

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

Petitioners,

v.

GAMEVICE, INC.,

Patent Owner

Case IPR2018-01521
U.S. Patent No. 9,126,119

**PATENT OWNER'S RESPONSE
PURSUANT TO 37 C.F.R. § 42.120**

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Exhibit Table

Exhibit #	Description
2001	Order No. 20: <i>Markman</i> Order In the Matter of Certain Portable Gaming Console Systems With Attachable Handheld Controllers and Components Thereof Inv. No. 337-TA-1111

The present petition (Paper 1, IPR2018-01521, hereinafter “Petition”) is one of two *inter partes* review petitions filed by NINTENDO CO., LTD. and NINTENDO OF AMERICA, INC. (hereinafter “Petitioner”) challenging various claims of U.S. Patent No. 9,126,119 (hereinafter “’119 Patent”). *See also* IPR2018-01522. The Petition relies on various combinations of references across three grounds in its attempt to invalidate the challenged claims. *See* Petition at 4. Claims 1-10 and 13-21 of the ’119 Patent are collectively referred to herein as “the Challenged Claims.”

I. INTRODUCTION

Petitioner has not met its “burden of proving a proposition of unpatentability by a preponderance of the evidence.” 35 U.S.C. § 316(e). Unable to muster any anticipation ground against the ’119 Patent, Petitioner advances hindsight combinations that selectively cull components from prior art in an attempt to fit the parameters of the patented invention. But these hindsight combinations fail to demonstrate that any of the challenged claims are unpatentable.

As explained in greater detail below, the Petition suffers from the same recurring problems that infect all three grounds of invalidity. First, Petitioner provides explicit claim constructions for the terms “pair of confinement structures” and “fastening mechanism,” but fails to analyze the Challenged Claims and cited art in view of these constructions. Instead, Petitioner ignores its proffered constructions

and appears to analyze the Challenged Claims' alleged invalidity under different, broader constructions without making reference to Petitioner's own constructions. Failure to show invalidity of the Challenged Claims under Petitioner's expressly proffered constructions counsels for denial of the Petition under 37 C.F.R. § 42.104(b)(3)-(4).

Another flaw that permeates the Petition is that Petitioner repeatedly cites to arguments and information appearing only in its 421-page expert declaration (Ex. 1002, Kitchen declaration) that are not discussed, and cannot be found, in the Petition itself. Relying heavily on its expert's declaration in this way has enabled Petitioner to unfairly off-load substantial amounts of arguments from its Petition to an extraneous document. As the Petition stands at 13,959 words, off-loading arguments in this manner prejudicially circumvents the statutory word count limits imposed on *inter partes* review petitions. The Board should disregard such off-loaded arguments and information pursuant to 37 C.F.R. § 42.22(a).

In addition to these over-arching threshold issues, Petitioner also fails to establish that the cited art references disclose various claim limitations found in independent claim 1. For instance, among other claim limitations, the cited art combinations all fail to teach or disclose a "pair of confinement structures" and a "fastening mechanism [that] secures the pair of confinement structures." Other limitations not taught by one or more of the asserted grounds include an "input

device...in electronic communication with the communication port” and a “structural bridge comprising: a conduit between the pair of control modules.”

Accordingly, the Grounds raised in the Petition do not prove Petitioner’s propositions of unpatentability by a preponderance of the evidence. The Board should, therefore, deny the present Petition.

II. OVERVIEW OF THE ’119 PATENT

A. The ’119 Patent Specification

The ’119 Patent provides unique game controllers and information input devices that control electronic games and allow entry of information for a computing device. Ex. 1001 at 2:53-55. The combination computing device and game controller shown in FIG. 16 of the ’119 Patent below is instructive.

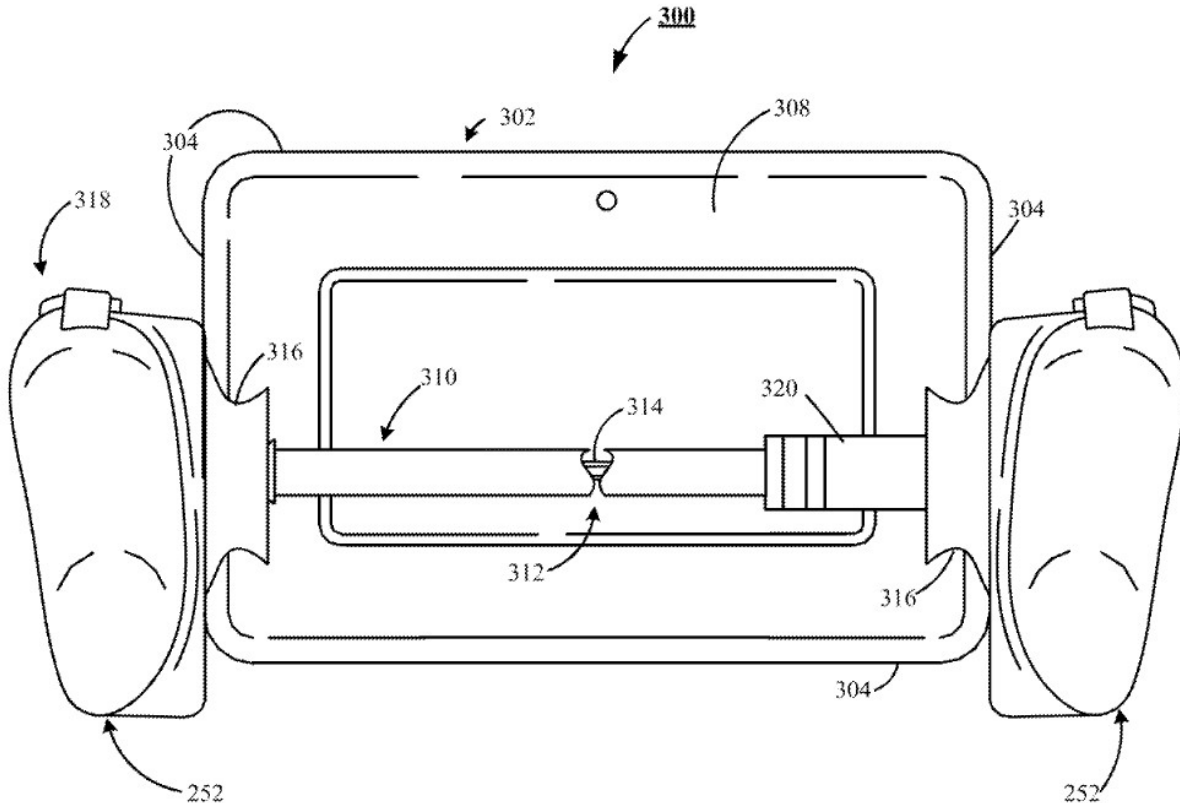


FIG. 16

The combination 300 in Figure 16 includes a computing device 302, which can take the form of a tablet computer or smart phone (*Id.* at 3:17-19), and a communication port 310 that interacts with the computing device 302. *Id.* at 7:56-64. The communication port 310 provides a communication link 312, shown as a wired connection 314, and a pair of confinement structures 316 that are preferably adjacent to and confine the computing device 302 on at least two opposing sides. *Id.* at 7:64-8:6. The combination 300 also includes an input device 318 that is in communication with the communication port 310 and provides a pair of control modules 252 having input apertures that secure instructional input devices, such as

joysticks, buttons, and keyboards. *See id.* at 7:51-55, 8:7-21.

Referring to FIGS. 17 and 18 below, the communication port 310 also includes a structural bridge 322 that secures the confinement structures 316 one to the other. *Id.* at 8:28-30. In one non-limiting, non-exclusive example, the structural bridge 322 is secured to a select confinement structure 316 by way of a solid connection 324 and to the other confinement structure 316 by way of a slip fit 326. *Id.* at 8:30-35. A fastening mechanism 320, such as, but not limited to, a soft draw latch, may securely fasten to a conduit 328 of the structural bridge 322 by way of an anchor 320 and an attachment member 332. *Id.* at 8:35-39. Operation of the fastening mechanism 320 in this non-limiting embodiment optionally permits expansion and contraction of the distance between the pair of confinement structures 316 for placement and removal of the computing device 302, and application of a sufficient compressive load to the computing device 302 to hold it between the pair of confinement structures 316. *Id.* at 8:43-53.

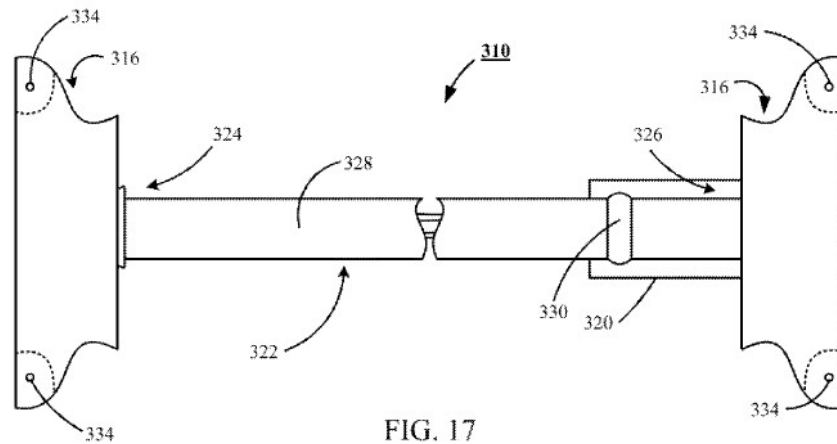


FIG. 17

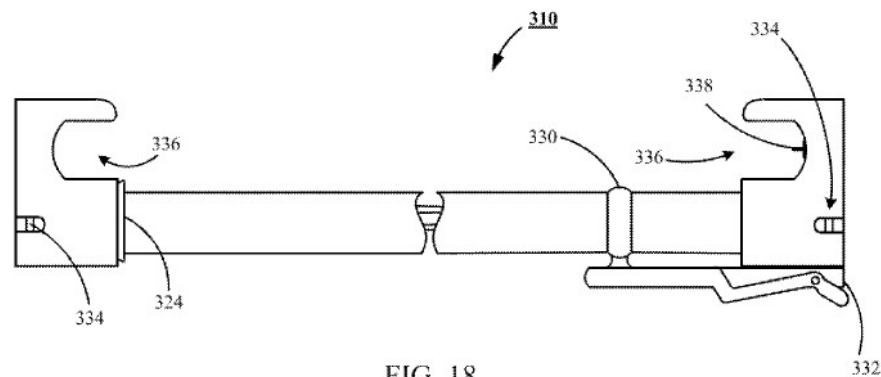


FIG. 18

These features, among others, provide a novel game controller and information entry device that the Examiner found to be patentable over the prior art.

B. The '119 Patent Claims

The '119 Patent includes 21 claims, including a single independent claim that recites:

1. A combination comprising:
a computing device, the computing device providing a plurality of sides, each of the plurality of sides are disposed between an

electronic display screen of the computing device and a back of the computing device;

a communication port interacting with the computing device, the communication port providing a communication link and a pair of confinement structures, the pair of confinement structures adjacent to and confining the computing device on at least two opposing sides of the plurality of sides of the computing device;

an input device attached to and in electronic communication with the communication port, the input device providing a pair of control modules, the pair of control modules providing input module apertures, each input module aperture secures an instructional input device, wherein said input module apertures are adjacent each of the at least two opposing sides of the plurality of sides of the computing device, and wherein the input device is a separate and distinct structure from the communication port, forming no structural portion of the communication port; and

a structural bridge securing the pair of confinement structures one to the other, in which each of the pair of control modules provide an attachment structure cooperating with the communication port, each attachment structure secures the input device to the communication port, and in which the structural bridge comprising:

a conduit between the pair of control modules; and

a fastening mechanism cooperating with the pair of confinement structures, the fastening mechanism secures the pair of confinement structures one to the other.

Id. at 9:63-10:28.

C. Prosecution History of the '119 Patent

The '119 Patent issued on September 8, 2015 from U.S. Application No. 14/611,804 (“’804 application”) filed on February 2, 2015. The ’804 application is a continuation-in-part application of U.S. application No. 13/779,987, filed on Feb. 28, 2013, now Pat. No. 8,529,357, which is a continuation-in-part of application No. 13/681,153, filed on Nov. 19, 2012, now Pat. No. 8,944,912, which is a continuation-in-part of application No. 13/494,801, filed on Jun. 12, 2012, now Pat. No. 9,005,026.

The '119 Patent was subject to a thorough examination by Examiner Jason Yen with over 45 references considered by the Examiner. *See* Ex. 1008 at 118-126. During prosecution, the Applicant and the Examiner discussed the application and prior art in detail, both through paper submissions and telephonic interviews. *See id.* at 99-140. Claim amendments were also made to further distinguish the invention from the prior art of record. *See id.*

After careful consideration of dozens of cited references, Examiner Yen allowed the claims of the ’804 application, stating, “the present invention is not anticipated or made obvious over the prior art” because:

[The prior art] is silent on the input device is a separate and distinct structure from the communication port, forming no structural portion of the communication port; and a structural bridge securing the pair of confinement structures one to the other, in which each of the

pair of control modules provide an attachment structure cooperating with the communication port, each attachment structure secures the input device to the communication port, and in which the structural bridge comprising: a conduit between the pair of control modules; and a fastening mechanism cooperating with the pair of confinement structures, the fastening mechanism secures the pair of confinement structures one to the other.

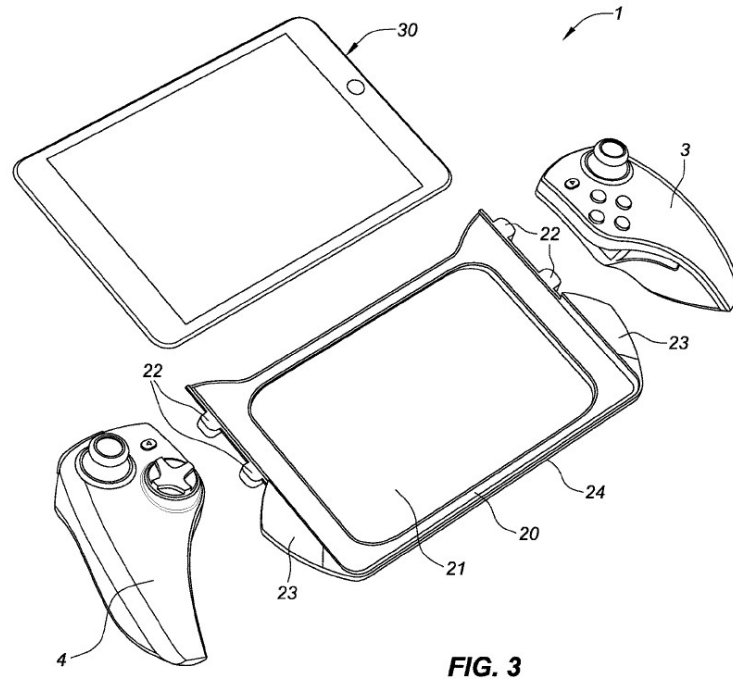
Ex. 1008 at 114-115.

