Grant E. Kinsel, Bar No. 172407
GKinsel@perkinscoie.com
PERKINS COIE LLP
1888 Century Park East
Suite 1700
Los Angeles, CA 90067
Telephone: 310.788.9900
Facsimile: 310.788.3399
Attorneys for NINTENDO OF AMERICA INC. and NINTENDO CO., LTD.

UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

GAMEVICE, INC.,

Plaintiff,

v.

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

Defendants

Case No. 3:18-cv-1942-RS

Notice of Motion and Motion Request to Vacate Portions of Judgment in View of Federal Circuit's Remand

Date: May 14, 2026
Time: 1:30 p.m.
Crt Rm: 12

NOTICE OF MOTION

PLEASE TAKE NOTICE, that on May 14, 2026, at 1:30 p.m., in Court Room 12, of the above-entitled Court, Nintendo will—and here by does—request that the Court modify the judgment entered in this case pursuant to the January 16, 2026, opinion of the United States Court of Appeals for the Federal Circuit.

BACKGROUND

This is a patent-infringement case in which Gamevice asserted the following patents and claims: Claims 1–4, 6, 7, 12 of U.S. Patent No. 10,391,393 (the "'393 patent"); Claims 1–2 of U.S. Patent No. 9,855,498 (the "'498 patent"); and Claims 1–4, 6–8, 16–19 of U.S. Patent No. 9,808,713 (the "'713 patent") (collectively, the "Asserted Patents" and the "Asserted Claims").

In January 2023, in connection with claim construction, the Court determined that claim 12 of the '393 patent was indefinite. Dkt. 241. Gamevice did not appeal that determination. The Asserted Claims other than claim 12 of the '393 patent are the "Remaining Asserted Claims."

In March 2023, the Court granted in part and denied in part Nintendo's Motion for Summary Judgment of Invalidity and determined that all Remaining Asserted Claims (except claim 16 of the '713 patent) were invalid as anticipated in view of Gamevice's allegations of infringement by the accused device, the Nintendo Switch. Dkt. 245. The Court reconsidered that order and determined that some claims were not anticipated in view of Gamevice's allegations of infringement by the Nintendo Switch. Dkt. 250. The Court's disposition of the Remaining Asserted Claims is shown in the table below:

Patent	Anticipated	Not Anticipated
'713 patent	1, 2, 8, 17, 18, 19	3, 4, 6, 7, 16
'498 patent	1, 2	
'393 patent	1–4, 7	6

In October 2023, the Court granted Nintendo's Motion for Summary Judgment of Noninfringement and determined that the claims that were not anticipated were not infringed. Dkt. 270.

Following these rulings, the Court entered an Amended Judgment holding: (a) claim 12 of the '393 patent invalid as indefinite; (b) claims 3, 4, 6, 7, and 16 of the '713 patent and claim 6 of the '393 patent not infringed by the accused Nintendo Switch; and (c) claims 1–2, 8, 17–19 of the '713 patent, claims 1–2 of the '498 patent, and claims 1–4 and 7 of the '393 patent invalid as anticipated in view of Gamevice's allegations of infringement by the Nintendo Switch, or, in the alternative, as not infringed. Dkt. 274.

Gamevice appealed to the Federal Circuit, challenging the Court's determination that claims 3, 4, 6, 7, and 16 of the '713 patent and claim 6 of the '393 patent were not infringed. Gamevice did not appeal any other aspect of the Court's judgment.

On January 16, 2026, the Federal Circuit affirmed this Court's noninfringement determination and remanded the matter back to this Court. The Federal Circuit's Opinion and Judgment are attached as Ex. 1. The Federal Circuit affirmed the Court's determination of noninfringement with respect to the claim term "apertures" that "secure" "instructional input devices," which appears in all Remaining Asserted Claims of the '713 and '498 patents. The Federal Circuit did not address the Court's determination of noninfringement of the "confinement structures" limitation because it was unnecessary to do so: although the '393 patent claims recite "confinement structures" and not "apertures" that "secure," the PTAB found all Remaining Asserted Claims of the '393 patent unpatentable in an *inter partes* review, *see* Ex. 2 (Final Written Decision), and Gamevice did not appeal that determination. *See XY, LLC v. Trans Ova Genetics*, 890 F.3d 1282, 1294 (Fed. Cir. 2018)) ("When a claim is invalidated at the PTAB, and that decision is made final, the cancellation of the claim carries preclusive effect in a co-pending litigation because the cause of action is extinguished."). Gamevice did not appeal the PTAB's Final Written Decision, which became final before the Federal Circuit issued its opinion.

Because Gamevice had contended that this Court's noninfringement and anticipation rulings were inconsistent, the Federal Circuit asked Nintendo's counsel at oral argument whether Nintendo would agree to vacatur of the invalidity judgment if the Federal Circuit affirmed noninfringement. Nintendo agreed, and the Federal Circuit's opinion accordingly remanded to this Court for Nintendo to request that the Court (1) vacate the portions of the Court's judgment determining that the Nintendo Switch anticipated any of the Remaining Asserted Claims and (2) enter its alternative noninfringement judgment as to all Remaining Asserted Claims.

NINTENDO'S REQUEST ON REMAND

Consistent with the Federal Circuit's decision and its representation at oral argument, Nintendo hereby requests that the Court vacate the portions of its judgment in which, in view of Gamevice's infringement allegations, the Nintendo Switch is found to have anticipated the asserted claims. Nintendo has prepared and files herewith a proposed amended final judgment to effectuate the vacatur. Nintendo also draws the Court's attention to the following three points:

First, Gamevice did not appeal the Court's judgment that the Nintendo Switch anticipates claims 1 and 2 of the '498 patent. *See* Ex. 1 at 2 n.1. Nevertheless, vacatur is in the Court's discretion, and Nintendo does not oppose vacatur of the invalidity judgment as to those claims provided the Court enters judgment of noninfringement of those claims.

Second, although the Remaining Asserted Claims of the '393 patent do not recite the "apertures" that "secure" limitations, vacatur of the Court's anticipation judgment does not remove finality because the PTAB independently determined that all asserted claims of the '393 patent are unpatentable and Gamevice did not appeal that determination. Because the '393 claims no longer exist, Gamevice has no cause of action on that patent, and the proposed judgment accordingly enters judgment for Nintendo and against Gamevice as to those claims.

And third, the proposed judgment confirms that Nintendo is the prevailing party and lifts the current stay of execution of judgment on taxed costs, Dkt. 281.

Dated: April 6, 2026

PERKINS COIE LLP

By: */s/ Grant Kinsel*
Grant Kinsel, Bar No. 172407
gkinsel@perkinscoie.com

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

CERTIFICATE OF SERVICE

I hereby certify that on April 6, 2026, I electronically filed the foregoing document with the Clerk of the Court using the CM/ECF system, which will send notification of such filing to all counsel of record for the parties.

/s/ *Grant E. Kinsel*
Grant E. Kinsel

EXHIBIT 1

NOTE: This disposition is nonprecedential.

United States Court of Appeals for the Federal Circuit

GAMEVICE, INC.,
Plaintiff-Appellant

v.

NINTENDO CO., LTD., NINTENDO OF AMERICA, INC.,
Defendants-Appellees

2024-1467

Appeal from the United States District Court for the Northern District of California in No. 3:18-cv-01942-RS, Judge Richard Seeborg.

Decided: January 16, 2026

ERIK R. PUKNYS, Finnegan, Henderson, Farabow, Garrett & Dunner, LLP, Washington, DC, argued for plaintiff-appellant. Also represented by JAMES R. BARNEY, SMITH BRITTINGHAM, IV.

DAN L. BAGATELL, Perkins Coie LLP, Hanover, NH, argued for defendants-appellees. Also represented by GRANT EDWARD KINSEL, THERESA H. NGUYEN, Seattle, WA.

Before MOORE, *Chief Judge*, CHEN, *Circuit Judge*, and ANDREWS, *District Judge*.[1]

CHEN, *Circuit Judge*

Gamevice, Inc. (Gamevice) appeals a decision by the United States District Court for the Northern District of California granting summary judgment of noninfringement in favor of Nintendo of America, Inc. and Nintendo Co., Ltd. (collectively, Nintendo). *Gamevice, Inc. v. Nintendo Co.*, No. 18-CV-01942-RS, 2023 WL 7194871 (N.D. Cal. Oct. 31, 2023) (*Summary Judgment Order*). The district court determined that the Nintendo Switch console (Switch) did not infringe claims 3, 4, 6, 7, and 16 of U.S. Patent No. 9,808,713 ('713 patent) and claim 6 of U.S. Patent No. 10,391,393 ('393 patent) because the Switch does not have (1) "confinement structures" that hold a computing device and (2) "apertures" that "secure an instructional input device." *See id.* at *7. For the reasons explained below, we *affirm and remand*.

BACKGROUND

Gamevice brought this case against Nintendo, alleging that Nintendo infringed three of its patents—the '393 patent, the '713 patent, and United States Patent No. 9,855,498 ('498 patent)—all of which have the same title: "Game Controller with Structural Bridge." During the course of the litigation, the district court invalidated all the asserted claims of the '498 patent,[2] narrowing the dispute to claims 3, 4, 6, 7, and 16 of the '713 patent and claim 6 of the '393 patent. *See Gamevice, Inc. v. Nintendo Co.*, 661 F.

