 4, 6, 7, 11, 13-14, and 17-20 have been amended. Claims 3 and 5 have been canceled. The rejections to claims 1 and 5 are traversed for the reasons provided below.

On pages 2 and 3, the Office Action alleges that "a back" and "top edge" recited in at least claims 1 and 2 can be interpreted to include lower half (3) and upper half (3) of main body unit (4) of Ogata. However, this interpretation is not compatible with the present specification and, therefore, is a misapplication of MPEP § 2111.

The underlying meaning of the words “back” and “top edge” as recited in the claims cannot be dismissed. While the claims must be given the broadest reasonable interpretation, this is not the complete standard. As required by MPEP § 2111, the claims must be given their broadest reasonable interpretation **consistent with the specification**. The Federal Circuit elaborated on this standard by requiring that the broadest reasonable interpretation must be “in light of the specification as it would be interpreted by **one of ordinary skill in the art**” per *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (emphasis added).

In the present case, in some embodiments, the specification discusses the claimed terms as follows. “A left trigger 6, a right trigger 7, a left bumper 8, and a right bumper 9 [are] located on the top edge of the controller 1” (page 1, lines 15-20; see FIG. 1) and additionally “two paddle levers 11 [are] located on the back of the controller.” (page 5, lines 1-5) Thus, the “top edge” and the “back” are differentiated from one another (e.g. different locations on the controller including different elements).

On the other hand, the Office Action indicates that the broadest reasonable interpretation of “back” allegedly includes lower half (3) of main portion (4) (so as to include thrusting actuators 19b and 20b) and the interpretation of “top edge” allegedly includes upper half (2) main portion (4) (so as to include thrusting actuators 19a and 20a). The Office Action alleges this interpretation even though Ogata *does not differentiate* between the upper half (2) and the lower half (3) of the main portion (4) when describing the thrusting actuators (19a, 19b, 20a, 20b). Rather, Ogata describes the position of the thrusting actuators (19a, 19b, 20a, 20b) on a single side of the main body unit (4). Specifically, Ogata discloses that “on the **front side** of the main body unit 4...are arranged fifth and sixth actuating units 17, 18. The fifth and sixth actuating units 17, 18 are provided with first and second thrusting actuators 19a, 19b, and 20a, 20b.” (column 5, lines 37-51, emphasis added) Further, Ogata only

mentions "upper half 2 and lower half 3" one time in column 4, line 38. As such, the front side of Ogata has been artificially divided into different parts in order to make the rejections.

Similarly, the Office Action's position that anything that faces away from the player is therefore the back of the controller is not consistent with the specification. For example, the Office Action does not explain why both the upper half (2) and the lower half (3) would be the back of the controller under this interpretation.

The record is otherwise devoid of any evidence supporting the Office Action's conclusion as to why a person of ordinary skill in the art would allegedly construe the front side of the main body (4) as both the "top edge" and "back" as recited in the claims. If the Examiner elects to maintain the position that a the front side of the main body (4) can be both the "top edge" and "back" as recited in the claims, Applicant respectfully requests that the Examiner provide documentary evidence on the record supporting this position. Otherwise, Applicant respectfully asserts that the conclusory assertion presented in support of this rejection is insufficient to maintain the rejection.

Accordingly, it is respectfully submitted that the rejection is overcome and respectfully requested that the rejection be withdrawn. For at least these reasons, claim 1 and claims 2-7, 11, 13-14, and 17-20 that depend therefrom are patentable over Ogata.

With respect to claim 5, Ogata fails to disclose "an elongate member which is inherently resilient and flexible such that it can be displaced by a user to activation control function." Ogata discloses a top layer 88 of rotation actuator 16 (see column 12, line 33 to column 13, line 11). However, rotation actuator 16 is not "located on the back of the controller" or "an elongate member" as claimed. Moreover, Ogata does not disclose that the thrusting actuators (19a, 19b, 20a, 20b) are "inherently resilient and flexible" as recited in claim 5.

MPEP § 2131 states that “[a] claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or **inherently** [See *related post*] described, in a single prior art reference.’ *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)” (emphasis added). “The identical invention must be shown in **as complete detail** as is contained in the ... claim.’ *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)” (emphasis added). Moreover, “[e]very element of the claimed invention must be literally present, **arranged as in the claim.**” *Id.* (emphasis added). In the present case, the Office Action has not established that each element of the claims is disclosed in Ogata. For at least these reasons, claim 5 is patentable over Ogata.

#### SECTION 103 REJECTIONS

Claims 8-10, 12, and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogata. Claims 8-10, 12, and 15-16 depend from claim 1 and are patentable over Ogata for at least the reasons provided above.

#### FEES

Payment of the fee covering a one-month extension of time is submitted herewith.

Applicant believes no other fees are due with the filing of this communication.

The Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 50-3447.

#### CONCLUSION

It is respectfully submitted that the application is in condition for allowance, and notice to that effect is respectfully requested.

If Examiner Hylinski has any new concerns, the Examiner is respectfully urged to contact the undersigned representative at her earliest convenience in order to efficiently advance prosecution of this application.

Respectfully Submitted,

PARKS IP LAW LLC

by /Stephen Terrell/  
Stephen Terrell; Reg. No. 62,734  
Agent for the Assignee

Parks IP Law  
Attention: Patent Docketing  
730 Peachtree Street N.E.  
Suite 600  
Atlanta, Georgia 30308

<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b> ( Not for submission under 37 CFR 1.99)	Application Number	13162727
	Filing Date	2011-06-17
	First Named Inventor	Simon Burgess
	Art Unit	3717
	Examiner Name	Hylinski, Steven J.
	Attorney Docket Number	0905-002

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<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b> ( Not for submission under 37 CFR 1.99)	Application Number	13162727
	Filing Date	2011-06-17
	First Named Inventor	Simon Burgess
	Art Unit	3717
	Examiner Name	Hylinski, Steven J.
	Attorney Docket Number	0905-002

1	<a href="http://benchmarkreviews.com/index.php?option=com_content&amp;task=view&amp;id=235&amp;Itemid=65&amp;limit=1&amp;limitstart=2">http://benchmarkreviews.com/index.php?option=com_content&amp;task=view&amp;id=235&amp;Itemid=65&amp;limit=1&amp;limitstart=2</a> Benchmarkreviews.com - Thurstrmaster Run-N-Drive PC/PS3 Wireless Gampad - Written by Oline Coles, April 8, 2009.	<input type="checkbox"/>
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**EXAMINER SIGNATURE**

Examiner Signature		Date Considered	
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\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through a citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

<sup>1</sup> See Kind Codes of USPTO Patent Documents at [www.USPTO.GOV](http://www.USPTO.GOV) or MPEP 901.04. <sup>2</sup> Enter office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>3</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>4</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. <sup>5</sup> Applicant is to place a check mark here if English language translation is attached.



<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b> ( Not for submission under 37 CFR 1.99)	Application Number	13162727
	Filing Date	2011-06-17
	First Named Inventor	Simon Burgess
	Art Unit	3717
	Examiner Name	Hylinski, Steven J.
	Attorney Docket Number	0905-002

**CERTIFICATION STATEMENT**

Please see 37 CFR 1.97 and 1.98 to make the appropriate selection(s):

That each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement. See 37 CFR 1.97(e)(1).

**OR**

That no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing the certification after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in 37 CFR 1.56(c) more than three months prior to the filing of the information disclosure statement. See 37 CFR 1.97(e)(2).

See attached certification statement.

The fee set forth in 37 CFR 1.17 (p) has been submitted herewith.

A certification statement is not submitted herewith.

**SIGNATURE**

A signature of the applicant or representative is required in accordance with CFR 1.33, 10.18. Please see CFR 1.4(d) for the form of the signature.

Signature	/Stephen Terrell/	Date (YYYY-MM-DD)	2012-10-29
Name/Print	Stephen Terrell	Registration Number	62,734

This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. **DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these records.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.



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The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
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## Electronic Patent Application Fee Transmittal

<b>Application Number:</b>	13162727			
<b>Filing Date:</b>	17-Jun-2011			
<b>Title of Invention:</b>	CONTROLLER FOR VIDEO GAME CONSOLE			
<b>First Named Inventor/Applicant Name:</b>	Simon Burgess			
<b>Filer:</b>	Cynthia R. Parks/Sheri Prine			
<b>Attorney Docket Number:</b>	0905-002			
Filed as Small Entity				
<b>Utility under 35 USC 111(a) Filing Fees</b>				
<b>Description</b>	<b>Fee Code</b>	<b>Quantity</b>	<b>Amount</b>	<b>Sub-Total in USD(\$)</b>
<b>Basic Filing:</b>				
<b>Pages:</b>				
<b>Claims:</b>				
<b>Miscellaneous-Filing:</b>				
<b>Petition:</b>				
<b>Patent-Appeals-and-Interference:</b>				
<b>Post-Allowance-and-Post-Issuance:</b>				
<b>Extension-of-Time:</b>				
Extension - 1 month with \$0 paid	2251	1	75	75

Description	Fee Code	Quantity	Amount	Sub-Total in USD(\$)
<b>Miscellaneous:</b>				
Submission- Information Disclosure Stmt	1806	1	180	180
<b>Total in USD (\$)</b>				<b>255</b>

## Electronic Acknowledgement Receipt

<b>EFS ID:</b>	14095760
<b>Application Number:</b>	13162727
<b>International Application Number:</b>	
<b>Confirmation Number:</b>	8138
<b>Title of Invention:</b>	CONTROLLER FOR VIDEO GAME CONSOLE
<b>First Named Inventor/Applicant Name:</b>	Simon Burgess
<b>Customer Number:</b>	52245
<b>Filer:</b>	Cynthia R. Parks/Sheri Prine
<b>Filer Authorized By:</b>	Cynthia R. Parks
<b>Attorney Docket Number:</b>	0905-002
<b>Receipt Date:</b>	29-OCT-2012
<b>Filing Date:</b>	17-JUN-2011
<b>Time Stamp:</b>	13:58:09
<b>Application Type:</b>	Utility under 35 USC 111(a)

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1		0905002Response.pdf	439084	yes	10
			c44fd936c8d8c1b8f55299fc451acef02bcc6c57		
<b>Multipart Description/PDF files in .zip description</b>					
		<b>Document Description</b>	<b>Start</b>	<b>End</b>	
		Amendment/Req. Reconsideration-After Non-Final Reject	1	1	
		Amendment Copy Claims/Response to Suggested Claims	2	5	
		Amendment/Req. Reconsideration-After Non-Final Reject	6	10	
<b>Warnings:</b>					
<b>Information:</b>					
2	Information Disclosure Statement (IDS) Form (SB08)	0905002IDS.pdf	612491	no	4
			0895545e41a32f13a4ec14f1d2947052ba65015e		
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3	Non Patent Literature	0905002IDSMaterial.pdf	216296	no	3
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<b>Warnings:</b>					
<b>Information:</b>					
4	Extension of Time	09050021MonthEOT.pdf	82788	no	2
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<b>Warnings:</b>					
<b>Information:</b>					
5	Fee Worksheet (SB06)	fee-info.pdf	32241	no	2
			99ac7e5fab71ed1c2ff7fa05d59fb5195146341		
<b>Warnings:</b>					
<b>Information:</b>					
<b>Total Files Size (in bytes):</b>				1382900	



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If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

**National Stage of an International Application under 35 U.S.C. 371**

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

**New International Application Filed with the USPTO as a Receiving Office**

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<b>PATENT APPLICATION FEE DETERMINATION RECORD</b> Substitute for Form PTO-875				Application or Docket Number <b>13/162,727</b>		Filing Date <b>06/17/2011</b>		<input type="checkbox"/> To be Mailed			
<b>APPLICATION AS FILED – PART I</b>											
(Column 1)			(Column 2)			SMALL ENTITY <input checked="" type="checkbox"/> OR		OTHER THAN SMALL ENTITY			
FOR		NUMBER FILED	NUMBER EXTRA		RATE (\$)	FEE (\$)	OR		RATE (\$)	FEE (\$)	
<input type="checkbox"/> BASIC FEE <small>(37 CFR 1.16(a), (b), or (c))</small>		N/A	N/A		N/A		OR		N/A		
<input type="checkbox"/> SEARCH FEE <small>(37 CFR 1.16(k), (i), or (m))</small>		N/A	N/A		N/A		OR		N/A		
<input type="checkbox"/> EXAMINATION FEE <small>(37 CFR 1.16(o), (p), or (q))</small>		N/A	N/A		N/A		OR		N/A		
TOTAL CLAIMS <small>(37 CFR 1.16(j))</small>		minus 20 =	*		X \$ =		OR		X \$ =		
INDEPENDENT CLAIMS <small>(37 CFR 1.16(h))</small>		minus 3 =	*		X \$ =		OR		X \$ =		
<input type="checkbox"/> APPLICATION SIZE FEE <small>(37 CFR 1.16(s))</small>		If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).									
<input type="checkbox"/> MULTIPLE DEPENDENT CLAIM PRESENT <small>(37 CFR 1.16(j))</small>											
					TOTAL		OR		TOTAL		
* If the difference in column 1 is less than zero, enter "0" in column 2.											
<b>APPLICATION AS AMENDED – PART II</b>											
(Column 1)			(Column 2)		(Column 3)		SMALL ENTITY OR		OTHER THAN SMALL ENTITY		
AMENDMENT	<b>10/29/2012</b>	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE (\$)	ADDITIONAL FEE (\$)	OR		RATE (\$)	ADDITIONAL FEE (\$)
	Total <small>(37 CFR 1.16(i))</small>	* 20	Minus	** 20	= 0	X \$31 =	0	OR		X \$ =	
	Independent <small>(37 CFR 1.16(h))</small>	* 2	Minus	***3	= 0	X \$125 =	0	OR		X \$ =	
	<input type="checkbox"/> Application Size Fee <small>(37 CFR 1.16(s))</small>										
	<input type="checkbox"/> FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM <small>(37 CFR 1.16(j))</small>										
					TOTAL ADD'L FEE	<b>0</b>	OR		TOTAL ADD'L FEE		
AMENDMENT		CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE (\$)	ADDITIONAL FEE (\$)	OR		RATE (\$)	ADDITIONAL FEE (\$)
	Total <small>(37 CFR 1.16(i))</small>	*	Minus	**	=	X \$ =		OR		X \$ =	
	Independent <small>(37 CFR 1.16(h))</small>	*	Minus	***	=	X \$ =		OR		X \$ =	
	<input type="checkbox"/> Application Size Fee <small>(37 CFR 1.16(s))</small>										
	<input type="checkbox"/> FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM <small>(37 CFR 1.16(j))</small>										
					TOTAL ADD'L FEE		OR		TOTAL ADD'L FEE		
* If the entry in column 1 is less than the entry in column 2, write "0" in column 3.											
** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20, enter "20".											
*** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 3, enter "3".											
The "Highest Number Previously Paid For" (Total or Independent) is the highest number found in the appropriate box in column 1.											
						Legal Instrument Examiner: /ANITA JOHNSON/					

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Table with 4 columns: APPLICATION NUMBER (13/162,727), FILING OR 371(C) DATE (06/17/2011), FIRST NAMED APPLICANT (Simon Burgess), ATTY. DOCKET NO./TITLE (0905-002)

CONFIRMATION NO. 8138

52245
Parks IP Law LLC
730 Peachtree Street, NE
Suite 600
ATLANTA, GA 30308

PUBLICATION NOTICE



Title:CONTROLLER FOR VIDEO GAME CONSOLE

Publication No.US-2012-0322553-A1

Publication Date:12/20/2012

NOTICE OF PUBLICATION OF APPLICATION

The above-identified application will be electronically published as a patent application publication pursuant to 37 CFR 1.211, et seq. The patent application publication number and publication date are set forth above.

The publication may be accessed through the USPTO's publically available Searchable Databases via the Internet at www.uspto.gov. The direct link to access the publication is currently http://www.uspto.gov/patft/.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/162,727	06/17/2011	Simon Burgess	0905-002	8138
52245	7590	02/04/2013	EXAMINER	
Parks IP Law LLC 730 Peachtree Street, NE Suite 600 ATLANTA, GA 30308			HYLINSKI, STEVEN J	
			ART UNIT	PAPER NUMBER
			3717	
			MAIL DATE	DELIVERY MODE
			02/04/2013	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



**DETAILED ACTION**

***Response to Arguments***

1. Applicant's arguments with respect to claims 1-2, 4, and 6-22 have been considered but are moot because the arguments do not apply to any of the references being used in the current rejection.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**2. Claim 22 is rejected under 35 U.S.C. 102(e) as being anticipated by US 7,859,514 to Park.**

**Re Claim 22,**

Park discloses a hand held controller for a game console (Abstract, Fig. 1) comprising:

an outer case (Fig. 1, case 30) comprising a front, a back, a top edge, and a bottom edge, wherein the back of the controller is opposite the front of the controller, and the top edge is opposite the bottom edge (Fig. 1 shows the front 21 of the controller 20 having a top edge where buttons 48 are located, and a bottom edge where reference numeral 60 is located. Figs. 5-6 show embodiments of the back of the controller, the

back face 22 being opposite the front face 21 of the controller as shown in the perspective view of Fig. 7, also see 4:11-15)

a front control located on the front of the controller (Fig. 1, plurality of front controls 40)

wherein the controller is shaped to be held in the hand of a user such that the user's thumb is positioned to operate the front control (Park 3:57-64 states that the ergonomic housing 30 is shaped to be held in a user's hands during operating conditions and has controls 40 that are easily manipulated by a user's fingers while still maintaining control of the device. Because claim 1 is an apparatus claim, the claimed recitations of specific fingers of a human being correlated to specific buttons on a device that has the same structure as that of the prior art of Park, fail to be awarded patentable weight. MPEP 2114 I-II states that "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). Choosing which finger(s) to correlate with which buttons of Figs. 1 (front) and 5 (rear) of Park does not distinguish the prior art structure from that of Park.)

and a back control located on the back of the controller, wherein the back control is an elongate member that extends between the top edge and the bottom edge (Fig. 5, elongate buttons 58 on the rear face 22 of the controller are elongate members that extend between the top edge where buttons 54 are located, and the bottom edge where tether 36 is located.)

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**3. Claims 1-2, 4, and 6-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 7,859,514 to Park, in view of US 2004/0224765 to Martinez et al.**

**Re Claim 1,**

Park discloses a hand held controller for a game console (Abstract, Fig. 1) comprising:

an outer case (Fig. 1, case 30) comprising a front, a back, a top edge, and a bottom edge, wherein the back of the controller is opposite the front of the controller, and the top edge is opposite the bottom edge (Fig. 1 shows the front 21 of the controller 20 having a top edge where buttons 48 are located, and a bottom edge where reference numeral 60 is located. Figs. 5-6 show embodiments of the back of the controller, the back face 22 being opposite the front face 21 of the controller as shown in the perspective view of Fig. 7, also see 4:11-15)

a front control located on the front of the controller (Fig. 1, plurality of front controls 40)

wherein the controller is shaped to be held in the hand of a user such that the user's thumb is positioned to operate the front control (Park 3:57-64 states that the



ergonomic housing 30 is shaped to be held in a user's hands during operating conditions and has controls 40 that are easily manipulated by a user's fingers while still maintaining control of the device. Because claim 1 is an apparatus claim, the claimed recitations of specific fingers of a human being correlated to specific buttons on a device that has the same structure as that of the prior art of Park, fail to be awarded patentable weight. MPEP 2114 I-II states that "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). Choosing which finger(s) to correlate with which buttons of Figs. 1 (front) and 5 (rear) of Park does not distinguish the prior art structure from that of Park.)

and a back control located on the back of the controller, wherein the back control is an elongate member that extends between the top edge and the bottom edge (Fig. 5, elongate buttons 58, 59 on the rear face 22 of the controller are elongate members that extend between the top edge where buttons 54 are located, and the bottom edge where tether 36 is located.)

Although Park discloses the same inventive concept substantially as claimed, Park does not go into detail as to what materials are selected for the manufacture of the buttons 58, 59 on the back of the controller.

Martinez is an analogous prior art handheld video game controller reference (See Martinez Figs. 5-6 No. 14) that teaches it was well-known in the art for analogous button keys disposed in the housing of a handheld video game controller to be "molded from

silicone rubber, and form inverted domes which, when pushed downward, close membrane or metal dome switches (not shown) located on printed circuit board 176" (Martinez [0086] and Fig. 19, silicone keys 174 which protrude through housing 172 and contact printed circuit board 176)

It would have been obvious to one having ordinary skill in the art at the time the invention was made that the button keys shown in Fig. 5 of Park, on the rear 22 of controller 20, could have been manufactured in the same way shown in Fig. 19 of Martinez, to result in the elongated buttons 58, 59 of Park being manufactured of inherently resilient silicone rubber, because it is no more than the mere application of a known technique to a piece of prior art ready for improvement." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007) The motivation for one of skill in the art to manufacture the buttons of Park as resilient silicone rubber buttons would be to provide soft-touch buttons that would provide good grip to the fingers of the user, while at the same time being non-fatiguing and comfortable to use during prolonged periods of gaming.

**Re Claims 2, 4,**

Fig. 1 of Park shows that controller 20 has two top edge controls 48 located on the top edge of the controller, and Figs. 5-6 show that there is a plurality of back controls located on the back of the controller 22. Park 3:57-64 states that the ergonomic housing 30 is shaped to be held in a user's hands during operating conditions and has controls 40 that are easily manipulated by a user's fingers while still maintaining control of the device. Because claim 1 is an apparatus claim, the claimed recitations of specific fingers of a human being correlated to specific buttons on a device that has the same

Art Unit: 3717

structure as that of the prior art of Park, fail to be awarded patentable weight. MPEP 2114 I-II states that "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). Choosing which finger(s) to correlate with which buttons of Figs. 1 (front) and 5 (rear) of Park which meets all of the structural limitations of the claim does not distinguish the prior art structure from that of Park.)

**Re Claims 6-7, 20,**

Fig. 19 of the teaching reference of Martinez, as discussed above, teaches that it is known to incorporate resilient, silicone-rubber button keys into a handheld controller where each elongate button member is separate from the outer case of the controller and mounted within a recess in the case of the controller, wherein the elongate button member(s) comprise an outermost surface which is disposed in close proximity to the outermost surface of the controller (See 172 and 174 in Fig. 19 of Martinez, which are to be incorporated into the apparatus of Fig. 5 of Park which also implements elongated button members in recesses in the case 20.)

**Re Claims 8-10,**

These claims recite alternative possible size considerations for the same elongate members 58 or 59 of Park, without claiming any unexpected result of these size considerations, especially in light of the several thickness ranges being presented

in the alternative, which indicates the function of the apparatus is unchanged as these parameters are varied.

Regarding claims 8-10, in *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. See also MPEP 2144.04 Section IV A. Changing the thickness of buttons can also be rejected as a change in shape, See also MPEP Section IV B.

**Re Claim 11,**

Park shows in Fig. 5 that the elongate members 58 on the back 22 of controller 20 are parallel to one another.

**Re Claim 12,**

Park shows in Fig. 5 that a second pair of elongate members on the back of the controller, 59, converges away from one another with respect to the front of the controller. However, Park does not provide a pair of elongate members on the back of the controller that converge towards one another with respect to the front of the controller. MPEP 2144.04 Section IV B states that a change in shape of an apparatus would be obvious to one having ordinary skill in the art absent persuasive evidence that the particular shape is significant. Also, because Park shows that the orientation of the elongate buttons on the rear of the controller can be varied as design choice layout of

the keys dictates, and further because instant claims 11 and 12 present the elongate members being parallel or converging towards one another in the alternative indicating they are interchangeable means of orienting the buttons, one of ordinary skill in the art would have found the exact orientation of the same buttons on the controller housing an obvious matter of design choice, and would have expected the controller of Park in view of Martinez to have functioned equally well with the elongate members parallel to or converging away from one another.

**Re Claims 13-14,**

Fig. 19 of the teaching reference of Martinez, which is used to improve Park by making the back controls 58 of Park out of resilient, silicone-rubber button keys as discussed above, teaches that such silicone-rubber keys when used in a handheld controller are constructed such that each key is in registry with a switch mechanism on the printed circuit board disposed within the controller, such that displacement of the control activates the switch mechanism, wherein the switch mechanism is disposed between the elongate members and an outer surface of the base of the controller (See Fig. 19 of Martinez, where the taught elongate members 174, when pressed, register against a corresponding switch mechanism of PCB 176, where PCB 176 is in between members 174 and the other side of the controller housing 180.)

**Re Claims 15-16,**

Although Park in view of Martinez discloses the same inventive concept substantially as claimed, providing a handheld controller that provides an interface allowing a user to command a peripheral electronic device to perform multiple actions

(Park 3:54-57), and although Park states that the buttons are selectively programmable by a user to satisfy the needs of different types of programs that the user may control with the device (Park 4:1-10), Park in view of Martinez does not go into detail as to whether the user-programmable button mapping can be used such that or more controls replicate the functions of other controls, or whether one or more controls have functions different from other controls on the front or top edge of the controller. Because claims 15 and 16 present duplicating vs. not duplicating button mapping functions as alternatives, and because there is further no claimed specific purpose, problem being solved by, or advantage caused by replicating button mapping or not doing so, it would have been an obvious matter of design choice to one having ordinary skill in the art at the time the invention was made whether to map the preprogrammed button functions for the controller of Park in view of Martinez such that functions are replicated or not. One of skill in the art would have expected Park in view of Martinez' controller to function well regardless of what specific software command mapping is applied by the game designer to the button controls.

**Re Claim 17,**

The one or more elongate members 58, 59 shown on the back 22 of controller 20 in Park Fig. 5, which are depressible by the fingers of the user as stated by Park, are interpreted as paddle levers.

**Re claim 18,**

Park Figs. 1, 5 and 7 show that the back controls including 58 and 59 reside on flat surface 22 which is parallel to front surface 21.

**Re Claim 19,**

The buttons 58, 59 that are some of the back controls in Fig. 5 of Park are constructed such that they form an integral part of the back case 22. The teaching reference of Martinez which is used to teach that these keys may be made of silicone rubber as is known in the art further shows in Fig. 19 that such keys can be distinct components that become integral with the case when they are assembled to protrude through openings in the body, yielding a continuous surface.

**Re Claim 21,**

Figs. 1 and 7 of Park show that the front edge of the controller is substantially perpendicular to the front.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to STEVEN J. HYLINSKI whose telephone number is (571)270-1995. The examiner can normally be reached on Mon-Fri 9am-7pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Melba Bumgarner can be reached on (571)272-4709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/STEVEN J HYLINSKI/  
Primary Examiner, Art Unit 3717



<b>Notice of References Cited</b>	Application/Control No. 13/162,727	Applicant(s)/Patent Under Reexamination BURGESS ET AL.	
	Examiner STEVEN J. HYLINSKI	Art Unit 3717	Page 1 of 2

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*	Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
*	A	US-5,531,443 A	Cruz, Jose L.	463/37
*	B	US-D376,826 S	Ashida, Kenichiro	D14/401
*	C	US-D377,198 S	Oikawa et al.	D14/401
*	D	US-D384,112 S	Riley et al.	D14/401
*	E	US-D393,291 S	Kung, Ching-hu	D14/401
*	F	US-D409,183 S	Chen, William	D14/401
*	G	US-5,984,785 A	Takeda et al.	463/38
*	H	US-6,102,803 A	Takeda et al.	463/38
*	I	US-D431,604 S	Chan, Wah Leung	D21/329
*	J	US-6,186,896 B1	Takeda et al.	463/38
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*	M	US-D464,349 S	Loughnane et al.	D14/401

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<b>Notice of References Cited</b>	Application/Control No. 13/162,727	Applicant(s)/Patent Under Reexamination BURGESS ET AL.	
	Examiner STEVEN J. HYLINSKI	Art Unit 3717	Page 2 of 2

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*	B	US-7,794,326 B2	09-2010	Wu et al.	463/37
	C	US-			
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Receipt date: 10/29/2012

13162727 - GAI: 3717

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	Filing Date		2011-06-17	
	First Named Inventor	Simon Burgess		
	Art Unit	3717		
	Examiner Name	Hylinski, Steven J.		
	Attorney Docket Number	0905-002		

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<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b> ( Not for submission under 37 CFR 1.99)	Application Number		13162727	13162727 - GAU: 3717
	Filing Date		2011-06-17	
	First Named Inventor	Simon Burgess		
	Art Unit	3717		
	Examiner Name	Hylinski, Steven J.		
	Attorney Docket Number	0905-002		

	1	<a href="http://benchmarkreviews.com/index.php?option=com_content&amp;task=view&amp;id=235&amp;Itemid=65&amp;limit=1&amp;limitstart=2">http://benchmarkreviews.com/index.php?option=com_content&amp;task=view&amp;id=235&amp;Itemid=65&amp;limit=1&amp;limitstart=2</a> Benchmarkreviews.com - Thurstrmaster Run-N-Drive PC/PS3 Wireless Gampad - Written by Oline Coles, April 8, 2009.	<input type="checkbox"/>
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Examiner Signature	/Steven Hylinski/	Date Considered	01/30/2013
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<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b> ( Not for submission under 37 CFR 1.99)	Application Number	13162727	13162727 - GAU: 3717
	Filing Date	2011-06-17	
	First Named Inventor	Simon Burgess	
	Art Unit	3717	
	Examiner Name	Hylinski, Steven J.	
	Attorney Docket Number	0905-002	

**CERTIFICATION STATEMENT**

Please see 37 CFR 1.97 and 1.98 to make the appropriate selection(s):

That each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement. See 37 CFR 1.97(e)(1).

**OR**

That no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing the certification after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in 37 CFR 1.56(c) more than three months prior to the filing of the information disclosure statement. See 37 CFR 1.97(e)(2).

- See attached certification statement.
- The fee set forth in 37 CFR 1.17 (p) has been submitted herewith.
- A certification statement is not submitted herewith.

**SIGNATURE**

A signature of the applicant or representative is required in accordance with CFR 1.33, 10.18. Please see CFR 1.4(d) for the form of the signature.

Signature	/Stephen Terrell/	Date (YYYY-MM-DD)	2012-10-29
Name/Print	Stephen Terrell	Registration Number	62,734

This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. **DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH. /S.H./

<b><i>Index of Claims</i></b> 	<b>Application/Control No.</b> 13162727	<b>Applicant(s)/Patent Under Reexamination</b> BURGESS ET AL.
	<b>Examiner</b> STEVEN J HYLINSKI	<b>Art Unit</b> 3717

✓	<b>Rejected</b>	-	<b>Cancelled</b>	N	<b>Non-Elected</b>	A	<b>Appeal</b>
=	<b>Allowed</b>	÷	<b>Restricted</b>	I	<b>Interference</b>	O	<b>Objected</b>

Claims renumbered in the same order as presented by applicant
  CPA
  T.D.
  R.1.47

CLAIM		DATE							
Final	Original	06/16/2012	01/30/2013						
	1	✓	✓						
	2	✓	✓						
	3	✓	-						
	4	✓	✓						
	5	✓	-						
	6	✓	✓						
	7	✓	✓						
	8	✓	✓						
	9	✓	✓						
	10	✓	✓						
	11	✓	✓						
	12	✓	✓						
	13	✓	✓						
	14	✓	✓						
	15	✓	✓						
	16	✓	✓						
	17	✓	✓						
	18	✓	✓						
	19	✓	✓						
	20	✓	✓						
	21		✓						
	22		✓						

## EAST Search History

## EAST Search History (Prior Art)

Ref #	Hits	Search Query	DBs	Default Operator	Plurals	Time Stamp
S52	1	"6394906".pn.	US-PGPUB; USPAT	OR	OFF	2013/01/16 19:36
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S58	1	S56 and (rubber or flexible or soft or urethane)	US-PGPUB; USPAT; USOCR	OR	OFF	2013/01/17 13:04
S57	0	S56 and (rubber or flexible)	US-PGPUB; USPAT; USOCR	OR	OFF	2013/01/17 13:04
S60	39	S59 and (button\$1 near5 (resilient or rubber))	US-PGPUB; USPAT; USOCR	OR	OFF	2013/01/17 13:11
S61	19	S59 and (key\$1 near5 (resilient or rubber))	US-PGPUB; USPAT; USOCR	OR	OFF	2013/01/17 14:15
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S62	6	("5874906" "5984548" "6288709" "6730013" "7794326" "6760013").pn.	US-PGPUB; USPAT;	OR	OFF	2013/01/17 14:52



			USOCR			
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S64	515	S59 and (video with game with controller)	US-PGPUB; USPAT; USOCR	OR	OFF	2013/01/17 15:03
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## EAST Search History

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S77	1	"20040224765".pn.	US- PGPUB; USPAT	OR	ON	2013/01/30 13:07
S78	1	"5984785".pn.	US- PGPUB; USPAT	OR	ON	2013/01/30 13:09
S79	6	("5874906" "5984548" "6288909" "6760013" "7794326" "7859514").pn.	US- PGPUB; USPAT	OR	ON	2013/01/30 13:11
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EAST Search History


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		"D623649"	"D659140").PN.					
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**EAST Search History (Interference)**

< This search history is empty >

**1/ 30/ 2013 7:34:55 PM**

**C:\ Users\ shyliniski\ Documents\ EAST\ Workspaces\ 13162727.wsp**

<b>Search Notes</b>  	<b>Application/Control No.</b>  13162727	<b>Applicant(s)/Patent Under Reexamination</b>  BURGESS ET AL.
	<b>Examiner</b>  STEVEN J HYLINSKI	<b>Art Unit</b>  3717

CPC- SEARCHED		
Symbol	Date	Examiner

CPC COMBINATION SETS - SEARCHED		
Symbol	Date	Examiner

US CLASSIFICATION SEARCHED			
Class	Subclass	Date	Examiner
463	37	06/16/2012	SJH
463	37	01/17/2013	SJH

SEARCH NOTES		
Search Notes	Date	Examiner
See EAST search history.	06/16/2012	SJH
Updated East search , see search history.	01/30/2013	SJH

INTERFERENCE SEARCH			
US Class/ CPC Symbol	US Subclass / CPC Group	Date	Examiner

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**CERTIFICATE OF ELECTRONIC TRANSMISSION**

I hereby certify that this paper (and any other paper referred to as being attached or enclosed) is being transmitted electronically to the U.S. Patent and Trademark Office via the Electronic Filing System (EFS) on the date set forth below.

5/6/2013  
Transmission Date

  
Sheri Prine

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Inventor(s): Simon Burgess et al.      Conf. No.: 8138  
App No.: 13/162,727      Filing Date: June 17, 2011  
Art Unit: 3717      Examiner: Hylinski, Steven J.  
Title: CONTROLLER FOR VIDEO GAME CONSOLE

Docket No.: 0905-002

Mail Stop: AMENDMENT  
Commissioner for Patents  
U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

**RESPONSE TO FINAL OFFICE ACTION UNDER 37 C.F.R. § 1.116**

This Response is filed in reply to the non-final Office Action mailed February 4, 2012. The Assignee requests consideration of the following amendments and remarks.

Amendments to the Claims begin on page 2.

Remarks begin on page 6.

### CLAIM LISTING

The following set of claims replaces all previous versions of the claims.

1. (Currently Amended) A hand held controller for a game console comprising:
  - an outer case comprising a front, a back, a top edge, and a bottom edge, wherein the back of the controller is opposite the front of the controller and the top edge is opposite the bottom edge; and
  - a front control located on the front of the controller;
  - wherein the controller is shaped to be held in the hand of a user such that the user's thumb is positioned to operate the front control; and
  - a first back control and a second back control, each back control being located on the back of the controller~~[[,]]-wherein the back control is~~ and each back control including an elongate member that extends substantially the full distance between the top edge and the bottom edge and is inherently resilient and flexible.
  
2. (Previously Presented) The controller of claim 1, further having a top edge control located on the top edge of the controller and wherein the controller is shaped such that the user's index finger is positioned to operate the top edge control.
  
3. (Canceled)
  
4. (Currently Amended) The controller of claim 1, ~~wherein there are two back controls on the back of the controller,~~ wherein each of which the back controls is positioned to be operated by a middle finger of a user.
  
5. (Canceled)

6. (Currently Amended) The controller of claim 1, wherein [[the]] each elongate member is mounted within a recess located in the case of the controller.
7. (Currently Amended) The controller of claim 6, wherein [[the]] each elongate member comprises an outermost surface which is disposed in close proximity to the outermost surface of the controller such that a user's finger may be received in said respective recess.
8. (Currently Amended) The controller of claim 1, wherein [[the]] each elongate member has a thickness between about 1mm and 10mm.
9. (Currently Amended) The controller of claim 1, wherein [[the]] each elongate member has a thickness between about 1mm and 5mm.
10. (Currently Amended) The controller of claim 1, wherein [[the]] each elongate member has a thickness between about 1mm and 3mm.
11. (Currently Amended) The controller of claim 1 [[4]], wherein the elongate members are parallel to one another.
12. (Currently Amended) The controller of claim 1 [[4]], wherein the elongate members converge towards the front end of the controller with respect to one another.
13. (Currently Amended) The controller of claim 1, wherein a portion of at least one of the first back control and the second back control is in registry with a switch mechanism disposed within the controller, such that displacement of the at least one back control activates the switch mechanism.

14. (Currently Amended) The controller of claim 1 ~~[[4]]~~, wherein a switch mechanism is disposed between each of the elongate members and an outer surface of the base of the controller.
15. (Currently Amended) The controller of claim 2, wherein at least one of the back controls replicates the function of one or more of the top edge control and the front control.
16. (Currently Amended) The controller of claim 2, wherein at least one of the back controls has functions in addition to the top edge control and the front control.
17. (Currently Amended) The controller of claim 1, wherein at least one of the back controls is a paddle lever.
18. (Currently Amended) The controller of claim 1, wherein at least one of the back controls is substantially parallel to the front of the controller.
19. (Currently Amended) The controller of claim 1, wherein at least one of the back controls is formed as an integral part of the outer case.
20. (Currently Amended) The controller of claim 1, wherein at least one of the back controls is formed separate from the outer case of the controller.
21. (Previously Presented) The controller of claim 2, wherein the top edge is substantially perpendicular to the front.



22. (Currently Amended) A hand held controller for a game console comprising:

an outer case comprising a front, a back, a top edge, and a bottom edge, wherein the back of the controller is opposite the front of the controller and the top edge is opposite the bottom edge;

a front control located on the front of the controller, wherein the controller is shaped to be held in the hand of a user such that the user's thumb is positioned to operate the front control; and

a first back control and a second back control, each back control being located on the back of the controller[[,]] wherein the back control is and each back control including an elongate member that extends substantially the full distance between the top edge and the bottom edge.

\* \* \*

**REMARKS**

SUMMARY OF THE CLAIMS

The application has been carefully reviewed in light of the Office Action dated February 4, 2013. This communication is believed to be a complete response to that Office Action. Claims 1, 2, 4 and 6-22 were pending in the present application prior to entry of the present amendments. By the present Office Action, claims 1, 2, 4, 6-22 have been rejected.

By the present amendment, claims 1, 4, 6-20 and 22 have been amended. Support for these amendments can be found in the original specification, and thus, no new matter has been added. Applicant reserves the right to pursue all original claims in this or other patent applications. Reconsideration and reexamination of the present application is respectfully requested in light of the foregoing amendments and in view of the following remarks, which establish that the pending claims are directed to allowable subject matter.

Because the present amendments (1) do not raise new issues requiring further consideration or search, (2) do not introduce new matter, (3) materially reduce the issues for appeal, and (4) place this application into better condition for allowance, entry is appropriate under 37 C.F.R. § 1.116, and is respectfully requested.

SECTION 102 REJECTIONS

Claim 22 is rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Pat. No. 7,859,514 (Park). Claim 22 has been amended and the rejection thereto is considered moot.

SECTION 103 REJECTIONS

Claims 1-2, 4, and 6-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Park, in view of U.S. Pat. Pub. 2004/0224765 (Martinez et al.).

Claim 1 has been amended and the rejections thereto are considered moot. Claims 2, 4, and 6-21 depend from amended claim 1 and thus the rejections thereto are also considered moot.

FEES

Applicant believes no fees are due with the filing of this communication. The Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 50-3447.

CONCLUSION

It is respectfully submitted that the application is in condition for allowance, and notice to that effect is respectfully requested. If Examiner Hylinski has any new concerns, the Examiner is respectfully urged to contact the undersigned representative at her earliest convenience in order to efficiently advance prosecution of this application.