III. OVERVIEW OF THE CITED ART

A. Schoenith

Schoenith describes a controller accessory for an electronic digital device, such as a smart phone or tablet, that provides auxiliary control functions to the electronic digital device it interfaces with. *See* Ex. 1003, Schoenith at 2:60-3:5, 4:33-39. Referring to FIG. 3 of Schoenith below, the controller 1 includes a right side panel 3, a left side panel 4, and a cradle 20. *Id.* at 9:57-59. The right and left side panels 3, 4 include joysticks and buttons. *Id.* at 9:45-49. The cradle 20 detachably couples to the right and left side panels 3, 4 and is configured to receive and secure a smart device 30. *See id.* at 9:50-56. The outer perimeter portion of the cradle 20 curves up to form a raised wall 24 that extends about three sides of the cradle 20 and supports the smart device 30. *See id.* at 9:66-10:3, FIGS. 3, 8, 19. The controller 1 may also include a wired or wireless connection that enables communication between the computing device 30 on one hand and one or more of

the right side panel 3, left side panel 4, or cradle 20 on the other hand. *See id.* at 7:35-47.



B. Kessler

Kessler discusses a game pad (*e.g.*, handheld control apparatus) that includes a pair of housings that are gripped by a user. Ex. 1005, Kessler at [0011]. Referring to FIG. 9 of Kessler below, the apparatus 10 includes a left housing 12 and a right housing 14 interconnected via a telescoping slide mechanism 84. *Id.* at [0084]-[0086]. Once fully extended, a space 68 is formed between the housings 12, 14 to accommodate an electronic device, such as a smart phone. *See id.* at [0077]. The

telescoping slide mechanism 84 can then be contracted to secure the electronic device between the housings' inner sides 12a, 14a. *Id.* at [0076], [0087].

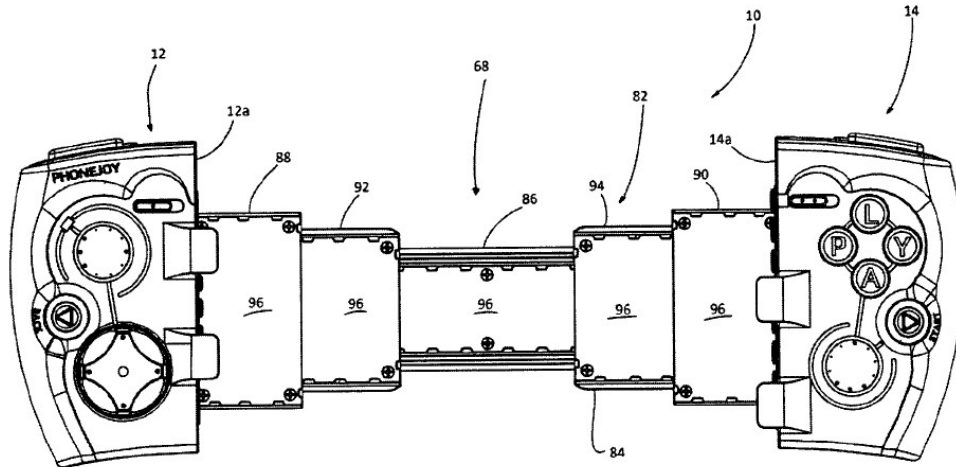


Figure 10

Referring to FIG. 13 of Kessler below, the telescoping slide mechanism 84 includes a series of slide sections 86, 88, 90, 92, 94 that utilize tongue and groove connections to nest within one another. *See id.* at [0085]-[0091]. The housings 12, 14 are also electrically connected by an electrical connection means 112 (*see* FIG. 19 of Kessler).

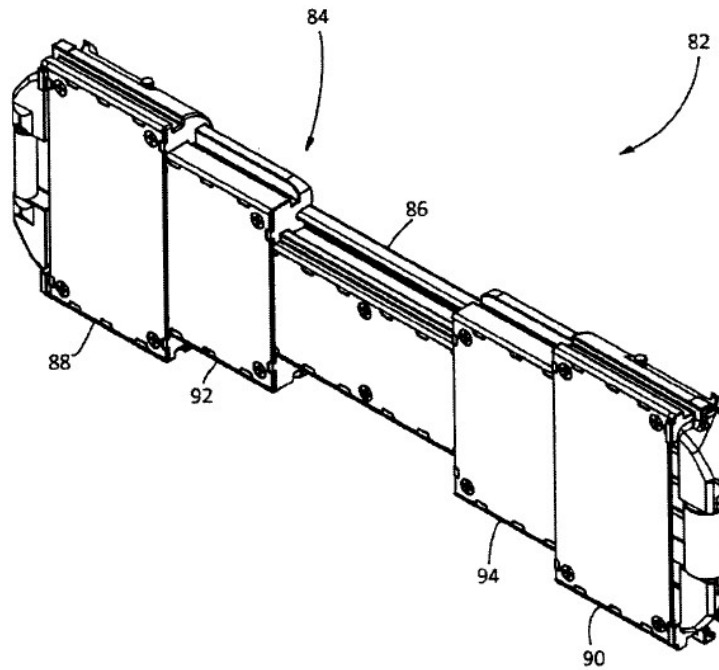
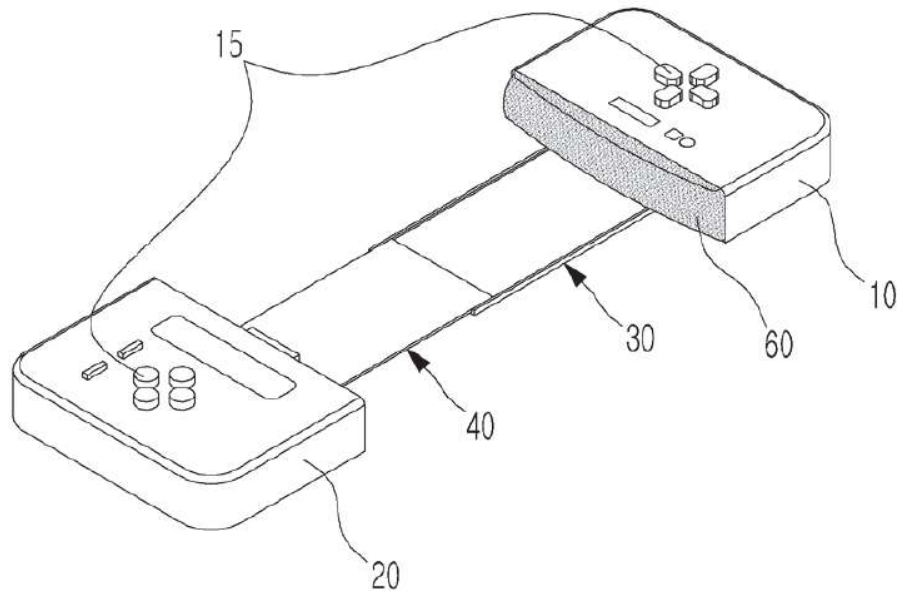


Figure 13

C. Park

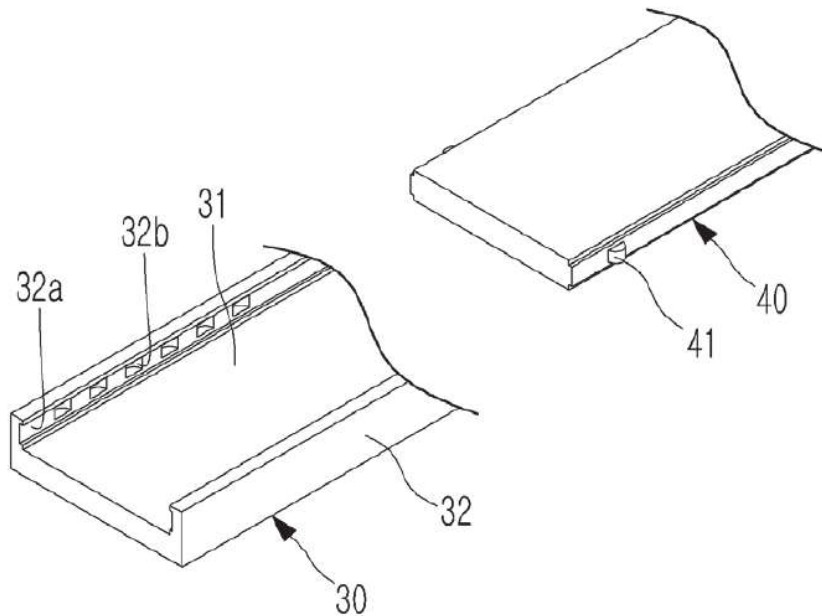
Park describes a game pad for a mobile phone that provides an auxiliary input device to the mobile phone it interfaces with. *See* Ex. 1004, Park at [0008], [0013]. Referring to FIG. 4 of Park below, the game pad includes a first body 10 and a second body 20 that are gripped by a user. *See id.* at [0026], [0030]. The first and second body 10, 20 each include a plurality of buttons 15 and are interconnected by a bridge 30, 40. *Id.* at [0026]. The bridge 30, 40 includes a first panel 30 and a second panel 40. *Id.* at [0033].

Fig 4



Referring to FIG. 2 of Park below, the panels 30, 40 use a groove-hole-protrusion mechanism for attaching a first panel 30 of a bridge to a second panel 40 of the bridge. *Id.* at [0033]-[0035]. Guide grooves 32a on the first panel 30 accommodate and receive an end of the second panel 40, and allow the second panel 40 to slide into the first panel's guide grooves 32a. *Id.* The guide grooves 32a include a plurality of recessed catching holes 32b at select intervals along the length of the groove. *Id.* at [0033]. Protrusions 41 near an end of the second panel 40 engage with the recessed catching holes 32b in the guide grooves 32a of the first panel 30 to allow adjustability of the bridge's length. *See id.* at [0033], [0039]-[0040].

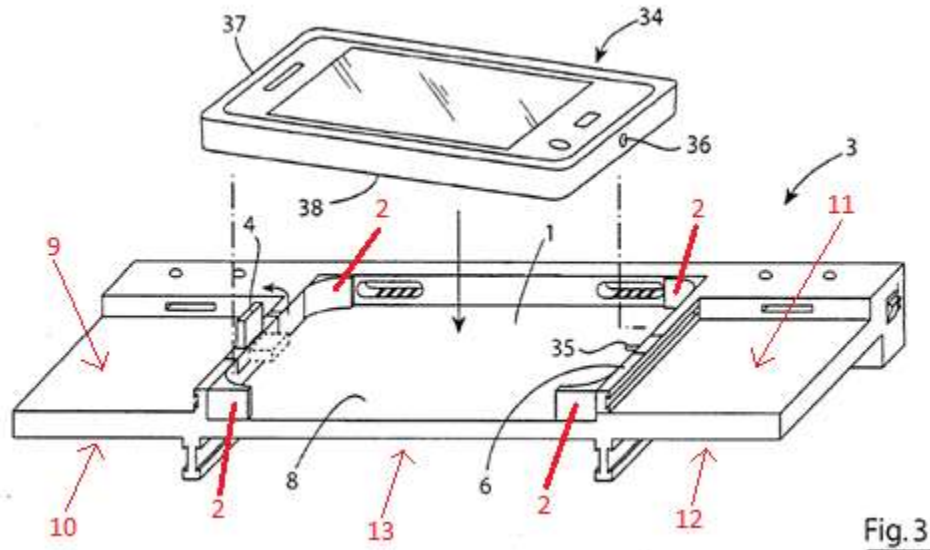
Fig 2



D. Michael

Michael discusses a docking station that allows different configurations for use of a personal electronic device. Ex. 1015, Michael at [0010]. “In particular, the docking station provides a cradle into which the personal electronic device may be fitted, and acts as an adapter, allowing various additional components to be functionally connected to the personal electronic device.” *Id.* Referring to annotated FIG. 3 of Michael below, the docking station 3 includes a first compartment 1 that receives the personal electronic device 34. *Id.* at [0125]. The docking station 3 includes a frame 6 having a platform 8 on which the electronic device 34 is secured using rubber grips 2 and a swiveling connector 4. *See id.* at [0125]. The docking

station 3 also includes other compartments 9-13 that receive modular accessories, such as various types of input devices that provide input and output means to the personal electronic device 34. *See id.* at [0127], [0130]-[0131].



IV. LEVEL OF ORDINARY SKILL IN THE ART

A person of ordinary skill in the art (“POSITA”) relevant to the ’119 Patent at the time of the invention would have a Bachelor of Science degree in electrical, mechanical, and/or computer engineering, and two years of work or research experience in the fields of gaming hardware development or design, or a Master’s degree in electrical, mechanical, and/or computer engineering and one year of work or research experience in such fields. Patent Owner’s description of the level of ordinary skill in the art is essentially the same as that of the Petitioner, except that Petitioner’s description requires only one year of relevant experience in the field (as

compared to two years). *See* Petition at 7-8. The positions set forth in this Response would be the same under either parties' proposal.

V. CLAIM CONSTRUCTION

For *inter partes* review petitions filed before November 13, 2018, claim terms are given their broadest reasonable interpretation ("BRI") in view of the specification in which they appear. 37 C.F.R. § 42.100(b); *see also* *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2142 (2016).

Petitioner identifies five terms ("confinement structures," "structural bridge," "conduit," "fastening mechanism," and "communication link") that require construction. Petition at 10-17. For two of these terms ("confinement structures" and "fastening mechanism"), Petitioner proffers a means-plus-function construction, identifying the alleged function and corresponding structure for each term. *See id.* at 10-12, 15-16. Petitioner provides no alternate constructions for any of these five terms except for the term "fastening mechanism" in Ground 1 where it argues that "Gamevice pointed to screws as fastening mechanisms," and also argues that Kessler's tongue and groove assembly would disclose this claimed feature "[u]nder that improper construction." Petition at 36.

