

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

GAMEVICE, INC.,
Patent Owner.

IPR2023-00643
Patent 10,391,393 B2

Before JOSIAH C. COCKS, ROBERT L. KINDER, and
MATTHEW S. MEYERS, *Administrative Patent Judges*.

MEYERS, Administrative Patent Judge.

DECISION

Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

Nintendo Co., Ltd. (“Petitioner”) filed a Petition (“Pet.,” Paper 1) requesting an *inter partes* review of claims 1–7 (“the challenged claims”) of U.S. Patent No. 10,391,393 B2 (Ex. 1001, “the ’393 patent”). Gamevice, Inc., (“Patent Owner”) filed a Preliminary Response to the Petition. Paper 7 (“Preliminary Response” or “Prelim. Resp.”). With our authorization, Petitioner filed a Reply (“Pet. Reply,” Paper 9,) and Patent Owner filed a Sur-Reply (“PO Sur-reply,” Paper 10).

We have authority, acting on the designation of the Director, to determine whether to institute an *inter partes* review. 35 U.S.C. § 314; 37 C.F.R. § 42.4(a) (2020). The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted unless “the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least [one] of the claims challenged in the petition.”

After considering the evidence of record, we determine that Petitioner has demonstrated a reasonable likelihood that it would prevail with respect to at least one of claims 1–7. Accordingly, we institute an *inter partes* review of all challenged claims on all asserted grounds pursuant to 35 U.S.C. § 314. 37 C.F.R. § 42.108(a) (“When instituting . . . review, the Board will authorize the review to proceed on all of the challenged claims and on all grounds of unpatentability asserted for each claim.”); *see also SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018).

I. BACKGROUND

A. *Real Parties-in-Interest*

Petitioner identifies Nintendo Co., Ltd. and Nintendo of America Inc. as the real parties -in-interest. Pet. 3. Patent Owner identifies itself (Gamevice, Inc.) as the real party in interest. Paper 4, 1.

B. *Related Proceedings*

The parties identify that the '393 patent is involved in *Gamevice, Inc. v. Nintendo Co., Ltd. et al.*, 3:18-cv-01942 (N.D. Cal) and other proceedings before the International Trade Commission ("ITC"). See Pet. 4–6; Paper 4, 2–3. In addition, the parties identify *Nintendo Co. Ltd. et al. v. Gamevice, Inc.*, IPR2020-01197 ("1197 IPR"), filed June 26, 2020. Pet. 82; Paper 4, 3.

The parties also identify other proceedings involving U.S. Patent No. 9,126,119 (the "'119 patent"), to which the '393 patent claims priority: *Gamevice, Inc. v. Nintendo Co., Ltd., et al.*, Case No. 17-cv-05923 (C.D. Cal.); *Nintendo Co. Ltd. et al. v. Gamevice, Inc.*, IPR2018-01521, filed August 30, 2018; and *Nintendo Co. Ltd. et al. v. Gamevice, Inc.*, IPR2018-01522, filed August 30, 2018 (collectively, "'119 IPRs" or "'119 patent's IPRs"). Pet. 4; Paper 4, 4.

C. *The '393 Patent*

The '393 patent is titled "GAME CONTROLLER WITH STRUCTURAL BRIDGE." Ex. 1001, code (54). The '393 patent "generally relates to a combination game controller and information input device directed to controlling electronic games and entry of information to a computing device." *Id.* at 4:12–15.

Figure 1 of the '393 patent, reproduced below, illustrates a front perspective view, with partial cutaway, of an embodiment an electronic game control apparatus. *Id.* at 1:58–59.

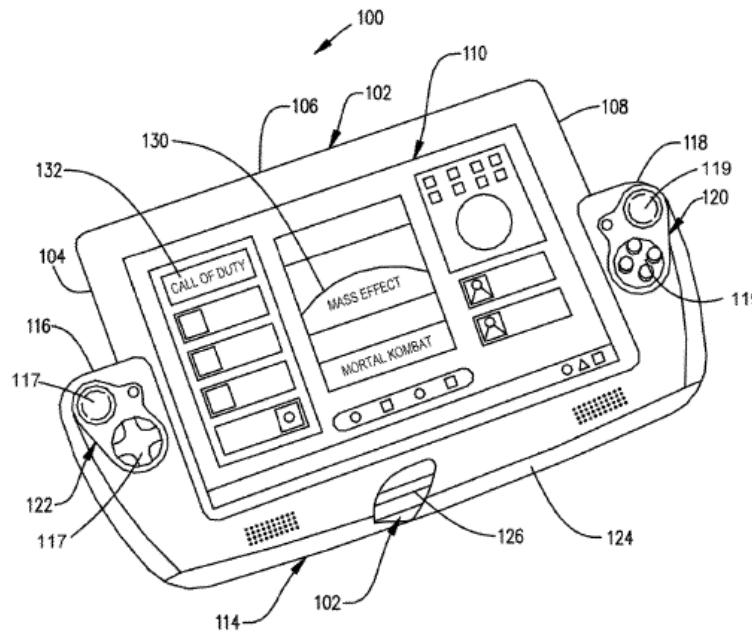


FIG. 1

Figure 1 (above) depicts a game controller and information entry device (“G&D”) 100 and a computing device 102. *Id.* at 4:35–37.

Computing device 102 has a plurality of sides 104, 106, 108, and 126, and electronic display screen 110. Ex. 1001, 4:36–41. According to the '393 patent, “computing device 102 may take the form of a tablet computer, smart phone, notebook computer, or other portable computing device.” *Id.* at 4:43–45. G&D 100 also “includes input device 114, [which] provides a pair of side structures, 116 and 118, with a bridge structure 115 disposed there between.” *Id.* at 4:46–48. As shown in Figure 1, “input device 114 further provides a plurality of removable game control modules 120 and 122.” *Id.* at 4:61–63.

D. Illustrated Claims

The '393 patent includes twenty-three claims, and Petitioner challenges claims 1–7. Of the challenged claims, claim 1 is independent. Claim 1 is illustrative and reads as follows:

1. A combination comprising:
 - a computing device;
 - a pair of confinement structures, the pair of confinement structures interacting with the computing device and adjacent at least two opposing sides of the computing device, but not more than three sides of the sides of the computing device, each of the pair of confinement structures comprising a communication link, each of the communication links configured for electronic communication with the computing device;
 - a rigid structural bridge disposed between and secured to the pair of confinement structures, the rigid structural bridge comprising a passageway between the pair of confinement structures, the passageway promotes electrical communication between the communication link of a first confinement structure of the pair of confinement structures and the computing device, the passageway further promotes electrical communication between the communication link of a second confinement structure of the pair of confinement structures and the computing device; and
 - a pair of electronic game control modules, each electronic game control module of the pair of electronic game control modules is secured to and interacts with a corresponding confinement structure of the pair of confinement structures, each electronic game control module in electronic communication with the communication link of its corresponding confinement structure, wherein each electronic game control module is a separate and distinct structure from each of their corresponding confinement structures, forming no structural portion of their corresponding confinement structures, and in which each of the pair of confinement structures are separate and distinct structures

from the structural bridge, forming no structural portion of the structural bridge.

Ex. 1001, 17:53–18:21.

E. Asserted Grounds of Unpatentability

Petitioner asserts that claims 1–7 of the '393 patent are unpatentable on the following grounds (Pet. 5, 8, 16–80):

Claim(s) Challenged	35 U.S.C. §	Reference(s)
1–7	103(a) ¹	Willner ² and Park ³
1–7	103(a)	Schoenith ⁴ and Park
1–7	103(a)	Schoenith and Kessler ⁵
1–4, 6, 7	102, 103(a)	Hirschman ⁶

Petitioner also relies on the declaration of Garry Kitchen (Ex. 1002) to support its arguments.

