

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NINTENDO CO., LTD. and
NINTENDO OF AMERICA INC.,
Petitioners,

v.

GAMEVICE, INC.,
Patent Owner.

PTAB Case No. IPR2023-00643

Patent No. 10,391,393

**REPLY IN SUPPORT OF PETITION FOR
INTER PARTES REVIEW**

(CLAIMS 1-7)

Nintendo's petition deserves institution. Gamevice's three discretionary denial arguments (its only arguments) fail for straightforward reasons. First, the *General Plastic* factors favor institution under the Director's *Code200* decision. Second, § 325(d) does not apply because the Examiner overlooked material prior art. Third, *Fintiv* is inapposite due to a *Sotera* stipulation.

Gamevice also wrongly accuses Nintendo of misusing Board resources. Nintendo has spent years defending against plainly invalid claims of the '393 patent that share core features with cancelled claims of the '119 patent. Gamevice convinced the Board to deny Nintendo's earlier '393 IPR petition because of co-pending ITC litigation—a practice the Board has since abandoned. Nintendo then prevailed at the ITC, including on invalidity, but now finds itself defending against the '393 patent in district court. While the court held five challenged claims invalid, Gamevice does not accept that outcome and will likely appeal. Thus, contrary to Gamevice's assertion, those claims still matter. Nintendo asks the Board to apply its unique expertise and render a substantive decision on whether claims 1-7 are unpatentable over cited prior art that Gamevice failed to distinguish at the ITC.

General Plastic. The Director's precedential *Code200* decision held that, when an initial IPR petition was “not evaluated on the merits,” allowing a petitioner to seek a merits-based decision best balances concerns about patent quality and repeated challenges. Ex. 1027 at 4-5. So it is here. The Board's earlier denial was

discretionary, though the decision mentioned Nintendo's challenge had "some strength." IPR2020-01197, Paper 13 at 7-23. Nintendo now seeks a full merits evaluation by the Board. *Code200* also states that where an earlier petition "was discretionarily denied," *General Plastic* factors 1-3 favor denial of a later petition only if there are road-mapping concerns. Ex. 1027, 6. None exist here: the Board's decision and Gamevice's response in the earlier IPR relate to discretionary denial, not the disclosures of cited prior art. Paper 1 at 83-84. Those papers offer nothing substantive that Nintendo could have used to revise its petition. And *Code200* explains that road-mapping concerns are minimized when two petitions "substantially overlap[]." Ex. 1027 at 5. Gamevice concedes that Nintendo's earlier and current petitions are "substantially similar." Paper 7 at 1.

Gamevice's counterarguments fall flat. Gamevice suggests the Board addressed the merits of the earlier petition. Paper 7 at 4-5, 8. Not so. Gamevice quotes the Board's decision discussing the '393 and '119 patent claims, but the statements say nothing about the disclosures of Nintendo's prior art. *Id.* at 4-5. Gamevice also asserts there are road-mapping concerns. *Id.* at 5-6. But it identifies no examples, asserting instead that the current and earlier petitions "are not identical." Paper 7 at 6. That is true but irrelevant. The current petition addresses the court's January 2023 claim constructions and adds a Schoenith-Park combination mirroring the Schoenith-Kessler combination. These changes are not

road-mapping because they are unrelated to the record in the earlier IPR.

The remaining *General Plastic* factors favor Nintendo. Paper 1 at 84-85. Gamevice criticizes the timing of Nintendo's petition. Paper 7 at 6-7. But Nintendo properly filed within a year of Gamevice reasserting the '393 patent in district court after it lost at the ITC. Paper 1 at 84. This allowed Nintendo to gauge whether to file an IPR in view of district court rulings and address district court claim constructions. *Id.*

Though not relevant to *General Plastic*, Gamevice argues that the district court should address invalidity over the cited art. Paper 7 at 7. That argument ignores the Board's general prior art expertise and its experience with the cited art and related '119 patent. By contrast, the court has never considered the art.