As a general matter, Patent Owner disputes Petitioner's proffered constructions for these terms as being inconsistent under the BRI standard, and nothing herein, including analyses of the cited art in view of Petitioner's

constructions, should be interpreted as acceptance of these constructions by Patent Owner.¹ Instead, Patent Owner contends that proper construction of these terms require that they be given the broadest reasonable interpretation in light of the specification. Patent Owner reserves the right to offer its own express constructions to these terms, as appropriate.

¹ On December 7, 2018, an administrative law judge in the United States International Trade Commission (ITC) issued a non-final order (Ex. 2001 *Markman* Order) providing claim constructions for eight claim terms appearing in the claims of U.S. Patent Nos. 9,808,713 and 9,855,498, two patents at issue in a pending ITC investigation, and in the same family as the '119 patent. Patent Owner disputes one or more of the claim constructions provided in this *Markman* order, and has appealed these constructions to the International Trade Commission.

VI. THE PETITION SHOULD BE DENIED UNDER 37 C.F.R. § 42.104(b)(3)-(4) BECAUSE IT FAILS TO ESTABLISH WHY THE CHALLENGED CLAIMS ARE UNPATENTABLE BASED ON PETITIONER’S PROPOSED CLAIM CONSTRUCTIONS

The Rules require a petition for an *inter partes* review to identify, for each challenged claim, “[h]ow the challenged claim is to be construed” (37 C.F.R. § 42.104(b)(3)), and “[h]ow the construed claim is unpatentable.” 37 C.F.R. § 42.104(b)(4). All three Grounds in the Petition fail to satisfy 37 C.F.R. § 42.104(b)(4) because they fail to identify how the *construed* claims are unpatentable.²

Regulations are interpreted according to the same rules as statutes, with consideration given to “the plain language of the regulation, the common meaning of the terms, and the text of the regulation both as a whole and in the context of its surrounding sections.” *Aqua Prods., Inc. v. Matal*, 872 F.3d 1290, 1316 (Fed. Cir. 2017) (en banc) (citations omitted). “If the regulatory language is clear and unambiguous, no further inquiry is usually required.” *Id.* (citation omitted).

² These Grounds also fail to satisfy 37 C.F.R. § 42.104(b)(3) because it cannot be readily determined what specific construction Petitioner applies in its analysis of alleged unpatentability of a claim term in view of the prior art.

Here, the plain language of the regulation clearly and unambiguously requires that a petition must set forth a statement of the precise relief requested for each challenged claim that identifies how the challenged claims *are to be construed*, and then how the challenged claims *so construed* are unpatentable. The plain language of the Rule does *not* allow for a petition to identify how the challenged claims are to be construed, and then completely **disregard** those constructions when determining how the challenged claims are unpatentable. If it did, 37 C.F.R. § 42.104(b) would not recite “*construed* claim,” and instead would simply state “*challenged* claim.”

The USPTO’s own discussion of the Rule also supports this straightforward conclusion: “Section 42.104(b)...requires that the petition identify each claim being challenged, the specific grounds on which each claim is challenged, how the claims are to be construed, [and] why the claims *as construed* are unpatentable under the identified grounds.” 77 Fed. Reg. 48680, 48688 (third col., first full para.). This Rule is consistent with 35 U.S.C. § 312(a)(3), “which requires that the petition identify, in writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence supporting the challenge.” *Id.* (citing 35 U.S.C. § 312(a)(3)).

As previous panels have also recognized, “37 C.F.R. § 42.104(b)(3) and (4), which relate to the content of petitions,” “require[] that the construction of a claim in a petition *be consistent* with the unpatentability contentions in a petition.” *ZTE*

Corp. v. Maxell, Ltd., IPR2018-00238, Paper 8 at 8 (Jun. 1, 2018) (emphasis added).

In *ZTE Corp.*, the petitioner provided its proposed constructions for a number of different claim terms, including the following means-plus-function construction for the term “a display unit configured to...”:

In the context of the ‘729 Patent, the term **has the function** for displaying an image corresponding to the image signals formed by the signal processing unit. Ex. 1002 at ¶80. **The structure** for the term should be “display screen of a television system” [] or other screen compatible with NTSC or PAL format.

ZTE Corp. v. Maxell, Ltd., IPR2018-00238, Paper 1 (petition) at 16-17 (emphasis added). However, when analyzing the alleged unpatentability of the challenged claims in view of the prior art, petitioner ignored its proffered construction and did not address whether the prior art disclosed a screen compatible with NTSC or PAL format, as its proposed construction required. *See id.* at 27-28, 46-47. In response, the Board found that “Petitioner’s showing with regard to the ‘display’ limitation **is inconsistent** with Petitioner’s construction of this limitation,” and that “Petitioner fails to show that the prior art teaches or suggests the ‘display’ limitation for any of the asserted grounds **under Petitioner’s proposed construction** for this limitation.” *ZTE Corp. v. Maxell, Ltd.*, IPR2018-00238, Paper 8 at 7-8 (emphasis added). Notably, regardless of whether the Board adopts Petitioner’s proffered construction, the Petition still needs to show how the challenged claims are unpatentable according

to Petitioner’s proposed constructions. *Id.* at 8 (“***Regardless of whether or not [petitioner’s] construction is correct***, Petitioner makes no showing that [the prior art] teaches a television screen or other screen compatible with either the NTSC or the PAL format.”) (emphasis added). Consequently, the Board found that “[37 C.F.R. § 42.104(b)(3)-(4)] requires that the construction of a claim in a petition **be consistent** with the unpatentability contentions in a petition,” and that “**Petitioner has violated Section 42.104(b)(3) and (4)** by failing to show that the prior art teaches or suggests the ‘display’ limitation ***under its own proposed construction.***” *Id.* (emphasis added).

In accord, other Board decisions have rejected grounds where the petitioner failed to show that its own proffered constructions were met. *See, e.g., Hologic, Inc. v. Enzo Life Scis., Inc.*, IPR2018-00019, Paper 17 at 8 (PTAB Apr. 18, 2018) (“Although the Petition identifies what Petitioner considers to be the correct claim construction, **Petitioner admittedly does not identify how the challenged claims are unpatentable under that construction.**”); *see also Nestle Healthcare Nutrition, Inc. v. Steuben Foods, Inc.*, IPR2015-00249, Paper 37 at 9 (PTAB July 20, 2015) (“The relevant inquiry is whether the Petition explained adequately how the ***construed*** claim is unpatentable...” (emphasis added)).

Here, Petitioner’s actions are even more egregious than those in *ZTE Corp.* Petitioner expressly proffers means-plus-function constructions for the terms

“confinement structures” and “fastening mechanism” but fails to properly address, discuss, or analyze in its Petition the alleged unpatentability of the challenged claims, *as so construed*, in any one of its three grounds. For example, Petitioner fails to apply a means-plus-function analysis by explaining how the alleged functions for these terms are identically taught or disclosed in any of the cited prior art, or where in the cited art the identical or equivalent corresponding structures are disclosed. *Kemco Sales, Inc. v. Control Papers Co.*, 208 F.3d 1352, 1364 (Fed. Cir. 2000) (Prior art element reads on the § 112(f) limitation where the prior art element’s structure is “either [] the same as the disclosed structure or is a section 112, paragraph 6 ‘equivalent,’ *i.e.*, (1) perform[s] the identical function and (2) [is] otherwise insubstantially different with respect to structure.”); *see Odetics, Inc. v. Storage Tech. Corp.*, 185 F.3d 1259, 1267, 51 U.S.P.Q.2d 1229 (Fed. Cir. 1999). Instead, as explained in detail below, Petitioner often completely ignores its constructions for these terms and analyzes the claim limitations in view of the cited art under unknown constructions that appear to be significantly broader and inconsistent with Petitioner’s proffered § 112(f) constructions. *See* Petition at 29-30, 36, 50, 53-54, 63-64, 67-68.

Moreover, the purpose of 37 C.F.R. § 42.104(b)(4), as stated by the PTO, further emphasizes why the Rule requires that a petitioner explain why the claims are unpatentable according to Petitioner’s proffered constructions: “[37 C.F.R.

§ 42.104(b)(4)] provides an efficient means for identifying the legal and factual basis for satisfying the threshold for instituting *inter partes* review and **provides the patent owner with notice** as to the basis for the challenge to the claims.” 77 Fed. Reg. 48680, 48688 (third col., first full para.) (emphasis added); *see also id.* at 48699 (third col., last para.) (“[T]he petitioner’s claim construction will help **to provide sufficient notice to the patent owner** on the proposed grounds of unpatentability.”) (emphasis added), 48700 (first col. second full para.) (stating same). Indeed, if a petitioner were free to proffer claim constructions for the challenged claims, and then ignore those proffered constructions when analyzing the challenged claims’ purported unpatentability, such inconsistency would create confusion and uncertainty in the petitioner’s unpatentability positions, which would deprive the patent owner of notice as to the specific “basis for the challenge” initiated by the petitioner against the claims.

This lack of notice would prejudice the patent owner because it places the patent owner in the untenable position of having to guess as to how precisely it should respond to the petitioner’s challenges. Should the patent owner dedicate limited space in its responsive brief to fully address the petitioner’s stated grounds of unpatentability based on a claim construction that was proffered by the petitioner, *yet never actually applied* by the petitioner? Or arguably even more precarious, should the patent owner attempt to guess as to what constructions the petitioner did

ultimately apply in its grounds of unpatentability, and then devote space in its responsive brief based on these presumed—but unconfirmed—constructions? This uncertainty frustrates the Rules’ stated purposes and does not “**provide[] an efficient means** for identifying the legal and factual basis for satisfying the threshold for instituting *inter partes* review and **provide[] the patent owner with notice** as to the basis for the challenge to the claims.” *Id.* at 48688 (third col., first full para.) (emphasis added).

Prior decisions have found that uncertainty and inconsistency in a petitioner’s proffered and applied claim constructions “is reason enough to deny the petition.” *See Infinera Corp. v. Core Optical Tech., LLC*, IPR2018-01259, Paper 9 (Inst. Dec.) at 14 (Jan. 14, 2019). In *Infinera*, the petitioner identified in its petition a number of constructions for a patent’s challenged claim terms adopted by a district court in related litigation. *Infinera*, IPR2018-01259, Paper 2 (petition) at 18-20. According to the Board, Petitioner did not, however, propose that the Board adopt those district court constructions and instead advocated in the IPR that “no specific construction is necessary under the BRI” for the majority of these terms, including the term “cross polarization interference canceller” (XPIC). *Infinera*, IPR2018-01259, Paper 9 (Inst. Dec.) at 11-12. The Board also found that Petitioner’s unpatentability analysis of the prior art to the challenged claims in its grounds revealed “two more implied proposed constructions for XPIC,” but that Petitioner **had failed to “set forth**

explicitly such [implied] construction[s] for XPIC in the Petition.” *Id.* at 12-13.

Based on the different constructions for the claim term XPIC explicitly and implicitly set forth by Petitioner, the Board held that Petitioner “failed to identify adequately its proposed construction applicable to its patentability challenges” under 37 C.F.R. § 42.104(b)(3), and that Petitioner’s failure to “tak[e] a definitive position” as to the construction of XPIC was “enough to deny the petition.” *See id.* at 13-14.

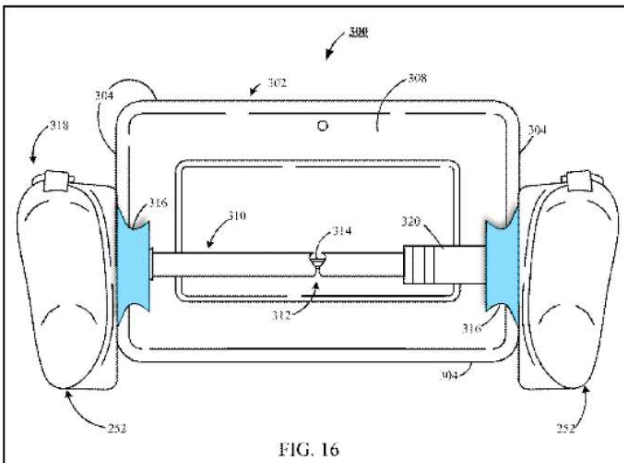
Here, Petitioner proffers means-plus-function constructions for the terms “confinement structures” and “fastening mechanism,” but its unpatentability analysis of these terms in its grounds ignores these constructions and appears instead to apply *other* (implied) constructions that are broader and inconsistent with its proffered § 112 (f) constructions. As in *Infinera Corp.*, Petitioner’s inconsistent positions as to how the claims should be construed with the unknown implied constructions used by Petitioner, improperly shifts Petitioner’s burden under § 42.104(b)(3)-(4) to Patent Owner and the Board to determine what construction Petitioner actually endorses and adopts as its basis to challenge the claims.

A. “Confinement Structures”

Petitioner provides, in part, the following construction for the term “confinement structures”:

[W]hile [“confinement structures”] does not use the term “means,” it is a means-plus-function limitation because it ‘fails to recite

sufficiently definite structure’ and recites function ‘without reciting sufficient structure for performing that function[.]’...The function for the *pair of confinement structures* is: ‘confining the computing device on at least two opposing sides of the plurality of sides of the computing device.’...[T]here is essentially no structure provided beyond, at most, the embodiment shown in Figures 16-22 and the corresponding limited



written description. Thus, only one construction exists that is, even arguably, definite. Figure 16 [annotated left] shows what the written description identifies as two confinement

structures 316.”

Petition at 10-11. Notably, this is the only construction for “confinement structures” set forth in the Petition.³ For example, Petitioner does not proffer a construction for

³ Immediately following its means-plus-function claim construction analysis, Petitioner also states, “In any case, the specification’s disclosures concerning the confinement structures, which are claimed to be adjacent to and confining the computing device on at least two opposing sides of the computing device, are limited

this term based on another construction that Patent Owner allegedly relied upon in related litigation. As explained in greater detail below, the Petition ignores its proffered means-plus-function construction in each and every ground of unpatentability set forth in its Petition, and instead applies an unknown and substantially broader construction, in violation of 37 C.F.R. § 42.104(b)(3)-(4).

