

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. IPR2018-01522

Patent No. 9,126,119

PETITIONERS' REPLY TO PATENT OWNER'S RESPONSE

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EXHIBIT LIST

- Ex. 1001 U.S. Patent No. 9,126,119 (“’119 patent”)
- Ex. 1002 Declaration of Garry Kitchen (“Kitchen”)
- Ex. 1003 U.S. Patent No. 9,539,507 B2 (“Schoenith”)
- Ex. 1004 Translation of Korean Patent No. 10-2011-0116892 (“Park”) with Korean Version and Translation Certification
- Ex. 1005 International Patent Application No. WO 2014/079264 A1 (“Kessler”)
- Ex. 1006 U.S. Patent Application Publication No. US 2015/0134859 A1 (“Hirschman”)
- Ex. 1007 U.S. Patent No. 8,529,357 (“’357 patent”)
- Ex. 1008 File History for U.S. Patent No. 9,126,119
- Ex. 1009 Complaint filed in *Gamevice, Inc. v. Nintendo Co., Ltd. et al.*, Case No. 17-cv-05923 (C.D. Cal. Aug. 9, 2017)
- Ex. 1010 U.S. Patent No. 8,944,912 (“’912 patent”)
- Ex. 1011 Excerpt of American Heritage Dictionary (Second College Edition)
- Ex. 1012 Merriam-Webster's Online Dictionary (“conduit”) (<https://www.merriam-webster.com/dictionary/conduit>)
- Ex. 1013 U.S. Provisional Patent Application No. 61/477,387
- Ex. 1014 U.S. Patent Application Publication No. 2001/0045938 A1 (“Willner”)
- Ex. 1015 U.S. Patent Application Publication No. 2010/0195279 A1 (“Michael”)
- Ex. 1016 Affidavit in Support of Petitioners’ Motion for *Pro Hac Vice* Admission of R. Hawkins

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Ex. 1017 Affidavit in Support of Petitioners' Motion for *Pro Hac Vice*
 Admission of K. Zeck

I. INTRODUCTION

Rather than addressing the Board's claim construction findings or offering responsive expert testimony, Gamevice merely presses the same arguments the Board already rejected, doubling down on its erroneous procedural objections and complaining that Nintendo's expert declaration was too detailed. As it did before, Gamevice criticizes Nintendo's constructions, while tellingly offering none of its own.

By contrast, Nintendo's Petition and supporting expert declaration explained in detail why the challenged claims are unpatentable in view of the prior art under either Nintendo's proffered constructions or Gamevice's apparent constructions. The same is true under the Board's preliminary claim constructions.

As explained in the Petition and confirmed by the only expert testimony before the Board, the '119 patent claims the combination of a computing device and game controller, which includes standard game-controller components known in the art, used as expected and intended. Accordingly, Nintendo respectfully requests that the Board cancel claims 1-10 and 13-21 of the '119 patent.

II. CLAIM CONSTRUCTION

A. Nintendo's proposed constructions should be adopted

Nintendo's Petition explained the proper construction for five terms. Two of those terms—confinement structures and fastening mechanism—should be

construed under 35 U.S.C. § 112(f). Gamevice once again refused to offer its own constructions or explain why it believes Nintendo's proposed constructions were incorrect. Paper 8 at 5.

The Board's Institution Decision indicated that it was not expressly construing any of the five terms. *Id.* It preliminarily noted, however, that the term *confinement structures* “encompasses components that ‘securely hold the computing device’ or ‘provide a computing device cradle,’ as well as components in which ‘the computing device is fully nested.’” *Id.* (internal citations omitted). The Board also included a footnote explaining that it was not convinced that fastening mechanism should be subject to § 112(f) “given that the root term ‘fasten’ conveys sufficient generic structure under its common and ordinary meaning.” *Id.* at 8 n.5. Nintendo respectfully asks the Board to reconsider those preliminary conclusions.

As for *confinement structures*, the Board's discussion of the term demonstrates why the term is subject to § 112(f). In discussing the scope of the term, the Board replaced one nonce word—“structure”—with another—“component”—and said that any “component” that can perform three listed functions is sufficient. *Id.* at 5. As the Federal Circuit explained in *Williamson*, however, “[g]eneric terms such as ‘mechanism,’ ‘element,’ ‘device,’ and other

nonce words that reflect nothing more than verbal constructs may be used in a claim in a manner that is tantamount to using the word ‘means’ because they ‘typically do not connote sufficiently definite structure’ and therefore may invoke § 112, para. 6.” *Williamson v. Citrix Online LLC*, 792 F.3d 1339, 1350 (Fed. Cir. 2015). “Structure” and “component” are classic nonce words—just like “mechanism,” “element,” or “device.” These terms are generic placeholders, standing in for any structure that can perform the recited function. “Component”—like “mechanism”—places no discernable limitations on the structure. *Mass. Inst. of Tech. & Elecs. for Imaging, Inc. v. Abacus Software (MIT)*, 462 F.3d 1344, 1354-56 (Fed. Cir. 2006); see *Manual of Patent Examining Procedure* § 2181 (9th ed., Mar. 2014) (“The following is a list of non-structural generic placeholders that may invoke ... 35 U.S.C. 112, paragraph 6: ‘mechanism for,’ ‘module for,’ ‘device for,’ ‘unit for,’ ‘*component* for,’ ‘element for,’ ‘member for,’ ‘apparatus for,’ ‘machine for,’ or ‘system for.’”) (emphasis added). For the reasons explained in the Petition, the term *pair of confinement structures* should be construed as a means-plus-function phrase limited to the disclosures of Figures 16-22 (and accompanying description) or their equivalents. Paper 2 at 10-12.

