

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

GAMEVICE, INC.,
Patent Owner.

IPR2023-00643
Patent 10,391,393 B2

Record of Oral Hearing
Held: August 14, 2024

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

IPR2023-00643
Patent 10,391,393 B2

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P R O C E E D I N G S

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2 JUDGE COCKS: All right. Good afternoon. Welcome to the Board.

3 Today we're here for oral argument in proceeding IPR2023-00643 involving

4 patent number 103,91,393. I'm Judge Cocks. I'm joined in the room by

5 Judge Kinder, and we are joined remotely by Judge Meyers.

6 Let's begin with introduction of counsel. Would counsel for the

7 Petitioner please state their appearance today?

8 MR. KINSEL: Grant Kinsel for Nintendo and with me is Tyler

9 Bowen.

10 JUDGE COCKS: Thank you, Mr. Kinsel.

11 And with counsel for Patent Owner please state their appearance?

12 MR. KUMAR: Karthik Kumar from the Finnegan Law Firm on

13 behalf of the Patent Owner, and with me is Joshua Goldberg.

14 JUDGE COCKS: Thank you. Okay. As we set forth in the trial

15 hearing order, each side has 60 minutes to present their case. Petitioner has

16 the burden of showing unpatentability and will proceed first. Patent Owner

17 will then argue their opposition. Petitioner may reserve rebuttal time and

18 Patent Owner may also reserve surrebuttal time.

19 We have the entire record before us, including the parties'

20 demonstratives. And specifically for Judge Meyers' benefit, when you are

21 referring to any paper or part of the slide deck please identify by the number.

22 And with that said, Petitioner, I believe that the podium is yours. Do

23 you wish to reserve rebuttal time?

24 MR. KINSEL: I do. I'd like to reserve 15 minutes, please.

25 JUDGE COCKS: You may begin when you're ready.

1 MR. KINSEL: Thank you very much. Again, Grant Kinsel for
2 Nintendo. I want to begin today with the issue of collateral estoppel because
3 collateral estoppel, I think, is dispositive here, but before I turn to it I think
4 it's important to give the Board some updates with respect to the parallel
5 District Court litigation because there have been some things that have
6 happened there.

7 As the Board is aware, after the ITC found all of the challenged
8 claims invalid, Gamevice returned to the District Court to try its allegations
9 of infringement there. Within the last few months, the District Court found
10 that all of the claims except for Claim 3 were not entitled to the '119 patent's
11 priority date. As a result, because Gamevice or because the Nintendo
12 Switch, the accused device, antedated the actual filing date of the '393 patent
13 and because Gamevice alleges that the Nintendo Switch infringed, met the
14 limitations of the claims, the District Court found that the claims, all the
15 claims except for Claim 3 are anticipated.

16 Now, Gamevice has appealed that ruling to the Federal Circuit, but in
17 so doing Gamevice did not appeal the finding of anticipation. So as we
18 stand here now, the only claim that has survived the District Court is Claim
19 3. We still think the Board needs to go through this process and rule as to all
20 of the pending claims, all the challenged claims, but from the District Court's
21 perspective only Claim 3 is surviving and Gamevice has now conceded the
22 invalidity of all of the challenged claims except for Claim 3.

23 And so what does, what does all that mean? So we need to put some
24 context around that. So the Board found in the '119 IPRs that the
25 grandparent patent of the '393 patent, all of the challenged claims there were
26 invalid or the very art we're going to look at today. The ITC found based on,

1 again, most of the same art that we're looking at today, that all of the
2 challenged claims were invalid.

3 And now the District Court has found that all the claimed challenge --
4 all the challenged claims with the exception of Claim 3 are invalid. And so,
5 you know, it really isn't a surprise to see all of these invalidity findings when
6 you consider just how close the art of Grounds 1 through 3 are to what's
7 accused here -- what's asserted.

8 The '393 patent claims a game controller with -- that can hold a
9 smartphone or tablet, and the idea of this invention is that maybe a soft draw
10 latch in combination with a structural bridge can cause the confinement
11 structures of the device to compress against the size of the gaming tablet,
12 like a iPad or an iPhone. And then you can release the latch and remove the
13 phone or the tablet for regular normal usage. And that is precisely what the
14 art that we've offered shows, exactly that.

15 So let me put up slide 2, which shows Ground 1, which is the Willner
16 and Park combination. And so what you see in the Willner and Park
17 combination is you've got Willner, which is a game controller with
18 removable control modules and Park, which has an adjustable bridge. And
19 the Park bridge works with a ratcheting action using protrusions and catch
20 holes and so it can ratchet the sides of the device and compress the size of a
21 smartphone or tablet as the case may be. And so it works exactly as the
22 embodiments in the '393 patent. It squeezes the sides.

23 Ground 2, shown in slide 3, is similar. That's Schoenith plus Park.
24 Schoenith is similar to Willner in that it has a fixed size adapter and
25 removable modules, removal game control modules, and Park we've talked
26 about has ratcheting action.

1 Ground 3, as show in slide 4, is Schoenith and Kessler, and Kessler is
2 like Park in that it has a spring and it's biased towards closed. So the bridge
3 is biased towards close and you can pull it and stretch it apart and the spring
4 causes the two sides of the Kessler device to press against the smartphone or
5 a tablet and hold the smartphone or tablet in place. And so that's what we're
6 talking about here.

7 And the art is so close that Gamevice doesn't even really dispute many
8 of the limitations, so you can see the limitations that Gamevice actually
9 disputes and that's on slide 5. Gamevice disputes limitation 1(b)1 and 1(b)4,
10 and that's it. The rest it concedes. Nor does Gamevice address any of the
11 dependent claims, including the now only dependent claim that survived and
12 the only claim that's surviving at all, Claim 3. Gamevice doesn't address any
13 of those claims either.

14 So the issues before the Board today are really quite narrow. In fact,
15 the Board really only needs to make two findings to determine that all
16 challenged claims are unpatentable, and you can see those findings on slide
17 6. The first is that Willner or Schoenith teach confinement structures, and I
18 should point to the -- point out to the Board there is a typo on this slide.
19 This says limitation 1(b)2. It should be limitation 1(b)1 there, so apologize
20 for that.

21 So Willner and Schoenith teach confinement structures. And the
22 second key finding is motivation to combine Willner or Schoenith with Park.
23 And the reason I say collateral estoppel is dispositive is because the Board
24 has already made those exact findings in the '119 case. So on the '119 case,
25 the Board found that Schoenith teaches confinement structures. You can
26 see that in slide 7.

1 And in slide 8, you can see that Willner teaches -- the Board has
2 found that Willner teaches confinement structures.

3 And then in slide 9, you can see that the Board has already found that
4 there is a motivation to combine Willner and Park and Schoenith and Park.

5 JUDGE COCKS: Counsel, one question?

6 MR. KINSEL: Yes.

7 JUDGE COCKS: So as between the '119 patent and the '393 patent
8 when it comes to the confinement structures, there is some variation is there
9 not?

10 MR. KINSEL: There is a modicum of variation, yes, and I can show
11 you what that is. It's on slide -- let me go to slide 16. So here are the two
12 side by side. On the left is the '119 and on the right is the '393.

13 USHER: We have two observers outside that would like to come in
14 to observe. We have two observers outside that want to come in.

15 MR. KINSEL: Should I pause?

16 JUDGE COCKS: Yes, please pause. Pause your time. So we've
17 been informed there are two observers outside that wish to come in so we're
18 going to allow them to come in.

19 MR. KINSEL: Thank you.

20 JUDGE COCKS: Apology for the interruption. You may proceed.

21 MR. KINSEL: Thank you. So I was discussing the differences
22 between the '119 confinement structure's limitation and the '393 patent
23 confinement structure's limitation, and I've got them up here on the slide,
24 slide 16. The first, the first difference is that in the '119 patent the
25 confinement structures confine the computing device and in the '393 the
26 confinement structures interact with the computing device. And then the

1 '393 adds that the confinement structures cannot be adjacent to more than
2 three sides of the sides of the computing device. So those are the two
3 differences.

4 And the question from a Federal Circuit law perspective on collateral
5 estoppel is whether these differences are material to patentability. You can
6 see that in Ohio Willow Wood v. Alps South, that's slide 11. And what Ohio
7 Willow Wood says is that for purposes of collateral estoppel when you're
8 deciding whether issues are identical, you look to issues. You don't look to
9 arguments. You don't look at evidence. You look to issues. And issues are
10 identical, according to Ohio Willow Wood, if the differences between the
11 unadjudicated patent claims and adjudicated patent claims are not -- do not
12 materially alter the question of invalidity. So that's the standard.

13 And the question then is do any of these differences materially alter
14 the question of patentability? And it was Gamevice's burden to show that
15 they do. Gamevice doesn't even attempt to make this showing. There's
16 nothing in its briefing describing how any of these differences materially
17 alter the question of patentability. And as I say, it was Gamevice's
18 obligation to do so.

19 You can see that in, again, Ohio Willow Wood, which is slide 15,
20 Ohio Willow Wood puts the burden on the party resisting collateral estoppel
21 to show that there are differences in patentability. This is what the Federal
22 Circuit says. Since OWW failed to explain how the block copolymer
23 limitation changes the invalidity analysis, OWW has not met its burden of
24 opposing summary judgment based on the distinction.

25 So Gamevice had the same obligation. Gamevice needed to show you
26 how those changes that we just looked at, interacting versus confining and

1 not adjacent to more than three sides, somehow change the question of
2 patentability. But Gamevice didn't do that.

3 Instead, Gamevice's only argument on this issue is that Nintendo
4 somehow treated the limitations differently, that Nintendo treated the
5 confinement structure limitation in the '119 patent somehow differently than
6 it treated it in the '393.

7 So that issue is irrelevant legally speaking because it doesn't go to the
8 question of material difference for patentability so it's irrelevant, but it's also
9 factually untrue, and I can show you that. So let me show you why
10 Nintendo did, in fact, treat these limitations the same. Go to slide 12.

11 Slide 12 has a few things on it. On the left-hand side is an excerpt
12 from the Board's final written decision, and as you can see there the Board is
13 relying on Nintendo's expert, Mr. Kitchen, to describe the two confinement
14 structures, which are the two sidewalls of the Willner adapter. And that's
15 what the Board is citing Mr. Kitchen for there at paragraph 485.

16 On the right-hand side is paragraph 485 from Mr. Kitchen's
17 declaration in the '119 case, and you can see he's talking about the two
18 sidewalls of the Willner adapter as the confinement structures.

19 And then you can see even more clearly how Nintendo treated these
20 things exactly the same in both cases when you look at the combinations. So
21 slide 13 shows the two combinations side by side. So on the left-hand side
22 is the Willner Park combination from the '119 case, and on the right-hand
23 side is the Willner Park combination from this case. And you can see, other
24 than some changes in the shading, they're identical, as is the description.

1 So when Gamevice gets up here and they tell you that Nintendo
2 treated the limitations somehow differently, it's not only irrelevant legally,
3 it's factually incorrect.