---

[1] Honorable Richard G. Andrews, District Judge, United States District Judge for the District of Delaware, sitting by designation.

[2] The invalidated asserted claims of the '498 patent are not on appeal.

Supp. 3d 971, 980 (N.D. Cal.), *on reconsideration*, 677 F. Supp. 3d 1069 (N.D. Cal. 2023); *Gamevice, Inc. v. Nintendo Co.*, 677 F. Supp. 3d 1069, 1075 (N.D. Cal. 2023).

The ’713 and ’393 patents (asserted patents) disclose an accessory device that attaches to a handheld computing device and enables users to play games. *See* ’713 patent at Abstract; ’393 patent at Abstract. Specifically, the asserted patents describe a combination of (1) a “computing device” with a display screen, such as a smartphone or tablet, and (2) an accessory that can be attached to opposing sides of the computing device to provide controls for gameplay—buttons and joysticks—and can be removed to return the device to normal operation. *See* ’713 patent, col. 1 ll. 24–46; ’393 patent, col. 1 ll. 32–54.

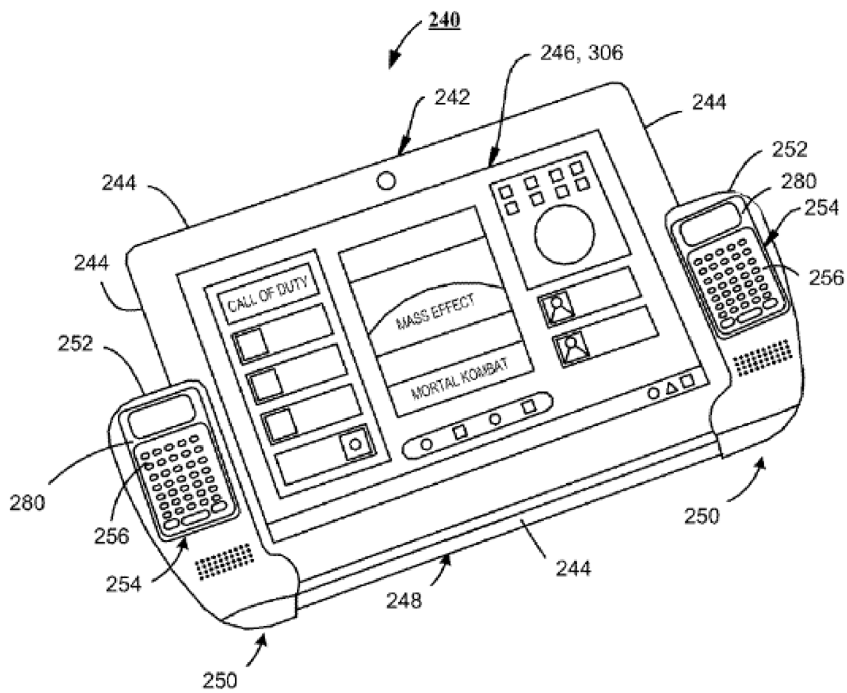


FIG. 13

’713 patent at FIG. 13; ’393 patent at FIG. 13. Relevant to this appeal, the asserted patents disclose a “pair of control

modules 252" having "input module apertures 254," each aperture securing "an instructional input device 256." '713 patent, col. 8 ll. 15–20; '393 patent, col. 8 ll. 22–27. The asserted patents explain that the input device can be buttons or a joystick. *See* '713 patent, col. 5 ll. 45–49; '393 patent, col. 5 ll. 53–57. Before us, the parties dispute the terms "computing device," "confinement structures," and "input module apertures" that "secure" "instructional input devices." *See* Appellant Br. 21–24; Appellee Br. 3–4.[3]

In the proceedings below, the district court construed "a pair of confinement structures/confinement structure" to mean "physical component(s) that hold[] a computing device." *Gamevice, Inc. v. Nintendo Co.*, No. 18-CV-01942-RS, 2023 WL 322901, at *10 (N.D. Cal. Jan. 19, 2023) (*Markman Order*). The court further construed "computing device" to mean "electronic equipment controlled by a CPU." *Id.* Although the court did not construe the term "input module apertures," it gave "aperture" its plain and ordinary meaning—"hole"—in the summary judgment order on appeal. *Summary Judgment Order*, 2023 WL 7194871, at *6.

With these constructions, the district court granted Nintendo's motion for summary judgment of noninfringement of all the remaining claims. It examined the alleged infringing product—the Switch—which includes a console and two "Joy-Con" controllers that slide into the side rails attached to the opposite ends of the console. It determined that there is no genuine dispute of material fact that the Switch lacks the claimed "confinement structures" that hold a "computing device," nor does it have the required

---

[3] Gamevice states that claims 1 and 3 of the '713 patent are representative claims, Appellant Br. 11–13, and Nintendo does not contest such characterization, *see generally* Appellee Br. We accordingly cite to these representative claims of the '713 patent.

"apertures" that "secure" an instructional input device. *Id.* at *6–7. The district court also held, in the alternative, that most of those claims, *i.e.*, claims 1, 2, 8, and 17–19 of the '713 patent and claims 1–4 and 7 of the '393 patent, were invalid as anticipated by the Nintendo Switch. *See Gamevice, Inc. v. Nintendo Co.*, 661 F. Supp. 3d 971, 980 (N.D. Cal.), *on reconsideration*, 677 F. Supp. 3d 1069 (N.D. Cal. 2023). Gamevice now appeals the district court's rulings. We have jurisdiction under 28 U.S.C. § 1295(a)(1).

STANDARD OF REVIEW

We review a district court's grant of summary judgment under the law of the regional circuit. *Ethicon Endo-Surgery, Inc. v. Covidien, Inc.*, 796 F.3d 1312, 1315 (Fed. Cir. 2015). The Ninth Circuit reviews a district court's grant of summary judgment de novo. *Arconic, Inc. v. APC Inv. Co.*, 969 F.3d 945, 950 (9th Cir. 2020). "Claim construction is reviewed de novo, and any underlying factual determinations are reviewed for clear error." *Azurity Pharms., Inc. v. Alkem Lab'ys Ltd.*, 133 F.4th 1359, 1363 (Fed. Cir. 2025).

DISCUSSION

The district court granted summary judgment of non-infringement on two independent grounds, determining that no genuine issue of material fact exists as to whether the Switch has the claimed "confinement structures" or the claimed "apertures" that "secure an instructional input device." *Summary Judgment Order*, 2023 WL 7194871, at *7. The district court held that there is no genuine dispute of material fact that the Switch does not possess "input module apertures" that secure the Switch's buttons or joysticks for two separate reasons: (1) the Switch joysticks are secured with screws, not apertures; and (2) the 0.2mm radial clearance between the respective Switch apertures and the buttons and joysticks demonstrates that the apertures do not secure the buttons and joysticks. *Summary Judgment Order*, 2023 WL 7194871, at *6. We agree the Switch lacks

the claimed "apertures" and therefore affirm the grant of summary judgment for Nintendo on that ground alone.[4]

The asserted claims require "*each*" of the "input module apertures" to "secure[] an instructional input device." *See, e.g.*, '713 patent, col. 18, ll. 15–18 (emphasis added). This means all apertures must individually secure their respective input devices. *See ResQNet.com, Inc. v. Lansa, Inc.*, 346 F.3d 1374, 1379 (Fed. Cir. 2003) (claim language requiring algorithm to evaluates attributes of "each field" required the algorithm to use "all fields"). As Gamevice concedes, "'instructional input devices' include both buttons and joysticks." Appellant Br. 45–46. Therefore, both the Switch's buttons and joysticks must be secured by the apertures.[5]

Here, neither the Switch buttons nor joysticks are secured by the apertures. It is undisputed that "secure"

---

[4] During oral argument, Nintendo conceded that we can affirm the district court's grant of summary judgment of noninfringement without addressing the district court's potentially inconsistent invalidity findings because the district court ruled in the alternative that the Switch also did not infringe the invalidated claims. Oral Arg. at 32:45 – 34:10 (available at https://www.cafc.uscourts.gov/oral-arguments/24-1467_09042025.mp3); *see also* J.A. 966. Nintendo agreed to file a motion on remand, asking the district court to reconsider its invalidity ruling and simply adopt the alternative noninfringement ground. *Id.*

[5] Gamevice argues that Nintendo waived this argument on appeal because it was not raised below. Appellant Resp. 16. Not so. In its motion for summary judgment, Nintendo argued that the Switch does not meet the "input modules apertures" limitation because "[t]he buttons *and* joysticks are not secured by the holes." J.A. 856 (emphasis added).

means "hold in place" and that "aperture" is a "hole." *See generally*, Appellant Br.; Appellee Br.; Appellant Resp. "[T]he parties [also] agree that the buttons are held in by a flange at the bottom." *Summary Judgment Order*, 2023 WL 7194871, at *6. That is, it is not disputed that the flange, to which the Switch buttons are attached, is secured in position by the rubber actuator, circuit board, and pins, all of which are sandwiched between the upper and lower housings of the Joy-Con controller, *see* J.A. 2503 (Nintendo engineer who designed the Switch describing how the combination of the rubber flange and the circuit board secured the buttons); J.A. 876–77. The holes, through which the Switch buttons and joysticks protrude, are larger in size than the buttons and joysticks, and thus do no work to secure these input devices in a fixed position. Summary judgment is therefore proper because the buttons are not secured by the claimed apertures.