¹ The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), amended 35 U.S.C. § 103. Because the challenged claims of the '393 patent have an effective filing date before the effective date of the applicable AIA amendments, we refer to the pre-AIA version of 35 U.S.C. § 103 in this Decision.

² Willner et al., US 2001/0045938 A1, pub. Nov. 29, 2001 (Ex. 1003).

³ Park, Korean Laid-Open Patent App. No. 10-2011-0116892, pub. Oct. 26, 2011 (Ex. 1004) (including English Translation and Translation Certification).

⁴ Schoenith et al., U.S. 9,539,507 B2, iss. Jan. 10, 2017 (Ex. 1005).

⁵ Kessler et al., Int’l Patent App. No. WO 2014/079264 A1, pub. May 30, 2014 (Ex. 1006).

⁶ Hirschman, US 2012/0271967 A1, pub. Oct. 25, 2012 (Ex. 1007).

II. DISCRETIONARY DENIAL

Patent Owner argues that we should exercise our discretion to deny institution of *inter partes* review under 35 U.S.C. § 314(a) and § 325(d). Prelim. Resp. 1–27; PO Sur-reply 1–5. For the following reasons, we decline to exercise our discretion under § 314(a) and § 325(d) to deny institution of *inter partes* review.

A. § 314(a) - Prior Petitions (*General Plastic*)

In exercising discretion to institute review, the Board may consider the following non-exhaustive list of factors set forth in *General Plastic Industrial Co. v. Canon Kabushiki Kaisha*:

1. whether the same petitioner previously filed a petition directed to the same claims of the same patent;
2. whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it;
3. whether at the time of filing of the second petition the petitioner already received the patent owner's preliminary response to the first petition or received the Board's decision on whether to institute review in the first petition;
4. the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition;
5. whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent;
6. the finite resources of the Board; and

7. the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.

IPR2016-01357, Paper 19 at 16 (PTAB Sept. 6, 2017) (precedential as to section II.B.4.i). The *General Plastic* factors “are not dispositive, but part of a balanced assessment of all relevant circumstances in the case, including the merits.” Consolidated Trial Practice Guide 58 (Nov. 2019) (“Trial Practice Guide”), <https://go.usa.gov/xpvPF> (citing *General Plastic*, Paper 19 at 15).

Below, we address each of these factors as they apply to the circumstances of this case, and determine that these circumstances do not warrant discretionary denial of institution.

- 1. Factor 1: whether the same petitioner previously filed a petition directed to the same claims of the same patent;*
- Factor 2: whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it; and*
- Factor 3: whether at the time of filing of the second petition the petitioner already received the patent owner’s preliminary response to the first petition or received the Board’s decision on whether to institute review in the first petition*

Patent Owner argues that Petitioner “previously filed a petition in [the 1197 IPR] directed to the same claims 1–7 of the ’393 [p]atent as they challenge in this Petition.” Prelim. Resp. 4. Patent Owner asserts that “the parties and the Board substantively addressed the merits of [Petitioner’s] petition in the first proceeding, which [Petitioner] has used as a roadmap to modify its current Petition.” *Id.* at 4. Patent Owner contends that, in the 1197 IPR, it explained how Petitioner’s “grounds lacked merit” under its

analysis of the sixth factor in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”). *Id.*; *see also id.* at 4–5 (detailing Patent Owner’s “six different criticisms of [Petitioner’s] proffered grounds and positions” in the 1197 IPR).

Patent Owner asserts further that “the Board addressed the merits of [Petitioner’s] petition in its decision denying institution” of the 1197 IPR, and as such, Petitioner’s reliance on the Director Decision in *Code200, UAB v. Bright Data Ltd.*, IPR2022-00861, Paper 18 at 6 (PTAB Aug. 23, 2022) (precedential) is misplaced. Prelim. Resp. 5. According to Patent Owner, Petitioner “has apparently used [Patent Owner’s] and the Board’s criticisms of its first petition as a roadmap to modify the grounds presented in this Petition.” *Id.* at 5–6.

Petitioner responds that it “previously petitioned for the Board to cancel the claims of the ’393 patent,” but notes that “the Board did not substantively address the merits of that petition.” Pet. 3. Petitioner asserts “that denial of institution of a subsequent petition under § 314, pursuant to the *General Plastic* factors, is improper if the Board did not substantively address the merits of a first petition.” Pet. 83 (citing *Code200*, Paper 18 at 6); *see also* Pet. Reply 1–2 (citing 1197 IPR, Paper 13, 7–23) (“The Board’s earlier denial was discretionary, though the decision mentioned [Petitioner’s] challenge had ‘some strength.’”).

In response, Patent Owner argues that “[t]he *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.” PO Sur-Reply 1

(citing *Code200*, Paper 18 at 5). According to Patent Owner,

[n]othing in the *Code200* decision requires that the prior evaluation be a “full merits evaluation by the Board” as [Petitioner] suggests.” [Pet. Reply] 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.”

Id. at 2 (citing *General Plastic*, Paper 19 at 15–16). Patent Owner argues that “there is ample evidence that [Petitioner] refined this Petition based on lessons learned from” the 1197 IPR. *Id.* As evidence of “road-mapping,” Patent Owner suggests that based on the 1197 IPR, Petitioner refined the present Petition by modifying “the grounds presented in this Petition to be identical to the ’119 IPRs” (*id.*), “adding specific discussion to strengthen its argument for application of issue preclusion doctrine” (*id.* at 3), and including additional arguments regarding “claim construction in the parallel district court litigation and prior ITC investigation” (*id.* at 3–4).

We are not persuaded by Patent Owner’s arguments. In our previous decision in the 1197 IPR, we exercised our discretion to deny institution under § 314(a) based on our consideration of the *Fintiv* factors. 1197 IPR, Paper 13, 23. The decision in the 1197 IPR noted that although “there does appear to be some strength to the merits of Petitioner’s challenges,” this determination was based particularly on the fact that “the ’393 patent’s claims share some of the same claim limitations addressed by the Board previously in the ’119 patent’s IPRs.” *See id.* at 20–21. Therefore, we did not fully address the substantive merits of any of Petitioner’s grounds of unpatentability.

We also are not persuaded that the changes between the Petition in the 1197 IPR and the present Petition demonstrates “ample evidence” of road-mapping. Instead, we agree with Petitioner that “[t]hese changes are not road-mapping because they are unrelated to the record in the earlier [1197] IPR.” Pet. Reply 2–3. And, as we explained above, our earlier decision did not fully address the substantive merits of any of Petitioner’s grounds of unpatentability, nor did we address the substantive merits of any of Patent Owner’s counterarguments. *See General Plastic*, Paper 19, 17 (warning against allowing “petitioners the opportunity to strategically stage their prior art and arguments in multiple petitions, *using our decisions* as a roadmap.”) (emphasis added); *see also id.* at fn.14 (citing *Butamax Advanced Biofuels LLC v. Gevo*, IPR2014-00581, Paper 8, 12–13 (PTAB Oct. 14, 2014) (criticizing petitioner’s use of “*our prior decision* as a roadmap”) (emphasis added). In addition, Patent Owner acknowledges that the present Petition challenges “the same claims 1–7 based on identical prior art references and substantially similar grounds.” Prelim. Resp. 1 (emphasis omitted). Thus, we find Patent Owner’s “road-mapping” concerns to be minimized based on the similarity of the unpatentability challenges between those raised in the 1197 IPR Petition and the present Petition.