Similarly, the Board’s discussion of the term *fastening mechanism* confirms that the term is subject to § 112(f). The Board noted that “the root term ‘fasten’

conveys sufficient *generic structure*.” Paper 8 at 8 n.5 (emphasis added). But “fastening” is a functional term describing what a generic “mechanism” does. The noun in the phrase “fastening mechanism”—that is the word that describes the thing that does the fastening—is “mechanism.” The Federal Circuit explained in *Williamson* that “mechanism” typically does not “connote sufficiently definite structure and therefore may invoke § 112, para. 6.” *Williamson*, 792 F.3d at 1350 (internal quotations omitted); see *Media Rights Techs., Inc. v. Capital One Fin. Corp.*, 800 F.3d 1366, 1373 (Fed. Cir. 2015) (“[The Federal Circuit] ha[s] never found that the term ‘mechanism’—without more—connotes an identifiable structure; certainly, merely adding the modifier ‘compliance’ to that term would not do so either.”); *MIT*, 462 F.3d at 1354 (“The term ‘mechanism’ standing alone connotes no more structure than the terms ‘means.’”); *Aspex Eyewear, Inc. v. Altair Eyeware, Inc.*, 288 F. App’x 697, 703-04 (Fed. Cir. 2008) (affirming determination that “retaining mechanisms” was a means-plus-function term). In fact, the Board’s finding that “fastening mechanism” conveys “generic structure” compels a § 112(f) construction because patent claims must claim specific structures, not generic ones. Paper 8 at 8 n.5.

For the remaining three terms—*structural bridge*, *conduit*, and *communication link*—the parties have a legal dispute over the scope of these terms

that should be resolved as part of claim construction. For instance, based on the intrinsic record, Nintendo has explained that a “structural bridge” must be separate from, and external to, the computing device, and that components inside of the computing device cannot be a “structural bridge.” Gamevice, by contrast, contends there are no limits on the location of the structural bridge relative to the computing device.

For the reasons set forth in the Petition, Nintendo’s proposed claim constructions should be adopted.

B. Nintendo applied its proposed constructions

Unlike Gamevice, Nintendo’s Petition applies the same constructions it advocated for in the corresponding District Court and ITC cases, which Nintendo submits are the only legally proper constructions. There is no merit to Gamevice’s argument that Nintendo did not apply its own constructions.

For *confinement structures*, Nintendo’s proposed means-plus-function construction noted that the function would be “confining the computing device on at least two opposing sides of the plurality of sides of the computing device.” Paper 2 at 11. Nintendo explained that the corresponding structure should be limited to the “disclosures of Figures 16-22 (and accompanying description) or their equivalents” which Nintendo said included “a device cradle.” *Id.* at 12.

In Grounds 1 and 2, Nintendo identified the structure that performs the claimed function. For example, the Petition explicitly identified “the sides of the adaptor 210” in Willner as meeting the confinement structures limitation. *Id.* at 28. Gamevice’s Response concedes that this structure was identified but argues that the Petition failed to explain how that structure satisfies the limitation under Nintendo’s proposed construction. Paper 10 at 28-29. But this is demonstrably false. Immediately after identifying this structure—in the same paragraph—the Petition provides several quotes from Willner describing how the sides of the adaptor 210 are “adjacent to and confining the computing device on at least two opposing sides” as required by Nintendo’s construction. *See, e.g.*, Paper 2 at 28 (“Adapter 210 is provided with an opening 212 *into which* the computing device is received.”) (emphasis in original); *id.* (“a mounting adapter having an opening for receiving a computing device therein”). And the Kitchen Declaration further explained how they evidence the structure and function required by Nintendo’s construction: “adaptor 210 is comprised of confinement structures in the form of sidewalls, which are adjacent to the computing device, establishing the opening 212. As shown, these highlighted sidewalls confine the computing device 10 on at least two opposing sides of the plurality of sides of the computing device.” Kitchen ¶ 485.

For Ground 2, Gamevice again complains that the Petition fails to explain how the structure identified by Nintendo performs the required function. Paper 10 at 33-34. But Gamevice acknowledges that the Petition clearly discloses what Nintendo contends meets this limitation under its proposed construction—Kessler’s “side walls.” *See id.* at 33 (“Kessler’s side walls 12a, 14a ... are the claimed ‘confinement structures....’”). The record also shows that Nintendo described how these sidewalls perform the required function: “Kessler discloses structures which are adjacent to and confine the computing device 70 on at least two opposing sides, in the form of the opposing end faces (side walls) 12a and 14a of the handle housings 12 and 14, which include the input devices.” Kitchen ¶ 622. Again, Nintendo explained how these sidewalls are “adjacent to and confine the computing device ... on at least two opposing sides”—the function required by Nintendo’s construction. Paper 2 at 48-49.