Respectfully Submitted,

PARKS IP LAW LLC

by /Stephen Terrell/

Stephen Terrell; Reg. No. 62,734  
Agent for the Assignee

Parks IP Law  
Attention: Patent Docketing  
730 Peachtree Street N.E.  
Suite 600  
Atlanta, Georgia 30308  
(678) 365-4426  
sterrell@parksiplaw.com

## Electronic Acknowledgement Receipt

<b>EFS ID:</b>	15700960
<b>Application Number:</b>	13162727
<b>International Application Number:</b>	
<b>Confirmation Number:</b>	8138
<b>Title of Invention:</b>	CONTROLLER FOR VIDEO GAME CONSOLE
<b>First Named Inventor/Applicant Name:</b>	Simon Burgess
<b>Customer Number:</b>	52245
<b>Filer:</b>	Mickki D. Murray/Sher Prine
<b>Filer Authorized By:</b>	Mickki D. Murray
<b>Attorney Docket Number:</b>	0905-002
<b>Receipt Date:</b>	06-MAY-2013
<b>Filing Date:</b>	17-JUN-2011
<b>Time Stamp:</b>	15:59:22
<b>Application Type:</b>	Utility under 35 USC 111(a)

### Payment information:

Submitted with Payment	no
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### File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1		Response0905002.pdf	278225 <small>3d14778cc0795dac24c8182ed60e6b466a9cc169</small>	yes	7

<b>Multipart Description/PDF files in .zip description</b>		
<b>Document Description</b>	<b>Start</b>	<b>End</b>
Amendment After Final	1	1
Amendment Copy Claims/Response to Suggested Claims	2	5
Applicant Arguments/Remarks Made in an Amendment	6	7

**Warnings:**

**Information:**

<b>Total Files Size (in bytes):</b>	278225
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This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

**New Applications Under 35 U.S.C. 111**

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

**National Stage of an International Application under 35 U.S.C. 371**

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

**New International Application Filed with the USPTO as a Receiving Office**

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<b>PATENT APPLICATION FEE DETERMINATION RECORD</b> Substitute for Form PTO-875	Application or Docket Number <b>13/162,727</b>	Filing Date <b>06/17/2011</b>	<input type="checkbox"/> To be Mailed
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ENTITY:  LARGE  SMALL  MICRO

**APPLICATION AS FILED – PART I**

FOR	NUMBER FILED	NUMBER EXTRA	RATE (\$)	FEE (\$)
<input type="checkbox"/> BASIC FEE (37 CFR 1.16(a), (b), or (c))	N/A	N/A	N/A	
<input type="checkbox"/> SEARCH FEE (37 CFR 1.16(k), (l), or (m))	N/A	N/A	N/A	
<input type="checkbox"/> EXAMINATION FEE (37 CFR 1.16(o), (p), or (q))	N/A	N/A	N/A	
TOTAL CLAIMS (37 CFR 1.16(i))	minus 20 =	*	X \$ =	
INDEPENDENT CLAIMS (37 CFR 1.16(h))	minus 3 =	*	X \$ =	
<input type="checkbox"/> APPLICATION SIZE FEE (37 CFR 1.16(s))	If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$310 (\$155 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).			
<input type="checkbox"/> MULTIPLE DEPENDENT CLAIM PRESENT (37 CFR 1.16(j))				
* If the difference in column 1 is less than zero, enter "0" in column 2.			TOTAL	

**APPLICATION AS AMENDED – PART II**

AMENDMENT	(Column 1)	(Column 2)	(Column 3)	PRESENT EXTRA	RATE (\$)	ADDITIONAL FEE (\$)
	<b>05/06/2013</b>	CLAIMS REMAINING AFTER AMENDMENT	HIGHEST NUMBER PREVIOUSLY PAID FOR			
	Total (37 CFR 1.16(i))	* 20	Minus ** 20	= 0	X \$40 =	0
	Independent (37 CFR 1.16(h))	* 2	Minus *** 3	= 0	X \$210 =	0
	<input type="checkbox"/> Application Size Fee (37 CFR 1.16(s))					
	<input type="checkbox"/> FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(j))					
					TOTAL ADD'L FEE	<b>0</b>

AMENDMENT	(Column 1)	(Column 2)	(Column 3)	PRESENT EXTRA	RATE (\$)	ADDITIONAL FEE (\$)
		CLAIMS REMAINING AFTER AMENDMENT	HIGHEST NUMBER PREVIOUSLY PAID FOR			
	Total (37 CFR 1.16(i))	*	Minus **	=	X \$ =	
	Independent (37 CFR 1.16(h))	*	Minus ***	=	X \$ =	
	<input type="checkbox"/> Application Size Fee (37 CFR 1.16(s))					
	<input type="checkbox"/> FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(j))					
					TOTAL ADD'L FEE	

\* If the entry in column 1 is less than the entry in column 2, write "0" in column 3.  
 \*\* If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20, enter "20".  
 \*\*\* If the "Highest Number Previously Paid For" IN THIS SPACE is less than 3, enter "3".  
 The "Highest Number Previously Paid For" (Total or Independent) is the highest number found in the appropriate box in column 1.

LIE  
/BURNELL ROSS/

This collection of information is required by 37 CFR 1.16. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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13/162,727	06/17/2011	Simon Burgess	0905-002	8138
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52245 7590 05/15/2013  
Parks IP Law LLC  
730 Peachtree Street, NE  
Suite 600  
ATLANTA, GA 30308

EXAMINER
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HYLINSKI, STEVEN J

ART UNIT	PAPER NUMBER
----------	--------------

3717

MAIL DATE	DELIVERY MODE
-----------	---------------

05/15/2013

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Applicant-Initiated Interview Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	13/162,727	BURGESS ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	STEVEN J. HYLINSKI	3717	

All participants (applicant, applicant's representative, PTO personnel):

(1) STEVEN J. HYLINSKI. (3) \_\_\_\_\_.

(2) Stephen Terrell. (4) \_\_\_\_\_.

Date of Interview: 04/25/2013.

Type:  Telephonic  Video Conference  
 Personal [copy given to:  applicant  applicant's representative]

Exhibit shown or demonstration conducted:  Yes  No.  
If Yes, brief description: \_\_\_\_\_.

Issues Discussed 101 112 102 103 Others  
(For each of the checked box(es) above, please describe below the issue and detailed description of the discussion)

Claim(s) discussed: 1.

Identification of prior art discussed: 7,859,514 Park, "Review: Scuf Xbox 360 Game Controller" by Dave Burns.

**Substance of Interview**  
(For each issue discussed, provide a detailed description and indicate if agreement was reached. Some topics may include: identification or clarification of a reference or a portion thereof, claim interpretation, proposed amendments, arguments of any applied references etc...)

Applicant's representative proposed amended claim limitations for possible entry after final. Examiner conducted a brief updated search for the purpose of discussion of the proposed amendmnets, and located <http://web.archive.org/web/20101022215104/http://www.xboxer360.com/features/review-scuf-xbox-360-controller/> "Review: Scuf Xbox 360 Controller" dated October 20, 2010, by Dave Burns. This NPL reference describes the same product Applicant is seeking patent protection for, with a 35 USC 102(e) priority date. Examiner indicated that this reference appears to anticipate the current and proposed claims, and that if Applicant wishes to further prosecution of the same invention Applicant may wish to consider filing an affidavit with an RCE, to attempt to swear behind the Dave Burns reference if Applicant has sufficient proof that Applicant had possession of this invention before the October 20, 2010 published date..

**Applicant recordation instructions:** The formal written reply to the last Office action must include the substance of the interview. (See MPEP section 713.04). If a reply to the last Office action has already been filed, applicant is given a non-extendable period of the longer of one month or thirty days from this interview date, or the mailing date of this interview summary form, whichever is later, to file a statement of the substance of the interview

**Examiner recordation instructions:** Examiners must summarize the substance of any interview of record. A complete and proper recordation of the substance of an interview should include the items listed in MPEP 713.04 for complete and proper recordation including the identification of the general thrust of each argument or issue discussed, a general indication of any other pertinent matters discussed regarding patentability and the general results or outcome of the interview, to include an indication as to whether or not agreement was reached on the issues raised.

Attachment

/STEVEN J HYLINSKI/  
Primary Examiner, Art Unit 3717



## Summary of Record of Interview Requirements

### Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

### Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews

Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,  
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

### Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

<b>Advisory Action Before the Filing of an Appeal Brief</b>	<b>Application No.</b> 13/162,727	<b>Applicant(s)</b> BURGESS ET AL.
	<b>Examiner</b> STEVEN J. HYLINSKI	<b>Art Unit</b> 3717

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 06 May 2013 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.  
NO NOTICE OF APPEAL FILED

1.  The reply was filed after a final rejection. No Notice of Appeal has been filed. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114 if this is a utility or plant application. Note that RCEs are not permitted in design applications. The reply must be filed within one of the following time periods:
- a)  The period for reply expires 3 months from the mailing date of the final rejection.
- b)  The period for reply expires on: (1) the mailing date of this Advisory Action; or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- c)  A prior Advisory Action was mailed more than 3 months after the mailing date of the final rejection in response to a first after-final reply filed within 2 months of the mailing date of the final rejection. The current period for reply expires \_\_\_\_\_ months from the mailing date of the prior *Advisory Action* or SIX MONTHS from the mailing date of the final rejection, whichever is earlier.
- Examiner Note:* If box 1 is checked, check either box (a), (b) or (c). ONLY CHECK BOX (b) WHEN THIS ADVISORY ACTION IS THE FIRST RESPONSE TO APPLICANT'S FIRST AFTER-FINAL REPLY WHICH WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. ONLY CHECK BOX (c) IN THE LIMITED SITUATION SET FORTH UNDER BOX (c). See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) or (c) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2.  The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3.  The proposed amendments filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- a)  They raise new issues that would require further consideration and/or search (see NOTE below);
- b)  They raise the issue of new matter (see NOTE below);
- c)  They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- d)  They present additional claims without canceling a corresponding number of finally rejected claims.
- NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4.  The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5.  Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
6.  Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7.  For purposes of appeal, the proposed amendment(s): (a)  will not be entered, or (b)  will be entered, and an explanation of how the new or amended claims would be rejected is provided below or appended.

AFFIDAVIT OR OTHER EVIDENCE

8.  The affidavit or other evidence filed after final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9.  The affidavit or other evidence filed after the date of filing the Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10.  The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11.  The request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
12.  Note the attached Information *Disclosure Statement(s)*. (PTO/SB/08) Paper No(s). \_\_\_\_\_
13.  Other: Note the attached Interview Summary Paper No. 20130507.

STATUS OF CLAIMS

14. The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: \_\_\_\_\_
- Claim(s) objected to: \_\_\_\_\_
- Claim(s) rejected: 1,2,4,6-22.
- Claim(s) withdrawn from consideration: \_\_\_\_\_

/STEVEN J HYLINSKI/  
Primary Examiner, Art Unit 3717

In response to the interview conducted on April 25 with Stephen Terrell during which proposed amendments were discussed, Examiner conducted an updated search and located online NPL reference "Review: Scuf Xbox 360 Controller" by Dave Burns, dated October 20, 2010, source <http://web.archive.org/web/20101022215104/http://www.xboxer360.com/features/review-scuf-xbox-360-controller/> This NPL reference is a review of the same product Applicant is seeking patent protection for, and shows and describes in detail the first and second back controls, each back control including an elongate member that extends substantially the full distance between the top and bottom edge, in addition to all of the other current and proposed claim limitations. Because the application is not placed into condition for allowance by the After Final amendments, the proposed amendments will not be entered, and further consideration is required.

PATENT

**CERTIFICATE OF ELECTRONIC TRANSMISSION**

I hereby certify that this paper (and any other paper referred to as being attached or enclosed) is being transmitted electronically to the U.S. Patent and Trademark Office via the Electronic Filing System (EFS) on the date set forth below.

5/16/2013  
Transmission Date

  
Sheri Prine

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Inventor(s): Simon Burgess et al.      Conf. No.: 8138  
App No.: 13/162,727      Filing Date: June 17, 2011  
Art Unit: 3717      Examiner: Hylinski, Steven J.  
Title: CONTROLLER FOR VIDEO GAME CONSOLE

Docket No.: 0905-002

Mail Stop: AMENDMENT  
Commissioner for Patents  
U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

**RESPONSE TO FINAL OFFICE ACTION UNDER 37 C.F.R. § 1.116**

This Response is filed in reply to the non-final Office Action mailed February 4, 2012. The Assignee requests consideration of the following amendments and remarks.

Amendments to the Claims begin on page 2.

Remarks begin on page 6.

Doc code: RCEX

Doc description: Request for Continued Examination (RCE)

PTO/SB/30EFS (07-09)

Approved for use through 07/31/2012. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

### REQUEST FOR CONTINUED EXAMINATION(RCE)TRANSMITTAL (Submitted Only via EFS-Web)

Application Number	13162727	Filing Date	2011-06-17	Docket Number (if applicable)	0905-002	Art Unit	3717
First Named Inventor	Simon Burgess			Examiner Name	Steven J. Hylinski		

**This is a Request for Continued Examination (RCE) under 37 CFR 1.114 of the above-identified application.**  
 Request for Continued Examination (RCE) practice under 37 CFR 1.114 does not apply to any utility or plant application filed prior to June 8, 1995, or to any design application. The Instruction Sheet for this form is located at WWW.USPTO.GOV

#### SUBMISSION REQUIRED UNDER 37 CFR 1.114

Note: If the RCE is proper, any previously filed unentered amendments and amendments enclosed with the RCE will be entered in the order in which they were filed unless applicant instructs otherwise. If applicant does not wish to have any previously filed unentered amendment(s) entered, applicant must request non-entry of such amendment(s).

Previously submitted. If a final Office action is outstanding, any amendments filed after the final Office action may be considered as a submission even if this box is not checked.

Consider the arguments in the Appeal Brief or Reply Brief previously filed on \_\_\_\_\_

Other \_\_\_\_\_

Enclosed

Amendment/Reply

Information Disclosure Statement (IDS)

Affidavit(s)/ Declaration(s)

Other \_\_\_\_\_

#### MISCELLANEOUS

Suspension of action on the above-identified application is requested under 37 CFR 1.103(c) for a period of months \_\_\_\_\_  
 (Period of suspension shall not exceed 3 months; Fee under 37 CFR 1.17(i) required)

Other \_\_\_\_\_

#### FEES

**The RCE fee under 37 CFR 1.17(e) is required by 37 CFR 1.114 when the RCE is filed.**

The Director is hereby authorized to charge any underpayment of fees, or credit any overpayments, to  
 Deposit Account No 503447

#### SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED

Patent Practitioner Signature

Applicant Signature

Doc code: RCEX

Doc description: Request for Continued Examination (RCE)

PTO/SB/30EFS (07-09)

Approved for use through 07/31/2012. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Signature of Registered U.S. Patent Practitioner			
Signature	/Stephen J. Terrell/	Date (YYYY-MM-DD)	2013-08-05
Name	Stephen J. Terrell	Registration Number	62734

This collection of information is required by 37 CFR 1.114. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450.

*If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.*

## Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these records.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b> ( Not for submission under 37 CFR 1.99)	Application Number		13162727	
	Filing Date		2011-06-17	
	First Named Inventor	Simon Burgess		
	Art Unit	3717		
	Examiner Name	Steven J. Hylinski		
	Attorney Docket Number	0905-002		

U.S. PATENTS							Remove
Examiner Initial*	Cite No	Patent Number	Kind Code <sup>1</sup>	Issue Date	Name of Patentee or Applicant of cited Document	Pages, Columns, Lines where Relevant Passages or Relevant Figures Appear	
	1						

If you wish to add additional U.S. Patent citation information please click the Add button. Add

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Examiner Initial*	Cite No	Publication Number	Kind Code <sup>1</sup>	Publication Date	Name of Patentee or Applicant of cited Document	Pages, Columns, Lines where Relevant Passages or Relevant Figures Appear	
	1						

If you wish to add additional U.S. Published Application citation information please click the Add button. Add

FOREIGN PATENT DOCUMENTS								Remove
Examiner Initial*	Cite No	Foreign Document Number <sup>3</sup>	Country Code <sup>2</sup> j	Kind Code <sup>4</sup>	Publication Date	Name of Patentee or Applicant of cited Document	Pages, Columns, Lines where Relevant Passages or Relevant Figures Appear	T <sup>5</sup>
	1	2481633	UK		2012-04-01	Burgess, Simon David		<input type="checkbox"/>

If you wish to add additional Foreign Patent Document citation information please click the Add button. Add

NON-PATENT LITERATURE DOCUMENTS			Remove
Examiner Initials*	Cite No	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc), date, pages(s), volume-issue number(s), publisher, city and/or country where published.	T <sup>5</sup>



<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b> ( Not for submission under 37 CFR 1.99)	Application Number	13162727
	Filing Date	2011-06-17
	First Named Inventor	Simon Burgess
	Art Unit	3717
	Examiner Name	Steven J. Hylinski
	Attorney Docket Number	0905-002

	1		<input type="checkbox"/>
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If you wish to add additional non-patent literature document citation information please click the Add button **Add**

**EXAMINER SIGNATURE**

Examiner Signature		Date Considered	
--------------------	--	-----------------	--

\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through a citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

<sup>1</sup> See Kind Codes of USPTO Patent Documents at [www.USPTO.GOV](http://www.USPTO.GOV) or MPEP 901.04. <sup>2</sup> Enter office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>3</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>4</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. <sup>5</sup> Applicant is to place a check mark here if English language translation is attached.

<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b> ( Not for submission under 37 CFR 1.99)	Application Number	13162727
	Filing Date	2011-06-17
	First Named Inventor	Simon Burgess
	Art Unit	3717
	Examiner Name	Steven J. Hylinski
	Attorney Docket Number	0905-002

**CERTIFICATION STATEMENT**

Please see 37 CFR 1.97 and 1.98 to make the appropriate selection(s):

That each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement. See 37 CFR 1.97(e)(1).

**OR**

That no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing the certification after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in 37 CFR 1.56(c) more than three months prior to the filing of the information disclosure statement. See 37 CFR 1.97(e)(2).

- See attached certification statement.
- The fee set forth in 37 CFR 1.17 (p) has been submitted herewith.
- A certification statement is not submitted herewith.

**SIGNATURE**

A signature of the applicant or representative is required in accordance with CFR 1.33, 10.18. Please see CFR 1.4(d) for the form of the signature.

Signature	/Stephen J. Terrell/	Date (YYYY-MM-DD)	2013-08-05
Name/Print	Stephen J. Terrell	Registration Number	62734

This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. **DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

<p>(21) Application No: <b>1011078.1</b></p> <p>(22) Date of Filing: <b>01.07.2010</b></p> <hr/> <p>(71) Applicant(s):  <b>Simon David Burgess</b>  <b>39 Jubilee Avenue, Sileby, LOUGHBOROUGH,</b>  <b>Leicestershire, LE12 7TH, United Kingdom</b></p> <p>(72) Inventor(s):  <b>Simon David Burgess</b></p> <p>(74) Agent and/or Address for Service:  <b>Serjeants</b>  <b>25 The Crescent, King Street, LEICESTER, LE1 6RX,</b>  <b>United Kingdom</b></p>	<p>(51) INT CL:  <b>A63F 13/02 (2006.01)</b></p> <p>(56) Documents Cited:  <b>WO 2008/131249 A1</b>  <b>Modified Xbox 360 controller discussed in 'Rapid Fire Mod For Wireless Xbox 360 Controller, Step by step tutorial with pictures' forum on xbox-scene.com.</b>  <b>'FireStorm Dual Power' gamepad by 'Thrustmaster'. Available around 2002.</b>  <b>'Run 'N' Drive' wireless gamepad by 'Thrustmaster'. Available since March 2007.</b></p> <p>(58) Field of Search:          Other: <b>Internet keyword search.</b></p>
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(54) Title of the Invention: **Controller for games console**  
 Abstract Title: **Games console controller with buttons on underside**

(57) A hand held gamepad or controller 10 for a games console (not shown) includes controls 2, 3, 4, 5 provided on a top surface for operation by the thumbs of a user, and controls 6, 7, 8, 9 provided on a front, shoulder or bumper surface for operation by the index fingers of the user. The back surface or underside of the gamepad includes additional controls 11 for operation by the middle fingers of the user (see fig. 3). The additional controls 11 are preferably paddle levers, and are preferably provided on a portion of the gamepad which is perpendicular to the plane of the top surface. The additional controls 11 may replicate the functions of one or more of the controls 2-9 located on the top or bumper surfaces, or may provide functionality in addition to those controls.

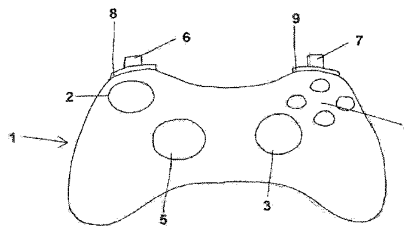


Figure 1

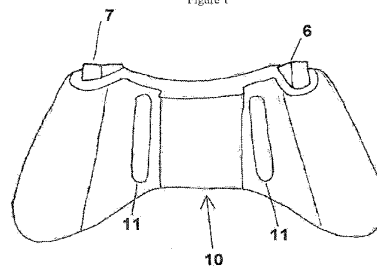


Figure 2

GB 2481633 A

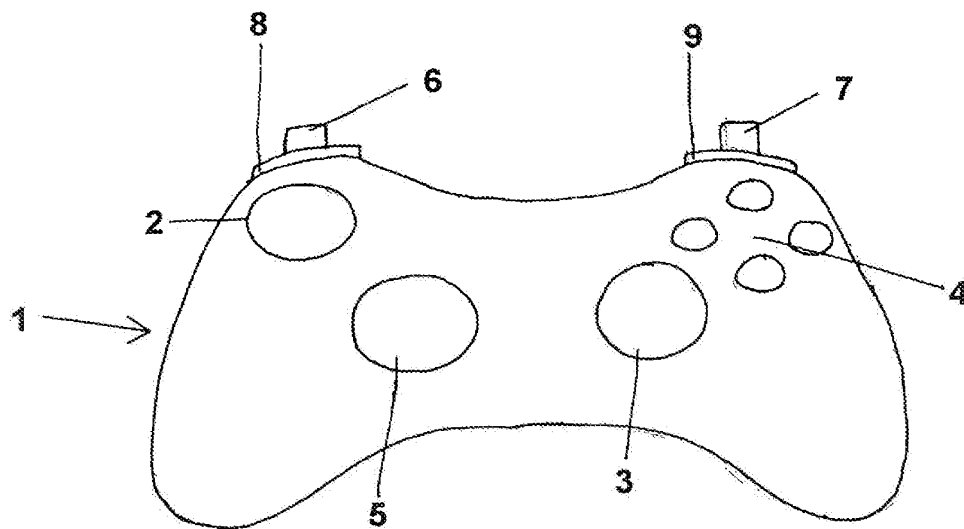


Figure 1

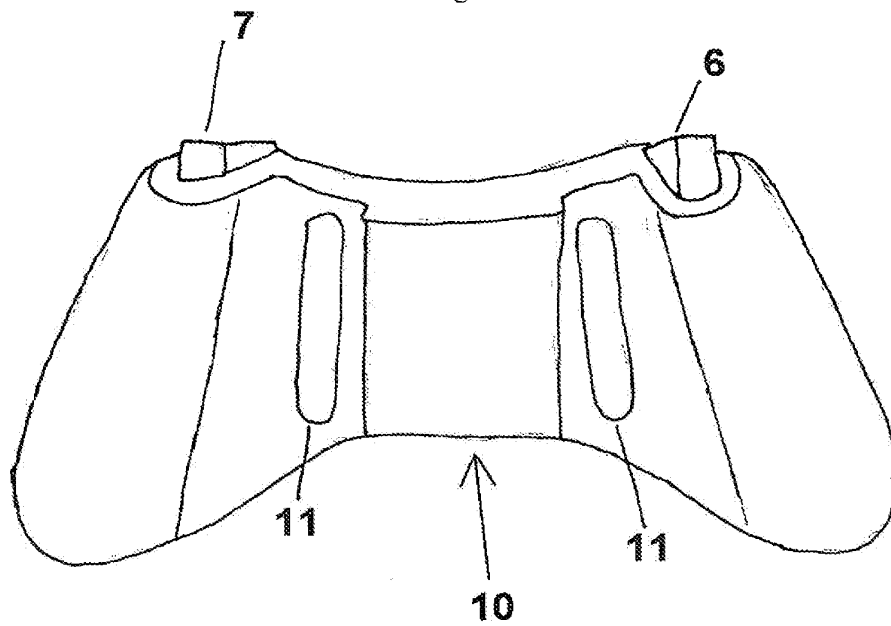


Figure 2

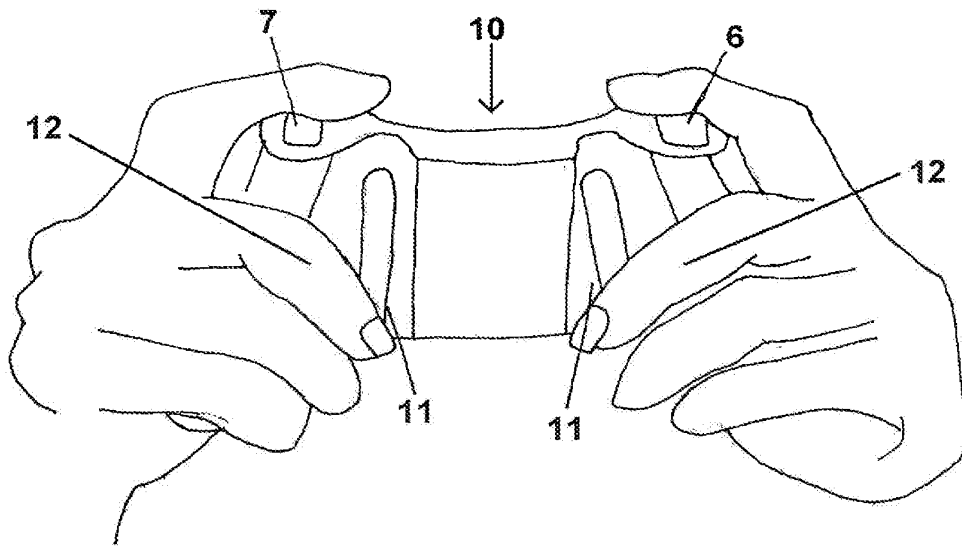


Figure 3

TITLE

Controller for Games Console

DESCRIPTION

5 Field of Invention

The present invention relates to games consoles, in particular to hand held controllers for games consoles.

Background

10 Controllers for most current games consoles are generally intended to be held and operated by the user using both hands. A conventional controller will generally comprise a hard outer case with a plurality of controls mounted about the controller. Typically the controls include buttons, analogue control sticks, bumpers and triggers. An example of a conventional controller is shown in Figure 1.

15

As can be seen in Figure 1, all of the controls are mounted on the front and top of the controller 1. Specifically, there are left and right analogue thumb sticks 2, 3 which normally control movement and are intended to be operated by the user's left and right thumb respectively. There are four buttons 4, located on a front-right portion of the controller 1 which normally control additional actions and are intended to be  
20 operated by the user's right thumb. There is a direction pad 5 located on the lower portion of the front-left of the controller 1. The direction pad 5 is intended to be operated by the user's left thumb, typically either as an alternative to the left thumb stick 2 or to provide additional actions. There are a left trigger 6, a right trigger 7, a  
25 left bumper 8 and a right bumper 9 located on the front edge of the controller 1. The left and right triggers 6, 7 are typically operated by a user's index fingers. The left and right bumpers 8, 9 may also be operated by a user's index fingers.

The only way to operate the four buttons 4 is for a user to remove their right thumb  
30 from the right thumb stick 3. This takes time and, in some games, can cause the loss of control. This is a particular problem in games where the right thumb stick 3 is used for aiming. A similar problem may arise in games where the direction pad 5 provides

additional actions and the user has to remove their thumb from the left thumb stick 2 in order to operate the direction pad 5.

5 In light of the above, there is a need for an improved controller which removes the need for a user to remove their thumb from the left or right thumb stick 2, 3 in order to operate additional actions controlled by the four buttons 4 and/or the direction pad 5.

#### Summary of Invention

10 The present invention provides a hand held controller for a games console comprising:

a hard outer case; and

a plurality of controls located on a front and top of the controller;

15 the controller being shaped to be held in both hands of a user such that the user's thumbs are positioned to operate controls located on the front of the controller and the user's index fingers are positioned to operate controls located on the top of the controller; wherein

the controller further comprises two additional controls located on a back of the controller in a position to be operated by the middle finger of a user.

20

The controller of the present invention may be very similar to controllers according to the prior art. In particular, the outer case of the controller and the type, number and positioning of the controls located on the front and top of the controller may be the same as a controller according to the prior art, as described above and as illustrated in  
25 the figures.

The controller of the present invention is particularly advantageous over controllers according to the prior art as it comprises two additional controls located on a back of the controller in a position to be operated by middle fingers of a user. The additional  
30 controls may either replicate the functions of one or more of the plurality of controls located on the front or top of the controller or provide additional functionality.



In a preferred embodiment of the invention the additional controls replicate the function of buttons and/or a direction pad located on the front of the controller. This means that a user does not need to remove their thumb from one of the other controls located on the front of the controller in order to operate the buttons and/or direction pad located on the front of the controller and can instead simply operate the additional controls located on the back of the controller with one or both of their middle fingers.

Alternatively, the additional controls may provide additional functionality in that they do not replicate the function of controls located on the front or top of the controller but may operate different functions. In this manner a controller according to the present invention may provide more functions according to the present invention.

Preferably, the controls located on the back of the controller are paddle levers. Suitable paddle levers may be formed integrally with the outer case of the controller or may be substantially separate from the outer case. This may be done in any manner apparent to the person skilled in the art. However, it is to be appreciated that the additional controls may comprise any other control suitable for use by a hand held controller.

Advantageously, if the additional controls are paddle levers, they will be formed such that they are substantially vertically aligned with respect to the controller. This may allow the most ergonomically efficient activation of the paddle levers by the middle fingers of the user.

Further features and advantages of the present invention will be apparent from the specific embodiment illustrated in the drawings and discussed below.

#### Drawings

Figure 1 is a schematic illustration of the front of a conventional games console controller according to the prior art;

Figure 2 is a schematic illustration of the rear of a games console controller according to the present invention; and

Figure 3 is a schematic illustration of the rear of a games controller according to the present invention in use.

5 The rear of a games controller 10 according to the present invention is illustrated in Figures 2 and 3. The front of the games controller 10 of Figures 2 and 3 is the same as a conventional controller 1, as illustrated in Figure 1 and as discussed above. Therefore, where appropriate the same reference numerals have been used to indicate the features of the controller according to the present invention 10 that are identical to the features of a conventional controller 1.

10

The games controller of the present invention 10 differs from the conventional controller 1 in that it additionally comprises two paddle levers 11 located on the rear of the controller. The paddle levers 11 are vertically orientated with respect to the controller 10 and are positioned to be operated by the middle fingers of a user 12, as shown in Figure 3.

15

The paddle levers 11 replicate the functions of two of the four buttons 4 located on the front of the controller 10 and thereby allow a user to operate the functions of the relevant buttons using their middle fingers 12, without the need to remove either of their thumbs from the left or right thumb stick 2, 3.

20

CLAIMS

1. A hand held controller for a games console comprising:  
a hard outer case; and  
5 a plurality of controls located on a front and top of the controller;  
the controller being shaped to be held in both hands of a user such that the user's  
thumbs are positioned to operate controls located on the front of the controller and the  
user's index fingers are positioned to operate controls located on the top of the  
controller; wherein  
10 the controller further comprises two additional controls located on a back of the  
controller in a position to be operated by the middle finger of a user.
  
2. A controller according to claim 1 wherein the additional controls are paddle  
levers.  
15
  
3. A controller according to claim 1 wherein the additional controls are  
substantially vertically orientated with respect to the controller.
  
4. A controller according to claim 2 or claim 3 wherein the additional controls  
20 are formed as an integral part of the outer case.
  
5. A controller according to claim 2 or claim 3 wherein the additional controls  
are formed separate from the outer case of the controller.



**Application No:** GB1011078.1

**Examiner:** Mr Brendan Donohoe

**Claims searched:** All

**Date of search:** 13 May 2011

**Patents Act 1977: Search Report under Section 17**

**Documents considered to be relevant:**

Category	Relevant to claims	Identity of document and passage or figure of particular relevance
X	All	Modified Xbox 360 controller discussed in 'Rapid Fire Mod For Wireless Xbox 360 Controller, Step by step tutorial with pictures' forum on xbox-scene.com. See post #341 (dated Jul 8 2008) - post #346 (dated Jul 9 2008) on pages 23 and 24 of the thread, referring to modified gamepad by contributor 'Jimakos Sn', available at <a href="http://forums.xbox-scene.com/index.php?showtopic=643928&amp;st=330">http://forums.xbox-scene.com/index.php?showtopic=643928&amp;st=330</a> .
X	All	'FireStorm Dual Power' gamepad by 'Thrustmaster'. Available around 2002. See the 'Thrustmaster USB game controller roundup' dated 5 April 2002 on 'Dan's Data' website, available at <a href="http://www.dansdata.com/tmsticks.htm">http://www.dansdata.com/tmsticks.htm</a> .
X	All	'Run 'N' Drive' wireless gamepad by 'Thrustmaster'. Available since March 2007. See the review by Olin Coles dated 08 April 2009 on BenchmarkReviews.com, note especially 'Closer Look' (page 3 of 4) available at <a href="http://benchmarkreviews.com/index.php?option=com_content&amp;task=view&amp;id=235&amp;Itemid=65&amp;limit=1&amp;limitstart=2">http://benchmarkreviews.com/index.php?option=com_content&amp;task=view&amp;id=235&amp;Itemid=65&amp;limit=1&amp;limitstart=2</a> .
X	All	WO2008/131249 A1 COE - See whole document, note especially buttons 113, 114 provided on the underside of the gamepad.

**Categories:**

X	Document indicating lack of novelty or inventive step	A	Document indicating technological background and/or state of the art.
Y	Document indicating lack of inventive step if combined with one or more other documents of same category.	P	Document published on or after the declared priority date but before the filing date of this invention.
&	Member of the same patent family	E	Patent document published on or after, but with priority date earlier than, the filing date of this application.

**Field of Search:**

Search of GB, EP, WO & US patent documents classified in the following areas of the UKC<sup>X</sup> :

Worldwide search of patent documents classified in the following areas of the IPC

The following online and other databases have been used in the preparation of this search report

Internet keyword search.



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**International Classification:**

<b>Subclass</b>	<b>Subgroup</b>	<b>Valid From</b>
A63F	0013/02	01/01/2006

## Electronic Patent Application Fee Transmittal

<b>Application Number:</b>	13162727				
<b>Filing Date:</b>	17-Jun-2011				
<b>Title of Invention:</b>	CONTROLLER FOR VIDEO GAME CONSOLE				
<b>First Named Inventor/Applicant Name:</b>	Simon Burgess				
<b>Filer:</b>	Cynthia R. Parks/Adrienne Mittons				
<b>Attorney Docket Number:</b>	0905-002				
Filed as Small Entity					
<b>Utility under 35 USC 111(a) Filing Fees</b>					
<b>Description</b>	<b>Fee Code</b>	<b>Quantity</b>	<b>Amount</b>	<b>Sub-Total in USD(\$)</b>	
<b>Basic Filing:</b>					
<b>Pages:</b>					
<b>Claims:</b>					
<b>Miscellaneous-Filing:</b>					
<b>Petition:</b>					
<b>Patent-Appeals-and-Interference:</b>					
<b>Post-Allowance-and-Post-Issuance:</b>					
<b>Extension-of-Time:</b>					
Extension - 3 months with \$0 paid	2253	1	700	700	

Description	Fee Code	Quantity	Amount	Sub-Total in USD(\$)
<b>Miscellaneous:</b>				
Request for Continued Examination	2801	1	600	600
Submission- Information Disclosure Stmt	2806	1	90	90
<b>Total in USD (\$)</b>				<b>1390</b>

## Electronic Acknowledgement Receipt

<b>EFS ID:</b>	16506188
<b>Application Number:</b>	13162727
<b>International Application Number:</b>	
<b>Confirmation Number:</b>	8138
<b>Title of Invention:</b>	CONTROLLER FOR VIDEO GAME CONSOLE
<b>First Named Inventor/Applicant Name:</b>	Simon Burgess
<b>Customer Number:</b>	52245
<b>Filer:</b>	Cynthia R. Parks/Adrienne Mittons
<b>Filer Authorized By:</b>	Cynthia R. Parks
<b>Attorney Docket Number:</b>	0905-002
<b>Receipt Date:</b>	05-AUG-2013
<b>Filing Date:</b>	17-JUN-2011
<b>Time Stamp:</b>	19:27:04
<b>Application Type:</b>	Utility under 35 USC 111(a)

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1		0905-002resp.pdf	107695 058f3474628a0737bdc5b091b932ba7fe23f4af3	yes	8
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		<b>Document Description</b>	<b>Start</b>	<b>End</b>	
		Amendment Submitted/Entered with Filing of CPA/RCE	1	1	
		Claims	2	5	
		Applicant Arguments/Remarks Made in an Amendment	6	8	
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<b>Information:</b>					
2	Request for Continued Examination (RCE)	0905-002RCE.pdf	697780 e2a8b859e3f4523686cb4ced4d4b8320f604d678	no	3
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3	Information Disclosure Statement (IDS) Form (SB08)	0905-002IDS.pdf	612372 6ae4585708c423b2dd920d8b5f65c12e421c38cf	no	4
<b>Warnings:</b>					
<b>Information:</b>					
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<b>Information:</b>					
<b>Total Files Size (in bytes):</b>				1950808	

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**New Applications Under 35 U.S.C. 111**

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

**National Stage of an International Application under 35 U.S.C. 371**

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

**New International Application Filed with the USPTO as a Receiving Office**

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Inventor(s): Simon Burgess et al.      Conf. No.: 8138  
App No.: 13/162,727                      Filing Date: June 17, 2011  
Art Unit: 3717                              Examiner: Hylinski, Steven J.  
Title:                      CONTROLLER FOR VIDEO GAME CONSOLE

Docket No.: 0905-002

Mail Stop: RCE  
Commissioner for Patents  
U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

**RESPONSE TO FINAL OFFICE ACTION UNDER 37 C.F.R. § 1.116**

This Response is filed in reply to the non-final Office Action mailed February 4, 2012 and the Advisory Action mailed May 15, 2013. The Assignee requests consideration of the following amendments and remarks.

Amendments to the Claims begin on page 2.

Remarks begin on page 6.

### CLAIM LISTING

The following set of claims replaces all previous versions of the claims.

1. (Currently Amended) A hand held controller for a game console comprising:
  - an outer case comprising a front, a back, a top edge, and a bottom edge, wherein the back of the controller is opposite the front of the controller and the top edge is opposite the bottom edge; and
  - a front control located on the front of the controller;
  - wherein the controller is shaped to be held in the hand of a user such that the user's thumb is positioned to operate the front control; and
  - a first back control and a second back control, each back control being located on the back of the controller~~[[,]]-wherein the back control is~~ and each back control including an elongate member that extends substantially the full distance between the top edge and the bottom edge and is inherently resilient and flexible.
  
2. (Previously Presented) The controller of claim 1, further having a top edge control located on the top edge of the controller and wherein the controller is shaped such that the user's index finger is positioned to operate the top edge control.
  
3. (Canceled)
  
4. (Currently Amended) The controller of claim 1, ~~wherein there are two back controls on the back of the controller,~~ wherein each of which the back controls is positioned to be operated by a middle finger of a user.
  
5. (Canceled)

6. (Currently Amended) The controller of claim 1, wherein ~~[[the]]~~ each elongate member is mounted within a recess located in the case of the controller.
7. (Currently Amended) The controller of claim 6, wherein ~~[[the]]~~ each elongate member comprises an outermost surface which is disposed in close proximity to the outermost surface of the controller such that a user's finger may be received in said respective recess.
8. (Currently Amended) The controller of claim 1, wherein ~~[[the]]~~ each elongate member has a thickness between about 1mm and 10mm.
9. (Currently Amended) The controller of claim 1, wherein ~~[[the]]~~ each elongate member has a thickness between about 1mm and 5mm.
10. (Currently Amended) The controller of claim 1, wherein ~~[[the]]~~ each elongate member has a thickness between about 1mm and 3mm.
11. (Currently Amended) The controller of claim 1 ~~[[4]]~~, wherein the elongate members are parallel to one another.
12. (Currently Amended) The controller of claim 1 ~~[[4]]~~, wherein the elongate members converge towards the front end of the controller with respect to one another.
13. (Currently Amended) The controller of claim 1, wherein a portion of at least one of the first back control and the second back control is in registry with a switch mechanism disposed within the controller, such that displacement of the at least one back control activates the switch mechanism.

14. (Currently Amended) The controller of claim 1 [[4]], wherein a switch mechanism is disposed between each of the elongate members and an outer surface of the base of the controller.
15. (Currently Amended) The controller of claim 2, wherein at least one of the back controls replicates the function of one or more of the top edge control and the front control.
16. (Currently Amended) The controller of claim 2, wherein at least one of the back controls has functions in addition to the top edge control and the front control.
17. (Currently Amended) The controller of claim 1, wherein at least one of the back controls is a paddle lever.
18. (Currently Amended) The controller of claim 1, wherein at least one of the back controls is substantially parallel to the front of the controller.
19. (Currently Amended) The controller of claim 1, wherein at least one of the back controls is formed as an integral part of the outer case.
20. (Currently Amended) The controller of claim 1, wherein at least one of the back controls is formed separate from the outer case of the controller.
21. (Previously Presented) The controller of claim 2, wherein the top edge is substantially perpendicular to the front.