For these reasons, we agree with Petitioner that factors 1–3 weigh in favor of institution. *See Code200*, Paper 18 at 5 (“Where the first-filed petition under factor 1 was discretionarily denied or otherwise was not evaluated on the merits, factors 1–3 only weigh in favor of discretionary denial when there are ‘road-mapping’ concerns under factor 3 or other concerns under factor 2.”).

2. *Factor 4: the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition; and*
Factor 5: whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent

Patent Owner asserts that Petitioner filed the 1197 IPR on June 26, 2020, and “relied on the identical references as this Petition filed on March 6, 2023.” Prelim. Resp. 6 (citing 1197 IPR, Paper 3, 5). Based on this time frame, Patent Owner asserts that Petitioner “learned of the prior art asserted in this Petition at least about *three years* before it filed the Petition.” *Id.* at 6–7. And, according to Patent Owner, Petitioner’s “explanation for the three years’ gap between the filing of its first petition and this Petition is not only inadequate but also disingenuous.” *Id.* at 7.

Petitioner asserts that the timing of when it discovered the prior art “is irrelevant because [Petitioner] is relying on the same art now that it used previously.” Pet. 84. According to Petitioner, it “filed the petition when it did to allow for the possibility that the District Court might resolve pending motions for summary judgment in [Petitioner’s] favor, and further, to allow the court to rule on [Petitioner’s] challenge that claim 12 is indefinite.” *Id.* Petitioner contends that it filed the present “[P]etition within the one-year period under § 315(b).” *Id.*

We determine that the fourth and fifth factors have limited value because, as Patent Owner acknowledges, the present Petition challenges “the same claims 1–7 based on identical prior art references and substantially similar grounds.” Prelim. Resp. 1 (emphasis omitted). We also determine that Petitioner adequately explains the time that passed before filing the

Petition. Patent Owner contends that Petitioner’s explanation is “inadequate” and “disingenuous” (Prelim. Resp. 7), however, Petitioner’s actions appear to be reasonably diligent under the circumstances. *See* Pet. Reply 3 (“[Petitioner] properly filed within a year of [Patent Owner] reasserting the ’393 patent in district court after it lost at the ITC.”).

Thus, factors 4 and 5 do not weigh in favor of exercising discretion to deny institution of the proceeding.

3. *Factor 6: the finite resources of the Board; and Factor 7: the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.*

Patent Owner argues that “the Board has previously expended its resources evaluating not only [Petitioner’s] first petition on the merits before denying institution, but also the ’119 IPRs even though [Patent Owner] did not maintain the ’119 [p]atent in litigation against [Petitioner].” Prelim. Resp. 8.

Petitioner argues that the prior Petition in the 1197 IPR “was not evaluated on its merits,” and as such, “[a]ny alleged concern regarding factor 6 is ‘outweighed by the Board’s mission to improve patent quality.’” Pet. 85 (citing *Code200*, Paper 18, 6). Petitioner also contends that factor 7 is inapplicable in this case. *Id.*

We are not persuaded that instituting this Petition will significantly affect the resources of the Board or our ability to issue a final determination within the one-year statutory timeline. As we explained above, we did not fully address the substantive merits of any of Petitioner’s grounds of unpatentability in the 1197 IPR, nor did we address the substantive merits of

any of Patent Owner's counterarguments relating to those grounds. Consequently, we agree with Petitioner that any potential concerns regarding Board resources would be outweighed by our "mission to improve patent quality." Pet. 85 (quoting *Code200*, Paper 18, 6).

Thus, factors 6 and 7 weigh against exercising our discretion to deny institution.

4. *Balancing the General Plastic Factors*

For the reasons discussed, the *General Plastic* factors weigh against denying institution here. Accordingly, we do not exercise our discretion to deny institution under § 314(a).

B. § 314(a) - *Parallel Proceedings (Fintiv)*

Patent Owner asserts that we should deny institution under *Fintiv* based on the related district court matters identified above. Prelim. Resp. 17–27; see *Fintiv*, Paper 11, 12 (holding that PTAB has discretion to deny institution in certain circumstances where there are parallel district court proceedings). Our analysis under *Fintiv* is guided by the USPTO Director's Memorandum issued on June 21, 2022, titled "Interim Procedure for Discretionary Denials in AIA Post Grant Proceedings with Parallel District Court Litigation" ("Director's Memo"). Pursuant to the Director's Memo, we "will not discretionarily deny institution . . . where a petitioner presents a [*Sotera*] stipulation." Director's Memo at 3 (citing *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020) (precedential as to § II.A)). Because Petitioner has offered a stipulation like in *Sotera*, i.e., to "not pursue the same invalidity grounds against the challenged claims of the '393 patent in the parallel litigation [or] any

grounds that could have been reasonably raised in this petition” (Pet. 85)⁷, we do not discretionarily deny institution under *Fintiv*.

C. § 325(d) (Advanced Bionics)

Patent Owner argues that the Petition should be denied under 35 U.S.C. § 325(d). Prelim. Resp. 8–17; PO Sur-reply 4–5. In determining whether to deny institution under § 325(d), we use

the following two-part framework: (1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of the first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.

Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential). “[T]he *Becton, Dickinson* factors provide useful insight into how to apply the framework under 35 U.S.C. § 325(d).” *Id.* at 9 (footnote omitted). The non-exclusive *Becton, Dickinson* factors are:

- (a) the similarities and material differences between the asserted art and the prior art involved during examination;
- (b) the cumulative nature of the asserted art and the prior art evaluated during examination;

⁷ In its Preliminary Response, Patent Owner argued that Petitioner’s *Sotera* stipulation was improper because it “include[d] an apparent typographical error.” Prelim. Resp. 22–23. In response to Patent Owner’s objection, Petitioner “replace[d] the word ‘on’ in its proffered *Sotera* stipulation with the word ‘or.’” Pet. Reply 7 (citing Director’s Memo, 3, 7). Patent Owner did not address the *Fintiv* factors or otherwise object to Petitioner’s modified *Sotera* stipulation in its Sur-reply. *See generally* PO Sur-reply.

(c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection;

(d) the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art;

(e) whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art; and

(f) the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments.

Becton, Dickinson & Co. v. B. Braun Melsungen AG, IPR2017-01586, Paper 8, 17–18 (PTAB Dec. 15, 2017) (precedential as to § III.C.5, first paragraph). *Becton, Dickinson* factors (a), (b), and (d) relate to the first part of the *Advanced Bionics* framework (whether the same or substantially the same art or arguments previously were presented to the Office), and *Becton, Dickinson* factors (c), (e), and (f) relate to the second part of that framework (previous Office error). *Advanced Bionics*, Paper 6, 9–11.

1. Whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office

Under the first part of the *Advanced Bionics* framework, we consider “whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office.” *Advanced Bionics*, Paper 6, 8. Previously presented art includes art made of record by the Examiner, and art provided to the Office by an applicant, such as on an Information

Disclosure Statement (“IDS”), in the prosecution history of the challenged patent. *Becton*, Paper 8, 7–8.

Paper Owner argues that Petitioner “does not dispute that part (1) of the Board’s two-part framework under *Advanced Bionics* is satisfied.” Prelim. Resp. 9 (citing Pet. 80–82). More particularly, Patent Owner asserts that “[t]he Examiner submitted a ‘list of references cited by the Applicant and considered by the Examiner,’ in which the Examiner acknowledged the Applicant’s information disclosure statement (‘IDS’) and indicated that he had considered, *inter alia*, all five references cited therein.” *Id.* (citing Ex. 1009, 92, 96–98). We agree with Patent Owner, and as such, the first part of the *Advanced Bionics* framework is satisfied.

2. *Whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims*

Under the second part of the *Advanced Bionics* framework, we consider “whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.” *Advanced Bionics*, Paper 6, 8. “An example of a material error may include misapprehending or overlooking specific teachings of the relevant prior art where those teachings impact patentability of the challenged claims.” *Id.* at 8 n.9.