4 And the same is true for the Schoenith and Park combination.
5 Nintendo treated those just the same. You can see that on slide 14. On the
6 left is an excerpt from the petition in the '119 case, and on the right is an
7 excerpt from the petition in this case. And you can see that Nintendo was
8 talking about the two sidewalls of Schoenith in the '119 case and, again,
9 talking about the same sidewalls in this case.

10 So Nintendo didn't treat the combinations differently and so even if
11 there was some legal significance to that issue, which there isn't, it's just
12 incorrect. So the Board should just simply follow its prior rulings, find that
13 Willner and Schoenith both teach confinement structures, apply collateral
14 estoppel, and find all of the claims unpatentable.

15 There's one last point on collateral estoppel that I'd like to just touch
16 on, and that is that Gamevice has conceded that the '393 patent is not
17 patentably distinct from the '119 patent. And that really means collateral
18 estoppel should apply. There's no material difference between the two
19 claims, and you can see that in slide 19.

20 So what happened in the prosecution history is that Gamevice
21 terminally disclaimed the '393 to the '498. The '498 was terminally
22 disclaimed to the '119. So Gamevice is saying our claims here are not
23 patentably distinct from the now unpatentable '119 and so the Board should
24 apply the collateral estoppel that it -- or the same findings that it found in
25 '119 case and apply them here and find all the claims, challenged claims
26 unpatentable.

1 So let me turn to --

2 JUDGE KINDER: This is --

3 MR. KINSEL: Oh, I'm sorry. Yes?

4 JUDGE KINDER: This is Judge Kinder. I understand -- I think I
5 understand that argument. Did you cite any legal precedent or authority to
6 support that argument?

7 MR. KINSEL: We included it in the introduction but we didn't cite
8 any cases. I'd be happy to provide several that, that are along the lines.
9 What the Federal Circuit has said is that you cannot rely simply on a
10 terminal disclaimer to demonstrate collateral estoppel, so it can't be on only
11 by itself. But the phrase that the Federal Circuit used is that it is a strong
12 hint that collateral estoppel applies, and that's the Google case but the
13 number is --

14 JUDGE KINDER: Okay. And those are cited?

15 MR. KINSEL: That is not cited in our brief, no. That case is not
16 cited in our brief.

17 JUDGE KINDER: Okay, and if it's not in your brief I don't --

18 JUDGE MEYERS: That's the SimpleAir v. Google case you're
19 referring to?

20 MR. KINSEL: Yes, SimpleAir. That's right.

21 JUDGE MEYERS: Okay.

22 MR. KINSEL: That's exactly right.

23 JUDGE KINDER: Thank you.

24 MR. KINSEL: So let me turn, if I can, unless there are questions on
25 collateral estoppel? I'm happy to answer any but let me turn to the
26 substantive issues here because I think even if you consider Gamevice's

1 substantive objections I think you arrive at the same place, that the claims
2 are unpatentable.

3 So I'll start with Ground 1, which is the Willner and Park
4 combination, and as to that ground what Gamevice says is that Willner and
5 Park don't teach confinement structures and there's no motivation to combine
6 Willner and Park. Now, Gamevice's argument is essentially that if you took
7 the Willner sidewalls and physically incorporated the Park bridge that the
8 resulting combination wouldn't hold a computing device and so therefore the
9 sidewalls of Willner are not confinement structures within the proffered
10 construction.

11 And that's incorrect for at least three different reasons, so let me tick
12 those off on slide 20. The first reason it's incorrect is that it's applying an
13 incorrect bodily incorporation standard. That's not how we do obviousness.
14 It also ignores the background understanding of a person of skill in the art.

15 Second, Gamevice is applying, kind of, a meta construction to hold
16 something that means that you can -- have to hold this computing device
17 under even the most extreme circumstances. And that construction is
18 inconsistent with the claims. It's not construction -- consistent with
19 Gamevice's position in any of the District Court or ITC litigation. It's not
20 consistent with the specification.

21 And finally, Gamevice has no actual evidence that the Willner and
22 Park combination wouldn't hold a computing device. The evidence that
23 Gamevice has is all speculation built on Dr. Slocum's say-so.

24 So let me take these one at a time. What Gamevice is saying in the
25 Willner and Park --

26 JUDGE MEYERS: Counsel?

1 MR. KINSEL: Yes?

2 JUDGE MEYERS: Sorry, I couldn't --

3 MR. KINSEL: No, please.

4 JUDGE MEYERS: -- (inaudible). Before we get to Dr. Slocum,
5 before you discuss Dr. Slocum, there is a argument about the different levels
6 of ordinary skill in the art. Does the analysis hinge on either party's
7 proffered definition?

8 MR. KINSEL: Not in our view. I think in our view either definition,
9 the -- under either definition these claims are invalid. I think in addition,
10 either expert qualifies as a person of skill in the art under either construction
11 or under either definition, so I don't think it matters. I don't think any --
12 none of the constructions hinge on it at any level of skill that any of the
13 parties are discussing these inventions would be obvious.

14 So let me, let me start again with why Gamevice is wrong here about
15 whether the Willner Park combination would hold a computing device.
16 What they say is a computing device would pop out, but what they're really
17 doing is they're trying to physically combine, bodily combine, the Park
18 bridge and the Willner sidewall. So you can see that in Dr. Slocum's
19 illustrations on slide 22. He's literally taking the physical sidewalls and
20 trying to physically incorporate the Park bridge, and that's -- and then he
21 says that that won't work. That won't work.

22 But that's not how an obviousness analysis is conducted. The Federal
23 Circuit has made it really quite clear, and the case that we've cited for this
24 proposition is Allied Engineering (sic). That's in our briefing. And you can
25 see it in slide 23.

1 What it says is the test for obviousness is not whether the features of a
2 secondary reference may be bodily incorporated into the structure of the
3 primary reference, but rather whether a skilled artisan would have been
4 motivated to combine the teachings of the prior art references to achieve the
5 claimed invention. That's the North Star.

6 And so Gamevice's and Dr. Slocum's contention that physically
7 combining Willner and Park would work is totally irrelevant. In fact, the
8 Federal Circuit cited In Re: Etter in Allied Engineering (sic) for exactly that
9 proposition. You can see that on slide 24. Here's what the Federal Circuit
10 says. "Contrary to Allied's position, it is not necessary that Caterpillar and
11 Ogawa would be physically combinable to render obvious the '489 patent."
12 And then citing In Re: Etter, quoting, "Etter's assertions that Azure cannot
13 be incorporated in Ambrosio are basically irrelevant, the criteria (sic) being
14 not whether the references could be physically combined but whether the
15 claimed inventions are rendered obvious by the teachings of the prior art as a
16 whole."

17 And so it doesn't matter whether Park could be physically combined
18 with Willner. What matters is whether a person of skill in the art looking at
19 those two references would have reached the confinement structures
20 limitation. And the Board has already found that that's exactly the case, that
21 a person of skill in the art looking at Willner and looking at Park would have
22 reached the confinement structures limitation.

23 So, you know, Gamevice likes to point to illustrations in Nintendo's
24 briefing as, sort of, an excuse for its bodily incorporation approach here.
25 And I'm sure you'll see some of these illustrations when co-counsel gets up,
26 or when counsel gets up. And you'll see them on slide 25. Nintendo

1 provided these illustrations as possible modifications for the prior art, not as
2 bodily incorporations, not as examples of Park being glued into Willner, but
3 rather as illustrative examples of ways to potentially modify the prior art.

4 But more to the point in addressing obviousness, a skilled artisan is
5 entitled to consider known solutions to known problems in the prior art and
6 adjust combinations in a way this solves those problems. So even if this,
7 sort of, inadvertent pop out problem that Gamevice is relying on was an
8 actual issue, and I'll show you evidence that that's not an issue, but assume it
9 is, a skilled artisan could easily have addressed that problem.

10 And indeed, you know, an obviousness analysis relies on the
11 background understanding of a person of skill in the art in how to handle
12 known problems and known solutions to known problems. And that's why
13 Nintendo cited cases like Tokai and Pride Mobility and its briefing. What
14 those cases stand for is a proposition that the Board should consider no
15 modifications to prior art combinations.

16 So let me put a little bit of substance on that to see what I'm driving at
17 Gamevice relies on the lip structure in Figures 17 and 18 of the confinement
18 structures as a solution to the supposed problem of the computing device
19 popping out. Now, I'll note that this is really only Dr. Slocum's view. The
20 specification doesn't describe the, what it calls the cradle in that way. It just
21 refers to a cradle. Instead, the specification describes the confinement
22 structure is holding the computing device through compression from the two
23 sides.

24 But in any case, Gamevice didn't invent lips that would hold a
25 computing device in place. That was replete in the art. So, for example, if
26 you look at slide 26 you'll see Willner had retention lips. Slide 27 shows

1 that Schoenith had retention lips and slide 28 shows that Kessler had
2 protection lips.

3 The point is that a person of skill in the art confronted with the
4 supposed problem that Gamevice is identifying here of a computing device
5 popping out, would have had at their fingertips the very solution that
6 Gamevice purports to have invented -- lips. They were all, they were all
7 throughout the prior art.

8 So there's no invention here. They were all in the prior art. A person
9 of skill in the art could easily have used those lips and solved the problem of
10 a computing device popping out and had a reasonable expectation of success
11 in doing so.

12 For the Schoenith-based combination, Gamevice's view is a little bit
13 all over the place. Sometimes they say the computing device would pop out.
14 Sometimes they say it would tip over. But again, that's all just based on Dr.
15 Slocum's say-so. And the more, sort of, salient point is that the observation
16 is irrelevant because the combinations aren't supposed to be bodily
17 incorporated.

18 In any case, Kessler expressly taught how to avoid some of those
19 problems, so slide 29 shows Kessler teaching that you can size up his bridge
20 so that you eliminate the supposed tip over problem. And Park taught other
21 methods like a cushioning pad, shown in slide 42, or a connecting assembly
22 to help with computer instability. And other prior art, for example shown in
23 43, had locks.

24 So the point of all of this is that a person of skill in the art had
25 innumerable ways to solve this supposed problem and so they would have
26 had a reasonable expectation of success in solving this supposed issue.

1 So let me turn now to the to the second point that I wanted to make.
2 Gamevice is applying, kind of, a meta construction of “hold.” A whole -- a
3 construction of “hold” that means you have to hold it under the most
4 extreme of circumstances. And you can see this in Gamevice's slides 14, 15,
5 and 16. You can see what Gamevice is doing. In those slides Gamevice is
6 trying to incorporate and comport to the construction things like securely
7 hold and inadvertent removal and things of that nature. But none of that is
8 supported by the lexicography. Gamevice hasn't identified any such
9 lexicography to modify the term “hold.”

10 The specification when it's talking about holding is really at column
11 10, lines 10 through 20. This is what it's talking about. It's talking about
12 compression. So the idea is that you can have a structural bridge and a latch
13 and you can close the latch and that will bring the two confinement
14 structures closer together thereby putting compressive force onto the sides of
15 a computing device, and then you can lift the latch to remove that
16 compressive force. That's what the specification is talking about.