Similarly, the Petition very clearly identifies what Nintendo contends meets the *fastening mechanism* limitation. For example, for Ground 1, the Petition has a paragraph that explains how “the combination [of Willner and Park] would contain a *fastening mechanism* that *secures the pair of confinement structures one to the other* as properly construed.” *Id.* at 34 (emphasis in original). The paragraph then identifies the structure: “Park in particular taught that its bridge had two panels that

were connected via the use of recessed guide grooves 32a and a plurality of recessed catching holes 32b....” *Id.* The Petition notes that this structure is “equivalent to the structure disclosed in the ’119 patent under the proper construction of *fastening mechanism*.” *Id.* (emphasis in original). And finally, the paragraph explains how this structure meets the required function: “Park’s fastening mechanism, which facilitated the expansion and contraction of the distance between the controllers’ inner side walls, *cooperat[ed] with the pair of confinement structures and secure[d]* them one to the other....” *Id.* (emphasis in original). And once again, beyond the Petition itself, this was further elaborated on in the Kitchen Declaration. Kitchen ¶¶ 526-35. The same level of clarity and explanation was provided for Ground 2. Paper 2 at 54-55.

Because Nintendo applied its proposed constructions, the cases cited by Gamevice are not applicable. For example, unlike the petitioner in *ZTE Corp. v. Maxwell, Ltd.*, IPR2018-00238, Paper 8 at 8 (June 1, 2018), Nintendo demonstrated how each claim term, as construed by Nintendo, is present. Further, unlike *Hologic, Inc. v. Enzo Life Scis., Inc.*, IPR2018-00019, Paper 17 at 6-7 (Apr. 18, 2018), Nintendo did not propose one construction, but then apply a different one as part of its analysis. Finally, Nintendo has not argued implied claim constructions or contradicted the positions that it took in related litigations like in *Infinera Corp.*

v. Core Optical Techs., LLC, IPR2018-01259, Paper 9 at 11-13 (Jan. 14, 2019).

Instead, as explained above, Nintendo advanced the same claim-construction positions in each proceeding. The case law cited by Gamevice, therefore, is inapplicable.

Gamevice falsely accuses Nintendo of not applying its constructions to draw the Board's attention from the fact that Gamevice has refused to offer any express claim constructions of its own. Gamevice's gambit is explained by its broad infringement positions in the co-pending litigations. Those broad positions are inconsistent with Gamevice's far narrower positions here. Gamevice's inconsistent positions are particularly inappropriate in this forum given that Gamevice's litigation constructions are governed by the *Phillips* standard, whereas this Petition is still governed by the broadest reasonable interpretation standard because it was filed before the recent PTAB claim construction rule change. See 83 FED. REG. 51340 (Oct. 11, 2018).

C. Gamevice has waived its right to make claim construction arguments

The Board's Scheduling Order states that “[t]he patent owner is cautioned that any arguments for patentability not raised and fully briefed in its response will be deemed waived.” Paper 9 at 5 (emphasis in original). In its Institution Decision, the Board explicitly noted that Gamevice “disputes Nintendo’s proposed

constructions but neither offers its own constructions nor explains why Nintendo's proposed constructions are incorrect." Paper 8 at 5. Gamevice's Response is no different. In a single paragraph, Gamevice summarily asserts that all terms should be given their broadest reasonable interpretation in light of the specification, without any explanation, and then purportedly "reserves the right to offer its own express construction to these terms, as appropriate." Paper 10 at 18. This is not enough for Gamevice to reserve any such right, especially given the Board's fair warning. Because Gamevice failed to proffer its own constructions and failed to make any substantive arguments against Nintendo's proposed constructions, Gamevice has waived the right to make arguments regarding the proper construction of any term at trial. *See Teradata Operations, Inc. v. Realtime Data LLC*, IPR2017-00557, 2018 WL 3155819, at *5 (June 25, 2018); *Apple Inc. v. Valencell, Inc.*, IPR2017-00321, 2018 WL 2734878, at *4 (June 5, 2018).

III. NINTENDO'S EXPERT DECLARATION PROPERLY ELABORATES ON THE ARGUMENTS IN THE PETITION

As noted above, Gamevice did not provide an expert declaration to support any of its positions. Instead, Gamevice argues that the Kitchen Declaration should be disregarded because it is too thorough and allegedly includes arguments not

contained within the Petition itself. See Paper 10 at 44-46.¹ But the Kitchen Declaration does not contain new arguments that are not within the Petition. Rather, the Kitchen Declaration appropriately elaborates further on the arguments in the Petition.

As the Board has explained, “it can be helpful when an expert provides additional detail and explanation beyond the Petition.” *Aristocrat Techs., Inc. v. High 5 Games, LLC*, IPR2018-00529, 2018 WL 3637131, at *12 (July 30, 2018). The Board has further explained that “there is no requirement that the expert’s testimony be coextensive to the statements in the Petition.” *Id.* Conversely, expert declarations have been stricken or disregarded when they do nothing more than parrot the contents of a petition. *Phishme, Inc. v. Phishline, LLC*, IPR2015-01356, Paper 7 at 28 n.3 (Nov. 19, 2015); *LG Elecs., Inc. v. Advanced Micro Devices, Inc.*, IPR2015-00323, Paper 13 at 8 n.2 (June 17, 2015). Thus, the additional explanation and detail provided by the Kitchen Declaration is entirely proper.

¹ Gamevice complains that the Kitchen Declaration is 421 pages long. The length of the Kitchen Declaration is not surprising considering it is a combined declaration for two petitions (IPR2018-01521 and IPR2018-01522), which collectively challenge 19 claims across six grounds.