Patent Owner argues that Petitioner “fails to point out *specifically how* the Examiner erred in his evaluation of [Petitioner’s] asserted references.” Prelim. Resp. 14 (citing *Advanced Bionics*, Paper No. 6, 21). According to Patent Owner, Petitioner simply “argues that [Patent Owner]

misled the Examiner by failing to disclose [Petitioner's] IPR petitions against a different patent—the '119 Patent—to the Office during examination of the application for the '393 [p]atent.” *Id.* Patent Owner argues that it “was not required to submit [Petitioner's] '119 IPR petitions to the Office, nor did [Patent Owner's] failure to do so mislead the Examiner in any way.” *Id.* at 15 (citing Pet. 80–82).

Petitioner asserts that, “[d]uring prosecution, the Examiner never discussed [Petitioner's] art or specific combinations.” Pet. Reply 3. According to Petitioner, “[t]he overlooked art is material to patentability” based on the “multiple grounds that render claims 1–7 unpatentable, including limitations [Patent Owner] asserts were the basis for allowance.” *Id.* In addition, Petitioner argues that “there is no evidence the Examiner substantively analyzed [Petitioner's] cited art, let alone its specific combinations.” *Id.* at 4.

Patent Owner responds that Petitioner “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.” PO Sur-reply 5 (citing *Advanced Bionics*, Paper 6, 9). Patent Owner also argues that there is no requirement for Patent Owner to show that the Examiner substantively analyzed the cited prior art in an Office Action under the *Advanced Bionics* framework. *Id.* We disagree.

At the outset, we note that the exercise of discretion in *Advanced Bionics* did not turn on mere citation in an IDS of the art asserted in the petition. Rather, the Board’s exercise of discretion in that case turned on the Examiner’s application and discussion of that art. Specifically, the Board

found in *Advanced Bionics* that the asserted art, Zimmerling, “is the same art previously presented to the Office” because “the Examiner rejected [the claims] as anticipated by Zimmerling” and “Zimmerling was discussed during prosecution.” *Advanced Bionics*, Paper 6, 13. In other words, the criteria adopted by the Board for denying the petition in *Advanced Bionics* included not only the fact that the art was made of record, but also the fact that it was applied and discussed during prosecution. Anything less disregards the express reasoning behind the Board’s exercise of discretion in that case. Here, Patent Owner has not shown that any Petitioner’s cited art (i.e., Willner, Park, Schoenith, Kessler, Hirschman) was applied by the Examiner or discussed during prosecution.

Instead, during examination of the ’393 patent, the record shows that the Examiner allowed the pending claims over “Wu (2006/0252537) in view of Willis (2014/0274394).” Ex. 1009, 26–29. In doing so, the Examiner stated that a “[g]ame controller with structural bridge is well known in the art” (*id.* at 27), but found that “Wu in view of Willis is silent on” the subject matter claim 1. *See id.* at 27–28 (quoting the subject matter of independent claim 1 in its entirety). However, on this record, Petitioner demonstrates that the Examiner overlooked the combination of Willner and Park’s teachings of the limitations that were the basis for allowing the challenged claims. *Id.* As discussed in more detail below, Petitioner’s evidence demonstrates a reasonable likelihood that at least independent claim 1 of the ’393 patent is unpatentable over the combination of Willner and Park. *See* Pet. 19–41 (citing Exs. 1002, 1003, 1004).

As a result, on this record, Petitioner demonstrates that the Office erred in a manner material to the patentability of challenged claims.

III. ANALYSIS

A. Level of Ordinary Skill in the Art

In determining the level of ordinary skill in the art, various factors may be considered, including the “type of problems encountered in the art; prior art solutions to those problems; rapidity with which innovations are made; sophistication of the technology; and educational level of active workers in the field.” *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995) (internal quotation marks and citation omitted).

Petitioner asserts that at the time of the invention a person of ordinary skill in the art (“POSITA”) would have had “an undergraduate degree in mechanical, electrical, or computer engineering or other technical training in product design or equivalent work experience in the development of interactive products.” Pet. 13. Petitioner adds that “[s]uch a person would have possessed at least one year of experience in developing and/or evaluating interactive products.” *Id.*

Patent Owner does not provide its own assessment regarding the level of skill in the art, or otherwise dispute Petitioner’s assertion. *See generally* Prelim. Resp.

Based on our review of the record at this stage, we find that Petitioner’s proposal is consistent with the level of skill reflected in the prior art references of record. *See Daiichi Sankyo Co. v. Apotex, Inc.*, 501 F.3d 1254, 1256 (Fed. Cir. 2007) (listing the type of problems encountered in the

art, prior art solutions to those problems, and the sophistication of the technology as factors that may be considered in determining the level of ordinary skill in the art). The prior art itself may be sufficient to demonstrate the level of skill in the art at the time of the invention. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (explaining that specific findings regarding ordinary skill level are not required “where the prior art itself reflects an appropriate level and a need for testimony is not shown”) (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).

Accordingly, for purposes of this decision, we adopt Petitioner’s definition of the person of ordinary skill in the art.

B. Claim Construction

In this *inter partes* review, we apply the same claim construction standard that would be used in a civil action under 35 U.S.C. § 282(b). 37 C.F.R. § 42.100(b). In applying this standard, we generally give claim terms their ordinary and customary meaning as would be understood by a person of ordinary skill in the art at the time of the invention and in the context of the entire patent disclosure. *See id.*; *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–14 (Fed. Cir. 2005) (en banc).

Petitioner references a district court order construing claims (Ex. 1028) issued in the Northern District of California on January 19, 2023. Pet. 14; *see also id.* at 14–17 (identifying several constructions applied by the district court). Petitioner asserts that where the district court has entered a claim construction or there is a construction agreed upon by the parties,

Petitioner applies it. *Id.* Petitioner asserts that the remaining claim terms should be construed according to their ordinary and customary meaning. *Id.*

Patent Owner does not address claim construction. *See generally* Prelim. Resp.

We currently do not discern any claim-construction issue affecting Petitioner’s demonstration of a reasonable likelihood of prevailing. Thus, at this stage, we do not find it necessary to construe expressly any language of the challenged claims. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (noting that “we need only construe terms ‘that are in controversy, and only to the extent necessary to resolve the controversy’”) (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)).

At this stage of the proceeding and based on the record, we determine that no express claim construction is necessary to institute.

C. Alleged Obviousness over Willner and Park

Petitioner contends the subject matter of claim 1–7 would have been obvious over the combination of Willner and Park. Pet. 19–41. Petitioner also relies on the testimony of Mr. Kitchen to support its arguments. *Id.* Patent Owner does not dispute Petitioner’s contentions at this time.⁸

⁸ Petitioner contends that the doctrine of issue preclusion prevents Patent Owner from contesting several findings regarding Petitioner’s grounds of unpatentability presented in the current Petitioner. Pet. 19–23, 25, 28, 29, 31, 41–44, 46–48, 56, and 57 (citing Exs. 1010, 1011). More particularly, Petitioner argues that “[i]n the ’119 IPRs, the Board made several findings that were necessary to its final written decisions that the challenged claims

1. *Overview of Willner (Ex. 1003)*

Willner is directed to “a hand grippable system which can function as both a pair of game controllers and as an ergonomic keyboard.” Ex. 1003 ¶ 3. Willner’s Figure 4, which is reproduced below, illustrates “a schematic view of the present invention incorporating an adaptor for receiving a computing device.” *Id.* ¶ 20.