22. (Currently Amended) A hand held controller for a game console comprising:

an outer case comprising a front, a back, a top edge, and a bottom edge, wherein the back of the controller is opposite the front of the controller and the top edge is opposite the bottom edge;

a front control located on the front of the controller, wherein the controller is shaped to be held in the hand of a user such that the user's thumb is positioned to operate the front control; and

a first back control and a second back control, each back control being located on the back of the controller[[,]] wherein the back control is and each back control including an elongate member that extends substantially the full distance between the top edge and the bottom edge.

\* \* \*

**REMARKS**

SUMMARY OF THE CLAIMS

The application has been carefully reviewed in light of the Office Action dated February 4, 2013 and the Advisory Action dated May 15, 2013. This communication is believed to be a complete response to that Office Action and that Advisory Action. Claims 1, 2, 4 and 6-22 were pending in the present application prior to entry of the present amendments. By the present Office Action, claims 1, 2, 4, 6-22 have been rejected.

By the present amendment, claims 1, 4, 6-20 and 22 have been amended. Support for these amendments can be found in the original specification, and thus, no new matter has been added. Applicant reserves the right to pursue all original claims in this or other patent applications. Reconsideration and reexamination of the present application is respectfully requested in light of the foregoing amendments and in view of the following remarks, which establish that the pending claims are directed to allowable subject matter.

SECTION 102 REJECTIONS

Claim 22 is rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Pat. No. 7,859,514 (Park). Claim 22 has been amended and the rejection thereto is considered moot.

SECTION 103 REJECTIONS

Claims 1-2, 4, and 6-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Park, in view of U.S. Pat. Pub. 2004/0224765 (Martinez et al.). Claim 1 has been amended and the rejections thereto are considered moot. Claims 2, 4, and 6-21 depend from amended claim 1 and thus the rejections thereto are also considered moot.



#### ADVISORY ACTION

The Advisory Action cites an online NPL reference "Review: Scuf Xbox 360 Controller" by Dave Burns, dated October 20, 2010 (<http://web.archive.org/web/20101022215104/http://www.xboxer360.com/features/review-scuf-xbox-360-controller/>). A UK Patent Application (GB 2481663) by one of the named inventors of the present application, Simon Burgess, filed July 1, 2010, is attached. The attached UK Patent application establishes invention of the subject matter prior to the date of the NPL reference.

#### FEES

The fee for the RCE is included herewith. The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to Deposit Account No. 50-3447.

#### CONCLUSION

It is respectfully submitted that the application is in condition for allowance, and notice to that effect is respectfully requested. If Examiner Hylinski has any new concerns, the Examiner is respectfully urged to contact the undersigned representative at her earliest convenience in order to efficiently advance prosecution of this application.

Respectfully Submitted,

PARKS IP LAW LLC

by           /Stephen J. Terrell/            
Stephen Terrell; Reg. No. 62,734  
Agent for the Assignee

Parks IP Law  
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<b>PATENT APPLICATION FEE DETERMINATION RECORD</b> Substitute for Form PTO-875				Application or Docket Number <b>13/162,727</b>		Filing Date <b>06/17/2011</b>		<input type="checkbox"/> To be Mailed		
ENTITY: <input type="checkbox"/> LARGE <input checked="" type="checkbox"/> SMALL <input type="checkbox"/> MICRO										
<b>APPLICATION AS FILED – PART I</b>										
(Column 1)			(Column 2)							
FOR		NUMBER FILED	NUMBER EXTRA		RATE (\$)	FEE (\$)				
<input type="checkbox"/> BASIC FEE <small>(37 CFR 1.16(a), (b), or (c))</small>		N/A	N/A		N/A					
<input type="checkbox"/> SEARCH FEE <small>(37 CFR 1.16(k), (l), or (m))</small>		N/A	N/A		N/A					
<input type="checkbox"/> EXAMINATION FEE <small>(37 CFR 1.16(o), (p), or (q))</small>		N/A	N/A		N/A					
TOTAL CLAIMS <small>(37 CFR 1.16(i))</small>		minus 20 =	*		X \$	=				
INDEPENDENT CLAIMS <small>(37 CFR 1.16(h))</small>		minus 3 =	*		X \$	=				
<input type="checkbox"/> APPLICATION SIZE FEE <small>(37 CFR 1.16(s))</small>		If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$310 (\$155 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).								
<input type="checkbox"/> MULTIPLE DEPENDENT CLAIM PRESENT <small>(37 CFR 1.16(j))</small>										
					TOTAL					
* If the difference in column 1 is less than zero, enter "0" in column 2.										
<b>APPLICATION AS AMENDED – PART II</b>										
(Column 1)			(Column 2)			(Column 3)				
AMENDMENT	CLAIMS REMAINING AFTER AMENDMENT			HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE (\$)	ADDITIONAL FEE (\$)			
	Total (37 CFR 1.16(i))		*	Minus	**	=	X \$	=		
	Independent (37 CFR 1.16(h))		*	Minus	***	=	X \$	=		
	<input type="checkbox"/> Application Size Fee (37 CFR 1.16(s))									
	<input type="checkbox"/> FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(j))									
					TOTAL ADD'L FEE					
(Column 1)			(Column 2)			(Column 3)				
AMENDMENT	08/05/2013			HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE (\$)	ADDITIONAL FEE (\$)			
	Total (37 CFR 1.16(i))		*	19	Minus	**	20	=	0	X \$40 =
	Independent (37 CFR 1.16(h))		*	2	Minus	***	3	=	0	X \$210 =
	<input type="checkbox"/> Application Size Fee (37 CFR 1.16(s))									
	<input type="checkbox"/> FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(j))									
					TOTAL ADD'L FEE		<b>0</b>			
* If the entry in column 1 is less than the entry in column 2, write "0" in column 3.										
** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20, enter "20".										
*** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 3, enter "3".										
The "Highest Number Previously Paid For" (Total or Independent) is the highest number found in the appropriate box in column 1.										
LIE /ANTJUAN RIVERA/										

This collection of information is required by 37 CFR 1.16. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/162,727	06/17/2011	Simon Burgess	0905-002	8138
52245	7590	08/09/2013	EXAMINER	
Parks IP Law LLC 730 Peachtree Street, NE Suite 600 ATLANTA, GA 30308			HYLINSKI, STEVEN J	
			ART UNIT	PAPER NUMBER
			3717	
			MAIL DATE	DELIVERY MODE
			08/09/2013	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 13/162,727	<b>Applicant(s)</b> BURGESS ET AL.	
	<b>Examiner</b> STEVEN J. HYLINSKI	<b>Art Unit</b> 3717	<b>AIA (First Inventor to File) Status</b> No

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1)  Responsive to communication(s) filed on 5 August 2013.  
 A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on \_\_\_\_\_.
- 2a)  This action is **FINAL**.                      2b)  This action is non-final.
- 3)  An election was made by the applicant in response to a restriction requirement set forth during the interview on \_\_\_\_\_; the restriction requirement and election have been incorporated into this action.
- 4)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 5)  Claim(s) 1,2,4 and 6-22 is/are pending in the application.  
5a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 6)  Claim(s) \_\_\_\_\_ is/are allowed.
- 7)  Claim(s) 1,2,4 and 6-22 is/are rejected.
- 8)  Claim(s) \_\_\_\_\_ is/are objected to.
- 9)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

\* If any claims have been determined allowable, you may be eligible to benefit from the **Patent Prosecution Highway** program at a participating intellectual property office for the corresponding application. For more information, please see [http://www.uspto.gov/patents/init\\_events/pph/index.jsp](http://www.uspto.gov/patents/init_events/pph/index.jsp) or send an inquiry to [PPHfeedback@uspto.gov](mailto:PPHfeedback@uspto.gov).

**Application Papers**

- 10)  The specification is objected to by the Examiner.
- 11)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

**Priority under 35 U.S.C. § 119**

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

**Certified copies:**

- a)  All    b)  Some \*    c)  None of the:
1.  Certified copies of the priority documents have been received.
  2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1)  Notice of References Cited (PTO-892)
- 2)  Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 08/05/2013.
- 3)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 4)  Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Arguments***

1. The present amendments overcome the previous rejections made under US 7,859,514 to Park and US 2004/0224765 to Martinez et al. New grounds of rejection have been applied, as required by the amendments.
2. The UK Patent Application GB 2481663, which Applicant alleges "establishes invention of the subject matter prior to the date of the NPL reference" is not material to the examination of the instant application because the instant application does not claim priority to the UK patent application. The NPL document relied on is a document authored by Dave Burns and made publicly available on Oct. 20, 2010, so it does not have any inventors in common with the instant invention, and therefore the 102(e) date of this document cannot be sworn behind by Applicant by claiming common inventorship with an unrelated document, the UK patent. The UK Patent furthermore is not date eligible prior art and is not being relied on by Examiner, so the common inventor between the UK Patent and the instant application is not material to the examination of the instant application.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of 35 U.S.C. 112(b):

(b) CONCLUSION.—The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention.

The following is a quotation of 35 U.S.C. 112 (pre-AIA), second paragraph:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 14 is rejected under 35 U.S.C. 112(b) or 35 U.S.C. 112 (pre-AIA), second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the inventor or a joint inventor, or for pre-AIA the applicant regards as the invention. Claim 14 recites the limitation "the base of the controller". There is insufficient antecedent basis for this limitation in the claim. Examiner is interpreting "the base of the controller" to mean "the outer case of the controller". Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of pre-AIA 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –  
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**4. Claims 1-2, 4, 6-7, 11-12, and 15-22 are rejected under pre-AIA 35 U.S.C. 102(e) as being anticipated by "Review: Scuf Xbox 360 Controller" by Dave Burns (hereinafter referred to as Burns).**

**Re Claims 1 and 22,**

Burns discloses a hand held controller for a game console (Title, and page 3, a handheld controller for XBOX 360) comprising:

an outer case comprising a front, a back, a top edge, and a bottom edge, wherein the back of the controller is opposite the front of the controller and the top edge is opposite the bottom edge (see the photographs on pages 3, 4, 5, and 6) and

a front control located on the front of the controller, wherein the controller is shaped to be held in the hand of a user so that the user's thumb is positioned to operate the front control (See pages 3-5. Page 4 refers to the control shown in the middle of the page as "extended right thumb stick)

a first back control and a second back control, each back control being located on the back of the controller, and each back control including an elongate member that extends substantially the full distance between the top edge and the bottom edge (see the first picture on page 4 and the description below) and is inherently resilient and flexible (paragraph 1 of page 3 states that each of the 2 paddles shown on the back of the control pad are made from polycarbonate plastic which is extremely strong so that "they can take as much punishment as possible". Polycarbonate plastic is inherently a flexible material that will elastically deform as a function of its modulus of elasticity when a force is applied.)

**Re Claim 2**, see pages 4 and 5, including the pictures and descriptions of the trigger buttons, labeled "LT" and "RT" and shown as being located on the front of the XBOX360 controller .in the pictures.

**Re Claim 4**, Paragraph 1 of page 4 states that the 2 paddles on the back of the controller are operated by "your unused middle fingers that rest on the rear of the pad".



**Re Claim 6**, the first and second pictures on page 4 show the two paddles being mounted within a recess in the case of the controller.

**Re Claim 7**, Paragraph 1 of page 4 states that “your unused middle fingers that rest on the rear of the pad” are used to operate the 2 paddles. The first picture on page 4 shows the elongate paddle members comprising an outermost surface that is disposed in close proximity to the outermost surface of the controller such that a user’s finger may be received in the recesses.

**Re Claims 11-12**, the first picture on page 4 of Burns shows the 2 paddles on the rear of the controller being substantially parallel, and converging slightly towards the front end of the controller with respect to one another.

**Re Claim 15**, the first and second paragraphs on page 4 state that each of the paddles located on the rear of the controller interfaces with a corresponding switch hard wired to the A and B buttons of the controller, such that when each button is pressed, programmed game instructions respond accordingly.

**Re Claim 16**, Paragraph 1 of page 4 states that the user can reassign button functions as desired. An example given is of the paddles being assigned to jump and crouch, or jump and melee game functions. Paragraph 4 of page 4 states that the front triggers can be used for firing shots, the triggers depicted in the third picture showing front and top triggers.

**Re Claims 17-18**, see the first picture on page 4 of Burns.

**Re Claims 19-20**, the two paddles shown in the first picture on page 4 are depicted as being distinct individual components that when installed in the controller forms an

integral part of the outer case. Paragraph 1 of page 4 states that each of the paddles is screwed and bonded into the chassis on the controller.

**Re Claim 21**, the pictures on pages 4-5 show the front of the controller, which has the front and top triggers, being substantially perpendicular to the front.

***Claim Rejections - 35 USC § 103***

The following is a quotation of pre-AIA 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**5. Claims 8-10, are rejected under pre-AIA 35 U.S.C. 103(a) as being unpatentable over Burns.**

**Re Claims 8-10,**

Burns discloses the same invention, but does not go into detail as to what the specific dimensions are of the invention. Claims 8-10 recite alternative possible size considerations for the same elongate members shown and described on page 4 of Burns, without claiming any unexpected result of these size considerations, especially in light of the several thickness ranges being presented in the alternative, which indicates the function of the apparatus is unchanged as these parameters are varied.

Regarding claims 8-10, in *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims

was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. See also MPEP 2144.04 Section IV A. Changing the thickness of buttons can also be rejected as a change in shape, See also MPEP Section IV B.

**6. Claims 13-14 is rejected under pre-AIA 35 U.S.C. 103(a) as being unpatentable over Burns in view of US 5,551,693 to Goto et al.**

**Re Claims 13-14,**

Paragraph 1 of page 4 of Burns states that each paddle is affixed to the chassis of the controller, and that depressing each paddle with a middle finger sends a hardwired trigger signal to the A and B buttons. However, Burns is silent as to the details of the switch mechanisms that the paddles activate. Goto is an old and well-known prior art reference in the art of handheld home video game controllers. Goto teaches that beneath each button integrated into the housing of such a handheld controller exists a switch mechanism that is activated in response to the button being depressed by the user's fingers (See Figs. 7-10 of Goto, 14a and 14c). It would have been obvious to one having ordinary skill in the art at the time the invention was made that the paddles on the back of the controller of Burns would function in the context of a home video game system by closing switch mechanisms located beneath each paddle when depressed by the middle fingers of the player, the switch mechanisms located inside the housing of the controller and therefore between each elongate member and an outer surface of the controller, as taught by Goto, because manufacturing a known

prior art device using components known in the art and producing predictable results is not patentable.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to STEVEN J. HYLINSKI whose telephone number is (571)270-1995. The examiner can normally be reached on Mon-Fri 9am-7pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Melba Bumgarner can be reached on (571)272-4709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/STEVEN J HYLINSKI/  
Primary Examiner, Art Unit 3717

<b>Notice of References Cited</b>	Application/Control No. 13/162,727	Applicant(s)/Patent Under Reexamination BURGESS ET AL.	
	Examiner STEVEN J. HYLINSKI	Art Unit 3717	Page 1 of 1

**U.S. PATENT DOCUMENTS**

*	Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A US-			
	B US-			
	C US-			
	D US-			
	E US-			
	F US-			
	G US-			
	H US-			
	I US-			
	J US-			
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**FOREIGN PATENT DOCUMENTS**

*	Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N				
	O				
	P				
	Q				
	R				
	S				
	T				

**NON-PATENT DOCUMENTS**

*	Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
U	"Review: Scuf Xbox 360 Controller" by Dave Burns, published October 20, 2010. Source <a href="http://www.xboxer360.com/features/review-scuf-xbox-360-controller/">http://www.xboxer360.com/features/review-scuf-xbox-360-controller/</a> Accessed Oct 22, 2010.
V	
W	
X	

\*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)  
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

Receipt date: 08/05/2013

13162727 - GAI: 3717

Doc code: IDS

Doc description: Information Disclosure Statement (IDS) Filed

Approved for use through 07/31/2012. OMB 0651-0031

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<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b> ( Not for submission under 37 CFR 1.99)	Application Number		13162727	
	Filing Date		2011-06-17	
	First Named Inventor	Simon Burgess		
	Art Unit	3717		
	Examiner Name	Steven J. Hylinski		
	Attorney Docket Number	0905-002		

U.S. PATENTS							Remove	
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<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b> ( Not for submission under 37 CFR 1.99)	Application Number		13162727	13162727 - GAU: 3717
	Filing Date		2011-06-17	
	First Named Inventor	Simon Burgess		
	Art Unit	3717		
	Examiner Name	Steven J. Hylinski		
	Attorney Docket Number	0905-002		

	1		<input type="checkbox"/>
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**EXAMINER SIGNATURE**

Examiner Signature	/Steven Hylinski/	Date Considered	08/06/2013
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\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through a citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

<sup>1</sup> See Kind Codes of USPTO Patent Documents at [www.USPTO.GOV](http://www.USPTO.GOV) or MPEP 901.04. <sup>2</sup> Enter office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>3</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>4</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. <sup>5</sup> Applicant is to place a check mark here if English language translation is attached.

<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b> ( Not for submission under 37 CFR 1.99)	Application Number	13162727	13162727 - GAU: 3717
	Filing Date	2011-06-17	
	First Named Inventor	Simon Burgess	
	Art Unit	3717	
	Examiner Name	Steven J. Hylinski	
	Attorney Docket Number	0905-002	

**CERTIFICATION STATEMENT**

Please see 37 CFR 1.97 and 1.98 to make the appropriate selection(s):

That each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement. See 37 CFR 1.97(e)(1).

**OR**

That no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing the certification after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in 37 CFR 1.56(c) more than three months prior to the filing of the information disclosure statement. See 37 CFR 1.97(e)(2).

See attached certification statement.

The fee set forth in 37 CFR 1.17 (p) has been submitted herewith.

A certification statement is not submitted herewith.

**SIGNATURE**

A signature of the applicant or representative is required in accordance with CFR 1.33, 10.18. Please see CFR 1.4(d) for the form of the signature.

Signature	/Stephen J. Terrell/	Date (YYYY-MM-DD)	2013-08-05
Name/Print	Stephen J. Terrell	Registration Number	62734

This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. **DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**




**Privacy Act Statement**

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these records.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH. /S.H./

<b>Search Notes</b>  	<b>Application/Control No.</b>  13162727	<b>Applicant(s)/Patent Under Reexamination</b>  BURGESS ET AL.
	<b>Examiner</b>  STEVEN J HYLINSKI	<b>Art Unit</b>  3717

CPC- SEARCHED		
Symbol	Date	Examiner


CPC COMBINATION SETS - SEARCHED		
Symbol	Date	Examiner

US CLASSIFICATION SEARCHED			
Class	Subclass	Date	Examiner
463	37	06/16/2012	SJH
463	37	01/17/2013	SJH

SEARCH NOTES		
Search Notes	Date	Examiner
See EAST search history.	06/16/2012	SJH
Updated East search , see search history.	01/30/2013	SJH
Updated East search , see search history.	08/07/2013	SJH

INTERFERENCE SEARCH			
US Class/ CPC Symbol	US Subclass / CPC Group	Date	Examiner

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<b><i>Index of Claims</i></b> 	<b>Application/Control No.</b> 13162727	<b>Applicant(s)/Patent Under Reexamination</b> BURGESS ET AL.
	<b>Examiner</b> STEVEN J HYLINSKI	<b>Art Unit</b> 3717

✓	<b>Rejected</b>	-	<b>Cancelled</b>	N	<b>Non-Elected</b>	A	<b>Appeal</b>
=	<b>Allowed</b>	÷	<b>Restricted</b>	I	<b>Interference</b>	O	<b>Objected</b>

Claims renumbered in the same order as presented by applicant
  CPA
  T.D.
  R.1.47

CLAIM		DATE							
Final	Original	06/16/2012	01/30/2013	08/07/2013					
	1	✓	✓	✓					
	2	✓	✓	✓					
	3	✓	-	-					
	4	✓	✓	✓					
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	16	✓	✓	✓					
	17	✓	✓	✓					
	18	✓	✓	✓					
	19	✓	✓	✓					
	20	✓	✓	✓					
	21		✓	✓					
	22		✓	✓					

## EAST Search History

## EAST Search History (Prior Art)

Ref #	Hits	Search Query	DBs	Default Operator	Plurals	Time Stamp
L1	1	"20040224765".pn.	US-PGPUB; USPAT	OR	ON	2013/08/07 18:40
L3	345	l2 and (contact with (button or switch))	US-PGPUB; USPAT	OR	ON	2013/08/07 18:45
L2	1775	463/37.ccls.	US-PGPUB; USPAT	OR	ON	2013/08/07 18:45
L5	1	"5551693".pn.	US-PGPUB; USPAT	OR	ON	2013/08/07 18:57
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L7	0	l6 not l4	US-PGPUB; USPAT	OR	OFF	2013/08/07 18:58
L6	64	(US-20050269769-\$ or US-20060040740-\$ or US-20060116204-\$ or US-20080261695-\$ or US-20050215321-\$ or US-20060025217-\$ or US-20070021209-\$ or US-20040063502-\$ or US-20040224768-\$).did. or (US-6001014-\$ or US-6019680-\$ or US-7942745-\$ or US-7927216-\$ or US-7774155-\$ or US-7596466-\$ or US-6280327-\$ or US-5670988-\$ or US-4552360-\$ or US-6135886-\$ or US-6171191-\$ or US-7377851-\$ or US-D620939-\$ or US-6394906-\$ or US-7859514-\$ or US-6288709-\$ or US-7804484-\$ or US-6760013-\$ or US-5984548-\$ or US-5874906-\$ or US-7471216-\$ or US-6261180-\$ or US-D547763-\$ or US-	US-PGPUB; USPAT	OR	OFF	2013/08/07 18:58

EAST Search History

D659140-\$ or US-D623649-\$ or US-6512511-\$).did. or (US-6342009-\$ or US-5716274-\$ or US-6887158-\$ or US-6682426-\$ or US-6231444-\$ or US-7473180-\$ or US-5551693-\$ or US-7488254-\$ or US-6524187-\$ or US-6524186-\$ or US-5853326-\$ or US-7235012-\$ or US-7407439-\$ or US-7753786-\$ or US-7794326-\$ or US-5531443-\$ or US-5984785-\$ or US-6102803-\$ or US-6186896-\$ or US-6241611-\$ or US-6267673-\$ or US-D376826-\$ or US-D377198-\$ or US-D464349-\$ or US-D409183-\$ or US-D572710-\$ or US-D393291-\$).did. or (US-D384112-\$ or US-D431604-\$).did.			
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**EAST Search History (Interference)**

<This search history is empty>

**8/ 7/ 2013 7:20:55 PM**

**C:\Users\shylinski\Documents\EAST\Workspaces\13162727.wsp**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Inventor(s): Simon Burgess et al.      Conf. No.: 8138  
App No.: 13/162,727                      Filing Date: June 17, 2011  
Art Unit: 3717                              Examiner: Hylinski, Steven J.  
Title:                      CONTROLLER FOR VIDEO GAME CONSOLE

Docket No.: 0905-002

Mail Stop: AMENDMENT  
Commissioner for Patents  
U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

**RESPONSE TO FINAL OFFICE ACTION UNDER 37 C.F.R. § 1.111**

This Response is filed in reply to the non-final Office Action mailed August 9, 2013. The Assignee requests consideration of the following amendments and remarks.

Amendments to the Claims begin on page 2.

Remarks begin on page 6.

### CLAIM LISTING

The following set of claims replaces all previous versions of the claims.

1. (Previously Presented) A hand held controller for a game console comprising:
  - an outer case comprising a front, a back, a top edge, and a bottom edge, wherein the back of the controller is opposite the front of the controller and the top edge is opposite the bottom edge; and
  - a front control located on the front of the controller;
  - wherein the controller is shaped to be held in the hand of a user such that the user's thumb is positioned to operate the front control; and
  - a first back control and a second back control, each back control being located on the back of the controller and each back control including an elongate member that extends substantially the full distance between the top edge and the bottom edge and is inherently resilient and flexible.
  
2. (Previously Presented) The controller of claim 1, further having a top edge control located on the top edge of the controller and wherein the controller is shaped such that the user's index finger is positioned to operate the top edge control.
  
3. (Canceled)
  
4. (Previously Presented) The controller of claim 1, wherein each of the back controls is positioned to be operated by a middle finger of a user.
  
5. (Canceled)

6. (Previously Presented) The controller of claim 1, wherein each elongate member is mounted within a recess located in the case of the controller.
7. (Previously Presented) The controller of claim 6, wherein each elongate member comprises an outermost surface which is disposed in close proximity to the outermost surface of the controller such that a user's finger may be received in said respective recess.
8. (Previously Presented) The controller of claim 1, wherein each elongate member has a thickness between about 1mm and 10mm.
9. (Previously Presented) The controller of claim 1, wherein each elongate member has a thickness between about 1mm and 5mm.
10. (Previously Presented) The controller of claim 1, wherein each elongate member has a thickness between about 1mm and 3mm.
11. (Previously Presented) The controller of claim 1, wherein the elongate members are parallel to one another.
12. (Previously Presented) The controller of claim 1, wherein the elongate members converge towards the front end of the controller with respect to one another.
13. (Previously Presented) The controller of claim 1, wherein a portion of at least one of the first back control and the second back control is in registry with a switch mechanism disposed within the controller, such that displacement of the at least one back control activates the switch mechanism.



14. (Currently Amended) The controller of claim 1, wherein a switch mechanism is disposed between each of the elongate members and an outer surface of the back base of the controller.
15. (Previously Presented) The controller of claim 2, wherein at least one of the back controls replicates the function of one or more of the top edge control and the front control.
16. (Previously Presented) The controller of claim 2, wherein at least one of the back controls has functions in addition to the top edge control and the front control.
17. (Previously Presented) The controller of claim 1, wherein at least one of the back controls is a paddle lever.
18. (Previously Presented) The controller of claim 1, wherein at least one of the back controls is substantially parallel to the front of the controller.
19. (Previously Presented) The controller of claim 1, wherein at least one of the back controls is formed as an integral part of the outer case.
20. (Previously Presented) The controller of claim 1, wherein at least one of the back controls is formed separate from the outer case of the controller.
21. (Previously Presented) The controller of claim 2, wherein the top edge is substantially perpendicular to the front.
22. (Previously Presented) A hand held controller for a game console comprising:

an outer case comprising a front, a back, a top edge, and a bottom edge, wherein the back of the controller is opposite the front of the controller and the top edge is opposite the bottom edge;

a front control located on the front of the controller, wherein the controller is shaped to be held in the hand of a user such that the user's thumb is positioned to operate the front control; and

a first back control and a second back control, each back control being located on the back of the controller and each back control including an elongate member that extends substantially the full distance between the top edge and the bottom edge.

\* \* \*

## REMARKS

### SUMMARY OF THE CLAIMS

The application has been carefully reviewed in light of the Office Action dated August 9, 2013. This communication is believed to be a complete response to that Office Action. Claims 1, 2, 4 and 6-22 were pending in the present application prior to entry of the present amendments. By the present Office Action, claims 1, 2, 4, 6-22 have been rejected.

Claim 14 has been amended to correct an informality. Claims 1, 2, 4, 6-22 remain in the application. Reconsideration and reexamination of the present application is respectfully requested in view of the following remarks, which establish that the pending claims are directed to allowable subject matter.

#### Examiner Interview

The Examiner is thanked for the telephone discussion on October 3, 2013. The discussion focused on MPEP 715.01.

### SECTION 112 REJECTIONS

Claim 14 is rejected under 35 USC 112(b), second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that the inventor regards as the invention. Claim 14 has been amended for purposes of antecedent basis.

### SECTION 102 REJECTIONS

Claims 1-2, 4, 6-7, 11-12, and 15-22 are rejected under 35 USC 102(e) as being anticipated by "Review: Scuf Xbox 360 Controller" by Dave Burns, dated October 20, 2010 (hereinafter, **Burns**) (<http://web.archive.org/web/20101022215104/http://www.xboxer360.com/features/review-scuf-xbox-360-controller/>). A 132 affidavit is attached that establishes that **Burns** discloses subject matter derived from the applicant rather than

invented by the author notwithstanding the authorship of the article. MPEP 716.10 states:

Where there is a published article identifying the authorship (MPEP § 715.01(c)) or a patent or an application publication identifying the inventorship (MPEP § 715.01(a)) that discloses subject matter being claimed in an application undergoing examination, the designation of authorship or inventorship does not raise a presumption of inventorship with respect to the subject matter disclosed in the article or with respect to the subject matter disclosed but not claimed in the patent or published application so as to justify a rejection under 35 U.S.C. 102(f).

However, it is incumbent upon the inventors named in the application, in response to an inquiry regarding the appropriate inventorship under 35 U.S.C. 102(f) or to rebut a rejection under 35 U.S.C. 102(a) or (e), to provide a satisfactory showing by way of affidavit under 37 CFR 1.132 that the inventorship of the application is correct in that the reference discloses subject matter derived from the applicant rather than invented by the author, patentee, or applicant of the published application notwithstanding the authorship of the article or the inventorship of the patent or published application. *In re Katz*, 687 F.2d 450, 455, 215 USPQ 14, 18 (CCPA 1982) (inquiry is appropriate to clarify any ambiguity created by an article regarding inventorship and it is then incumbent upon the applicant to provide “a satisfactory showing that would lead to a reasonable conclusion that [applicant] is the ... inventor” of the subject matter disclosed in the article and claimed in the application).

An uncontradicted “unequivocal statement” from the applicant regarding the subject matter disclosed in an article, patent, or published application will be accepted as establishing inventorship. *In re DeBaun*, 687 F.2d 459, 463, 214 USPQ 933, 936 (CCPA 1982). However, a statement by the applicants regarding their inventorship in view of an article, patent, or published application may not be sufficient where there is evidence to the contrary. *Ex*

*parte Kroger*, 218 USPQ 370 (Bd. App. 1982) (a rejection under 35 U.S.C. 102(f) was affirmed notwithstanding declarations by the alleged actual inventors as to their inventorship in view of a nonapplicant author submitting a letter declaring the author's inventorship); *In re Carreira*, 532 F.2d 1356, 189 USPQ 461 (CCPA 1976) (disclaiming declarations from patentees were directed at the generic invention and not at the claimed species, hence no need to consider derivation of the subject matter).

The 132 affidavit removes **Burns** as a prior art reference under 35 USC 102(a) or (e) and the rejection is overcome. For at least these reasons, claims 1-2, 4, 6-7, 11-12, and 15-22 are patentable over **Burns**.

#### SECTION 103 REJECTIONS

Claims 8-10 rejected under 35 USC 103(a) as being unpatentable over **Burns**. As established above, **Burns** is removed as a prior art reference by the 132 affidavit. For at least these reasons, claims 8-10 are patentable over **Burns**.

Claims 13-14 are rejected under 35 USC 103(a) as being unpatentable over **Burns** in view of US Patent No. 5,551,693 to Goto et al. (hereinafter, **Goto**) As established above, **Burns** is removed as a prior art reference by the 132 affidavit. **Goto** fails to disclose all the features of claims 13-14 and the Office Action does not claim that it does. For at least these reasons, claims 13-14 are patentable over **Burns** in view of **Goto**.

#### FEES

The Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 50-3447.

#### CONCLUSION

It is respectfully submitted that the application is in condition for allowance, and notice to that effect is respectfully requested. If Examiner Hylinski has any

new concerns, the Examiner is respectfully urged to contact the undersigned representative at her earliest convenience in order to efficiently advance prosecution of this application.

Respectfully Submitted,

PARKS IP LAW LLC

by /Stephen J. Terrell/  
Stephen Terrell; Reg. No. 62,734  
Agent for the Assignee

Parks IP Law  
Attention: Patent Docketing  
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Atlanta, Georgia 30308  
385-282-5291  
sterrell@parksiplaw.com

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Inventor(s): Simon Burgess et al.      Conf. No.: 8138  
App No.: 13/162,727                      Filing Date: June 17, 2011  
Art Unit: 3717                              Examiner: Hylinski, Steven J.  
Title:    CONTROLLER FOR VIDEO GAME CONSOLE

Docket No.: 0905-002

Mail Stop: AMENDMENT  
Commissioner for Patents  
U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

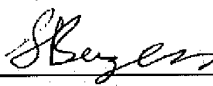
**DECLARATION OF SIMON BURGESS UNDER 37 C.F.R. § 1.132**

I, Simon Burgess, state as follows:

1. I am an inventor on the above-referenced patent application.
2. I understand that in the present Office Action, Claims 1-2, 4, 6-7, 11-12, and 15-22 are rejected under pre-AIA 35 U.S.C § 102(e) as being anticipated by: "Review: Scuf Xbox 360 Controller" by Dave Burns (hereinafter the *Burns* article), dated October 20, 2010 (<http://web.archive.org/web/20101022215104/http://www.xboxer360.com/features/review-scuf-xbox-360-controller/>).
3. I understand that in the present Office Action, claims 8-10 are rejected under pre-AIA 35 U.S.C § 103(a) as being unpatentable over the *Burns* article.
4. I understand that in the present Office Action, claims 13-14 are rejected under pre-AIA 35 U.S.C § 103(a) as being unpatentable over the *Burns* article in view of U.S. Patent No. 5,551,693 to Goto et al.
5. I am the inventor of the subject matter disclosed in the *Burns* article.
6. The inventorship of the present application is correct in that the *Burns* article discloses subject matter invented by me rather than by Dave Burns notwithstanding the authorship of the *Burns* article.

7. The following further supports my conception of the subject matter disclosed in the *Burns* article:
- a. At the time of publication of the *Burns* article, I was an owner of a business operating under the name "Scuf Control" and registered the domain name [www.scufcontrol.com](http://www.scufcontrol.com).
  - b. Scuf Control sent Dave Burns a controller, about which he wrote the online review, which is the *Burns* article, the cited reference.
  - c. The *Burns* article refers to the "Scuf" controller and to the domain name <http://www.scufcontrol.com/>.
  - d. The controller that was reviewed in the *Burns* article was sold on [www.scufcontrol.com](http://www.scufcontrol.com). Sales of the controller were serviced by Scuf Control.
  - e. I am the inventor of a UK Patent Application, GB 2481663. The UK application, filed July 1, 2010, was filed prior to the writing and publication of the *Burns* article.
8. I herein declare that all statements of my knowledge are true and that all statements made on information and belief are believed to be true and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both under Section 1000 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

11/10/2013  
Date

  
Simon Burgess



## Electronic Acknowledgement Receipt

<b>EFS ID:</b>	17116608
<b>Application Number:</b>	13162727
<b>International Application Number:</b>	
<b>Confirmation Number:</b>	8138
<b>Title of Invention:</b>	CONTROLLER FOR VIDEO GAME CONSOLE
<b>First Named Inventor/Applicant Name:</b>	Simon Burgess
<b>Customer Number:</b>	52245
<b>Filer:</b>	Stephen J. Terrell/Adrienne Mittons
<b>Filer Authorized By:</b>	Stephen J. Terrell
<b>Attorney Docket Number:</b>	0905-002
<b>Receipt Date:</b>	14-OCT-2013
<b>Filing Date:</b>	17-JUN-2011
<b>Time Stamp:</b>	13:16:21
<b>Application Type:</b>	Utility under 35 USC 111(a)

### Payment information:

Submitted with Payment	no
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### File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1		0905-002res.pdf	153629 59297faa381bb50523671bae51a05910dab0c2d7	yes	9

Multipart Description/PDF files in .zip description			
Document Description	Start	End	
Amendment/Req. Reconsideration-After Non-Final Reject	1	1	
Claims	2	5	
Applicant Arguments/Remarks Made in an Amendment	6	9	

**Warnings:**

**Information:**

2	Affidavit-Rule 131-pre-AIA (FTI) ONLY	0905-002Affidavit.pdf	100680	no	2
			b718cf3796356be603d5ded455cc2c8c2eb3022a		

**Warnings:**

**Information:**

<b>Total Files Size (in bytes):</b>	254309
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This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

**New Applications Under 35 U.S.C. 111**

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

**National Stage of an International Application under 35 U.S.C. 371**

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

**New International Application Filed with the USPTO as a Receiving Office**

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<b>PATENT APPLICATION FEE DETERMINATION RECORD</b> Substitute for Form PTO-875				Application or Docket Number <b>13/162,727</b>	Filing Date <b>06/17/2011</b>	<input type="checkbox"/> To be Mailed	
ENTITY: <input type="checkbox"/> LARGE <input checked="" type="checkbox"/> SMALL <input type="checkbox"/> MICRO							
<b>APPLICATION AS FILED – PART I</b>							
(Column 1)		(Column 2)					
FOR	NUMBER FILED	NUMBER EXTRA	RATE (\$)	FEE (\$)			
<input type="checkbox"/> BASIC FEE <small>(37 CFR 1.16(a), (b), or (c))</small>	N/A	N/A	N/A				
<input type="checkbox"/> SEARCH FEE <small>(37 CFR 1.16(k), (l), or (m))</small>	N/A	N/A	N/A				
<input type="checkbox"/> EXAMINATION FEE <small>(37 CFR 1.16(o), (p), or (q))</small>	N/A	N/A	N/A				
TOTAL CLAIMS <small>(37 CFR 1.16(j))</small>	minus 20 =	*	X \$	=			
INDEPENDENT CLAIMS <small>(37 CFR 1.16(h))</small>	minus 3 =	*	X \$	=			
<input type="checkbox"/> APPLICATION SIZE FEE <small>(37 CFR 1.16(s))</small>	If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$310 (\$155 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).						
<input type="checkbox"/> MULTIPLE DEPENDENT CLAIM PRESENT <small>(37 CFR 1.16(j))</small>							
* If the difference in column 1 is less than zero, enter "0" in column 2.				TOTAL			
<b>APPLICATION AS AMENDED – PART II</b>							
(Column 1)		(Column 2)		(Column 3)			
AMENDMENT	<b>10/14/2013</b>	CLAIMS REMAINING AFTER AMENDMENT	HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE (\$)	ADDITIONAL FEE (\$)	
	Total (37 CFR 1.16(i))	* 20	Minus	** 20	= 0	X \$40 = 0	
	Independent (37 CFR 1.16(h))	* 2	Minus	*** 3	= 0	X \$210 = 0	
	<input type="checkbox"/> Application Size Fee (37 CFR 1.16(s))						
	<input type="checkbox"/> FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(j))						
				TOTAL ADD'L FEE	<b>0</b>		
(Column 1)		(Column 2)		(Column 3)			
AMENDMENT		CLAIMS REMAINING AFTER AMENDMENT	HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE (\$)	ADDITIONAL FEE (\$)	
	Total (37 CFR 1.16(i))	*	Minus	**	=	X \$ =	
	Independent (37 CFR 1.16(h))	*	Minus	***	=	X \$ =	
	<input type="checkbox"/> Application Size Fee (37 CFR 1.16(s))						
	<input type="checkbox"/> FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(j))						
				TOTAL ADD'L FEE			
<p>* If the entry in column 1 is less than the entry in column 2, write "0" in column 3.  ** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20, enter "20".  *** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 3, enter "3".  The "Highest Number Previously Paid For" (Total or Independent) is the highest number found in the appropriate box in column 1.</p>							

LIE  
/MARSHA RICHARDS/

This collection of information is required by 37 CFR 1.16. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

*If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.*



UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

NOTICE OF ALLOWANCE AND FEE(S) DUE

52245 7590 11/18/2013
Parks IP Law LLC
730 Peachtree Street, NE
Suite 600
ATLANTA, GA 30308

EXAMINER

HYLINSKI, STEVEN J

ART UNIT PAPER NUMBER

3717

DATE MAILED: 11/18/2013

Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.

13/162,727 06/17/2011 Simon Burgess 0905-002 8138

TITLE OF INVENTION: CONTROLLER FOR VIDEO GAME CONSOLE

Table with 7 columns: APPLN. TYPE, ENTITY STATUS, ISSUE FEE DUE, PUBLICATION FEE DUE, PREV. PAID ISSUE FEE, TOTAL FEE(S) DUE, DATE DUE

nonprovisional SMALL \$890 \$300 \$0 \$1190 02/18/2014

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. PROSECUTION ON THE MERITS IS CLOSED. THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHTS. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. THIS STATUTORY PERIOD CANNOT BE EXTENDED. SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE DOES NOT REFLECT A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE IN THIS APPLICATION. IF AN ISSUE FEE HAS PREVIOUSLY BEEN PAID IN THIS APPLICATION (AS SHOWN ABOVE), THE RETURN OF PART B OF THIS FORM WILL BE CONSIDERED A REQUEST TO REAPPLY THE PREVIOUSLY PAID ISSUE FEE TOWARD THE ISSUE FEE NOW DUE.

HOW TO REPLY TO THIS NOTICE:

I. Review the ENTITY STATUS shown above. If the ENTITY STATUS is shown as SMALL or MICRO, verify whether entitlement to that entity status still applies.

If the ENTITY STATUS is the same as shown above, pay the TOTAL FEE(S) DUE shown above.

If the ENTITY STATUS is changed from that shown above, on PART B - FEE(S) TRANSMITTAL, complete section number 5 titled "Change in Entity Status (from status indicated above)".

For purposes of this notice, small entity fees are 1/2 the amount of undiscounted fees, and micro entity fees are 1/2 the amount of small entity fees.