1. Ground 1: Schoenith + Kessler

In Ground 1, Petitioner relies exclusively on Schoenith as teaching the claimed “confinement structures.” Petition at 29-30. Specifically, Petitioner contends that the “cradle’s sides and raised walls” described in Schoenith satisfy this

to the structure 316 identified in Figure 16 and related figures and corresponding descriptions, as discussed above. So even if *confinement structure* is not considered a means-plus-function term, **its construction should be limited to the disclosures of Figures 16-22 and accompanying descriptions because any broader interpretation would be improper.**” Petition at 12 (emphasis added). To the extent this is an attempt to provide an alternate construction, the issue before this Board remains unchanged: Petitioner again explicitly argues for a narrow construction that limits “confinement structures” to the two confinement structures 316 (highlighted blue in Petitioner’s figure above) shown in FIGS. 16-22 “because any broader interpretation would be improper” *Id.*

term. *Id.* What is noticeably absent from the Petition’s lone paragraph concerning this limitation, however, is an analysis consistent with a means-plus-function claim construction, such as an examination into whether the cradle’s sides and raised walls perform the “identical” alleged function (“confining the computing device on at least two opposing sides of the plurality of sides of the computing device”) and whether the cradle’s sides and raised walls are “insubstantially different,” structurally, from the ’119 Patent’s two confinement structures 316 or equivalents thereof.⁴ *See Kemco*

⁴ While the Petition indisputably fails to apply Petitioner’s proffered construction to its unpatentability analysis of “confinement structures” in Ground 1, the Petition cites to ¶¶113-115 of its expert declaration. Petition at 30. There, in ¶115, Petitioner’s expert provides a cursory discussion of why Schoenith allegedly satisfies “confinement structures” according to Petitioner’s proposed construction. However, for the reasons described *infra* in Section VII, this testimony should be ignored because there is absolutely no discussion in the Petition—however brief—of why or how Schoenith satisfies the claim limitation according to Petitioner’s means-plus-function construction. And, as further discussed below, Schoenith’s cradle, including its sides and raised walls, fails to perform the identical function and

Sales, Inc., 208 F.3d at 1364; Petition at 10-12. Instead, “[r]egardless of whether or not [petitioner’s] construction is correct,”⁵ the Petition analyzes the claim limitation using a different, unidentified construction that is inconsistent with and significantly broader than its proffered means-plus-function construction. *See ZTE Corp.*, IPR2018-00238, Paper 8 at 8. As in *Infinera Corp.*, such unidentified, inconsistent constructions prejudice Patent owner by usurping Patent Owner’s rightful notice as to Petitioner’s basis for the challenge to the claims and shift the Petitioner’s obligations under 37 C.F.R. § 42.104(b)(3)-(4) to Patent Owner and/or the Board.

is not structurally similar to the two confinement structures 316 shown and described in the ’119 Patent. *See discussion infra* Section VI.A.1(b).

⁵ The institution decision (“Decision”) did not adopt Petitioner’s proposed means-plus-function construction for “confinement structures,” and instead favored its own construction for that term. *See* Decision (Paper 7) at 5. However, as the Board correctly held in *ZTE Corp.*, “[r]egardless of whether or not [petitioner’s] construction is correct,” the Petitioner must still make a showing that the cited art teaches the claim limitation based on its own proffered construction, otherwise “Petitioner has violated Section 42.104(b)(3) and (4).” *ZTE Corp.*, IPR2018-00238, Paper 8 at 8.

77 Fed. Reg. 48680, 48688 (third col., first full para.); *Infinera Corp.*, IPR2018-01259, Paper 9 at *3-6. Accordingly, the Petition fails to satisfy § 42.104(b)(3)-(4), which “requires that the construction of a claim in a petition be consistent with the unpatentability contentions in a petition.” *ZTE Corp.*, IPR2018-00238, Paper 8 at 8.

- (a) Petitioner’s expert provides conclusory testimony that fails to make the required showing of unpatentability.

As to whether Schoenith’s structures teach “confinement structures” based on Petitioner’s proffered means-plus-function construction, Petitioner’s expert provides a single cursory and conclusory sentence that, even if admitted,⁶ is defective on its face. First, Petitioner’s expert fails to properly examine the “identical function” prong of a means-plus-function analysis. *See Kemco Sales, Inc.*, 208 F.3d at 1364. Specifically, the expert states, “Schoenith’s structures satisfy the confinement structures limitation because they perform the same function, as required under a proper construction of that term.” Ex. 1002, Kitchen Decl., ¶ 115. But no indication

⁶ Patent Owner submits that it should not. Otherwise Petitioner would effectively be granted a free pass to violate the Rules’ explicit requirement to limit IPR Petitions to 14,000 words. *See discussion infra* Section VII.

is given as to what specific “structures” of Schoenith the expert is referring to here.⁷ Moreover, the expert’s statement here is conclusory and does not explain how or why they perform the identical function. *In re Nuvasive, Inc.*, No. 2015-1670 (Fed. Cir. Dec. 7, 2016) (“‘[C]onclusory statements’ alone are insufficient and, instead, the finding must be supported by a ‘reasoned explanation.’”) (quoting *In re Lee*, 277 F.3d 1338, 1342, 1345 (Fed. Cir. 2002)).

Second, as to the structural prong, Petitioner’s expert merely states, “the structure is physically similar to those disclosed in the ’119 Patent—they provide raised structures, like the device cradle in Figures 16 and 19 of the ’119 Patent, that confine the computing device on two sides.” This rudimentary analysis fails to consider whether this “similar”—but not same—structure is an equivalent by analyzing, for example, whether Schoenith’s raised walls perform the function “in substantially the same way, with substantially the same result.” *See Odetics*, 185

⁷ Compounding this issue is that the Petition and the expert’s declaration refer to different structures of Schoenith as purportedly satisfying the claim limitation “confinement structures.” *Compare* Petition at 30 (stating that “cradle’s sides and raised walls” satisfy claim limitation) *with* Ex. 1002, Kitchen Decl., ¶ 114 (stating that “raised walls” alone satisfy the limitation).

F.3d at 1267. Nor does Petitioner's expert opine whether the two structures are "insubstantially different." *Id.*

In sum, Petitioner's expert fails to satisfy its burden of establishing that the alleged structures of Schoenith read on "confinement structures" as so construed by Petitioner. For this reason too, Petitioner fails to satisfy 37 C.F.R. § 42.104(b)(4).

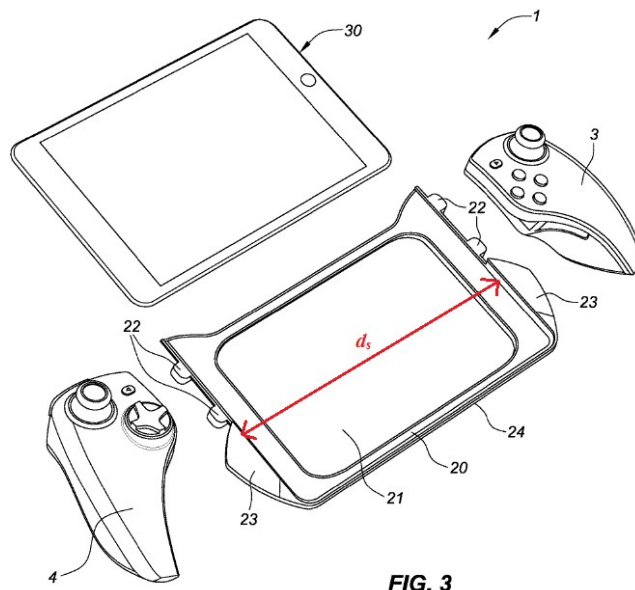
(b) Schoenith's cradle does not perform the identical function nor is it structurally similar to the '119 Patent's two confinement structures 316 shown in FIG. 16.

In addition to Petitioner's own failure to meet its burden described above, Schoenith's cradle's sides and raised walls⁸ 24 are not means-plus-function equivalents to the two confinement structures 316 of FIGS. 16-22 identified by Petitioner in its proposed construction. *See* Petition at 11-12. The cradle's sides and raised walls 24 are **not** structurally "insubstantially different" from the two confinement structures 316 in the '119 Patent. *Kemco Sales, Inc.*, 208 F.3d at 1364. For instance, the cradle's sides and raised walls 24 do not perform the function

⁸ Despite the Petition and Petitioner's expert pointing to non-identical structures as satisfying the claimed "confinement structures" (*see supra* n.7), for purposes of this limitation Patent Owner examines the prior art based on the structures identified by the Petition, namely, the "cradle's sides and raised walls."

identified by Petitioner (“confining the computing device on at least two opposing sides of the plurality of sides of the computing device”) “in substantially the same way, with substantially the same result.” *See Odetics*, 185 F.3d at 1267.

First, with reference to annotated FIG. 3 below, Schoenith’s cradle 20 has dimensions that are specifically sized so as to snugly accommodate a specific computing device for which the cradle 20 was specially designed. Ex. 1003, Schoenith at 6:22-26 (“Preferably, the cradle is substantially planar and has the dimensions corresponding to dimensions of a specific smart device so that the cradle can accommodate the specific smart device. Preferably, the cradle has shape and dimensions so that the smart device fits snugly against the cradle.”). Thus, the distance d_s (shown in FIG. 3 below) between the cradle’s raised walls 24 are ideally spaced so as to snugly receive accommodate the smart device 10.



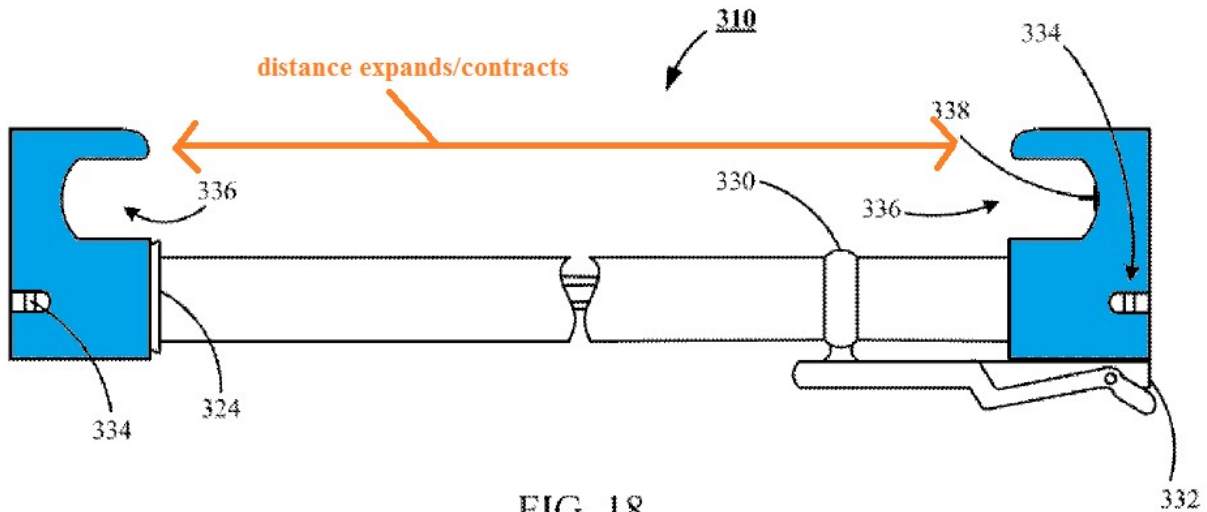
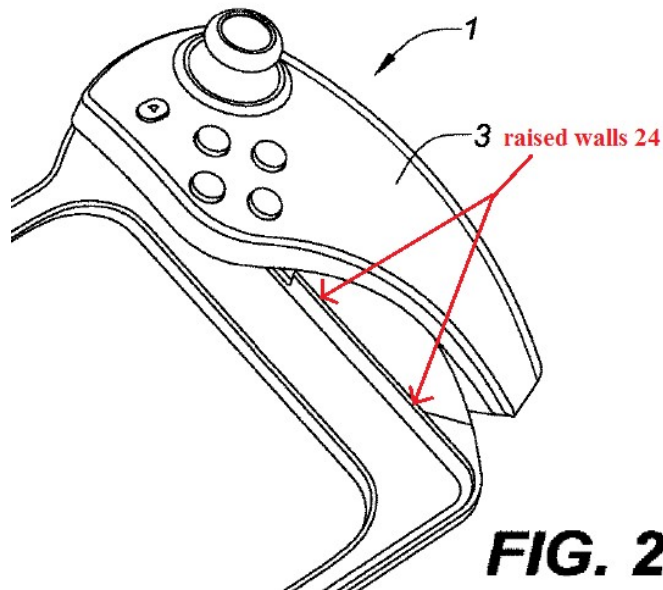


FIG. 18

By contrast, and with reference to annotated FIG. 18 of the '119 Patent above, the two confinement structures 316 confine the computing device on at least two opposing sides of the plurality of sides of the computing device by “[o]peration of the fastening mechanism 320,” which “facilitates an **expand and contract of the distance** between the pair of confinement structures 316.” Ex. 1001 at 8:43-45 (emphasis added). In particular, “[t]he **expansion and contraction** of the distance between the pair of confinement structures 316, **facilitates placement of the computing device 302 between the pair of confinement structures 316**, the application of **sufficient compressive load being placed on the computing device 302 to securely hold the computing device between the pair of confinement structures 316**.” *Id.* at 8:45-51. Schoenith’s cradle’s sides and raised walls 24 do not confine the computing device on opposing sides by expanding and contracting away and toward one another to facilitate placement of the computing device

between the raised walls 24, nor do the raised walls 24 provide sufficient compressive load (by way of a fastening mechanism) to securely hold the computing device between the raised walls 24.

Second, Schoenith's cradle's sides and raised walls 24 do not perform the function identified by Petitioner in substantially the same way as the two confinement structures 316 of the '119 Patent because Schoenith's raised walls are vertical and do not curve around the front surface of the computing device to confine



the computing device on two opposing sides. With reference to a portion of annotated FIG. 2 of Schoenith (left), the raised walls 24 of Schoenith's cradle rise vertically, straight up so that when the computing device is placed on the

cradle 20, the raised walls do not wrap or otherwise curve around the computing device's front surface. *See also* Ex. 1003, Schoenith at FIG. 8.

