

Erik R. Puknys (SBN 190926)
erik.puknys@finnegan.com
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, LLP
3300 Hillview Avenue
Palo Alto, California 94304-1203
Telephone: (650) 849-6600
Facsimile: (650) 849-6666

Smith R. Brittingham IV (*pro hac vice*)
smith.brittingham@finnegan.com
Ji Hye Christina Yang (SBN 317039)
christina.yang@finnegan.com
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, LLP
901 New York Avenue, NW
Washington, DC 20001-4413
Telephone: (202) 408-4000
Facsimile: (202) 408-4400

Attorneys for Plaintiff Gamevice, Inc.

**UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN FRANCISCO DIVISION**

GAMEVICE, INC.,

Plaintiff,

v.

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

Defendants.

NINTENDO OF AMERICA INC.,

Counter-Claimant,

v.

GAMEVICE, INC.,

Counter-Defendant.

CASE NO. 3:18-cv-1942-RS

**GAMEVICE, INC.'S OPPOSITION TO
NINTENDO'S MOTION FOR
SUMMARY JUDGMENT OF
NONINFRINGEMENT**

Date: October 20, 2023
Time: 1:30 P.M.
Location: Courtroom 3, 17th Floor
Judge: Hon. Richard Seeborg

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1 **I. INTRODUCTION**

2 Nintendo's second motion for summary judgment, which asserts that its accused Switch
3 product does not infringe any of the remaining claims of Gamevice's '713 and '393 patents, should
4 be denied for two reasons.

5 First, rather than demonstrate that no genuine disputes of material fact exist, Nintendo's
6 motion does the opposite. Indeed, the motion is based almost entirely on the conflicting evidence
7 and expert opinions that Gamevice and Nintendo presented *at trial* in the prior ITC litigations
8 concerning their inherently *factual* dispute over whether the Switch meets various claim elements.
9 Nintendo argues that because the ITC resolved the battle of the experts in Nintendo's favor, this
10 Court must now do the same. But Nintendo's reliance on the ITC's rulings is misplaced. Gamevice
11 can, will, and previously did present expert opinion that contradicts Nintendo's non-infringement
12 evidence. A reasonable fact-finder could accept Gamevice's evidence over Nintendo's. Indeed, that
13 is why the 1197 ITC case required a trial, and neither ITC case ended on a summary judgment of
14 non-infringement on the issues Nintendo presents in its motion. So even if the ALJ decided in
15 Nintendo's favor on some of these issues after a full trial in the ITC, the jury in this case could see
16 things differently and resolve the same factual disputes in Gamevice's favor. But whatever the jury
17 will decide after hearing both parties' experts is beside the point. In evaluating this summary
18 judgment motion, this Court must construe the evidence in the light most favorable to Gamevice and
19 draw all justifiable inferences in its favor. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248
20 (1986). Nintendo's motion asks the Court to, instead, weigh the expected evidence now and pick
21 Nintendo as the winner, which is improper at the summary judgment stage.

22 Second, Nintendo should not even be permitted to make these non-infringement arguments.
23 As detailed in Gamevice's motion for summary judgment of infringement, Dkt. 255, this Court has
24 already determined that the Nintendo Switch anticipates many of Gamevice's asserted patent claims.
25 That ruling, like any anticipation ruling, rests on the Court's determination that all elements of the
26 invalidated claims are present in the Switch, a ruling that was facilitated by Nintendo's concession
27 that the Switch satisfies all the elements of the asserted claims. Since the Court accepted Nintendo's
28 concession and found that the Switch anticipates many of the Gamevice patent claims, that ruling

precludes Nintendo from changing course and now arguing that the Switch does not embody the same claim elements that were essential to the anticipation ruling. Indeed, in this respect, Nintendo's non-infringement summary judgment motion and Gamevice's summary judgment motion of infringement are two sides of the same coin. The Court's anticipation ruling dictates the result on infringement with respect to the patent claims that were not proven to be invalid, so Gamevice's motion should be granted and Nintendo's should be denied.

II. LEGAL STANDARD

Summary judgment is proper only if Nintendo shows that there is no genuine dispute as to any material fact and it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(a). In evaluating Nintendo's summary judgment motion, this Court must construe the evidence in the light most favorable to Gamevice and draw all justifiable inferences in its favor. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986); *Interwoven, Inc. v. Vertical Computer Sys.*, Case No. CV 10-04645 RS, 2013 WL 3786633 at *3 (N.D. Cal. Feb. 3, 2014). "[C]ourts may not resolve genuine disputes of fact in favor of the party seeking summary judgment." *Tolan v. Cotton*, 572 U.S. 650, 656 (2014). "[A]t the summary judgment stage the judge's function is not himself to weigh the evidence and determine the truth of the matter but to determine whether there is a genuine issue for trial." *Anderson*, 477 U.S. at 249. "In short, what is required to defeat summary judgment is simply evidence 'such that a reasonable juror drawing all inferences in favor of the respondent could return a verdict in the respondent's favor.'" *Zetwick v. County of Yolo*, 850 F.3d 436, 441 (9th Cir. 2017), quoting *Reza v. Pearce*, 806 F.3d 497, 505 (9th Cir. 2015). Where parties in a patent infringement dispute present conflicting expert testimony in a "classic battle of the experts," summary judgment is inappropriate. *NetFuel, Inc. v. Cisco Systems, Inc.*, 438 F. Supp. 3d 1031, 1038-39 (N.D. Cal. 2020) ("Both experts have explained their analyses. Their disputes amount to a 'battle of the experts' over material facts, precluding summary judgment. See *Edwards Sys. Tech., Inc. v. Dig. Control Sys., Inc.*, 99 F. App'x 911, 921 (Fed. Cir. 2004).").