II. PART B - FEE(S) TRANSMITTAL, or its equivalent, must be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). If you are charging the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed and an extra copy of the form should be submitted. If an equivalent of Part B is filed, a request to reapply a previously paid issue fee must be clearly made, and delays in processing may occur due to the difficulty in recognizing the paper as an equivalent of Part B.

III. All communications regarding this application must give the application number. Please direct all communications prior to issuance to Mail Stop ISSUE FEE unless advised to the contrary.

IMPORTANT REMINDER: Utility patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.

**PART B - FEE(S) TRANSMITTAL**

**Complete and send this form, together with applicable fee(s), to: Mail Mail Stop ISSUE FEE  
 Commissioner for Patents  
 P.O. Box 1450  
 Alexandria, Virginia 22313-1450  
 or Fax (571)-273-2885**

**INSTRUCTIONS:** This form should be used for transmitting the ISSUE FEE and PUBLICATION FEE (if required). Blocks 1 through 5 should be completed where appropriate. All further correspondence including the Patent, advance orders and notification of maintenance fees will be mailed to the current correspondence address as indicated unless corrected below or directed otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate "FEE ADDRESS" for maintenance fee notifications.

CURRENT CORRESPONDENCE ADDRESS (Note: Use Block 1 for any change of address)

52245                      7590                      11/18/2013  
 Parks IP Law LLC  
 730 Peachtree Street, NE  
 Suite 600  
 ATLANTA, GA 30308

Note: A certificate of mailing can only be used for domestic mailings of the Fee(s) Transmittal. This certificate cannot be used for any other accompanying papers. Each additional paper, such as an assignment or formal drawing, must have its own certificate of mailing or transmission.

**Certificate of Mailing or Transmission**

I hereby certify that this Fee(s) Transmittal is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the Mail Stop ISSUE FEE address above, or being facsimile transmitted to the USPTO (571) 273-2885, on the date indicated below.

_____ (Depositor's name)
_____ (Signature)
_____ (Date)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/162,727	06/17/2011	Simon Burgess	0905-002	8138

TITLE OF INVENTION: CONTROLLER FOR VIDEO GAME CONSOLE

APPLN. TYPE	ENTITY STATUS	ISSUE FEE DUE	PUBLICATION FEE DUE	PREV. PAID ISSUE FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	SMALL	\$890	\$300	\$0	\$1190	02/18/2014

EXAMINER	ART UNIT	CLASS-SUBCLASS
HYLINSKI, STEVEN J	3717	463-037000

<p>1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.363).</p> <p><input type="checkbox"/> Change of correspondence address (or Change of Correspondence Address form PTO/SB/122) attached.</p> <p><input type="checkbox"/> "Fee Address" indication (or "Fee Address" Indication form PTO/SB/47; Rev 03-02 or more recent) attached. <b>Use of a Customer Number is required.</b></p>	<p>2. For printing on the patent front page, list</p> <p>(1) the names of up to 3 registered patent attorneys or agents OR, alternatively, _____ 1</p> <p>(2) the name of a single firm (having as a member a registered attorney or agent) and the names of up to 2 registered patent attorneys or agents. If no name is listed, no name will be printed. _____ 2</p> <p>_____ 3</p>
---	---

3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)

PLEASE NOTE: Unless an assignee is identified below, no assignee data will appear on the patent. If an assignee is identified below, the document has been filed for recordation as set forth in 37 CFR 3.11. Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE \_\_\_\_\_ (B) RESIDENCE: (CITY and STATE OR COUNTRY) \_\_\_\_\_

Please check the appropriate assignee category or categories (will not be printed on the patent):  Individual  Corporation or other private group entity  Government

<p>4a. The following fee(s) are submitted:</p> <p><input type="checkbox"/> Issue Fee</p> <p><input type="checkbox"/> Publication Fee (No small entity discount permitted)</p> <p><input type="checkbox"/> Advance Order - # of Copies _____</p>	<p>4b. Payment of Fee(s): (Please first reapply any previously paid issue fee shown above)</p> <p><input type="checkbox"/> A check is enclosed.</p> <p><input type="checkbox"/> Payment by credit card. Form PTO-2038 is attached.</p> <p><input type="checkbox"/> The Director is hereby authorized to charge the required fee(s), any deficiency, or credit any overpayment, to Deposit Account Number _____ (enclose an extra copy of this form).</p>
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5. **Change in Entity Status** (from status indicated above)

- Applicant certifying micro entity status. See 37 CFR 1.29
- Applicant asserting small entity status. See 37 CFR 1.27
- Applicant changing to regular undiscounted fee status.

NOTE: Absent a valid certification of Micro Entity Status (see form PTO/SB/15A and 15B), issue fee payment in the micro entity amount will not be accepted at the risk of application abandonment.

NOTE: If the application was previously under micro entity status, checking this box will be taken to be a notification of loss of entitlement to micro entity status.

NOTE: Checking this box will be taken to be a notification of loss of entitlement to small or micro entity status, as applicable.

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NOTE: The Issue Fee and Publication Fee (if required) will not be accepted from anyone other than the applicant; a registered attorney or agent; or the assignee or other party in interest as shown by the records of the United States Patent and Trademark Office.

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Authorized Signature \_\_\_\_\_

Date \_\_\_\_\_

Typed or printed name \_\_\_\_\_

Registration No. \_\_\_\_\_

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This collection of information is required by 37 CFR 1.311. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

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Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.
13/162,727 06/17/2011 Simon Burgess 0905-002 8138

52245 7590 11/18/2013
Parks IP Law LLC
730 Peachtree Street, NE
Suite 600
ATLANTA, GA 30308

EXAMINER

HYLINSKI, STEVEN J

ART UNIT PAPER NUMBER

3717

DATE MAILED: 11/18/2013

Determination of Patent Term Adjustment under 35 U.S.C. 154 (b)
(application filed on or after May 29, 2000)

The Patent Term Adjustment to date is 0 day(s). If the issue fee is paid on the date that is three months after the mailing date of this notice and the patent issues on the Tuesday before the date that is 28 weeks (six and a half months) after the mailing date of this notice, the Patent Term Adjustment will be 0 day(s).

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (http://pair.uspto.gov).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at 1-(888)-786-0101 or (571)-272-4200.

## Privacy Act Statement

**The Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.



**Notices of Allowance and Fee(s) Due mailed between October 1, 2013 and  
December 31, 2013**

(Addendum to PTOL-85)

If the "Notice of Allowance and Fee(s) Due" has a mailing date on or after October 1, 2013 and before January 1, 2014, the following information is applicable to this application.

If the issue fee is being timely paid on or after January 1, 2014, the amount due is the issue fee and publication fee in effect January 1, 2014. On January 1, 2014, the issue fees set forth in 37 CFR 1.18 decrease significantly and the publication fee set forth in 37 CFR 1.18(d)(1) decreases to \$0.

If an issue fee or publication fee has been previously paid in this application, applicant is not entitled to a refund of the difference between the amount paid and the amount in effect on January 1, 2014.

<b>Notice of Allowability</b>	<b>Application No.</b> 13/162,727	<b>Applicant(s)</b> BURGESS ET AL.	
	<b>Examiner</b> STEVEN J. HYLINSKI	<b>Art Unit</b> 3717	<b>AIA (First Inventor to File) Status</b> No

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1.  This communication is responsive to 10/14/2013.  
 A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on \_\_\_\_\_.
2.  An election was made by the applicant in response to a restriction requirement set forth during the interview on \_\_\_\_\_; the restriction requirement and election have been incorporated into this action.
3.  The allowed claim(s) is/are 1,2,4 and 6-22. As a result of the allowed claim(s), you may be eligible to benefit from the **Patent Prosecution Highway** program at a participating intellectual property office for the corresponding application. For more information, please see [http://www.uspto.gov/patents/init\\_events/pph/index.jsp](http://www.uspto.gov/patents/init_events/pph/index.jsp) or send an inquiry to [PPHfeedback@uspto.gov](mailto:PPHfeedback@uspto.gov).
4.  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

**Certified copies:**

- a)  All    b)  Some    \*c)  None of the:
1.  Certified copies of the priority documents have been received.
  2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3.  Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.  
**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5.  CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.  
 including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.  
**Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).**
6.  DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

- |  |  |
|--|--|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892)   | 5. <input type="checkbox"/> Examiner's Amendment/Comment                             |
| 2. <input type="checkbox"/> Information Disclosure Statements (PTO/SB/08),<br>Paper No./Mail Date _____    | 6. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| 3. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit<br>of Biological Material | 7. <input type="checkbox"/> Other _____.   |
| 4. <input type="checkbox"/> Interview Summary (PTO-413),<br>Paper No./Mail Date _____.                     |  |

/STEVEN J HYLINSKI/  
Primary Examiner, Art Unit 3717

### **DETAILED ACTION**

The present application is being examined under the pre-AIA first to invent provisions.

#### ***Response to Arguments***

The amendment to claim 14 to overcome the 35 USC 112(b) rejection is accepted. The 35 USC 112(b) rejection has been withdrawn.

Examiner has reviewed and accepts the 37 CFR 1.132 Affidavit of 10/14/2013 as establishing that the "Burns" publication was derived from Applicant's own invention, and is now excluded as prior art because the "Burns" publication has a 102(e) date.

#### ***Allowable Subject Matter***

The following is an examiner's statement of reasons for allowance: Claims 1-2, 4, and 6-22 are allowed because the best prior art reference of "Burns" has been excluded by a 37 CFR 1.132 showing that it was a derivation of Applicant's own invention and that the author of the "Burns" reference was not the inventor of the "Scuf Gaming" controller described in that article. None of the other prior art references cited, including the closest date-eligible reference of US 7,859,514 to Park, anticipate or suggest the invention as claimed in independent claims 1 and 22 wherein "each back control including an elongate member that extends substantially the full distance between the top edge and the bottom edge", when interpreted in the whole context of claims 1 and 22.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably


accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to STEVEN J. HYLINSKI whose telephone number is (571)270-1995. The examiner can normally be reached on Mon-Fri 9am-7pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Melba Bumgarner can be reached on (571)272-4709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/STEVEN J HYLINSKI/  
Primary Examiner, Art Unit 3717

<b>Search Notes</b>  	<b>Application/Control No.</b>  13162727	<b>Applicant(s)/Patent Under Reexamination</b>  BURGESS ET AL.
	<b>Examiner</b>  STEVEN J HYLINSKI	<b>Art Unit</b>  3717

CPC- SEARCHED		
Symbol	Date	Examiner

CPC COMBINATION SETS - SEARCHED		
Symbol	Date	Examiner

US CLASSIFICATION SEARCHED			
Class	Subclass	Date	Examiner
463	37	06/16/2012	SJH
463	37	01/17/2013	SJH

SEARCH NOTES		
Search Notes	Date	Examiner
See EAST search history.	06/16/2012	SJH
Updated East search , see search history.	01/30/2013	SJH
Updated East search , see search history.	08/07/2013	SJH

INTERFERENCE SEARCH			
US Class/ CPC Symbol	US Subclass / CPC Group	Date	Examiner
463	37	11/14/2013	SJH

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**EAST Search History**

**EAST Search History (Prior Art)**

< This search history is empty >

**EAST Search History (Interference)**

Ref #	Hits	Search Query	DBs	Default Operator	Plurals	Time Stamp
L1	1859	463/37.ccls.	US-PGPUB; USPAT; UPAD	OR	OFF	2013/11/14: 16:16
L2	1	"7859514".pn.	US-PGPUB; USPAT; UPAD	OR	OFF	2013/11/14: 16:25
L3	0	(game controller top bottom front back edge elongate).clm.	US-PGPUB; USPAT; UPAD	WITH	ON	2013/11/14: 16:47

**11/ 14/ 2013 4:47:58 PM**

**C:\ Users\ shyliniski\ Documents\ EAST\ Workspaces\ 13162727.wsp**







<b>Issue Classification</b> 	<b>Application/Control No.</b> 13162727	<b>Applicant(s)/Patent Under Reexamination</b> BURGESS ET AL.
	<b>Examiner</b> STEVEN J HYLINSKI	<b>Art Unit</b> 3717

<input type="checkbox"/> Claims renumbered in the same order as presented by applicant		<input type="checkbox"/> CPA		<input type="checkbox"/> T.D.		<input type="checkbox"/> R.1.47									
Final	Original	Final	Original	Final	Original	Final	Original	Final	Original	Final	Original	Final	Original	Final	Original
1	1	16	17												
2	2	17	18												
	3	18	19												
6	4	19	20												
	5	5	21												
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8	7														
9	8														
10	9														
11	10														
12	11														
13	12														
14	13														
15	14														
3	15														
4	16														

NONE		<b>Total Claims Allowed:</b>	
(Assistant Examiner)	(Date)	20	
/STEVEN J HYLINSKI/ Primary Examiner.Art Unit 3717	11/14/2013	O.G. Print Claim(s)	O.G. Print Figure
(Primary Examiner)	(Date)	1	1,3



## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
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## BIB DATA SHEET

CONFIRMATION NO. 8138

SERIAL NUMBER	FILING or 371(c) DATE RULE	CLASS	GROUP ART UNIT	ATTORNEY DOCKET NO.
13/162,727	06/17/2011	463	3717	0905-002
<b>APPLICANTS</b>				
<b>INVENTORS</b>				
Simon Burgess, Loughborough, UNITED KINGDOM; Duncan Ironmonger, Atlanta, GA;				
** CONTINUING DATA *****				
** FOREIGN APPLICATIONS *****				
** IF REQUIRED, FOREIGN FILING LICENSE GRANTED ** * SMALL ENTITY ** 06/28/2011				
Foreign Priority claimed	<input type="checkbox"/> Yes <input checked="" type="checkbox"/> No			
35 USC 119(a-d) conditions met	<input type="checkbox"/> Yes <input type="checkbox"/> No	<input type="checkbox"/> Met after Allowance	<b>STATE OR COUNTRY</b>	<b>SHEETS DRAWINGS</b>
Verified and	/STEVEN J HYLINSKI/ Examiner's Signature	Initials	UNITED KINGDOM	2
Acknowledged				<b>TOTAL CLAIMS</b>
				20
				<b>INDEPENDENT CLAIMS</b>
				1
<b>ADDRESS</b>				
Parks IP Law LLC 730 Peachtree Street, NE Suite 600 ATLANTA, GA 30308 UNITED STATES				
<b>TITLE</b>				
CONTROLLER FOR VIDEO GAME CONSOLE				
<b>FILING FEE RECEIVED</b> 527	FEES: Authority has been given in Paper No. _____ to charge/credit DEPOSIT ACCOUNT No. _____ for following:	<input type="checkbox"/> All Fees		
		<input type="checkbox"/> 1.16 Fees (Filing)		
		<input type="checkbox"/> 1.17 Fees (Processing Ext. of time)		
		<input type="checkbox"/> 1.18 Fees (Issue)		
		<input type="checkbox"/> Other _____		
		<input type="checkbox"/> Credit		

**PART B - FEE(S) TRANSMITTAL**

Complete and send this form, together with applicable fee(s), to: **Mail** Mail Stop ISSUE FEE  
**Commissioner for Patents**  
**P.O. Box 1450**  
**Alexandria, Virginia 22313-1450**  
**or Fax (571) 273-2885**

**INSTRUCTIONS:** This form should be used for transmitting the ISSUE FEE and PUBLICATION FEE (if required). Blocks 1 through 5 should be completed where appropriate. All further correspondence including the Patent, advance orders and notification of maintenance fees will be mailed to the current correspondence address as indicated unless corrected below or directed otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate "FEE ADDRESS" for maintenance fee notifications.

CURRENT CORRESPONDENCE ADDRESS (Note: Use Block 1 for any change of address)

**52245 7590 11/18/2013**  
**Parks IP Law LLC**  
**730 Peachtree Street, NE**  
**Suite 600**  
**Atlanta, GA 30308**

Note: A certificate of mailing can only be used for domestic mailings of the Fee(s) Transmittal. This certificate cannot be used for any other accompanying papers. Each additional paper, such as an assignment or formal drawing, must have its own certificate of mailing or transmission.

**Certificate of Mailing or Transmission**  
 I hereby certify that this Fee(s) Transmittal is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the Mail Stop ISSUE FEE address above, or being facsimile transmitted to the USPTO (571) 273-2885, on the date indicated below.

<b>Adrienne D. Miltons</b>	(Depositor's name)
<i>A. D. Miltons</i>	(Signature)
<b>12/23/13</b>	(Date)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
<b>13/162,727</b>	<b>06/17/2011</b>	<b>Simon Burgess</b>	<b>0905-002</b>	<b>8138</b>

TITLE OF INVENTION:

**Controller for Video Game Console**

APPLN. TYPE	SMALL ENTITY	ISSUE FEE	PUBLICATION FEE	TOTAL FEE(S) DUE	DATE DUE
<b>nonprovisional</b>	<b>YES</b>	<b>\$890</b>	<b>\$300</b>	<b>\$1190</b>	<b>02/18/2014</b>

EXAMINER	ART UNIT	CLASS-SUBCLASS
<b>Hyllinski, Steven J</b>	<b>3717</b>	<b>463-037000</b>

1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.363).  
 Change of correspondence address (or Change of Correspondence Address form PTO/SB/122) attached.  
 "Fee Address" indication (or "Fee Address" Indication form PTO/SB/47; Rev. 03-02 or more recent) attached. Use of a Customer Number is required.

2. For printing on the patent front page, list  
 (1) the names of up to 3 registered patent attorneys or agents OR, alternatively, 1 **Parks IP Law LLC**  
 (2) the name of a single firm (having as a member a registered attorney or agent) and the names of up to 2 registered patent attorneys or agents. If no name is listed, no name will be printed. 2 \_\_\_\_\_  
 3 \_\_\_\_\_

3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)

PLEASE NOTE: Unless an assignee is identified below, no assignee data will appear on the patent. If an assignee is identified below, the document has been filed for recordation as set forth in 37 CFR 3.11. Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE  
**Ironburg Inventions LTD.**

(B) RESIDENCE: (CITY and STATE OR COUNTRY)  
**United Kingdom**

Please check the appropriate assignee category or categories (will not be printed on the patent):  Individual  Corporation or other private group entity  Government

4a. The following fee(s) are enclosed:  
 Issue Fee  
 Publication Fee (No small entity discount permitted)  
 Advance Order - # of Copies 1

4b. Payment of Fee(s):  
 A check in the amount of the fee(s) is enclosed.  
 Payment by credit card. Form PTO-2038 is attached.  
 The Director is hereby authorized by charge the required fee(s), or credit any overpayment, to Deposit Account Number 50-3447 (enclose an extra copy of this form).

5. Change in Entity Status (from status indicated above)

a. Applicant claims SMALL ENTITY status. See 37 CFR 1.27.  b. Applicant is no longer claiming SMALL ENTITY status. See 37 CFR 1.27(g)(2).

The Director of the USPTO is requested to apply the Issue Fee and Publication Fee (if any) or to re-apply any previously paid issue fee to the application identified above.  
 NOTE: The Issue Fee and Publication Fee (if required) will not be accepted from anyone other than the applicant; a registered attorney or agent; or the assignee or other party in interest as shown by the records of the United States Patent and Trademark Office.

Authorized Signature /Stephen J. Terrell/

Date December 23, 2013

Typed or printed name Stephen J. Terrell

Registration No. 62734

This collection of information is required by 37 CFR 1.311. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

## Electronic Patent Application Fee Transmittal

<b>Application Number:</b>	13162727			
<b>Filing Date:</b>	17-Jun-2011			
<b>Title of Invention:</b>	CONTROLLER FOR VIDEO GAME CONSOLE			
<b>First Named Inventor/Applicant Name:</b>	Simon Burgess			
<b>Filer:</b>	Stephen J. Terrell/Adrienne Mittons			
<b>Attorney Docket Number:</b>	0905-002			
Filed as Small Entity				
<b>Utility under 35 USC 111(a) Filing Fees</b>				
<b>Description</b>	<b>Fee Code</b>	<b>Quantity</b>	<b>Amount</b>	<b>Sub-Total in USD(\$)</b>
<b>Basic Filing:</b>				
<b>Pages:</b>				
<b>Claims:</b>				
<b>Miscellaneous-Filing:</b>				
<b>Petition:</b>				
<b>Patent-Appeals-and-Interference:</b>				
<b>Post-Allowance-and-Post-Issuance:</b>				
Utility Appl Issue Fee	2501	1	890	890
Publ. Fee- Early, Voluntary, or Normal	1504	1	300	300

Description	Fee Code	Quantity	Amount	Sub-Total in USD(\$)
<b>Extension-of-Time:</b>				
<b>Miscellaneous:</b>				
<b>Total in USD (\$)</b>				<b>1190</b>

## Electronic Acknowledgement Receipt

<b>EFS ID:</b>	17745626
<b>Application Number:</b>	13162727
<b>International Application Number:</b>	
<b>Confirmation Number:</b>	8138
<b>Title of Invention:</b>	CONTROLLER FOR VIDEO GAME CONSOLE
<b>First Named Inventor/Applicant Name:</b>	Simon Burgess
<b>Customer Number:</b>	52245
<b>Filer:</b>	Stephen J. Terrell/Adrienne Mittons
<b>Filer Authorized By:</b>	Stephen J. Terrell
<b>Attorney Docket Number:</b>	0905-002
<b>Receipt Date:</b>	23-DEC-2013
<b>Filing Date:</b>	17-JUN-2011
<b>Time Stamp:</b>	16:27:34
<b>Application Type:</b>	Utility under 35 USC 111(a)

### Payment information:

Submitted with Payment	yes
Payment Type	Credit Card
Payment was successfully received in RAM	\$1190
RAM confirmation Number	4138
Deposit Account	
Authorized User	

### File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
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1	Issue Fee Payment (PTO-85B)	0905-002IF.pdf	91628 cf6353582f986a485f642337f6076b5561108aac	no	1
<b>Warnings:</b>					
<b>Information:</b>					
2	Fee Worksheet (SB06)	fee-info.pdf	31883 63ad10a7e4899d5a03cab2082befde428d05c99b	no	2
<b>Warnings:</b>					
<b>Information:</b>					
<b>Total Files Size (in bytes):</b>				123511	
<p><b>This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.</b></p> <p><b><u>New Applications Under 35 U.S.C. 111</u></b>  <b>If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.</b></p> <p><b><u>National Stage of an International Application under 35 U.S.C. 371</u></b>  <b>If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.</b></p> <p><b><u>New International Application Filed with the USPTO as a Receiving Office</u></b>  <b>If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.</b></p>					



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APPLICATION NO.	ISSUE DATE	PATENT NO.	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/162,727	02/04/2014	8641525	0905-002	8138

52245 7590 01/15/2014  
Parks IP Law LLC  
730 Peachtree Street, NE  
Suite 600  
ATLANTA, GA 30308

**ISSUE NOTIFICATION**

The projected patent number and issue date are specified above.

**Determination of Patent Term Adjustment under 35 U.S.C. 154 (b)**  
(application filed on or after May 29, 2000)

The Patent Term Adjustment is 0 day(s). Any patent to issue from the above-identified application will include an indication of the adjustment on the front page.

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (<http://pair.uspto.gov>).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Application Assistance Unit (AAU) of the Office of Data Management (ODM) at (571)-272-4200.

APPLICANT(s) (Please see PAIR WEB site <http://pair.uspto.gov> for additional applicants):

Simon Burgess, Loughborough, UNITED KINGDOM;  
Duncan Ironmonger, Atlanta, GA;

The United States represents the largest, most dynamic marketplace in the world and is an unparalleled location for business investment, innovation, and commercialization of new technologies. The USA offers tremendous resources and advantages for those who invest and manufacture goods here. Through SelectUSA, our nation works to encourage and facilitate business investment. To learn more about why the USA is the best country in the world to develop technology, manufacture products, and grow your business, visit [SelectUSA.gov](http://SelectUSA.gov).



## PATENT ASSIGNMENT COVER SHEET

Electronic Version v1.1  
 Stylesheet Version v1.2

EPAS ID: PAT2983051

<b>SUBMISSION TYPE:</b>	NEW ASSIGNMENT
<b>NATURE OF CONVEYANCE:</b>	SECURITY INTEREST
<b>CONVEYING PARTY DATA</b>	
<b>Name</b>	<b>Execution Date</b>
IRONBURG INVENTIONS LIMITED	07/31/2014

<b>RECEIVING PARTY DATA</b>	
<b>Name:</b>	CHATHAM CAPITAL MANAGEMENT IV, LLC
<b>Street Address:</b>	400 GALLERIA PARKWAY
<b>Internal Address:</b>	SUITE 1950
<b>City:</b>	ATLANTA
<b>State/Country:</b>	GEORGIA
<b>Postal Code:</b>	30339

<b>PROPERTY NUMBERS Total: 20</b>	
Property Type	Number
Application Number:	61910176
Application Number:	61826087
Application Number:	61910260
Application Number:	61910168
Application Number:	61930065
Application Number:	61882171
Application Number:	61935898
Application Number:	13162727
Application Number:	14141840
Application Number:	13163368
Application Number:	13910409
Application Number:	13910427
Application Number:	61844548
Application Number:	29394525
Application Number:	29425268
Application Number:	29451960
Application Number:	29481483
Application Number:	29480547
Application Number:	29480182
Application Number:	29480396

**CORRESPONDENCE DATA****Fax Number:**

*Correspondence will be sent to the e-mail address first; if that is unsuccessful, it will be sent using a fax number, if provided; if that is unsuccessful, it will be sent via US Mail.*

**Phone:** 404-685-4269  
**Email:** rlockwood@burr.com  
**Correspondent Name:** ROBERT LOCKWOOD  
**Address Line 1:** 171 SEVENTEENTH STREET, NW  
**Address Line 2:** SUITE 1100  
**Address Line 4:** ATLANTA, GEORGIA 30363

<b>ATTORNEY DOCKET NUMBER:</b>	0017224.0000025
<b>NAME OF SUBMITTER:</b>	ROBERT LOCKWOOD
<b>SIGNATURE:</b>	/Robert Lockwood/
<b>DATE SIGNED:</b>	08/15/2014
	This document serves as an Oath/Declaration (37 CFR 1.63).

**Total Attachments: 3**

source=Scuf Gaming -- Assignment for Security - Patents#page1.tif  
source=Scuf Gaming -- Assignment for Security - Patents#page2.tif  
source=Scuf Gaming -- Assignment for Security - Patents#page3.tif

## ASSIGNMENT FOR SECURITY --PATENTS

WHEREAS, IRONBURG INVENTIONS LIMITED, a private limited company incorporated in England and Wales (the "Grantor") holds all right, title and interest in the letter patents, design patents and utility patents listed on the attached Schedule A, which patents are issued or applied for in the United States Patent and Trademark Office (the "Patents");

WHEREAS, the Grantor has entered into a Pledge and Security Agreement, dated July 31, 2014 (as amended, restated, supplemented, modified or otherwise changed from time to time, the "Security Agreement"), in favor of Chatham Capital Management IV, LLC, a Georgia limited liability company, as the Collateral Agent for itself and certain lenders (in such capacity, together with its successors and assigns, if any, the "Grantee"); and

WHEREAS, pursuant to the Security Agreement, the Grantor has granted to the Grantee, and granted to the Grantee for the benefit of the Secured Parties (each such term as defined in the Security Agreement), a continuing security interest in all right, title and interest of the Grantor in, to and under the Patents and the applications and registrations thereof, and all proceeds thereof, including, without limitation, any and all causes of action which may exist by reason of infringement thereof and any and all damages arising from past, present and future violations thereof (the "Collateral"), to secure the payment, performance and observance of the Secured Obligations (as defined in the Security Agreement).

NOW, THEREFORE, for good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, the Grantor does hereby pledge and collaterally assign to the Grantee for the benefit of the Secured Parties, a continuing security interest in the Collateral to secure the prompt payment, performance and observance of the Secured Obligations.

The Grantor does hereby further acknowledge and affirm that the rights and remedies of the Grantee with respect to the Collateral are more fully set forth in the Security Agreement, the terms and provisions of which are hereby incorporated herein by reference as if fully set forth herein.

Exh. B-1

21251929 v1

IN WITNESS WHEREOF, the Grantor has caused this Assignment to be duly executed by its officer thereunto duly authorized as of July 31, 2014.

IRONBURG INVENTIONS LIMITED

By: [Signature]  
Name: DUNCAN IRONMONGER  
Title: CEO

STATE OF GEORGIA  
ss.:  
COUNTY OF FULTON

On this 1st day of August, 2014, before me personally came DUNCAN IRONMONGER to me known to be the person who executed the foregoing instrument, and who, being duly sworn by me, did depose and say that ~~s~~he is the CEO of IRONBURG INVENTIONS LIMITED, a GB PRIVATE LTD. CO., and that ~~s~~he executed the foregoing instrument in the firm name of IRONBURG INVENTIONS LIMITED, and that ~~s~~he had authority to sign the same, and ~~s~~he acknowledged to me that he executed the same as the act and deed of said firm for the uses and purposes therein mentioned.

Peggy L. Davis  
[NOTARY SEAL]  
PEGGY L. DAVIS  
NOTARY  
EXPIRES  
GEORGIA  
Jan. 30, 2018  
PUBLIC  
FULTON COUNTY

Exh. B-2

SCHEDULE A TO ASSIGNMENT FOR SECURITY

**Ironburg Inventions Limited - U.S. Patents**

OUR REF	FILING DATE	APPLICATION NO.	TITLE	STATUS
PUS1311169	29/11/2013	US61/910,176	INTERCHANGEABLE CONTROL COMPONENTS	PROVISIONAL PATENT
PUS1311048	22/05/2013	US61/826,087	CONTROLLER FOR A GAMES CONSOLE	PROVISIONAL PATENT
PUS1311174	29/11/2013	US61/910,260	X BOX HAIR TRIGGER STOP	PROVISIONAL PATENT
PUS1311084	29/11/2013	US61/910,168	BIOMECHANICS CONTROLLER	PROVISIONAL PATENT
PUS1411200	22/01/2014	US61/930,065	X BOX ONE GRIP MOUNTED HAIR TRIGGER	PROVISIONAL PATENT
PUS1311121	25/09/2013	US61/882,171	PADDLE SADDLE	PROVISIONAL PATENT
PUS1411195	05/02/2014	US61/935,898	CONTROLLER FOR A GAMES CONSOLE, TOOL AND A METHOD THEREFOR	PROVISIONAL PATENT
FPUS1110630	17/06/2011	US13/162,727	CONTROLLER FOR VIDEO GAME CONSOLE	UTILITY PATENT
FPUS1410630CON	27/12/2013	US14/141,840	CONTROLLER FOR VIDEO GAME CONSOLE	UTILITY PATENT
FPUS1110629	17/06/2011	US13/163,368	GAME CONTROLLER	UTILITY PATENT
FPUS1310629DIV1	05/06/2013	US13/910,409	GAME CONTROLLER	UTILITY PATENT
FPUS1310629DIV2	05/06/2013	US13/910,427	GAME CONTROLLER	UTILITY PATENT
FPUS1311038	10/07/2013	US61/844,548	GAMES CONTROLLER AND TRIGGER THEREFOR	PROVISIONAL PATENT
FDUS1110633	17/06/2011	US29/394,525	GAME CONTROLLER	DESIGN PATENT
FDUS1210633DIV	21/06/2012	US29/425,268	GAME CONTROLLER	DESIGN PATENT
FDUS1310633DIV1	10/04/2013	US29/451,960	GAME CONTROLLER	DESIGN PATENT
DUS1411202		US29/481,483	TRIGGER STOP	DESIGN PATENT
DUS1411203	27/01/2014	US29/480,547	X BOX ONE BATTERY HATCH	DESIGN PATENT
DUS1411204	23/01/2014	US29/480,182	X BOX ONE GRIPS	DESIGN PATENT
DUS1411205	24/01/2014	US29/480,396	PS 4 BACK PANEL	DESIGN PATENT
PUS1311047			MAGNETIC MOTION POT	PATENT

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 IPR2016-00948  
Patent 8,641,525

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

KAUFFMAN, *Administrative Patent Judge*.

DECISION

Institution of *Inter Partes* Review

37 C.F.R. § 42.108

## I. INTRODUCTION

### A. OVERVIEW

Valve Corporation (“Petitioner”) filed a corrected Petition (Paper 4, “Pet.”) requesting *inter partes* review of claims 1–20 of U.S. Patent No. 8,641,525 B2 (Ex. 1001, “the ’525 patent”). Pet. 1. Ironburg Inventions Ltd. (“Patent Owner”) filed a Preliminary Response (Paper 7, “Prelim. Resp.”) to the Petition.

Upon consideration of the Petition and the Preliminary Response, 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 1–11, 13, 14, and 16–20 of the ’525 patent. We do not institute review of claims 12 and 15.

### B. RELATED PROCEEDINGS

The parties indicate that the ’525 patent is at issue in: *Ironburg Inventions Ltd. v. Valve Corp.*, Case No. 1:15-cv-04219-MHC (N.D. Ga.). Pet. 1; Paper 6, 1.

Petitioner also filed a petition against U.S. Patent 9,089,770 B2 (“the ’770 patent”), the subject of *inter partes* review IPR2016-00949 (“the ’949 IPR”). The ’770 patent issued from an application that was a continuation of application 13/162,727, now the ’525 patent.

## II. PRELIMINARY MATTERS

### A. PETITIONER'S CLAIM INTERPRETATIONS

Patent Owner asks that we dismiss the Petition because Petitioner's claim interpretations are the "bald conclusions of its expert," made without utilizing the intrinsic record as required. Prelim. Resp. 9–10, 16.

Pursuant to 37 C.F.R. § 42.104(b)(3), the Petition is to include a statement of how each challenged claim is to be construed. The Office Patent Trial Practice Guide ("Practice Guide") states that, "it may be sufficient for a party to provide a simple statement that the claim terms are to be given their broadest reasonable interpretation, as understood by one of ordinary skill in the art and consistent with the disclosure." 77 Fed. Reg. 48764 (Aug. 14, 2012). Here, Petitioner explicitly construes some terms and asserts that the remaining terms carry their ordinary and customary meaning. Pet. 11–17. Such an assertion is consistent with an assertion that the claims should be given their broadest reasonable interpretation. Consequently, we do not dismiss the Petition on this basis.

Somewhat relatedly, Patent Owner contends that the Petition should be denied because it argues that the written description requirement of 35 U.S.C. § 112 is not met. Prelim. Resp. 8 (citing Pet. 12, 15, and 43). We agree with Patent Owner that a petitioner in an *inter partes* review may not assert a ground of unpatentability based on 35 U.S.C. § 112. 35 U.S.C. § 311(b); Prelim. Resp. 8. Here, Petitioner addresses an alleged lack of written description in the context of construing claim limitations, and does not assert a ground of unpatentability based on 35 U.S.C. § 112. *See* Pet.



Accordingly, we do not deny the Petition for asserting an unauthorized ground of unpatentability because no such ground was asserted.

B. LEVEL OF SKILL IN THE ART

Petitioner contends that patent examiners are persons of ordinary skill in the relevant art, and provides a statement from Mr. Brendan Donohoe, a patent examiner in the United Kingdom (UK), regarding examination of the UK counterpart to the '770 patent. Pet. 9–11. In that statement, Mr. Donohoe contends that it was well known to modify gamepads to suit the requirements of a particular game or gamer, and that the features claimed were typical features. Ex. 1007 ¶¶ 5–7.

Patent Owner asks that we dismiss the Petition because Petitioner has failed to establish the level of skill in the art. Prelim. Resp. 28. According to Patent Owner, Petitioner's statements from a UK examiner are inadmissible hearsay and are not prior art.<sup>1</sup> *Id.* Patent Owner asks that we exclude this section of the Petition in its entirety. *Id.*

As an initial matter, we observe that Petitioner has not explained persuasively how observations from a UK patent examiner, which presumably are based on UK law and not United States law, are of use in our proceeding. Despite this shortcoming, we do not dismiss the Petition as

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<sup>1</sup> We agree that Mr. Donohoe's statement is not a prior art publication. Nevertheless, Mr. Donohoe's statement, which appears to have been made on May 16, 2011, before the June 17, 2011, filing date of the '525 patent, may be probative of the level of skill in the art at the time of invention. Ex. 1007, 1; Ex. 1001 (22). We do not express any opinion at this time regarding the admissibility of Mr. Donohoe's statement as evidence.

Patent Owner requests, because an explicit definition of the level of skill is not required, where, as here, the prior art of record is indicative of the level of skill in the art. *See, e.g., Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001).

Patent Owner's assertion that Dr. Donohoe's statements are inadmissible hearsay is premature. Rule 42.64 provides the framework for Patent Owner to object to information proffered as evidence and move to exclude objectionable material from evidence during the trial. *See* 37 C.F.R. § 42.64.

If the parties further develop this issue, we ask that the parties focus on the role the level of skill in the art plays in an obviousness analysis. *See Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966); *Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (The “level of skill in the art is a prism or lens through which a judge, jury, or the Board views the prior art and the claimed invention.”); *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718 (Fed. Cir. 1991) (“The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry”).

### III. THE CLAIMED SUBJECT MATTER

#### A. INTRODUCTION

The '525 patent relates to hand held controllers for video game consoles. Ex. 1001, 1:6–7.

As background, the '525 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 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 '525 patent was intended to address this problem. *Id.* at 1:41–45.

Controller 10 of the '525 patent includes a plurality of controls on the front and 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). Figure 2 follows:

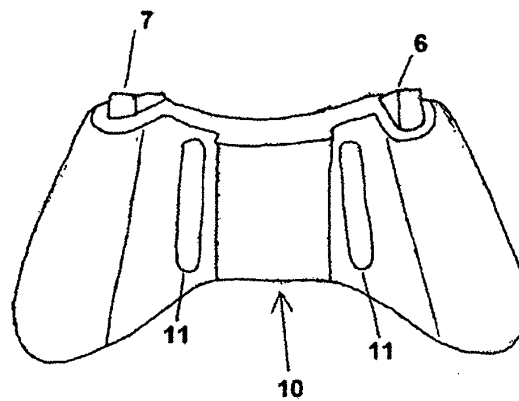


Figure 2

Figure 2 is a schematic illustration of the back of game controller 10. *Id.* at 2:63–64.

#### B. ILLUSTRATIVE CLAIM

Of the challenged claims, 1 and 20 are independent. Claim 1 follows:

1. A hand held controller for a game console comprising:  
an outer case comprising a front, a back, a top edge, and a bottom edge, wherein the back of the controller is opposite the

front of the controller and the top edge is opposite the bottom edge; and

a front control located on the front of the controller;

wherein the controller is shaped to be held in the hand of a user such that the user's thumb is positioned to operate the front control; and

a first back control and a second back control, each back control being located on the back of the controller and each back control including an elongate member that extends substantially the full distance between the top edge and the bottom edge and is inherently resilient and flexible.

#### C. CLAIM INTERPRETATION

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 following claim terms 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).

We emphasize that these claim interpretations are preliminary. During the remainder of this proceeding, the parties are permitted to develop argument and evidence regarding claim interpretation as appropriate.

1. *Directional References (all claims)*

The claims recite words indicating relative position or direction such as “front,” “back,” “top,” and “bottom” without expressly stating a frame of reference for interpreting these words. Because the claims do not recite an express frame of reference for these words, Petitioner contends that any frame of reference may apply such that: (1) any side of the video controller may be considered the “back,” and another side as the “front,” so long as the “back is opposite the front,” as required by claim 1, and (2) any edge may be considered as a “top” edge so long as it is opposite the “bottom” edge. Pet. 11–12 (citing Ex. 1001, 4:28–32).

A “claim term will not receive its ordinary meaning if the patentee acted as his own lexicographer and clearly set forth a definition of the disputed claim term in either the specification or prosecution history.” *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002). Such definitions must be set forth with reasonable clarity, deliberateness, and precision. *In re Paulsen*, 30 F.3d 1475 1480 (Fed. Cir. 1994). Here, we agree with Petitioner that the ’525 patent explicitly states that directional words, such as front, back, top, and bottom, merely serve to distinguish those features from one another and do not limit the respective features to a particular static orientation. *See* Pet. 11–12; Ex. 1001, 4:28–32. Consequently, the ’525 patent has supplanted the ordinary meaning of directional references.

We interpret directional words in the claims to be terms that merely distinguish one feature from another and define positions relative to each

other. For example, the “front” is opposite the “back,” and the “top” is opposite the “bottom.”

Claim 13 requires additional analysis. Claim 13 depends from claim 1 and recites, “wherein the elongate members converge towards the front end of the controller with respect to one another.”

It is unclear how this claim should be construed. First, the claim term “the front end” has no antecedent basis. Independent claim 1 recites a “front” and a “top edge,” but does not recite a “front end” or “end.” Second, claim 13 appears to use the term “front” in two manners: one, to mean the portion of the controller opposite the back and having front controls, and two, to identify a portion of the end of the controller (i.e., the “front end”) shown in Figure 2 towards which the elongated members converge.

The Specification sheds little light on proper interpretation of this limitation. The summary of the invention portion of the Specification describes that the elongate members may converge towards the “front end” of the controller, Ex. 1001, 2:4–7, but the detailed description of the invention portion of the Specification does not describe such an embodiment, *id.* at 3:1–4:38. Rather, the detailed description portion of the Specification describes that elongate members, in the form of paddles 11, may be oriented so that they converge towards the “top edge.” *Id.* at 2:63–64; 3:14–15, 54–56; Fig. 2 (depicting the “back” of the controller).