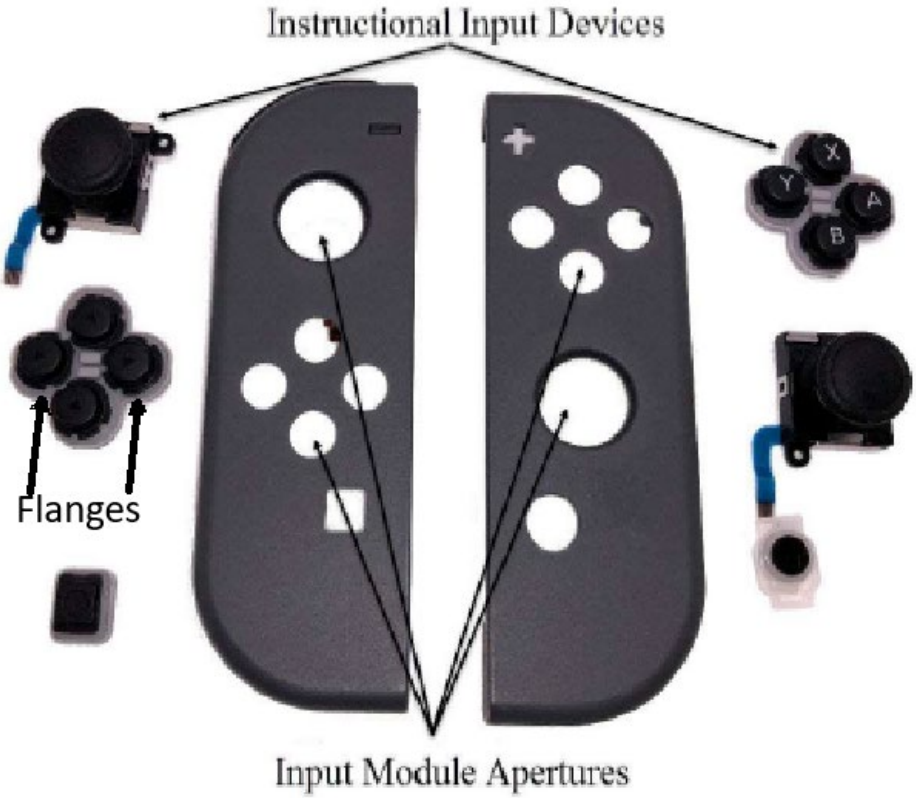
Even assuming the buttons are secured by the apertures, Gamevice still cannot prevail. Because the Switch joysticks are undisputedly secured to the upper housing with screws rather than apertures, the Switch fails to meet the "input module apertures" limitation. *See* J.A. 2503 (Nintendo engineer who designed the Switch attesting that "the joystick passes through the hole and then is secured to the upper housing with two M1.4 x 3.5 screws"). The district court thus correctly concluded that "[e]ven if the [Switch controller's] buttons . . . comport with the claim limitation, the joysticks [of the controller] are not secured with the apertures but with screws" and therefore the Switch controller does not meet the "input module apertures" limitation. *Summary Judgment Order*, 2023 WL 7194871, at *6.

Gamevice contends the district court erred in two respects. First, the court's statement that "apertures themselves cannot secure anything" contradicts the patent specification, which shows that "each input module aperture 254[] secures an instructional input device 256."

Appellant Br. 43–44 (citing '713 patent, col. 8 ll. 18–23). Second, the court improperly construed "secure" to exclude the use of additional components, such as a flange or a screw, to hold the instructional input device in place. *Id.* at 45. Because the specification is silent on how the buttons are secured, Gamevice contends the claimed inventions are agnostic as to whether additional components are used to secure the instructional input devices. *Id.* (citation omitted).

Gamevice misreads the district court's summary judgment order. First, the district court did not say that the claimed apertures categorically "cannot secure anything." Rather, it found that the specific apertures Gamevice identified in the accused Switch "themselves cannot secure anything [because] the parties agree that the buttons are held in by a flange at the bottom." *Summary Judgment Order*, 2023 WL 7194871, at *6. Second, to the extent that Gamevice now construes "secure" to allow for the use of housing material surrounding the holes (and not the holes themselves) to hold the instructional input devices in place, Gamevice never requested such a construction in front of the district court. *See Markman Order*, 2023 WL 322901, at *3 ("[t]he parties present ten disputed terms for constructions," none of which relates to the "input module apertures" limitation). Even if this argument is not waived, Gamevice does not point to any part of the specification or its expert report to support this construction. *See* Appellant Br. 45.

Gamevice's expert did not advance such a construction, but simply identified the "multiple openings for the Joy-Con buttons and joysticks . . . " as "input module apertures . . . [that] secure[] multiple instructional input devices, including joysticks and buttons." J.A. 2560 ¶ 81 (Gamevice's expert report).



Id. The specification also does not define "secure" to include the use of any housing materials apart from the apertures themselves, and we see reason to do so. *See Thorner v. Sony Comput. Ent. Am. LLC*, 669 F.3d 1362, 1365 (Fed. Cir. 2012) ("To act as its own lexicographer, a patentee must clearly set forth a definition of the claim term other than its plain and ordinary meaning" and must "clearly express an intent to redefine the term." (international quotations omitted)).

Gamevice alternatively contends the district court improperly discounted its expert's testimony that the holes secure the buttons through the relative size of the holes compared to the size of the flange. *See* Appellant Br. 45. Its expert testified that "it is th[e] interaction of [the] flange with the holes, and the proper sizing of the holes, that allows the button to both protrude from the housing and yet still be secured in place. . . . [I]f the holes were bigger than the flange, the buttons would fall out, so the size of the holes secures the buttons in place." Appellant Br. 45 (citing J.A. 941 ¶ 54). Gamevice faults the district court for focusing on the joysticks while ignoring that the buttons are secured using the input module apertures. *Id.* at 45–46. Because "instructional input devices" include both buttons and joysticks, Gamevice contends infringement is established if the apertures secure the buttons, regardless of whether they secure the joysticks. *Id.*

Gamevice is wrong. Its expert's counterfactual—that buttons would fall out if the holes were larger—does not show that the holes secure the buttons. The problem with this argument is that it fails to acknowledge, that under this theory, it is the wall material *surrounding* the hole—not the hole itself—that performs any securing function. Here, the Switch buttons are secured by a flange on their back side that is larger than the holes through which the buttons protrude. *See* J.A. 2503 (Nintendo engineer who designed the Switch testifying that "[t]he flange on the backside of the buttons prevents the buttons from falling through the holes in the housing."). As discussed previously, this flange is "secured and supported from behind by the . . . [rubber] Actuator Contact," which is "sandwiched between the housing and a printed circuit board, which is fastened to the housing with screws." J.A. 876. Accordingly, it is "the combination of the housing and actuator contact, *not* the holes . . ., [that] secures and supports the buttons when the buttons are not being pressed." *Id.* at 877. Gamevice's own expert does not rebut that the Switch

holes merely "allow the buttons and joysticks to pass through and move within." J.A. 875; *see* 940–41 ¶¶ 50, 54. Neither the specification nor the prosecution history redefines "apertures" to include the surrounding housing material, and Gamevice never requested such a construction below. The district court thus correctly found no genuine dispute of material fact that the identified apertures do not "secure" the buttons. In any event, Gamevice's argument does not address the undisputed fact that the Joy-Con's joysticks are held in place by screws—not by the apertures through which they protrude. *See Summary Judgment Order*, 2023 WL 7194871, at *6. Gamevice therefore cannot prove that both the buttons and joysticks are secured by the Switch's purported apertures, making summary judgment proper.

CONCLUSION

We have considered Gamevice's remaining arguments and find them unpersuasive. For the foregoing reasons, we *affirm and remand* to permit Nintendo to move the district court to vacate its invalidity ruling and enter judgment based on noninfringement.

AFFIRMED AND REMANDED

COSTS

No costs.

United States Court of Appeals for the Federal Circuit

GAMEVICE, INC.,
Plaintiff-Appellant

v.

NINTENDO CO., LTD., NINTENDO OF AMERICA, INC.,
Defendants-Appellees

2024-1467

Appeal from the United States District Court for the Northern District of California in No. 3:18-cv-01942-RS, Judge Richard Seeborg.

JUDGMENT

THIS CAUSE having been considered, it is

ORDERED AND ADJUDGED:

AFFIRMED AND REMANDED

FOR THE COURT

January 16, 2026
Date

Jarrett B. Perlow
Clerk of Court

EXHIBIT 2

Trials@uspto.gov
571-272-7822

Paper 37
Date: October 29, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

GAMEVICE, INC.,
Patent Owner.

IPR2023-00643
Patent 10,391,393 B2

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

MEYERS, *Administrative Patent Judge*.

DECISION
Final Written Decision
Determining All Challenged Claims Unpatentable
35 U.S.C. § 318(a)

I. INTRODUCTION

A. Background and Summary

Nintendo Co., Ltd. ("Petitioner") filed a Petition to institute an *inter partes* review of claims 1–7 (the "challenged claims") of U.S. Patent No. 10,391,393 B2 (Ex. 1001, the "'393 patent") pursuant to 35 U.S.C. § 311 *et seq*. Paper 1 ("Petition" or "Pet."). Gamevice, Inc. ("Patent Owner") filed a Preliminary Response. Paper 7 ("Prelim. Resp."). On November 6, 2023, we instituted an *inter partes* review of the challenged claims on all grounds raised in the Petition. Paper 11 ("Institution Decision" or "Inst. Dec."), 39.