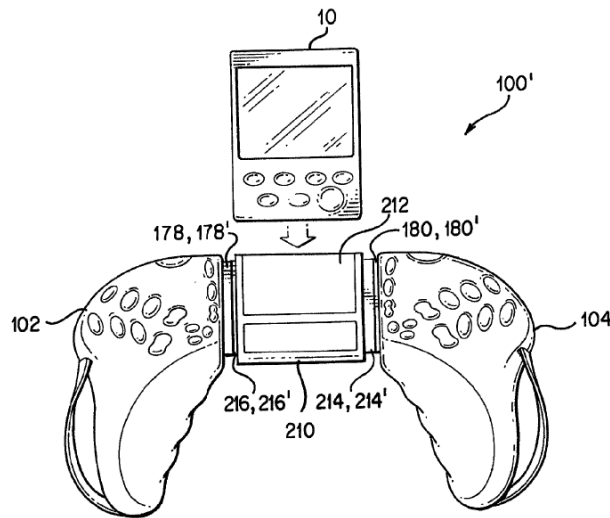


FIG. 4

Figure 4 depicts hand grippable game controller system 100' including

of the '119 patent are unpatentable, and are, thus, binding on [Patent Owner] now.” *Id.* at 19. At this stage of the proceeding, we do not decide the issue of collateral estoppel, but instead evaluate the arguments and evidence presented in the Petition to determine whether there is a reasonable likelihood that Petitioner would prevail with respect to the grounds of unpatentability presented, rather than assuming that Patent Owner is generally estopped from asserting patentability of the challenged claims over the prior art references presented in both the '119 IPRs and this proceeding. To the extent necessary for final resolution of any issue or ground, we will determine whether collateral estoppel applies in our final decision. Thus, the parties are given notice that this is an issue to be addressed during trial.

housings 102, 104 which can communicate with computer 10.
Ex. 1003 ¶ 50.

Willner discloses that “adaptor 210 is provided with an opening 212 into which the computing device 10 is received. Adaptor 210 is provided with connecting portions 214 and 216 which respectively matingly engage with connecting portions 180, 180' of housing 104 and 178, 178 of housing 102.” Ex. 1003 ¶ 50. Willner further discloses that “[a]daptor 210 is provided with complementary connectors 214 and 216” for receiving the keystroke signals from each hand grippable unit and transferring such to a docking connector within the adaptor 210 which mates with a corresponding connector of the computing device 10.” *Id.* ¶ 51.

2. Overview of Park (Ex. 1004)

Park is directed to “a game pad device for a mobile phone.” Ex. 1004 ¶ 1. Park’s Figure 1, which is reproduced below, illustrates “a perspective view showing the basic configuration of the game pad device for a mobile phone.” *Id.* ¶ 23.

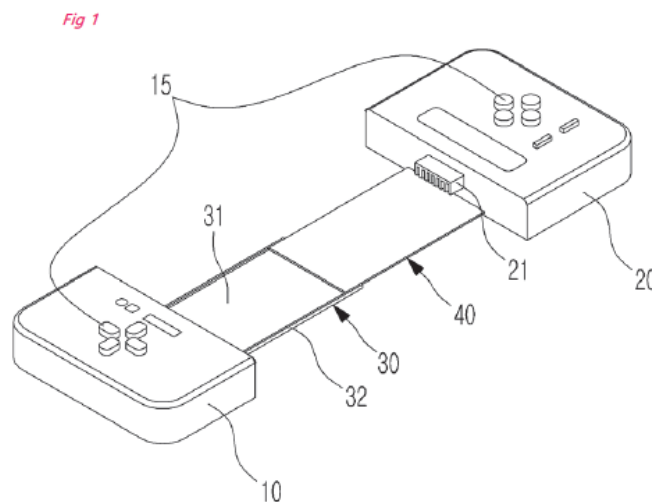


Figure 1 depicts first body 10 and second body 20 connected via bridge 30, 40. Ex. 1004 ¶ 30.

Park discloses that adjustable bridge 30, 40 mechanically and electrically connects first body 10 to second body 20 which is connected to mobile phone 1 by connecting terminal 21 when the mobile phone is mounted on the device. Ex. 1004 ¶ 40.

3. *Analysis of Claim 1*

Petitioner asserts claim 1 would have been obvious over Willner and Park. Pet. 19–41. We use Petitioner’s notations to identify the claim elements.

a) *1[pre] A combination comprising:⁹ 1[a]] a computing device;*

Petitioner asserts that Willner discloses “computing device 10, which is described as a ‘palm/tablet sized computing device’ that can have ‘a wireless data link’” and “hard wire ‘connectors.’” Pet. 22 (citing Ex. 1003 ¶ 50). Petitioner also identifies that Park discloses “a ‘touchscreen type mobile phone for gaming.’” *Id.* (citing Ex. 1004 ¶ 1). According to Petitioner, one of ordinary skill in the art “would have understood that Willner’s computing device 10 and Park’s mobile phone included a central processing unit (CPU) and electronic equipment controlled by the CPU, such

⁹ We need not decide whether the preamble of claim 1 is limiting for purposes of this Decision, because Petitioner shows sufficiently that the cited art teaches the preamble.

as a (touch)screen, memory, Bluetooth module, and connectors.” *Id.* (citing Ex. 1002 ¶ 144).

Based on the present record, Petitioner shows sufficiently that the combination of Willner and Park teaches the subject matter of limitation 1[a].

b) *1[b][1] a pair of confinement structures, the pair of confinement structures interacting with the computing device and adjacent at least two opposing sides of the computing device, but not more than three sides of the sides of the computing device,*

Petitioner asserts that the combination of Willner and Park renders this limitation obvious. Pet. 22–25. More particularly, Petitioner asserts that “the sidewalls of the Willner/Park combination *interact* with the *computing device* and are *adjacent*[□] [to] *at least two opposing sides of the computing device.*” *Id.* at 23. Petitioner provides the following copy of Figure 4 of Willner, annotated to identify in orange, adaptor 210 that receives computing device 10 with sidewalls that “are nearby (*adjacent*) the two opposing sides of computing device 10 when the device is inserted into the

adaptor.” *Id.* 23–24 (citing Ex. 1003 ¶¶ 50–51, Fig. 4; Ex. 1002 ¶¶ 146–156).

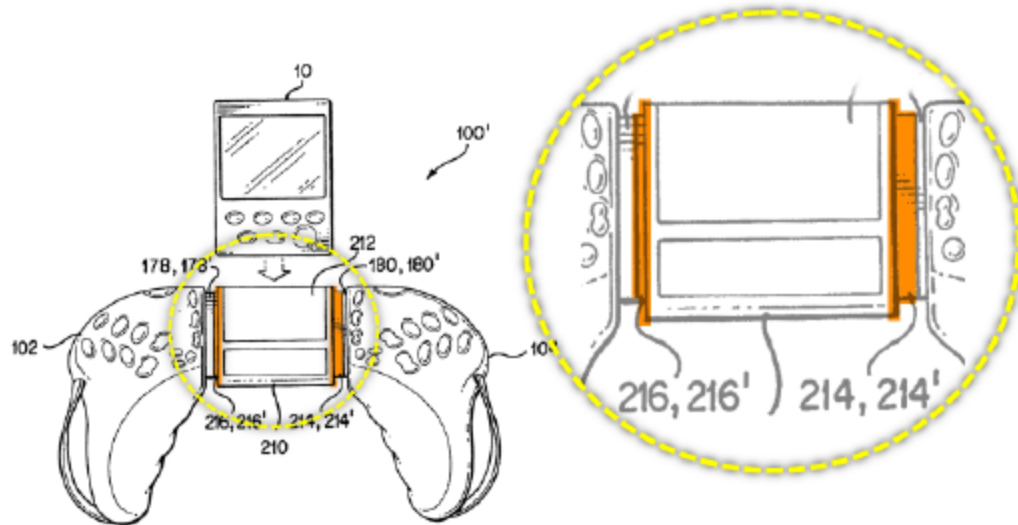
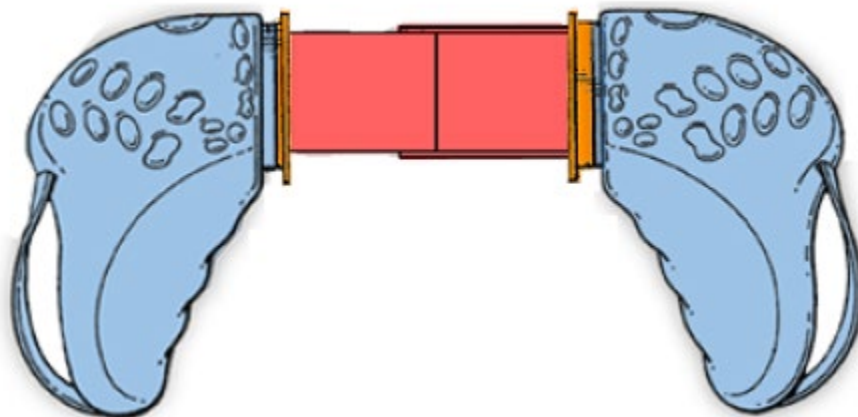