1 **III. ARGUMENT**

2 **A. Genuine issues of material fact exist and preclude summary judgment.**

3 On its face, Nintendo's motion shows that there are genuine issues of material fact that
 4 preclude summary judgment in Nintendo's favor. While Nintendo's motion spins the facts in its
 5 favor, it is premised on the contrasting expert opinions that both parties presented and that,
 6 ultimately, had to be resolved after trial, not in a pre-trial summary determination motion.¹ In fact,
 7 Nintendo did not even seek summary determination in the ITC on any of the limitations it now
 8 discusses in its motion. The conflicting evidence from the ITC cases, which Gamevice has
 9 supplemented with the attached declaration of one of its experts, Dr. Singhose, precludes summary
 10 judgment here, particularly where the Court must construe the facts in the light most favorable to
 11 Gamevice.

12 **1. Gamevice is not limited to the exact evidence and testimony**
 13 **presented at trial in the ITC.**

14 At the outset, Nintendo overstates the importance of the ITC record and the ALJ's
 15 conclusions. The gist of Nintendo's motion is that (a) Gamevice must present the same evidence,
 16 including the same testimony, in this case as it did in the prior ITC case, and (b) since the ITC found
 17 non-infringement on this evidence, no reasonable jury could find in Gamevice's favor. But both of
 18 those statements are incorrect. Gamevice is not obligated to present its infringement case at trial the
 19 same way it did in the ITC. It is required only to be consistent with the contentions as set forth in its
 20 ITC expert reports (which are proxies for initial infringement contentions in this case) or any
 21 supplement to those contentions justified by developments since those expert reports were first
 22 served in 2018 and 2020. And a reasonable fact-finder could reject Nintendo's positions and accept
 23 Gamevice's, notwithstanding the ITC's prior post-trial rulings.

24
 25
 26 ¹ The 1111 ITC Investigation was scheduled for trial on January 7, 2019, and the parties had
 27 exchanged written witness statements that would presumably have been admitted into the record as
 28 direct witness testimony and then been subject to cross-examination if the case had actually gone to
 trial. The ALJ's Markman decision was issued on December 7, 2018, however, and that ultimately
 led to an agreed summary determination of no violation so that the trial never occurred. The 1197
 ITC Investigation did go to trial.,

1 Nintendo incorrectly says “Gamevice’s infringement allegations are set by its positions
 2 before the ITC. The parties agreed that their contentions in the ITC, ***described in expert-witness***
 3 ***reports and testimony before the ITC***, would constitute their infringement and invalidity contentions
 4 for purposes of this case.” Nintendo Mot. at 7 (emphasis added). That is an overstatement. With
 5 respect to the infringement contentions, the parties agreed only that “the infringement contentions set
 6 forth in Gamevice’s ***expert reports*** submitted during the ITC cases will be treated as initial
 7 infringement contentions under L. Pat. R. 3-1.” Dkt. 219 at 2 (emphasis added). Nintendo’s
 8 extension of that agreement to also incorporate trial testimony is incorrect. Further, the infringement
 9 contention disclosure required to satisfy Patent Local Rule 3-1 is an identification of the asserted
 10 claims, which Nintendo knows, the accused product, which Nintendo knows, and “[a] chart
 11 identifying specifically where and how each limitation of each asserted claim is found with each
 12 ‘Accused Instrumentality,’” Patent L.R. 3-1(a)-(c). Gamevice’s expert reports satisfy that last
 13 requirement, since they identify “where and how” the contested limitations (“passageway,”
 14 “confinement structure,” “apertures,” and “computing device”) are found in the Switch. The
 15 additional detail that Nintendo points to from the trial record represents only one way to present
 16 Gamevice’s infringement evidence consistent with those initial infringement contentions as
 17 disclosed in the ITC expert reports.

18 The parties also agreed that “[t]o the extent there are developments in this case, such as claim
 19 construction positions raised by either party or adopted by the Court that were not contemplated
 20 when the infringement and validity contentions, expert reports, or declarations were exchanged in
 21 the ITC cases, either party may seek to amend or supplement those disclosures to account for those
 22 developments.” Dkt. 219 at 2; *see also* Patent L.R. 3-6. Consistent with that agreement and Patent
 23 Local Rules 3-1 and 3-6, Gamevice can craft its trial presentation without having to repeat its ITC
 24 trial testimony and presentation. It can rely on new or different evidence as long as it is within the
 25 scope of Gamevice’s ITC expert reports or any amendment or supplement to those disclosures to
 26 account for developments in this case. In this case, developments that would justify supplemental
 27 contentions include the Court’s adoption of claim constructions that differ from what the parties
 28 thought were in place or agreed to during the ITC proceedings, the fact that some patent claims have

1 been found invalid and will not be discussed at trial, Nintendo's own admissions during the course
 2 of the litigations, and the introduction of additional versions of the Switch.² Indeed, in the ITC cases
 3 at the time the infringement expert reports were served, none of the claim terms had been formally
 4 construed by either the ITC or this Court.³ So, the ITC expert reports, much like early initial
 5 contentions in a district court case, were addressing some undeveloped issues.

6 Nintendo also fixates on trial testimony from the 1197 ITC Investigation without noting that
 7 the 1197 ITC trial addressed only the '393 patent, not the '713 patent, where the bulk of the
 8 remaining patent claims in this case reside. And most of the testimony Nintendo points to addressed
 9 claim 1 of the '393 patent, which was found invalid in this case and will not be at issue a trial, rather
 10 than claim 6, which is the only '393 patent claim at issue here. So, for example, when Nintendo is
 11 discussing trial testimony about the "computing device," that was testimony about claim 1, where
 12 the computing device did not need to have a screen or a back. In contrast, this case will only involve
 13 patent claims that include both a screen and a back, elements that even Nintendo admits are
 14 integrated with the rest of the Switch console. Indeed, Mr. Stubben's opinions on "computing
 15 device" in the 1111 ITC Investigation differed from the 1197 ITC trial since all the claims in the
 16 '713 patent required at least a screen, and many required both a screen and a back. Since the
 17 unadorned "computing device" of claim 1 of the '393 patent is no longer at issue, that testimony will
 18 not be needed.