Section 325(d). Because the Examiner overlooked Nintendo's cited prior art and combinations, § 325(d) does not apply. Paper 1 at 81-82. During prosecution, the Examiner never discussed Nintendo's art or specific combinations. That is no surprise. Gamevice submitted over 90 references to the Examiner (Ex. 1009 at 90-100) while holding back the '119 IPRs, which explained how Nintendo's cited art is relevant to several '393 claim limitations. The overlooked art is material to patentability. For example, Nintendo's petition lays out multiple grounds that render claims 1-7 unpatentable, including limitations Gamevice asserts were the basis for allowance. *Compare* Paper 7 at 13-14 *with* Paper 1 at 30-31, 33-37, 47,

49-51, 61-63, 75, 77-78. It makes no sense to apply § 325(d) when, as here, an examiner failed to articulate any substantive consideration of the art. Indeed, the Patent Office is considering a rule to that effect. 88 Fed. Reg. 24503 at 24511-12 (“mere citation” of art to examiner does not mean it was “previously addressed”).

Gamevice argues the Examiner “evaluated” Nintendo’s cited art because he initialed the references in an IDS. Paper 7 at 9, 12. That misses the point. *Advanced Bionics* factor (c) focuses on *the extent* to which art was evaluated. Here, there is no evidence the Examiner substantively analyzed Nintendo’s cited art, let alone its specific combinations. Gamevice emphasizes that the Examiner identified a Schoenith-related patent application. Paper 7 at 12-13. But nothing suggests the Examiner evaluated the substance of that application, Schoenith, or any Schoenith-based combination. Gamevice further argues Nintendo failed to explain how the Examiner erred in evaluating the art. Paper 7 at 14-15. But the petition explains that the Examiner overlooked all the art’s relevant teachings, including disclosures cited in the ’119 IPRs. Paper 1 at 81. Further, as noted above, the cited art disclosed the very limitations Gamevice identifies as securing allowance.

Fintiv. Nintendo replaces the word “on” in its proffered *Sotera* stipulation with the word “or.” Paper 1 at 85 (last paragraph). Based on the corrected stipulation, the Board “will not discretionarily deny institution in view of parallel district court litigation.” Ex. 1025 at 3, 7. That settles the issue: *Fintiv* does not

apply. Gamevice argues a *Sotera* stipulation is insufficient because Nintendo can use cited prior art in the district court against the unchallenged '713 patent. Paper 7 at 23. Gamevice offers no support for that position, which contradicts the Board's *Fintiv* procedure. Ex. 1025 at 3, 7; *RideCo Inc. v. Via Transportation, Inc.*, IPR2022-00740, Paper 10 at 9 (PTAB Sept. 1, 2022).

Other *Fintiv* factors support institution. Paper 1 at 85-86. For factor 1, Nintendo has informed the district court it will seek a stay if this IPR is instituted. As to factor 2, the court set August 5, 2024 as a trial date, which could slip. The final written decision is due by November 10, 2024, only three months after the trial date. For factor 3, at the time of the November 2023 institution decision, fact discovery (which closes in February 2024) and expert discovery (which closes in May 2024) will be open and trial will be at least nine months away. Further, the court will not have considered the cited art. In any case, factor 6 is determinative because the petition has "compelling merits." Ex. 1025 at 3-5. The Board previously recognized "some strength" to Nintendo's challenge, IPR2020-01197, Paper 13 at 20-21, and the petition presents extensive evidence that the challenged claims are unpatentable, including detailed expert testimony and prior Board rulings on overlapping claim limitations from the related '119 patent. In response, Gamevice regurgitates arguments the Board considered before describing Nintendo's challenge as ostensibly strong. IPR2020-01197, Paper 13 at 19-21.

Dated: August 24, 2023

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on August 24, 2023, true and correct copies of the foregoing REPLY IN SUPPORT OF PETITION FOR *INTER PARTES* REVIEW (CLAIMS 1-7) were served via electronic mail upon the following counsel of record for Petitioner:

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