By contrast, and with reference to annotated FIG. 18 of the '119 Patent below, the two confinement structures 316 are U-shaped and include a curved, front-side portion (labeled 316x) that curves around the front surface of a computing device to confine the computing device on opposing sides and prevents the computing device

from falling out (*e.g.*, the front side). Schoenith's cradle does not have such a feature and thus does not confine the computing device on at least two opposing sides of the computing device in substantially the same way. Notably, as explained below, Schoenith instead relies on the left and right panels (*i.e.*, controllers) to confine the computing device's front surface, which are not part of the cradle 20 and are not cited to by Petitioner as being a structure that performs the alleged function of "confining."

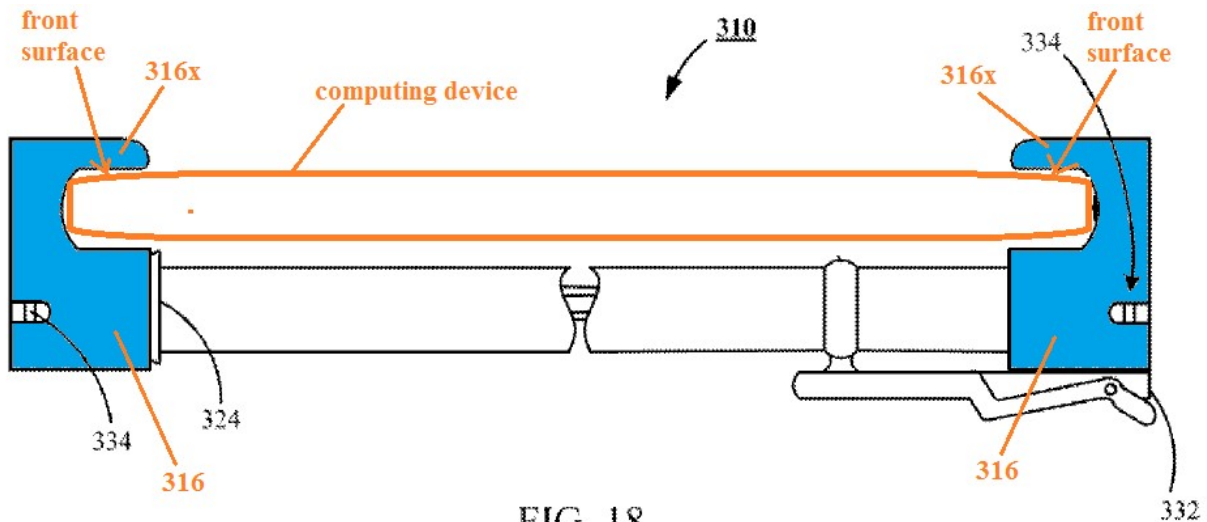
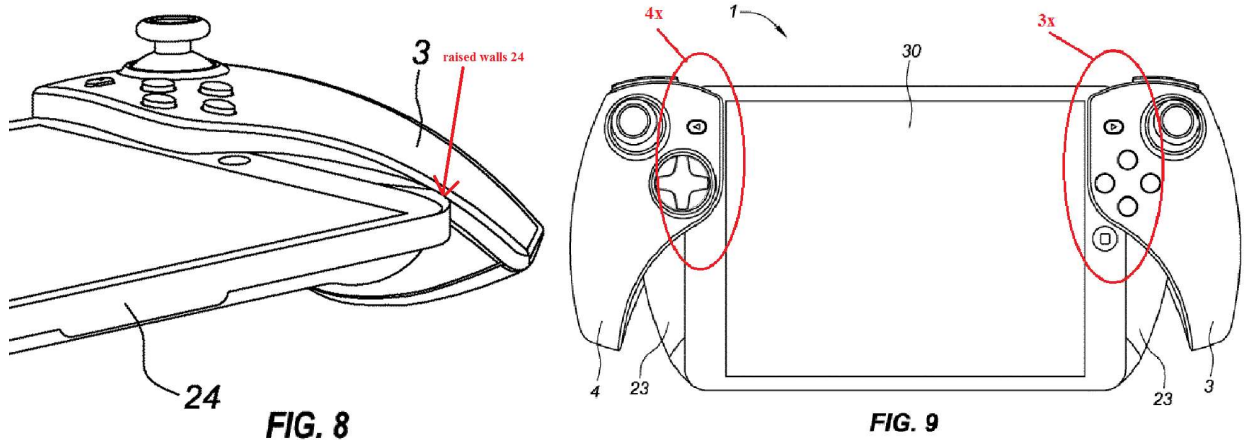


FIG. 18

Third, Schoenith's cradle's sides and raised walls 24 do not perform the function identified by Petitioner with substantially the same result. With reference to annotated FIGS. 8 and 9 of Schoenith below, the raised walls 24 do not curve around the front surface of the computing device (FIG. 8), and instead the left and right panels 3, 4 (*i.e.*, controllers) each include portions 3x, 4x that cover and secure the computing device's front side and prevent the computing device from falling out

face-forward. Thus, even if it were presumed that Schoenith's cradle's sides and raised walls 24 confine the computing device on at least two opposing sides, the **result** is not substantially the same because without the panels 3, 4 secured in place, the computing device may fall out face-forward. By contrast, the two confinement structures 316 of the '119 Patent (see annotated FIG. 18 above) include the curved portions 316x that prevent such a result.



For at least the reasons provided above, Schoenith's cradle's sides and raised walls 24 do not perform the function identified by Petitioner in substantially the same way, with substantially the same result. Consequently, Petitioner fails to satisfy 37 C.F.R. § 42.104(b)(3)-(4) in showing how the cited art render the claims unpatentable as construed by Petitioner.

2. Ground 2: Schoenith + Park

For Ground 2, Petitioner again relies exclusively on Schoenith as teaching the claimed "confinement structures" by referring to its analysis in Ground 1. Petition

at 50. Thus, for the same reasons presented above, Petitioner’s analysis of “confinement structures” is defective and fails to satisfy 37 C.F.R. § 42.104(b)(3)-(4). *See* discussion *supra* Section VI.A.1.

3. Ground 3: Michael + Park

For Ground 3, Petitioner relies on Michael and Park as allegedly teaching the claimed “confinement structures.” Petition at 63-64. Specifically, Petitioner contends that Michael’s docking device includes “sidewalls 20 and rubber grips in its corners to secure, confine, the portable computing device.” *Id.* at 63. What is absent from the Petition’s single-sentence discussion concerning this limitation, however, is an analysis consistent with a means-plus-function claim construction, such as an examination into whether the docking device’s sidewalls 20 and rubber grips 2 perform the “identical” alleged function (“confining the computing device on at least two opposing sides of the plurality of sides of the computing device”) and whether these components are “insubstantially different,” structurally, from the ’119 Patent’s two confinement structures 316 or equivalents thereof. *See Kemco Sales, Inc.*, 208 F.3d at 1364; Petition at 10-12. Petitioner’s contention that Park too discloses “confinement structures” is even more egregious because it summarily states, “Park disclosed a similar game controller in which the two controller modules were explicitly connected via an electrical cable running through the bridge, and so also disclosed...a pair of confinement structures, as claimed.” *Id.* at 64. Here, again,

Petitioner provides absolutely no analysis concerning whether Park's game controller, including its two controller modules, perform the identical alleged function as the claimed "confinement structures," and whether these components are structurally similar to the '119 Patent's two confinement structures 316.

Petitioner and its expert fail to apply their construction and instead analyze the claim limitation using a different, unidentified construction that is inconsistent with and significantly broader than its proffered means-plus-function construction. And, as in *Infinera Corp.*, these unidentified, inconsistent constructions prejudice Patent owner by failing to give Patent Owner notice as to Petitioner's basis for the challenge and shift the Petitioner's obligations under 37 C.F.R. § 42.104(b)(3)-(4) to Patent Owner and/or the Board. 77 Fed. Reg. 48680, 48688 (third col., first full para.); *Infinera Corp.*, IPR2018-01259, Paper 9 at *3-6. Accordingly, Petitioner fails to satisfy § 42.104(b)(3)-(4), which "requires that the construction of a claim in a petition be consistent with the unpatentability contentions in a petition." *ZTE Corp.*, IPR2018-00238, Paper 8 at 8.

- (a) Michael's sidewalls 20 and rubber grips 2 do not perform the identical function nor are they structurally similar to the '119 Patent's two confinement structures 316 shown in FIG. 16.

In addition to Petitioner's failure to meet its burden under 37 C.F.R. § 42.104(b)(3)-(4) described above, Michael's sidewalls 20 and rubber grips 2 are not means-plus-function equivalents to the two confinement structures 316 of FIGS. 16-22 identified by Petitioner in its proposed construction. *See* Petition at 11-12. The structure of the docking device's sidewalls 20 and rubber grips 2 are *not* "insubstantially different" from the two confinement structures 316 in the '119 Patent. *Kemco Sales, Inc.*, 208 F.3d at 1364. For instance, as shown in annotated FIG. 16 below, the pair of confinement structures 316 of the '119 Patent are just that: *a pair* of structures that are separate and apart from one another.

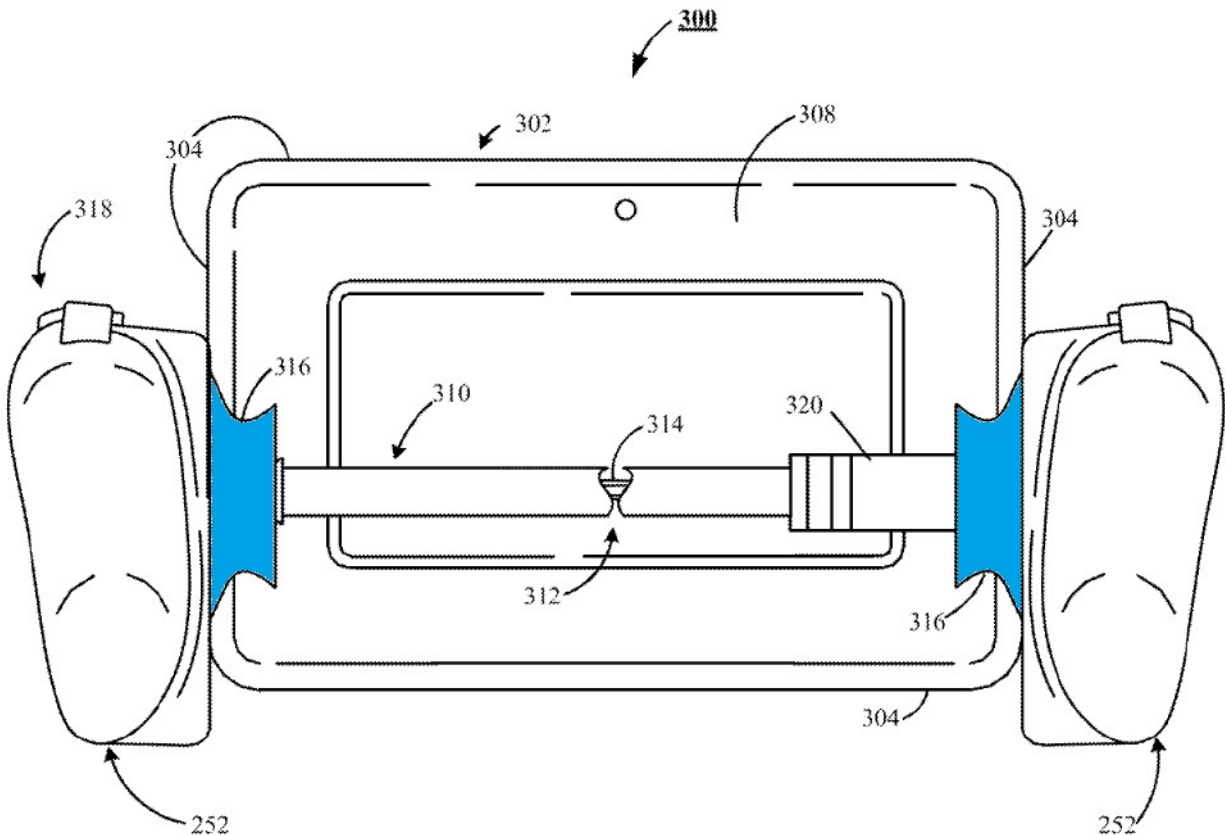
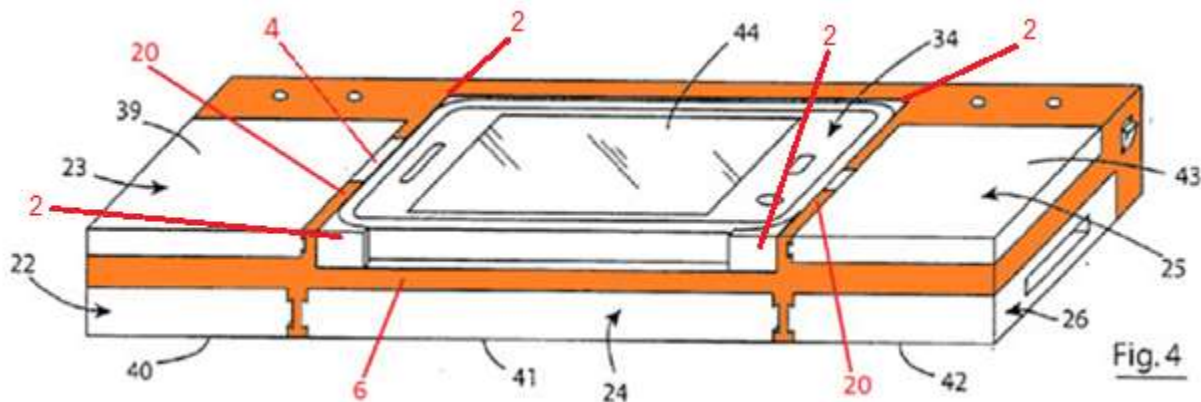


FIG. 16

By contrast, the sidewalls 20 of Michael shown in annotated FIG. 4 below are part of the docking station's frame 6 and thus form a single, unitary piece—not a distinct pair. Besides this significant structural difference between Michael's sidewalls 20 and the pair of confinement structures in the '119 Patent, the sidewalls 20 do not perform Petitioner's recited function of confining the computing device on at least two opposing side as Petitioner alleges. Instead, Michael's rubber grips 2, acting in concert with a swiveling connector 4 (not identified by Petitioner as a confinement structure), secure the electronic device. Ex. 1015, Michael at [0125], [0136] (“The first compartment 1 is substantially rectangular and has at each corner

thereof rubber grips 2 arranged to secure the docked personal device within the docking station...the first compartment is further provided with an adjustable connector 4 which may be functionally attached for anchoring the personal device within the docking station.”). By contrast, the two confinement structures 316 of the ’119 Patent undisputable press against and confine the computing device on two opposing sides. Thus, for purposes of Petitioner’s § 112(f) claim construction, Michael’s sidewalls 20 and rubber grips 2 together are not structurally or functionally the same as the confinement structures 316 of the ’119 Patent.