19 Finally, Nintendo frequently mentions that the ITC found non-infringement in the 1197 ITC
 20 Investigation, which Nintendo improperly trumpets as establishing that no reasonable jury could find
 21 in Gamevice's favor. For example, Nintendo argues that "based on the same evidence that is before
 22 the Court now, the ITC agreed that Gamevice had not demonstrated the existence of a 'passageway.'

23 _____
 24 ² If the Court grants Gamevice's motion for summary judgment of infringement, then the
 25 details of how the claim language reads on the accused Switch would be irrelevant. If, however, the
 26 Court denies Gamevice's motion and also denies Nintendo's motion, Gamevice will seek leave to
 27 serve amended infringement contentions to address the Court's constructions and rulings and other
 28 developments that have occurred since August 27, 2020, when the last of Gamevice's infringement
 expert reports was served.

³ The ALJ issued the claim construction order in the 1111 ITC Investigation long after the
 expert reports were exchanged, and even after the parties submitted their written direct testimony.
 And in the 1197 ITC Investigation, there was no pre-trial Markman ruling.

1 1197 Initial et., 143. Gamevice has no new evidence to present because the ‘upper frame’ does not
 2 ‘comprise’ a ‘passageway,’ and no reasonably jury could find otherwise.” As discussed above,
 3 Nintendo is wrong to say that the “same evidence” that was presented at the 1197 ITC trial is “before
 4 the Court now,” since both parties can modify their trial presentations. But more fundamentally, the
 5 ITC ruling in Nintendo’s favor does not bind this Court and does not mean that another fact-finder,
 6 in this case a jury, cannot find in Gamevice’s favor based on similar contentions. As noted earlier,
 7 Nintendo never sought summary determination on these non-infringement arguments in the ITC,
 8 suggesting that even Nintendo realized that there were material facts in dispute. That the ALJ ruled
 9 in Nintendo’s favor after the trial does not mean that Nintendo’s pre-trial assessment was wrong or
 10 that Gamevice’s evidence could no longer sway another fact-finder.

11 **2. The Nintendo Switch has the claimed “passageway.”**

12 As Nintendo’s motion acknowledges, Gamevice previously presented expert opinion in the
 13 ITC cases that the accused Nintendo Switch satisfies the “passageway” limitation. *See* Nintendo
 14 Mot. at 8-10. Gamevice will produce evidence of a passageway in the accused Switch in this case as
 15 well, as the attached declaration from Dr. Singhose demonstrates. Although Nintendo has various
 16 contrary arguments and will no doubt submit competing expert testimony, that alone does not
 17 eliminate the genuine issues of material fact with respect to the passageway claim element,
 18 particularly since the Court must view the evidence in a light most favorable to Gamevice and draw
 19 all reasonable inferences in Gamevice’s favor.

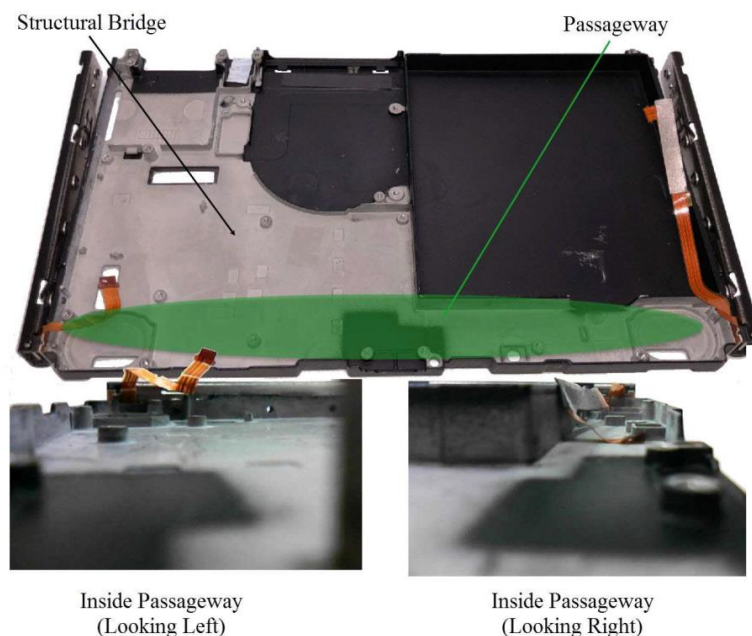
20 Claim 1 of the ’713 patent calls for, among other things:

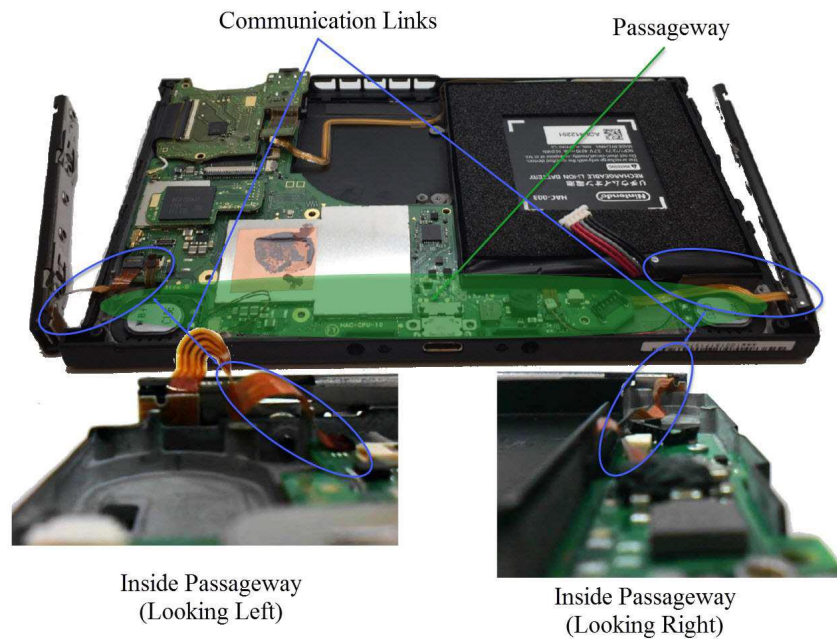
21 a structural bridge disposed between the pair of confinement
 22 structures, the structural bridge comprising, a passageway between the
 23 pair of confinement structures, the passageway promotes
 24 communication between the first communication link and the
 computing device, the passageway further promotes communication
 between the second communication link and the computing device;