IV. GAMEVICE’S UNSUPPORTED ATTORNEY ARGUMENT REGARDING THE KNOWLEDGE OF A POSITA SHOULD BE DISREGARDED

Despite regularly commenting on what a POSITA allegedly would or would not know, Gamevice chose not to provide any expert testimony (or any other type of actual evidence) in support of its positions. *See, e.g.*, Paper 10 at 60-61 (“Petitioner also ignores undeniable challenges that a POSITA would face attempting to reengineer and reroute the complex flexible, flat, multi-wire electrical connector....”). The Board should ignore Gamevice’s unsupported attorney argument. *See VMAC Global Techs., Inc. v. Vanair Mfg., Inc.*, IPR2018-00670, 2018 WL 3872872, at *13 (Aug. 10, 2018) (finding unsupported attorney argument insufficient regarding questions of obviousness). Instead, the Board should rely on the unrebutted expert testimony provided by Nintendo regarding the knowledge of a POSITA. *See Arris Int’l PLC v. Sony Corp.*, IPR2016-00835, Paper 39 at 30-32, 41 (Sept. 25, 2017).

V. THE CHALLENGED CLAIMS ARE UNPATENTABLE

Regarding Grounds 1 and 2, Gamevice’s Response repeats the same arguments from its Preliminary Response that the Board’s Institution Decision already rejected.

A. Ground 1: Willner and Park

1. Confinement structures

Contrary to Gamevice's assertion (Paper 10 at 28-30), the Petition properly applies Nintendo's proposed means-plus-function construction. The Petition discusses how Willner's adaptor is comprised of confinement structures in the form of sidewalls (i.e., structure), which confine the computing device on at least two opposing sides (i.e., function) to receive and secure the computing device (i.e., result). Ex. 1014 ¶¶ 0013, 0050, 0052; Paper 2 at 28; Kitchen ¶ 485. The walls of the adaptor in Willner receive and mount the computing device into the opening 212. Ex. 1014 ¶¶ 0050, 0052; Paper 2 at 28; Kitchen ¶ 485.

Gamevice argues that Willner's adaptor does not perform an identical function to the pair of confinement structures because its sidewalls do not expand and contract to facilitate placement of the computing device. Paper 10 at 31-33. To make its argument, Gamevice improperly focuses *solely* on Willner instead of Nintendo's claimed *combination* of Willner and Park. *See Samsung Elecs. Am. Inc. v. Uniloc 2017 LLC*, IPR2017-01802, 2019 WL 413642, at *13 (Jan. 31, 2019) (“[T]he test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.”). As Nintendo explained, the sidewalls of the adaptor in Willner would expand and contract when combined with the fastening mechanism of Park. Paper 2 at 34-35; Kitchen ¶¶ 526-35. Further, claim 1 of the

'119 patent only claims the function of “confining the computing device on at least two opposing sides of the plurality of sides of the computing device.” Ex. 1001 at 10:4-6.

Gamevice continues to improperly focus solely on Willner to argue that Willner’s sidewalls are part of a single unitary structure and not a distinct pair of structures. Paper 10 at 48; *Samsung*, 2019 WL 413642, at *12. The Board has already rejected this argument. Paper 8 at 6; Ex. 1014 at Fig. 4. And Nintendo demonstrated that the sidewalls of Willner’s adaptor meet this limitation in combination with Park. Paper 2 at 34-35; Kitchen ¶¶ 526-35.

Finally, Gamevice argues that the sidewalls of Willner’s adaptor do not function to confine the computing device. Paper 10 at 49-50. This argument was also rejected by the Board, which noted that claim 1 does not require that the confinement structures “touch” the computing device. Paper 8 at 6-7. Further, Gamevice ignores the express teachings of Willner, which states that the computing device is received into opening 212 of adaptor 210. *Id.* at 7; Ex. 1014 ¶ 0050. And considering connector 226, the Petition explained that a POSITA understood that a computing device must be secured to avoid rotational flexing of the device during use. Paper 8 at 6-7; Kitchen ¶¶ 485, 531-35. Gamevice ignores that Willner’s connector is not necessary because a wireless connection is possible. Ex. 1014

¶ 0050. Gamevice's argument also ignores the '119 patent's disclosure of a connector provided by its confinement structure, which a POSITA would have understood contributes to anchoring the computing device, as Willner's connector does. Ex. 1001 at 8:58-60, Figs. 18-19; Kitchen ¶ 485. Thus, as explained in the Petition, the combination of Willner and Park teaches a pair of confinement structures.

2. Fastening mechanism

Gamevice incorrectly argues that Nintendo did not apply its construction of fastening mechanism. Paper 10 at 37-39. The Petition describes how Park's two panels, connected via recessed grooves and a plurality of catching holes (i.e., structure), would secure the sidewalls of Willner to facilitate expansion and contraction of the distance between them (i.e., function) to allow the mechanism to work with smart devices of varying types (i.e., result). Paper 2 at 34-35; Kitchen ¶¶ 526-35.

