

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re U.S. Patent No. 8,641,525

**Currently in Litigation Styled:
Ironburg Inventions Ltd. v.
Collective Minds Gaming Co. Ltd.
Case No: 1:16-cv-04110-TWT**

Issued: February 4, 2014

Application Filed: June 17, 2011

Inventors: Simon Burgess, et al.

Title: Controller for Video Game Console

**PETITION FOR *INTER PARTES*
REVIEW PURSUANT TO 37
C.F.R. §42.100 ET SEQ.**

Mail Stop *Inter Partes* Review

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

DECLARATION OF MARK BENDEN, PhD, CPE

I. Introduction

I, Mark Benden, Ph.D., CPE, declare:

- 1.** I am making this declaration at the request of Collective Minds Gaming Co. Ltd. in the matter of the *Inter Partes* Review of U.S. Patent No. 8,641,525 (“the ‘525 Patent”) to Burgess, *et al.*
- 2.** I am being compensated for my work in this matter. My compensation in no way depends upon the outcome of this proceeding.

3. In the preparation of this declaration, I have studied:

- (1) The '525 Patent, Exhibit 1001;
- (2) The prosecution history of the '525 Patent, Exhibit 1002;
- (3) U.S. Patent Publication No. 2010/0298053 to David Kotkin ("*Kotkin*"), Exhibit 1003;
- (4) U.S. Provisional Patent Application No. 61/179,551 to David Kotkin ("*'551 Provisional*"), Exhibit 1004;
- (5) U.S. Patent No. 6,760,013 to Michael A. Willner, et al. ("*Willner*"), Exhibit 1005;
- (6) Japanese Patent Publication JPH1020951 to Tsuchiya Koji ("*Koji*"), Exhibit 1006;
- (7) U.S. Patent No. 5,773,769 to Christopher W. Raymond ("*Raymond*"), Exhibit 1007.

4. In forming the opinions expressed below, I have considered:

- (1) The documents listed above,
- (2) The relevant legal standards, including the standard for obviousness provided in *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007),
- (3) The following background materials: Dark Watcher, History of the Game Controller, Video Game Console Library *available at* <https://web.archive.org/web/20080920145239/http://www.videogameconsolelibrary.com/art-controller.htm> Exhibit 1013,
- (4) My knowledge and experience based upon my work in this area, as described below.

II. Qualifications and Professional Experience

5. My complete qualifications and professional experience are described in my curriculum vitae, a copy of which can be found attached hereto as Exhibit 1009. I am an expert in the field of mechanical design, bioengineering, ergonomics, and product design, among other

fields. I have a B.S. in Bioengineering, an M.S. in Industrial Engineering, and a Ph.D. in Interdisciplinary Engineering, and I am a Certified Professional Ergonomist. I have been working in the fields of ergonomics, mechanical engineering and industrial design for twenty-five (25) years and I am currently the Department Head, Associate Professor and Director of the Ergonomics Center at Texas A&M Health Science Center, School of Public Health, Environmental & Occupational Health Department. I have taught courses in human product safety, ergonomics and industrial design and human factors, among others; I have advised graduate students and Ph.D. candidates conducting research in human centered design and accommodation; and have been an author of peer-reviewed journal articles and presented my research at numerous conferences. As a professional in industry, I designed hand tools for surgeons and ergonomic controls for seating and computer accessories. I have received awards for my work in ergonomics and industrial design, including several ADEX awards for Design Excellence including designs specifically dealing with human control manipulation with the hands. I am an inventor or co-inventor of 20 U.S. patents and several pending patent applications, in the fields of mechanical design for human use, ergonomics and industrial design.

6. In summary, I have extensive familiarity with design for hand controls.

III. Level of Ordinary Skill in the Art

7. I am familiar with the knowledge and capabilities of persons of ordinary skill in product design around June 2011, the earliest claimed prior date for the '525 Patent. I base this on my experience in design and ergonomics, including the specific experience listed above in Section II and the further experience detailed in my CV, which is attached as Exhibit 1009 to this declaration. One of ordinary skill in the art would have been familiar with ergonomic

aspects of handheld device design, which would include ergonomic aspects of video game controller configurations. This person of ordinary skill in the art would also have been familiar with cost and durability considerations and would have understood how those considerations impact product design and manufacturing.

8. In my opinion, the level of ordinary skill in the art that one would need in order to have the capability of understanding the scientific and engineering principles applicable to the '525 Patent is (i) a Bachelor's degree (or higher degree) in an academic area emphasizing mechanical engineering or similar discipline and (ii) at least 2 years of industry experience in product design or the equivalent. Additional industry experience or technical training may offset less formal education, while advanced degrees or additional formal education may offset lesser levels of industry experience.

IV. Relevant Legal Standards

9. Obviousness

a. I have been asked to provide my opinions regarding whether the claims 1-11 and 13-20 of the '525 Patent would have been obvious to a person having ordinary skill in the art at the time of the alleged invention, in light of the prior art.

b. I have been informed and understand that a patent claim is not patentable under 35 U.S.C. § 103 if the differences between the patent claim and the prior art are such that the claimed subject matter as a whole would have been obvious at the time the claimed invention was made to a person having ordinary skill in the art to which the subject matter pertains. Obviousness, as I have been informed, is based on the scope and content of the prior art, the differences between the prior art and the claim, the level of ordinary skill in the art, and, to the extent that they exist and have an appropriate nexus to the claimed invention (as opposed to prior

art features), secondary indicia of non-obviousness.

c. I have been informed that whether there are any relevant differences between the prior art and the claimed invention is to be analyzed from the view of a person of ordinary skill in the art at the time of the invention. As such, my opinions below as to a person of ordinary skill in the art are as of the time of the invention, even if not expressly stated as such; for example, even if stated in the present tense.

d. In analyzing the relevance of the differences between the claimed invention and the prior art, I have been informed that I must consider the impact, if any, of such differences on the obviousness or non-obviousness of the invention as a whole, not merely some portion of it. The person of ordinary skill faced with a problem is able to apply his or her experience and ability to solve the problem and also look to any available prior art to help solve the problem.

e. An invention is obvious if a person of ordinary skill in the art, facing the wide range of needs created by developments in the field, would have seen an obvious benefit to the solutions tried by the applicant. When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, it would be obvious to a person of ordinary skill to try the known options. If a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique would have been obvious.

f. I have been informed that a precise teaching in the prior art directed to the subject matter of the claimed invention is not needed. I have been informed that one may take into account the inferences and creative steps that a person of ordinary skill in the art would have employed in reviewing the prior art at the time of the invention. For example, if the claimed

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.