Moreover, Michael’s sidewalls 20 and rubber grips 2 (shown above) are not means-plus-function equivalents to the confinement structures 316 of FIGS. 16-22 identified by Petitioner. For instance, the sidewalls 20 and rubber grips 2 do not perform the function identified by Petitioner (“confining the computing device on at least two opposing sides of the plurality of sides of the computing device”) “in substantially the same way, with substantially the same result.” *See Odetics*, 185 F.3d at 1267. In order for Michael’s rubber grips 2 to secure the electronic device

to the docking device, the rubber grips 2 must elastically deform to accommodate and press against the electronic device's corners when the electronic device is placed into the docking device's first compartment 1. *See* Ex. 1015, Michael at ¶ 125. By contrast, the two confinement structures 316 receive and confine the computing device on at least two opposing sides of the plurality of sides of the computing device by “[o]peration of the fastening mechanism 320,” which “facilitates an **expand and contract of the distance** between the pair of confinement structures 316.” Ex. 1001 at 8:43-45 (emphasis added). The distances between Michael's rubber grips 2 (or its sidewalls 20) do not change and instead they remain fixed in place when receiving and securing the electronic device. *See, e.g.*, Ex. 1015, Michael at ¶¶ 125-131, FIGS. 1-5. Thus, even if it were assumed that Michael's sidewalls 20 and rubber grips 2 performed the same function as the two confinement structures 316 of the '119 Patent, the two utilize substantially different ways (*e.g.*, fixed components providing elastic deformation and elastic force vs. moveable confinement structures that expand and contract to receive and secure a device) of performing the function.

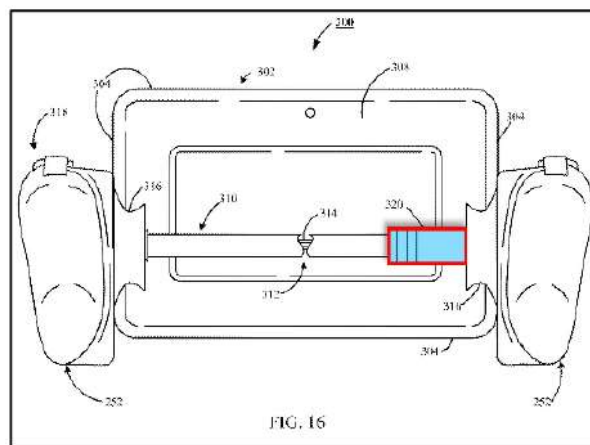
For at least the reasons provided above, Michael's sidewalls and rubber grips do not perform the same function as the confinement structures 316 of FIGS. 16-22 of the '119 Patent nor are their insubstantial differences between their structures. In addition to the fact that Petitioner fails to even point to any specific structure(s) of Park as being the claimed “confinement structures,” Park does not disclose features

that perform the alleged function and are insubstantially different structurally from the pair of confinement structures 316. Consequently, Petitioner fails to satisfy 37 C.F.R. § 42.104(b)(3)-(4) in showing how Michael and/or Park render the claims unpatentable as those claims are construed by Petitioner.

B. “Fastening Mechanism”

Petitioner provides, in part, the following construction for the term “fastening mechanism”:

[W]hile the phrase [fastening mechanism] does not use the term “means,” it is a means-plus-function limitation because it merely recites function with no structure...As claimed, the function of the *fastening mechanism* is “cooperating with and securing the pair of confinement structures one to the other.” The only



structure disclosed for *fastening mechanism* is the fastening mechanism 320, taught in Figures 16-18, 21, and 24-25. That component is shown in annotated Figure 16 ([above]).

Petition at 15. Thus, Petitioner proposes that “fastening mechanism” should be construed as a means-plus-function term whose function is “cooperating with and

securing the pair of confinement structures one to the other,” and its structure is limited to the soft draw latch 320 shown and described in FIGS. 16-18, 21, and 24-25. As explained in greater detail below, Petitioner fails to properly apply its proposed construction when determining “[h]ow the *construed* claim is unpatentable” in view of the prior art cited. 37 C.F.R. § 42.104(b)(4).

1. Ground 1: Schoenith + Kessler

Petitioner relies on the combination of Schoenith and Kessler as teaching the claimed “fastening mechanism.” Petition at 35-36. Admitting that “Schoenith and Kessler do not explicitly teach a fastening mechanism under Nintendo’s proposed construction,” Petitioner contends that:

[A] POSITA would have found it obvious to include a *fastening mechanism that cooperat[es] with and secures the pair of confinement structures one to the other*. Kessler taught that its extension mechanism, or bridge, contained slats that slide together via overlapping tongue/groove connections. Ex. 1005 ¶¶90-91. While Kessler did not expressly describe how its extension mechanism was fastened together, **a POSITA would have understood that such a mechanism *would be* fastened together, including by using a latch-type structure or another equivalent, as known in the art.**

Id. (emphasis in bold added). Thus, Petitioner admits that its proposed combination of Schoenith and Kessler fails to explicitly teach the soft draw latch identified in its means-plus-function construction, but that incorporating such a latch or its equivalent into Kessler to fasten Kessler's slats⁹ together would be obvious to a POSITA. Petitioner does nothing but pay its proffered construction lip service. Its purported analysis of how and why the cited art would be modified to include a soft draw latch is on its face grossly conclusory and lacks merit. Petitioner fails to satisfy its burden under § 42.104(b)(3)-(4) to show how the *construed* claim is unpatentable.

⁹ The Decision states, "For satisfying the claimed 'fastening mechanism,' Nintendo **points to Kessler's provision of an 'extension mechanism'** between two game control modules, which is adjustable 'via overlapping tongue/groove connections' to fit different-sized smart phones." Decision (Paper 7) at 7 (emphasis added). To the extent the Board believes Kessler's entire extension mechanism is Petitioner's alleged "fastening mechanism," Patent Owner respectfully disagrees. Petitioner expressly states that the extension mechanism is the claimed "structural bridge" and that the claimed "fastening mechanism" would be "a latch-like structure or equivalent" that is "add[ed]" to the "adjustable structural bridge." *See* Petition at 35-36.

The figure below shows a side-by-side comparison of Kessler's extension member 82 having telescoping slats 86, 88, 90, 92, 94 (left) and the soft draw latch 320 of the '119 Patent (right). Ex. 1005, Kessler at FIG. 13; Ex. 1001 at FIG. 24.

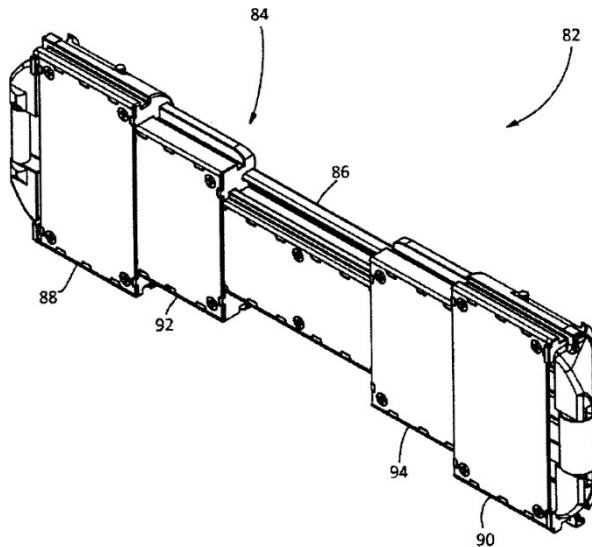


Figure 13

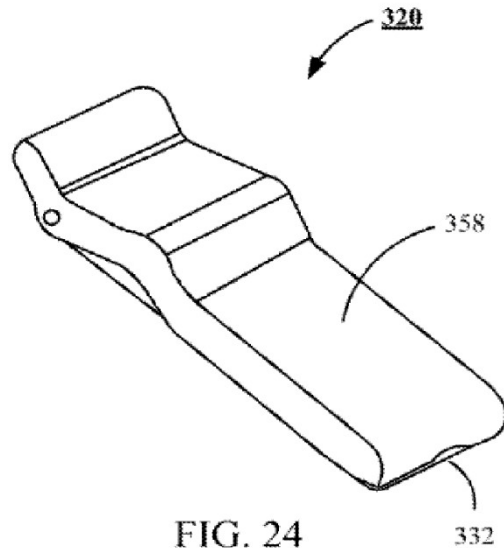


FIG. 24

Petitioner and its expert fail to offer even a modicum of reasoning to support their incredible argument that a POSITA would somehow be able to—or desire to—modify Kessler's telescoping slats 86, 88, 90, 92, 94 on the left with the soft draw latch 320 on the right so that the slats 86, 88, 90, 92, 94 are coupled together. Indeed, no explanation is provided as to where on the slats 86, 88, 90, 92, 94 the latch could be placed and what function it would serve. Kessler's telescoping slats are slideably coupled to one another so that the central slat 86 retracts within the secondary slats 92, 94, which retract within the primary slats 88, 90, which in turn ultimately retract into the left and right controller housings 12, 14, thereby advantageously allowing the game controller 10 to be more portable. *See* Ex. 1005, Kessler at [4],

[22]-[25], [83]-[91], FIG. 1, 8-10, 13. Randomly tacking on a latch somewhere on the extension mechanism defeats Kessler's goal of providing a space-efficient, portable gaming controller. *Id.*

Petitioner's failure to even attempt to explain how and why such a modification to Kessler would be made supports a finding that Petitioner failed to satisfy its burden under § 42.104(b)(3)-(4).

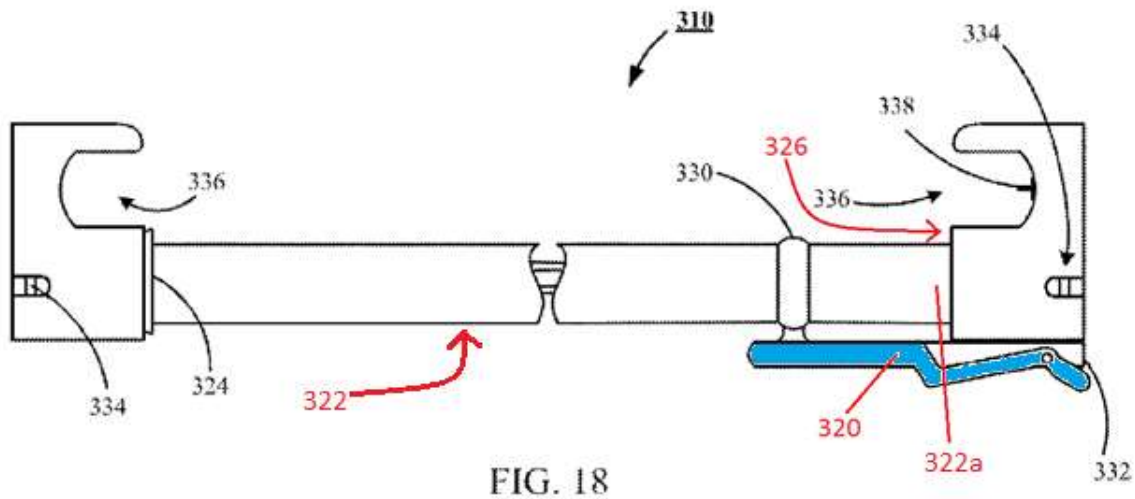
2. Grounds 2 and 3: Schoenith + Park; Michael + Park

For Grounds 2 and 3, Petitioner argues that Park's "use of recessed guide grooves 32a and a plurality of recessed catching holes 32b" that "accommodate[] protrusions 42" (collectively "groove-hole-protrusion mechanism") constitute the claimed "fastening mechanism." *See* Petition at 53-54, 67-68. Here, again, Petitioner only makes a passing reference to its proffered construction, stating that the groove-hole-protrusion mechanism "is equivalent to the structure disclosed in the '119 patent." *Id.* at 53, 68. This conclusory statement fails to provide any meaningful analysis consistent with a means-plus-function claim construction. For instance, Petitioner does not examine whether the groove-hole-protrusion mechanism is "insubstantially different," structurally, from the '119 Patent's soft draw latch 320 or equivalents thereof. *See Kemco Sales, Inc.*, 208 F.3d at 1364. Similarly, Petitioner fails to consider whether the groove-hole-protrusion mechanism performs the alleged function "in substantially the same way, with

substantially the same result.” *See Odetics*, 185 F.3d at 1267. Accordingly, the Petition fails to satisfy § 42.104(b)(3)-(4), which “requires that the construction of a claim in a petition be consistent with the unpatentability contentions in a petition.” *ZTE Corp.*, IPR2018-00238, Paper 8 at 8.

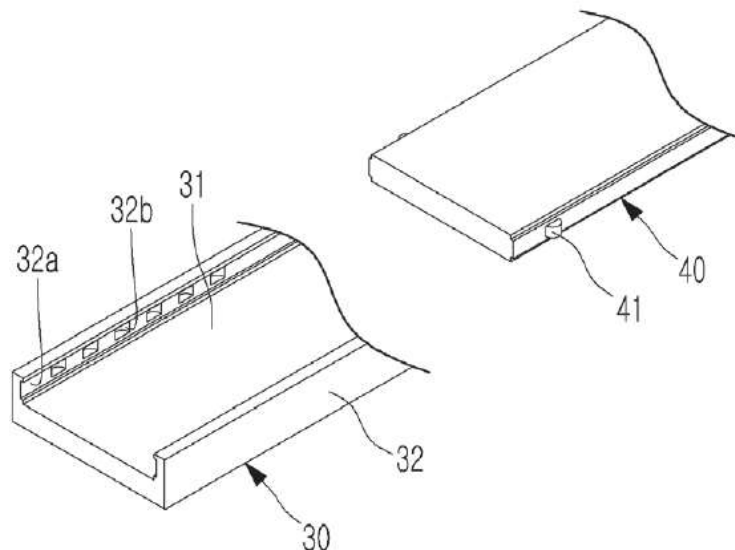
- (a) Park’s groove-hole-protrusion mechanism does not perform the identical function nor is it structurally similar to the ’119 Patent’s soft draw latch.

