

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COLLECTIVE MINDS GAMING CO. LTD.,
Petitioner,

v.

IRONBURG INVENTIONS LTD.,
Patent Owner.

Case IPR2018-00354
Patent 8,641,525

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

PETRAVICK, *Administrative Patent Judge*.

DECISION

Institution of *Inter Partes* Review

35 U.S.C. § 314(a)

I. INTRODUCTION

A. OVERVIEW

Collective Minds Gaming Co. LTD. (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting *inter partes* review of claims 1–11 and 13–20 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 6, “Prelim. Resp.”), to which we authorized and Petitioner filed a Reply (Paper 10, “Pet. Reply”).

Section 314(a) of Title 35 of the United States Code provides that an *inter partes* review may not be instituted “unless . . . the information presented in the petition . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). Upon consideration of the Petition, the Preliminary Response, and Petitioner’s Reply, 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 the ’525 patent.

B. RELATED PROCEEDINGS

The parties indicate that the ’525 patent is or was at issue in a number of district court litigations. Pet. 78–29; Paper 5, 1. In particular, the ’525 patent is at issue in: *Ironburg Inventions Ltd. v. Valve Corp.*, Case No. 2:17-cv-01182-TSZ (W.D. Wash.) and *Ironburg Inventions Ltd. v. Collective Minds Gaming Co. Ltd.*, Case No. 1:16-cv-04110-TWT (N.D. Ga). Pet. 78–79; Paper 5, 1.

The '525 patent was the subject of petitions filed by Valve Corporation ("Valve") in cases IPR2016-00948 ("the '948 IPR") and IPR2017-00136 ("the '136 IPR"). *Id.* On September 22, 2017, we issued a final written decision in IPR2016-00948, finding claims 1, 6, 13, 14, 16, 17, 19, and 20 of the '525 patent unpatentable. Ex. 3002. On January 25, 2018, we issued a decision terminating IPR2017-00136, without issuing a final written decision. *See Valve Corp. v. Ironburg Inventions LTD.*, IPR2017-00136 (PTAB Jan. 25, 2018) (Paper 43).

C. THE '525 PATENT

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), Fig. 2 (back of controller 10). Figure 2 follows:

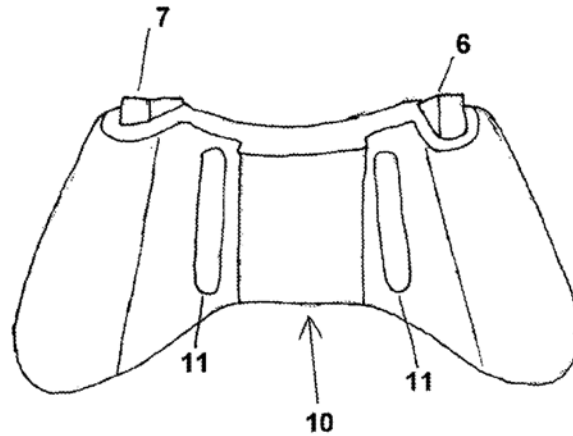


Figure 2

Figure 2 is a schematic illustration of the back of game controller 10.
Id. at 2:63–64.

D. ILLUSTRATIVE CLAIMS

Of the challenged claims, 1 and 20 are independent. Claims 2–11 and 13–19 depend directly or indirectly from claim 1. 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;
 - 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.

Claim 20 differs from claim 1 by, among other ways, not requiring the elongate member to be inherently resilient and flexible. Claim 20 follows:

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; 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.

E. EVIDENCE AND ASSERTED GROUNDS OF UNPATENTABILITY

Petitioner challenges the claims on the following grounds:

Claims Challenged	Basis	Reference(s)
1-3, 5-11, 13, 14, 17,18, and 20	§ 103(a)	Kotkin ¹
1-11, 13-17, 19 and 20	§ 103(a)	Willner ² , Koji ³ , and Raymond ⁴

Pet. 6. Petitioner relies upon a Declaration of Mark Benden, Ph.D., CPE (Ex. 1008). Patent Owner relies upon a Declaration of Dr. Glen Stevick (Ex. 2001).

¹ U.S. Patent Application Pub. No. 2010/0298053 A1, published Nov. 23, 1999 (Ex. 1003).

² U.S. Patent Application No. 6,760,013 B2, issued Jul. 6, 2004 (Ex. 1005).

³ Japanese Patent Application No. JP-A H10-020951, published Jan. 23, 1998 (Ex. 1011).

⁴ U.S. Patent Application No. 5,773,769, issued Jun. 30, 1998 (Ex. 1007).

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