25 ’713 patent, col. 17:63-18:3. That limitation is incorporated into dependent claims 3, 4, 6, and 7.
 26 Claim 1 of the ’393 patent, which is incorporated into dependent claim 6, is similar. ’393 patent,
 27 17:63-18-6. Claim 16 of the ’713 patent is slightly different, calling only for “an electronics
 28 communications passageway between the first and second confinement structures.” ’713 patent,

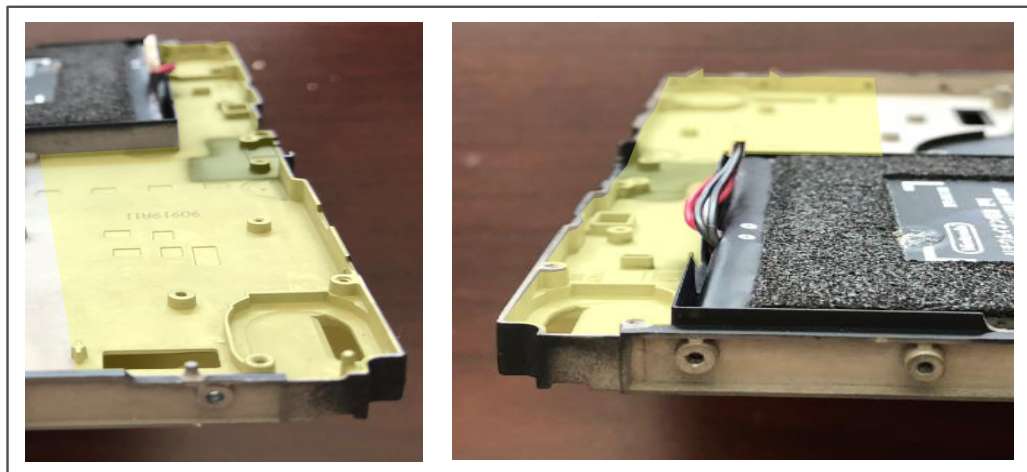
20:6-8. The Court construed the claim term “passageway” as “a space that accommodates a communication wire,” the construction proposed by Gamevice. Dkt. 241 at 12-13.

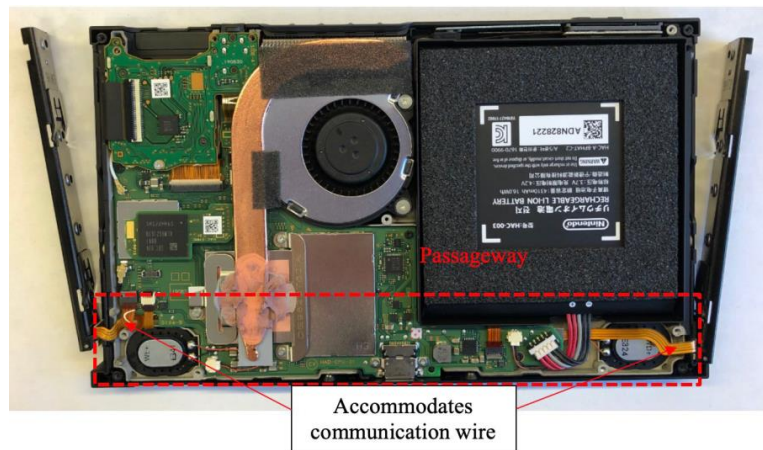
As Dr. Singhose’s declaration explains, the upper frame in the Switch, which Gamevice contends is the “structural bridge,” is a tray-like structure with a space that accommodates the flexible printed circuits that allow communication between the communication link, which is part of the claimed confinement structure, and the computing device. Ex. 1 (Singhose Decl.) at ¶¶17-32. This is consistent with Dr. Stubben’s expert report on the ’713 patent, which used the following annotated photos showing the passageway with the internal components removed and present:





Ex. 1 at ¶33. Dr. Singhose's declaration shows the passageway in a slightly different way, first showing the structural bridge without internal components and the passageway shaded in yellow, then with components:





Ex. 1 at ¶¶30, 32. As Dr. Singhose notes in his declaration, the upper frame has depth, which provides a three-dimensional space in the lower portion of the upper frame assembly where the printed circuit boards of the computing device are located and where the flexible printed circuits from the side rails connect to the PCBs. *Id.* at ¶¶31-32. That space constrains the movement of the flexible printed circuits.

Nintendo attacks that previous testimony by arguing that the proposed passageway “bears no relationship to the physical structure of the upper frame itself.” Nintendo Mot. at 14. But the claim says the structural bridge “comprises” a passageway, meaning it “consists at least of,” so there is no requirement that the structural bridge be physically co-extensive with the passageway. Ex. 1 at ¶34. And the three-dimensional tray structure of the upper frame does define a space. *Id.* There is no ceiling structure to the upper frame, but a street beneath open sky is still a passageway.⁴ And as Dr. Singhose notes, there would be another structure above the passageway that would also help define that space. Ex. 1 at ¶32. Nintendo also argues that the path taken by the flexible printed circuits is circuitous, see Nintendo Mot. at 15-16, but the claim does not require the passageway to be straight, and some of what Nintendo’s expert is talking about is actually the nature of a flexible circuit, which

⁴ See, e.g., Merriam-Webster On-Line Dictionary, defining “passageway” as “a way that allows passage” and providing as an example of proper usage “The streets no longer exist, they have been replaced by perilous passageways on top of the rubble. — Ivana Kottasová, CNN, 12 Sep. 2023.” <https://www.merriam-webster.com/dictionary/passageway> (last visited Sep 28, 2023).