17 And that --

18 JUDGE COCKS: Counsel?

19 MR. KINSEL: Yes?

20 JUDGE COCKS: One question. Do we need to construe “hold”?

21 MR. KINSEL: No. No, I don't think so, but I do think it's important
22 to understand that Gamevice is really trying to narrow how one would see it.
23 And I think the best example of that is in Dr. Slocum's declaration, so let me
24 jump to slide 31. I can show you an excerpt from Dr. Slocum's declaration.

25 Here he says, he's talking about the Willner adapter, and he says that,
26 "Even with all of the pieces of the Willner adapter in place, in his opinion a

1 computing device wouldn't be held by that device." So that's how extreme
2 Dr. Slocum and Gamevice's view is. When they say hold they mean
3 something very different than what the common ordinary meaning of that
4 word would be. They mean something like if you're on a trapeze and
5 playing this game and the thing falls out you're not holding it.

6 And I'd note that this reading is so extreme that it writes out
7 embodiments -- all of the embodiments in the specification describing a
8 three-sided, U-shaped controller, so that's Figures 1 through 13 in the
9 specification.

10 And if you look at Figure 5 in particular, you'll see that Figure 5 is
11 almost identical to the Willner adapter. And so what Gamevice is saying is
12 that even Figure 5 wouldn't meet its definition of hold.

13 So while I think you're right, or while I think that holding doesn't need
14 to be expressly meta construed, it is important to understand just how
15 extreme Gamevice's view of that word is.

16 So let me turn then to the fact that Gamevice --

17 JUDGE KINDER: This is Judge Kinder. Can I ask a real quick
18 question about that?

19 MR. KINSEL: Of course.

20 JUDGE KINDER: In the transition in the new claim language, I
21 think, from the '119 patent, when the function of confining was eliminated,
22 does that impact how we should view the structure now, the confinement
23 structure?

24 MR. KINSEL: The confinement structure was construed -- let me
25 back up. The term confinement structures was construed by the District
26 Court and so that's the definition that we have proffered, the District Court's

1 definition, which was Gamevice's proposed definition back in the ITC days.
2 And so I don't think that term needs any further construction, but the
3 function has been changed and the function is even broader now than it was
4 in the '119 case.

5 So let me jump back to this slide 16 so I can show you what I mean.
6 So before the confinement structures had to confine the computing device.
7 Now they just have to interact with the computing device, and Gamevice's
8 position has always been that interacting just means, sort of, touching or
9 something similar to that. They've never actually really said what
10 interacting is supposed to require. But their position seems to be that it
11 doesn't require much of anything. It doesn't require an electrical interaction.
12 It doesn't seem to require a physical interaction. So the function has
13 changed, and so I do think that when the Board is writing its opinion it has to
14 take account for the change in language but the language is broader. So to
15 the extent that the Board already found that the confinement structure is
16 confined, surely the confinement structures interact.

17 JUDGE MEYERS: So, Counsel, you're saying that the '393 patent
18 limitation defining structures is broader than the '119 patent. That's your
19 position?

20 MR. KINSEL: That's our position. The function is certainly, is
21 certainly broader and the term itself is the same, of course, but the function -
22 -

23 JUDGE MEYERS: Okay.

24 MR. KINSEL: -- that it's, that it's performing is broader. It can't be
25 around more than three sides of the size of the computing device, but that
26 has no impact on any of the prior art. In fact, if you look at slide 17, this is

1 the Willner adapter as illustrated by Dr. Slocum with some additions. So
2 what you see here is the Willner adapter and it has a backside in yellow, two
3 sides in orange, a green front side and a red front side, and then a bottom
4 side that's in blue. The specification describes only the top sides and bottom
5 as sides. The front is the front and the back is the back.

6 So when we say that the Willner adapter is -- the Willner adapter
7 would only be adjacent to three sides of the sides of the computing device,
8 side one, side two, and side three. So it doesn't really matter that the
9 limitation has this additional requirement because it's manifested in the prior
10 art and Gamevice has never said otherwise.

11 JUDGE COCKS: Counsel, one question, and this is stepping back but
12 -- and you've already said this, I think, but I just want to hear you say it
13 again. So in your view the term "interacting" is broader than "confining"?

14 MR. KINSEL: Yes.

15 JUDGE COCKS: Okay.

16 MR. KINSEL: So let me talk a little bit about Gamevice's evidence
17 on computing device pop out. I don't know what we need to get too in detail
18 in this because I don't think it matters, but Gamevice's evidence here is really
19 just Dr. Slocum's testimony and a sentence fragment from Park.

20 And Dr. Slocum's testimony is built on his anecdotal observations of
21 kids playing video games at his house. These aren't scientific surveys.
22 These are him making dinner and watching the kids play. He tried to dress
23 that up in his deposition as something more than it really was, but it's not
24 really materially different than me watching my son play as I'm cooking
25 dinner. But that's the basis for his -- that's the basis for his opinion.

1 And even taking his opinion, sort of, for what it's worth, you see it's
2 not particularly worthwhile. So slide 33 shows you why, so Mr. -- Dr.
3 Slocum can't tell you, for example, what games any of these kids were
4 playing. He can't tell you what controllers you saw.

5 And about the only thing that he can tell you is that he didn't see the
6 kinds of controllers that we're talking about here, a two-piece controller with
7 a screen and a separate attachment. That's what we're talking about here.
8 And Dr. Slocum confirms he didn't see that kind of device.

9 And so when Dr. Slocum tells you that his view of normal use is that
10 kids are, kind of, like, wrestling with the computing -- with the controller
11 and that kind of wrestling would cause a computing device to pop out, he's
12 not basing it on any actual observations. And if we compare Dr. Slocum, for
13 example, to Mr. Kitchen, Nintendo's expert, Mr. Kitchen has 40 years of
14 design experience making the kinds of products that we're talking about
15 here, handheld games. That's what he did. That's what he's done since the
16 1970s.

17 And Dr. -- Mr. Kitchen is express about the kinds, the different kinds
18 of uses that person of skill in the art would expect from a combined
19 controller like the one that we're talking about here. On slide 34 you can see
20 some excerpts from Mr. Kitchen's testimony, and what he's saying is that the
21 kinds of controllers that we're talking about here have a screen on them.
22 And so people playing them aren't going to be wrestling with them as Dr.
23 Slocum seems to suggest, but instead are going to have them in front of them
24 with their thumbs at the ready and they're going to play their games.

25 And in Mr. Kitchen's opinion, again, the only person with actual
26 knowledge in the field, the specific field, is that -- and you can see this on

1 slide 35 -- is that a skilled person would have understood that when using
2 one of the combined handheld gaming devices under ordinary use conditions
3 the handheld gaming device would have retained the computing device
4 during game play.

5 So Mr. Kitchen's testimony is that the Willner device, the Park device,
6 all of these devices which, by the way, were designed and patented to do the
7 very thing that we're talking about, to hold a computing device, that's what
8 these patients were all about. This is not, you know, we were talking the
9 other day about our friends, we're talking about whether this is a case where
10 you've got prior art from one orthogonal (phonetic sp.) field and you're
11 putting it and using it to bolster some art in a more central field. What we're
12 talking about here is art that discusses and describes devices that hold
13 computing devices. That's all they do.

14 And so the suggestion that they somehow don't work, which is really
15 at the bottom line, all Dr. Slocum is saying is that Park doesn't work, Willner
16 doesn't work, Kessler doesn't work. The only one that apparently works is
17 Figure 16. It's just -- it really degrades the art that's in front of us.

18 So the other piece of evidence that Gamevice relies on for this notion
19 that the computing device would pop out is a sentence fragment from Park,
20 and I do want to talk about that because Gamevice spends a lot of time on
21 that. So let me go to slide 36 before we do that. This is Park and this is
22 what I was getting at a moment ago that the reality here is Park's device was
23 designed to and intended to hold the computing device. That's what it shows
24 in Figure 3.

25 So, you know, again, the notion that Dr. Slocum somehow thinks this
26 wouldn't work is really, kind of, beside the point, but in any case here's the

1 sentence fragment that Gamevice relies on and it's throughout their brief so I
2 think it's important to at least look at.

3 The sentence fragment reads, and I'll just read it, this is slide 37, "As
4 the mobile phone is not sufficiently in contact with the device according to
5 the present invention when using the above configuration, the mobile phone
6 (1), will come loose during gaming or become detached in severe cases
7 hindering comfortable and stable operation of the game." So that's the
8 sentence that Gamevice relies on as purported evidence that Park just doesn't
9 work.

10 But, you know, Gamevice never reads the first part of the sentence
11 which reads, "Whereas the above configuration sufficiently allows for a
12 mobile phone, one, to be mounted on a device according to the present
13 invention and use." So Park thinks that his invention works, and when you
14 read the whole sentence in context you see that it's not consistent with what
15 Dr. Slocum is saying but is perfectly consistent with what Mr. Kitchen is
16 saying, that these devices would be off -- all of them would be fine. They
17 would all work. That's what Mr. Kitchen says and that's what Park is saying.

18 In fact, Park, to go even further, has multiple embodiments of his
19 invention including one embodiment shown on slide 38 of just the gamepad.
20 So Park has all these other, sort of, add-ons that can help increase the
21 stability of the game device in his controller, but he claims in Claim 1 just
22 the controller itself.

23 Let me, let me jump quickly, because I can see I'm running out of
24 time, to motivation to combine because I do think it's important to talk about
25 motivation to combine. Gamevice's arguments on Grounds 2 and 3 are
26 essentially identical to their arguments on Ground 1. They have one

1 additional argument about the separate and distinct controller issues but that
2 argument is so hard to follow that I'll let them make it and then I'll show you
3 why it's wrong.

4 But let me, let me go to motivation to combine, so this is slide 41.
5 Gamevice has a number of different grounds that they claim there is no
6 motivation to combine on, but the first problem they've got is that collateral
7 estoppel precludes it. So the Board has already found that there is a
8 motivation to combine Willner and Park and Schoenith and Park. And that
9 motivation to combine is that by adding an adjustable bridge to this device
10 you increase the usage of that device. You increase the number of people
11 who can use it.

12 You can lower your cost. You make it easier to use with multiple
13 different kinds of products. And that's what the Board has already found.
14 And Gamevice has never articulated a reason why they should get to reargue
15 this, and I think collateral estoppel precludes it. But if you take their
16 arguments on their merits, on their face, they're wrong anyway.

17 So the first argument Gamevice makes is, well, a person of skill in the
18 art would be frustrated because a computing device would pop out of the
19 Willner Park combination, but there's no evidence that that's actually true,
20 number one.

21 Number two, it's irrelevant because as we've talked about, bodily
22 incorporation is not the obvious standard. But more importantly, there are
23 prior art solutions that solve this supposed problem and so a person of skill
24 in the art would be reasonably expecting success in making this
25 combination. And, in fact, even Dr. Slocum agrees that a person of skill in

1 the art would have a reasonable expectation of success in making, for
2 example, the Park and Willner combination.