We ask that the parties further address proper interpretation of claim 13 at trial.

2. *Thickness (claims 9–11)*

Independent claim 1 is directed to a hand held controller that includes a first and second back control, each back control including an inherently resilient and flexible elongate member that extends substantially the full distance between the top and bottom edge of the controller. Claims 9–11 each depend from independent claim 1, and add a “thickness” range for the elongate member (*e.g.*, claim 9 specifies the elongate member has a thickness between about 1 and 10 mm).

Petitioner contends that the ’525 patent does not depict the thickness of the elongate member as required by 35 U.S.C. § 112 and 37 C.F.R. § 1.83(a). Pet. 12–13. Mr. Rempel, opines that a person of ordinary skill in the art reading the ’525 patent could not distinguish thickness from width. Ex. 1008 ¶ 12. Based on this, Petitioner asserts that the claim term “thickness” is vague and ambiguous. Pet. 12–13. Petitioner’s patentability analysis assumes that “thickness” corresponds to any dimension of the elongate member except for length. *Id.* at 13.

Patent Owner submits the claim term “thickness” is a common term in the English language and needs no express interpretation. Prelim. Resp. 10–11 (citing two non-precedential Board cases).

For the reasons that follow, we disagree with Petitioner’s contention that thickness as claimed corresponds to any dimension of the elongate member other than length.

The ’525 patent describes that the elongate members (*e.g.*, paddles 11) are inherently resilient and flexible to permit displacement by the user to activate control function. Ex. 1001, 1:59–61; *see also* 2:8–11 (describing

that preferably displacement of the elongate member activates the switch mechanism). The '525 patent describes that preferably, paddles 11 are less than 10 mm thick, but may be less than 5 mm thick, and more preferably are 3 mm thick or less. *Id.* at 3:28–32; *see also* 2:1–3 (describing preferred thickness ranges); 3:28–30 (describing that paddles 11 are formed from a thin flexible material such as plastics). Consequently, the '525 patent describes that the elongate members are resilient and flexible to permit displacement of the elongate member, and advantageously the members are thin (less than 10 mm and more preferably 3 mm or less).

A person of ordinary skill in the art would understand that a user's finger displaces the elongate members to activate the controls in the direction in which the thickness of the elongate member (perpendicular to the surface of the elongate member) would be measured.

The broadest reasonable interpretation of “thickness” as used in claims 9–11 is the dimension of the elongate member perpendicular to the surface of the elongate member (i.e., also the direction of displacement when the user activates the control function).

3. *Extension of the Elongate Members (all claims)*

Independent claims 1 and 20 recite that each elongate member on the back of the controller “extends substantially the full distance between the top edge and the bottom edge” of the controller. Claims 2–19 include this limitation by virtue of dependence from claim 1.

The use of the term “substantially” in claims 2, 17, and 20 does not shed additional light on the meaning of the term. The '525 patent is the parent of the '770 patent, and consequently we seek to construe claim terms



consistently across the patents. *See NTP Inc., v. Research in Motion, Ltd.*, 418 F.3d 1282, 1293 (Fed. Cir. 2005) (When construing claims in patents that derive from the same parent application and share common terms, “we must interpret the claims consistently across all asserted patents.”). Claim 1 of the ’770 patent requires that the elongate member extends at least half of a first distance between the top and bottom edge of the outer case along the longitudinal axis of the elongate member. Dependent claim 2 adds that the elongate member extends along “substantially” all of the first distance. Claim 2 further limits claim 1, and supports the interpretation that “substantially” all the first distance is more than at least half that distance.

The Specification echoes the claim language, describing that elongate members in the form of paddles 11 “substantially extend in a direction from the top edge to the bottom edge of controller 10.” Ex. 1001, 3:51–53. Paddles 11 are depicted extending largely, but not wholly the entire distance from the top to the bottom edge of the controller. Fig. 2.

“Substantially” is often used to mean, “largely but not wholly what is specified.” *See, e.g., York Products, Inc., v. Central Tractor Farm & Family Center*, 99 F.3d 1568, 1572–73 (Fed. Cir. 1996); *Amhil Enterprises Ltd. v. Wawa, Inc.*, 81 F.3d, 1554, 1562, (Fed. Cir. 1996)). We do not apply this interpretation as a *per se* rule. We are mindful that the claim term “substantially” can render a claim indefinite. *See generally Ex parte Lazzara*, 2007 WL 7751836, Appeal No. 2007-0192 (PTAB May 30, 2007) (informative), *rehearing denied*, 2007 WL 5063473 (Nov. 13, 2007) (providing an overview of use of the claim term “substantially”). Here, the Specification does not provide a special meaning for the term, nor have the

parties identified any relevant portion of the prosecution history. The use of the term to modify “the full distance” does not render the phrase so unclear that there is no means to ascertain the scope. Interpreting “substantially” to mean, “largely but not wholly what is specified” is consistent with the Specification as discussed above.

We preliminarily construe the claims to require that the elongate members extend largely but not necessarily the entire distance between the top and the bottom edges.

4. *Inherently Resilient and Flexible (claims 1–19)*

Claim 1 recites that the elongate member is “inherently resilient and flexible.” Claims 2–19 include this limitation by virtue of dependence from claim 1. Claim 20 does not recite this limitation.

Petitioner contends that “flexible” means that the elongated member may be moved to a biased position by a user’s finger and contends that “inherently resilient” is expressly defined in the ’525 patent as returning to an unbiased position when not under load. Pet. 14. Based on this, Petitioner contends that “inherently resilient and flexible” as claimed means that the elongate member “can be moved to a biased position by a user’s finger, and returns to an unbiased position when not under load.” Pet. 14.

Patent Owner contends that this claim term needs no express interpretation. Prelim. Resp. 12. Patent Owner contends that Petitioner proffers no reasonable basis to depart from the plain and ordinary meanings of “inherently resilient” and “flexible,” but Patent Owner does not specify the plain and ordinary meaning of either term.

Petitioner is correct that the '525 patent expressly defines that elongate members (paddles 11) are “inherently resilient, which means that they return to an unbiased position when not under load.” Ex. 1001, 3:34–35; Pet. 14.

Regarding “flexible,” as explained above, the '525 patent describes that the elongate members (paddles 11) are inherently resilient and flexible to permit displacement by the user to activate control function. Therefore, the '525 patent describes that the elongate members are flexible in that they permit displacement. An ordinary meaning of “flexible” is “capable of being bent or flexed.” Ex. 3001, 1 (adj., def. 1.a.). This meaning is consistent both with the context of the claim and with the specification.

An elongate member as claimed is inherently resilient and flexible in that it may be bent or flexed by a load, such as that from a user’s finger, and will then return to its unbiased position when not under load.

5. *Recess (claims 7, 8)*

Claim 7 depends from claim 1 and recites, “wherein each elongate member is mounted within a recess located in the case of the controller.” Because elongate members are “located on the back of the controller” (claim 1), the recess that those elongate members are mounted within is also located on the back of the controller. Claim 8 depends from claim 7 and adds that a user’s finger may be received in the recess.

Petitioner “assumes that any region between a first and second handle that is recessed *towards the front* of the video game controller can qualify as a ‘recess’” as claimed. Pet. 15 (emphasis added).

Patent Owner contends that the term “recess” carries its ordinary meaning and needs no express interpretation. Prelim. Resp. 13–14. Patent Owner does not specify that plain and ordinary meaning.

We disagree with Petitioner’s assertion that a recess as claimed must be recessed towards the front of the controller. Neither the claim language, nor the ordinary meaning of the term supports such an interpretation. In the ’770 patent, claim 7 depends from claim 6 and requires that the recess portion is recessed towards the front, implying that the recessed portion of claim 6 includes no such limitation. Neither the Specification of the ’525 patent nor that of the ’770 patent provides a lexicographical definition of a “recess” or a “recessed portion,”

The claims require that the recess be located on the back of the controller, but the claims are not limited to a specific contour of the surface of the back of the controller. Consequently, the claims are broad enough to cover a configuration in which the recess is on the back, but because of the shape of that back surface the recess is not towards the front of the controller.

We do not construe a “recess” as claimed to be limited to a recess towards the front of the controller.

6. *Elongate Member as a Paddle Lever (claim 16)*

Claim 16 depends from claim 1, and recites, “wherein at least one of the back controls is a paddle lever.”

Petitioner contends that “one of ordinary skill in the art would have generally considered prior art buttons, triggers, and other control members to

qualify as a ‘paddle lever’ in the context of the ’525 patent when it was filed.” Pet. 16.

Patent Owner contends that the ordinary meaning of “paddle lever” should be used, and that one of ordinary skill in the art would know that ordinary meaning. Prelim. Resp. 15–16. Patent Owner, thus, contends that “no further elaboration, expansion or restriction” is required. *Id.*

Claim 1 requires a first and second back control that each include an elongate member, and claim 16 depends from claim 1 and limits at least one of the back controls to take the form of a paddle lever. Given, this, to the extent that Petitioner argues that an “elongate member” as recited in claim 1 may take various forms, such as a button or trigger, we agree. However, we do not agree that any button, trigger, or control member qualifies as a “paddle lever” as recited in claim 16.

#### IV. PATENTABILITY

##### A. EVIDENCE AND ASSERTED GROUNDS OF UNPATENTABILITY

Petitioner asserts the following grounds of unpatentability:

<b>Claim(s) Challenged</b>	<b>Basis</b>	<b>References(s)</b>
1, 6, 13, 14, 16, 17, 19, and 20	§ 102(b)	Tosaki <sup>2</sup>
1–11, 13, 16, 17, and 20	§ 103(a)	Enright <sup>3</sup> and Tosaki
14, 15, and 19	§ 103(a)	Enright, Tosaki, and Ono <sup>4</sup>
2, 4, 5, 7, 8, 12, 14–16, and 19	§ 103(a)	Tosaki and Jimakos <sup>5</sup>
18	§ 103(a)	Enright, Tosaki, and Oelsch <sup>6</sup>

Pet. 3.

Petitioner includes the Declaration of Dr. David Rempel, M.D.  
(Ex. 1008).<sup>7</sup>

**B. ANTICIPATION BY TOSAKI**

Petitioner contends that claims 1, 6, 13, 14, 16, 17, 19, and 20 are unpatentable under 35 U.S.C. § 102(b) as anticipated by Tosaki (Ex. 1002).

Pet. 18–29.

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<sup>2</sup> U.S. Patent 5,989,123, published Nov. 23, 1999 (Ex. 1002).

<sup>3</sup> U.S. Pub. 2010/0073283 A1, published Mar. 25, 2010 (Ex. 1003).

<sup>4</sup> U.S. Pub. 2001/0025778 A1, published Oct. 4, 2001 (Ex. 1004).

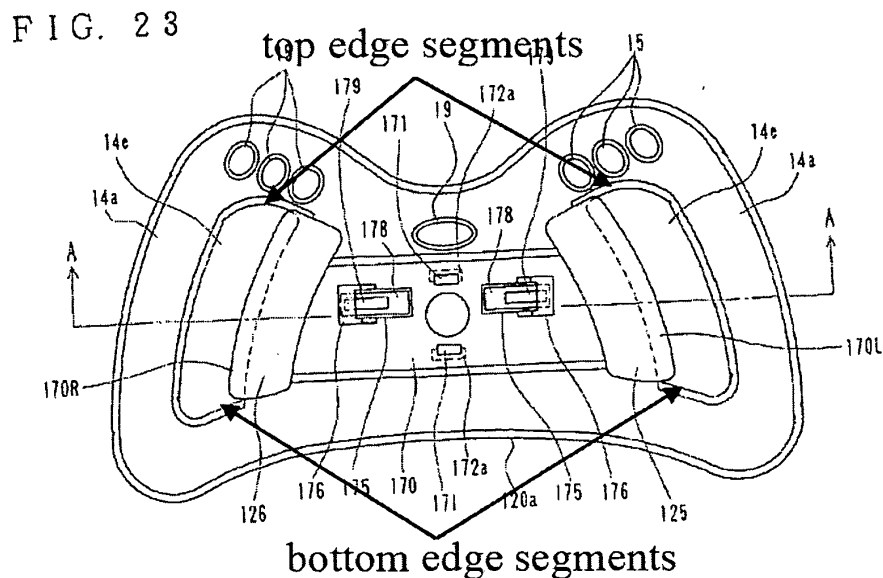
<sup>5</sup> “Rapid Fire Mod for Wireless Xbox 360 Controller, Step by Step Tutorial with Pictures,” posts 341-346 by Jimakos Sn, published 09 July, 2008, at <http://forums.xbox-scene.com/index.php?/topic/643928-rapid-fire-mod-forwireless-xbox-360-controller/page-23> and at <http://forums.xboxscene.com/index.php?/topic/643928-rapid-fire-mod-for-wireless-xbox-360-controller/page-24> (Ex. 1005).

<sup>6</sup> U.S. Patent 4,032,728, published June 28, 1977 (Ex. 1006).

<sup>7</sup> The cover page of this Exhibit is not numbered and the following page begins as page 1.

1. *Claim 1*

Petitioner contends that Tosaki's hand held controller includes an outer case comprised of a front (outer surface of front casing 120a) opposite a back (outer surface of back casing 120b). Pet. 19 (citing Ex. 1002, Figs. 6, 7, 23, 24). Petitioner contends that Tosaki's controller includes a top edge opposite a bottom edge as claimed. Pet. 19–20 (providing an annotated version of Tosaki's Figure 23). A version of Tosaki's Figure 23 bearing Petitioner's annotations follows:



Annotated Figure 23 is a diagram of a steering wheel with arrows and labels identifying “top edge segments” and “bottom edge segments” as corresponding a top edge and a bottom edge as claimed. Pet. 19–20; Ex. 1002, Fig. 23.

Patent Owner contends that Tosaki does not include a front, back, top edge, and a bottom edge as claimed. Prelim. Resp. 20. Patent Owner adds

that the “segments” identified by Petitioner are near the center of the wheel and are not at the top or bottom edge as claimed. *Id.* As explained above, directional references in the ’525 patent merely serve to distinguish features from one another in a relative sense, and do not limit respective features to a static orientation. *See* Ex. 1001, 4:26–31. Consequently, Patent Owner’s argument is unpersuasive.

Petitioner contends that Tosaki discloses a front control (push button switch 15) located on the outer case of the controller that is shaped to be held in the hand of a user such that the user’s thumb is positioned to operate the front control. Pet. 20 (Ex. 1002, 3:25–34; 9:47–53). Petitioner contends that Tosaki discloses first and second back controls (shift levers 125, 126) each located on the back of the controller (i.e., the side opposite the front side bearing thumb-operated “front” controls). Pet. 21 (Ex. 1002, 13:11–15, 62–65; 12:61–53; Figs. 2, 3, 23, and 24).

Patent Owner contends that Tosaki’s shift levers 125 and 126 are “actually on or adjacent to the front surface as can be seen in Fig. 23 used by Petitioner.” Prelim. Resp. 20. Tosaki explicitly describes and depicts shift levers 125 and 126 as “located at the reverse” of the steering wheel (i.e., the area corresponding to the back of the controller). Ex. 1002, 13:62–64; *see also* Ex. 1002, 10:64–67 (describing casing 120b as the reverse half); Figs. 6, 7. While a portion of shift levers 125 and 126 is adjacent the front surface of the controller as Patent Owner alleges, nothing in claim 1 prohibits such a configuration.

Petitioner contends that each back control (shift levers 125, 126) includes an elongate member that extends substantially the full distance



between the top and the bottom edge of the controller. Pet 21–22 (Ex. 1002, 13:24; Figs. 2, 3, 23). In support, Petitioner compares the length of Tosaki’s elongate members to the distance between the “top edge segments” and “bottom edge segments.” *Id.* (providing an annotated version of Figure 23).

Patent Owner contends that Petitioner “makes no effort” to show controls that are located and extend as claimed. Prelim. Resp. 21. To the contrary, Petitioner provided an annotated version of Figure 23 illustrating how Tosaki’s elongated members (shift levers 125, 126) extend substantially the full distance between the top and the bottom edge of the controller. *See* Pet. 22.

Petitioner contends that Tosaki’s elongate members (shift levers 125, 126) are inherently resilient and flexible. Pet. 23.

Patent Owner argues that Tosaki is nonanalogous art and teaches away from the challenged subject matter.<sup>8</sup> Prelim. Resp. 17–20. Such contentions are not applicable to a ground of unpatentability based on anticipation. *See In re Self*, 671 F.2d 1344, 1350 (CCPA 1982); *Seachange Int’l, Inc. v. C-COR, Inc.*, 413 F.3d 1361, 11380 (Fed. Cir. 2005).

On the record before us, Petitioner has demonstrated a reasonable likelihood of prevailing in the contention that claim 1 is unpatentable as anticipated by Tosaki.

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<sup>8</sup> Patent Owner’s contentions based on a recessed portion are not applicable to claim 1. *See* Prelim. Resp. 18.

2. *Claims 6, 13, 14, 16, 17, 19, and 20*

Patent Owner does not present further arguments regarding these claims. We have reviewed Petitioner's contentions and determine that Petitioner has demonstrated a reasonable likelihood of prevailing in the contention that these claims are unpatentable as anticipated by Tosaki. *See* Pet. 23–29.

C. OBVIOUSNESS OVER ENRIGHT AND TOSAKI

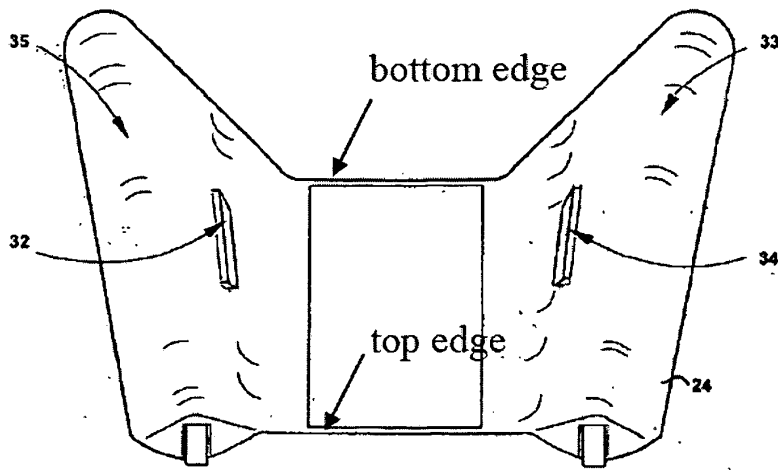
Petitioner contends that claims 1–11, 13, 16, 17, and 20 are unpatentable under 35 U.S.C. § 103 as obvious over Enright and Tosaki. Pet. 29–41.

1. *Claim 1*

Petitioner contends that Enright discloses a hand held controller for a game console (user device 2) comprising an outer case (housing 24) having a front opposite a back.<sup>9</sup> Pet. 32 (Ex. 1003 ¶ 27; Figs. 4, 5). Petitioner provides the annotated version of Enright's Figure 5, shown below:

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<sup>9</sup> Parenthetical nomenclature is Enright's.



Pet. 32–33. The annotated version of Enright’s Figure 5 illustrates the underside of user device 2 in an inverted position. *Id.*; Ex. 1003 ¶ 23.

Petitioner contends that Enright discloses a front control on one side of the controller (e.g., D-pad 28, thumbstick 30, buttons 25). Pet. 33; Ex. 1003, Figs. 4, 6.

Petitioner contends that Enright’s controller is shaped to be held in the hand of a user such that the user’s thumb is positioned to operate the front control. Pet. 33; Ex. 1003 ¶ 32; Figs. 4, 6.

Petitioner contends that Enright discloses first and second back controls (mode switches 32, 34), each located on the back of the controller (i.e., the side opposite the one bearing the front controls), and including an elongate member. Pet. 33–34 (Ex. 1003 ¶ 32, Fig. 5).

Petitioner contends that each of Enright’s first and second back controls (mode switches 32, 34) include an inherently resilient and flexible elongate member that substantially extends in a direction from the top to the bottom edge of the controller. Pet. 34–35; Ex. 1008 ¶¶ 20, 22; Ex. 1003

¶ 35; Fig. 5. Petitioner contends the Enright's elongate members extend a portion of the full distance between the top edge and the bottom edge, but relies on Tosaki for first and second elongate members (shift levers 125, 126) that extend substantially the full distance between the top and bottom edge. Pet. 31 (referring to Pet. 22 illustrating how Tosaki's elongate members extend as claimed).

Petitioner contends that Enright and Tosaki each disclose hand-held video game controllers having front controls operated by a user's thumbs and back controls on the opposite side that are operated by fingers other than the thumb. Pet. 29–30. Petitioner contends that Enright's elongate members (mode switches 32, 34) allow users to press a control without moving their thumbs from the front controls and these controls are placed in an ergonomically desired location. Pet. 30–31; Ex. 1003 ¶¶ 32, 35. Petitioner reasons that it would have been obvious to modify Enright's elongate members (mode switches 32, 34) to extend a substantial portion of the full distance between the top edge and the bottom edge as taught by Tosaki, for easy operation of the device or if ergonomically desired. Pet. 31–32 Ex. 1003 ¶ 32; Ex. 1008 ¶ 20. According to Petitioner, such a modification would have been “an obvious variation — in a predictable art.” Pet. 31.

Patent Owner contends that Petitioner argues in a conclusory fashion without providing an adequate *Graham* analysis in that Petitioner fails to identify sufficiently the differences between the challenged claims of '525 patent and the asserted references. Prelim. Resp. 22–25 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966)). According to Patent Owner, Mr. Rempel's Declaration does not remedy the Petition because it provides

the same conclusory reasons to combine the references as the Petition. *Id.* at 24. Similarly, Patent Owner contends that Petitioner provides superficial and conclusory reasons for combining the references and did not provide a sufficient rationale for combining the references. *Id.* at 25–27.

Contrary to Patent Owner’s contention, Petitioner identifies the differences between Enright and the challenged subject matter by relying upon Tosaki rather than Enright for elongate members that extend as claimed. *See* Pet. 31. Further, Petitioner provides a rationale for the proposed modification, namely, that it is a predictable variation that would provide for easy operation of the device and enhance ergonomics. Pet. 31–32. Patent Owner’s contention is unpersuasive because it labels Petitioner’s rationale as superficial and conclusory, but does not address Petitioner’s rationale directly.

On the record before us, Petitioner has demonstrated a reasonable likelihood of prevailing in the contention that claim 1 is unpatentable as obvious over Enright and Tosaki.

2. *Claims 2–11, 13, 16, 17, and 20*

Patent Owner does not present further arguments regarding these claims. We have reviewed Petitioner’s contentions and determine that Petitioner has demonstrated a reasonable likelihood of prevailing in the contention that these claims are unpatentable as obvious over Enright and Tosaki. *See* Pet. 35–41.

D. OBVIOUSNESS OVER ENRIGHT, TOSAKI, AND ONO

Petitioner contends that claims 14, 15, and 19 are unpatentable under 35 U.S.C. § 103 as obvious over Enright, Tosaki, and Ono.<sup>10</sup> Pet. 41–45.

Claims 14, 15, and 19 further limit claim 1 with regard to the switch mechanism. Claim 14 depends from claim 1 and recites, “wherein a portion of at least one of the first back control and the second back control is in registry with a switch mechanism disposed within the controller, such that displacement of the at least one back control activates the switch mechanism.” Claim 15 depends from claim 1 and recites, “wherein a switch mechanism is disposed between each of the elongate members and an outer surface of the back of the controller. Claim 19 depends from claim 1 and recites, “wherein at least one of the back controls is formed separate from the outer case of the controller.”

Regarding rationale, Petitioner contends that Enrich and Ono are both video game controllers and that Ono discloses a switch structure that may enhance the operability of Enright’s elongate switches 32, 34. Pet. 41; Ex. 1004 ¶ 5; Ex. 1008 ¶ 29.

It is Petitioner’s duty to explain how the claims are unpatentable, and Petitioner has not provided an adequate rationale. *See* 37 C.F.R. § 42.104(b)(4)–(5). The observation that Enright and Ono are both video game controllers is helpful for understanding the scope of the prior art, but

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<sup>10</sup> This ground of unpatentability differs from the ground based on anticipation by Tosaki. *See, e.g.*, Pet. 24 (relying upon Tosaki for the subject matter of claim 14), and Pet. 43 (relying upon Ono for the subject matter of claim 14).

does not provide a sufficient reason why a person of ordinary skill would modify Enright's device to include Ono's switch. Petitioner's reasoning that Ono discloses a switch structure that "may enhance operability" does not align with the modifications proposed. Ono discloses a switch that enhances operability by adding an analog output capability to known switches that only had a digital "on" and "off" output. Ex. 1004 ¶¶ 1–6. Claims 14, 15, and 19 modify claim 1 with regard to the configuration of the switch. Petitioner proposes to modify the combination of Enright and Tosaki to enhance operability in the form of adding an analog output, but Petitioner does not even identify that added capability much less address adequately how this feature enhances the combination. It is not enough to demonstrate that each of the elements were known independently in the prior art. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007).

On the record before us, Petitioner has not demonstrated a reasonable likelihood of prevailing in the contention that claims 14, 15, and 19 are unpatentable as obvious over Enright, Tosaki, and Ono.

E. OBVIOUSNESS OVER TOSAKI AND JIMAKOS

Petitioner contends that claims 2, 4, 5, 7, 8, 12, 14–16, and 19 are unpatentable under 35 U.S.C. 103 as obvious over Tosaki and Jimakos.<sup>11</sup> Pet. 45–51.

Regarding rationale, Petitioner contends that person of ordinary skill in the art would have been motivated to combine Tosaki and Jimakos, “because Tosaki teaches a video game controller and Jimakos teaches how to modify and improve a video game controller.” Pet. 46. In support, Mr. Rempel echoes the Petition and opines that one of ordinary skill would have been motivated to combine the Tosaki and Jimakos “because Tosaki teaches a video game controller and Jimakos teach how to modify and improve a video game controller.” Ex. 1008 ¶ 31.

Our analysis here parallels that of the previous ground of unpatentability in that Petitioner’s rationale does not align with the modifications proposed. The improvement disclosed by Jimakos is to add a rapid fire feature. Ex. 1005. The modifications proposed by Petitioner have nothing to do with Jamako’s rapid fire capability. For example, claim 2 depends from claim 1 and recites, “further having a top edge control located on the top edge of the controller and wherein the controller is shaped such that the user’s index finger is positioned to operate the top edge control.” Petitioner proposes to modify Tosaki to locate the top edge control as taught

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<sup>11</sup> Claims 14, 16, and 19 are subject to this ground of unpatentability and the ground based upon anticipation by Tosaki. The ground of unpatentability at hand differs from the ground based on anticipation by Tosaki. *See, e.g.*, Pet. 24 (relying upon Tosaki for the subject matter of claim 14), and Pet. 49 (relying upon Jimakos for the subject matter of claim 14).



by Jimakos. *See* Pet. 46–47 (citing Ex. 1008 ¶ 32; Ex. 1010). Petitioner does not even identify the improvement offered by Jimakos, much less explain sufficiently how Jamako’s rapid fire feature is tied to the proposed modification (e.g., relocation of the top edge control). Petitioner has only shown that each of the elements were known independently in the prior art. *KSR*, 550 U.S. at 418. The ground of unpatentability for each of the remaining challenged claims is similarly flawed.

On the record before us, Petitioner has not demonstrated a reasonable likelihood of prevailing in the contention that claims 2, 4, 5, 7, 8, 12, 14–16, and 19 are unpatentable as obvious over Tosaki and Jimakos.

F. OBVIOUSNESS OVER ENRIGHT, TOSAKI, AND OELSCH

Petitioner argues that claim 18 is unpatentable under 35 U.S.C. § 103 as obvious over Enright, Tosaki, and Oelsch. Pet. 51–52.

Claim 18 depends from independent claim 1 and recites, “wherein at least one of the back controls is formed as an integral part of the outer case.”

Petitioner contends that Oelsch discloses a conventional U-shaped slot that forms integral elongate member 19 of a control switch. *Id.* at 52 (Ex. 1006, Fig. 3). Petitioner contends that Oelsch’s switch structure at Figures 2–4 “may simplify the manufacture of the elongate mode switches 32, 34 of Enright.” *Id.* at 51 (citing Ex. 1008 ¶ 36). In the cited provision, Mr. Rempel echoes the Petition and opines that, “[o]ne of ordinary skill in the art would have been motivated to combine Enright and Oelsch, at least because Oelsch discloses a switch structure at Figs. 2-4 that may simplify the manufacture of the elongate mode switches 32, 34 of Enright.” Ex. 1008

¶ 36. Petitioner contends that a person of ordinary skill in the video controller arts would have known that back controls such as Enright's switches 32, 43, could be conventionally formed as an integral part of the outer case of a controller. Pet. 51 (citing Ex. 1008 ¶ 37). In the cited provision, Mr. Rempel opines that a person of ordinary skill in the art would have known that Enright's back controls (mode switches 32, 34) would be conventionally formed as an integral part of the outer case. Ex. 1008 ¶ 37. In other words, Petitioner contends that Oelsch discloses a control in the form of a U-shaped slot that is formed as an integral part of the outer case as claimed, and a person of ordinary skill in the art would have known that switches such as Enright's mode switches 32, 34 could be formed in such a manner.

Petitioner's contention that Oelsch's technique for forming a switch integrally with the outer case implies that such feature is missing from Enright. Contrary to Patent Owner's contention, this identifies sufficiently the differences between the prior art and the challenged subject matter. *See* Prelim. Resp. 22–24 (arguing that Petitioner failed to explain adequately the differences between the prior art and the challenged subject matter).

Further, Petitioner provides a rationale for the proposed modification, namely, that it would simplify the manufacturing of Enrich's switches 32, 34. Pet. 51–52. Patent Owner's contention is unpersuasive because it labels Petitioner's rationale as superficial and conclusory, but does not address it directly. *See* Prelim. Resp. 25–27.

On the record before us, Petitioner has demonstrated a reasonable likelihood of prevailing in the contention that claim 18 is unpatentable as obvious over Enright, Tosaki, and Oelsch.

#### V. CONCLUSION

For the foregoing reasons, we determine that Petitioner has demonstrated on the record to this point that there is a reasonable likelihood that Petitioner would prevail in proving the unpatentability of claims 1–11, 13, 14, and 16–20 of the '525 patent, but has not made such a showing with regard to claims 12 and 15.

At this stage of the proceeding, the Board has not made a final determination as to the patentability of any challenged claim or any underlying factual and legal issues.

#### VI. ORDER

For the reasons given, it is:

ORDERED that *inter partes* review is *instituted* with respect to the following grounds of unpatentability:

(1) claims 1, 6, 13, 14, 16, 17, 19, and 20 as unpatentable under 35 U.S.C. § 102(b) as anticipated by Tosaki;

(2) claims 1–11, 13, 16, 17, and 20 as unpatentable under 35 U.S.C. § 103(a) over Enright and Tosaki;

(3) claim 18 as unpatentable under 35 U.S.C. § 103(a) over Enright, Tosaki, and Oelsch;

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Patent 8,641,525

FURTHER ORDERED that no other ground of unpatentability is authorized for this *inter partes* review; and

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(a), *inter partes* review of the '525 patent is hereby instituted commencing on the entry date of this Order, and pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial.

Case IPR2016-00948  
Patent 8,641,525

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PATENT OWNER:

Ehab Samuel  
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<b>PATENT ASSIGNMENT COVER SHEET</b>
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Electronic Version v1.1  
 Stylesheet Version v1.2

EPAS ID: PAT4179231

<b>SUBMISSION TYPE:</b>	NEW ASSIGNMENT
<b>NATURE OF CONVEYANCE:</b>	RELEASE OF SECURITY INTEREST
<b>CONVEYING PARTY DATA</b>	
<b>Name</b>	<b>Execution Date</b>
CHATHAM CAPITAL MANAGEMENT IV, LLC	12/07/2016
<b>RECEIVING PARTY DATA</b>	
<b>Name:</b>	IRONBURG INVENTIONS LIMITED
<b>Street Address:</b>	10 MARKET PLACE
<b>City:</b>	WINCANTON, SOMERSET BA9 9LP
<b>State/Country:</b>	UNITED KINGDOM
<b>PROPERTY NUMBERS Total: 20</b>	
<b>Property Type</b>	<b>Number</b>
Application Number:	61910176
Application Number:	61826087
Application Number:	61910260
Application Number:	61910168
Application Number:	61930065
Application Number:	61882171
Application Number:	61935898
Application Number:	13162727
Application Number:	14141840
Application Number:	13163368
Application Number:	13910409
Application Number:	13910427
Application Number:	61844548
Application Number:	29394525
Application Number:	29425268
Application Number:	29451960
Application Number:	29481483
Application Number:	29480547
Application Number:	29480182
Application Number:	29480396

**CORRESPONDENCE DATA****Fax Number:** (312)984-7700***Correspondence will be sent to the e-mail address first; if that is unsuccessful, it will be sent using a fax number, if provided; if that is unsuccessful, it will be sent via US Mail.*****Phone:** 3123722000**Email:** ipdocketmwe@mwe.com, bvaz@mwe.com, cvicino@mwe.com**Correspondent Name:** CAROLYN M VICINO**Address Line 1:** 227 W. MONROE STREET, SUITE 4400**Address Line 4:** CHICAGO, ILLINOIS 60606-5096

<b>ATTORNEY DOCKET NUMBER:</b>	72981-030
<b>NAME OF SUBMITTER:</b>	CAROLYN M. VICINO
<b>SIGNATURE:</b>	/Carolyn M. Vicino/
<b>DATE SIGNED:</b>	12/09/2016
	This document serves as an Oath/Declaration (37 CFR 1.63).

**Total Attachments: 3**

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## **RELEASE OF PATENT SECURITY INTEREST**

**WHEREAS**, Chatham Capital Management IV, LLC, a Georgia limited liability company, as Collateral Agent (the "Agent"), is holder of the following security agreement (the "Security Agreement") recorded in the United States Patent and Trademark Office against the federal patents referenced in the attached Schedule A (the "Patents"):

That certain Assignment for Security - Patents from IRONBURG INVENTIONS LIMITED, a private limited company incorporated in England and Wales (the "Grantor"), dated July 31, 2014, and recorded in the Patent Office of the United States Patent and Trademark Office, on August 15, 2014 against the Patents;

**WHEREAS**, pursuant to that certain Loan Payoff Agreement dated December 7, 2016 (the "Agreement"), Agent released and terminated all liens against the Patents evidenced by the Security Agreement; AND

**WHEREAS**, pursuant to the Agreement, Agent authorized the parties named therein (and/or their respective attorneys, designees and representative) to file releases of intellectual property recordations in the United States Patent and Trademark Office on behalf of the Agent, without charge or expense to the Agent or any Lender;

**NOW, THEREFORE**, pursuant to the authority granted in the Agreement, Chatham Capital Management IV, LLC, a Georgia limited liability company, as Collateral Agent, does hereby release, exonerate and discharge the liens, security interests, and encumbrances of the Security Agreement and the property described therein.



IN WITNESS WHEREOF, the Agent has caused this Release of Patent Security Interest to be executed by its duly authorized officer as of the 7th day of December, 2016.

CHATHAM CAPITAL MANAGEMENT IV, LLC

By: Chatham Capital Holdings, Inc. Its  
Manager

By: Brian G. Reynolds

Name: Brian G. Reynolds

Title: CEO

[SIGNATURE PAGE TO RELEASE OF PATENT SECURITY INTEREST]

**Schedule A**

**Ironburg Inventions Limited - U.S. Patents**

<b>OUR REF</b>	<b>FILING DATE</b>	<b>APPLICATION NO.</b>	<b>TITLE</b>	<b>STATUS</b>
PUS1311169	29/11/2013	US61/910,176	INTERCHANGEABLE CONTROL COMPONENTS	PROVISIONAL PATENT
PUS1311048	22/05/2013	US61/826,087	CONTROLLER FOR A GAMES CONSOLE	PROVISIONAL PATENT
PUS1311174	29/11/2013	US61/910,260	X BOX HAIR TRIGGER STOP	PROVISIONAL PATENT
PUS1311084	29/11/2013	US61/910,168	BIOMECHANICS CONTROLLER	PROVISIONAL PATENT
PUS1411200	22/01/2014	US61/930,065	X BOX ONE GRIP MOUNTED HAIR TRIGGER	PROVISIONAL PATENT
PUS1311121	25/09/2013	US61/882,171	PADDLE SADDLE	PROVISIONAL PATENT
PUS1411195	05/02/2014	US61/935,898	CONTROLLER FOR A GAMES CONSOLE, TOOL AND A METHOD THEREFOR	PROVISIONAL PATENT
FPUS1110630	17/06/2011	US13/162,727	CONTROLLER FOR VIDEO GAME CONSOLE	UTILITY PATENT
FPUS1410630CON	27/12/2013	US14/141,840	CONTROLLER FOR VIDEO GAME CONSOLE	UTILITY PATENT
FPUS1110629	17/06/2011	US13/163,368	GAME CONTROLLER	UTILITY PATENT
FPUS1310629DIV1	05/06/2013	US13/910,409	GAME CONTROLLER	UTILITY PATENT
FPUS1310629DIV2	05/06/2013	US13/910,427	GAME CONTROLLER	UTILITY PATENT
FPUS1311038	10/07/2013	US61/844,548	GAMES CONTROLLER AND TRIGGER THEREFOR	PROVISIONAL PATENT
FDUS1110633	17/06/2011	US29/394,525	GAME CONTROLLER	DESIGN PATENT
FDUS1210633DIV	21/06/2012	US29/425,268	GAME CONTROLLER	DESIGN PATENT
FDUS1310633DIV1	10/04/2013	US29/451,960	GAME CONTROLLER	DESIGN PATENT
DUS1411202		US29/481,483	TRIGGER STOP	DESIGN PATENT
DUS1411203	27/01/2014	US29/480,547	X BOX ONE BATTERY HATCH	DESIGN PATENT
DUS1411204	23/01/2014	US29/480,182	X BOX ONE GRIPS	DESIGN PATENT
DUS1411205	24/01/2014	US29/480,396	PS 4 BACK PANEL	DESIGN PATENT
PUS1311047			MAGNETIC MOTION POT	PATENT

<b>PATENT ASSIGNMENT COVER SHEET</b>
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Electronic Version v1.1  
 Stylesheet Version v1.2

EPAS ID: PAT4179276

<b>SUBMISSION TYPE:</b>	NEW ASSIGNMENT
<b>NATURE OF CONVEYANCE:</b>	SECURITY INTEREST
<b>CONVEYING PARTY DATA</b>	
<b>Name</b>	<b>Execution Date</b>
IRONBURG INVENTIONS LIMITED	12/07/2016
<b>RECEIVING PARTY DATA</b>	
<b>Name:</b>	TRIANGLE CAPITAL CORPORATION
<b>Street Address:</b>	3700 GLENWOOD AVENUE, SUITE 530
<b>City:</b>	RALEIGH
<b>State/Country:</b>	NORTH CAROLINA
<b>Postal Code:</b>	27612
<b>PROPERTY NUMBERS Total: 52</b>	
<b>Property Type</b>	<b>Number</b>
Patent Number:	8480491
Patent Number:	9308450
Patent Number:	9308451
Application Number:	15095662
Patent Number:	8641525
Patent Number:	9089770
Application Number:	14754789
Application Number:	14754793
Patent Number:	D667892
Application Number:	29425268
Patent Number:	D721139
Application Number:	29514515
Application Number:	61826087
Patent Number:	9352229
Patent Number:	9492744
Application Number:	14805641
Application Number:	14805661
Application Number:	61882171
Application Number:	61844548
Application Number:	14911524

Property Type	Number
Application Number:	61910168
Application Number:	15039984
Application Number:	61910176
Application Number:	61910260
Application Number:	15040000
Application Number:	61930065
Application Number:	15113152
Application Number:	29481483
Application Number:	29480182
Application Number:	29480547
Application Number:	29545847
Patent Number:	D733802
Application Number:	61935898
Application Number:	15116549
Application Number:	61979124
Patent Number:	9289688
Application Number:	61911843
Application Number:	14953121
Application Number:	62101420
Application Number:	62213780
Application Number:	62232020
Application Number:	15264810
Application Number:	62260394
Application Number:	15362134
Application Number:	62239517
Application Number:	62222659
Application Number:	29556677
Application Number:	29556661
Application Number:	29556666
Application Number:	29556673
Application Number:	62349859
Application Number:	62373456

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<b>Address Line 4:</b>	CHICAGO, ILLINOIS 60606-5096
<b>ATTORNEY DOCKET NUMBER:</b>	72981-030
<b>NAME OF SUBMITTER:</b>	CAROLYN M. VICINO
<b>SIGNATURE:</b>	/Carolyn M. Vicino/
<b>DATE SIGNED:</b>	12/09/2016
	This document serves as an Oath/Declaration (37 CFR 1.63).
<b>Total Attachments: 7</b>	
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NOTICE OF  
GRANT OF SECURITY INTEREST  
IN PATENTS

United States Patent and Trademark Office

Ladies and Gentlemen:

Please be advised that pursuant to the Security and Pledge Agreement dated as of December 7, 2016 (as amended, modified, extended, restated, renewed, replaced, or supplemented from time to time, the "Agreement") by and among the Grantors party thereto (each an "Grantor" and collectively, the "Grantors") and Triangle Capital Corporation, a Maryland corporation, as Agent (the "Agent") for the Secured Parties referenced therein, the undersigned Grantor has granted a continuing security interest in and continuing lien upon the patents and patent applications shown on Schedule 1 attached hereto to the Agent for the ratable benefit of the Secured Parties.

