

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VALVE CORPORATION,
Petitioner,

v.

IRONBURG INVENTIONS LTD.,
Patent Owner.

Case IPR2017-00136
Patent 8,641,525 B2

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, 4.¹ 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.”).²

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.

¹ Patent Owner filed a copy of the first Petition as Exhibit 2015.

² 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:

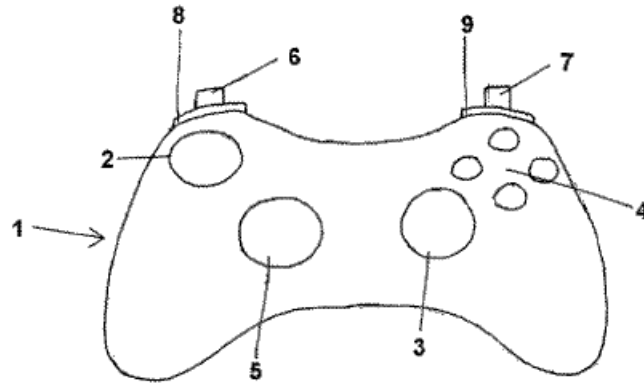


Figure 1

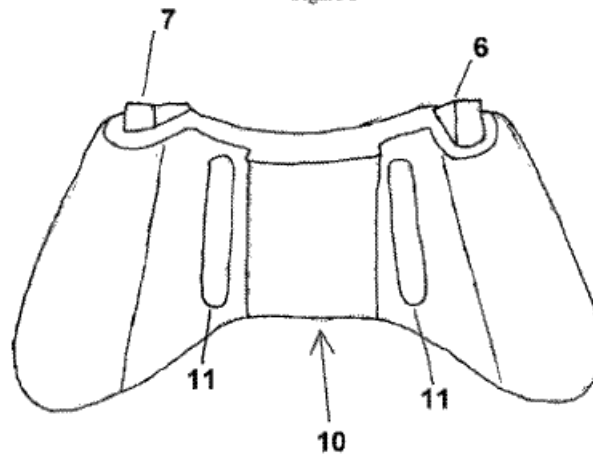


Figure 2

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.

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