Subsequent to institution, Patent Owner filed a Patent Owner Response (Paper 18, "PO Resp."), Petitioner filed a Reply to the Patent Owner Response (Paper 21, "Pet. Reply"), and Patent Owner filed a Sur-reply to Petitioner's Reply (Paper 27, "PO Sur-reply"). An oral hearing was held on August 14, 2024. A transcript of the hearing has been entered into the record. Paper 36.

We have jurisdiction under 35 U.S.C. § 6. This Decision is a Final Written Decision under 35 U.S.C. § 318(a) as to the patentability of the claims on which we instituted trial. Based on the complete record, Petitioner has shown, by a preponderance of the evidence, that claims 1–7 of the '339 patent are unpatentable.

B. Real Parties-in-Interest

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

C. Related Proceedings

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

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

D. The '283 Patent

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

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

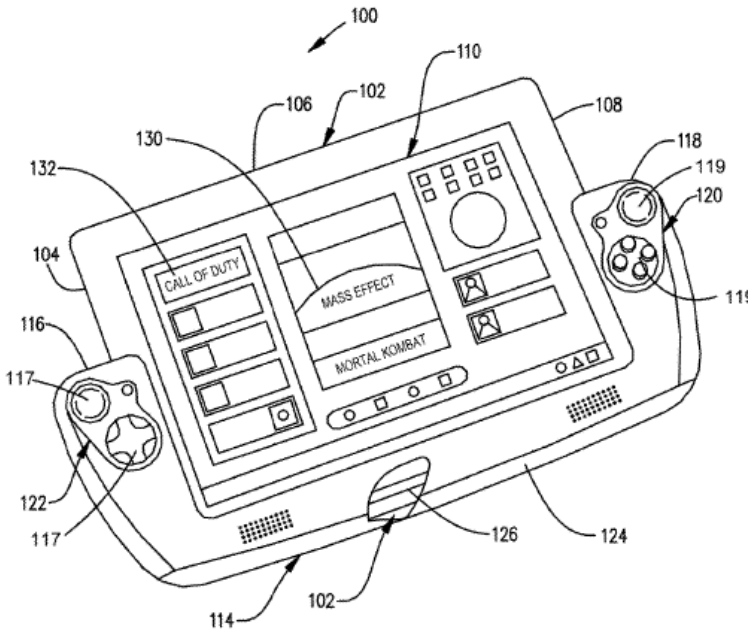


FIG. 1

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

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

E. The Challenged Claims

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

1. A combination comprising:

a computing device;

a pair of confinement structures, the pair of confinement structures interacting with the computing device and adjacent at least two opposing sides of the computing device, but not more than three sides of the sides of the computing device, each of the pair of confinement structures comprising a communication link, each of the communication links configured for electronic communication with the computing device;

a rigid structural bridge disposed between and secured to the pair of confinement structures, the rigid structural bridge comprising a passageway between the pair of confinement structures, the passageway promotes electrical communication between the communication link of a first confinement structure of the pair of confinement structures and the computing device, the passageway further promotes electrical communication between the communication link of a second confinement structure of the pair of confinement structures and the computing device; and

a pair of electronic game control modules, each electronic game control module of the pair of electronic game control modules is secured to and interacts with a corresponding confinement structure of the pair of confinement structures, each electronic game control module in electronic communication with the communication link of its corresponding confinement structure, wherein each electronic game control module is a separate and distinct structure from each of their corresponding confinement structures, forming no structural portion of their corresponding confinement structures, and in which each of the pair of confinement structures are separate and distinct structures from the structural bridge, forming no structural portion of the structural bridge.

Ex. 1001, 17:53–18:21.

F. Instituted Grounds of Unpatentability

We instituted trial based on all asserted claims and grounds of unpatentability as follows:

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

Pet. 8; Inst. Dec. 39. Petitioner submits a declaration of Garry Kitchen (Ex. 1002, "Kitchen Declaration") in support of its contentions. Patent Owner submitted a declaration of Prof. Alexander H. Slocum (Ex. 2004, "Slocum Declaration) in support of its Response. Prof. Slocum was cross-examined. *See* Ex. 1041 (deposition transcript of Prof. Slocum). Petitioner also submits a second declaration of Mr. Kitchen (Ex. 1033) to support its Reply. Mr. Kitchen was not cross-examined.

II. ANALYSIS

A. Principles of Law

"In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable." *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed.

[1] The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) ("AIA"), amended 35 U.S.C. § 103. Because the challenged claims of the '393 patent have an effective filing date before the effective date of the applicable AIA amendments, we refer to the pre-AIA version of 35 U.S.C. § 103 in this Decision.
[2] Willner et al., US 2001/0045938 A1, pub. Nov. 29, 2001 (Ex. 1003).
[3] Park, Korean Laid-Open Patent App. No. 10-2011-0116892, pub. Oct. 26, 2011 (Ex. 1004) (including English Translation and Translation Certification).
[4] Schoenith et al., U.S. 9,539,507 B2, iss. Jan. 10, 2017 (Ex. 1005).
[5] Kessler et al., Int'l Patent App. No. WO 2014/079264 A1, pub. May 30, 2014 (Ex. 1006).
[6] Hirschman, US 2012/0271967 A1, pub. Oct. 25, 2012 (Ex. 1007).

Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify "with particularity . . . the evidence that supports the grounds for the challenge to each claim")). Petitioner bears the burden of persuasion to prove unpatentability of each challenged claim by a preponderance of the evidence. 35 U.S.C. § 316(e). This burden never shifts to Patent Owner. *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015).

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. Inc. v. Union Oil Co.*, 814 F.2d 628, 631 (Fed. Cir. 1987). Moreover, "[b]ecause the hallmark of anticipation is prior invention, the prior art reference—in order to anticipate under 35 U.S.C. § 102—must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements 'arranged as in the claim.'" *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008). Whether a reference anticipates is assessed from the perspective of an ordinarily skilled artisan. *See Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 1368 (Fed. Cir. 2003) ("'[T]he dispositive question regarding anticipation [i]s whether *one skilled in the art* would reasonably understand or infer from the [prior art reference's] teaching' that every claim element was disclosed in that single reference.").

A patent claim is unpatentable under 35 U.S.C. § 103 if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, "would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said

subject matter pertains." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) when in evidence, any objective evidence of obviousness or non-obviousness.[7] *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). "While the sequence of these questions might be reordered in any particular case" (*KSR*, 550 U.S. at 407), the Federal Circuit has explained that an obviousness determination can be made only after consideration of all of the *Graham* factors. *See, e.g.*, *Kinetic Concepts, Inc. v. Smith & Nephew, Inc.*, 688 F.3d 1342, 1360 (Fed. Cir. 2012).

B. Level of Ordinary Skill in the Art

The level of ordinary skill in the art is "a prism or lens" through which we view the prior art and the claimed invention. *Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001). The person of ordinary skill in the art ("POSITA") is a hypothetical person presumed to have known the relevant art at the time of the invention. *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995). In determining the level of ordinary skill in the art, we may consider certain factors, including: "(1) the educational level of the inventor; (2) type of problems encountered in the art; (3) prior art solutions to those problems; (4) rapidity with which innovations are made; (5) sophistication of the technology; and (6) educational level of active workers in the field." *Best Med. Int'l, Inc. v. Elekta Inc.*, 46 F.4th 1346, 1353 (Fed. Cir. 2022). "The patent's purpose can also be informative." *Id.*

[7] The parties do not present objective evidence of non-obviousness.

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

In response, Patent Owner contends that one of ordinary skill in the art

> would have had an undergraduate degree in mechanical engineering and two years of industry or research experience in mechanical assemblies and hand-held consumer devices or other technology involving a physical device that allows humans to interface with electrical devices, where additional relevant experience can compensate for a lack of relevant education, and vice versa.

PO Resp. 5 (citing Ex. 2004 ¶¶ 17–18). Patent Owner adds that one of ordinary skill in the art would have also "understood the manner in which normal users generally operate game controllers." *Id.* at 6 (citing Ex. 2004 ¶ 20). Patent Owner points out that Patent Owner's proposed "definition requires ordinary artisans to have a mechanical engineering degree" whereas Petitioner's proposed definition "permits an undergraduate degree in electrical or computer engineering, or other technical training in product design or equivalent work experience in the development of interactive products." *Id.* (citing Pet. 13; Ex. 1002 ¶¶ 39–41).

Petitioner responds arguing that its proposed definition "allows for degrees in mechanical or computer engineering 'or other technical training

in product design or equivalent work experience in the development of interactive products.'" Pet. Reply 16 (citing Pet. 13).

The main distinction between Petitioner's ordinarily skilled artisan and Patent Owner's is that Patent Owner's definition requires "a mechanical engineering degree" whereas Petitioner's definition allows for a degree in "mechanical, electrical, or computer engineering." *See* Pet. Reply 16 (citing Pet. 13). However, Mr. Kitchen states that he qualifies as one of ordinary skill in the art based on Patent Owner's proffered definition "even without an undergraduate degree in mechanical engineering" because he has "over 40 years of experience in the design and development of interactive products, including specifically with respect to handheld gaming devices." Ex. 1033 ¶ 7 (citing Ex. 1002 ¶¶ 24–30). Mr. Kitchen asserts that his experience is in "the same category of products claimed in the '393 patent and described in the prior art references at issue in this proceeding." *Id.*

In view of this and based on the complete record before us, we view the parties' proposals as substantially the same because Petitioner's proposed definition includes the requisite education Patent Owner's definition requires. Thus, we find (as we did in the Institution Decision) that Petitioner's level of ordinary skill in the art is consistent with the level of ordinary skill in the art reflected by the '393 patent and the prior art of record. *See* Inst. Dec. 20–21 (citing *Okajima*, 261 F.3d at 1355). More particularly, we do not agree with Patent Owner that the education component for the level of ordinary skill in the art for computing gaming devices would be limited to just mechanical engineering. We note that, based on the record and evidence before us, our decision and analysis would

be the same applying either party's definition of a person of ordinary skill in the art.