3 So slide 44 is Dr. Slocum's testimony, and I asked him, "And they
4 would have a reasonable expectation of succeeding in making the
5 combination, right" The answer, well, eventually they'd make it work,
6 yeah." So he's acknowledging that a person of skill in the art would have a
7 reasonable expectation of success in making these combinations.

8 JUDGE KINDER: Could I clarify one thing?

9 MR. KINSEL: Yes.

10 JUDGE KINDER: Is the problem of popping out, is that even a
11 problem you agree that needs to be addressed?

12 MR. KINSEL: No. It's -- I don't believe it's a problem in fact, and it's
13 not a problem that even needs to be addressed. It's irrelevant. From a legal
14 perspective it's totally irrelevant.

15 JUDGE KINDER: Can you explain that a little bit?

16 MR. KINSEL: Sure, because it only comes up if you are bodily --
17 physically trying to incorporate the Park bridge into, for example, the
18 Willner sidewalls, and that's not the standard for obviousness. The standard
19 for obviousness is not bodily incorporation. It's whether you take the
20 readings of these two patents and would have reached the confinement
21 structures limitation.

22 So it's irrelevant whether it would pop out or not. In fact, if you look
23 at, for example, Pride Mobility, one of the cases that we cited in our briefing
24 (inaudible) maybe Figure 5. Let me -- here it is. Here is Pride Mobility.
25 One of the cases that we cited is Pride Mobility, and what Pride Mobility --
26 what happened in that case is the Petitioner filed a petition to validate some

1 claim, a claim relating to a wheelchair design. The Board invalidated the
2 claims on appeal.

3 The issue was that in response to the petition the Patent Owner said,
4 look, if you take these two pieces of prior art and you combine them you'll
5 end up with an unstable wheelchair, so effectively exactly what Gamevice is
6 saying here.

7 But what the Federal Circuit said is, no, you don't look at that. It's
8 perfectly appropriate to consider adjustments that a person of skill in the art
9 would make to avoid such problems. And so here's what they say.

10 "What we read the Board as having found and as having -- and as
11 reasonably understanding Dr. Richter to have testified that a relevant, skilled
12 artisan would have known to compensate for the instability problem in ways
13 that preserve the acceptability of the wheelchair," which is precisely what
14 we're talking about here. And so that's why it's irrelevant from a legal
15 perspective.

16 So I see I'm into my rebuttal time so unless there are any further
17 questions I'll yield the floor.

18 JUDGE COCKS: I don't think we have -- well, actually I do have one
19 clarification. So you're asking us to credit Mr. Kitchen's testimony over Dr.
20 Slocum but you're not seeking to exclude Dr. Slocum's testimony?

21 MR. KINSEL: We're not. Dr. Slocum is a mechanical engineer of
22 great skill. We don't have a dispute there. His testimony is irrelevant but
23 you can consider it if you like.

24 JUDGE COCKS: Well, we had a brief interruption so you'll have
25 your full 15 minutes for rebuttal.

26 MR. KINSEL: Thank you very much.

1 JUDGE COCKS: Before you begin would you like to reserve
2 surrebuttal time?

3 MR. KUMAR: Oh, yes, Your Honor, five minutes, please.

4 JUDGE COCKS: You may begin.

5 MR. KUMAR: Thank you. Good afternoon, Your Honors. Karthik
6 Kumar from the Finnegan Law Firm on behalf of the Patent Owner. There
7 are a few key disputed issues in this case so I'll go through them one by one.
8 In the interest of completeness, we have listed the person of ordinary skill in
9 the art issue where the parties do diverge on the definition. We don't think
10 that it really makes a difference in terms of the arguments, but I wanted to
11 highlight it because it is there. The other thing it does is it -- the key point
12 I'm trying to make when bringing up the person of ordinary skill in the art is
13 if you look at the claim dimensions and the description of the patent it is
14 primarily focused on the mechanical side and that's reflected in the
15 differences between the definitions that have been proffered by the parties
16 on the level of ordinary skill. That said, I don't think any of the issues, the
17 actual disputed issues in the case resolve differently depending on which
18 definition the Board chooses.

19 So I'll skip straight to the first three grounds. Some of the issues are
20 similar and I'll go through them one-by-one anyway because there are some
21 differences between how they are to be traveled (phonetic sp.)

22 JUDGE COCKS: Counsel, before you do that, (inaudible) your
23 opposing counsel had mentioned several developments in the parallel
24 proceedings. I think they said that that doesn't necessarily impact on what
25 we do here. Do you agree with that? Well, do you agree with what they

1 said? They summarized what has occurred, and do you agree that we just
2 proceed?

3 MR. KUMAR: Your Honor, the issues in District Court fairly
4 complicated and intertwining the issues of infringement and invalidity. I
5 think the Board should just focus on the issues that are before us today, and
6 that's what I intend to do as well.

7 JUDGE COCKS: Well, it sounds like the parties are in agreement on
8 it?

9 MR. KUMAR: Yes.

10 JUDGE COCKS: Thank you.

11 MR. KUMAR: So starting with the first three grounds, we have,
12 broadly speaking, four disputed issues across those three grounds, and I'll
13 take the grounds one by one. The key claim limitations at issue though
14 across all three grounds are highlighted on demonstrative slide 10. As you
15 can see here, read together as a whole the limitations that are highlighted in
16 yellow they set out the scope of the claimed arrangement of the pair of
17 confinement structures. And that's where the focus of Gamevice's
18 arguments lie.

19 As slide 11 shows, the term "pair of confinement structures" has a
20 construction that comes from District Court. This is a construction that
21 Gamevice has consistently won in the ITC at District Court, but now,
22 apparently, the parties dispute as to how the construction should be applied,
23 in particular how the world hold ought to be applied.

24 There are two points of disagreement. First, Nintendo misunderstands
25 Gamevice is arguing that the confinement structures by themselves must do
26 all the holding of the computing device. That is not true. Instead,

1 Gamevice's position is that the electronic game control modules alone
2 cannot participate – oh, the electronic game control modules cannot
3 participate in holding the computing device because of the specific claim
4 language on slide 10 that says that "the electronic game control modules
5 must be a separate and distinct structure from and forming no structural
6 portion of the physical components that hold the computing device." And
7 that is a more accurate statement of Gamevice's position. It's really based on
8 the claim language.

9 The second issue is as shown on slide 12, Gamevice has proffered in
10 its surreply papers its understanding of this construction. That is, that is the
11 construction that it has consistently won before the ITC and the District
12 Courts, and that construction is based on the intrinsic evidence of the '393
13 patent. And that understanding is that a POSITA would understand from the
14 '393 patent's description that physical components do not hold the computing
15 device if they allow it to inadvertently come out during normal user
16 operation.

17 This understanding is consistent with how Gamevice applied the
18 construction for its infringement analysis, which the administrative law
19 judge at the ITC credited, notwithstanding otherwise related (phonetic sp.)
20 against Gamevice.

21 So, for example, in ITC investigation 337-TA-1197, Gamevice argued
22 that certain "rails" in the accused product were in pressing contact with the
23 computing device through screws that applied a compressive force. The
24 ALJ found that to the extent that the rails are considered separate from the
25 computing device then they are components that hold a computing device by
26 being in pressing contact with it and thus qualify as the claimed confinement

1 structures. The citation for this is Exhibit 1018, pages 121 and 192. And
2 this infringement analysis is consistent with Gamevice's application of the
3 construction in this proceeding.

4 Now, if you look at slide 13, the '393 patent's description related to
5 Figures 16 and 18 are instructive and Gamevice has already taken the
6 position that it is these Figures 16 and through 20 and their associated
7 description in the text that provide a description of support for these claims.
8 And counsel for Nintendo knows that well.

9 In Figure 16, the confinement structures 316 are shown in yellow and
10 they hold the computing device 302 shown in blue in such a way that it does
11 not come out during normal user operation. Let me show you some of the
12 evidence for that. Slide 14 shows the '393 patent contrasts holding the
13 computing device between the confinement structures against removing the
14 computing device. At column 10, lines 12 through 20, the patent states,
15 "The expansion and contraction of the distance between the pair of
16 confinement structures 316 facilitates placement of the computing device
17 302 between the pair of confinement structures 316. The application of
18 sufficient compressive load being placed on the computing device 302 to
19 securely hold the computing device between the pair of confinement
20 structures 316 and in contrast an ability to remove the compressive load and
21 allow removal of the computing device from the communication port 310."

22 So --

23 JUDGE COCKS: Counsel, I have one question, well, two points
24 actually. So you seem to be setting up a dispute in terms of the meaning of
25 the term "hold." At one point I note is it based on what I understand you to

1 be saying to securely hold, securely is redundant in that phrase, hold should
2 it encompass, I think, securely? That's what it's suggesting to me.

3 Second, that the term "hold" is not a claim term. It's part of the
4 construction that has been offered for confinement structures. So what I'm
5 finding slight puzzlement is we are then construing a term of the
6 construction, which is an unusual situation.

7 MR. KUMAR: I agree with you on the first point. On the second
8 point this issue that we're facing is one of Nintendo's making by completely
9 removing the word hold of all meaning. We have to understand what the
10 words in the construction mean with reference to the intrinsic evidence, and
11 the specification is the best guide to understanding what it is we're actually
12 talking about.

13 And the only point I'm trying to make here is that holding something
14 is contrasted by the '393 patent with removal. So it cannot be that something
15 that gets removed is considered to be held, and it's right there in front of you,
16 column 10, lines 12 through 20.

17 JUDGE MEYERS: Counsel, I have a further question. The body is
18 U-shaped function that you are referring to. Just isn't the claim – the claim
19 require (inaudible)?

20 MR. KUMAR: I'm sorry, Your Honor, could you please repeat the
21 question?

22 JUDGE MEYERS: Yes, yes. So let me find the slide. So you
23 pointed to on slide 15 here, you're pointing to the portion of the specification
24 and then also (inaudible). Oh, my colleague is -- are you having a hard time
25 hearing me?

26 JUDGE COCKS: Yeah. Can you turn him up?

1 JUDGE MEYERS: Is my audio not coming through?

2 JUDGE COCKS: That's a little bit better. They just increased the
3 volume.

4 JUDGE MEYERS: Okay. Okay. Counsel, my question was the
5 claim does not require there to be three sides. It only requires there to be
6 two sides and I'm referring to the portion of the specification you were
7 reading to us on slide 15.

8 MR. KUMAR: Agreed, Your Honor, yes.

9 JUDGE MEYERS: Okay, thank you.

10 MR. KUMAR: Well, here on slide 15 is another quote from column
11 5, lines 22 to 31, that's provided here just to show that the '393 patent again
12 contrasts inadvertent removal against holding the computing device between
13 confinement structures. At column 5, lines 22 through 31, the patent says
14 that the computing device 102 is confined by the U-shaped structure 128 and
15 the U-shaped structure 128 "mitigates inadvertent removal of the computing
16 device 102 from the U-shaped structure 128 when the computing device 102
17 is fully nested within the three-sided structure."

