

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.

Case IPR2023-00643
U.S. Patent No. 10,391,393

PATENT OWNER'S PRELIMINARY SUR-REPLY

Gamevice respectfully requests that the Board exercise its discretion to deny institution under 35 U.S.C. §§ 314(a), 325(d), to avoid needlessly expending the Board's and parties' resources on bifurcated litigation between different forums. The Board should not reward Nintendo's gamesmanship. Instead of simply re-filing its original petition with minimal updates as quickly as possible, Nintendo intentionally delayed as much as possible and used both Gamevice's and the Board's statements about the original petition as a roadmap to modify its new petition. Yet, Nintendo still failed to identify any grounds worthy of additional review, given the Examiner's allowance. Nintendo's new petition does not warrant use of the Board's limited resources and should be denied.

I. THE BOARD SHOULD DENY INSTITUTION UNDER *GENERAL PLASTIC* (35 U.S.C. § 314(a))

Contrary to Nintendo's position in its pre-institution reply, the rationale behind the Director's decision in *Code200, UAB v. Bright Data Ltd.*, IPR2022-00861, Paper No. 18 (PTAB Aug. 23, 2022) supports denial of institution of this later Petition. The *Code200* decision makes clear that "road-mapping" concerns warranting denial of institution exist where the later petition is refined based on lessons learned from an evaluation on the merits of the earlier-filed petition. *See id.*, at 5. In this regard, Nintendo cannot have it both ways. It cannot argue that its current Petition has "compelling merits" because "[t]he Board previously

recognized ‘some strength’ to Nintendo’s challenge, IPR2020-01197, Paper No. 13 at 20-21,” *see* Paper No. 9, at 5, but then turn around and argue that its last petition in IPR2020-01197 was not evaluated on the merits, *see id.*, at 1.

Nothing in the *Code200* decision requires that the prior evaluation be a “full merits evaluation by the Board” as Nintendo suggests. *See id.*, at 2. As *General Plastic* factor 3 shows, a prior merits evaluation is not limited to a Board-issued Final Written Decision but can include “the patent owner’s preliminary response to the first petition” and “the Board’s decision on whether to institute review in the first petition.” *General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper No. 19, at 15-16 (Sept. 6, 2017) (§ II.B.4.i). Here, there is ample evidence that Nintendo refined this Petition based on lessons learned from Gamevice’s and the Board’s evaluation of its first petition’s merits.

For example, learning from Gamevice’s critique that Nintendo’s first petition overstated the relevance of the ’119 IPRs because the specific grounds were different, *see* IPR2020-01197, Paper No. 7, at 13, Nintendo refined the grounds presented in this Petition to be identical to the ’119 IPRs. Specifically, the Petition here presents the same “Schoenith in view of Park” and “Schoenith in view of Kessler” grounds as in IPR2018-01521, and the same “Willner in view of Park” and “Hirschman” grounds as in IPR2018-01522. *Compare* Pet. 8 with IPR2018-01521, Paper No. 2, at 4; IPR2018-01522, Paper No. 2, at 4.

Similarly, learning from Gamevice’s arguments against application of collateral estoppel over the ’119 IPRs, *see* IPR2020-01197, Paper No. 7, at 13; IPR2020-01197, Paper No. 12, at 1-3, 5-7, Nintendo refined this Petition by adding specific discussion to strengthen its argument for application of issue preclusion doctrine. *Compare* Pet. 19-20 (adding Section VI.B.1 on issue preclusion) *with* IPR2020-01197, Paper No. 3, at 22. Further, Nintendo refined this Petition by including additional argument on issue preclusion under its discussion of the individual claim limitations. *E.g., compare* Pet. 22-23 (citing *Ohio Willow Wood Co. v. Alps., LLC*, 735 F.3d 1333, 1341 (Fed. Cir. 2013)) *with* IPR2020-01197, Paper No. 3, at 23-24. Additionally, where Gamevice had identified differences between the claim language of the ’393 and ’119 Patents, Nintendo added back-up arguments should the Board not apply issue preclusion doctrine. *See, e.g.,* IPR2020-01197, Paper No. 12, at 2 (“Third, claim 1 requires “the pair of confinement structures” to be adjacent ‘not more than three sides of the sides of the computing device’ . . . The ’119 patent’s claims do not have these limitations.”); *compare* Pet. 23 (“But even if Gamevice is not estopped . . .”) *with* IPR2020-01197, Paper No. 3, at 23-24.

Moreover, learning from Gamevice’s argument that Nintendo’s first petition applied an incorrect construction of “confinement structures,” *see* IPR2020-01197, Paper No. 7, at 13-14, Nintendo refined this Petition to pay lip service to the claim

construction in the parallel district court litigation and prior ITC investigation, *compare* Pet. 14-15 *with* IPR2020-01197, Paper No. 3, at 11. Similarly, learning from Gamevice’s argument that Nintendo failed to inform the Board of other disputed claim constructions, *see* IPR2020-01197, Paper No. 7, at 15, Nintendo refined this Petition to provide constructions for “computing device,” “passageway,” “communication link,” “structural bridge,” “electrical communication,” and “electronic communication,” *compare* Pet. 14-16 *with* IPR2020-01197, Paper No. 3, at 10-11. Nintendo also included additional argument on these claim constructions. *E.g.*, *compare* Pet. 22 (discussing construction of “computing device,” 1[a]) *with* IPR2020-01197, Paper No. 3, at 23 (1[a]); *compare* Pet. 26-28 (adding section on 1[b][2][b] addressing construction of “communication link”) *with* IPR2020-01197, Paper No. 3, at 25-27.

In sum, Nintendo’s refinement of the current Petition based on lessons learned from the evaluation of its first petition raise clear “road-mapping” concerns that warrant discretionary denial of institution under *General Plastic*.

II. THE BOARD SHOULD DENY INSTITUTION UNDER *ADVANCED BIONICS* (35 U.S.C. § 325(d))

Contrary to Nintendo’s position, *see* Paper No. 9, at 3, Gamevice was not required to submit Nintendo’s ’119 IPR petitions to the Office, nor did Gamevice’s failure to do so mislead the Examiner in any way, because the ’119 Patent’s claims

do not include and thus Nintendo's '119 IPR petitions do not address several of the limitations of the '393 Patent's challenged claims that the Examiner identified as reasons for allowance over the prior art of record. *See* Paper No. 7, at 15-17.

Nintendo cannot show material error in the Office's prior evaluation of the cited references merely by pointing to its proposed grounds in its current Petition. *See Advanced Bionics*, IPR2019-01469, Paper No. 6, at 9. Nor can Nintendo identify any authority that the Examiner substantively discussing the evaluated prior art in an Office Action is a requirement under the *Advanced Bionics* framework. Indeed, Nintendo admits that the Office is *merely considering* a rule to that effect, meaning that such a rule is *not* currently in effect. *See* Paper No. 9, at 4. Further, it strains credulity to argue that an Examiner did not evaluate the substance of a reference that he found through independent searching, as Nintendo does with respect to Schoenith's prior patent application publication. *See id.*, at 4. In sum, the Board should exercise its discretion under 35 U.S.C. § 325(d) to deny institution under *Advanced Bionics*.

III. CONCLUSION

For the foregoing reasons, the Board should deny institution.

Respectfully submitted,

Date: August 31, 2023

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CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing **PATENT OWNER'S PRELIMINARY SUR-REPLY** was served electronically via email on August 31, 2023, in its entirety on the following:

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