C. Claim Construction

In an *inter partes* review, claims are construed using the same claim construction standard that would be used to construe the claims in a civil action under 35 U.S.C. § 282(b), including construing the claims in accordance with the ordinary and customary meaning of such claims as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent. 37 C.F.R. § 42.100(b). "[T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention" and "after reading the entire patent." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313, 1321 (Fed. Cir. 2005) (en banc). In addition to the specification and prosecution history, we also consider use of the terms in other claims and extrinsic evidence including expert and inventor testimony, dictionaries, and learned treatises, although extrinsic evidence is less significant than the intrinsic record. *Id.* at 1312–17. Usually, the specification is dispositive, and it is the single best guide to the meaning of a disputed term. *Id.* at 1315.

Petitioner references a district court order construing claims (Ex. 1028) issued in the California Litigation on January 19, 2023. Pet. 14; *see also id.* at 14–17 (identifying several constructions applied by the district court). Petitioner asserts that where the district court has entered a claim construction or there is a construction agreed upon by the parties, Petitioner applies it. *Id.* However, with respect to the term "confinement structures," Petitioner identifies that this term was construed in the California Litigation

as "physical component(s) that hold(s) a computing device." *Id.* at 15 (citing Ex. 1028, 10–12). Patent Owner agrees that this is the proper construction of the term. *See* PO Sur-reply 12 ("In its Patent Owner Response, [Patent Owner] properly applied the construction of 'a pair of confinement structures'—physical component(s) that hold(s) a computing device."). Thus, there is no dispute regarding the construction of the term "confinement structures" or "a pair of confinement structures."

There is a dispute, however, with respect to the meaning of the word "hold(s)," as it appears in the agreed upon construction. For example, Patent Owner argues that Petitioner fails to consider "how the combination of Willner's adaptor 210 sidewalls and Park's adjustable bridge (30, 40) could hold Willner's computing device 10 from popping out in the direction of the user (out of the page)." PO Resp. 18 (citing Ex. 2004 ¶ 83). Petitioner responds arguing that Patent Owner's "new narrow interpretation of the term 'hold(s)'" contradicts its previous positions and is unsupported by evidence. Pet. Reply 9–10. Petitioner asserts that "in the district court, [Patent Owner] asserted that 'confinement structures' were 'components that keep other components in place.'" *Id.* (citing Ex. 1028, 11).

After reviewing the full record, we determine that it is unnecessary to construe the term "confinement structures," as it appears in the limitation "a pair of confinement structures" to reach a determination in this proceeding. *Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019) ("The Board is required to construe 'only those terms . . . that are in controversy, and only to the extent necessary to resolve the controversy.'") (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)). However, we will address the parties' dispute regarding whether the prior art

discloses or teaches physical component(s) that hold(s) a computing device within our merits analysis below.

The parties do not dispute the construction of any other claim terms and we find that no other terms require express construction to resolve the controversy between the parties. Accordingly, we do not construe any other claim terms expressly. *See Realtime Data*, 912 F.3d at 1375 ("The Board is required to construe 'only those terms . . . that are in controversy, and only to the extent necessary to resolve the controversy.'") (quoting *Vivid Techs.*, 200 F.3d at 803).

D. Obviousness over Willner and Park (Ground 1)

Petitioner asserts that claims 1–7 are unpatentable as obvious over Willner and Park. Pet. 19–41. Petitioner also relies on the testimony of Mr. Kitchen to support its arguments. *Id.* (citing Exs. 1002, 1033). Patent Owner responds to Petitioner's assertions. *See* PO Resp. 8–26; PO Sur-reply 16–23. Patent Owner relies on the testimony of Prof. Slocum to support its arguments. *See* Ex. 2004.

We begin our discussion with a brief summary of Willner and Park and then address the evidence and arguments presented.

1. Overview of Willner (Ex. 1003)

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

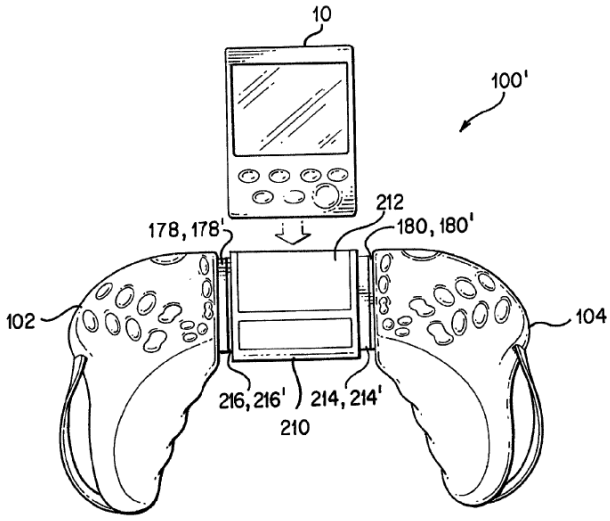


FIG. 4

Figure 4 depicts hand grippable game controller system 100' including housings 102, 104 which can communicate with computer 10. Ex. 1003 ¶ 50.

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

2. Overview of Park (Ex. 1004)

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

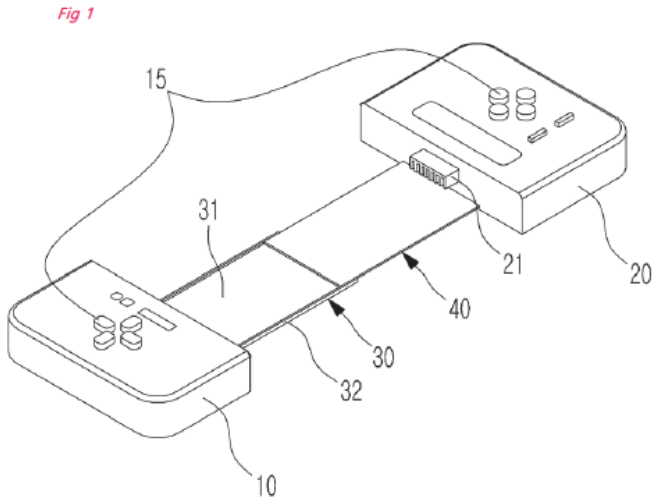


Figure 1 depicts first body 10 and second body 20 connected via bridge 30, 40. Ex. 1004 ¶ 30.

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

3. Analysis of Claim 1

Petitioner asserts claim 1 would have been obvious over Willner and Park. Pet. 19–41; Pet. Reply 8–25. Patent Owner contends that Petitioner has failed to establish that "a pair of confinement structures," as recited-in-part by limitation 1[b][1], is taught by the references. PO Resp. 16–20. Patent Owner further contends that there is no motivation to combine Willner and Park. PO Resp. 20–26; Sur-Reply 16–20.

Petitioner's contentions regarding the preamble and remaining limitations of claim 1 are undisputed.

We have reviewed the evidence and arguments provided by the parties and are persuaded that Petitioner has demonstrated by a preponderance of the evidence that claim 1 is unpatentable as obvious over Willner and Park.[8]

We begin by reproducing, for context, Petitioner's assertions regarding limitations 1[b][1] as set forth in the Petition. Pet. 22–25.

a) Petitioner's Assertions

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

Petitioner asserts that the combination of Willner and Park renders this limitation obvious. Pet. 22–25. More particularly, Petitioner asserts that "the sidewalls of the Willner/Park combination *interact* with the *computing device* and are *adjacent*[] *at least two opposing sides of the computing device*." *Id.* at 23. Petitioner provides the following copy of Figure 4 of Willner, annotated to identify in orange, adaptor 210 that receives computing device 10 with sidewalls that "are nearby (*adjacent*) the two opposing sides of computing device 10 when the device is inserted into the adaptor." *Id.* 23–24 (citing Ex. 1003 ¶¶ 50–51, Fig. 4; Ex. 1002 ¶¶ 146–156).

[8] We addressed the preamble and remaining limitations in a limitation-by-limitation analysis in our Institution Decision. *See* Inst. Dec. 25–37.