1 can bend and twist if needed, as well as the path the flexible printed circuit has to take to get over the
 2 wall of the structural bridge and *into* the passageway, not the more straightforward and three-
 3 dimensional space that Gamevice is pointing to as the passageway.⁵ See generally Ex. 1 at ¶35. And
 4 finally, Nintendo argues that the flexible printed circuits do not extend all the way from one
 5 confinement structure to the other. Nintendo Mot. at 16-17. But the claim only requires the
 6 communication wires to go from the confinement structure communication links to the computing
 7 device, which they do in the Switch. The communication wires need not go all the way to the
 8 opposite confinement structure. Ex. 1 at ¶36.

9 Gamevice has identified structures in the Switch that a reasonable jury could conclude satisfy
 10 the “passageway” limitation in the asserted claims of the ’713 and ’393 patents, notwithstanding
 11 Nintendo’s counter-arguments and defensive expert testimony. The contrasting expert testimony and
 12 argument shows a genuine issue of material fact exists that precludes summary judgment in
 13 Nintendo’s favor.

14 3. The Nintendo Switch has the claimed “confinement structures.”

15 Nintendo’s motion also acknowledges that Gamevice presented expert opinion in both prior
 16 ITC cases that the accused Switch satisfies the “confinement structure” claim limitation, which
 17 appears in all 6 remaining asserted claims. Claim 1 of the ’713 patent, which is incorporated into
 18 claims 3, 4, 6, and 7, provides:

19 a pair of confinement structures, the pair of confinement structures
 20 adjacent to and confining the computing device on at least two
 21 opposing sides, but not more than three sides of the sides of the
 22 computing device, and in which a first confinement structure of the
 23 pair of confinement structures provides a first communication link,
 24 while a second confinement structure of the pair of confinement
 25 structures provides a second communication link:

26 ’713 patent, 17:54-62. Claim 1 of the ’393 patent, incorporated into claim 6, provides:

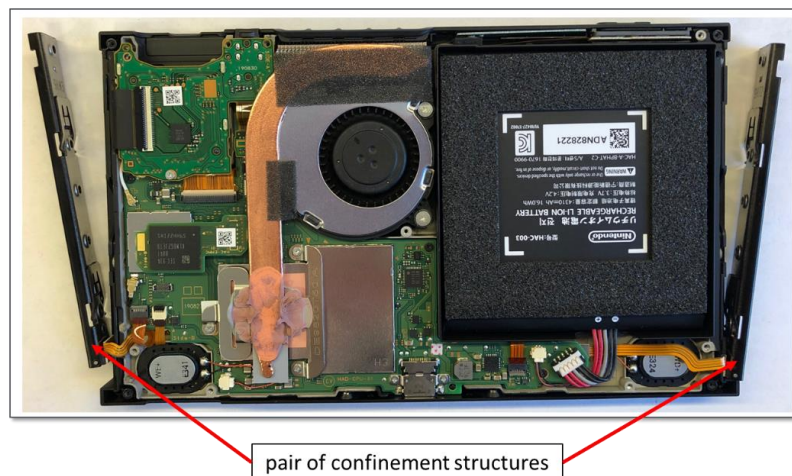
27 a pair of confinement structures, the pair of confinement structures
 28 interacting with the computing device and adjacent at least two
 opposing sides of the computing device, but not more than three sides
 of the sides of the computing device, each of the pair of confinement
 structures comprising a communication link, each of the

⁵ Nintendo points out that the ALJ accepted its argument on this point, but that does not mean that the jury has to reach the same conclusion.

communication links configured for electronic communication with the computing device.

'393 patent, 17:55-62. In each of the above claims, the confinement structures must be “separate and distinct” structures from and form “no structural portion” of the control modules or the structural bridge.⁶ In the claims of the '713 patent, the confinement structures are secured to the structural bridge using “fastening mechanisms.” The Court construed “confinement structure” to be a “physical component that holds a computing device.” Dkt. 241 at 12.

Gamevice’s infringement contention with respect to the “confinement structure” claim element is fairly simple and consistent through each of the patent claims—the metal rails that are screwed onto the side of the Nintendo Switch and to which the control modules attach when in handheld mode satisfy the “confinement structure” limitations. The rails are shown below in this image from Dr. Singhose’s declaration:



Ex. 1 at ¶40. The rails are secured to the upper frame, i.e., the “structural bridge,” using screws, i.e., “fastening mechanisms,” one of which passes through a hole in the plastic back cover of the Switch console, part of the “computing device.” *Id.* at ¶¶41. When a user places the Joy-Con controllers onto the rails, i.e., the “confinement structures,” in order to operate the Switch and play a game, the

⁶ Claim 16 of the '713 patent is worded differently, but still includes the requirement that the control modules not form a structural portion of the confinement structures. '713 patent, 20:23-25.

1 user holds the controllers, which are connected to the confinement structures, which in turn are
2 holding the computing device, as shown in this picture:



14 Ex. 1 at ¶42. This is because the screws between the confinement structures and the structural bridge
15 and through the back cover of the console create sufficient pressing contact to hold the console in
16 place even if the user is only holding the controllers. *Id.*

17 Nintendo claims that the rails are part of the Nintendo Switch console, *see* Nintendo Mot. at
18 18, but in fact they are separate and distinct components. Ex. 1 at ¶¶43-45. Nintendo argues that the
19 rails do not “hold” internal components of the console, *see* Nintendo Mot. at 18, but as discussed
20 previously, the claims in this case only involve computing devices that include both the back and the
21 display screen, and the confinement structures do interact with and hold the larger console. Ex. 1 at
22 ¶¶43-45. And Nintendo points to the ITC’s decision in the 1197 ITC Investigation that the Switch is
23 different from the embodiments shown in the patent specification, *see* Nintendo Mot. at 19, but the
24 correct comparison is the accused product to the claims as construed, not the specification.

25 Again, Gamevice has identified structures in the Switch that a reasonable jury could conclude
26 satisfy the “confinement structure” limitation in the asserted claims of the ’713 and ’393 patents,
27 notwithstanding Nintendo’s counter-arguments and conflicting expert testimony. The contrasting
28

expert testimony and arguments show a genuine issue of material fact exists that precludes summary judgment in Nintendo's favor.