Gamevice contends that Park's fastening mechanism is not structurally similar to the '119 patent's soft draw latch because the soft draw latch operated to effectuate a slip fit. Paper 10 at 39-41. Gamevice, however, ignores Park's disclosure that the second panel is inserted into the grooves of the first so that it can move by sliding. Ex. 1004 ¶ 0039. It is only when the desired length is reached that the protrusions catch the catching holes. *Id.*; Paper 2 at 34-35; Kitchen ¶¶ 528-

31. And the Board confirmed that the fastening mechanism in Park is structurally similar to the fastening mechanism of the '119 patent. Paper 8 at 8. As Nintendo explained, the fastening mechanism in Park is structurally similar because it moves in place by sliding until the desired length is reached and it would cooperate with the sidewalls of Willner's adaptor to confine them as the protrusions of the male part fit into the grooves of the female. Paper 2 at 34-35; Kitchen ¶¶ 526-35. Indeed, it is surprising that Gamevice disputes that Park's fastening mechanism is equivalent given that Gamevice accuses a simple screw (which is very different from the disclosed fastening mechanism) as allegedly meeting this limitation in the co-pending litigations. See Ex. 1009 at 11.

Finally, Gamevice argues, without support, that a POSITA would not be motivated to combine the fastening mechanism of Park with the adaptor's sidewalls of Willner. Paper 10 at 50-53. However, the Board already properly credited Nintendo's expert testimony that a POSITA would be motivated to combine the teachings of Park and Willner. Paper 8 at 8.

As with Willner, Gamevice does not address Nintendo's proposed *combination*, but instead attacks Park individually. Paper 10 at 51-53. As the Petition explained, it would have been obvious for a POSITA to take Willner's adaptor's sidewalls and modify them to incorporate Park's fastening mechanism,

which would secure the sidewalls together and facilitate contraction or expansion of the sides to accommodate smart devices of varying sizes. Paper 2 at 34-35; Kitchen ¶¶ 526-35. And Gamevice concedes that Park's fastening mechanism secures the structural bridge. Paper 10 at 51. Because Park's structural bridge secured the pair of confinement structures, a POSITA would have understood that Park's fastening mechanism also secures the confinement structures. Paper 8 at 8; Paper 2 at 34-45; Kitchen ¶¶ 526-35.

3. Structural bridge

Gamevice once again advances only attorney argument to assert that a POSITA would not be motivated to modify Willner's adaptor to include Park's electrical connection means. Paper 10 at 53-55. As Nintendo explained in detail, however, Willner's structural bridge would be improved by Park to be adjustable so that it could accommodate different sized smart devices. Paper 2 at 33-34; Kitchen ¶¶ 502-10. Because both Willner and Park taught that their respective structural bridges contained a wired electrical connection and accommodated devices of varying sizes, it would have been obvious to a POSITA that Willner's structural bridge, either alone or modified by Park, would include a space through which the electrical connection means would run. Paper 8 at 9-10; Paper 2 at 33-34; Kitchen ¶¶ 511-25.

The Kitchen Declaration further explains that a POSITA would recognize that electronic toy products are engineered for endurance and a conduit would be necessary to protect the integrity of a wire running through an adjustable bridge. Paper 8 at 10; Paper 2 at 33-34; Kitchen ¶¶ 516-25. The Board was persuaded by the Petition and Kitchen Declaration in finding that a POSITA would be motivated to combine Park and Willner’s teachings to disclose the claimed conduit. Paper 8 at 10. Gamevice’s attorney argument is not enough to overcome Nintendo’s credible expert testimony regarding the motivation of a POSITA.

Thus, as explained above, and in the Petition, the combination of Willner and Park renders claim 1 obvious.

B. Ground 2: Kessler and Hirschman

1. Confinement structures

Contrary to Gamevice’s assertion, the Petition applies Nintendo’s proposed means-plus-function construction of confinement structures. Paper 10 at 33-34. The Petition describes how the confinement structures are taught by the walls disclosed in Kessler (i.e., structure), which are interconnected but define a space for receiving and confining the computing device (i.e., function) to hold the computing device in place (i.e., result). Paper 2 at 48-49; Kitchen ¶¶ 624-30.

Gamevice counters that Kessler’s sidewalls are not identical in structure because the confinement structures of the ’119 patent have a “u-shaped” region that

wraps around the device whereas Kessler's sidewalls are flat. Paper 10 at 35-37. Nintendo explained, however, that the structure of the sidewalls in Kessler is substantially similar to the confinement structures in the '119 patent, which does not claim that the confinement structures wrap around and extend behind the computing device. Ex. 1001 at 10:4-6; Paper 2 at 48-49; Kitchen ¶¶ 622-30. Instead, the '119 patent discloses that holding the device on three sides keeps the device in place. Ex. 1001 at 3:61-4:3.

Gamevice also argues that the alleged difference in structure causes Kessler's sidewalls to perform a different function in a different way than the pair of confinement structures. Paper 10 at 36-37. As Nintendo explained, Kessler's teachings confirm that its sidewalls confine the computing device as construed by the Board (Paper 8 at 5) because the handle housings with sidewalls 12a and 14a provide a sufficient gripping force for confining the computing device so that it remains stable while the device is in use. Paper 8 at 12; Ex. 1005 ¶¶ 40, 101; Paper 2 at 48-49; Kitchen ¶¶ 619-20.