The undersigned Grantor and the Agent, on behalf of the Secured Parties, hereby acknowledge and agree that the security interest in the foregoing patents and patent applications (a) may only be terminated in accordance with the terms of the Agreement and (b) is not to be construed as an assignment of any patent or patent application.

Each of the parties hereto has caused a counterpart of this Agreement to be duly executed and delivered as of the date first above written.

**GRANTORS:**

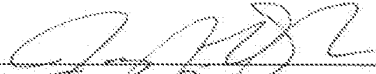
**IRONBURG INVENTIONS LIMITED**

By: \_\_\_\_\_  
Name: Evan Karp  
Title: Director

Signature Page to Notice of Grant of Security Interest in Patents

Accepted and agreed to as of the date first above written.

**TRIANGLE CAPITAL CORPORATION,**  
as Agent

By:   
Name: James Burke  
Title: Principal

Signature Page to Notice of Grant of Security Interest in Patents



Schedule 1

Patents and Patent Applications

LOAN PARTY/OWNER	TITLE	COUNTRY/TYPE	PATENT NO./GRANT DATE	APPLICATION NO./FILING DATE	PUBLICATION NO.
Ironburg Inventions Limited	GAME CONTROLLER	US UTILITY	US8,480,491 09-JUL-2013	US13/163,368 17-JUN-2011	US2012322555
Ironburg Inventions Limited	GAME CONTROLLER	US UTILITY	US9,308,450 12-APR-2016	US13/910,409 05-JUN-2013	US20130267320
Ironburg Inventions Limited	GAME CONTROLLER	US UTILITY	US 9,308,451 12-APR-2016	US13/910,427 05-JUN-2013	US20130267321
Ironburg Inventions Limited	GAME CONTROLLER	US UTILITY		US15/095,662 11-APR-2016	US20160296837
Ironburg Inventions Limited	CONTROLLER FOR VIDEO GAME CONSOLE	US UTILITY	US8,641,525 04-FEB-2014	US13/162,727 17-JUN-2011	US20120322553
Ironburg Inventions Limited	CONTROLLER FOR VIDEO GAME CONSOLE	US UTILITY	US9,089,770 28-JUL-2015	US14/141,840 27-DEC-2013	US20140113723
Ironburg Inventions Limited	CONTROLLER FOR VIDEO GAME CONSOLE	US UTILITY		US14/754,789 30-JUN-2015	US20150297993
Ironburg Inventions Limited	CONTROLLER FOR VIDEO GAME CONSOLE	US UTILITY		US14/754,793 30-JUN-2015	US20150297994
Ironburg Inventions Limited	GAME CONTROLLER	US DESIGN	USD667,892 25-SEP-2012	US29/394,525 17-JUN-2011	
Ironburg Inventions Limited	GAME CONTROLLER	US DESIGN		US29/425,268 21-JUN-2012	
Ironburg Inventions Limited	GAME CONTROLLER	US DESIGN	USD721,139 13-JAN-2015	US29/451,960 10-APR-2013	
Ironburg Inventions Limited	GAME CONTROLLER	US DESIGN		US29/514,515 13-JAN-2015	

LOAN PARTY/OWNER	TITLE	COUNTRY/ TYPE	PATENT NO/ GRANT DATE	APPLICATION NO./FILING DATE	PUBLICATION NO.
Ironburg Inventions Limited	CONTROLLER FOR A GAMES CONSOLE	US PROVISIONAL		US61/826,087 22-MAY-2013	
Ironburg Inventions Limited	CONTROLLER FOR A GAMES CONSOLE	US UTILITY	US9,352,229 31-MAY-2016	US14/736,771 11-JUN-2015	US20150283458
Ironburg Inventions Limited	CONTROLLER FOR A GAMES CONSOLE	US UTILITY	US9,492,744 15-NOV-2016	US14/805,597 22-JUL-2015	US20150321091
Ironburg Inventions Limited	CONTROLLER FOR A GAMES CONSOLE	US UTILITY		US14/805,641 22-JUL-2015	US20150321092
Ironburg Inventions Limited	CONTROLLER FOR A GAMES CONSOLE	US UTILITY		US14/805,661 22-JUL-2015	US20150321093
Ironburg Inventions Limited	CONTROLLER FOR A GAMES CONSOLE	US PROVISIONAL		US61/882,171 25-SEP-2013	
Ironburg Inventions Limited	GAMES CONTROLLER AND TRIGGER THEREFOR	US PROVISIONAL		US61/844,548 10-JUL-2013	
Ironburg Inventions Limited	CONTROLLER FOR A GAMES CONSOLE	US UTILITY		US14/911,524 11-FEB-2016	US20160193259
Ironburg Inventions Limited	CONTROLLER FOR A GAMES CONSOLE	US PROVISIONAL		US61/910,168 29-NOV-2013	
Ironburg Inventions Limited	CONTROLLER FOR A GAMES CONSOLE	US UTILITY		US15/039,984 27-MAY-2016	
Ironburg Inventions Limited	CONTROLLER FOR A GAMES CONSOLE	US PROVISIONAL		US61/910,176 29-NOV-2013	
Ironburg Inventions Limited	GAMES CONTROLLER	US PROVISIONAL		US61/910,260 29-NOV-2013	
Ironburg Inventions Limited	GAMES CONTROLLER	US UTILITY		US15/040,000 27-MAY-2016	
Ironburg Inventions Limited	GAMES CONTROLLER	US PROVISIONAL		US61/930,065 22-JAN-2014	
Ironburg Inventions Limited	GAMES CONTROLLER	US UTILITY		US15/113,152 21-JUL-2016	
Ironburg Inventions Limited	CONTROLLER TRIGGER	US DESIGN	USD728,030 28-APR-2015	US29/481,483 06-FEB-2014	
Ironburg Inventions Limited	CONTROLLER HANDLE INSERT	US DESIGN	USD730,451 26-MAY-2015	US29/480,182 23-JAN-2014	

9289532v4 21649.00031

LOAN PARTY/OWNER	TITLE	COUNTRY/ TYPE	PATENT NO/ GRANT DATE	APPLICATION NO./FILING DATE	PUBLICATION NO.
Ironburg Inventions Limited	CONTROLLER HATCH COVER	US DESIGN	USD748,734 02-FEB-2016	US29/480,547 27-JAN-2014	
Ironburg Inventions Limited	CONTROLLER HATCH COVER	US DESIGN		US29/545,847 17-NOV-2015	
Ironburg Inventions Limited	CONTROLLER BACK PANEL	US DESIGN	USD733,802 07-JUL-2015	US29/480,396 24-JAN-2014	
Ironburg Inventions Limited	CONTROLLER FOR A GAMES CONSOLE, TOOL AND A METHOD THEREFOR	US PROVISIONAL		US61/935,898 05-FEB-2014	
Ironburg Inventions Limited	CONTROLLER FOR A GAMES CONSOLE, TOOL AND A METHOD THEREFOR	US UTILITY		US15/116,549 04-AUG-2016	
Ironburg Inventions Limited	GAMES CONTROLLER	US PROVISIONAL		US61/979,124 14-APR-2014	
Ironburg Inventions Limited	GAMES CONTROLLER	US UTILITY	US9,289,688 22-MAR-2016	US14/832,211 21-AUG-2015	US20150360126
Ironburg Inventions Limited	GAMES CONTROLLER	US PROVISIONAL		US61/991,843 12-MAY-2014	
Ironburg Inventions Limited	GAMES CONTROLLER	US UTILITY		US14/953,121 27-NOV-2015	US20160082349
Ironburg Inventions Limited	CONTROLLER FOR GAMES CONSOLE	US PROVISIONAL		US62/101,420 09-JAN-2015	
Ironburg Inventions Limited	INPUT DEVICE FOR A COMPUTER	US PROVISIONAL		US62/213,780 03-SEP-2015	
Ironburg Inventions Limited	GAMES CONTROLLER	US PROVISIONAL		US62/232,020 24-SEP-2015	
Ironburg Inventions Limited	GAMES CONTROLLER	US		US15/264,810 14-SEP-2016	
Ironburg Inventions Limited	GAMES CONTROLLER AND TRIGGER THEREFOR	US PROVISIONAL		US62/260,394 27-NOV-2015	

9289532v4 21649.00031

LOAN PARTY/OWNER	TITLE	COUNTRY/ TYPE	PATENT NO/ GRANT DATE	APPLICATION NO./FILING DATE	PUBLICATION NO.
Ironburg Inventions Limited	GAMES CONTROLLER AND TRIGGER THEREFOR	US UTILITY		US15/362,134 28-NOV-2016	
Ironburg Inventions Limited	GAMES CONTROLLER	US PROVISIONAL		US62/239,517 09-OCT-2015	
Ironburg Inventions Limited	GAMES CONTROLLER	US PROVISIONAL		US62/222,659 23-SEP-2015	
Ironburg Inventions Limited	GAMES CONTROLLER	US DESIGN		US29/556,677 02-MAR-2016	
Ironburg Inventions Limited	GAMES CONTROLLER	US DESIGN		US29/556,661 02-MAR-2016	
Ironburg Inventions Limited	GAMES CONTROLLER	US DESIGN		US29/556,666 02-MAR-2016	
Ironburg Inventions Limited	GAMES CONTROLLER	US DESIGN		US29/556,673 02-MAR-2016	
Ironburg Inventions Limited	GAMES CONTROLLER	US PROVISIONAL		US62/349,859 14-JUN-2016	
Ironburg Inventions Limited	CONTROLLER WITH TWO SEPARATE HALVES	US PROVISIONAL		US62/373,456 11-AUG-2016	

<b>PATENT ASSIGNMENT COVER SHEET</b>
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Electronic Version v1.1  
 Stylesheet Version v1.2

EPAS ID: PAT4180396

<b>SUBMISSION TYPE:</b>	NEW ASSIGNMENT
<b>NATURE OF CONVEYANCE:</b>	SECURITY INTEREST
<b>CONVEYING PARTY DATA</b>	
<b>Name</b>	<b>Execution Date</b>
IRONBURG INVENTIONS LIMITED	12/07/2016
<b>RECEIVING PARTY DATA</b>	
<b>Name:</b>	TRIANGLE CAPITAL CORPORATION, AS AGENT
<b>Street Address:</b>	3700 GLENWOOD AVENUE
<b>Internal Address:</b>	SUITE 530
<b>City:</b>	RALEIGH
<b>State/Country:</b>	NORTH CAROLINA
<b>Postal Code:</b>	27612
<b>PROPERTY NUMBERS Total: 52</b>	
<b>Property Type</b>	<b>Number</b>
Patent Number:	8480491
Patent Number:	9308450
Patent Number:	9308451
Application Number:	15095662
Patent Number:	8641525
Patent Number:	9089770
Application Number:	14754789
Application Number:	14754793
Application Number:	29394525
Application Number:	29425268
Application Number:	29451960
Application Number:	29514515
Application Number:	61826087
Patent Number:	9352229
Patent Number:	9492744
Application Number:	14805641
Application Number:	14805661
Application Number:	61882171
Application Number:	61844548

Property Type	Number
Application Number:	14911524
Application Number:	61910168
Application Number:	15039984
Application Number:	61910176
Application Number:	61910260
Application Number:	15040000
Application Number:	61930065
Application Number:	15113152
Application Number:	29481483
Application Number:	29480182
Application Number:	29480547
Application Number:	29545847
Application Number:	29480396
Application Number:	61935898
Application Number:	15116549
Application Number:	61979124
Application Number:	14832211
Application Number:	61991843
Application Number:	14953121
Application Number:	62101420
Application Number:	62213780
Application Number:	62232020
Application Number:	15264810
Application Number:	62260394
Application Number:	15362134
Application Number:	62239517
Application Number:	62222659
Application Number:	29556677
Application Number:	29556661
Application Number:	29556666
Application Number:	29556673
Application Number:	62349859
Application Number:	62373456

**CORRESPONDENCE DATA**

Fax Number: (704)339-3470

*Correspondence will be sent to the e-mail address first; if that is unsuccessful, it will be sent using a fax number, if provided; if that is unsuccessful, it will be sent via US Mail.*

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<b>Correspondent Name:</b>	ELIZABETH CAMPBELL
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<b>Address Line 4:</b>	CHARLOTTE, NORTH CAROLINA 28246
<b>ATTORNEY DOCKET NUMBER:</b>	21649.00031
<b>NAME OF SUBMITTER:</b>	ELIZABETH CAMPBELL
<b>SIGNATURE:</b>	/Elizabeth Campbell/
<b>DATE SIGNED:</b>	12/12/2016
	This document serves as an Oath/Declaration (37 CFR 1.63).
<b>Total Attachments: 7</b>	
source=Patent Security Interest#page1.tif	
source=Patent Security Interest#page2.tif	
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source=Patent Security Interest#page4.tif	
source=Patent Security Interest#page5.tif	
source=Patent Security Interest#page6.tif	
source=Patent Security Interest#page7.tif	

NOTICE OF  
GRANT OF SECURITY INTEREST  
IN PATENTS

United States Patent and Trademark Office

Ladies and Gentlemen:

Please be advised that pursuant to the Security and Pledge Agreement dated as of December 7, 2016 (as amended, modified, extended, restated, renewed, replaced, or supplemented from time to time, the "Agreement") by and among the Grantors party thereto (each an "Grantor" and collectively, the "Grantors") and Triangle Capital Corporation, a Maryland corporation, as Agent (the "Agent") for the Secured Parties referenced therein, the undersigned Grantor has granted a continuing security interest in and continuing lien upon the patents and patent applications shown on Schedule 1 attached hereto to the Agent for the ratable benefit of the Secured Parties.

The undersigned Grantor and the Agent, on behalf of the Secured Parties, hereby acknowledge and agree that the security interest in the foregoing patents and patent applications (a) may only be terminated in accordance with the terms of the Agreement and (b) is not to be construed as an assignment of any patent or patent application.



Each of the parties hereto has caused a counterpart of this Agreement to be duly executed and delivered as of the date first above written.

**GRANTORS:**

**IRONBURG INVENTIONS LIMITED**

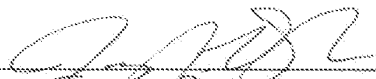
By: \_\_\_\_\_  
Name: Evan Karp  
Title: Director



Signature Page to Notice of Grant of Security Interest in Patents

Accepted and agreed to as of the date first above written.

**TRIANGLE CAPITAL CORPORATION,**  
as Agent

By:   
Name: Janka Burtka  
Title: Vice President

Signature Page to Notice of Grant of Security Interest in Patents

Schedule 1

Patents and Patent Applications

<b>LOAN PARTY/OWNER</b>	<b>TITLE</b>	<b>COUNTRY/TYPE</b>	<b>PATENT NO./GRANT DATE</b>	<b>APPLICATION NO./FILING DATE</b>	<b>PUBLICATION NO.</b>
Ironburg Inventions Limited	GAME CONTROLLER	US UTILITY	US8,480,491 09-JUL-2013	US13/163,368 17-JUN-2011	US2012322555
Ironburg Inventions Limited	GAME CONTROLLER	US UTILITY	US9,308,450 12-APR-2016	US13/910,409 05-JUN-2013	US20130267320
Ironburg Inventions Limited	GAME CONTROLLER	US UTILITY	US,9,308,451 12-APR-2016	US13/910,427 05-JUN-2013	US20130267321
Ironburg Inventions Limited	GAME CONTROLLER	US UTILITY		US15/095,662 11-APR-2016	US20160296837
Ironburg Inventions Limited	CONTROLLER FOR VIDEO GAME CONSOLE	US UTILITY	US8,641,525 04-FEB-2014	US13/162,727 17-JUN-2011	US20120322553
Ironburg Inventions Limited	CONTROLLER FOR VIDEO GAME CONSOLE	US UTILITY	US9,089,770 28-JUL-2015	US14/141,840 27-DEC-2013	US20140113723
Ironburg Inventions Limited	CONTROLLER FOR VIDEO GAME CONSOLE	US UTILITY		US14/754,789 30-JUN-2015	US20150297993
Ironburg Inventions Limited	CONTROLLER FOR VIDEO GAME CONSOLE	US UTILITY		US14/754,793 30-JUN-2015	US20150297994
Ironburg Inventions Limited	GAME CONTROLLER	US DESIGN	USD667,892 25-SEP-2012	US29/394,525 17-JUN-2011	
Ironburg Inventions Limited	GAME CONTROLLER	US DESIGN		US29/425,268 21-JUN-2012	
Ironburg Inventions Limited	GAME CONTROLLER	US DESIGN	USD721,139 13-JAN-2015	US29/451,960 10-APR-2013	
Ironburg Inventions Limited	GAME CONTROLLER	US DESIGN		US29/514,515 13-JAN-2015	

LOAN PARTY/OWNER	TITLE	COUNTRY/ TYPE	PATENT NO./ GRANT DATE	APPLICATION NO./FILING DATE	PUBLICATION NO.
Ironburg Inventions Limited	CONTROLLER FOR A GAMES CONSOLE	US PROVISIONAL		US61/826,087 22-MAY-2013	
Ironburg Inventions Limited	CONTROLLER FOR A GAMES CONSOLE	US UTILITY	US9,352,229 31-MAY-2016	US14/736,771 11-JUN-2015	US20150283458
Ironburg Inventions Limited	CONTROLLER FOR A GAMES CONSOLE	US UTILITY	US9,492,744 15-NOV-2016	US14/805,597 22-JUL-2015	US20150321091
Ironburg Inventions Limited	CONTROLLER FOR A GAMES CONSOLE	US UTILITY		US14/805,641 22-JUL-2015	US20150321092
Ironburg Inventions Limited	CONTROLLER FOR A GAMES CONSOLE	US UTILITY		US14/805,661 22-JUL-2015	US20150321093
Ironburg Inventions Limited	CONTROLLER FOR A GAMES CONSOLE	US PROVISIONAL		US61/882,171 25-SEP-2013	
Ironburg Inventions Limited	GAMES CONTROLLER AND TRIGGER THEREFOR	US PROVISIONAL		US61/844,548 10-JUL-2013	
Ironburg Inventions Limited	CONTROLLER FOR A GAMES CONSOLE	US UTILITY		US14/911,524 11-FEB-2016	US20160193259
Ironburg Inventions Limited	CONTROLLER FOR A GAMES CONSOLE	US PROVISIONAL		US61/910,168 29-NOV-2013	
Ironburg Inventions Limited	CONTROLLER FOR A GAMES CONSOLE	US UTILITY		US15/039,984 27-MAY-2016	
Ironburg Inventions Limited	CONTROLLER FOR A GAMES CONSOLE	US PROVISIONAL		US61/910,176 29-NOV-2013	
Ironburg Inventions Limited	GAMES CONTROLLER	US PROVISIONAL		US61/910,260 29-NOV-2013	
Ironburg Inventions Limited	GAMES CONTROLLER	US UTILITY		US15/040,000 27-MAY-2016	
Ironburg Inventions Limited	GAMES CONTROLLER	US PROVISIONAL		US61/930,065 22-JAN-2014	
Ironburg Inventions Limited	GAMES CONTROLLER	US UTILITY		US15/113,152 21-JUL-2016	
Ironburg Inventions Limited	CONTROLLER TRIGGER	US DESIGN	USD728,030 28-APR-2015	US29/481,483 06-FEB-2014	
Ironburg Inventions Limited	CONTROLLER HANDLE INSERT	US DESIGN	USD730,451 26-MAY-2015	US29/480,182 23-JAN-2014	

LOAN PARTY/OWNER	TITLE	COUNTRY/ TYPE	PATENT NO./ GRANT DATE	APPLICATION NO./FILING DATE	PUBLICATION NO.
Ironburg Inventions Limited	CONTROLLER HATCH COVER	US DESIGN	USD748,734 02-FEB-2016	US29/480,547 27-JAN-2014	
Ironburg Inventions Limited	CONTROLLER HATCH COVER	US DESIGN		US29/545,847 17-NOV-2015	
Ironburg Inventions Limited	CONTROLLER BACK PANEL	US DESIGN	USD733,802 07-JUL-2015	US29/480,396 24-JAN-2014	
Ironburg Inventions Limited	CONTROLLER FOR A GAMES CONSOLE, TOOL AND A METHOD THEREFOR	US PROVISIONAL		US61/935,898 05-FEB-2014	
Ironburg Inventions Limited	CONTROLLER FOR A GAMES CONSOLE, TOOL AND A METHOD THEREFOR	US UTILITY		US15/116,549 04-AUG-2016	
Ironburg Inventions Limited	GAMES CONTROLLER	US PROVISIONAL		US61/979,124 14-APR-2014	
Ironburg Inventions Limited	GAMES CONTROLLER	US UTILITY	US9,289,688 22-MAR-2016	US14/832,211 21-AUG-2015	US20150360126
Ironburg Inventions Limited	GAMES CONTROLLER	US PROVISIONAL		US61/991,843 12-MAY-2014	
Ironburg Inventions Limited	GAMES CONTROLLER	US UTILITY		US14/953,121 27-NOV-2015	US20160082349
Ironburg Inventions Limited	CONTROLLER FOR GAMES CONSOLE	US PROVISIONAL		US62/101,420 09-JAN-2015	
Ironburg Inventions Limited	INPUT DEVICE FOR A COMPUTER	US PROVISIONAL		US62/213,780 03-SEP-2015	
Ironburg Inventions Limited	GAMES CONTROLLER	US PROVISIONAL		US62/232,020 24-SEP-2015	
Ironburg Inventions Limited	GAMES CONTROLLER	US		US15/264,810 14-SEP-2016	
Ironburg Inventions Limited	GAMES CONTROLLER AND TRIGGER THEREFOR	US PROVISIONAL		US62/260,394 27-NOV-2015	

9289532v4 21649.00031

LOAN PARTY/OWNER	TITLE	COUNTRY/ TYPE	PATENT NO./ GRANT DATE	APPLICATION NO./FILING DATE	PUBLICATION NO.
Ironburg Inventions Limited	GAMES CONTROLLER AND TRIGGER THEREFOR	US UTILITY		US15/362,134 28-NOV-2016	
Ironburg Inventions Limited	GAMES CONTROLLER	US PROVISIONAL		US62/239,517 09-OCT-2015	
Ironburg Inventions Limited	GAMES CONTROLLER	US PROVISIONAL		US62/222,659 23-SEP-2015	
Ironburg Inventions Limited	GAMES CONTROLLER	US DESIGN		US29/556,677 02-MAR-2016	
Ironburg Inventions Limited	GAMES CONTROLLER	US DESIGN		US29/556,661 02-MAR-2016	
Ironburg Inventions Limited	GAMES CONTROLLER	US DESIGN		US29/556,666 02-MAR-2016	
Ironburg Inventions Limited	GAMES CONTROLLER	US DESIGN		US29/556,673 02-MAR-2016	
Ironburg Inventions Limited	GAMES CONTROLLER	US PROVISIONAL		US62/349,859 14-JUN-2016	
Ironburg Inventions Limited	CONTROLLER WITH TWO SEPARATE HALVES	US PROVISIONAL		US62/373,456 11-AUG-2016	

AO 120 (Rev. 2/99)

TO: <b>Commissioner of Patents and Trademarks</b> <b>Washington, DC 20231</b>	<b>REPORT ON THE                  FILING OR DETERMINATION OF AN                  ACTION REGARDING A PATENT OR                  TRADEMARK</b>
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In Compliance with 35 § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court Northern District of Georgia on the following  Patents or  Trademarks:

DOCKET NO. 1:15-cv-4219-MHC	DATE FILED December 3, 2015	U.S. DISTRICT COURT Northern District of Georgia
PLAINTIFF Ironburg Inventions LTD. A United Kingdom Limited Company		DEFENDANT Valve Corporation, a Washington Corporation
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1 8,641,525	February 4, 2014	Ironburg Inventions LTD.
2 9,089,770	July 28, 2015	Ironburg Inventions LTD.
3		
4		
5		

In the above—entitled case, the following patent(s) have been included:

DATE INCLUDED	INCLUDED BY <input type="checkbox"/> Amendment <input type="checkbox"/> Answer <input type="checkbox"/> Cross Bill <input type="checkbox"/> Other Pleading		
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK	
1			
2			
3			
4			
5			

In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT
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CLERK James N. Hatten	(BY) DEPUTY CLERK	DATE December 4, 2015
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Copy 1—Upon initiation of action, mail this copy to Commissioner    Copy 3—Upon termination of action, mail this copy to Commissioner  
 Copy 2—Upon filing document adding patent(s), mail this copy to Commissioner    Copy 4—Case file copy

**COMMUNICATION TO THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Application/Patent No. : 13/162,727 / 8,641,525 Confirmation No.: 8138  
 Applicant : -  
 Inventors : Burgess, et al.  
 Filing Date : 06/17/2011  
 TC/A.U. : 3717  
 Examiner : Hylinski, Steven J.  
 Docket No. : JVV-163679-878

USPTO  
 Commissioner for Patents  
 P.O. Box 1450  
 Alexandria, VA 22313-1450

**NOTIFICATION OF LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS**

Applicant hereby requests a change in the entity status of the above-referenced patent from Small Entity to Large Entity. Applicant hereby notifies the USPTO of loss of entitlement to small entity status under 37 CFR 1.27, as required by 37 CFR 1.27(g)(2).

Please update this matter accordingly.

Respectfully submitted,

Date: April 5, 2017

/W. Lyle Gravatt/  
 W. Lyle Gravatt  
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 Acting in a representative capacity

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Customer No. 115007



AO 120 (Rev. 2/99)

TO: <b>Commissioner of Patents and Trademarks</b> <b>Washington, DC 20231</b>	<b>REPORT ON THE                  FILING OR DETERMINATION OF AN                  ACTION REGARDING A PATENT OR                  TRADEMARK</b>
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In Compliance with 35 § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court Northern District of Georgia on the following  Patents or  Trademarks:

DOCKET NO. 1:15-cv-4219-MHC	DATE FILED December 3, 2015	U.S. DISTRICT COURT Northern District of Georgia
PLAINTIFF Ironburg Inventions LTD. A United Kingdom Limited Company		DEFENDANT Valve Corporation, a Washington Corporation
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	8,641,525	February 4, 2014 Ironburg Inventions LTD.
2	9,089,770	July 28, 2015 Ironburg Inventions LTD.
3		
4		
5		

In the above—entitled case, the following patent(s) have been included:

DATE INCLUDED 8/15/16	INCLUDED BY <input checked="" type="checkbox"/> Amendment <input type="checkbox"/> Answer <input type="checkbox"/> Cross Bill <input type="checkbox"/> Other Pleading		
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK	
1	9,289,688	March 22, 2016 Ironburg Inventions LTD.	
2	9,352, 229	May 31, 2016 Ironburg Inventions LTD.	
3			
4			
5			

In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT
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CLERK James N. Hatten	(BY) DEPUTY CLERK s/Jennifer Lee	DATE 8/16/16
--------------------------	-------------------------------------	-----------------

Copy 1—Upon initiation of action, mail this copy to Commissioner Copy 3—Upon termination of action, mail this copy to Commissioner  
 Copy 2—Upon filing document adding patent(s), mail this copy to Commissioner Copy 4—Case file copy

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 IPR2017-00136  
Patent 8,641,525 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 Petition (“the first Petition”) requesting *inter partes* review of claims 1–20 of U.S. Patent No. 8,641,525 B2 (Ex. 1001, “the ’525 patent”). Ex. 2015, 4.<sup>1</sup> We instituted an *inter partes* review (IPR2016-00948) of claims 1–11, 13, 14, and 16–20 of the ’525 patent, but did not institute review of claims 12 and 15. Ex. 2016, 1 (“Dec.”).<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 ’525 patent. Pet. 12. In conjunction with the second Petition, Petitioner filed a Motion (Paper 3, “Mot.”) seeking Joinder or Consolidation with IPR2016-00948.

Ironburg Inventions Ltd. (“Patent Owner”) filed a Preliminary Response (Paper 11, “Prelim. Resp.”) to the second Petition, and an Opposition to the Motion (Paper 9, “Opp.”). Petitioner filed a reply to Patent Owner’s Opposition (Paper 10, “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 one of the challenged claims. We institute an *inter partes* review of claim 20 of the ’525 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 IPR2016-00948 (Paper 10) as Exhibit 2016.

B. RELATED PROCEEDINGS

The parties indicate that the '525 patent is at issue in: *Ironburg Inventions Ltd. v. Valve Corp.*, Case No. 1:15-cv-04219-MHC (N.D. Ga.) (“the related litigation”). Pet. 1; Paper 7, 1.

Petitioner also filed a first and a second petition against U.S. Patent 9,089,770 B2 (“the '770 patent”) (IPR2016-00949 and IPR2017-00137).

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 '525 patent relates to hand held controllers for video game consoles. Ex. 1001, 1:6–7.

As background, the '525 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 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 '525 patent was intended to address this problem. *Id.* at 1:41–45.

Controller 10 of the '525 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:

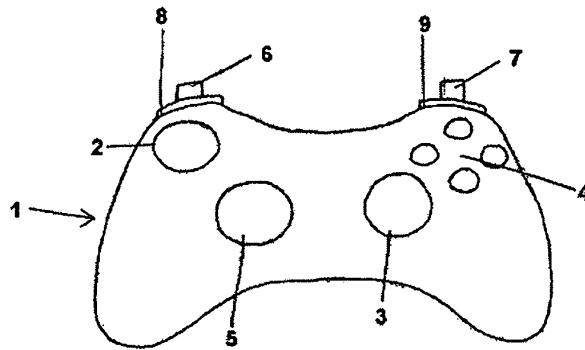


Figure 1

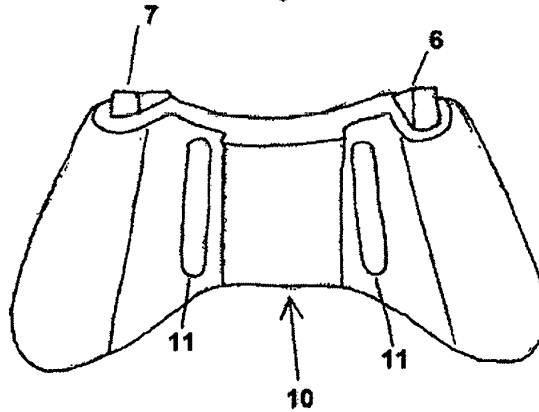


Figure 2

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 CLAIMS

Of the challenged claims, 1 and 20 are independent. Claims 1 and 20 follow:

1. A hand held controller for a game console comprising:
  - an outer case comprising a front, a back, a top edge, and a bottom edge, wherein the back of the controller is opposite the front of the controller and the top edge is opposite the bottom edge; and wherein the back of the controller is opposite the front of the controller and the top edge is opposite the bottom edge;
  - and
    - a front control located on the front of the controller;
    - wherein the controller is shaped to be held in the hand of a user such that the user's thumb is positioned to operate the front control; and
    - a first back control and a second back control, each back control being located on the back of the controller and each back control including an elongate member that extends substantially the full distance between the top edge and the bottom edge and is inherently resilient and flexible.
  
20. A hand held controller for a game console comprising:
  - an outer case comprising a front, a back, a top edge, and a bottom edge, wherein the back of the controller is opposite the front of the controller and the top edge is opposite the bottom edge;
  - a front control located on the front of the controller, wherein the controller is shaped to be held in the hand of a user such that the user's thumb is positioned to operate the front control; and
  - a first back control and a second back control, each back control being located on the back of the controller and each back control including an elongate member that extends substantially the full distance between the top edge and the bottom edge.

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).

We emphasize that these determinations are preliminary. The parties may further develop argument and evidence regarding claim construction as appropriate.

D. SPECIFIC CLAIM TERMS

1. “inherently resilient and flexible” (claims 1–19)

Claim 1 recites that the elongate member is “inherently resilient and flexible.” Claims 2–19 include this limitation by virtue of dependence from claim 1.

Petitioner contends that the claim phrase “inherently resilient and flexible” means “can be moved to a biased position by a user’s finger and returns to an unbiased position when not under load.” Pet. 21. Underlying this interpretation is the contention that “flexible” means that the elongated member can be moved to a biased position by a user’s finger. *Id.* Patent

Owner contends that Petitioner’s interpretation eliminates meaning for the claim term “flexible.” Prelim. Resp. 38–39. For the reasons that follow, we agree with Patent Owner.

The claims require that each elongate member has two characteristics: it must be inherently resilient, and it must be flexible. *See Bicon Inc. v. Straumann Co.*, 441 F.3d 945, 950 (Fed. Cir. 2006) (“[C]laims are interpreted with an eye toward giving effect to all terms in the claim.”); *see also Stumbo v. Eastman Outdoors, Inc.*, 508 F.3d 1358, 1362 (Fed. Cir. 2007) (denouncing claim constructions that render phrases in claims superfluous).

One of these characteristics is defined in the ’525 patent. Specifically, “inherently resilient” means that each elongate member (*e.g.*, paddle 11) “returns to an unbiased position when not under load.” Ex. 1001, 3:34–35; *see also* 3:51–53 (paddles 11 are elongate in shape).

The ’525 patent does not provide a lexicographical definition for “flexible.” An ordinary meaning of “flexible” is “capable of being bent or flexed.” *See* Dec. 14 (citing a definition filed as Ex. 3001 of IPR2016-00948). The ordinary meaning of “flexible” as “capable of being bent or flexed” is consistent with the description in the ’525 patent that the elongate members are formed of a thin flexible material. *See* Ex. 1001, 2:1–3 (describing that the elongate members preferably have a thickness less than 10 mm and most desirably 1 to 3 mm), 3:28–32 (describing paddles 11 as formed of a thin flexible material).

Petitioner’s interpretation that “inherently resilient and flexible” means “can be moved to a biased position by a user’s finger and returns to an unbiased position when not under load” (Pet. 21) omits the requirement



that the elongate member must be flexible in that it bends or flexes under load. Petitioner does not provide a cogent explanation or evidence (*e.g.*, a dictionary definition, expert testimony, citation to the intrinsic record, or citation to the specification) for the assertion that an ordinary meaning of “flexible” is that the elongate member can be moved to a biased position by a user’s finger. *See* Pet. 21. Notably, as mentioned above, our previous interpretation of this claim limitation included a supporting dictionary definition for the ordinary meaning of flexible, and here Petitioner chose not to address it. *See* Dec. 14.

An elongate member as claimed is “inherently resilient” in that it returns to an unbiased position when not under load (*e.g.*, the load from a user’s finger), and is “flexible” in that it may be bent or flexed by that load.

2. Preamble (claim 20)

The preamble of claim 20 recites, “A hand held controller for a game console.”

Patent Owner argues that the preamble of claim 20 means “*a controller for a video game console that is held in and operated by both hands of a user.*” Prelim. Resp. 25; *see also* 20–25 (supporting argument). For the reasons that follow, claim 20 is not limited to a controller that is held in and operated by both hands of a user, nor is the preamble otherwise limiting.

Regarding the controller being held in and operated by both hands of a user, Patent Owner’s argument is not supported by the language of the claim. Specifically, claim 20 does not recite that the controller is held in and operated by both hands of a user; rather, claim 20 recites that the controller is shaped to be “held in the hand of a user.” Similarly, the ordinary meaning

proffered by Patent Owner does not support being held in and operated by both hands of a user; rather, it refers to being held in “the hand.” *See* Prelim. Resp. 25. Patent Owner does not assert, nor do we discern, that the Specification of the ’525 patent includes a lexicographical definition that would require the controller to be capable of being held in and operated by both hands of a user.

Regarding the preamble otherwise being limited to a controller for a game console, the term “controller” in the preamble serves as antecedent basis for use of that term in the body of the claim, but the preamble does not recite essential structure or breathe life, meaning, and vitality into the claim. *See* Prelim. Resp. 20; *see also Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999). The body of claim 20 describes an outer case having a front, back, top edge, bottom edge, a front control, and a first and a second back control. Consequently, the body of the claim describes a structurally complete device. *See Schumer v. Lab. Computer Sys., Inc.*, 308 F.3d 1304, 1310 (Fed. Cir. 2002) (if the body of the claim “sets out the complete invention,” the preamble is not ordinarily treated as limiting the scope of the claim).

Patent Owner’s reliance on *Eaton* is unpersuasive because here the body of the claim recites a structurally complete device while in *Eaton* the steps recited in the body of the claim referred to structures only identified in the preamble. *See* Prelim. Resp. 20–21; *Eaton Corp. v. Rockwell Int’l Corp.*, 323 F.3d 1332, 1339–40 (Fed. Cir. 2003). *Pacing Technologies*, also relied on by Patent Owner, is distinguishable because in *Pacing Technologies* two terms in the preamble were necessary to understand positive limitations in the body of the claim, while here, the preamble term “controller” is not

necessary to understand any limitation in the body of the claim. *See* Prelim. Resp. 21; *Pacing Techs. LLC. v. Garmin Intern. Inc.*, 778 F.3d 1021, 1024 (Fed. Cir. 2015).

Patent Owner contends that the Specification contains clear and unmistakable claim scope disavowal. Prelim. Resp. 21–24. For the reasons that follow, we disagree.

The portions of the Specification relied on by Patent Owner do not manifest exclusion or restriction, and therefore, do not rise to the level of disavowal. *See* Prelim. Resp. 21–24; *Martek Biosciences Corp. v. Nutrinova, Inc.*, 579 F.3d 1363, 1381 (Fed. Cir. 2009). That is, the '525 patent does not state or imply that the invention only covers controllers that may be held in both hands nor does it state or imply that it does not cover controllers that may be held in one hand. Further, the descriptions that the device is held in both hands (*e.g.*, “shaped to be held in both hands of a user”) is not limiting because the language of claim 20 is broader (*i.e.*, “held in the hand of a user”). Ex. 1001, Abstract, 1:52–56, 6:19–20; *Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004) (“Though understanding the claim language may be aided by the explanations contained in the written description, it is important not to import into a claim limitations that are not a part of the claim. For example, a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment.”).

Patent Owner’s contentions that there is no dispute are mischaracterizations. *See* Prelim. Resp. 24–25. Petitioner’s reference to the claimed device as a “game controller” and as a device that is “held and

operated by a user” does not suggest that claim 20 is limited to controllers that are held in and operated by both hands of a user. *See* Pet. 15. Our observation in the institution decision for the first Petition that the ’525 patent relates to hand held controllers does not suggest that claim 20 is limited to controllers that may be held in and operated by both hands of a user. *See* Dec. 5. Similarly, our observation in the institution decision for the first Petition in IPR2016-00949 that “conventional controllers were intended to be held and operated by the user using both hands” is a general description and does not suggest that claim 20 is limited to controllers that may be held in and operated by both hands of a user. IPR2016-00949, Paper 10, 25.

Claim 20 is not limited to a controller that is held in and operated by both hands of a user, nor is the preamble otherwise limiting. Rather, the preamble of claim 20 describes an intended use (as a controller for a game console) of the structurally complete outer case recited in the body of the claim.

### III. PATENTABILITY

#### A. EVIDENCE AND GROUNDS OF UNPATENTABILITY

Petitioner asserts the following grounds of unpatentability:

(1) Claims 1, 2, 4–7, 12, 16, 17, and 20 as unpatentable under 35 U.S.C. § 103(a) over Wörn<sup>3</sup>;

(2) Claims 1–3, 6, 8–11, and 13 as unpatentable under 35 U.S.C. § 103(a) over Wörn and Enright<sup>4</sup>;

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<sup>3</sup> U.S. Patent 6,362,813 B1, issued Mar. 26, 2002 (Ex. 1003).

<sup>4</sup> U.S. Pub. 2010/0073283 A1, published Mar. 25, 2010 (Ex. 1004).

(3) Claims 14–16 and 19 as unpatentable under 35 U.S.C. § 103(a) over Wörn and Date<sup>5</sup>;

(4) Claims 14, 15, and 19 as unpatentable under 35 U.S.C. § 103(a) over Wörn and Lee<sup>6</sup>;

(5) Claim 18 as unpatentable under 35 U.S.C. § 103(a) over Wörn and Oelsch<sup>7</sup>.

Pet. 13–14.

B. GROUND S

1. Wörn

Petitioner asserts that claims 1, 2, 4–7, 12, 16, 17, and 20 are unpatentable as obvious over, or anticipated by, Wörn. Pet. 23–32 (regarding anticipation, *see* Pet. 23, n.1).

a) Claims 1, 2, 4–7, 12, 16, 17

With regard to the requirement that the elongate member is “inherently resilient and flexible” as claimed, Petitioner asserts that,

It is necessary and inherent that control buttons such as Wörn’s switching keys 21 are resilient and flexible, because otherwise a user would not be able to repeatedly displace the buttons to accomplish the control function intended for such buttons. *See* the Rempel ‘525 Decl., Exhibit 1009, at ¶ 19, p. 4. *See also*, MPEP § 2112 (“The express, implicit, and inherent disclosures of a prior art reference may be relied upon in the rejection of claims under 35 U.S.C. 102 or 103.”)