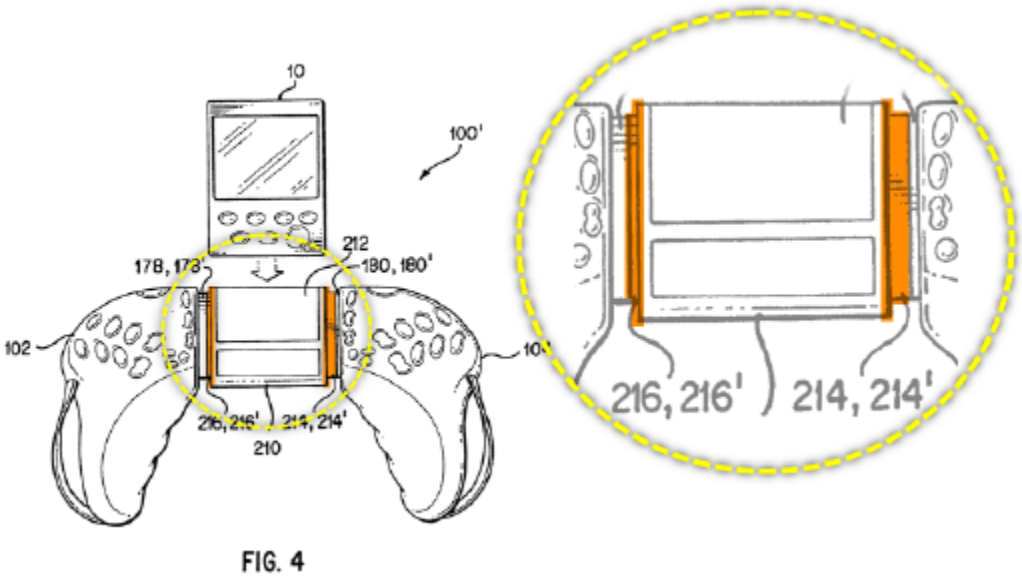
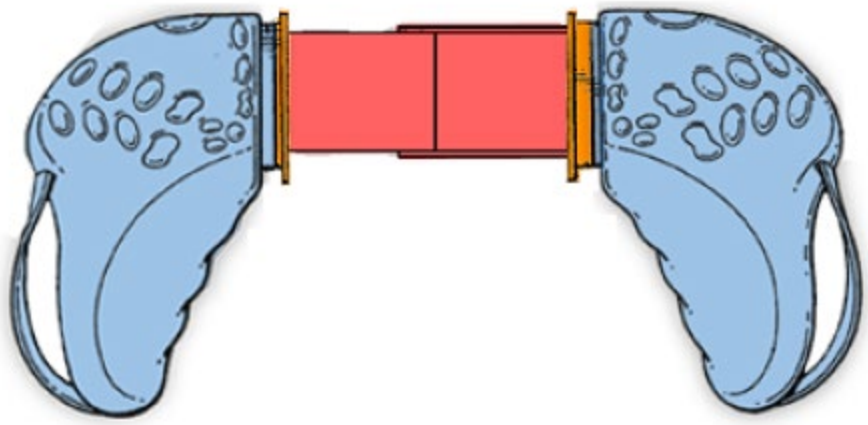


FIG. 4

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

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



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

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

> [w]hen a user adjusts the bridge, the sidewalls apply pressure to and receive resistance from the *computing device*—thereby

> *physically interacting with the computing device*. Additionally, the left and right sidewalls contain connectors 214' and 216' that electrically interact with the computing device through the reception and transmission of data to the computing device.

Pet. 24 (citing Ex. 1002 ¶¶ 156–157).

b) Discussion of Claim 1

Patent Owner argues that the Petition fails to establish that the combination of Willner and Park discloses or suggests the "pair of confinement structures," as recited by limitation 1[b][1]. PO Resp. 16–20. More particularly, Patent Owner argues that "the sidewalls of Willner's adaptor 210, which [Petitioner] contends are the claimed 'pair of confinement structures,' would not hold the computing device 10, e.g., from coming out in the direction of the user (out of the page)." PO Resp. 17 (citing Ex. 2004 ¶¶ 76–81). According to Patent Owner, Petitioner's "proposed combination of Willner's adaptor 210 sidewalls with Park's adjustable bridge (30, 40) does not provide any structure that would hold Willner's computing device 10 in position, e.g., from coming out in the direction of the user (out of the page)." *Id.* at 18–19 (citing Ex. 2004 ¶ 83); PO Sur-reply 1. Patent Owner adds that Petitioner's assertion that "Park's adjustable bridge (30, 40) could compress the sidewalls of Willner's adaptor 210 to hold Willner's computing device 10" is deficient (*id.* at 19 (citing Pet. 24)) because

> without any retaining structure to prevent the computing device 10 from coming out in the direction of the user (out of the page), placing the computing device 10 above Park's bridge (30, 40) will cause Park's bridge (30, 40) to bow and tend to make the computing device 10 pop out in the direction of the user (out of the page).

Id. (citing Ex. 2004 ¶ 84).

To support its position, Patent Owner directs our attention to a three-dimensional reconstruction of Willner's adaptor 210 generated by Prof. Slocum, which according to Patent Owner, demonstrates that in addition to sidewalls, Willner's adaptor 210 also relies on four additional structural elements to retain computing device 10. PO Resp. 9–10 (citing Ex. 2004 ¶ 49). And, relying on the declaration testimony of Prof. Slocum, Petitioner contends that one of ordinary skill in the art would understand "that without these additional four structural elements, Willner's adaptor 210 cannot retain computing device 10 during normal user operation" because "Willner's adaptor 210 does not provide any compressive load on computing device 10; it merely 'receive[s]' computing device 10 through opening 212 from the top side." *Id.* at 10 (citing Ex. 1003 ¶ 50; Ex. 2004 ¶ 49).

Patent Owner also points out that Park uses an arrangement of "recessed guide grooves (32a) and catching holes (32b)" along with "small protrusions (41)" and "catching holes (32b)" that work together "to join panels (30) and (40) together to form bridge (30, 40)." PO Resp. 13–14 (citing Ex. 1004 ¶¶ 33, 34, 39; Ex. 2004 ¶¶ 55–56). Patent Owner contends that Park admits that this arrangement "does not properly retain [a] mobile phone (1) between controller bodies (10) and (20) during normal user operation." *Id.* at 15 (citing Ex. 2004 ¶ 57). Patent Owner adds that neither Willner nor Park "discuss using screws or snap-fit connectors to secure any of its components together" (*id.* at 11, 15) and one of ordinary skill in the art would understand that "Park's bridge (30, 40) is not designed to be secured to another component using screws or snap-fit connectors" (*id.* at 15–16 (citing Ex. 2004 ¶ 58)).

In response, Petitioner argues that under the agreed upon construction of the term "confinement structures," Willner's sidewalls combined with Park's adjustable bridge are "perfectly capable of holding a computing device during normal use." Pet. Reply 9–10 (citing Ex. 1033 ¶¶ 36–39). Petitioner argues that Patent Owner's "new narrow interpretation of the term 'hold(s)' in [Petitioner]'s construction for 'confinement structures'" is not only "inconsistent with [Patent Owner's] infringement positions in the district court and the ITC," but "unsupported by evidence" and "irrelevant to a proper understanding of obviousness." *Id.* at 10 (citing Ex. 1018, 28–32, 120–121; Ex. 1028, 11–12).

We have considered Petitioner's arguments and evidence, and Patent Owner's counterarguments and evidence and find, on the complete trial record, that Petitioner demonstrates, by a preponderance of the evidence, that the combination of Willner and Park teaches "a pair of confinement structures," as recited by limitation 1[b][1].

Patent Owner argues that "[Petitioner] and its expert Mr. Kitchen fail to consider how the combination of Willner's adaptor 210 sidewalls and Park's adjustable bridge (30, 40) could hold Willner's computing device 10 from popping out in the direction of the user (out of the page)." PO Resp. 18 (citing Ex. 2004 ¶ 83). Patent Owner argues that one of ordinary skill in the art would understand "that physical components do not hold a 'computing device' if they allow it to inadvertently come out (including 'pop out') during normal user operation." PO Sur-reply 12; *see also id.* at 15–16 (arguing "physical components do not hold a 'computing device' if they allow it to inadvertently come out during normal user operation").

However, we agree with Petitioner that Patent Owner fails to provide "objective evidence that [Petitioner]'s combinations would have failed to hold a computing device." Pet. Reply 13–14.

At the outset, we note that it is unclear as to what Patent Owner considers to be "normal user operation." Patent Owner's assessment of "normal user operation" appears to be based on Prof. Slocum's "experience observing gamers in action" while his "wife ran a FIRST robotics team from 2005 to 2019 in [his] house . . . where the high school students would hang out to relax, and this often included gaming." Ex. 2004 ¶ 20. In this context, Prof. Slocum declares that

> [a]lthough I do not recall exactly what games or controllers they were using at the time, I observed how physical they would be with the controllers, as if they were wrestling with the controls to make the game do what they wanted. In my opinion, POSITAs with their industry or research experience would also have this understanding of the manner in which normal users operate controllers.

Id.

At least one difficulty with Prof. Slocum's characterization of "normal user operation" being one where "gamers" are "physical . . . with the controllers" and "wrestling with the controls" is that it fails to identify whether the controllers being used were controllers combined with phones like the present invention or just controllers somehow connected to a gaming system. And, during deposition, when asked if he "recall[ed] what controllers" he was basing his opinion on, Prof. Slocum responded, "I do not." Ex. 1041, 74:1–3. When asked if he "recall[ed] whether the controllers were connected to, for example, a game console that had the game on the TV" (*id.* at 74:4–6), Prof. Slocum responded

> There was all types. When they first started, things were wired. Then things went remote, and sometimes they would play on the TV. Sometimes they would sit and they would have the whole game with them just -- you know, because you'd have different kids and they'd have a game in their hands.

Id. at 74:7–13. In fact, when Prof. Slocum was asked if he "recall[ed] whether there were any kids playing games sort of like with the structure of, for example, the Park device, where there was a phone inside of a controller," Prof. Slocum responded "I do not think at the time there was that type of device." *Id.* at 75:14–20.