In addition to Petitioner’s failure to meet this burden, Park’s groove-hole-protrusion mechanism and its panels 30, 40 are structurally and functionally different than the soft draw latch 320 identified in Petitioner’s proposed claim constructions. Annotated FIG. 18 of the ’119 Patent below illustrates the soft draw latch 320 (colored blue) and shows how, in this non-limiting embodiment, the soft draw latch 320 is attached by way of an anchor member 330, and engages with an attachment member 332 adjacent to a slip fit 326 so that operation of the soft draw latch 320 to expand and contract the distance between the pair of confinement structures 316 causes an end 322a of the structural bridge 322 to effectuate the slip fit 326 with the confinement structure 316.



By contrast, the groove-hole-protrusion mechanism 32a, 32b, 41 and accompanying panels 30, 40 of Park, shown below, are structurally very different than the soft draw latch 320 and slip fit 326 shown and discussed above. In particular, Park's groove-hole-protrusion mechanism 32a, 32b, 41 and accompanying panels 30, 40 do not include a similar latch-type mechanism or feature a slip fit design that fits into a confinement structure.

Fig 2



For this reason, Park fails to disclose a “fastening mechanism secures the pair of confinement structures one to the other” as that limitation is construed by Petitioner. Additionally, the groove-hole-protrusion mechanism of Park operates in a substantially *different way*. Namely, Park’s groove-hole-protrusion mechanism operates in a lock-step, progressive fashion where protrusions 41 at the end of one of the panels engages with a series of catching holes 32b on the other panel along the length of the latter panel’s guide grooves 32a. By contrast, the soft draw latch 320 operates by expanding and contracting the distance between the pair of confinement structures 316 to cause an end 322a of the structural bridge 322 to effectuate the slip fit 326 with the confinement structure 316. This difference in the way the two structures perform their respective functions also supports the conclusion that Park’s structures are not a means-plus-function equivalent to the claimed fastening mechanism.

VII. PETITIONER’S CITATION TO ARGUMENTS AND INFORMATION APPEARING ONLY IN PETITIONER’S 421 PAGE EXPERT DECLARATION CIRCUMVENTS WORD COUNT LIMITS AND SHOULD NOT BE CONSIDERED

An *inter partes* review petition must include a “full statement of the reasons for the relief requested, including a detailed explanation of the significance of the evidence including material facts, and the governing law, rules, and precedent.” 37 C.F.R. § 42.22(a)(2). The petition is also subject to word count limits. 37 C.F.R. § 42.24(a)(1)(i) (setting a 14,000 word limit on *inter partes* review petitions).

Information presented in a supporting declaration that is not sufficiently discussed in the petition should not be considered by the Board because “doing so would permit the use of declarations to circumvent the page limits that apply to petitions.” *Fidelity National Information Services, Inc. v. Datatrans Corp.*, Case No. IPR2014-00491, Paper 9 at 8 (August 13, 1994); *Conopco, Inc. dba Unilever v. The Procter & Gamble Company*, Case No. IPR2013-00510, Paper 9 at 8 (Board declining to consider information presented in a single paragraph of an expert declaration that was not discussed in the petition because “doing so would encourage the use of declarations to circumvent the page limits that apply to petitions.”); *Fujian Newland Computer Co., Ltd. v. Hand Held Products, Inc.*, Case No. IPR2013-00595, Paper 28 at 2 (“The Board may not consider arguments contained only in a declaration and not presented specifically within the response itself.”).

At 13,959 words (*see* Petition at 77), the Petition here is just under the 14,000 word limit for IPR petitions. But, Petitioner liberally supplements its Petition with references to significant portions of a 761-paragraph, 421-page declaration, including appendices, from its expert Garry Kitchen. *See* Ex. 1002 (“Kitchen’s declaration”). As discussed in greater detail below, Kitchen’s declaration includes scores of pages (and thousands of words) of substantive arguments, annotated drawings, and other information not appearing in the Petition. Some non-limiting,

non-exclusive examples of information found in Kitchen's declaration that are cited in the Petition, but not discussed or presented in the Petition, include:

- Kitchen decl. ¶¶ 113-115, cited to by the Petition at page 30 for its contention that Schoenith/Kessler and Schoenith/Park teach a “pair of confinement structures,” including information concerning Schoenith not discussed by the Petition;
- Kitchen decl. ¶¶ 150-157, cited to by the Petition at page 36 for its contention that Schoenith/Kessler teach a “fastening mechanism,” including information concerning Kessler not discussed by the Petition;
- Kitchen decl. ¶¶ 250-260, cited to by the Petition at page 53 for its contention that Schoenith/Park teach a “conduit between the pair of control modules,” including information concerning Schoenith and Park not discussed by the Petition;
- Kitchen decl. ¶¶ 264-270, cited to by the Petition at page 53 for its contention that Schoenith/Park teach a “fastening mechanism,” including information concerning Park not discussed by the Petition;
and
- Kitchen decl. ¶¶ 381-389, 394-397, cited to by the Petition at page 68 for its contention that Michael/Park teach a “fastening mechanism,”

including information concerning Michael and Park not discussed by the Petition.

The Board should disregard the additional argument, annotations and information appearing only in Kitchen's declaration because allowing Petitioner to incorporate by reference this information into the Petition unfairly allows Petitioner to circumvent a word count limit explicitly mandated by statute.

VIII. THE PETITION FAILS TO DEMONSTRATE UNPATENTABILITY OF ANY CHALLENGED CLAIM BASED ON SCHOENITH AND KESSLER (GROUND 1)

Petitioner fails to demonstrate the unpatentability of any Challenged Claim over Schoenith in view of Kessler by a preponderance of the evidence. 35 U.S.C. § 316(e). As reiterated by the Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007), the framework for the objective analysis for determining obviousness under 35 U.S.C. § 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). Determining obviousness is a question of law based on underlying factual inquiries that include: (1) determining the scope and content of the prior art; (2) ascertaining the differences between the claimed invention and the prior art; and (3) resolving the level of ordinary skill in the pertinent art. *Graham*, 383 U.S. at 17-18. Having discussed the scope of the prior art and the level of ordinary skill in the pertinent art above, the analysis below

demonstrates that there are substantial differences between the claimed invention and Schoenith in view of Kessler that merit denial of Ground 1.

A. Schoenith and Kessler Fail to Disclose a Fastening Mechanism That Cooperates With and Secures a Pair of Confinement Structures

Schoenith alone or in combination with Kessler fails to disclose the claim limitation, “a fastening mechanism cooperating with the pair of confinement structures, the fastening mechanism secures the pair of confinement structures one to the other” of claim 1. Petitioner contends that not only would a POSITA modify Schoenith’s fixed, raised wall 24 with Kessler’s telescoping slide mechanism 84, but that one would be motivated to do so by incorporating and modifying Kessler’s telescoping slide mechanism 84 with a “latch-like structure or equivalent,” even though such a structure is not recited by Schoenith or Kessler.

“In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3)) (requiring *inter partes* review petitions to identify “with particularity...the evidence that supports the grounds for the challenge to each claim”). Petitioner cannot satisfy its burden of proving obviousness by employing “mere conclusory statements.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016); *see also In re Nuvasive, Inc.*, No. 2015-1670 (Fed. Cir. Dec. 7,

2016) (“First, ‘conclusory statements’ alone are insufficient and, instead, the finding must be supported by a ‘reasoned explanation.’”) (quoting *In re Lee*, 277 F.3d 1338, 1342, 1345 (Fed. Cir. 2002)).

Here, the Petition provides no reasoned explanation as to *why* or *how* a POSITA would be motivated to incorporate and modify Kessler’s telescoping slide mechanism 84 (or the combination of Schoenith’s cradle/raised wall 24 as modified by Kessler’s slide mechanism 84) with “a latch-type structure or another equivalent.” Instead, the Petition makes a conclusory statement that doing so would be obvious “[i]n light of these disclosures and the knowledge of a POSITA.” *See* Petition at 36. Consequently, Petitioner fails to meet its burden of showing with particularity why or how a POSITA would make its alleged modifications of the cited art, and its failure to do so counsels for denial of Ground 1. *See Harmonic Inc.*, 815 F.3d at 1363.

Petitioner also cites several paragraphs from Kitchen’s declaration in support of its contention that a POSITA would modify Schoenith and Kessler to include a latch-like structure, but this, too, fails to remedy the deficiencies of the Petition. Petition at 36 (citing Ex. 1002, Kitchen at ¶¶149, 154-157). First, as discussed above (*see supra* Section VII), arguments appearing only in Kitchen’s declaration, and not found in the Petition, should be disregarded. Such arguments include those found in ¶¶154-157 of Kitchen’s declaration. Second, even if considered, these arguments

do not address why or how a POSITA would modify the cited art to **specifically include a latch-like structure** as proposed by the Petitioner, and instead are directed at generally arguing a different point; that is, why Schoenith's cradle would purportedly benefit from Kessler's slide mechanism 84. Again, Petitioner fails to provide sufficient evidence or reasoning as to why or how a POSITA would modify Schoenith and/or Kessler to include a latch-type structure or equivalent in support of Petitioner's proposed claim construction.

Petitioner also argues that "Kessler's tongue and groove mechanism would satisfy this limitation" because "Gamevice pointed to screws as fastening mechanisms" in a suit filed in the Central District of California. *See* Petition at 36 (citing Ex. 1009 at 11). Even assuming, *arguendo*, that screws satisfy the limitation "a fastening mechanism cooperating with the pair of confinement structures, the fastening mechanism secures the pair of confinement structures one to the other," there is a gap in Petitioner's argument, as Kessler's telescoping slide mechanism 84 (*i.e.*, tongue and groove mechanism) does not include screws (explicitly or implicitly), nor does Petitioner explain what feature(s) of Kessler constitutes a screw or is equivalent to a screw.

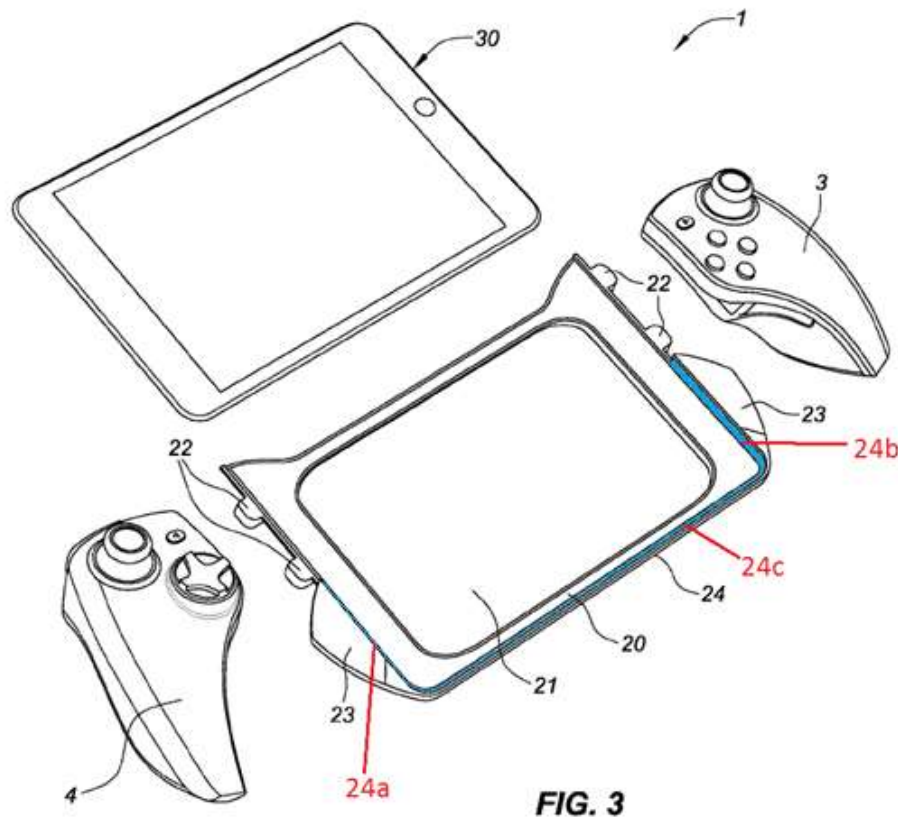
Moreover, further assuming Kessler's tongue and groove mechanism is equivalent to a screw, the tongue and groove mechanism does not secure a pair of confinement structures one to the other as required by the claim. Instead, it secures

Kessler's slats 86-92 to one another. Notably, the extension mechanism itself is not secured to the sides 12a, 14a of Kessler's controllers (See FIG. 10 of Kessler) and is instead secured to internal components deep within the left and right controller housings 12, 14 that allow it to retract into the housings 12, 14 when the controller 10 is in a closed state. In particular, the two primary slide members 98c (see FIG. 17 of Kessler) include elongate grooves 111 that engage complementary tongue structures within the housings 12, 14 so that both primary slide members 98c can slide into and be wholly stored within the housings 12, 14. *See* Ex. 1005, Kessler at [0086], [0090], [0091] (“[E]ach of the primary slide members 98c has elongate grooves 111 formed in its outermost facing walls which, in use, engage complementary tongue structures formed within the respective handle housings 12, 14 such that the slide mechanism can be substantially or wholly accommodated within the two handle housings 12, 14.”). Since Kessler's telescoping slide mechanism (and its corresponding tongue and groove mechanism used for retraction) does not couple to the controllers' sides 12a, 14a, Petitioner's arguments that the tongue and groove mechanism would secure Schoenith's raised walls (alleged confinement structures) “one to the other” fails.

1. *A POSITA would not be motivated to combine Schoenith with Kessler to obtain the claimed fastening mechanism.*

A person of ordinary skill in the art would not be motivated to combine Schoenith with Kessler to obtain the claimed “fastening mechanism” for a number

of reasons. First, modifying Schoenith's cradle with Kessler's telescoping slide mechanism 84 is anything but straightforward or obvious to a POSITA. As shown in annotated FIG. 3 below, Schoenith's raised wall 24 (colored blue) has a left side portion 24a and a right side portion 24b.