2. Fastening mechanism that cooperates with confinement structures

Once again, Gamevice submits only attorney argument to assert that a POSITA would not have found it obvious to add a fastening mechanism to secure a pair of confinement structures. Paper 10 at 64-66. Contrary to Gamevice's

argument, the Petition does not state that Park is expressly included in the combination of Ground 2. Instead, the Petition explained that a POSITA would have found it obvious to include a fastening mechanism, similar to the fastening mechanism in Park (included as a state-of-the-art reference regarding the knowledge of a POSITA), to secure Kessler's sidewalls. Paper 8 at 12 (finding that Hirschman is cumulative of Park in that both references teach a fastening mechanism); Paper 2 at 54; Kitchen ¶¶ 666-73.

Nintendo's un rebutted expert testimony explained that a POSITA would have found it obvious to include a fastening mechanism such as a latch to secure the pair of confinement structures because there were a limited number of structures that could be used to fasten two components together, where the selection of one over the other is not novel. Kitchen ¶ 670. Gamevice does not dispute this point (via attorney argument or otherwise). Paper 10 at 64-67.

Finally, the Petition also explained how Kessler's tongue and groove mechanism would meet the limitation under a broader construction as suggested by the Board. Paper 2 at 54; Kitchen ¶¶ 667-70.

3. Structural bridge

Gamevice asserts that a POSITA would not modify Kessler's design to include the detachable controllers taught in Hirschman. Paper 10 at 56-64. In particular, Gamevice asserts that the controllers of Kessler could not be detached

as taught in Hirschman because the extension mechanism in Kessler collapses into the housings 12 and 14. *Id.* at 58. Once again, however, Gamevice improperly focuses solely on Kessler, rather than the actual *combination* of references presented by Nintendo. *Samsung*, 2019 WL 413642, at *12. And contrary to Gamevice's argument, the test for obviousness does not require a showing that the features of a secondary reference are bodily incorporated into the structure of the primary reference. See *HTC Corp. v. Koninklijke Philips N.V.*, IPR2017-00857, Paper 33 at 32 (Aug. 24, 2018) (citing *In re Keller*, 642 F.2d 413, 425 (CCPA 1981)).

Nintendo thoroughly explained how a POSITA would have understood the combined teachings of Kessler and Hirschman. For example, given Hirschman's emphasis on the importance of sidewalls to allow for removable controllers and Kessler's emphasis on the importance of sidewalls to confine the computing device, a POSITA would have incorporated Kessler's side housings and bridge with Hirschman's detachable controllers. Paper 2 at 51-53; Kitchen ¶¶ 624-25, 649-53. A POSITA would also recognize that the combined system would use Kessler's sidewalls to maintain confinement of the computing device if a user wanted to replace the controllers, and the removable controllers taught by Hirschman similarly used sidewalls to effectuate a secure connection of the

controllers to the confinement structures. Kitchen ¶¶ 624-25, 649-53. Adding functionality to make the controllers removable does not take away from the importance of Kessler's sidewalls in confining the computing device. Paper 2 at 51-53; Kitchen ¶¶ 624-25, 649-53. Given the desire to confine the computing device and detach controllers but still allow them to function with the computing device, a POSITA would have recognized and applied the obvious solution of creating a physical and electronic interfacing structure between the computing device and removable controllers. Paper 2 at 48-53; Kitchen ¶¶ 624-53. Thus, a POSITA would have been motivated to use Kessler's sidewalls 12a and 14a in the combination.

Gamevice asserts (once again without expert support) that a POSITA would not have been able to accomplish the combination. Paper 10 at 58-61. As the Kitchen Declaration explained, however, a POSITA would have understood that modifications to the controllers would be made to account for Kessler's expanding bridge. Kitchen ¶ 628. Further, a POSITA would have been motivated to combine the teachings of Kessler and Hirschman because the combination would allow for the resulting structure to have many control devices and fit a variety of computing devices available at the time, thus increasing player satisfaction. Paper 2 at 51-53; Kitchen ¶¶ 624-30; 649-53. As Mr. Kitchen explained, there were several portable

computing devices that became popular for gamers but that contained touch screens that did not meet some gamers' preference for physical controls. Kitchen ¶¶ 60-62. Devices like those taught in Hirschman allowed for multiple controllers of varying types, while devices as taught in Kessler disclosed an expanding mechanism allowing controllers to adapt to devices of different sizes. *Id.* ¶¶ 64, 67-71. Thus, contrary to Gamevice's attorney argument, the modifications to Kessler are not impermissible hindsight. Paper 10 at 61-64.

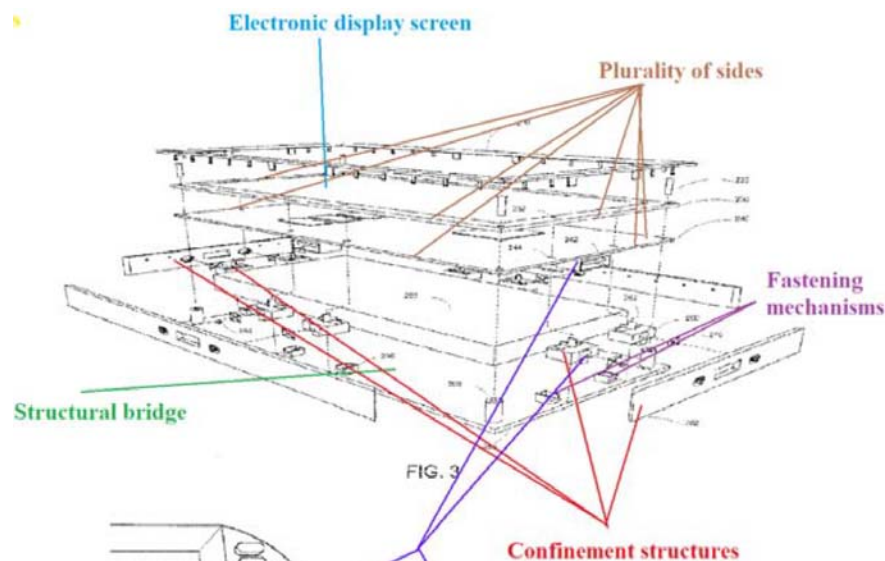
For the reasons explained above, and in the Petition, the combination of Kessler and Hirschman renders claim 1 obvious.