Mr. Kitchen responds that the type of gaming configuration used matters, i.e., there are differences between what would be considered "normal user operation" with a controller that is separate from the gaming device and display, and a handheld gaming devices like the ones at issue in this proceeding. Ex. 1033 ¶ 34. Relying on the declaration testimony of Mr. Kitchen, Petitioner contends that "[a] user would have kept the combinations stationary and avoided sudden movements so the screen of the computing device displaying the game remained easily visible." Pet. Reply 14 (citing Ex. 1033 ¶¶ 26, 34).

We agree with Petitioner and find more credible Mr. Kitchen's opinion regarding "normal user operation." In doing so, we credit Mr. Kitchen's opinion that Willner's sidewalls would "function to secure the sides of the computing device and hold it in place" and, "[i]n the combination, Park's bridge would be adjusted to reduce the length of the bridge and thereby 'mount' a computing device by having Willner's side walls (confinement structures) 'apply pressure' to opposing sides of the computing device." Ex. 1002 ¶¶ 154–156 (citing Ex. 1004 ¶¶ 38–41). We

note that the '393 patent operates in a similar manner using a sufficient compressive load to hold a computing device. More particularly, the '393 patent discloses that

> [t]he expansion and contraction of the distance between the pair of confinement structures 316, facilitates placement of the computing device 302 between the pair of confinement structures 316, the application of sufficient compressive load being placed on the computing device 302 to securely hold the computing device between the pair of confinement structures 316.

Ex. 1001, 10:11–20. Thus, we find Mr. Kitchen's opinion credible and supported by the complete record. Accordingly, we find that Petitioner has proven, by a preponderance of the evidence, that the combination of Willner and Park teaches or suggests "a pair of confinement structures," as recited by limitation 1[b][1].

In addition, Patent Owner argues that one of ordinary skill in the art would not have been "motivated to combine Willner and Park as Nintendo proposes to teach or suggest the above claimed arrangement with respect to 'confinement structures.'" PO Resp. 20.

Patent Owner first argues that Petitioner's "proposed modification of Willner's adaptor 210 with the teachings of Park's adjustable bridge (30, 40) would frustrate Willner's basic purpose of retaining its computing device 10 in position between its hand grippable housings 102 and 104, e.g., from coming out in the direction of the user." PO Resp. 20 (citing Ex. 2004 ¶¶ 60–65); PO Sur-reply 16–17. Patent Owner argues that "[r]eplacing only the back of Willner's adaptor 210 with the teachings of Park's adjustable bridge (30, 40), as Mr. Kitchen proposes, does not remedy the problem of retaining computing device 10 in position during normal user operation, e.g., from coming out in the direction of the user." *Id.* at 21 (citing Ex. 2004

¶ 67). According to Patent Owner, the proposed combination would suffer from "the same deficiency that Park expressly points out in its disclosure," i.e., Park's adjustable bridge "configuration does not allow mobile phone (1) to be seated for stability in the device." *Id.* (citing Ex. 1004 ¶ 42; Ex. 2004 ¶ 68).

Patent Owner's argument that the proposed modification "would frustrate Willner's basic purpose of retaining its computing device 10" (PO Resp. 20) is not persuasive for at least two reasons.

First, the test for obviousness "is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference, . . . but rather whether 'a skilled artisan would have been motivated to combine the teachings of the prior art references to achieve the claimed invention.'" *Allied Erecting & Dismantling Co. v. Genesis Attachments, LLC*, 825 F.3d 1373, 1381 (Fed. Cir. 2016); *see also* Pet. Reply 11–12 (arguing the same).

Second, we disagree with Patent Owner's assertion that the proposed combination would fail "to retain[] computing device 10 in position during normal user operation" because Park's adjustable bridge "configuration does not allow mobile phone (1) to be seated for stability in the device." PO Resp. 20 (citing Ex. 1004 ¶ 42; Ex. 2004 ¶ 68). At the outset, we note that Patent Owner's argument mischaracterizes the disclosure of Park. Instead, we find Park discloses that a "basic configuration of [Park's] game pad device for a mobile phone according to the present invention" "sufficiently allows mobile phone (1) to be mounted on the device according to the present invention and used." Ex. 1004 ¶¶ 25, 41. Although Park discloses that "mobile phone (1) may come loose during gaming or become detached

in severe cases" (*id.* ¶ 41), we do not view this disclosure to otherwise negate Park's teaching that its adjustable bridge (30,40) "sufficiently allows mobile phone (1) to be mounted on the device according to the present invention and used." *Id.* We credit Mr. Kitchen's declaration testimony to that effect. *See* Ex. 1033 ¶ 47 (declaring that one of ordinary skill in the art would have "understood this disclosure to mean that a computing device (mobile phone) would have been secured by the device for normal use . . . as part of a handheld gaming device.").

Patent Owner argues next that "the combined teachings of Willner's adaptor 210 modified with Park's adjustable bridge (30, 40), taken as a whole, do not enable an ordinary artisan to make and use the claimed invention without undue experimentation." PO Resp. 22. More particularly, Patent Owner argues that "there is no positive mechanical retention of Park's protrusions (41) in its catching holes (32b)," and as such, "during normal operation the user is likely to apply pull forces that cause the protrusions (41) to disengage from the catching holes (32b), resulting in expansion of Park's adjustable bridge (30, 40) and computing device (10) coming out." *Id.* (citing Ex. 2004 ¶ 73).

Patent Owner's argument regarding undue experimentation is not persuasive at least because it is based on Prof. Slocum's inadequately supported assessment of what would be considered "normal user operation," as discussed above, and Patent Owner's contention that Park's adjustable bridge "configuration does not allow mobile phone (1) to be seated for stability in the device." PO Resp. 20 (citing Ex. 1004 ¶ 42; Ex. 2004 ¶ 68). However, as discussed above, Park discloses that its adjustable bridge "allows for a mobile phone (1) to be mounted . . . and used." Ex. 1004 ¶ 41;

see also Ex. 1033 ¶ 82 (citing Ex. 1004 ¶ 41) (One of ordinary skill in the art would understand this statement to mean "that during ordinary use of Park's bridge, a computing device would have been securely held in the handheld gaming device. It is only in 'severe' use cases that the computing device might 'come loose' or 'become detached.'").

Relying on the declaration testimony of Prof. Slocum, Patent Owner argues that "Park's bridge design is fundamentally flawed because, in attempting to make it easy for a user to reduce or expand its length through ratcheting action, Park fatally compromises its ability to retain a mobile device between its controller bodies during normal user operation." *Id.* (citing Ex. 2004 ¶ 73). Mr. Kitchen responds that

> Prof. Slocum offers no evidence to support his conclusion that Park's protrusions and catching holes in the adjustable bridge would make the bridge unable to retain a mobile device between its controller bodies during normal user operation. Park taught the opposite: the mobile device would be "mounted on the [bridge] . . . and used" in ordinary operation.

Ex. 1033 ¶ 88 (citing Ex. 1004 ¶ 41). And, according to Mr. Kitchen, one of ordinary skill in the art

> implementing the bridge would have used a design that was both secure and easy to use. If the bridge pulled apart too easily, one basic solution would have been to make it more difficult to expand Park's bridge to decrease the likelihood that a user would have unintentionally pulled the bridge apart. That design objective would have been accomplished by making the catching holes and protrusions larger so that more pull force would have been required to dislodge the protrusions from the catching holes to expand the bridge.

Id. ¶ 89. We agree with Petitioner that one of ordinary skill in the art would have had reason to "implement[]a tensioning mechanism to ensure the

bridge would stabilize a computing device and not pull apart easily." Pet. Reply 25. We credit the declaration testimony of Mr. Kitchen that one of ordinary skill in the art "would have implemented one or more of the prior-art mechanical mechanisms . . . to further secure a computing device held in the overall device and ensure the computing device would be retained during normal operation." Ex. 1033 ¶ 50. Thus, we conclude that a person of ordinary skill at the time of the invention would have been able to combine Willner's adaptor 210 with Park's adjustable bridge (30, 40) to hold a computing device during normal operation with a reasonable expectation of success. *See KSR Int'l Co.*, 550 at 421 ("A person of ordinary skill is also a person of ordinary creativity, not an automaton.").

Patent Owner argues further that one of ordinary skill in the art "would require undue experimentation to re-design the connection of the sidewalls of Willner's adaptor 210 with Park's adjustable bridge (30, 40)." PO Resp. 23 (citing Ex. 2004 ¶ 74). According to Patent Owner, Mr. Kitchen "ignores these mechanical design issues entirely." *Id.* (citing Ex. 2004 ¶ 75). For example, Patent Owner argues that Mr. Kitchen "fails to articulate where or how to position the screws or snap-fit connectors to connect the sidewalls of Willner's adaptor 210 with Park's adjustable bridge (30, 40)" in order to retain the components during normal user operation. *Id.* (citing Ex. 2004 ¶ 75).

In response, Petitioner argues that one of ordinary skill in the art "exercising ordinary creativity would have known how to connect the sidewalls and bridges in [Petitioner]'s combinations." Pet. Reply 22. We agree with Petitioner.