FIG. 4

Figure 4, annotated, depicts adaptor 210 “with an opening 212 into which the computing device 10 is received.” Ex. 1003 ¶ 50; Pet. 24.

Petitioner also provides the following annotated figure that “includes Park’s adjustable bridge (red) that connects left and right sidewalls (orange).” Pet. 24.



Petitioner’s annotated figure depicts “Park’s adjustable bridge (red) that connects left and right sidewalls (orange).” Pet. 24.

With reference to Petitioner’s annotated figure, Petitioner asserts that

[w]hen a user adjusts the bridge, the sidewalls apply pressure to and receive resistance from the *computing device*—thereby physically *interacting with the computing device*. Additionally, the left and right sidewalls contain connectors 214’ and 216’ that electrically *interact* with the computing device through the reception and transmission of data to the computing device.

Pet. 24 (citing Ex. 1002 ¶¶ 156–157).

Based on the present record, Petitioner shows sufficiently that the combination of Willner and Park teaches the subject matter of limitation 1[b][1].

c) *1[b][2][a] each of the pair of confinement structures comprising a communication link,*

Petitioner asserts that Willner discloses “adaptor sidewalls (*confinement structures*) (orange) that include connectors 214’ and 216’ (yellow).” Pet. 25–26. Petitioner provides another annotated copy of Figure 4 of Willner, annotated to identify adaptor 210 and connectors 214’ and 216’. *Id.* at 25 (citing Ex. 1003 ¶ 51, Fig. 4).

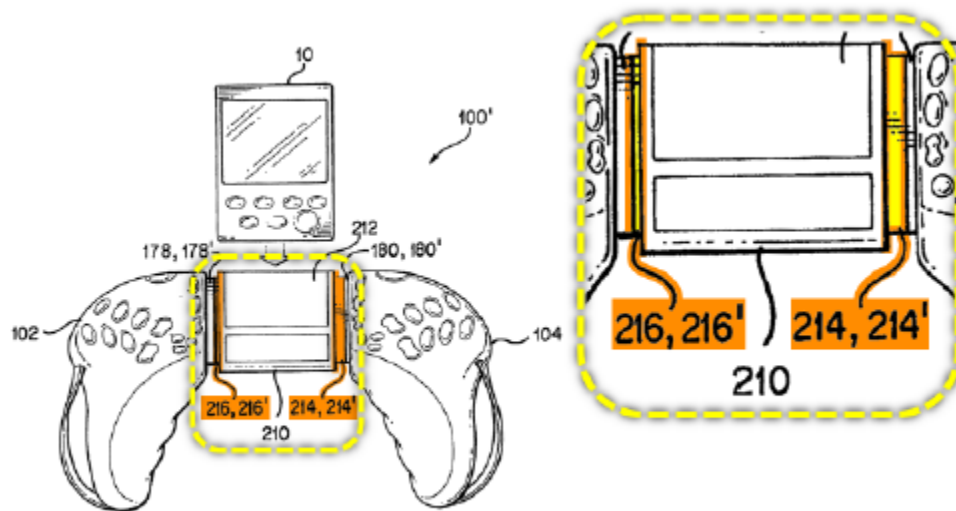


FIG. 4

Figure 4, annotated, depicts “[a]daptor 210 is provided with complementary connectors 214’ and 216.” Ex. 1003 ¶ 51 Pet. 26.

Petitioner asserts that “[e]ach connector ‘receiv[es] the keystroke signals from each hand grippable unit’ and ‘transfers’ them to device 10 via connector 226.” Pet. 25 (citing Ex. 1003 ¶ 51, Fig. 8). According to Petitioner, “[c]onnector 214’ or 216’ are thus *communication links* (‘a component for reception and transmission of data’).” *Id.* at 25–26 (citing Ex. 1002 ¶¶ 159–162).

Based on the present record, Petitioner shows sufficiently that the combination of Willner and Park teaches the subject matter of limitation 1[b][2][a].

d) 1[b][2][b] each of the communication links configured for electronic communication with the computing device;

Petitioner asserts that Willner discloses sidewall connectors 214’ and 216’ are part of adapter 210 and “receive and transfer data from housings 102 and 104 ‘to a docking connector within adaptor 210 which mates with a

corresponding connector of the computing device 10.” Pet. 26 (citing Ex. 1003 ¶ 51). Petitioner identifies that Willner’s adaptor 210 also includes switch 218. *Id.* at 26–27 (citing Ex. 1002 ¶¶ 166–170). And, according to Petitioner, one of ordinary skill in the art “would have understood that for the sidewall connectors 214’ and 216’ to receive and transfer data, the connectors would have included associated electronic circuitry, such as switches.” *Id.* at 27 (citing Ex. 1002 ¶ 165).

Petitioner further asserts that “sidewall connectors 214’ and 216’ of the Willner/Park combination receive and transfer data to computing device 10, by receiving data from housings 102, 104 and transferring it to device connector 226, which sends the data to computing device 10.” Pet. 28 (citing Ex. 1003 ¶ 51, Fig. 8; Ex. 1002 ¶ 163–164). According to Petitioner,

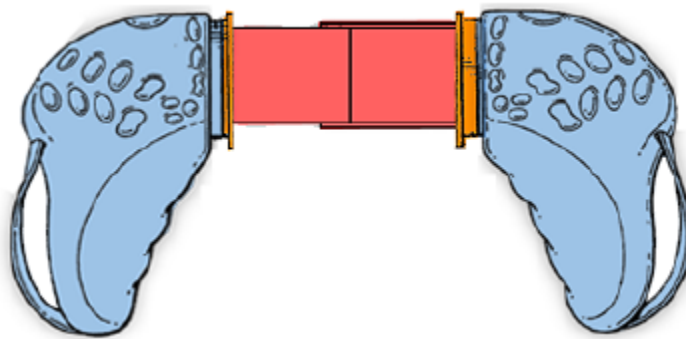
[i]n the Willner/Park combination, regardless of the physical location of device connector 226 (i.e., whether at the sidewall with connector 214’ or at the sidewall with connector 216’), a cable in Park’s bridge would have allowed communication between the sidewall connectors (and their corresponding housings) and between each sidewall connector (and housing) and device 10.