Moreover, the Office may take official notice that it was notoriously old and well known common knowledge in the art to make a control button resilient and flexible, for example to

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<sup>5</sup> U.S. Patent 6,153,843, issued Nov. 28, 2000 (Ex. 1005).

<sup>6</sup> U.S. Patent 6,364,771 B1, issued Apr. 2, 2002 (Ex. 1006).

<sup>7</sup> U.S. Patent 4,032,728, published June 28, 1977 (Ex. 1007).

enable users to repeatedly displace the buttons whenever desired. *See* the Rempel '525 Decl., Exhibit 1009, at ¶ 19, p. 4. *See also*, MPEP § 2144.03 (“Reliance on Common Knowledge in the Art”).

Pet. 26–27.

Based on this, Petitioner asserts that Wörn’s switching keys 21 must be resilient and flexible as claimed because they can be repeatedly displaced. The cited evidence echoes the Petition. *See* Ex. 1009 ¶ 19. The ability to be repeatedly displaced relates to resilience as claimed. Petitioner has not addressed how Wörn’s switching keys 21 are flexible as claimed (*i.e.*, may be bent or flexed).

Regarding official notice, Manual of Patent Examining Procedure (MPEP) § 2144.03 pertains to notice by an examiner, and says nothing about notice in an *inter partes* review. *See generally* *Washington Inventory Services v. RGIS, LLC*, Case CBM2014-00158, slip op. at 38 (PTAB Dec. 30, 2015) (Paper 40); *see also* 37 C.F.R. § 42.104(b)(4) (requiring petitioners to demonstrate how the claim is unpatentable to include where each element of the claim is found in the prior art). Further, even assuming we may take official notice, Petitioner has not persuaded us that making buttons inherently resilient and flexible as of the critical date of the '525 patent is “capable of instant and unquestionable demonstration as being well known.” *See* MPEP § 2144.03.A. Nor is the Declaration of Mr. Rempel persuasive on this point, as Mr. Rempel merely concludes that this characteristic was well known and does not provide any underlying facts or data for that conclusion. *See* 37 C.F.R. § 42.65. Even if we were to take notice as requested, Petitioner only addresses the characteristic of resilience and not flexibility.

On the record before us, Petitioner has not demonstrated a reasonable likelihood of prevailing in the contention that claims 1, 2, 4–7, 12, 16, and 17 are unpatentable as anticipated by, or obvious over, Wörn.

b) Claim 20

Independent claim 20 is similar to claim 1, except that the elongate members are not required to be inherently resilient and flexible.

Petitioner contends that Wörn’s hand held programming device 10 corresponds to a hand held controller for a game console as claimed. Pet. 29–30. Petitioner contends that Wörn’s controller includes an outer case having a front, back, top edge, and bottom edge as claimed. *Id.* at 30. Petitioner contends that Wörn’s function keys and thumb ball pad each correspond to a front control as claimed. *Id.* at 30–31. Petitioner contends that Wörn’s switching keys 21 are elongated and correspond to a first and a second back control as claimed. *Id.* at 31–32.

Thus, Petitioner contends that Wörn discloses each limitation. Petitioner does not identify any difference between Wörn and the claimed subject matter, nor does Petitioner propose to modify Wörn in any way. Consequently, Petitioner has provided a showing of likely anticipation, but not of obviousness over Wörn alone.

Patent Owner argues that Wörn is not analogous art. Prelim. Resp. 32–37. This assertion is not relevant to a ground of unpatentability based on anticipation.

Patent Owner argues that Wörn does not disclose a hand held controller for a game console. Prelim. Resp. 37–38; *see also* 20–25 (contending that the preamble is limiting). As explained above, the preamble to claim 20 describes an intended use for the structurally complete

device described in the body of the claim. At this stage of the proceeding, we are persuaded by Petitioner's contention that Wörn discloses such a device.

On the record before us, Petitioner has demonstrated a reasonable likelihood of prevailing in the contention that claim 20 is unpatentable as anticipated by Wörn.

2. Obviousness over Wörn and Enright

Petitioner contends that claims 1–3, 6, 8–11, and 13 are obvious over Wörn and Enright. Pet. 33–41. In this ground of unpatentability, Petitioner contends that Enright discloses elongate members that are inherently resilient and flexible as claimed because Enright's buttons may be depressed and return to the same position after force is removed. *Id.* at 38.

Our analysis here parallels that of claim 1 in the previous ground. Specifically, Petitioner does not address the requirement that the elongate members are flexible.

Accordingly, on the record before us, Petitioner has not demonstrated a reasonable likelihood of prevailing in the contention that claims 1–3, 6, 8–11, and 13 are unpatentable as obvious over Wörn and Enright.

3. Remaining Grounds<sup>8</sup>

In each of the remaining grounds, Petitioner relies on Wörn with regard to the elongate members being inherently resilient and flexible just as for claim 1 of the first ground analyzed above. *See* Pet. 42, 46, 50 (referring in each ground to the earlier discussion of Wörn). Thus, these grounds of

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<sup>8</sup> Obviousness over Wörn and either Date, Lee, or Oelsch.



unpatentability suffer from the same shortcoming as the ground based on Wörn alone.

#### IV. OTHER MATTERS

##### A. JOINDER AND CONSOLIDATION

Joinder is not appropriate in this case. Petitioner's only reason that joinder is appropriate is the overlap in prior art references in the two proceedings. *See* Mot. 5–8. As detailed above, the only ground of unpatentability that Petitioner has demonstrated a reasonable likelihood of prevailing on is anticipation by Wörn. *See* Opp. 9 (arguing that a new ground of unpatentability counsels against joinder). Petitioner did not rely on Wörn in the first Petition, and consequently, there is no overlap in the prior art.

In seeking joinder, Petitioner repeatedly emphasizes that it was Patent Owner's amendment of the complaint to add the '229 patent to the related litigation that caused Petitioner to discover the Wörn reference. *See, e.g.*, Mot. 4–5, 8–9, Pet. 5–6, 8, 9, 10–11. Petitioner contends that Patent Owner would not be prejudiced by joinder because it was Patent Owner's actions that led to discovery of Wörn. Mot. 8–9. Essentially, Petitioner asserts that because Patent Owner is responsible for the belated discovery of Wörn, Patent Owner cannot complain of prejudice. We agree with Patent Owner that Petitioner inappropriately seeks to attribute the reason for delay to Patent Owner. *See* Opp. 9–10. Petitioner has not alleged, nor are we aware of, any obligation Patent Owner was under to include the '229 patent with the original complaint in the related litigation. The fact that the '229 and

'525 patents are in the same area of technology (*see, e.g.*, Mot. 4, 8; Pet. 5–6) is immaterial. The '229 and '525 patents are not related.

Petitioner has not persuaded us that joinder is appropriate in these circumstances. *See* 35 U.S.C. § 315(c) and 37 C.F.R. §§ 42.20(c), 42.122(b).

Petitioner contends that consolidation is appropriate for the same reasons that joinder is appropriate. Mot. 8. This contention is unpersuasive for the reasons given above.

B. 35 U.S.C. § 325(d)

The Board has the authority under 35 U.S.C. § 325(d) to reject a petition when the same or substantially the same prior art or arguments previously were presented in another proceeding before the Office. Here, we institute only on Wörn, a reference that was not used in the first Petition. This ground does not involve substantially the same prior art or argument, and for that reason we decline to reject this Petition under 35 U.S.C. § 325(d). *See* Prelim. Resp. 6–17; Pet. 4–11.<sup>9</sup>

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<sup>9</sup> The contentions of the parties were written with respect to all the asserted grounds of unpatentability and must be considered in the context that we are instituting on Wörn only.

## V. CONCLUSION

For the foregoing reasons, we do not institute on the following grounds of unpatentability:

(1) Claims 1, 2, 4–7, 12, 16, and 17 as anticipated by Wörn under 35 U.S.C. § 102(b), or as unpatentable under 35 U.S.C. § 103(a) over Wörn or;

(2) Claims 1–3, 6, 8–11, and 13 as unpatentable under 35 U.S.C. § 103(a) over Wörn and Enright;

(3) Claims 14–16 and 19 as unpatentable under 35 U.S.C. § 103(a) over Wörn and Date;

(4) Claims 14, 15, and 19 as unpatentable under 35 U.S.C. § 103(a) over Wörn and Lee; and

(5) Claim 18 as unpatentable under 35 U.S.C. § 103(a) over Wörn and Oelsch.

At this stage of the proceeding, the Board has not made a final determination as to the patentability of any challenged claim or any underlying factual and legal issues.

## VI. ORDER

Accordingly, it is

ORDERED that *inter partes* review is *instituted* with respect to claim 20 as unpatentable under 35 U.S.C. § 102(b) as anticipated by Wörn;

FURTHER ORDERED that no other ground of unpatentability is authorized for this *inter partes* review;

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(a), *inter partes* review of the '525 patent is hereby instituted commencing on the entry date of this Order, and pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial; and

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FURTHER ORDERED that Petitioner's Motion for Joinder/  
Consolidation is denied.

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 IPR2017-00136  
Patent 8,641,525 B2

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

WEATHERLY, *Administrative Patent Judge, concurring*.

I concur with the majority decision in all respects except for the  
reasons expressed in Part IV.A. for denying the motion for joinder.

Nevertheless, I concur in the result of denying the motion for joinder.

Case IPR2017-00136  
Patent 8,641,525 B2

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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 IPR2016-00948  
Patent 8,641,525 B2

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

KAUFFMAN, *Administrative Patent Judge*.

FINAL WRITTEN DECISION

35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

## I. INTRODUCTION

### A. OVERVIEW

Valve Corporation (“Petitioner”) filed a corrected Petition (Paper 4, “Pet.”) requesting *inter partes* review of claims 1–20 of U.S. Patent No. 8,641,525 B2 (Ex. 1001, “the ’525 patent”). Pet. 1. Ironburg Inventions Ltd. (“Patent Owner”) filed a Preliminary Response (Paper 7, “Prelim. Resp.”) to the Petition. We instituted an *inter partes* review of claims 1–11, 13, 14, and 16–20, and did not institute review of claims 12 and 15. Paper 10 (“Dec.”).

Subsequently, Patent Owner filed a Patent Owner Response (Paper 19, “PO Resp.”), and Petitioner filed a Reply (Paper 23, “Pet. Reply”).

Oral hearing was held on June 5, 2017, and a transcript of the oral hearing is included in the record. Paper 36 (“Tr.”).

We have jurisdiction under 35 U.S.C. § 6(b). This Final Written Decision is issued pursuant to under 35 U.S.C. § 318(a) as to the patentability of the claims on which we instituted trial.

For the reasons that follow, we determine that Petitioner has shown by a preponderance of the evidence that claims 1, 6, 13, 14, 16, 17, 19, and 20 of the ’525 patent are unpatentable, but has not made such a showing with regard to claims 2–5, 7–11, and 18. *See* 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d).

### B. RELATED PROCEEDINGS

The parties indicate that the ’525 patent is at issue in: *Ironburg Inventions Ltd. v. Valve Corp.*, Case No. 1:15-cv-04219-MHC (N.D. Ga.). Pet. 1; Paper 6, 1.



Petitioner also filed a petition against U.S. Patent 9,089,770 B2 (“the ’770 patent”), the subject of *inter partes* review IPR2016-00949 (“the ’949 IPR”). The ’770 patent issued from an application that was a continuation of application 13/162,727, now the ’525 patent. These *inter partes* reviews have proceeded on the same schedule.

Petitioner filed a second petition against both the ’525 patent and the ’770 patent (IPR2017-00136 and IPR2017-00137, respectively), and each petition was accompanied by a Motion for Joinder/Consolidation. In IPR2017-00136, we instituted review of claim 20 and denied the Motion for Joinder/Consolidation. IPR2017-00136, Paper 12. In IPR2017-00137, we denied institution and denied the Motion for Joinder/Consolidation. IPR2017-00137, Paper 10.

## II. PRELIMINARY MATTERS

### A. PATENT OWNER’S MOTION TO EXCLUDE EVIDENCE

Patent Owner moves to exclude (1) Exhibits 1025–1027 and the associated Paper (Paper 25), and (2) Exhibit 1007. Paper 28. Petitioner filed an opposition to the Motion (Paper 32) and Patent Owner filed a Reply to the Opposition (Paper 33). Patent Owner has the burden of establishing that evidence should be excluded. *See* 37 C.F.R. § 42.20(c), § 42.22. For the reasons that follow, we *deny* Patent Owner’s Motion.

#### 1. Exhibits 1025–1027 and Associated Paper

Petitioner filed Exhibits 1025–1027 with an associated Paper (Paper 25) on April 13, 2017, as supplemental evidence in response to Patent Owner’s second set of objections to Exhibit 1007. *See* Paper 24 (Patent

Owner's second set of objections); Paper 25 (asserting that the subject information was only being used regarding the admissibility of Ex. 1007); Paper 32, 11–12 (acknowledging that the subject information is supplemental evidence only).

These Exhibits and the associated Paper are not evidence on the merits of this case; they are in the record for the limited purpose of the admissibility of Exhibit 1007. Consequently, these Exhibits and the associated Paper are not the proper subject of a Motion to Exclude.

2. *Exhibit 1007*

Exhibit 1007 is a United Kingdom (UK) Search and Examination Report for the counterpart to the application that became the '525 patent. Petitioner submitted Exhibit 1007 in association with the Petition, and as such, it is evidence submitted during a preliminary proceeding.<sup>1</sup> *See* 37 C.F.R. § 42.2 (defining preliminary proceeding).

A timely objection is a prerequisite to a Motion to Exclude. *See* 37 C.F.R. § 42.64(b)(1), (c). Patent Owner purports to have made three sets of objections to Exhibit 1007 in the following papers: (1) the Preliminary Response, (2) Paper 15, and (3) Paper 24. Paper 28, 1.

a) *Preliminary Response*

Patent Owner asserted in the Preliminary Response that Exhibit 1007 is “hearsay and is not prior art,” and “should be excluded in its entirety.” Prelim. Resp. 28.

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<sup>1</sup> Exhibit 1007 was served on Petitioner in association with Paper 1 (the original Petition) and was not served a second time with Paper 4 (the corrected Petition). *See* Paper 1, 61; Paper 4, 54. This distinction is immaterial to our analysis.

In our Decision to Institute, we explained that a preliminary response cannot serve as an effective objection for two reasons.<sup>2</sup> Dec. 4–5 (entered on September 27, 2016). First, objections must be made after institution of trial. *See* 37 C.F.R. § 42.64(b)(1) (objections are due ten days from institution of trial). Second, an objection and a preliminary response may not be combined into a single document. *See* 37 C.F.R. § 42.6(a)(3) (prohibiting combined documents).

*b) Paper 15*

On Wednesday, October 26, 2016, the Board held a conference call at Patent Owner’s request. Paper 13. During that call, Patent Owner asked again whether the Preliminary Response had served as a timely objection to Exhibit 1007. *See* Paper 13, 2–3. We reiterated that the statements in the Preliminary Response were not an effective objection, and explained that Patent Owner was raising the issue after expiration of the time-period for an objection. *Id.* at 3. Patent Owner maintained the request to object to Exhibit 1007. *Id.* Before ending the call, we informed the parties that we would enter an order shortly.

On Thursday, October 27, 2016, the next business day after the call, the Board entered the anticipated Order. Paper 13. In that Order, we permitted Patent Owner two business days (until Monday, October 31, 2016) to file objections to Exhibit 1007. *See* Paper 13, 4. Entry of that Order triggered an automated email to the email address of record entered by

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<sup>2</sup> In the interest of brevity, we incorporate by reference our analysis at Paper 13 pages 2–4.

Patent Owner. *See* Tr. 41:12–44:5 (summarizing the situation). On Tuesday, November 1, 2016, after the allotted period for filing objections had expired, Patent Owner filed objections. *See* Paper 13, 4; Paper 15, 1.

During the oral hearing, Patent Owner acknowledged filing the objections after the deadline. Tr. 44:15–16. Patent Owner elaborated that he received the email notice, but did not review the content of that notice because he was traveling, and because it was “buried with a whole bunch of other things.” Tr. 44:16–45:15. Patent Owner orally requested that we excuse the late filing of Paper 15 under 37 C.F.R. § 42.5(c)(3). Tr. 45:10–46:4.

Patent Owner knew that the objections were late when filed on November 1, 2016, and took no action until the oral hearing on June 5, 2017. Such lengthy inaction diminishes the persuasiveness of Patent Owner’s request to excuse its late filing of objections. *See* 37 C.F.R. § 42.25(b) (“A party should seek relief promptly after the need for relief is identified. Delay in seeking relief may justify a denial of relief sought.”) Perhaps more importantly, a request to excuse a late action must be in the form of a motion. *See* 37 C.F.R. §§ 42.5(c)(3), 42.20. Patent Owner did not request authorization to file such a motion. Consequently, a proper request for relief is not before us.

Patent Owner did not submit Paper 15 within the allotted time, and consequently that Paper is not an effective set of objections.

*c) Paper 24*

In response to evidence relied upon in Petitioner’s Reply, Patent Owner filed another set of objections (Paper 24) including objections to Exhibit 1007.

Rule 42.64(b)(1) provides that during trial, objections must be filed within five business days of “service of evidence to which the objection is directed.” Petitioner served Exhibit 1007 on Patent Owner in association with the Petition, not in association with Petitioner’s Reply. Although Paper 24 was filed within five business days of filing of Petitioner’s Reply, it was not served within five business days of service of Exhibit 1007. Thus, by strict application of the rule, Paper 24 was not timely.

We recognize that under the Federal Rules of Evidence the use of evidence may affect the admissibility of that evidence. For example, a single piece of evidence might be capable of a use that would be inadmissible hearsay and a use that would not be hearsay. Thus, if evidence were submitted in association with a petition and relied upon in a first manner, and then relied upon in a second, different manner in a subsequent paper (e.g., petitioner’s reply), the second use could create a potential objection to that evidence that was not present with the use in the petition. Such a situation might warrant permitting the submittal of the subsequent paper (e.g., Petitioner’s Reply) to trigger an opportunity to submit an objection. *See* 37 C.F.R. § 42.5(b) (permitting waiver of requirements of part 42). With this in mind, we compare the objections of Paper 15 to those of Paper 24.

In Paper 24, Patent Owner asserts that Exhibit 1007: contains inadmissible hearsay under Federal Rule of Evidence (Fed. R. Evid.) 802; lacks proper authentication under Fed. R. Evid. 901; is irrelevant under Fed. R. Evid. 401; and, has probative value outweighed by one of the enumerated dangers of Fed. R. Evid. 403. Paper 24, 1–3.

Regarding hearsay, both sets of objections assert that Exhibit 1007 “is not prior art, not from before the application was filed, not sworn testimony, and is therefore hearsay not subject to any hearsay exception.” Paper 15, 3; Paper 24, 2. Further, in Paper 15, Patent Owner asserts that the portion of Exhibit 1007 that is quoted by Petitioner is hearsay because it is offered to prove the truth of the matter asserted, namely, “what was known in the art at the time of the invention.” Paper 15, 2–3 (citing Pet. 10–11 (citing Ex. 1007, 2)). Likewise, in Paper 24, Patent Owner asserts that the same portion of Exhibit 1007 is hearsay because it is offered to prove the truth of the matter asserted, namely, “what was known in the art at the time of the invention.” Paper 24, 2 (citing Pet. Reply, 21 (citing Ex. 1007, 2)). Patent Owner’s hearsay objections in Paper 24 have no meaningful distinction from the objections in Paper 15.

Regarding authentication, Patent Owner’s objections are the same. *Compare* Paper 15, 3 *with* Paper 24, 2–3.

Regarding relevance, in Paper 24, Patent Owner asserts that Exhibit 1007 is irrelevant, misleading, and confusing because the statements were not made in the context of the challenged claims or applicable United States law. Paper 24, 3. Patent Owner elaborates that Petitioner has not sufficiently explained the evidence. *Id.* Patent Owner makes no distinction between reliance on Exhibit 1007 in the Petition and in the Petitioner’s Reply.

Given that Petitioner relies on Exhibit 1007 in the same manner in the Petition as in the Reply,<sup>3</sup> and the lack of a meaningful distinction between the two sets of objections, we determine that Rule 42.64(b)(1) set the deadline for objecting to Exhibit 10017 as ten days after institution of trial and that waiver of this rule is not warranted.

In light of this, Patent Owner did not make a timely objection, and consequently we *deny* Patent Owner's Motion to Exclude.

B. EXHIBIT 1028

Petitioner filed Exhibit 1028, a duplicate of Exhibit 1027, in association with Petitioner's opposition to Patent Owner's Motion to Exclude. *See* Paper 32, 12–13. Petitioner did not seek Board authorization for filing a duplicate, and accordingly we expunge this Exhibit. *See* 37 C.F.R. § 42.6(d) (stating that documents already of record in the proceeding may not be filed without express Board Authorization); *see also* 37 C.F.R. § 42.7(a) (authoring the Board to expunge unauthorized papers).

C. SCOPE OF PETITIONER'S REPLY

During the oral hearing, Patent Owner objected to Petitioner's demonstrative exhibits as containing information beyond the scope of a permissible reply. Based on this, we authorized Patent Owner to file a paper identifying such information, and we authorized Petitioner a response.

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<sup>3</sup> In both the Petition and Petitioner's Reply, Petitioner relies on Mr. Donohoe's opinion as evidence of the state of the video game controller art as of the critical date of the '525 patent. *Compare* Pet. 9–11 *with* Pet. Reply 21.

Paper 37, 3–4 (authorization); Paper 39 (Patent Owner); Paper 41 (Petitioner). In the analysis that follows, we address these contentions with respect to information in Petitioner’s Reply that we rely upon in making this decision, but we do not address information that we did not rely upon.

### III. THE CLAIMED SUBJECT MATTER

#### A. INTRODUCTION

The ’525 patent relates to handheld controllers for video game consoles. Ex. 1001, 1:6–7.

As background, the ’525 patent describes that conventional controllers were intended to be held and operated by the user using both hands, and describes that the plurality of controls were mounted on the front and 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 ’525 patent was intended to address this problem. *Id.* at 1:41–45.

The controller of the ’525 patent is very similar to controllers of the prior art with respect to the outer case and the front and top controls. *Id.* at 2:15–20; *compare* Fig. 1 (prior art, *id.* at 2:61–62) to Figs 2, 3.

Controller 10 of the ’525 patent includes a plurality of controls on the front and 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). Figure 2 follows:



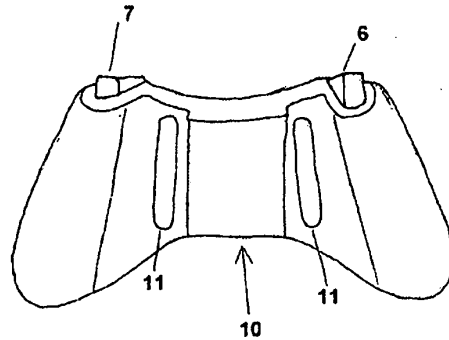


Figure 2

Figure 2 is a schematic illustration of the back of game controller 10. *Id.* at 2:63–64.

#### B. CHALLENGED CLAIMS

Of the challenged claims, 1 and 20 are independent. Claim 1 follows:

1. A hand held controller for a game console comprising:  
an outer case comprising
  - a front, a back, a top edge, and a bottom edge,  
wherein the back of the controller is opposite the front of  
the controller and the top edge is opposite the bottom edge;  
and
  - a front control located on the front of the controller;  
wherein the controller is shaped to be held in the  
hand of a user such that the user's thumb is positioned to  
operate the front control; and
  - a first back control and a second back control, each  
back control being located on the back of the controller  
and each back control including an elongate member that  
extends substantially the full distance between the top  
edge and the bottom edge and is inherently resilient and  
flexible.<sup>4</sup>

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<sup>4</sup> A line break was added for readability.

C. CLAIM INTERPRETATION

The Board interprets claims of an unexpired patent using the broadest reasonable interpretation. *See* 37 C.F.R. § 42.100(b).

For the purposes of this decision, and on this record, we determine that only the following claim terms require 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).<sup>5</sup>

1. *Directional References*

The claims recite words indicating relative position or direction such as “front,” “back,” “top,” and “bottom” without expressly stating a frame of reference for interpreting these words. In the Institution Decision, we interpreted directional words in the claims to be terms that merely distinguish one feature from another and define positions relative to each other. Dec. 8–9. For example, “front” is opposite the “back,” and the “top” is opposite the “bottom.” This is true because the ’525 patent explicitly states that directional words, such as front, back, top, and bottom, merely serve to distinguish those features from one another and do not limit the respective features to a particular static orientation. *Id.* at 8 (citing Pet. 11–12; Ex. 1001, 4:28–32). The parties do not challenge this interpretation, and we adopt it here.

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<sup>5</sup> Some aspects of claim construction, such as Patent Owner’s assertions regarding “flexible,” are addressed in the patentability analysis below.

2. *Thickness*

In the Institution Decision, we determined that the broadest reasonable interpretation of “thickness” as used in claims 9–11 is the dimension of the elongate member perpendicular to the surface of the elongate member (i.e., also the direction of displacement when the user activates the control function). Dec. 10–11. The parties do not challenge this interpretation, and we adopt it here.

3. *Extension of Elongate Members*

Independent claims 1 and 20 recite that each elongate member on the back of the controller “extends substantially the full distance between the top edge and the bottom edge” of the outer case of the controller. Claims 2–19 include this limitation by virtue of dependence from claim 1.

In the Institution Decision, we determined that the claims require that the elongate members extend largely but not necessarily the entire distance between the top and the bottom edges. Dec. 11–13. The parties do not challenge this interpretation, and we adopt it here.

4. *Recess*

Claim 7 recites “[t]he controller of claim 1, wherein each elongate member is mounted with a recess located in the case of the controller.”

Claim 8 recites, “[t]he controller of claim 7, wherein each elongate member comprises an outermost surface which is disposed in close proximity to the outermost surface of the controller such that a user’s fingers may be received in said respective recess.”

We address two aspects of the claimed “recess:” one, the direction of the recess, and two, whether the user’s fingers must be received in the recess.

*a) Direction of the Recessed Portion*

In the Petition, Petitioner asserted that, “any region between a first and second handle that is recessed *towards the front* of the video game controller can qualify as a ‘recess’” as claimed. Pet. 15 (emphasis added). In the Institution Decision, we determined that a “recess” as claimed is not limited to be recessed towards the front of the controller. Dec. 14–15. The parties do not contest this determination, and we adopt it here.

*b) User’s Fingers*

Patent Owner contends that a “recess” as claimed is required to receive a user’s finger and Petitioner argues the claims are not limited in that manner. PO Resp. 15–20; Pet. Reply 2–5. We disagree with Patent Owner’s assertion for several reasons.

First, in the Preliminary Response, Patent Owner asserted that the claim term “recess” should be given its ordinary meaning. Prelim. Resp. 9, 13; *see also* Pet. Reply 5 (pointing out this earlier statement). In the Response, Patent Owner asserts that a recess as claimed must receive the user’s fingers based on claim scope disavowal. PO Resp. 15–20. Patent Owner’s change in interpretation significantly undermines Patent Owner’s position.

Second, Patent Owner’s analogy to *AVX Corporation* is not persuasive because the claim interpretation to which Patent Owner analogizes was changed on rehearing. *See* PO Resp. 16–17 (citing *AVX*

*Corp. v. Greatbatch Ltd.*, Case No. IPR2015-00710, slip op. at 5–12, (PTAB Aug. 12, 2015) (Paper 9)); *AVX*, Paper 13 (PTAB Jan. 13, 2016) (rehearing).

Third, for the reasons that follow, claim 8 undermines rather than supports Patent Owner’s position. Claim 1 requires that the elongate members are located on the back of the controller, and dependent claim 7 adds that the elongate members are mounted in “a recess” located in the case of the controller. Ex. 1001, 4:40–55, 5:4–6. Claim 8 depends from claim 7 and adds that each elongate member includes an outermost surface that is disposed in close proximity to the outermost surface of the controller so that a user’s finger may be received in the recess. The presence of the explicit requirement in claim 8 that the recess receives the user’s fingers suggests that a recess as recited in claim 7 does not include such a requirement. *See Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 910 (Fed.Cir. 2004) (the presence of a dependent claim that adds a particular limitation gives rise to a presumption that the limitation in question is not present in the independent claim).<sup>6</sup> In other words, if, as Patent Owner contends, a recess as claimed must receive the user’s fingers, such interpretation would render the explicit requirement in claim 8 superfluous. *Bicon Inc. v. Straumann Co.*, 441 F.3d 945, 950 (Fed. Cir. 2006) (“[C]laims are interpreted with an eye toward giving effect to all terms in the claim.”); *Stumbo v. Eastman Outdoors, Inc.*, 508 F.3d 1358, 1362 (Fed. Cir. 2007) (denouncing claim constructions that render phrases in claims superfluous).

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<sup>6</sup> We presume this principle applies to claim 8 by virtue of dependence from claim 7 even though claim 7 is not independent.

The '525 patent does not include a lexicographical definition of “recess.” An ordinary meaning of a “recess” is “an indentation in a line or a surface (as an alcove in a room).” *See* Ex. 2005, 435<sup>7</sup> (defining recess); *see also* PO Resp. 16 (asserting that this definition of recess is the ordinary meaning, but contending such meaning does not apply due to claim scope disavowal). The claims recite that a recess as claimed is included in the back of the outer case of the controller (a surface). This suggests that the claims require the back of the outer case of the controller to include an indentation. We consider this ordinary meaning in light of the Specification.<sup>8</sup>

The '525 patent describes that

Preferably, each elongate member is mounted within a respective recess located in the case of the controller.

Preferably, each elongate member comprises an outermost surface which is disposed in close proximity to the outermost surface of the controller such that the user's finger's may be received in said respective recess.

Ex. 1001, 1:62–67. The '525 patent describes that the

controller of the present invention is particularly advantageous over controllers according to the prior art as it comprises one or more additional controls located on the back of the controller in a position to be operated by middle fingers of a user.

*Id.* at 2:21–25. The '525 patent describes that

The paddles 11 are mounted within recesses located on the case of the controller 10; and are disposed in close proximity to the outer surface of the controller body. In this way a user may engage the paddles 11 with the tips of the fingers, preferably the

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<sup>7</sup> This refers to the native page number of the Exhibit.

<sup>8</sup> The disclosures that follow are those portions of the '525 patent cited by Patent Owner as evidencing disavowal.

middle fingers, without compromising the user's grip on the controller 10.

*Id.* at 3:39–44. Figure 3 of the '525 patent, as annotated by Patent Owner, follows.

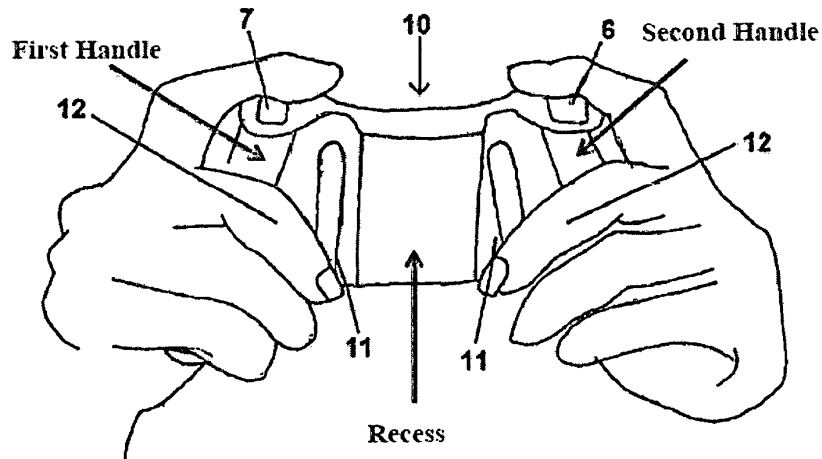


Figure 3

Annotated Figure 3 depicts the back of a game controller as held and operated by a user, and includes Patent Owner's identification of the first and second handle and the recess. *See* PO Resp. 19; Ex. 1001, 2:65–67.

Patent Owner's argument is that the '525 patent expresses a clear intent to disavow controllers having a recess that does not receive a user's fingers. *See* PO Resp. 17–22. Stated in a positive sense, Patent Owner argues that the '525 patent expresses a clear intent to cover only recesses that receive a user's fingers. Patent Owner does not identify, nor do we discern, any explicit disclosure in the '525 patent that the invention includes only recessed portions that receive a user's fingers. The description that “preferably” each elongate member is mounted in a recess such that a user's finger may be received in the recess is an exemplary disclosure of a

preferred embodiment. *See* Ex. 1001, 1:62–67. Likewise, the disclosures that the elongate members (e.g., paddles 11) are mounted within recesses so that a user may engage the elongate members with the tips of the fingers are exemplary. *See id.* at 2:21–25, 3:39–44, Fig. 3. Consequently, the '525 patent does not express a clear intent to limit the claimed invention to recessed portions that receive a user's fingers. *See e.g., SciMed Life Sys. Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1341 (Fed.Cir. 2001); *see also Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1571 (Fed.Cir. 1988) (“Although the specification may aid the court in interpreting the meaning of disputed claim language, particular embodiments and examples appearing in the specification will not generally be read into the claims.”).

In light of the disclosures above, the ordinary meaning that a recess is an indentation is consistent with the Specification.

The claims require that the outer case of the controller includes a recess (indentation), and the claims are not limited to a recess that permits receipt of a user's fingers.

#### 5. *Handheld Controller*

Patent Owner contends that a “handheld controller” as recited in independent claims 1 and 20 requires that the controller must be “held in and operated by both hands of a user.” PO Resp. 9. Our inquiry focuses on two aspects of Patent Owner's contention: one, whether the device must be held in a single hand or in both, and two, whether the operability requirement precludes support of the controller from other than the user's hands. We address these contentions in turn.



*a) Single Hand or Both Hands*

In support of the argument that claims 1 and 20 each require the controller to be held in and operated by both hands of a user, Patent Owner contends that the preamble is limiting, that a controller that may be held in one hand has been disavowed, and that the ordinary meaning supports such an interpretation. PO Resp. 9–14, 23–26, Paper 38, 1–2.

As detailed below in the analysis of the ground of unpatentability based on anticipation by Tosaki, Petitioner has demonstrated adequately that Tosaki’s controller may be held in and operated by one or both hands. Consequently, we need not determine if the claims are limited as Patent Owner asserts. *See Wellman, Inc. v. Eastman Chem. Co.*, 642 F.3d 1355, 1361 (Fed. Cir. 2011) (Claim terms need only be construed to the extent necessary to resolve the controversy).

*b) Preclusion of Other Support*

We begin by clarifying Patent Owner’s contention. Patent Owner contends that Tosaki’s controller is not “handheld” as claimed because it is held between a player’s thighs. PO Resp. 23–26; Tr. 107:11–14. This contention implies the underlying claim interpretation that the claims preclude support by anything other than a player’s hands. During the oral argument, we asked Patent Owner if their argument was that the claims preclude support from other than a user’s hands. Tr. 107:15–19. Patent Owner replied, “No, your honor. My argument is that it must be – must be held by the hand and operated while being held in the hand.” *Id.* at 107:20–22; *see also* 112:8–9 (stating “We’re not saying no to other support other than the hands.”). Patent Owner elaborated that Tosaki’s device would not be operable for its intended purpose when supported only by a user’s hands

because without such support the steering wheel would not be able to move relative to the steering wheel base. *Id.* at 108:18–111:16. In other words, the steering wheel only operates properly with support other than the user’s hands (e.g., the base resting on a table or held between a user’s thighs). Although Patent Owner disagrees, Patent Owner’s argument is premised on the interpretation that the claims require the device to be fully operable when supported only by the user’s hands, which precludes support from other than the user’s hands.

The preamble of claims 1 and 20 each recite, “A handheld controller for a game console comprising.” The body of each claim recites that, “the controller is shaped to be held in the hand of a user such that the user’s thumb is positioned to operate the front control.” The language of claims 1 and 20 requires the controller to be handheld and requires the controller to have a particular shape (i.e., a shape permitting the user’s thumb to be positioned to operate the front control).

The language of the claims does not support Patent Owner’s argument. *See Renishaw PLC*, 158 F.3d 1243, 1248. Neither claim explicitly recites that the controller is (1) supported only by the user’s hands or (2) is operable only when supported only by the user’s hands alone. Further, claims 1 and 20 each use the open-ended term “comprising,” so that other support (e.g., a user’s thighs or a steering wheel base) is not precluded. *See Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501 (Fed. Cir. 1997) (“Comprising” is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim.).

Patent Owner repeatedly emphasizes that the proffered interpretation is the ordinary meaning of “handheld.”<sup>9</sup> *See, e.g.*, Tr. 106:15–22; 112:8–16; 116:10–12. In support, Patent Owner contends the ordinary meaning of “handheld” is, “held in the hand; *esp* to be operated while being held in the hand.” PO Resp. 14 (citing Ex. 2004, p. 526). This definition does not preclude support other than a user’s hands; rather, it means that the device must be held in the hand and operable when so held. With this ordinary meaning in mind, we turn to the claims.

The ordinary meaning of “handheld” as being held in the hand and operable when so held is consistent with the Specification. *See, e.g.*, Ex. 1001, Abstract, 1:49–56, 3:14–15, Fig. 3. That ordinary meaning does not preclude support from other than a user’s hands.

Patent Owner’s argument is unpersuasive for other reasons. First, Patent Owner contends that Tosaki’s steering function is inoperable when the device is held only in the hands, but Patent Owner makes no such assertion regarding operation of Tosaki’s controls that correspond to claimed controls (i.e., the front control and first and second back controls). In other words, Patent Owner does not contest that the controls corresponding to the claimed controls are operable when Tosaki’s device is held in and operated by both hands without other support. *See generally*, Tr. 138:17–151:19. Patent Owner’s contention regarding an additional unclaimed function (steering) is inapposite.

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<sup>9</sup> Patent Owner does not allege, nor do we discern, a lexicographical definition of “handheld” in the ’525 patent.

Second, claims 1 and 20 are apparatus claims, and consequently cover what the device is and not what the device does. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1468 (Fed. Cir. 1990) (“[A]pparatus claims cover what a device *is*, not what a device *does*.”). Patent Owner’s argument is to some degree based on a use of the device and not the structure of the device. Petitioner illustrated this point well by pointing out that a video controller user might rest the controller on their lap (providing support other than the hands), yet this does not change the structure of the device. *See* Tr. 67:18–69:2; *see also* 115:1–117:14 (questioning Patent Owner on this point).

Patent Owner has not persuaded us that a “handheld” controller as claimed must be operable when supported only by the hands of a user. In other words, the claims do not preclude support of the controller from other than the user’s hands.

6. *Claim 13*

Claim 13 depends from claim 1 and recites, “wherein the elongate members converge towards the front end of the controller with respect to one another.”

In our Institution Decision, we asked the parties to further address proper interpretation of this claim. Dec. 9.

Patent Owner contends that claim 13 requires two types of convergence: one, each of the elongate members converge towards the front of the controller, and two, the elongate members converge towards one

another towards the front end of the controller.<sup>10</sup> PO Resp. 20–23; *see generally* Tr. 138:17–151:19 (discussing this limitation). We address these contentions in turn.

*a) Convergence Between Each Elongate Member and the Front*

Claim 13 recites that the elongate members come closer together (“converge. . . with respect to one another”) in a specified direction (“towards the front end of the controller”). Claim 13 only requires convergence between the elongate members without requiring convergence between each of the elongate members and the front of the outer case. Consistent with that interpretation, the ’525 patent does not contain any description of convergence between each elongate member and the front of the controller. Accordingly, Patent Owner’s assertion that claim 13 requires the elongate members to converge towards the front of the controller is not persuasive.

*b) Convergence Between the Elongate Members*

The claim term “the front end” lacks an antecedent basis. Patent Owner asks that we read “front end” to mean “front” so that “a front” is the antecedent basis for “the front end.” PO Resp. 20–23; *see also* Tr. 144:10–14 (indicating that “front end” and “front” are synonymous in claim 13). Yet Patent Owner does not identify, nor do we discern, any disclosure in the ’525 patent indicating that the terms “front end” and “front” refer to the same portion of the controller. We agree with Petitioner that Patent Owner’s interpretation is disfavored because it effectively reads out the term “end.”

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<sup>10</sup> Patent Owner does not contend that claim 13 contains a typographical error.

See PO Resp. 20–23; Pet. Reply 5–7; *Bicon Inc.*, 441 F.3d at 950; *Stumbo*, 508 F.3d at 1362; Patent Owner cites no persuasive authority for such an interpretation.

We further analyze claim 13 by looking at the structure of the apparatus in light of claim language and the Specification.

Claim 13, by virtue of dependence from claim 1, recites that the front of the outer case of the controller is opposite the back, and the top edge of the outer case of the controller is opposite the bottom edge. Figures 1 and 2 of the '525 patent follow.