4. The Nintendo Switch has the claimed "apertures."

The Nintendo Switch has physical features, specifically in the Joy-Con controllers, that



satisfy the "input module apertures" claim limitations of the '713 patent. Claim 1 of the '713 patent, on which claims 3, 4, 6, and 7 depend, requires:

an input device, the input device comprising a pair of control modules, ..., each of the pair of control modules providing input module apertures, each input module aperture secures an instructional input device, ...

Neither the ITC nor this Court construed the term "input module apertures."

As Dr. Singhose notes in his declaration, and as Mr. Stubben set forth in his expert report in the 1111 ITC Investigation, a Joy-Con controller, which Gamevice contends is a control module that can make up a "pair of control modules," has buttons and a joystick that extend up through holes in the housing of the Joy-Con, as shown in these annotated images:



Ex. 1 at ¶¶48-49, citing to Stubben Expert Rep. at 32 and 34 (excerpts at Ex. 15 to Nintendo Mot.). Mr. Stubben opined in his expert report that the holes, labeled “input module apertures” on the figure, secure the joysticks and buttons, and Dr. Singhose agrees with that opinion. *Id.* Specifically, in his proposed direct testimony, Mr. Stubben stated that “the buttons are not attached at their base to anything internal to the Joy-Con so if the apertures were, for example, too large in diameter, the buttons would simply fall out of the Joy-Con.” Ex. 1 at ¶50, quoting Stubben W.S., CX-0168C at Q/A 103.

Nintendo again argues that Gamevice is wrong, but this argument just demonstrates the existence of a factual dispute. Nintendo argues that the holes do not *secure* the buttons, but instead allow the buttons to protrude through the housing. Nintendo Mot. at 20. Dr. Singhose disagrees, as

Nintendo's conceptual argument regarding this unconstrued term would read out the preferred embodiments in the patent that work the same way as the Switch Joy-Cons. For example, the embodiment of Figure 13 of the '713 patent is described the same way as the claim language at issue:

Preferably, the input device 250 provides a pair of control modules 252. . . . The pair of control modules 252 preferably provide input module apertures 254, each input module aperture 254, secures an instructional input device 256.

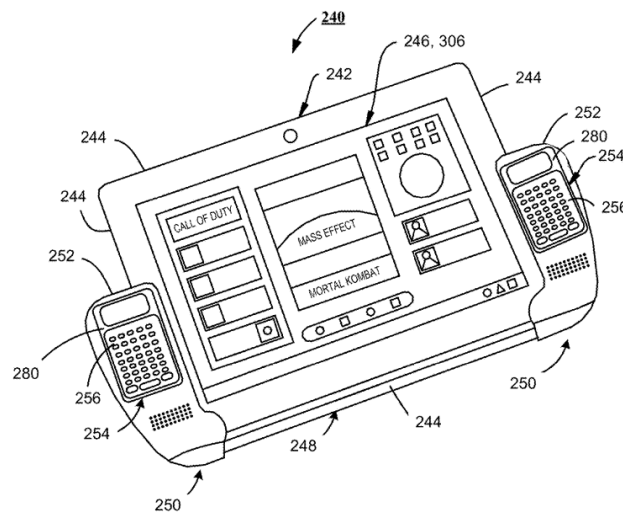


FIG. 13

'713 patent, Fig. 13 and 8:11-20. The patent embodiment works the same way as the Joy-Cons, with instructional input device 256 protruding through an aperture 254 in a housing, and the patent specification teaches that "each input module aperture 254, **secures** an instructional input device 256." *Id.* at 8:19-20 (emphasis added); Ex. 1 at ¶¶51-53. Nintendo's proposed reading of the claim language, where the holes do not "secure" the input devices, is inconsistent with the specification and is thus improper. The cited testimony from Nintendo's employee merely confirms Dr. Singhose's and Mr. Stubben's opinion, since the employee never contradicts Mr. Stubben's original comment that the buttons are not attached to anything internal to the Joy-Con. Instead, he says that

1 the buttons are held in by a flange at the bottom, meaning Mr. Stubben is correct—if the holes were
 2 bigger than the flange, the buttons would fall out. Ex. 1, ¶54-55.

3 As with the other limitations, Gamevice has identified structures in the Switch that a
 4 reasonable jury could conclude satisfy the “apertures” limitation in the asserted claims of the ’713
 5 and ’393 patents. Nintendo’s counter-arguments and defensive expert testimony show only that there
 6 is a genuine issue of material fact precluding summary judgment in Nintendo’s favor.

7 **5. Nintendo admits that the Nintendo Switch satisfies the “computing**
 8 **device” limitation.**

9 Nintendo’s discussion of the “computing device” limitation, a claim element that Nintendo
 10 agrees can be found in the Switch, is out of place in this non-infringement summary judgment
 11 motion. Nintendo expends a fair amount of effort to poke holes in Gamevice’s ITC trial presentation
 12 on the “computing device” limitation and insists that, since Gamevice is supposedly bound to that
 13 same presentation, Gamevice will not be able to satisfy the “computing device” limitation here. But
 14 at the same time, Nintendo admits that the Switch satisfies the “computing device” limitation. See
 15 Nintendo Mot. at 12 (“Nintendo has never disputed that the Nintendo Switch console, itself, is a
 16 computing device.”). Nintendo also admitted that the Switch comprised a “computing device” in the
 17 1197 ITC Investigation, and the ALJ agreed. Initial Determination (Ex. 15 to Nintendo Mot.) at 115
 18 (“The record evidence thus demonstrates that the Nintendo Switch includes a computing device.”).
 19 So, Nintendo is not arguing that summary judgment of non-infringement is appropriate because
 20 Gamevice **cannot** show that the Switch includes the claimed “computing device.” Quite to the
 21 contrary, Nintendo admits that the Switch does, in fact, include the claimed “computing device.”
 22 That is not a winning argument in favor of non-infringement with respect to the “computing device”
 23 limitation. Nintendo mostly argues that Gamevice pointed to the wrong Switch components in the
 24 1197 ITC investigation to support its infringement case and will do the same again in this case. But
 25 even assuming that is true, Gamevice still proved that the Switch had a “computing device” in the
 26 1197 ITC Investigation because Nintendo admitted it there, and it has done so again here. As a
 27 result, there is no reason to conclude that Gamevice will fail to prove that the Switch includes a
 28 “computing device” in this case.