Id. (citing Ex. 1002 ¶ 171). Petitioner notes that “[t]he ’393 patent similarly describes ‘interface feature 338’ in a confinement structure that allows communications with a computing device.” *Id.* (citing Ex. 1001, 10:21–29).

Based on the present record, Petitioner shows sufficiently that the combination of Willner and Park teaches the subject matter of limitation 1[b][2][b].

e) 1[c][1] a rigid structural bridge disposed between and secured to the pair of confinement structures,

Petitioner asserts that the combination of Willner and Park renders this limitation obvious. Pet. 28–29. Petitioner provides the following annotated figure illustrating “Park’s adjustable bridge (*structural bridge*)” “between and attached to (*secured to*) Willner’s adaptor sidewalls (*confinement structures*).” *Id.* at 29 (citing Ex. 1004 ¶¶ 9, 31–35, Fig. 2).



Petitioner’s annotated figure depicts Park’s adjustable bridge (red) between and attached to Willner’s sidewalls. Pet. 29.

Petitioner identifies that “Park’s bridge is *rigid* in order to hold game pads together and support a ‘mounted’ phone and internal connecting cable.” Pet. 29 (citing Ex. 1004 ¶¶ 30, 32, 36, 40; Ex. 1002 ¶¶ 174–175).

Based on the present record, Petitioner shows sufficiently that the combination of Willner and Park teaches the subject matter of limitation 1[c][1].

f) 1[c][2][a] the rigid structural bridge comprising a passageway between the pair of confinement structures,

Petitioner asserts that the combination of Willner and Park renders this limitation obvious. Pet. 29–30. More particularly, Petitioner asserts that “Park’s adjustable bridge (*structural bridge*) contains a ‘certain

portion . . . inside of the bridge’ (*passageway*) that accommodates a ‘cable’ to ‘electrically join[]’ Willner’s adaptor sidewalls (*between the pair of confinement structures*).” *Id.* at 30 (citing Ex. 1004 ¶¶ 26, 36; Ex. 1002 ¶¶ 177–180).

Based on the present record, Petitioner shows sufficiently that the combination of Willner and Park teaches the subject matter of limitation 1[c][2][a].

g) 1[c][2][b] *the passageway promotes electrical communication between the communication link of a first confinement structure of the pair of confinement structures and the computing device, the passageway further promotes electrical communication between the communication link of a second confinement structure of the pair of confinement structures and the computing device; and*

Petitioner asserts that the combination of Willner and Park renders this limitation obvious. Pet. 30–31. More particularly, Petitioner asserts that “Willner disclosed connectors 214’ and 216’ (*communication links*) in the left and right sidewalls of adaptor 210 (*confinement structures*) to allow electrical signals to be received and transferred from housings 102 and 104 to computing device 10 (*computing device*).” *Id.* at 30 (citing Ex. 1003 ¶¶ 24, 50, 51, Figs. 4, 8).

Based on the present record, Petitioner shows sufficiently that the combination of Willner and Park teaches the subject matter of limitation 1[c][2][b].

h) 1[d][1] *a pair of electronic game control modules,*

Petitioner asserts that Willner discloses “housings 102 and 104 (*electronic game control modules*) (blue) that are used for ‘gaming . . . functions.’” Pet. 31 (citing Ex. 1003 ¶¶ 25–29, 32, 40, 51; Ex.

1002 ¶ 184). Petitioner provides another annotated copy of Figure 4 of Willner, annotated to identify housings 102 and 104. *Id.*

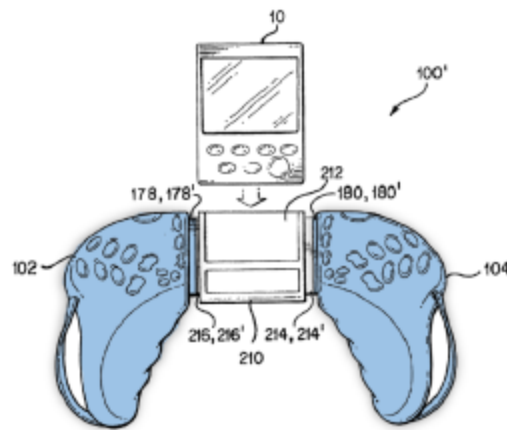


FIG. 4

Figure 4, annotated, depicts housing 102 and 104. Pet. 31; Ex. 1003 ¶¶ 25–29.

Based on the present record, Petitioner shows sufficiently that the combination of Willner and Park teaches the subject matter of limitation 1[d][1].

- i) 1[d][2] *each electronic game control module of the pair of electronic game control modules is secured to and interacts with a corresponding confinement structure of the pair of confinement structures,*

Petitioner asserts that the combination of Willner and Park renders this limitation obvious. Pet. 32–33. More particularly, Petitioner asserts that “Willner’s housings 102 and 104 (*electronic game control modules*) attach to (*secure to*) adaptor sidewalls (*confinement structures*) via ‘connectors 214’ and 216’.” *Id.* at 32 (citing Ex. 1003 ¶¶ 46, 51). Petitioner further asserts that “[t]he housings also *interact* with a *corresponding confinement structure*” using pins and sockets. *Id.* (citing Ex. 1003 ¶¶ 50–51; Ex. 1002

¶¶ 186–190). Petitioner explains that “the two housings electrically *interact* with the sidewalls, for example, by sending ‘keystroke signals’ from connectors 178’ and 180’ to connectors 214’ and 216’. These signals are then transferred by connectors 214’ and 216’ to computing device 10, through combining gate circuitry 228 and device connector 226.” *Id.* at 32–33 (citing Ex. 1003 ¶¶ 46, 51; Ex. 1002 ¶ 191). Petitioner notes that “[t]he ’393 patent describes similar electrical interactions.” *Id.* at 33 (citing Ex. 1001, 6:1–6).

Based on the present record, Petitioner shows sufficiently that the combination of Willner and Park teaches the subject matter of limitation 1[d][2].

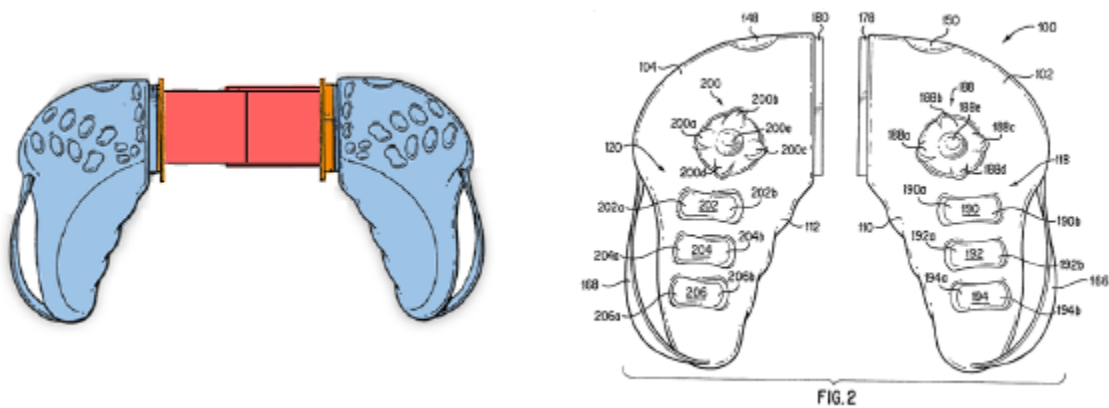
j) *1[d][3] each electronic game control module in electronic communication with the communication link of its corresponding confinement structure,*

Petitioner asserts that the combination of Willner and Park renders this limitation obvious. Pet. 33–34. More particularly, Petitioner asserts that Willner’s “housings 102 and 104 send ‘keystroke signals’ through gate circuitry 230 to connectors 178’ and 180’, which pass those signals to corresponding connectors 214’ and 216’ (*communication links*).” *Id.* at 33 (citing Ex. 1003 ¶¶ 46, 51, 52). Petitioner further asserts that one of ordinary skill in the art would have understood that “for connectors 214’ and 216’ to receive and transmit data,” the connectors would include some electronic circuitry, i.e., switch 218. *Id.* (citing Ex. 1002 ¶¶ 193–198; Ex. 1003 ¶ 52).