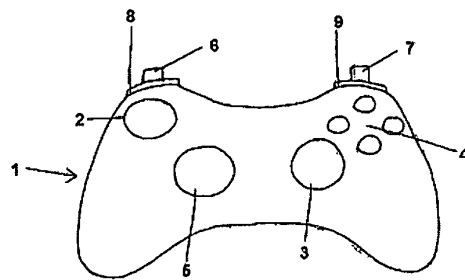


Figure 1

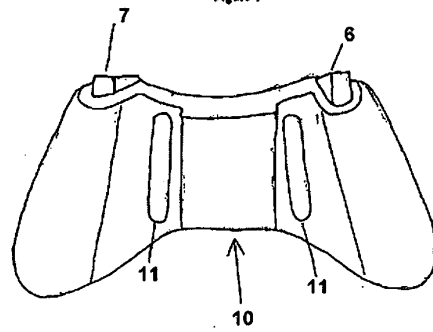


Figure 2

Figure 1 depicts the front of the controller, and Figure 2 depicts the back of the controller.<sup>11</sup> Ex. 1001, 2:61–64.

In parity with the claim language, the '525 patent describes that the top edge of the controller is the portion of the front and the back of the controller near the top as oriented in Figures 1 and 2. *Id.* at 1:27–29 (describing that left bumper 8 and right bumper 9 are located on the top edge of controller 1); 1:29–30, 52–56 (describing left and right triggers 6 and 7 as operated by a user's index fingers and located at the top edge of the controller). Because claim 13 recites that the bottom edge is opposite the top edge, the bottom edge is then the portion of the front and back of the controller near the bottom as oriented in Figures 1 and 2.

The '525 patent defines directional references as terms for distinguishing one feature from another. Ex. 1001, 4:26–31. In particular, the '525 patent identifies several terms in pairs to set the relationship between those elements, such as: top and bottom, front and back, end and side, inner and outer, and upper and lower. *Id.* Given these associations, and assuming the terms carry their ordinary meaning, the sides (left and right in Figure 1) of the controller would be orthogonal to the ends (top and bottom in Figure 1). From this perspective, the controller has two “front ends:” the portion of the front near the bottom edge, and the portion of the front near the top edge.

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<sup>11</sup> Figure 1 depicts a controller of the prior art, but it is the same as the controller of the '525 patent, except that two paddle levers 11 have been added to the back. Ex. 1001, 2:15–20, 3:13–24.

Outside of the claims, the '525 patent uses the term “converge” twice.

First, it describes in the *Summary of the Invention* that,

Preferably, there are two additional controls which are elongate members that are parallel to each another. In another embodiment, the elongate members *converge* towards the front end of the controller with respect to one another.

Ex. 1001, 2:4–7 (emphasis added). Second, it describes in the *Detailed Description of the Invention* that,

In one embodiment the paddles are orientated parallel with each other. In an alternative embodiment the paddles are orientated such that they *converge* towards the top edge with respect to each other.

*Id.* at 3:53–56 (emphasis added).

In each use of the term, the '525 patent contrasts the relationship between the elongate members as parallel to each other or as converging towards each other. That is, the elongate members become nearer to each other in a specified direction (i.e., towards either the front end of the controller or the top edge of the controller).<sup>12</sup>

Therefore, the '525 patent describes that the elongate members may converge towards the “top edge” of the controller (the top in Figures 1 and 2) or towards the “front end” of the controller (the top or the bottom of Figures 1 and 2).

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<sup>12</sup> We considered the '770 patent because, as detailed above, it is related. It describes, in claim 15, convergence between the elongate members “towards one another in a direction pointing from the bottom edge to the top edge.” This use is consistent with our analysis of “top edge,” but sheds no light on the meaning of “front end.”



Petitioner contends that we should reject Patent Owner’s assertion that “front end” means “front” because it is more plausible that “front end” means “top edge.” Pet. Reply 5–7. In making this assertion, Petitioner addresses the disclosure in the ’525 patent regarding the elongate members converging towards the top edge (Ex. 1001, 3:53–56), but does not address the disclosure regarding convergence towards the front end (Ex. 1001, 2:4–7). Consequently, Petitioner’s assertion does not persuade us “front end” means “front.”

A person of ordinary skill would understand claim 13 to require the elongate members to converge towards the front end, which may be either the portion of the front towards the top or the portion of the front towards the bottom. That is, claim 13 requires the elongate members to converge towards each other either in a direction from the top to the bottom or in a direction front the bottom to the top.

#### IV. PATENTABILITY

##### A. EVIDENCE AND ASSERTED GROUNDS OF UNPATENTABILITY<sup>13</sup>

We instituted *inter partes* review on the following grounds of unpatentability:

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<sup>13</sup> Our analysis of each ground of unpatentability should be viewed from the perspective that arguments not made by Patent Owner are waived. *See* Paper 11 ¶ 3 (cautioning Patent Owner that arguments not raised are waived).

Claims Challenged	§	References(s)
1, 6, 13, 14, 16, 17, 19, and 20	102(b)	Tosaki <sup>14</sup>
1–11, 13, 16, 17, and 20	103(a)	Enright <sup>15</sup> and Tosaki
18	102(a)	Enright, Tosaki, and Oelsch <sup>16</sup>

Dec. 30.

Petitioner relies on the Declarations of Dr. David Rempel. Ex. 1012; Ex. 1021 (reply declaration); *see also* Ex. 1009 (curriculum vitae);

Patent Owner relies on the Declaration of Dr. Glen Stevick. Ex. 2002; *see also* Ex. 2003 (curriculum vitae).

#### B. ANTICIPATION BY TOSAKI

Petitioner contends that claims 1, 6, 13, 14, 16, 17, 19, and 20 are unpatentable under 35 U.S.C. § 102(b) as anticipated by Tosaki (Ex. 1002). Pet. 18–29.

##### 1. *Independent claim 1*

##### a) *Ground of Unpatentability*

Tosaki discloses a video game controller that may be held in and operated by both hands, and includes an outer case comprised of a front (outer surface of front casing 120a) opposite a back (outer surface of back casing 120b) as called for in claim 1 of the '525 patent. Pet. 19; Ex. 1002, 8:63–64 (steering wheel 14 includes left and right hand grips 14a), Figs. 6, 7, 23, 24; Ex. 1008 ¶ 15 (opining that Tosaki's steering wheel is handheld); Pet. Reply 7–9; *see also* Ex. 1002, 10:64–67 (steering wheel 14 is comprised

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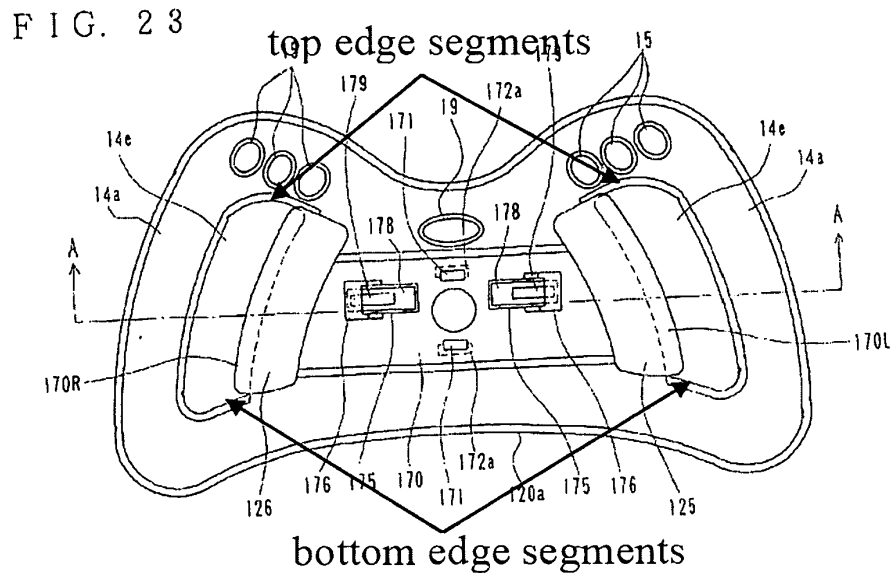
<sup>14</sup> U.S. Patent 5,989,123, published Nov. 23, 1999 (Ex. 1002).

<sup>15</sup> U.S. Pub. 2010/0073283 A1, published Mar. 25, 2010 (Ex. 1003).

<sup>16</sup> U.S. Patent 4,032,728, published June 28, 1977 (Ex. 1006).

of casings 120a, 120b), 13:6–17 (left and right shift levers 125, 126 may be operated to shift), Fig. 1 (depicting steering wheel held in and operated by both hands).

Tosaki's controller includes a top edge opposite a bottom edge as claimed. Pet. 19–20. An annotated version of Tosaki's Figure 23 follows.



Annotated Figure 23 is a diagram of the steering wheel of Tosaki's controller with Petitioner's arrows and labels identifying "top edge segments" and "bottom edge segments" as corresponding to a top edge and a bottom edge as claimed. Pet. 19–20; Ex. 1002, Fig. 23.

Tosaki's front control (push button switch 15) is located on the front of the outer case of the controller, and Tosaki's controller is shaped so that the front control is operable by the user's thumb. Pet. 20; Ex. 1002, 3:25–34; 9:47–53; Ex. 1002, Fig. 23.

Tosaki discloses first and second back controls (shift levers 125, 126) that are each located on the back of the controller (i.e., the side of steering

wheel 14 opposite the front side). Pet. 21; Ex. 1002, 9:1–3, 13:11–15, 62–65; 12:61–53; Figs. 2, 3, 23, and 24. Each back control (shift levers 125, 126) includes an elongate member that extends substantially the full distance between the top and the bottom edge of the controller as claimed. Pet 21–22; Ex. 1002, 13:24; Figs. 2, 3, 23.

Toaski's first and second back controls are inherently resilient and flexible as claimed in that shift levers 125 and 126 may be displaced and return to their original position and may be elastically deformed. Pet. 23; Ex. 1002 12:61–63, 14:19–24, Figs 23, 24; Ex. 1008 ¶ 18.

*b) Patent Owner Contentions*

Patent Owner challenges three aspects of Petitioner's ground of unpatentability.<sup>17</sup>

*(1) Handheld*

Patent Owner contends that Tosaki does not disclose a handheld controller that is held in and operated by both hands of a user. PO Resp. 23–26, 30. As detailed above, Tosaki's device can be held in and operated by both hands of the user. Pet. 19; Ex. 1002, 8:63–64 (steering wheel 14 includes left and right hand grips 14a), Figs. 6, 7, 23, 24; Ex. 1008 ¶ 15 (opining that Tosaki's steering wheel is handheld); Pet. Reply 7–9; *see also* Ex. 1002, 10:64–67 (steering wheel 14 is comprised of casings 120a, 120b), 13:6–17 (left and right shift levers 125, 126 may be operated to shift), Fig. 1 (depicting steering wheel held in and operated by both hands). Further, as detailed in our claim construction above, claim 1 does not preclude support

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<sup>17</sup> We cautioned Patent Owner that arguments not raised are waived. *See* Paper 11 ¶ 3.

other than the hands. For these reasons, Patent Owner's contention is unpersuasive.

*(2) First and Second Handles*

Patent Owner contends that Tosaki does not include first and second handles as required by claim 1. PO Resp. 27. Although claim 1 of the '770 patent recites first and second handles, claim 1 of the '525 patent does not. Patent Owner's argument is unpersuasive because it is not commensurate in scope with the claim. Pet. 17.

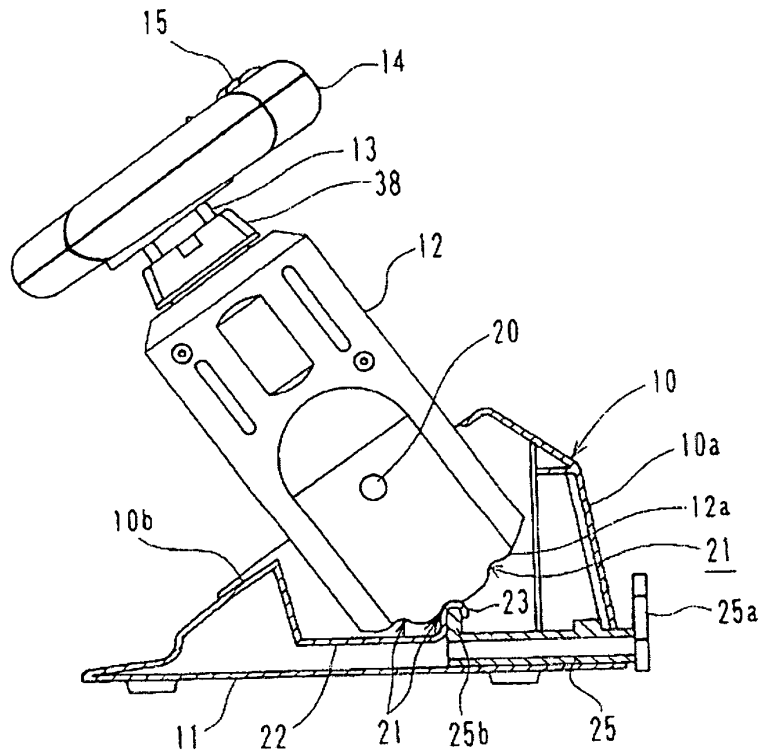
Regarding this argument and the one immediately preceding, Patent Owner argues that Petitioner's contention that hand grips 14 are "handles" is new argument and beyond the scope of a permissible reply. Paper 39, 1 (citing Pet. Reply 9). Patent Owner's argument implies that Tosaki is not handheld. We agree with Petitioner that the argument in Petitioner's Reply is not new (*see* Pet. 19 asserting that the "Tosaki controller is handheld"), and is properly proffered in response to Patent Owner's argument (*see* PO Resp. 27 asserting that Tosaki does not disclose the handles of claim 1). *See* Paper 41, 1.

*(3) Back of the Controller*

Patent Owner argues that Tosaki's gear shift levers 125 and 126 do not correspond to elongate members located on the back of the controller as claimed because the back of Tosaki's controller is bottom plate 11 of base casing 10, not the back of steering wheel 14. PO Resp. 27–29.

Tosaki's Figure 10 follows.

FIG. 10



Tosaki's Figure 10 is a side view of the steering wheel control apparatus. Ex. 1002, 7:25–28. Tosaki's steering wheel control apparatus includes a steering wheel 14, base casing 10, and bottom plate 11. Ex. 1002, 8:28–31, 8:41–56.

We agree with Petitioner (Pet. Reply 9–10) that nothing in claim 1 precludes the back of Tosaki's steering wheel 14 from corresponding to the back of the controller as claimed. As detailed in our claim construction

above, claim 1 is open-ended, so that additional components like base casing 10 with its bottom plate 11 are not precluded. Patent Owner's argument is not persuasive because it is not commensurate in scope with claim 1.

*c) Conclusion*

Petitioner has demonstrated by a preponderance of the evidence that Tosaki anticipates independent claim 1.

*2. Claims 6, 14, 16, 17, and 19*

Claims 6, 14, 16, 17, and 19 each depend from claim 1. Patent Owner does not present separate argument for these claims.

Claim 6 recites, "wherein each of the back controls is positioned to be operated by a middle finger of a user." Tosaki's back controls (shift levers 125 and 126) are positioned to be operated by a middle finger of a user. Pet. 23; Ex. 1002, 13:11–15; Ex. 1008 ¶ 19; *see also* Pet. 21 (discussing disclosures in Tosaki regarding fingers other than the thumb operating shift levers 125 and 126); Ex. 1002, Fig. 5 (depicting fingers, to include the middle finger as reaching the back of steering wheel 14), Figs. 1, 9.

Claim 14 recites, "wherein a portion of at least one of the first back control and the second back control is in registry with a switch mechanism disposed within the controller, such that displacement of the at least one back control activates the switch mechanism." Tosaki's shift levers 125 and 126 are in registry with first and second switch mechanisms (switch manipulation portion 176 of one of the operating portions 170R and 170L presses the operating piece 179 of the corresponding limit switch 178) to activate those mechanisms. Pet. 24; Ex. 1002, 13:47–58, Fig. 24; *see also*

Ex. 1002, 10:60–63 (describing that shift levers 125 and 126 are used to shift up and down).

Claim 16 recites, “wherein at least one of the back controls is a paddle lever.” Petitioner explains that, Tosaki’s “shift levers 126, 125 are paddle levers.” Pet. 24 (citing Ex. 1008 ¶ 14). The switch associated with Tosaki’s shift lever 126 is operated by pressure at distal end portion 126e that causes shift lever 126 to pivot about rotary shaft 127. Ex. 1002, 12:7–13:6, Figs. 6, 7.<sup>18</sup>

Claim 17 recites, “wherein at least one of the back controls is substantially parallel to the front of the controller.” Tosaki’s shift levers 125 and 126 are substantially parallel to the front of the controller (casing 120a of steering wheel 14). Pet. 25; Ex. 1002, Fig. 24; *see also* Ex. 1002, 7:65–8:2, 10:64–67 (steering wheel 14 is comprised of casings 120a and 120b), Fig. 6.

Claim 19 recites, “wherein at least one of the back controls is formed separate from the outer case of the controller.” Figures 23 and 24 of Tosaki depict shift levers 125, 126 as formed separate from outer case 120a, 120b. Pet. 25; Ex. 1002, Figs. 23, 24.

We conclude that Petitioner has demonstrated, by a preponderance of the evidence, that claims 6, 14, 16, 17, and 19 are anticipated by Tosaki.

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<sup>18</sup> Note that Patent Owner’s argument regarding paddle levers is only made against the ground of unpatentability based on Enright and Tosaki, not the ground at issue here. *See* PO Resp. 57–58.



3. *Claim 13*

Claim 13 depends from claim 1 and recites, “wherein the elongate members converge towards the front end of the controller with respect to one another.” As detailed in our claim construction above, claim 13 requires the elongate members to converge towards each other either towards the top of the controller or towards the bottom, but claim 13 does not require each elongate member to converge only towards the front of the controller

Petitioner cites to the reference and provides an annotated version of Tosaki’s Figure 23 to illustrate the limitation at issue. *See* Pet. 23–24 (citing Ex. 1002, Figs 2, 3, and 23). These Figures illustrate the Tosaki’s elongate members (shift levers 125, 126) converge in a direction towards the front end (the portion of the front near the top as depicted in Figure 23). This is assertion is supported adequately by the cited portions of Tosaki. Thus, contrary to Patent Owner’s argument, Petitioner’s assertion is supported by evidence. *See* PO Resp. 31.

Patent Owner argues that Tosaki does not disclose convergence between the pair of elongate members (gear shift levers 125, 126) and the front of the controller. PO Resp. 31–32. Such argument is unpersuasive because it is not commensurate in scope with claim 13.

We conclude that Petitioner has demonstrated, by a preponderance of the evidence, that claim 13 is anticipated by Tosaki.

4. *Independent claim 20*

Claim 20 is similar to independent claim 1 except that claim 20 does not require that the elongate members are inherently resilient and flexible. With the exception of that aspect of the elongate members, Petitioner relies on Tosaki in essentially the same manner as claim 1. *See* Pet. 25–29. Patent

Owner asserts the same arguments for patentability of claim 20 as those it asserts for patentability of claim 1. *See* PO Resp. 23–31. Thus, our analysis of claim 1 also applies to Petitioner’s challenge to claim 20.

Petitioner has demonstrated, by a preponderance of the evidence, that claim 20 is anticipated by Tosaki.

5. *Summary*

Petitioner has shown by a preponderance of the evidence that claims 1, 6, 13, 14, 16, 17, 19, and 20 are anticipated by Tosaki.

C. OBVIOUSNESS OVER ENRIGHT AND TOSAKI

Petitioner contends that claims 1–11, 13, 16, 17, and 20 are unpatentable under 35 U.S.C. § 103 as obvious over Enright and Tosaki. Pet. 29–41.

1. *Claims 1–11, 13, 16, and 17*

Independent claim 1 includes the requirement that each elongate member is “inherently resilient and flexible.” Consequently, each elongate member has two characteristics: it must be inherently resilient and it must be flexible. *See Bicon Inc.*, 441 F.3d at 950; *Stumbo*, 508 F.3d at 1362. Claims 2–11, 13, 16, and 17 include this limitation by virtue of dependence from claim 1.

In the Institution Decision, we determined that the ’525 patent expressly defines “inherently resilient” as returning from a loaded position to the unloaded position, and we determined that the ordinary meaning of “flexible” as “capable of being bent or flexed” is consistent with both the

context of the claim and the specification.<sup>19</sup> Dec. 14 (Ex. 1001, 3:34–35; Ex. 3001, 1 (adj., def. 1.a.)). In light of this, we determined that the claims require each elongate member to be inherently resilient and flexible in that it may be bent or flexed by a load, such as that from a user’s finger, and will then return to the unloaded position.

In the Petition, Petitioner relies on Enright as disclosing elongate members as claimed. Pet. 34–35. Specifically, Petitioner contends that Enright’s elongate members (mode switches 32, 34) return to normal after being released. *Id.* (citing Ex. 1003 ¶ 35; Ex. 1008 ¶ 22). This portion of Enright and Dr. Rempel’s Declaration address the ability of Enright’s elongate members to return to an unloaded position (i.e., inherently resilient as claimed) but do not address whether the elongate members may be bend or flex (i.e., flexible as claimed).

In the Reply, Petitioner argues that paragraph 35 of Enright would have suggested to a person of ordinary skill that “mode switches 32, 34 are or include some flexible element such as a spring, to provide the ubiquitous function that is described therein (i.e. depressing to a biased position, and releasing to return).” Pet. Reply 15 (citing Ex. 1021 ¶ 12). Petitioner elaborates that a flexible elongate member is obvious over Enright because Patent Owner did no invent flexible materials, and because a person of ordinary skill would have recognized that the functionality of mode switches

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<sup>19</sup> In the Institution Decision we used the term “unbiased position” rather than the term “unloaded position.” It is possible the elongate member is biased by a spring to the unloaded position so that the term “unloaded position” is a better choice than “unbiased.” This change does not impact our analysis.

32, 34 could have been obtained by making the elongate member flexible. *Id.* (citing Ex. 1021 ¶ 12).

The Petition fails to address a claimed characteristic of the elongate members (flexibility). *See* PO Resp. 39–41 (arguing that Enright does not disclose elongate members that are flexible as claimed). This cannot be corrected in Petitioner’s Reply. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,767 (Aug. 14, 2012) (a reply may not raise a new issue or belatedly present evidence); 35 U.S.C. § 312 (a)(3) (requiring petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”); 37 C.F.R. § 42.104(b)(4) (a petition for *inter partes* review must identify how the construed claim is unpatentable under the statutory grounds on which the petitioner challenges the claim and must specify where each element of the claim is found in the prior art patents or printed publications relied upon); *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1080 (Fed. Cir. 2015); *see also* Paper 39, 2 (pointing out that Petitioner is making a new argument).<sup>20</sup>

Petitioner has not demonstrated by a preponderance of the evidence that claim 1 is unpatentable under 35 U.S.C. § 103 as obvious over Enright and Tosaki. The same is true of claims 2–11, 13, 16, and 17 by virtue of their dependence from claim 1.

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<sup>20</sup> Petitioner argues that Patent Owner’s contention could not have been addressed earlier because the Board did not explicitly construe this claim limitation. Petitioner’s burden is not alleviated by the lack of a claim construction by the Board.

2. *Claim 20*

In contrast to independent claim 1, independent claim 20 does not include the requirement that the elongate members are inherently resilient and flexible.

a) *Level of Skill in the Art*

Before addressing the level of skill in the art, we address Mr. Donohoe's statement.

(1) *Mr. Donohoe's statement*

In the Petition, Petitioner asserted that Brendan Donohoe, a patent examiner from the United Kingdom (UK), was a person of ordinary skill in the art. Pet. 9–11 (submitting as Exhibit 1007 the UK Search and Examination Report prepared by Mr. Donohoe regarding the UK counterpart to the application that became the '525 patent).

In our Institution Decision, we observed that the Petition does not explain persuasively how observations from a UK patent examiner, which presumably are based on UK law and not United States law, are of use in our proceeding. Dec. 4. Petitioner asserts that Mr. Donohoe must be a person of ordinary skill because the level of ordinary skill is low, and because the UK Intellectual Property Office employed Mr. Donohoe to examine the video game controller art. Pet. Reply 16–17. Petitioner chose not to address our concern regarding the distinctions between United States and UK law. Because of those distinctions, Petitioner's assertions and evidence with regard to Mr. Donohoe are entitled to little or no weight. This shortcoming is not fatal to this ground of unpatentability because, as explained below, the prior art of record is reflective of the level of skill in the art.

*(2) Level of Skill in the Art*

In our Institution Decision, we determined that the prior art of record was indicative of the level of skill in the art. Dec. 4–5. We asked that if the parties further develop this issue, the focus should be on the role the level of skill in the art plays in an obviousness analysis. *Id.* 5.

Patent Owner contends that the level of skill in the art is relatively low and that “less than a year of experience or other training in controller assembly or tooling is required.” PO Resp. 34; Ex. 2002 ¶ 30 (Patent Owner’s expert opining that the level of skill is “no more than a year of experience or other training in controller assembly or tooling”). Patent Owner bases this level of skill on the education level of the inventor and the type of problems encountered in the art. PO Resp. 35. Regarding the education level of the inventors, Patent Owner provides evidence that the named inventors have degrees in unrelated fields. *Id.* (citing Ex. 2008, 3; Ex. 2009, 4). Patent Owner asserts the problem solved was that users of conventional game controllers were at risk of hand strain or injury from having to operate many different controls on the front of the controller with only a user’s thumbs. *Id.* at 35–36 (citing Ex. 2012 ¶ 10; Ex. 1001, 1:33–40, 3:56–61).

Petitioner does not contest the education level of the inventors or the problem solved by the ’525 patent. Pet. Reply 15–16. Rather, Petitioner asserts that Patent Owner has taken the illogical position that the qualifications of a person of ordinary skill in the art are maximum levels of experience or training rather than minimums. *Id.*

To the extent that Patent Owner’s assertion suggests that the level of skill may not exceed a year of experience or other training in controller

assembly or tooling, we disagree. Patent Owner does not cite, nor are we aware, of any legal precedent supporting the assertion that education and experience levels are maximums that must not be exceeded.

Regarding the problem solved by the '525 patent, the portions cited by Patent Owner do not describe solving the problem of risk of hand strain or injury from having to operate many different controls; rather the portions cited deal with loss of game control by the user and user comfort. *See* PO Resp. 35–36 (citing Ex. 1001, 1:33–40, 3:56–61). A better characterization is that the '525 patent solved the problem of loss of control caused by moving a thumb from one control to another. *See* Ex. 1001, 1:41–45.

We accept Patent Owner's uncontested assertions regarding the education level of the inventors; however, this information provides an incomplete picture because other factors are involved. *See e.g. Daiichi Sankyo Co. Ltd, Inc. v. Apotex, Inc.*, 501 F.3d 1254, 1256 (Fed. Cir. 2007) (enumerating a non-exhaustive list of six factors that are a guide to determining the level of skill in the art). For example, one concern is the type of problems encountered in the art, and the problem solved by the '525 patent is but one type of problem encountered.

Tosaki describes that removing a hand from the controller to manipulate switches makes prompt reaction difficult and degrades usability, and describes that repositioning the user's hands can impact comfort. Ex. 1002, 1:54–67, 2:19–23. Tosaki describes an apparatus that permits manipulation of a plurality of switches while holding the controller. *Id.* at 3:20–23. Tosaki's solution also includes switches on the back of the controller (shift levers) that are accessible to a user's fingers. *Id.* at 3:36–4:8. Enright describes that controllers had become more complex in that the

number of functions and user input devices increased to the point that user's had difficulty moving a finger to a desired button. Ex. 1003 ¶ 2. Enright describes that movement between input devices can be difficult. *Id.* ¶¶ 3–4. As a solution, Enright disclosed a device that permits selection of discrete switches without looking at or removing fingers from those switches. *Id.* at ¶ 5. Enright's solution includes switches (mode switches 32, 34) added to the underside (back) of the controller to reside near a user's fingers for easy operation. *Id.* at ¶ 32. Enright also discloses that these switches may be located elsewhere if ergonomically desired. *Id.*

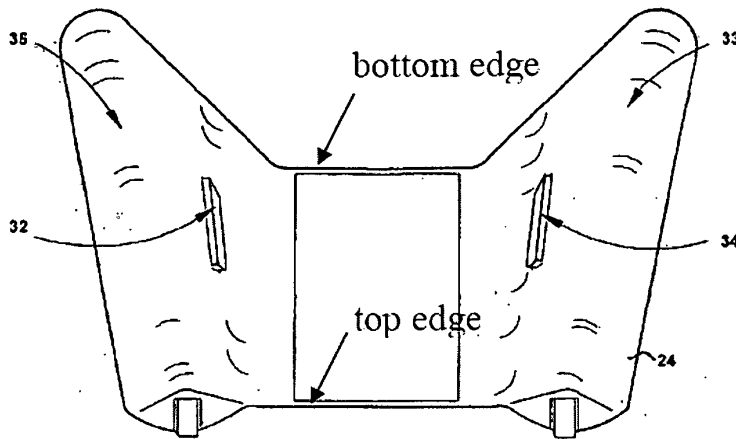
In light of this, the prior art of record demonstrates that switching position on the controller, usability, and comfort were known problems in the art. Further, prior solutions included placing switches to be easily accessible to a user's finger or thumb, and placing switches so that those switches are accessible without removing a finger or thumb from another switch. In particular, these solutions placed controls on the back of the controller to be accessible to a user's fingers. The technology involved was placement of switches in ergonomically desired locations that permit usability.

Neither addressed the impact of the level of art on the obviousness analysis. We do so in our analysis below.

*b) Ground of Unpatentability*

Enright discloses a handheld controller for a game console (user device 2) comprising an outer case (hand-holdable housing 24) having a front opposite a back. Pet. 32; Ex. 1003 ¶¶ 22, 23, 27, 31, Fig. 4 (front view), Fig. 5 (back view). Annotated Figure 5 of Enright follows.





Annotated Figure 5 of Enright is an inverted illustration of the back of the housing of user device 2 with Petitioner's labels identifying the top edge and the bottom edge opposite that top edge. Pet. 40; Ex. 1003 ¶ 23.

Enright discloses a front control on one side of the controller (e.g., D-pad 28, thumbstick 30, buttons 25), Pet. 33; Ex. 1003, Figs. 4, 6. Enright discloses elongate members in the form of mode switches 32, 34 that extend a substantial portion of the full distance between the top and bottom edges of the controller. Pet. 30; Ex. 1003 ¶ 35, Fig. 5.

Enright's controller is shaped to be held in the hand of a user such that the user's thumb is positioned to operate the front control. Pet. 33; Ex. 1003 ¶ 32; Figs. 4, 6.

The difference between the prior art (Enright) and claim 20 is that Enright's elongate members (mode switches 32, 34) do not extend to the extent required by the claims.<sup>21</sup>

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<sup>21</sup> As detailed in section III.A. above, the '525 patent describes that the claimed controller is like that of the prior art with respect to the outer case and the front and top controls.

Enright and Tosaki each disclose handheld video game controllers having front controls operated by a user's thumbs and back controls on the opposite side that are operated by fingers other than the thumb. Pet. 29–30; Pet. Reply 7–9; Ex. 1008 ¶ 15 (opining that Tosaki's steering wheel is handheld); Ex. 1002, 8:63–64, Figs. 1, 6, 7, 23, 24; Ex. 1003 ¶¶ 22, 23, 27, 31, Figs. 4, 5. Petitioner explains that Enright's elongate members (mode switches 32, 34) allow users to press a control without moving their thumbs from the front controls and these controls are placed in an ergonomically desired location. Pet. 30–31; Ex. 1003 ¶¶ 32, 35. Petitioner reasons that it would have been obvious to modify Enright's elongate members (mode switches 32, 34) to extend a substantial portion of the full distance between the top edge and the bottom edge as taught by Tosaki, for easy operation of the device or if ergonomically desired. Pet. 31–32; Ex. 1003 ¶ 32; Ex. 1008 ¶ 20. According to Petitioner, such a modification would have been “an obvious variation — in a predictable art.” Pet. 31.

The modification of extending Enright's switches must be considered in the light that, as detailed in our analysis of the level of skill above, it was known in the art to place switches ergonomically for comfort and for usability. In particular, it was known to place switches: on the rear of a controller, to be easily accessible to a user's finger or thumb, and to be accessible without removing a finger or thumb from another switch. In light of this, and Tosaki's disclosure of elongate members on the back of a controller that extend a substantial portion of the full distance between the top edge and the bottom edge, the proposed modification was within the level of skill in the art. Further, a person of ordinary skill in the art would

have made the proposed modification for easy operation of the device or if ergonomically desired.

*c) Patent Owner Arguments*

Before addressing each of Patent Owner's arguments individually, we address two of Patent Owner's characterizations that affect several of Patent Owner's individual arguments.

First, Patent Owner characterizes the ground of unpatentability as if Enright were being modified to include elongate members positioned in an arched opening as disclosed by Tosaki. For example, Patent Owner argues that Petitioner "attempts to plug in Tosaki's gearshift levers into Enright's handheld controller." PO Resp. 38 (citing Pet. 42.), *see also* 41 (similar statement). This is a mischaracterization. Petitioner proposes to modify Enright's elongate members to extend a substantial portion of the full distance between the top edge and the bottom edge as taught by Tosaki. *See* Pet. 31-32; Ex. 1003 ¶ 32; Ex. 1008 ¶ 20; *see also* Pet. Reply 14, 16 (explaining how Patent Owner mischaracterizes the ground of unpatentability). Petitioner relies on Tosaki only for the extent over which the elongate members extend. Petitioner does not propose to incorporate Tosaki's arched openings into Enright's controller.

Second, Patent Owner argues as if Tosaki is a thigh held controller and not a handheld controller. As detailed above, this contention is a mischaracterization of the reference because Tosaki discloses a handheld controller for a video game to the extent required by the claims. With these clarifications in mind, we turn to Patent Owner's individual arguments.

Patent Owner argues that Petitioner "cherry-picks" teachings from Enright and Tosaki, and argues that Petitioner's reasons for the modification

are entitled to little weight because they are conclusory and lack corroborating facts or data. PO Resp. 38–39, 41–42.

As detailed above, Petitioner provides reasons for the proposed modification (i.e., for easy operation of the device or if ergonomically desired). Rather than address those reasons and the associated underlying evidence, Patent Owner asserts, without a supporting explanation, that Petitioner’s reasons are conclusory. In other words, Patent Owner makes a conclusory assertion that Petitioner’s assertions are conclusory. Such a contention is not persuasive.

The difference between the prior art (Enright) and the claimed subject matter is simply the length of the elongate members. As detailed above, Petitioner reasons that a person of ordinary skill would have lengthened Enright’s elongate members in view of Tosaki for easy operation and in light of ergonomics. This reasoning has a rationale underpinning in that, as detailed above: (1) Enright and Tosaki each disclose handheld video game controllers having front controls operated by a user’s thumbs and back controls that are operated by fingers other than the thumb, (2) Tosaki’s elongate members extend 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 (3) Enright’s elongate members (mode switches 32, 34) are positioned so that users may press a back control without moving their thumbs from the front controls and these controls are in an ergonomically desired location.

Patent Owner contends that “[c]onspicuously absent from the Petition is any explanation of *how* to implement Tosaki’s gearshift levers (intended

to be positioned in an arched opening) with the Enright controller.” PO Resp. 39.

This contention is unpersuasive. Petitioner does not explain how Tosaki’s elongate members (gear shift levers) positioned within arched openings are incorporated in Enright’s device because, as explained above, Petitioner does not rely on Tosaki in that manner. Rather, Petitioner proposes to modify Enright’s elongate members to extend a substantial portion of the full distance between the top edge and the bottom edge as taught by Tosaki. *See* Pet. 29–30.

According to Patent Owner, Petitioner ignores the state of the art in that Microsoft only recently launched controllers with back controls. *Id.* at 42–43 (citing Ex. 2006 ¶¶ 15–16; Ex. 2011). At most, this evidence demonstrates that the Xbox controller did not previously include back controls, but this evidence falls short of demonstrating that back controls were not known in the art until that time. To the contrary, as detailed above, Petitioner asserted, and Patent Owner did not contest, that Enright’s controller included back controls prior to the critical date of the ’525 patent. Consequently, it is Patent Owner’s contention, not Petitioner’s, that ignores the state of the art. *Contra* PO Resp. 42–43; *see also* PO Resp. 52 (acknowledging, during prosecution that a hand operated controller having a control on the rear face (Park) was known).

Patent Owner contends that Tosaki’s disclosure of gearshift levers 125, 126 positioned and operated through arched openings would discourage a person of ordinary skill from using Tosaki’s gear shift levers in Enright. PO Resp. 43–45. This contention is unpersuasive because, as explained above, Petitioner does not propose to modify Enright to have shift levers that

are operated through arched openings; rather, Petitioner relies on Tosaki only for the magnitude of the extension of Tosaki's shift levers (elongate members).

Patent Owner argues that Petitioner's approach is fundamentally flawed because it misrepresents Tosaki as a handheld controller. PO Resp. 45–46. As explained above, Tosaki is a handheld controller to the extent required by the claims, and for that reason, this contention is unpersuasive.

Relatedly, Patent Owner contends that Tosaki is non-analogous art. PO Resp. 49–51. In particular, Patent Owner contends that Tosaki is not in the same field of endeavor because it is not a handheld controller. *Id.* As detailed above, Tosaki is a handheld controller and for that reason, Patent Owner's assertion is unpersuasive. Further, we are persuaded by Petitioner's evidence that handheld video game controllers were considered to be in the same field of endeavor without regard for whether those controllers were supported by other than a user's hands (e.g., a user's thighs). Pet. Reply 20; Ex. 1021 ¶ 8.

Patent Owner contends that modifying Enright to include elongate members in an arched opening would change Enright's principle of operation and render Enright inoperable for its intended purpose. PO Resp. 53–57. Patent Owner adds that Tosaki operates differently because it is thigh held rather than handheld. *Id.* at 54–55. As explained above, these assertions are based on a mischaracterization of the ground of unpatentability and a mischaracterization of Tosaki. Consequently, these assertions are not persuasive.

Patent Owner contends that Petitioner's rationale is impermissible hindsight because the cited portions of Enright (i.e., “for easy operation” and

“if ergonomically desired”) relate to the location of the back controls, not the length of those controls. PO Resp. 49–50 (citing Pet. 31–32; Ex. 1003 ¶ 32; Ex. 1008 ¶ 20).

Patent Owner’s argument is unpersuasive for two reasons. First, although Enright does not explicitly disclose the desirability of longer back controls, it is not required that the reference contain such an explicit disclosure. *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418-419 (2007). Second, Patent Owner argues as if Petitioner contends that it would have been obvious to lengthen Enright’s back controls (mode switches 32, 34) based on Enright alone. The ground of unpatentability is not based on Enright alone; rather, it is based upon the combination of Tosaki and Enright. Specifically, Petitioner asserts that Enright and Tosaki are each controller’s having back controls operated by a user’s fingers, and it would have been obvious to make Enright’s mode switches 32 and 34 longer based on Tosaki’s longer back controls. Pet. 29–31. Petitioner elaborates that a person of ordinary skill in the art would have been motivated to do so because Enright seeks mode switches 32 and 34 to be easy to operate and placed in ergonomically desired locations. In other words, a person of ordinary skill would recognize that Tosaki’s longer finger controls would be desirable in a device such as Enright’s which is described as having controls that are easy to operate and ergonomically positioned.

### 3. *Summary*

Petitioner has shown by a preponderance of the evidence that claim 20 would have been obvious over Enright and Tosaki. Petitioner has not made such a showing with regard to claims 1–11, 13, 16, 17.

D. OBVIOUSNESS OVER ENRIGHT, TOSAKI, AND OELSCH

Claim 18 depends from independent claim 1, and for that reason, includes the requirement that the elongate members are flexible.

Petitioner argues that claim 18 is unpatentable under 35 U.S.C. § 103 as obvious over Enright, Tosaki, and Oelsch. Pet. 51–52. Although not explicitly stated, this ground of unpatentability relies upon the combination of Enright and Tosaki in the previous ground of unpatentability with respect to claim 1, to include relying upon Enright as disclosing elongate members as claimed. As explained above in the analysis of the ground of unpatentability based on Enright and Tosaki, Petitioner has not demonstrated this contention adequately. Consequently, Petitioner has not demonstrated by a preponderance of the evidence that claim 18 is unpatentable as obvious over Enright, Tosaki, and Oelsch.

V. CONCLUSION

Petitioner has demonstrated by a preponderance of the evidence that the following claims are unpatentable in view of the following grounds:

- a) Claims 1, 6, 13, 14, 16, 17, 19, and 20 as anticipated by Tosaki;  
and
- b) Claim 20 as obvious over Enright and Tosaki.

VI. ORDER

For the reasons given, it is:

ORDERED that Exhibit 1028 be expunged;

FURTHER ORDERED that claims 1, 6, 13, 14, 16, 17, 19, and 20 are held unpatentable; and



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FURTHER ORDERED that that this is a Final Written Decision;  
therefore, parties to the proceeding seeking judicial review of the decision  
must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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