1 Nintendo's argument really boils down to the assertion that, although the Switch has a
 2 computing device, Gamevice will try to prove that the wrong way because that is what happened in
 3 the last trial. But there is no reason to conclude that Gamevice will repeat the same trial presentation
 4 from the 1197 ITC Investigation. First, as noted previously, the 1197 ITC Investigation involved
 5 only the '393 patent, not the '713 patent, and it involved claims no longer at issue here, particularly
 6 claim 1. Claim 1 of the '393 patent is unique in that, unlike claim 1 of the '713 patent or the claims
 7 still asserted in this case, the claim language does not mandate that the computing device have a
 8 screen and a back. In addition, the parties had agreed to a construction of "computing device" that, at
 9 least in Gamevice's view, represented a rejection of Nintendo's arguments that only a completed
 10 device, such as the entire Switch console, could satisfy the "computing device" limitation.⁷ Under
 11 those circumstances and at that time, Gamevice's trial presentation was reasonable. The ITC,
 12 however, surprisingly shifted from the agreed broad construction of "computing device" to
 13 Nintendo's much narrower interpretation during the infringement determination.

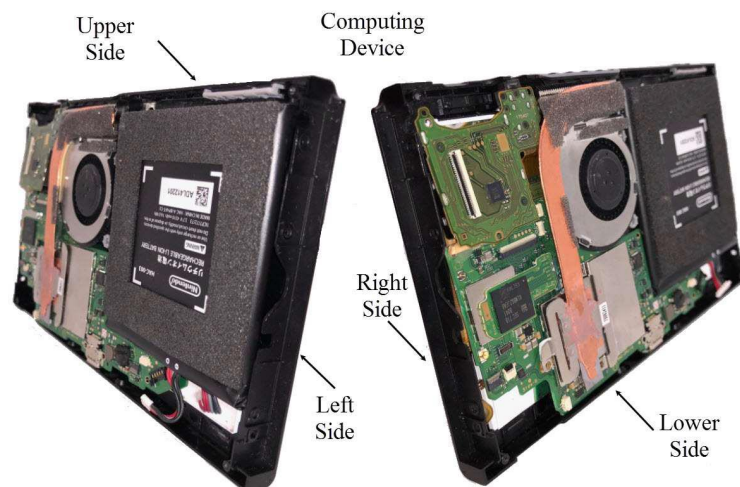
14 But conditions here are different, and the approach with respect to the '713 patent was also
 15 different. All the claims still at issue in this case require the computing device to have a screen and a
 16 back, so Gamevice will not be relying merely on evidence relevant to proving infringement of the
 17 broader claim 1 of the '393 patent. Instead, Gamevice will present evidence at trial consistent with
 18 the approach disclosed in Mr. Stubben's expert report, which was not limited to the more discrete set
 19 of components identified in the '393 patent claim 1 "computing device" presentation. In fact, in his
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 21

22 ⁷ As discussed previously in Gamevice's opposition to Nintendo's sanctions motion, in the
 23 1111 ITC Investigation, Nintendo asserted that "computing device" should be construed as "a tablet
 24 computer, smart phone, notebook computer, or other portable computing device." Nintendo argued
 25 that, in contrast, Gamevice's proposed construction—electronic equipment controlled by a CPU, the
 26 same construction this Court adopted—would cover "whichever internal components of a computing
 27 device Gamevice might wish when making its infringement case," and that the term should instead
 28 be construed to cover only "some sort of a consumer-ready, full-fledged device." See Dkt. 221 at 16-
 17 and materials cited therein and attached as exhibits. The ALJ rejected Nintendo's position in the
 1111 Markman order. Then, in the 1197 ITC Investigation, Nintendo agreed to Gamevice's original
 claim construction, seemingly abandoning its argument that only a "full-fledged device" could
 satisfy the claims. Only later at trial did Nintendo shift back to that construction in the context of a
 "non-infringement" argument.

report, Dr. Stubben opined that the Switch included a computing device even under Nintendo’s proposed construction:

I understand the ALJ has not construed the term “computing device.” I understand that Gamevice asserts that “computing device” carries its plain and ordinary meaning, for example, electronic equipment controlled by a CPU. I also understand that Nintendo asserts “computing device” means “a tablet computer, smart phone, notebook computer, or other portable computing device.” It is my opinion that the Nintendo Switch includes a “computing device” under either party’s proposed construction.

Stubben Expert Rep., at 18, ¶ 46 (Ex. 15 to Nintendo Mot.). As Mr. Stubben further disclosed, the Switch console satisfied the “computing device” limitation under Gamevice’s construction, which he demonstrated using these figures that removed certain portions of the console to reveal the “electronic equipment controlled by a CPU:





12 *Id.* at 19 and 20, ¶¶ 47 and 49. Mr. Stubben also opined that “[u]nder Nintendo’s proposed
13 construction, the Nintendo Switch console is a computing device that is a tablet computer, smart
14 phone, notebook computer, or other portable computing device as shown below:”



27 *Id.* at 21, ¶ 51.
28

1 Nintendo’s premise that Gamevice is locked into an infringement theory for “computing
 2 device” that relies only on an identification of limited components and that the ITC rejected, even
 3 while the ITC still found that the Switch included a “computing device,” is simply incorrect.
 4 Gamevice’s expert reports preserved alternative infringement reads for “computing device” different
 5 from the more specific approach that was ultimately designed to fit the unique dynamics of the 1197
 6 ITC Investigation and the claims and constructions at issue there. In fact, one of those reads is
 7 identical to Nintendo’s admission—the Switch console itself is a computing device. Nintendo’s
 8 argument regarding computing device fails to provide any basis for granting summary judgment of
 9 non-infringement as to the “computing device” limitation. If anything, it shows that there is little, if
 10 any, dispute that the “computing device” limitation is met in the Switch.