Based on the present record, Petitioner shows sufficiently that the combination of Willner and Park teaches the subject matter of limitation 1[d][3].

k) 1[d][4] wherein each electronic game control module is a separate and distinct structure from each of their corresponding confinement structures, forming no structural portion of their corresponding confinement structures, and

Petitioner asserts that Willner's control modules are separate and distinct from the sidewalls of its adaptor. Pet. 34 (citing Ex. 1002 ¶¶ 199–200; Ex. 1003, Abstract, ¶¶ 50–51). Petitioner provides the following annotated figure illustrating that “[e]ach of Willner’s housings (*electronic game control modules*) (blue) is detachable from a corresponding adaptor sidewall (*confinement structures*) (orange).”

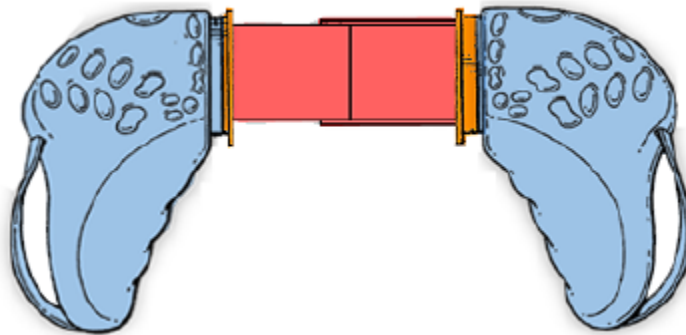


Petitioner's annotated figure is a side-by-side comparison of its figure next to Figure 2 of Willner depicting housings 102 and 104. Pet. 34; Ex. 1003, Fig. 2.

Based on the present record, Petitioner shows sufficiently that the combination of Willner and Park teaches the subject matter of limitation 1[d][4].

- l) *1[d][5] in which each of the pair of confinement structures are separate and distinct structures from the structural bridge, forming no structural portion of the structural bridge.*

Petitioner asserts that the combination of Willner and Park renders this limitation obvious. Pet. 35–37. Petitioner provides the following annotated figure illustrating “Park’s bridge (*structural bridge*) (red) is separate and distinct from Willner’s adaptor sidewalls (*confinement structures*) (orange), with the sidewalls *forming no structural portion of the structural bridge.*” *Id.* at 35 (citing Ex. 1002 ¶¶ 201–212).



Petitioner’s annotated figure depicts Park’s adjustable bridge as being separate and distinct from Willner’s adaptor sidewalls. Pet. 35.

Petitioner identifies that Park teaches that its bridge 30, 40 “is separate from and connects to first and second bodies (10 and 20) that hold a mobile device.” Pet. 35 (citing Ex. 1004 ¶¶ 26–30, Figs. 3–4). Based on these teachings, Petitioner asserts that one of ordinary skill in the art “would have connected Park’s bridge and Willner’s adaptor sidewalls (separate and distinct structures) as part of the combination.” *Id.* (citing Ex. 1002 ¶¶ 202–203). Relying on the declaration testimony of Mr. Kitchen, Petitioner also argues that “whether the sidewalls are separate and distinct from the bridge is a mere design choice, including, for example, where the

sidewalls are detachably connected to the bridge” because “[s]eparate structures were well-known in the art, and the substitution of separate sidewalls for non-separate sidewalls would do no more than yield predictable results.” *Id.* (citing Ex. 1002 ¶ 203). Also, relying on the declaration testimony of Mr. Kitchen, Petitioner asserts that one of ordinary skill in the art would “have recognized screws as a known mechanism for affixing Willner’s sidewalls to Park’s bridge,” and as such, “Willner’s sidewalls would have been replaceable or repairable in case of damage or malfunction.” *Id.* at 36 (citing Ex. 1002 ¶¶ 208–210).

Based on the present record, Petitioner shows sufficiently that the combination of Willner and Park teaches the subject matter of limitation 1[d][5].

4. *Conclusion for Claim 1*

Petitioner has shown sufficiently that the combination of Willner and Park teaches all limitations of claim 1. Petitioner also has put forth sufficient reasons for combining these references with a reasonable expectation of success. Pet. 20–21 (citing Ex. 1002 ¶¶ 133–139, 150–157; Ex. 1003 ¶ 50; Ex. 1004 ¶¶ 39–46). For example, Petitioner asserts that “Park’s adjustable bridge ‘would greatly expand the number of devices that [Willner’s] product would support, leading to the predictable result of having a larger base of customers.’” *Id.* at 20 (citing Ex. 1011, 19; Ex. 1018, 185 Ex. 1003 ¶ 138). Based on the present record, we determine that Petitioner has established a reasonable likelihood that it would prevail in showing that the subject matter of claim 1 would have been obvious over the combination of Willner and Park.

5. *Analysis of Claims 2–7*

Claims 2–7 depend directly or indirectly from claim 1. Petitioner provides a clause-by-clause analysis of where each element in dependent claims 2–7 is disclosed in, or would have been obvious in view of, Willner and Park. Pet. 37–41. Throughout Petitioner’s analysis, Petitioner cites and relies on the testimony of Mr. Kitchen for evidentiary support. *Id.* (citing Ex. 1002 ¶¶ 213–233).

Patent Owner does not specifically address any of the dependent claims. *See* Prelim. Resp. 1–27.

We find Petitioner’s arguments and evidence in support thereof sufficient at this stage of the proceeding for the reasons explained by Petitioner. *See* Pet. 37–41. Accordingly, based on the arguments and evidence on the record before us, we determine, for purposes of this Decision, Petitioner has established a reasonable likelihood of prevailing on dependent claims 2–7.

D. Alleged Obviousness over Schoenith and Park (Ground 2); Schoenith and Kessler (Ground 3); and Hirschman (Ground 4)

Petitioner also asserts various other challenges against claims 1–7. *See* Pet. 41–80. Similar to Ground 1, Patent Owner does not separately address the merits of Petitioner’s other prior art challenges. *See* Prelim. Resp. 1–27. Because, as discussed above, Petitioner meets the threshold for institution by demonstrating a reasonable likelihood that at least claim 1 is unpatentable as obvious over Willner and Park, we need not decide whether Petitioner’s other challenges demonstrate the same. *SAS Inst.*, 138 S.Ct. at 1359–60; *see also PGS Geophysical AS v. Iancu*, 891 F.3d 1354, 1360 (Fed.

Cir. 2018) (interpreting the statute to require “a simple yes-or-no institution choice respecting a petition, embracing all challenges included in the petition”). We will address the merits of these challenges, if necessary, after a full development of the record during trial.

IV. CONCLUSION

After considering the evidence and arguments presented in the Petition, we determine that Petitioner has demonstrated a reasonable likelihood of prevailing in proving that at least one of claims 1–7 of the ’393 patent is unpatentable, and thus, we institute an *inter partes* review of all challenged claims on all presented challenges. 37 C.F.R. § 42.108(a).

At this stage of the proceeding, the Board has not made a final determination as to the patentability of any challenged claim or any underlying factual and legal issues.

V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that *inter partes* review of claims 1–7 of the ’393 patent is instituted on the grounds asserted in the Petition; and

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial; the trial will commence on the entry date of this decision.

IPR2023-00643
Patent 10,391,393 B2

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