18 Once again you see the contrast between something being held versus
19 something being removed inadvertently. This is coming from the intrinsic
20 evidence of the patent.

21 On slide 16 here's another quote, this time from column 4, lines 28
22 through 31 of the patent, again showing that the patent contrasts inadvertent
23 removal from being held by the confinement structures. You can see here it
24 says that "The third structure mitigates inadvertent removal of the computing
25 device from the three-sided structure when the computing device is fully
26 nested within the three-sided structure.

1 And this contrast between inadvertent removal and holding is what
2 Gamevice is trying to point to to explain the word hold because Nintendo is
3 trying to render the word hold now devoid of all meaning. It's here in the
4 patent.

5 Now, with that claim construction background, let's look at the first of
6 Nintendo's three grounds -- four grounds. Ground 1 is in view of Willner
7 and Park. As we mentioned before, again, as shown on slide 18, there are
8 four disputed issues. We can deal with the first two issues together, which
9 are that, one, the claimed arrangement of the confinement structures as
10 construed in this proceeding is not disclosed or suggested; and two, that a
11 person of ordinary skill would not be motivated to combine the references as
12 the petition proposes.

13 So let's look at what the petition says. So looking at slide 20,
14 Willner's design is shown as this on the left-hand side. That design includes
15 an adapter 210 in the middle. On the right-hand side is a 3D model of
16 Willner's adapter 210. As shown with added color Willner's adapter 210 has
17 retaining lips in green color along either side and along the bottom, a
18 retaining crossbar in pink color across the middle and a bottom in blue color
19 along the bottom.

20 By the way, Professor Slocum, who is a professor of -- who has been
21 a professor of mechanical engineering for over 30 years at one of the most
22 prestigious and well-known research institutions in the world, MIT, and who
23 previously was a mechanical engineer at the National Institute of Science
24 (sic) and Technology within the U.S. Department of Commerce, is the one
25 who made the models and is making these observations.

1 He made -- he noted an obvious fact. If you turn this device upside
2 down or even lean it facing downwards, the device will come out because
3 there's no retaining structure on the top surface. That's really all that
4 Professor Slocum was trying to say which Nintendo is trying to make into
5 something bigger than it is.

6 It's very simple. The top surface has no cover so if you turn it upside
7 down the device will fall out because the adapter 210 itself provides no
8 compressive force. There's nothing controversial, but the statement is
9 actually pretty self-evident.

10 Now, going back to the petition, for reference in IPR2018-01522 of
11 the '119 patent, Nintendo's petition included all of the elements that I just
12 highlighted in the proposed combination. The citation for that is Exhibit
13 1042, pages 27 and 28 as well as 30 and 31. For reference, slide 13 of
14 Nintendo's demonstratives they do not show what's in Nintendo's petition in
15 those proceeding -- in that proceeding. They show Mr. Kitchen's
16 declaration, which does not actually appear. And those drawings on slide 13
17 do not appear in the petition in the '119 patent proceeding 01522.

18 Now, looking at slide 21, here is the graphic on the right taken
19 directly from page 25 of Nintendo's petition. In this proceeding, Nintendo
20 removes the retaining lips that were shown in green, the retaining crossbar
21 that was shown in pink, as well as the bottom that was shown in blue from
22 the proposed combination.

23 This picture is not one that Professor Slocum put together. This is
24 directly from the petition page 25. I will note here that Nintendo is arguing
25 that Professor Slocum and Gamevice are somehow bodily incorporating the
26 teachings of one reference into another. That is not so. Professor Slocum is

1 merely analyzing the combination as Nintendo set forth in its petition. All
2 of Professor Slocum's 3D models shown on slide 20, 22 and elsewhere, are
3 merely 3D renders of the combinations as set out in Nintendo's petition. So
4 the bodily incorporation argument is just later fanned by Nintendo.

5 Now, the other argument that Nintendo has made is that this picture
6 shown here is just exemplary, but it is not the Board's burden nor
7 Gamevice's burden just to act as an archaeologist going through the record
8 and through Nintendo's petition to find what else might be covered by the
9 petition and what else is -- what other combinations are within the scope of
10 the petition. That was squarely Nintendo's burden, one that they failed to
11 uphold.

12 JUDGE MEYERS: Counselor, excuse me for a moment. Can you
13 point to anywhere where Professor Slocum addresses the compressive force
14 that Petitioner points to that would be provided by Park's, I guess, the
15 adjustability of Park?

16 MR. KUMAR: In a couple of ways. I think Professor Slocum
17 accepts that Park would provide that compressive force. In fact, it is that
18 compressive force that causes the instability because combined with the
19 motion of a handheld device it is that compressive force that is liable to -- or
20 to cause the tendency of the device to come out of the position that it's in.
21 And I'll get to paragraph 41 of Park as well where Park expressly discusses
22 this.

23 JUDGE MEYERS: Thank you.

24 MR. KUMAR: Yeah. So as shown on slide 22, Professor Slocum
25 looked at Nintendo's proposed combination as set forth in the petition,
26 performed an independent technical analysis then came to the conclusion

1 that you see on this slide, that a computing device would come out in the
2 direction of the user because the removed the retaining lips, the retaining
3 crossbar, and the bottom are all structural elements that are required to retain
4 that device in position.

5 As I said before, he has been a professor of mechanical engineering, at
6 MIT no less, for more than 30 years and formerly worked for the Federal
7 Government within the U.S. Department of Commerce at the National
8 Institute of Science (sic) and Technology.

9 JUDGE KINDER: Mr. Kumar, could you explain the pop out
10 argument a little bit more? Like, what forces would cause it to pop out?

11 MR. KUMAR: So, Your Honor, when there is a compressive force
12 combined with any other, kind of, lateral movement in an orthogonal
13 direction, that combination would lead do an instability essentially. That's
14 what Professor Slocum has said. When you have two pieces, the two
15 retaining sidewalls push against the phone, or in this case a tablet that's
16 sitting in an upright position based on Nintendo's proposed combination, that
17 force is essentially compressing the device that's in between and any kind of
18 movement, because this is a handheld game controller, any movement in an
19 orthogonal direction to that compressive force would combine with the
20 compressive force to create that movement that would cause -- that it would
21 tend to cause the device to come out in the direction of the user.

22 There is absolutely nothing in the direction of the user to stop a device
23 from coming out in practical reality because this is a handheld device. It's
24 not stationary on the ground.

25 JUDGE KINDER: Your arguments almost seem contradictory
26 because in one sense you're saying that the part has no compressive force but

1 then you're saying the combination would result in too much compressive
2 forces so instead of holding it would pop out.

3 MR. KUMAR: No, Your Honor, we disagree with the first one. We
4 are not saying that Park does not provide a compressive force. We're saying
5 we agree Park is there because it's an adjustable structural bridge. The
6 reason that Nintendo is trying with hindsight bias to bring it in is because it
7 provides a compressive force. We don't dispute that Park provides the
8 compressive force.

9 The problem is that compressive force without the structure on the top
10 surface to block the device from popping out, that compressive force creates
11 the instability that makes the device want to pop out.

12 JUDGE KINDER: Why wouldn't one of skill in the art just know to
13 use less compressive force?

14 MR. KUMAR: That is an issue there and it's, again, I can bring it up
15 with respect to Park paragraph 41. This is slide 23. The second paragraph
16 listed on slide 23 is paragraph 41, but I wanted to set the context by bringing
17 out a sentence from paragraph 38. Paragraph 38 says, "Figure 3 is a
18 perspective view of a mobile phone mounted on the game device -- gamepad
19 device for a mobile phone according to the present invention."

20 Now, Figure 3 of Park is showing Park's device lying on a flat surface
21 and the phone mounted on the device. In that context Park is saying the
22 mobile phone is mounted on the device. Then Park says at paragraph 41
23 what else the above configuration when the phone is lying flat on the ground
24 allows for a mobile phone to be mounted on the device according to the
25 present invention and used when it's on the ground, as the mobile phone is
26 not sufficiently in contact with the device according to the present invention.

1 When using the above configuration the mobile phone, one, may come loose
2 during gaming or become detached in severe cases, hindering comfortable
3 and stable operation of a game. So what are they saying here is sure, when
4 you set it down and you put it -- put the phone in the phone can stay
5 mounted and you can use it when it's lying flat on the ground, but the
6 moment you pick it up to play again there is insufficient contact across this
7 device for Park's phone to stay in place when gaming.

8 And that is why during gaming it may come loose, and this is a
9 problem of -- and further in paragraph 41 of Park, if I may pull it up?

10 JUDGE COCKS: How did you do that, Mr. Kumar? I do see that
11 we're getting a little bit of visual interference on Judge Meyers' video. Is it
12 distracting you in any fashion?

13 MR. KUMAR: Oh, I'm fine, Your Honor. It's okay. Thank you.

14 Paragraph 41 goes on to state, and I quote, "Further, if a user reduces
15 the length of the bridge 30, 40 to be less than the length of the mobile phone
16 in order to address this problem, the first and second bodies come to apply
17 pressure on the mobile phone potentially causing damage to the mobile
18 phone." So there is another issue.

19 So if you don't provide enough compressive force, as paragraph 41
20 says, during gaming the mobile phone can come loose or become detached.
21 On the other hand, if we provide too much force Park itself tells you can
22 damage the phone. So you're stuck between a rock and a hard place.

23 Park was using Figure 3 to explain the problem that Park was
24 eventually going to solve and that solution in Park involves a cushioning pad
25 and other elements that are described subsequently in Park. But this entire
26 embodiment of Park was set out by Park to explain the problem that Park

1 was trying to solve. And the problem is it is hard to find that balance where
2 you're pressing the phone enough that it stays in place during gaming and
3 pressing it too hard so it damages the phone. All of this is in paragraph 41
4 of the patent and the -- of Park.

5 And the initial portion of Park is just saying when you have it lying
6 down, sure, you can put the phone in and you can use it while it's on the
7 ground. But the moment you pick it up to game with it you have these
8 combination of problems and you're stuck trying to find that balance.

9 Judge Kinder, I hope that answers the question you were asking?

10 JUDGE KINDER: I believe you addressed it. Thank you.

11 MR. KUMAR: Now, starting this slide 24, Professor Slocum
12 explained in his declaration the Park's flawed design of Figures 1 and 3 is
13 structurally equivalent to the overall combination that Nintendo proposes in
14 its petition with respect to the Willner Park combination. That's why in
15 Nintendo's proposed combination as well there is that same tendency of the
16 phone to come loose during gaming or become detached, and this is the
17 problem that he's been pointing out.

18 It's based on actual description in Park plus his years of experience as
19 a mechanical engineer. I'll note that Mr. Kitchen, while very successful in
20 his business, is an electrical engineer more focused on the software aspect of
21 games, and we think that Professor Slocum is the more credible expert as a
22 mechanical engineer on this particular issue.