11 **B. The Court’s anticipation ruling prevents Nintendo from arguing that**
 12 **claim elements from the invalidated claims are not present in the Switch.**

13 In making the non-infringement arguments discussed above, Nintendo is still trying to have
 14 its cake and eat it too. As Gamevice has previously argued in its summary judgment motion, Dkt.
 15 255, Nintendo successfully proved that the accused product, the Nintendo Switch, anticipates a
 16 number of Gamevice patent claims in the asserted patents, including claims 1 and 2 of the ’713
 17 patent and claims 1-4 of the ’393 patent. Finding that a claim has been anticipated means that a
 18 single reference contains all the elements of that challenged claim. *See, e.g., IXYS Corp. v. Advanced*
 19 *Power Tech. Inc.*, Case No. 02-03942 MHP, 2004 WL 540513, at *5 (N.D. Cal. Mar. 18, 2004)
 20 (“Invalidity for anticipation requires that all of the elements and limitations of the challenged claim
 21 be found within a single prior art reference.”). All the claim elements Nintendo discusses in its
 22 summary judgment motion and that Nintendo insists are not found in the Switch appear in claims
 23 that were found to be anticipated, so the Court necessarily found those claim elements present in the
 24 Switch when those claims were rendered invalid. The Court should, therefore, reject Nintendo’s
 25 invitation to find, quite to the contrary, that the Switch does not have those same claim elements.

26 All of the claim elements addressed in Nintendo’s motion appear in claims that were
 27 invalidated. Claim 1 of the ’713 patent introduces the passageway (*see* ’713 patent, 17:63-18:3),
 28 confinement structure (*id.* at 17:54-62), aperture (*id.* 18:16-21), and computing device (*id.* at 17:48-

53) claim elements. As for asserted claim 16 of the '713 patent, which was not invalidated, it uses the passageway, confinement structure, and aperture claim elements, *see generally* '713 patent, claim 16, 19:48-20:25, but those elements are also incorporated into invalidated claim 17 since claim 17 covers “the combination of claim 16 . . .” The claims of the '393 patent do not use the aperture term anywhere in the claims related to remaining claim 6. But invalidated claim 1 does introduce the passageway ('393 patent, 17:63-18:6), confinement structure (*id.*, 17:55-62), and computing device claim elements (*id.*, 17:54). This is not a situation where one must connect claim elements across patent families. These are claim elements that run in unaltered form through a group of related claims in a single patent.

While Nintendo has previously claimed a right to make inconsistent arguments (and this argument is definitely inconsistent), it is one thing to make inconsistent arguments, it is quite a different thing for the Court to reach inconsistent conclusions. The Court cannot simultaneously find that the Switch both does and does not have, for example, the passageway of claim 1 and, by extension, claims 3, 4, 6, and 7. Anticipation and infringement are both factual determinations. *See, e.g., SRAM Corp. v. AD-II Eng'g, Inc.*, 465 F.3d 1351, 1357 (Fed. Cir. 2006) (“Anticipation is a question of fact.”); *Apple Inc. v. Samsung Elecs. Co.*, 839 F.3d 1034, 1040 (Fed. Cir. 2016) (“Infringement is a question of fact.”). Nintendo is improperly asking the Court to rest two key legal rulings affecting Gamevice’s property rights—whether Gamevice’s patent claims are valid and whether they are infringed—on diametrically opposed factual conclusions about whether the Switch satisfies the claim elements.

As recounted in more detail in Gamevice’s summary judgment motion and related reply brief, Nintendo cannot now repudiate its representation that “the Nintendo Switch satisfies each limitation of the asserted claims,” where the Court relied on that original representation. Dkt. 255 at 6-9; Dkt. 262 at 11-12. Alternatively, the Court’s anticipation ruling, which rests on factual determinations that the Switch embodies each limitation of the invalid claims, should be treated as law of the case and result in a finding that the Switch embodies those same limitations when it comes to infringement. Dkt. 255 at 9-11; Dkt. 262 at 2-5 and 12-13.

1 Nintendo's summary judgment motion shows why both of those doctrines should apply here.
2 Nintendo's non-infringement arguments are clearly contrary to the concession it made in order to
3 obtain the Court's anticipation ruling, meaning Nintendo has "[gained] an advantage by asserting
4 one position, and [is now] seeking an advantage by taking a clearly inconsistent position," which
5 judicial estoppel is designed to prevent. *Hamilton v. State Farm Fire & Cas. Co.*, 270 F.3d 778, 782
6 (9th Cir. 2001). And by arguing that the Switch does not have certain claim elements that appear in
7 both the anticipated and potentially infringed claims, Nintendo is asking the Court to reconsider the
8 question of whether the Switch has the claimed passageway, confinement structures, apertures, and
9 computing device, contrary to the "law of the case" doctrine, which dictates that "[a] court will not
10 generally revisit an issue once decided in the litigation." *Mendenhall v. Barber-Green Co.*, 26 F.3d
11 1573, 1582 (Fed. Cir. 1994).

12 Accordingly, Nintendo's summary judgment motion of non-infringement should be denied
13 because Nintendo should be precluded from raising non-infringement under the circumstances here.

14 **IV. CONCLUSION**

15 Nintendo has failed to show that there are no genuine issues of material fact as to whether the
16 Nintendo Switch has the claimed passageway, confinement structures, apertures, and computing
17 device, or that Nintendo is entitled to judgment as a matter of law. Gamevice presented evidence in
18 the prior ITC cases, and will present evidence in this case, that a reasonable fact-finder could accept
19 and decide in Gamevice's favor. And beyond that, Nintendo should be precluded from arguing that
20 any of the claim limitations from the anticipated claims are absent from the Switch. Accordingly,
21 Nintendo's motion for summary judgment should be denied.
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1 Dated: September 28, 2023

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, LLP

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3 By: /s/ Smith R. Brittingham IV
4 Smith R. Brittingham IV
Attorneys for Plaintiff Gamevice, Inc.
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