C. Ground 3: Hirschman

Nintendo brought Ground 3 only against claim 1 of the '119 patent based on Gamevice's constructions in the co-pending litigations. As the Petition makes clear, Gamevice's litigation constructions are incorrect. And as the Board correctly noted in its Institution Decision in IPR2018-01521, "a petitioner should not be forced into the untenable position of having to choose—as *its own*—a patentee's constructions from the district court action (which may not necessarily be favorable to its non-infringement positions) in order to present unpatentability arguments in this administrative proceeding." IPR2018-01521, Paper 7 at 7 n.5 (emphasis in original). To the extent Gamevice's broad litigation constructions are deemed appropriate here, claim 1 is obvious in view of Hirschman. Paper 2 at 64-70.

1. Nintendo did not double count elements

Gamevice's argument that Nintendo double-counted elements ignores Gamevice's positions in the co-pending litigations. Paper 10 at 67-70. In litigation, Gamevice asserts that the "computing device" is only the "electronic equipment controlled by the CPU" and does not include the housing of the device. Therefore, under Gamevice's litigation construction, the back of the computing device would be the back of the "electronic equipment controlled by the CPU" in Hirschman. Paper 2 at 66-67. This can be seen in an annotated version of Hirschman's Figure 3 below, which has brown-colored lines pointing only to the "sides" of the electronic display (blue) and circuit board—the "electronic components controlled by the CPU." These lines do not point to the sides of the housing because Gamevice's litigation position is that the housing is not part of the computing device.



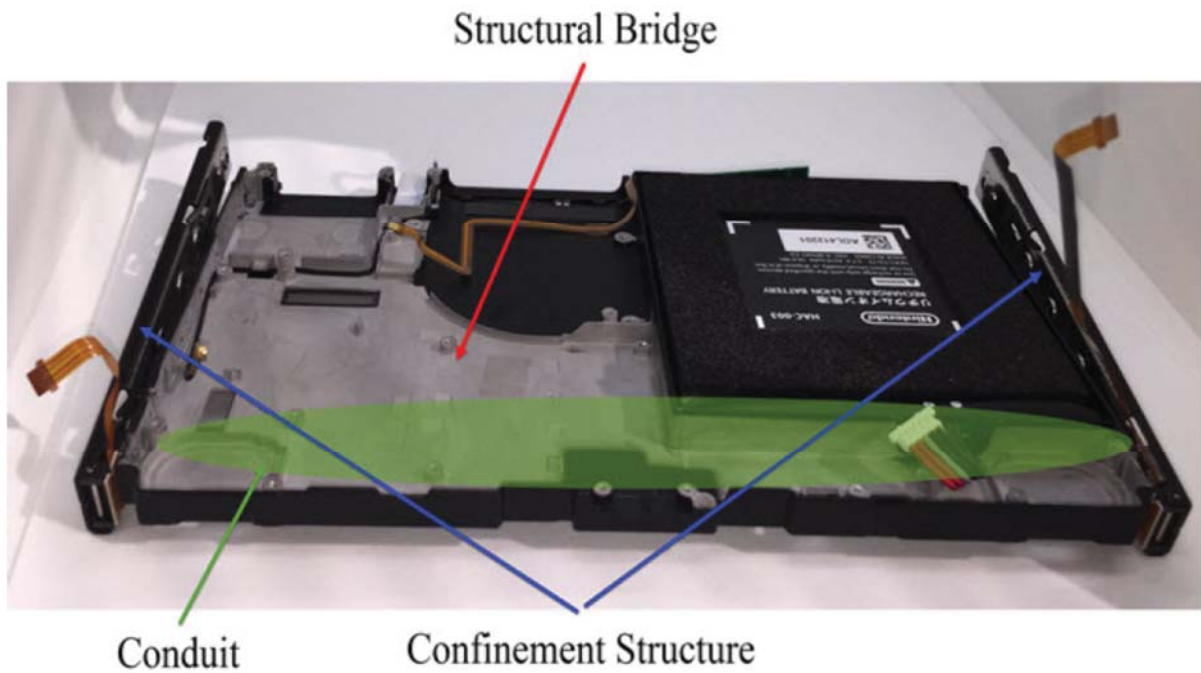
Id. at 66. Furthermore, this figure also points (in green) to a component that is part of the housing and not part of the “electronic equipment controlled by the CPU” for the *structural bridge*.