23 Turning to slide 25, Nintendo cites no technical analysis to the
24 contrary in its petition or reply except to mischaracterize Park's explicit
25 disclosure in paragraph 41 of the deficiency. Now, Gamevice has also
26 briefed an additional argument in this ground relating to a deficiency in the

1 design of Park's bridge itself about the ratcheting mechanism. Professor
2 Slocum identified this and put it in his declaration. It was based on his
3 independent review.

4 In the interest of time and streamlining the discussion today, we will
5 rest on the briefing with respect to that argument unless the Board has any
6 questions about the ratcheting mechanism issue that Professor Slocum
7 identified.

8 JUDGE COCKS: I don't think we do. Thank you.

9 MR. KUMAR: Thank you. So, that takes us to the issue of collateral
10 estopped. Now, as shown on slide 27, collateral estoppel requires that a
11 prior action presented the identical issue and that the judgment in the prior
12 action necessarily required determination of the identical issue. And in the
13 context of obviousness, which is what we have here, the federal case law is
14 shown on slide 28. "Where obviousness is the basis for the prior invalidity
15 holding, an inquiry into the identity of the validity issue is more properly
16 phrased in terms of the factual inquiries underlying the obviousness
17 determination."

18 Also the interconnect part here also made it clear that consistent with
19 Section 103 case law, the invention as a whole must be evaluated against the
20 prior art asserted, not merely the differences between the previously litigated
21 claims and the current claims. I think this is relevant to the terminal
22 disclaimer issue that Nintendo brought up with respect to its slide 9
23 (phonetic sp.).

24 Turning to slide 29, let's look at the Board's analysis in the '119 IPR.
25 In IPR 2018-01522 of the '119 patent, Nintendo's petition, as we've said
26 before, included all the elements of Willner's adapter 210, including the

1 retaining crossbar in pink across the middle and the bottom in blue across
2 the bottom.

3 The Board did use a slightly different claim construction for the
4 confinement structures. As shown on the left-hand side, the Board stated
5 that "It encompasses confinement structures in the context of the '119 patent
6 encompasses a three-sided structure in which the computing device is fully
7 nested."

8 But more importantly, turning to the right-hand side, the Board
9 analyzed Willner, including its retaining crossbar in pink color, which it
10 called a front crossbeam, and the bottom in blue color across the bottom.
11 And the Board stated, "Willner's adapter has a bottom, a rear-facing side and
12 a front crossbeam. The sidewalls of Willner's adapter are additionally
13 connected by a bridge structure spanning the bottom, the front, and the rear
14 sides."

15 And then in the final conclusion, factual conclusion, "As Willner
16 clearly illustrates, once the computing device is received within the opening
17 movement of the computing device is confined not only by the adapter's
18 opposing sidewalls but also by the front, rear, and bottom walls bridging the
19 two sidewalls." So this is the determination of the factual -- underlying
20 factual issue that the Board reached in the 01522 IPR.

21 JUDGE COCKS: Counsel, ground me, what are you asking us to take
22 from that what you just said?

23 MR. KUMAR: What I'm asking you to take, Your Honor, is that the
24 factual finding, the underlying factual finding related to obviousness that the
25 Board made in the '119 IPR here is different from the one that is going to be
26 asked to be made in the context of Nintendo's proposed ground here because

1 Nintendo's proposed combination now does not have the front crossbeam,
2 does not have the bottom. And those were factors that the Board considered
3 in coming to its conclusion that there is a confinement structure because the
4 movement is confined by all those elements put together.

5 So now what's before the Board is different. There is no front. There
6 is no bottom. And now a factual finding has to be made separately in this
7 type of a post combination that Nintendo has in its petition, would you still
8 have the same confinement? So it's a different factual inquiry that underlies
9 the obviousness question.

10 So we see on slide 30 the combination that the Board here starts with
11 analyzing is not identical because Nintendo chose to remove the retaining
12 lips in green across side-to-side or along the bottom. It chose to remove the
13 retaining crossbar in the pink color across the middle. And it chose to
14 remove the bottom in blue color along the bottom.

15 And these were part of the Board's analysis in the previous case of
16 reaching the factual findings that it did and that's why the issue here is
17 different in this context, and that's why collateral estoppel does not apply.

18 Now, turning to slide 31, the final issue with respect to Ground 1
19 concerns Nintendo's reply Gamevice's Patent Owner response. Rather than
20 point out any deficiency in Professor Slocum's mechanical analysis of the
21 combination, Nintendo proposes to modify the grounds further in its petition
22 in view of Gamevice's position.

23 Gamevice believes that the Board should not allow Nintendo to keep
24 moving goalposts in this manner. Nintendo is trying to move the goalpost in
25 five different ways with respect to Ground 1. As shown in slide 32,

1 Nintendo argues in reply for "adding back in Willner or Kessler's lips alone,"
2 which it had previously removed from the proposed combination.

3 Turning to slide 33, Nintendo argues in reply for "adding in Park's
4 cushioning pad 60," which is nowhere in the petition.

5 Turning to slide 34, Nintendo argues in reply for "broadening Park's
6 bridge or adding a lock switch to offer additional stability," again, not a hint
7 of this in the petition.

8 With respect to slide 35, Nintendo argues for "adding in Kessler's
9 tensioning mechanism into the Willner and Park combination." Again, no
10 hint of this in the petition.

11 And then turning to slide 36, Nintendo was required but failed to
12 articulate in its petition where and how to position the connectors between
13 the sidewalls of Willner's adapter 210, given that all the other material of the
14 adapter has been removed, how to position and where to position the
15 connectors that connect Willner's adapter 210 and Park's adjustable bridge.

16 Now, Nintendo argues in reply for adding in screws or snap-fit
17 connectors to connect the sidewalls and the bridges in the Willner Park
18 combination, and there was no notice of this in the petition. All of these are
19 improper.

20 In its reply Gamevice cited the Wasica case. On slide 37 here's a
21 quote from that case, and I quote, "It is of utmost importance that Petitioners
22 in the IPR proceedings adhere to the requirement that the initial petition
23 identify with particularity the evidence that supports the grounds for the
24 challenge to each claim. Unlike District Court litigation where parties have
25 greater freedom to revise and develop their arguments over time and in
26 response to newly discovered material, the expedited nature of IPRs bring

1 with it an obligation for Petitioners to make their case in their petition to
2 institute it." And the citation for this is 853 F.3d 1286.

3 On slide 38 here's another quote from pages 1286 and 1287 of that
4 same Wasica case applicable to Nintendo shifting positions in this
5 proceeding. "Rather than explaining how its original petition was correct,
6 Petitioners' subsequent arguments amount to an entirely new theory of prima
7 facia obviousness absent from the petition. Shifting arguments in this
8 fashion is foreclosed by statute or precedent and Board guidelines."

9 So the Board should not credit these new arguments made for the first
10 time in reply. Collateral estoppel does not apply. And when you look at the
11 intrinsic disclosure in Park, as well as Professor Slocum's based on 30 years
12 of experience as a mechanical engineer of the highest repute, the
13 combination that Nintendo has proposed in its petition doesn't work as
14 intended. And that's why a person of ordinary skill would not be motivated
15 to go ahead and make that combination, nor does it satisfy the limitation of
16 the confinement structures as arranged in the claim.

17 With that, I'll move to the second ground. This is in view of
18 Schoenith and Park. Some of the issues are similar but not quite the same,
19 so I will walk through this in some detail.

20 Again, there are four disputed issues that are shown on slide 40, and
21 we'll start by taking the first two issues together. They are the same issues
22 as we've dealt with before with respect to the Ground 1, which is that the
23 claim arrangement of the confinement structures are not disclosed or
24 suggested and there is no motivation to combine as the petition proposes.

25 There are two main arguments here with respect to these disputed
26 issues. First, turning to slide 42, Nintendo's proposed combination here

1 violates the claimed requirement that each electronic game control module is
2 a separate and distinct structure from each of their corresponding
3 confinement structures, forming no structural portion of their corresponding
4 confinement structures.

5 Let's look at that claim construction. Again, turning to slide 43, as we
6 discussed before a pair of confinement structures has been construed here in
7 this proceeding as physical components that hold a computing device.
8 Importantly, the electronic game control modules cannot participate in
9 holding the computing device because of the specific language on slide 42
10 that says that the electronic game control modules have to be separate and
11 distinct structure and forming no structural portion of the physical
12 components that hold the computing device.

13 And therefore, the electronic game control modules must form no
14 structural portion of the confinement structures, meaning they cannot be
15 included among the physical components that hold the computing device.

16 Now, when you look at the petition's proposed combination of
17 Schoenith and Park, Nintendo cannot deny that the overlapping portions of
18 the side panels three and four they form a portion of the structure that would
19 hold the computing device.

20 And the graphic on the left is taken from page 43 of Nintendo's
21 petition, and the graphic on the right is taken from paragraph 267 of Mr.
22 Kitchen's declaration in support. You can see that the side panels three and
23 four overlap the computing device and they are meant to prevent it from
24 falling out in the direction out of the page. This violates the claimed
25 requirements here because the control modules are now among the physical
26 components that are being used to hold the computing device.

1 JUDGE KINDER: Mr. Kumar, make sure you introduce the slides by
2 number --

3 MR. KUMAR: Sorry. Thank you, Your Honor.

4 JUDGE KINDER: -- for the record and for us.

5 MR. KUMAR: So, for the record I'm pointing to slide 44 where you
6 can see with the graphic on the right-hand side, the side panels three and
7 four are overlapping the computing device as shown in Mr. Kitchen's
8 declaration and therefore they are part of the structure that is holding the
9 computing device.

10 Now, let's move to the second issue or the second point of dispute.
11 Looking at slide 45, Schoenith's design is shown as is on the right-hand side.
12 That design includes a cradle 20 in the middle. You can see that it has raised
13 sidewalls 23 on either side and a raised sidewall 24 along the bottom. Along
14 with some structure at the bottom going from left to right there's also a
15 crossbeam at the top going from left to right.

16 For reference in IPR2018-01521 of the '119 patent, Nintendo's
17 petition there included the entire cradle in its proposed combination. The
18 citation for that proposition is Exhibit 1043, pages 28 through 33 and 49
19 through 51.

20 Turning to slide 46, compare that situation in the 01521 IPR on the
21 left-hand side against Nintendo's proposed combination in this proceeding
22 on the right-hand side. The graphic on the right is taken from page 43 of
23 Nintendo's petition.

24 You can see that in Nintendo's combination here only the raised
25 sidewalls 23 on the opposite sides remain. The raised sidewalls 24 along the
26 bottom is missing, along with the structure at the bottom going from left to

1 right. Also the cross beam at the top going from left to right is missing and
2 the back of the cradle 20 has been replaced with Park's narrower bridge.

3 Now turning to slide 47, Professor Slocum looked at Nintendo's
4 proposed combination in its petition, performed an independent analysis, and
5 came to the conclusion that you see on the right-hand side of this slide.

6 What he found was that only the small regions indicated by the red arrows
7 provide any resistance to the computing device tipping away from the user.

8 You can see there's an X marked above the bridge indicating that the
9 computer is -- the top of the computing device would tip away from the user
10 into the page and the bottom portion would tip towards the user out of the
11 page.