Petitioner argues that the alleged confinement structures of Schoenith, namely its raised walls 24 (*e.g.*, left and right portions 24a and 24b above), would be modified by Kessler to extend and retract away from each other using Kessler's extension mechanism. *See* Petition 35-36. However, a POSITA would be hard pressed to implement such a modification to Schoenith because Kessler's extension mechanism

does not couple to a controllers' sides and is instead secured to components inside the controllers' housings. *See* discussion *supra* Section VIII.A.

B. Petitioner Fails to Show That Schoenith Discloses an Input Device in Communication with a Communication Port

Petitioner contends that Schoenith's right and left side panels 3, 4 are the claimed pair of control modules that are attached to the cradle 20, which purportedly is the claimed communication port. Petition at 32. Petitioner further argues, "Those control panels [3, 4]... could communicate with the smart device or the cradle (the *communication port*) via wired or wireless connection." *Id.* (citing Ex. 1003, Schoenith at 7:35-47).

However, Schoenith only discusses how a wireless communication protocol, such as Bluetooth®, may be used for exchanging data between the smart device 30 on one hand and at least one of the right side panel 3, left side panel 4, the chassis 2, and/or the cradle 20 on the other hand. *See* Ex. 1003, Schoenith at 7:35-41 ("[T]he controller may include at least one wireless connection, such as Bluetooth® or infrared light-emitting diodes (LEDs) for exchanging data between *the smart device and* the controller in the right side panel, left side panel, the chassis, the cradle, or a combination thereof.") (emphasis added). The phrase "or a combination thereof" modifies the list of items ("right side panel, left side panel, the chassis, the cradle") that appear after "the smart device and," which is the first party to the communication. Thus, Schoenith discusses how the smart device 30, on the one

hand, may wirelessly communicate with either the controller in the right side panel 3, the left side panel 4, the chassis 2, the cradle 20; or communicate with two or more of these four devices.

Similarly, column 7, lines 42-47 reveals that Schoenith only discusses how a wired connection, such as a 30-pin dock or Apple Lightning® connector, that “connect[s] a smart device to a host device” may be used for communication between the smart device 30 on one hand and at least one of the right side panel 3, left side panel 4, and/or the cradle 20 on the other hand. *See* Ex. 1003, Schoenith (“[T]he controller may include at least one power connector to provide a wired connection between *the smart device and* the controller in the right side panel, left side panel, the cradle, or a combination thereof.”) (emphasis added). The phrase “or a combination thereof” modifies the list of items (“right side panel, left side panel, the cradle”) that appear after “the smart device and.” Thus, Schoenith discusses how the smart device 30, on the one hand, may communicate via a wire with either the controller in the right side panel 3, the left side panel 4, the cradle 20; or communicate with two or more of these three devices.

What Schoenith does not disclose, however, is that left or right side panels 3, 4 can wirelessly or via wire communicate *with the cradle 20*. The present claims require that the input device be “attached to and in electronic communication with the communication port.” The structure in Schoenith that Petitioner identifies as

being the claimed input device—namely, the left and right side panels 3, 4—are not described as being in electronic communication (wirelessly or via wire) with the cradle 20, which Petitioner identified as being the claimed communication port. *See* Petition at 30.

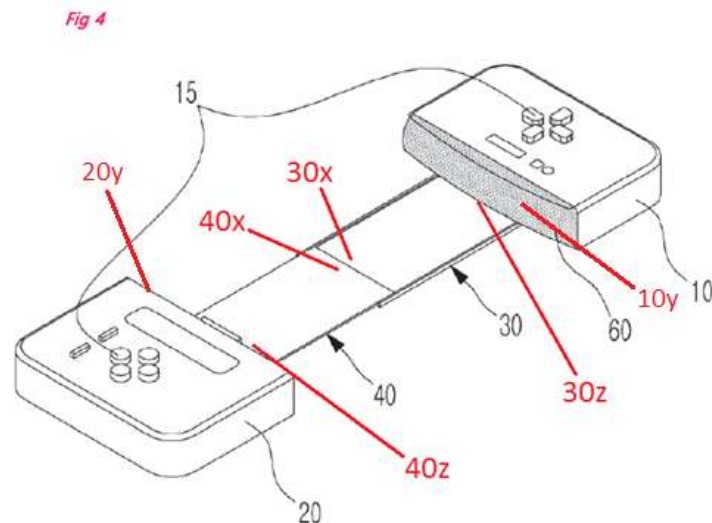
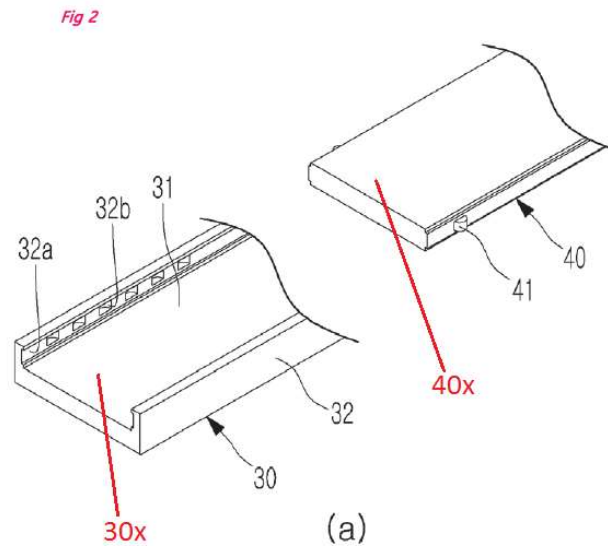
Since Petitioner relies exclusively on Schoenith as purportedly teaching this limitation, the Petition fails to establish that the aforementioned claim feature is disclosed and Ground 1 must be denied. For at least the reasons presented above, Petitioner fails to establish that claim 1 is obvious over Schoenith in view of Kessler (Ground 1).

IX. THE PETITION FAILS TO DEMONSTRATE UNPATENTABILITY OF ANY CHALLENGED CLAIM BASED ON SCHOENITH AND PARK (GROUND 2)

Petitioner fails to demonstrate the unpatentability of any Challenged Claim over Schoenith in view of Park by a preponderance of the evidence. 35 U.S.C. § 316(e). Having discussed the scope of the prior art and the level of ordinary skill in the pertinent art above, the analysis below according to *Graham* demonstrates that there are substantial differences between the claimed invention and Schoenith in view of Park that counsel denial of Ground 2.

A. Schoenith and Park Fail to Disclose a Fastening Mechanism That Cooperates With and Secures a Pair of Confinement Structures

Schoenith alone or in combination with Park fails to disclose the claim limitation, “a fastening mechanism cooperating with the pair of confinement structures, the fastening mechanism secures the pair of confinement structures one to the other” of claim 1. First, Petitioner argues that Park’s recessed guide grooves 32a having recessed catching holes 32b that accommodate the corresponding protrusions 41 (shown in annotated FIG. 2 of Park, below) constitute the claimed “fastening mechanism” and are structurally “equivalent to the structure disclosed in the ’119 patent.” Petition at 53. Park’s groove-hole-protrusion mechanism, however, does not secure *a pair of confinement structures one to the other* as required by the claims. Instead, as shown in FIGS. 2 and 4 below, the groove-hole-protrusion mechanism of Park secures the inner end (annotated as 30x) of the first panel 30 to the inner end (annotated as 40x) of the second panel 40. In other words, it secures one part of the purported structural bridge to another part of the structural bridge.



Notably, Park's groove-hole-protrusion mechanism is not responsible for securing the first and second panels' outer ends (annotated as 30z, 40z in figures above) to the controller's sidewalls (annotated as 10y, 20y), which Petitioner contends are Park's disclosed confinement structures. Indeed, Petitioner does not identify any fastening mechanism in Park that secures the first and second panels' outer ends 30x, 40x to Park's controllers' sidewalls 10y, 20y. Nor does Petitioner explain how

Park's groove-hole-protrusion mechanism would secure to Schoenith's raised wall 24. At best, the groove-hole-protrusion mechanism of Park merely secures inner/interior ends of panels to each other, and does not secure a pair of confinement structures to each other. Consequently, Petitioner fails to establish that Park teaches or discloses a "fastening mechanism secures the pair of confinement structures one to the other," which alone merits denial of Ground 2.

B. Petitioner Fails to Show That a Person of Ordinary Skill in the Art Would be Motivated to Combine Schoenith with Park to Obtain a Structural Bridge Having a Conduit Between a Pair of Control Modules.

Petitioner alleges that Schoenith in combination with Park teaches "the structural bridge comprising: a conduit between the pair of control modules." Petition at 52-53. Specifically, the Petition states:

Park taught that its bridge contained a confined space inside, through which the electrical connection means ran. In light of that disclosure and a POSITA's knowledge, the use of a *conduit between the pair of control modules* was obvious. Ex. 1004 ¶¶8, 13, 26, 36. That *conduit* would have run *between the pair of control modules*, which both Schoenith and Park taught on the left and right sides. Kitchen ¶¶248-60.

Petition at 52-53.

However, as outlined in *In re Magnum Oil Tools Int'l, Ltd.*, Petitioner cannot satisfy its burden of proving obviousness by employing "mere conclusory

statements.” 829 F.3d at 1380; *see also In re Nuvasive, Inc.*, No. 2015-1670 (“First, ‘conclusory statements’ alone are insufficient and, instead, the finding must be supported by a ‘reasoned explanation.’”) (quoting *In re Lee*, 277 F.3d 1338, 1342, 1345 (Fed. Cir. 2002))). Here, the Petition provides absolutely no reasoning as to how or why a POSITA would be motivated to modify Schoenith’s cradle with Park’s electrical connection means (*i.e.*, Park’s “connecting cable”). Instead, the Petition merely identifies that Park’s panels include the connecting cable and then summarily concludes, without more, that modifying Schoenith based on Park “was obvious.” *See* Petition at 52-53. Moreover, the information provided in the cited portions of Kitchen’s declaration, in particular ¶¶250-260, cannot be found in the Petition (*see* Petition at 52-53), and consequently, should be disregarded consistent with 37 C.F.R. § 42.22(a). For these reasons, Petitioner fails to establish that Schoenith in view of Park discloses “the structural bridge comprising: a conduit between the pair of control modules.”

X. THE PETITION FAILS TO DEMONSTRATE UNPATENTABILITY OF ANY CHALLENGED CLAIM BASED ON MICHAEL AND PARK (GROUND 3)

Petitioner fails to demonstrate the unpatentability of any Challenged Claim over Michael in view of Park by a preponderance of the evidence. 35 U.S.C. § 316(e). Having discussed the scope of the prior art and the level of ordinary skill in the pertinent art above, the analysis below according to *Graham* demonstrates that

there are substantial differences between the claimed invention and Michael in view of Park that merit denial of Ground 3.

A. Michael and Park Fail to Disclose a Fastening Mechanism That Cooperates With and Secures a Pair of Confinement Structures

Michael alone or in combination with Park fails to disclose the claim limitation, “a fastening mechanism cooperating with the pair of confinement structures, the fastening mechanism secures the pair of confinement structures one to the other” of claim 1. As to this claim limitation, Petitioner relies on Park and advances substantially the same arguments it made in Ground 2; namely, that Park’s groove-hole-protrusion mechanism (*e.g.*, recessed guide grooves 32a having recessed catching holes 32b and corresponding protrusions 41) purportedly discloses a fastening mechanism that secures the pair of confinement structures one to the other. *See* Petition at 53, 67-68. Petitioner fails to establish that the cited art discloses the above claim limitation for the same reasons discussed above with respect to Ground 2. *See, supra*, Section IX.A.

B. Petitioner Fails to Show That a Person of Ordinary Skill in the Art Would be Motivated to Combine Park with Michael to Obtain a Structural Bridge Having a Conduit Between a Pair of Control Modules.

Petitioner alleges that Michael in combination with Park teaches “the structural bridge comprising: a conduit between the pair of control modules.” Petition at 67. Specifically, the Petition states:

The Michael/Park combination satisfies this limitation. First, Park’s bridge had a defined space inside, through which the electrical connection means ran. In light of that disclosure and a POSITA’s knowledge, the use of a *conduit between the pair of control modules* was obvious. Ex. 1004 ¶¶8, 13, 26, 36. That *conduit* would have run *between the pair of control modules*, which both Michael and Park taught on the left and right sides.

As outlined in *In re Magnum Oil Tools Int’l, Ltd.*, Petitioner cannot satisfy its burden of proving obviousness by employing “mere conclusory statements.” 829 F.3d at 1380; *see also In re Nuvasive, Inc.*, No. 2015-1670. Here, the Petition provides no reasoning as to how or why a POSITA would be motivated to modify any aspect of Michael with Park’s electrical connection means (*i.e.*, Park’s “connecting cable”). *See* Petition at 67. Moreover, the information provided in the cited portions of Kitchen’s declaration, in particular ¶¶382-389, cannot be found in the Petition (*see* Petition at 67) and, consequently, should be disregarded consistent with 37 C.F.R. § 42.22(a). Thus, Petitioner fails to establish that Michael in view of Park discloses “the structural bridge comprising: a conduit between the pair of control modules.”

Additionally, a POSITA would have little reason to modify Michael’s docking station 3 with Park’s connecting cable. Michael already teaches that its modular devices 22-26 connect directly with the docking station 3 so that they are “operably

connected to the personal electronic device.” Ex. 1015, Michael at [0130]-[0131], FIG. 1 (explaining that modular devices include a male or female connective arrangement 27 for engaging with a corresponding connective arrangement 21 of the docking station 3). No reasonable benefit would be derived by modifying Michael to include a conduit “between the pair of control modules” since Michael’s modular devices can already communicate with the personal electronic device. Petitioner also does not explain any benefit in this regard.

XI. CONCLUSION

In view of the foregoing, Patent Owner respectfully requests that the Board deny this Petition for *Inter Partes* Review of the ’119 Patent.

Date: June 12, 2019

Respectfully submitted,

By: /s/ Christopher Mathews

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CERTIFICATE OF COMPLIANCE

I hereby certify that this paper complies with the type-volume limitation of 37 C.F.R. § 42.24 because it contains 12,953 words, excluding the parts of the paper exempted by 37 C.F.R. § 42.24(b).

/s/ Christopher Mathews

Christopher Mathews
Registration No. 35,944

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned hereby certify that the PATENT OWNER'S RESPONSE, and all exhibits and other documents filed together with the response, were served on June 12, 2019 by e-mailing copies to:

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