2. Confinement structures

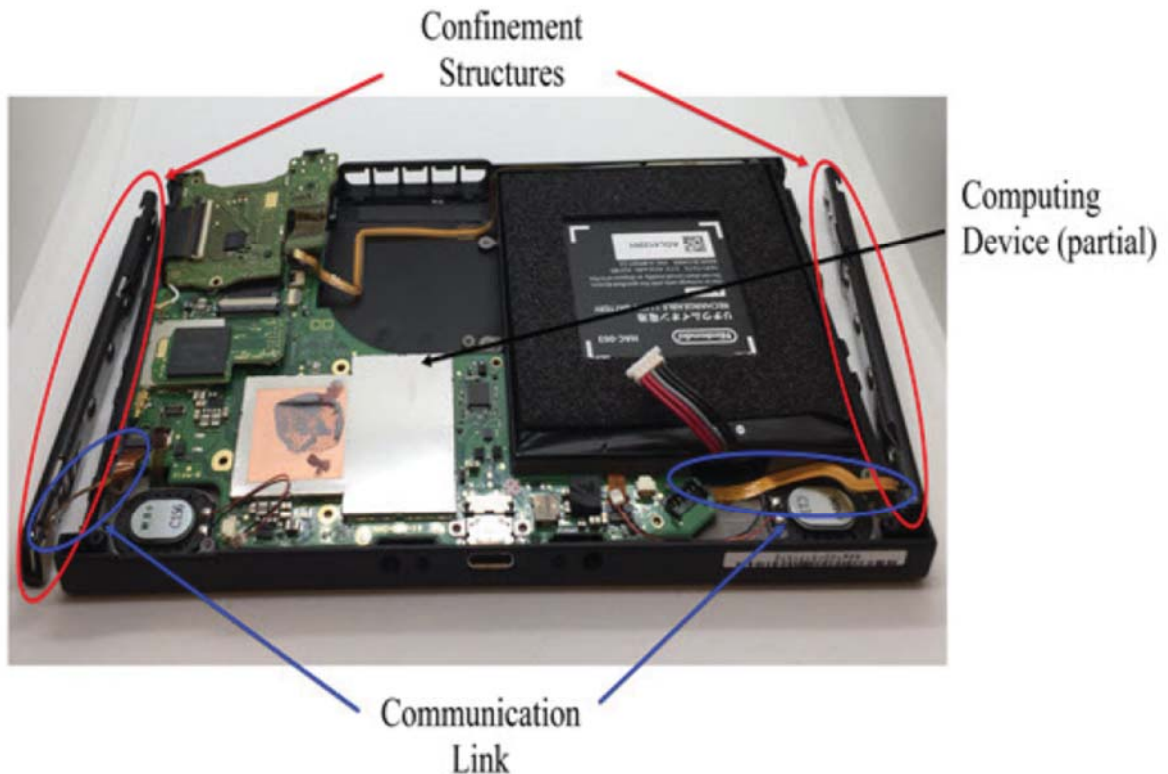
As discussed above, the Petition explained that based on Gamevice’s litigation constructions the “plurality of sides” (as shown in brown above) are disclosed by the sides of the electronic display screen and processor. As shown in red above, the sidewalls disclose *confinement structures* that are separate and distinct from the sides of the computing device under Gamevice’s constructions.

3. Conduit

In the co-pending litigations, Gamevice contends that the *conduit* is the area in the Nintendo Switch highlighted in green in the image below from Gamevice’s complaint. Ex. 1009 at 11.



In the picture above, most of the internal components of the Switch have been removed. The picture below still has many components removed but nonetheless shows that the alleged *conduit* in the Switch, when assembled, includes components like the speakers, wires, circuit boards, etc. *Id.* at 7.



Yet here, Gamevice tells the Board that the identified conduit in Hirschman cannot be a “conduit” because it does not have any “appreciable space ... because Hirschman’s battery 250 occupies this space.” Paper 10 at 70. As shown in Figure 3 of Hirschman and described in the Petition, there is space around the battery, even when assembled. Regardless, under Gamevice’s litigation constructions, the presence of components in the conduit does not matter.

For the reasons explained above, and in the Petition, Hirschman renders claim 1 obvious under Gamevice’s litigation constructions.

VI. GAMEVICE HAS WAIVED ANY ARGUMENTS REGARDING THE DEPENDENT CLAIMS

The Institution Decision stated that “[o]n its face, Nintendo’s analysis of the dependent claims has merit,” but the Board noted that it did not need to address the dependent claims unless Gamevice addressed them. Paper 8 at 11. Despite the Board’s warning, Gamevice’s Response did not address the dependent claims. As a result, Gamevice is now limited to its arguments based on the independent claim, and it has waived any other arguments as to the limitations of the dependent claims. *See e.g., inContact, Inc. v. Microlog Corp.*, IPR2015-00560, Paper 21 at 44-45 (July 28, 2015).

VII. CONCLUSION

Nintendo respectfully asks the Board to cancel claims 1-10 and 13-21 of the ’119 patent.

Dated: September 12, 2019

Respectfully submitted,

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CERTIFICATION OF WORD COUNT UNDER 37 CFR § 42.24(d)

Under the provisions of 37 C.F.R. § 42.24(d), the undersigned hereby certifies that the word count for the foregoing Petitioners' Reply to Patent Owner's Response totals 5,467 words, excluding the parts exempted by 37 C.F.R. § 42.24(c).

This word count was made by using the build-in word count function tool in the Microsoft Word software Version 2010 used to prepare the document.

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that true copies of the foregoing PETITIONERS' REPLY TO PATENT OWNER'S RESPONSE has been served this 12th day of September 2019, by electronic mail on the Patent Owner via its attorneys of record:

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