12 So turning to slide 48, Professor Slocum explained that the computing
13 device when placed in this system proposed in the petition, the computing
14 device is prone to tipping into the page because Schoenith's panels three and
15 four would only overlap a small portion of Park's narrower adjustable
16 bridge. And he referred to this concept as having a weak tilting moment
17 capacity.

18 Now, Nintendo cites no technical analysis to the contrary in its
19 Petitioner reply, whereas turning to slide 49, Professor Slocum provided a
20 technical explanation of the physics, the mechanics, behind the
21 combination's weak tilting moment capacity. This is what you're seeing in
22 front of you in terms of the graphics taken from paragraphs 96 through 98 of
23 his declaration.

24 Here -- and what he's trying to explain here is that the computing
25 device which is the -- I marked as the iPad tips above the edge of Park's

1 bridge on the left-hand side. The resistance to that tipping is provided by the
2 overlap region between the bridge and the control module.

3 And the resistance to tipping is proportional to the square of the
4 overlap region's width, which is indicated as L in the figure. So this is the
5 mechanical analysis that Professor Slocum is identifying. He's pointing to
6 the height of the overlap, calling that a distance L, and showing you that the
7 resistance to tilting is proportional to the square of that overlap with.
8 Nintendo does not dispute any of this analysis. It cites no technical analysis
9 to the contrary in its reply.

10 So because of that weak tilting moment capacity, once again you find
11 that the combination proposed in the petition would not serve its intended
12 purpose of holding the computing device in place during normal operation,
13 and that is why there is no motivation here for a person of ordinary skill to
14 make this combination, nor is there any satisfaction of the claimed
15 arrangement of the pair of confinement structures because it allows for
16 inadvertent removal during operation.

17 Turning to collateral estoppel, again, it does not apply here. I'll skip
18 the case law slides and go straight to slide 53 because the case law is roughly
19 the same. Turning to slide 53, as we've already discussed, Nintendo's
20 petition included all the elements of Schoenith's cradle 20, including the
21 raised sidewalls, sidewall 24 at the bottom along with the structure at the
22 bottom going from left to right and also the crossbeam at the top going from
23 left to right.

24 Turning to the right-hand side of slide 53, this is the Board's analysis
25 in the 01521 IPR. And the Board analyzed Schoenith, including the
26 structures on the front side. These are the raised sidewalls 24 along the

1 bottom, along with the structure at the bottom going from left to right, as
2 well as the crossbeam at the top going from left to right. And those elements
3 were part of the Board's analysis in the 01521 IPR of the '119 patent.

4 And that's why the inquiry there was different than from what the
5 Board is tasked with looking into here because Nintendo chose to remove
6 those front side elements from its combination that is proposed in this
7 petition.

8 As you can see on slide 54, Nintendo has removed all of those that
9 were here and left only the raised sidewall 23 on the opposite sides of the
10 cradle and removed the remaining structure. And that's the reason why the
11 issue being placed here before the Board for determination is different from
12 the previous IPR. And that's why collateral estoppel does not apply.

13 Now, once again, when faced with these arguments in Gamevice's
14 Patent Owner response, rather than try and explain why those arguments
15 were incorrect Nintendo tries to move the goalpost in five different ways by
16 modifying its grounds for the first time in its reply. And the Board should
17 not allow this in the context of this proceeding.

18 So again, with respect to slide 56, Gamevice adds -- argues in reply
19 for adding back just the lips which it had previously removed.

20 With respect of slide 57, Nintendo argues for adding in the cushioning
21 pad which appears nowhere in the petition from Park.

22 With respect to slide 58, Nintendo argues in reply for broadening
23 Park's bridge or adding a locksmith -- switch, lock switch, excuse me.
24 Again, no notice of any of that in the petition.

1 And then on slide 59 Nintendo again argues in reply for adding in a
2 tensioning mechanism from Kessler. Again, no notice of that in the petition
3 anywhere.

4 And finally, with respect to slide 60, Nintendo again was required to
5 articulate where and how to position the connectors between the sidewalls of
6 Schoenith's cradle and Park's adjustable bridge because all of the other
7 remaining structures are removed. Now, Nintendo is arguing in reply for
8 adding in screws or a snap-fit connector to connect the sidewalls and the
9 bridges in the combination. And the Board should not allow for these
10 related arguments because they're prejudicial to creating a proper record and
11 evidentiary record of the proceeding.

12 The arguments with respect to Ground 3, turning to slide 63, the
13 arguments with respect to Ground 3 are pretty much identical to that of
14 Ground 2. The only difference in Ground 3 is that instead of Park's
15 adjustable bridge, Kessler's extension mechanism 82 is being used.

16 That difference doesn't impact any of the analysis or any of the
17 argument that are displayed before you with respect to Ground 2 so the exact
18 same arguments apply with respect to Ground 3,, including with respect to
19 collateral estoppel and Nintendo moving the goalposts in terms of arguing
20 for new prima facie theories of obviousness for the first time in reply.

21 So with that, I will reserve my time unless there' are further questions
22 that you would like me to answer with respect to these claims?

23 JUDGE COCKS: All right. You'll have your full time so you'll have
24 five minutes plus the 10, so 15 minutes for a surrebuttal. But I just want to
25 make one point. So neither side has been discussing Ground 4. Are you just
26 relying on your briefs for Ground 4?

1 MR. KUMAR: Yes, Your Honor. I'm happy to discuss it except that
2 Nintendo's counsel did not so I don't wish to exceed --

3 JUDGE COCKS: Okay, thank you.

4 MR. KUMAR: -- the scope of his argument.

5 JUDGE COCKS: Thank you.

6 MR. KUMAR: Thank you, Your Honor.

7 JUDGE COCKS: Whenever you're ready.

8 MR. KINSEL: Thank you. Let me address tail end of counsel's
9 presentation about the question of moving goalposts, and in particular
10 Gamevice's citation to Wasica, which was one of the cases that Gamevice
11 relies on. Gamevice has never described the facts of the Wasica case
12 because it's so diametrically different from what we're talking about here
13 that it would be obvious that it doesn't apply. So what happened in Wasica
14 was the Petitioner made a very conclusory obviousness-type argument, right,
15 so something along the lines of for all the reasons stated above the invention
16 is obvious, the claim is obvious, relying on a particular portion from the
17 reference.

18 When the reply -- when it came time to reply the Petitioner came up
19 with a completely new obviousness analysis, one that they had never made
20 before relying on different elements from the reference. That's manifestly
21 not what's going on here. Nintendo's combinations haven't changed.
22 Nintendo's evidence hasn't changed.

23 What we did is we responded to Gamevice's criticism. Gamevice's
24 criticism was that the computing device would pop out inadvertently. And
25 so what we did is we audit -- we offered evidence showing that a person of
26 skill in the art would know how to address that very problem based on the

1 prior art in front of them. And that's a standard, appropriate reply. It's not
2 moving the goalposts. It's just responding to an argument that Gamevice
3 made.

4 In fact, the case that is really most aligns with what's going on is the
5 Pride Mobility case that we talked about earlier on slide 52. Again, what
6 happened in Pride Mobility is almost exactly what happened here. The
7 Petitioner put in its petition. The Patent Owner said, well, the prior art
8 combined as Petitioner has suggested would lead to instability. Then
9 Petitioner responded saying, well, a person of skill in the art would know
10 how to solve that problem.

11 The Federal Circuit said that was appropriate. The Board said that
12 was appropriate, and that's what Nintendo has done here. Now, Gamevice
13 has made a conscious decision not to respond to Nintendo. So keep in mind
14 that Nintendo made these arguments about lips and all of the various means
15 that a person of skill in the art would have to avoid any, kind of, a
16 computing device pop out problem if that problem actually existed, made
17 that in their -- in our reply.

18 Gamevice had a surreply and could have responded had they had a
19 response to give, but they didn't. Gamevice could have taken Mr. Kitchen's
20 deposition but they never asked for it. In fact, Gamevice took no deposition
21 testimony in this matter at all and only noted they did request Mr. Kitchen's
22 deposition, but then the day before the deposition was to take place they
23 unilaterally cancelled it. So they've never taken any deposition testimony.
24 They could have easily responded to this issue if they had a response to give.

25 They just simply made a strategic decision to claim prejudice and not
26 to respond. So there have been no moving of the goalposts. There's just

1 been a simple response to Gamevice's arguments that are not very
2 persuasive, and that's what's really happened here.

3 Let me talk about this issue of the separate and distinct limitation,
4 1(d)4. This is the limitation that Gamevice talks about with respect really
5 only to the Schoenith combinations. And what you'll see when you go back
6 and you look at slides, Gamevice's slides 42 through 44, Gamevice's
7 argument seems to be that the panels of Schoenith, because they overlap
8 with the computing device, the smartphone or tablet in the device, somehow
9 become part of the confinement structures and somehow, and somehow
10 become part of a structural portion of the component structures. But there's
11 just absolutely no basis for this argument. It doesn't exist in the confinement
12 structures limitation. There's no negative limitation, for example, in the
13 confinement structures limitation that says other things can't also hold a
14 computing device.

15 And, in fact, if that were the construction you'd read out all of the
16 embodiments regarding Figure 16, for example. So let me give you an
17 example. Figure 16 has a structural bridge and a latch and that latch and
18 structural bridge force the two confinement structures to squeeze onto the
19 sides of the computing device. Under Gamevice's interpretation, because the
20 structural bridge and the latch are involved in holding the computing device,
21 they too are part of the confinement structure, so they too form a structural
22 portion of the confinement structures in 1(d)4.

23 And the problem with that is that the claim explicitly precludes the
24 structural bridge from being part of the confinement structures in the same
25 way that the modules can't be part of the confinement structure. So, for
26 example, 1(d)5 says, "in which each of the pair of confinement structures are

1 separate and distinct from the structural bridge forming no structural portion
2 of the structural bridge." So what Gamevice's analysis that you just heard
3 here today does, is it reads Figure 16 out of the claims because under
4 Gamevice's analysis the structural bridge, which is indubitably involved in
5 holding the computing device, is now a structural portion of the confinement
6 structures. And that can't happen under 1(d)5.

7 So Gamevice's theory is just contrary to the claim and it's also
8 contrary to, sort of, common sense about the about the prior art. So let me
9 go to slide 57 so we can see Figure 3, okay? Figure 3 is from Schoenith, and
10 what Gamevice's position is is that because those panels hold or help hold, I
11 guess, the computing device they somehow form a structural portion of the
12 confinement structures.

13 But you can see that the whole point of Schoenith is that the modules
14 are detachable. They don't attach. They're not permanently attached.
15 They're detachable components so that's why we cited the art.

16 So to suggest that we can't say that they don't form a structural portion
17 of the corresponding confinement structures is nonsense. They clearly don't.
18 They're detachable. That's the whole point of this reference.

19 I wanted to take a look quickly at Gamevice's position on what the
20 Board specifically found in the '119 IPR. Gamevice spends a lot of time
21 talking about how Nintendo, sort of, switched around those combinations,
22 but it's just, it's just not true. So if we look, for example, at slide 8, this is an
23 excerpt from the Board's final written decision in the 01522 case, and here's
24 what the Board said.

25 "We disagree that there is any meaningful structural or functional
26 difference between the sidewalls of Willner's adapter and the pair of

1 confinement structures that are cited by Claim 1." So we were all on the
2 same page that we were talking about the same combination, and Gamevice
3 doesn't even address Mr. Kitchen's combination.

4 And so this is the combination that we proffered. Gamevice says that
5 we somehow modified the Willner adapter, but here is the combination on
6 slide 13 that we've proposed. It is true this is Mr. Kitchen's declaration, but
7 that is the basis of our combinations so Gamevice is incorrect there.

8 Gamevice talks about this supposed problem with Park that if you
9 leave Park on the ground I think is what Mr. Kumar said, Park works but as
10 soon as you pick it up it doesn't. There's no indication in Park that that's
11 true.

12 What Park shows is that -- pardon me, if I can get to Park here. Here
13 it is. What Park shows is that his device holds a computing device. That's
14 what it was designed to do. It has additional features for additional
15 functionality, but it specifically claims this embodiment, just the gamepad
16 embodiment as a separate claim. You can see that on slide 38.

17 So to suggest that somehow Park knew that his device didn't work is
18 really contrary to the Park patent. The Park patent claims the gamepad all
19 by itself not sitting, you know, on the floor as Mr. Kumar said, but rather
20 just as a gamepad.

21 Now, Gamevice says that we are removing all meaning from the word
22 hold, but that's just not true. So we see Park, slide 28 -- no that's -- sorry. I
23 beg your pardon. We see Kessler on slide 28 and Kessler is holding a
24 phone. We see Park holding a phone. That's what these devices are
25 intended to do.

1 And Gamevice is -- or Nintendo isn't removing the meaning of the
2 word hold. We're just not ascribing some additional meaning to it that
3 Gamevice is. Gamevice wants to narrow that down so that it has a very, sort
4 of, microscopic scope to save these claims. But that's not what the word
5 means.

6 The word doesn't need to do any further claim construction, sort of,
7 meta construction on that term. The term is hold. There's nothing in the
8 claims. There's nothing in the construction of the claims that requires
9 computing devices to be held in any particular way, including inadvertent
10 removal, right? The claims don't say that.

11 The claims simply require physical structures like confinement
12 structures. And those confinement structures have to interact with the
13 computing device. Gamevice could have claimed confinement structures
14 that hold a computing device to prevent inadvertent removal, but that's not
15 what it claimed. What it claimed is confinement structures that interact with
16 a computing device. That's all they have to do. That's the scope of the
17 limitation and to ascribe inadvertent popping out or prevention of
18 inadvertent popping out and all this other stuff is to read in limitations to the
19 claims that just simply are not there.

20 JUDGE COCKS: Mr. Kinsel, could you, and I apologize if you
21 already did, but can you address the arguments made with respect to Park
22 paragraph 41 --

23 MR. KINSEL: Yes.

24 JUDGE COCKS: -- that talks about "the mobile phone is not
25 sufficiently in contact with the device according to the present invention

1 when using the above configuration, the mobile phone (1) may come loose
2 during gaming."

3 MR. KINSEL: Yeah. So we talked about that earlier and what the
4 claim -- what the sentence, the full sentence really says is that the device can
5 be used. There are circumstances, severe use, for example, where you might
6 want to do something else, where you might want to add some additional
7 embodiments. And that is really what Park is after.

8 So Park describes at least three different embodiments. The first
9 embodiment is just the gamepad. The second embodiment is a gamepad
10 plus the two cushioning pads on either side, and the point of those
11 cushioning pads is that you can use the ratchet mechanism in such a way that
12 you could scratch or damage the sides of your computing device. And so
13 you could add a cushioning pad.

14 And then the third embodiment, and actually this is the fourth claim,
15 is this, sort of, air bladder-type device that will help to further secure the
16 computing device, but Park isn't suggesting that his device doesn't work. He
17 says in this first part of the sentence that it does work. "Whereas the above
18 configuration sufficiently allows for a mobile phone to be mounted on the
19 device according to the present invention and used." You can use it for its
20 purpose.

21 He's talking here about game play. That's what, that's what this whole
22 patent is about. So he certainly thinks that the device can be used. It may be
23 that in severe circumstances you want to have this air bladder situation, but
24 Park is talking about compression in exactly the same way that the '393
25 patent is talking about it, and Park solves the problem of computing device
26 pop out and describes how to do it.

1 Well, unless there's any further questions I think I'm just about out of
2 time, but I'm happy to answer any further questions if there are any.

3 JUDGE COCKS: I don't think we have any further questions. Thank
4 you.

5 MR. KINSEL: Thank you very much.

6 JUDGE COCKS: Whenever you're ready.

7 MR. KUMAR: Thank you, Your Honors. Three points. We'll start
8 with Park. Thank you for waiting on the screen. There is no question that
9 paragraph 41 of Park is addressing the problem to be solved by Park's patent
10 application. As we all know, patent applications are typically written in the
11 format where problems are identified and then there's a statement of
12 identifying that there are needs for these problems to be solved, followed by
13 a description of the solutions to the problems.

14 Now, if you look at Park, this is Park paragraph 41, where if you look
15 at the immediately following paragraph, paragraph 42, you will see Park
16 says, quote, "Accordingly, there is a need for an art that allows a mobile
17 phone (1) to be seated for stability in the device according to the present
18 invention and also reduces the pressure applied on the mobile phone." That
19 recitation of the needs to be solved, the needs that are there in the art clearly
20 emphasizes that paragraph 41 is talking about the problems to be solved.

21 And so this is referring to problems that Park had with the way things
22 are in this configuration, and those are the same problems that manifest in
23 the petition combinations.

24 JUDGE KINDER: Could you explain how Park solves it? Is it by
25 using cushions and the air bladders on the sides?

1 MR. KUMAR: Yes, Your Honor. There is a cushioning pad that's
2 added to Figure 4 of Park. If I could bring up Exhibit 1004 on the screen?

3 JUDGE KINDER: We can also pull it up if you can't.

4 MR. KUMAR: Yes. I'm just waiting to see if this screen will show
5 up but if not, you will see in Figure 4 there is a cushioned pad towards the
6 right-hand side of that figure. You'll see it's marked as element 60. And that
7 cushioning pad is also connected, as you see in Figure 5, to this complex
8 hydraulic mechanism or air mechanism to inflate or deflate the cushioning
9 pad as necessary in order to modulate the force that's applied on the mobile
10 phone. So this is the solution that Park is going after. And Figure 3 is to
11 explain the problem that leads to its invention of this solution with the
12 cushioning pad 60 and the associated, sort of, pneumatics or hydraulics or
13 whatever the way it is the correct way is to explain that, the air -- modulating
14 the air pressure. So that's what's going on here.

15 JUDGE MEYERS: Excuse me, Mr. Kumar. At paragraph, sorry,
16 paragraph 38 Park specifically says that Figure 3 is the present invention, is
17 that mobile phone according to the present invention.

18 MR. KUMAR: Yes, Your Honor. It does say that the Figure 3 is a
19 perspective view of a mobile phone mounted on the gamepad device for a
20 mobile phone according to the present invention. It is referring to the fact
21 that these solutions are meant to be applied to mobile phones such as the one
22 that you see in Figure 3, not that Figure 3 is somehow the invention.

23 JUDGE MEYERS: Okay. But looking at that Figure 4 then, you
24 were pointing out that other than 16 with the aircraft, in your opinion would
25 that then share the same negative effects of a compressive force backing out
26 the phone?

1 MR. KUMAR: I do not have an analysis from Professor Slocum on
2 which to rely to give you an assessment one way or the other, sorry.

3 JUDGE MEYERS: Okay, thank you. Apologies for that.

4 MR. KUMAR: So that's the first one I wanted to --

5 JUDGE KUMAR: And apologies for my video.

6 MR. KUMAR: No worries, Your Honor. Any other questions with
7 respect to Park? Otherwise I'll move on to my second topic.

8 So the second topic concerns counsel's argument regarding claim
9 limitation 1(d)5. Just to orient everybody, let me bring up slide 44. So on
10 slide 44 what you will see is that the side panels (3) and (4) of Schoenith
11 they overlap the computing device. And as Gamevice has argued before,
12 this violates the requirement of 1(d)4 because now the side panels or the
13 control modules are part of the structure that's holding the computing device
14 in place.

15 In response to which counsel brought up limitation 1(d)5, which says
16 that the structural bridge also has to be separate and distinct from the pair of
17 confinement structures and form no structural portion thereof and made the
18 assertion that somehow this was not true when it came to the '393 patent.
19 And I want to show you why that's incorrect.

20 So if you go to the patent and look at Figure 18 --

21 MR. GOLDBERG: Let me see if I can bring that up.

22 MR. KUMAR: -- you will see a side view of the overall configuration
23 that is also the configuration of Figure 16. You will see that you have the
24 confinement structures marked here as the U-shaped confinement structures
25 336 on the left and right-hand sides.

1 You will see that in this embodiment there is an upper lip to the U-
2 shaped structure and a lower lip to the U-shaped structure. You will see that
3 the lower lip of the U-shaped structure is at a level that is above that of the
4 structural bridge. There is no indication anywhere in this patent that
5 somehow the computing device rests on the structural bridge. That is just
6 not true.

7 In fact, it rests within the confines of elements 336 and even the
8 lowest lip of 336 is above the elevation of the surface of the structural
9 bridge. That's the best evidence we have for what's going on here, so the
10 argument that counsel is making that somehow claim limitation 1(d)5 is
11 contrary to what we're saying about claim limitation 1(d)4 is just not true.

12 And then the final point I would make is counsel for Nintendo faulted
13 Gamevice for not taking Mr. Kitchen's deposition and so on and so forth and
14 perhaps trying to suggest that there was an opportunity to make arguments
15 about the additional combinations that Nintendo posited in its reply. The
16 problem is Gamevice was denied the opportunity to seek the independent
17 technical analysis of the more credible, the more credible mechanical expert
18 in this case, and that is Professor Slocum. He's got 30 years of experience as
19 a professor at MIT and he's a Federal Government employee previously. He
20 was a mechanical engineer at NIST.

21 And Gamevice was denied the opportunity to seek his independent
22 technical analysis, submit a declaration within the time constraints and the
23 schedule of this proceeding. And so to say that somehow Gamevice did
24 have the opportunity to develop a full and fair evidentiary record is just not
25 true in that context.

1 With that, I have nothing else to say. I'm happy to answer any
2 questions that you have.

3 JUDGE COCKS: I don't think we have any further questions, thank
4 you.

5 MR. KUMAR: Thank you so much.

6 JUDGE COCKS: Well, we thank both sides for their time and
7 presentation today. It's been very informative. The case is submitted and
8 we are adjourned. Thank you.

9 (Whereupon, the proceedings at 3:00 p.m. were concluded.)

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