At the outset, we note that Patent Owner's argument is once again premised on Prof. Slocum's inadequately supported assessment of what would be considered "normal user operation," as discussed above. In addition, we do not see, and Patent Owner does not adequately explain why it "would require undue experimentation to re-design the connection of the sidewalls of Willner's adaptor 210 with Park's adjustable bridge (30, 40) using properly sized screws or snap-fit connectors without having them interfere with [Willner's other] components." PO Resp. 23 (citing Ex. 2004 ¶ 74).

Instead, we credit Mr. Kitchen that one of ordinary skill in the art would have known that Willner's confinement structures could be connected to Park's adjustable bridge using snap-fit connectors (Ex. 1002 ¶ 204) or screws "in a manner that uses only a small footprint" (*id.* ¶ 209). Mr. Kitchen identifies that it was possible to use screws that were "0.8mm long" in order to "fixedly attach[] components within a device." *Id.* As Petitioner points out,

> Prof. Slocum's deposition undermined [Patent Owner]'s position on undue experimentation. Prof. Slocum conceded that a POSITA could successfully combine the relevant art, and have a reasonable expectation of success in doing so. [Ex. 1041,] 224:3–7 ("And they would have a reasonable expectation of succeeding in making that combination, right? A. Well, eventually, they'd make it work, yeah.").

Pet. Reply 21. Thus, we conclude that a person of ordinary skill at the time of the invention would have been able to combine Willner's adaptor 210 with Park's adjustable bridge (30, 40) to hold a computing device during normal operation with a reasonable expectation of success. *See KSR Int'l*

Co., 550 at 421 ("A person of ordinary skill is also a person of ordinary creativity, not an automaton.").

Patent Owner argues last that Mr. Kitchen's suggestion that an improvement "in one prior art reference to expand the selection of mobile devices the gaming controller can operate with would likely apply to and improve the other prior art references (PO Resp. 24 (citing Ex. 1002 ¶¶ 133–139)) "is not necessarily true because such an improvement can also have disadvantages." *Id.* (citing Ex. 2004 ¶¶ 36–38). Relying on the declaration testimony of Prof. Slocum, Patent Owner argues that "attempting to combine the teachings of Park's adjustable bridge (30, 40) . . . into Willner's fixed-sized adaptor 210 design . . . only imports the disadvantages of an adjustable bridge into Willner's . . . otherwise acceptable designs." *Id.* at 24–25 (citing Ex. 2004 ¶¶ 41–43). In addition, Patent Owner argues that incorporating Park's adjustable design would "increase cost (more parts and assembly costs) and result in a more mechanically compliant bridge structure (i.e., more likely to flex, open up, and release the computing device) than Willner's adaptor 210 . . . that [is] designed specifically for a computing device of a particular size." *Id.* at 25 (citing Ex. 2004 ¶¶ 44–45).

Though Patent Owner identifies these potential drawbacks, there are almost always tradeoffs to different designs. On the complete record before us, this does not discredit Petitioner's reasoning that adding "[a]n adjustable bridge would have obviated the need for a user to (i) purchase multiple adaptors/cradles for Willner's . . . device[] and (ii) reconfigure those adaptors/cradles when using different computing devices." Pet. Reply 23 (citing Ex. 1002 ¶¶ 136-139, 150-153; Ex. 1033 ¶¶ 66–68). *See also Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1165 (Fed. Cir. 2006) ("[A]

given course of action often has simultaneous advantages and disadvantages, and this does not necessarily obviate motivation to combine"). Moreover, the Federal Circuit's "precedent . . . does not require that the motivation be the best option, only that it be a suitable option from which the prior art did not teach away." *PAR Pharm., Inc. v. TWI Pharms., Inc.*, 773 F.3d 1186, 1197–98 (Fed. Cir. 2014). So, even if Petitioner's proposed combination would "increase cost (more parts and assembly costs) and result in a more mechanically compliant bridge structure," as Patent Owner suggests, these potential drawbacks do not teach way or otherwise detract sufficiently from an adjustable bridge, as proposed in Petitioner's combination.

c) Collateral Estoppel

Petitioner argues that issue preclusion prevents Patent Owner from contesting several limitations and the motivation to combine Willner and Park. Pet. 19. More particularly, Petitioner contends that "[i]n the '119 IPRs, the Board made several findings that were necessary to its final written decisions that the challenged claims of the '119 patent are unpatentable, and are, thus, binding on [Patent Owner] now." *Id.*; *see also* Pet. Reply 11 (citing Ex. 1011, 13, 19–20) ("The Board has already determined that a POSITA would have improved Willner's device . . . by adding Park's adjustable bridge."). Patent Owner responds arguing that collateral estoppel does not apply. PO Resp. 25–26; PO Sur-reply 2–7.

Because we determine that Petitioner has established that claim 1 is unpatentable based upon the combination of Willner and Park, it is not necessary to consider Petitioner's arguments regarding collateral estoppel. Accordingly, based on the strength of the merits discussed above, we do not

rely on any sort of estoppel as a basis for ruling in Petitioner's favor in this Decision.

d) Conclusion for Claim 1

Based on the analysis above, we conclude that Petitioner has proven, by a preponderance of the evidence, that claim 1 is unpatentable under 35 U.S.C. § 103 over the combination of Willner and Park.

e) Claims 2–7

Claims 2–7 depend from claim 1 ultimately. *See* Ex. 1001, 18:22–46. Petitioner provides citations to evidence of record, including Willner, Park, and Mr. Kitchen's testimony on how the combination of Willner and Park teaches or suggests the subject matter of claims 2–5. Pet. 37–41 (citing Exs. 1002, 1003, 1004).

Upon review of the information in the Petition and corresponding evidence, including Petitioner's reasons for modifying Willner with Park's teachings, we find that Petitioner has proven, by a preponderance of the evidence, that the combination of Willner and Park teaches or suggests the subject matter of claims 2–7. Patent Owner does not dispute Petitioner's contentions with respect to these claims, other than the arguments made with respect to claim 1, which we address above. PO Resp. 26.

4. Conclusion for Ground 1

Based on the analysis above, we conclude that Petitioner has proven, by a preponderance of the evidence, that claims 1–7 are unpatentable under 35 U.S.C. § 103 over the combination of Willner and Park.

E. Grounds 2–4

Petitioner contends that claims 1–7 are unpatentable over the combination of Schoenith and Park (Ground 2), Claims 1–7 are unpatentable

over the combination of Schoenith and Kessler (Ground 3), and claims 1–4, 6, and 7 are anticipated by or unpatentable over Hirschman (Ground 4). Pet. 8. Because Petitioner has shown that claims 1–7 are unpatentable based on the asserted grounds analyzed above, we do not reach these additional asserted grounds. *See Beloit Corp. v. Valmet Oy*, 742 F.2d 1421, 1423 (Fed. Cir. 1984) ("The Commission . . . is at perfect liberty to reach a 'no violation' determination on a single dispositive issue."); *Boston Sci. Scimed, Inc. v. Cook Grp. Inc.*, 809 F. App'x 984, 990 (Fed. Cir. 2020) (recognizing that "[t]he Board has the discretion to decline to decide additional instituted grounds once the petitioner has prevailed on all its challenged claims").

III. CONCLUSION

Based on the information presented, we conclude that Petitioner has proven, by a preponderance of the evidence, that claims 1–7 are unpatentable.[9]

In summary:

Claims	35 U.S.C. §	References	Claims Shown Unpatentable	Claims Not Shown Unpatentable
1–7	103(a)	Willner, Park	1–7	
1–7	103(a)	Schoenith, Park		

[9] Should Patent Owner wish to pursue amendment of the challenged claims in a reissue or reexamination proceeding subsequent to the issuance of this decision, we draw Patent Owner's attention to the April 2019 Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding. *See* 84 Fed. Reg. 16,654 (Apr. 22, 2019). If Patent Owner chooses to file a reissue application or a request for reexamination of the challenged patent, we remind Patent Owner of its continuing obligation to notify the Board of any such related matters in updated mandatory notices. *See* 37 C.F.R. § 42.8(a)(3), (b)(2).

Claims	35 U.S.C. §	References	Claims Shown Unpatentable	Claims Not Shown Unpatentable
1–7	103(a)	Schoenith, Kessler		
1–4, 6, 7	102, 103(a)	Hirschman		
Overall Outcome			1–7	

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner has established based on a preponderance of evidence that claims 1–7 of U.S. Patent No. 10,391,393 B2 are unpatentable as obvious under 35 U.S.C. § 103; and

FURTHER ORDERED that because this is a Final Written Decision, parties to the proceeding seeking judicial review of the Decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

IPR2023-00643
Patent 10,391,393 B2

FOR PETITIONER:

Tyler Bowen
Ruben Kendrick
PERKINS COIE LLP
bowen-ptab@perkinscoie.com
kendrick-ptab@perkinscoie.com

FOR PATENT OWNER:

Rajeev Gupta
Joshua Goldberg
Christina Ji-Hye Yang
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, LLP
raj.gupta@finnegan.com
joshua.goldberg@finnegan.com
christina.yang@finnegan.com

UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

GAMEVICE, INC.,

Plaintiff,

v.

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

Defendants

Case No. 3:18-cv-1942-RS

[PROPOSED] SECOND AMENDED FINAL JUDGMENT

WHEREAS, in this patent-infringement action, Plaintiff Gamevice ("Gamevice") averred that the Nintendo Switch infringes twenty claims across three of its patents ("the asserted claims"): claims 1–2 of U.S. Patent No. 9,855,498 ("the '498 patent"), claims 1–4, 6–8, 16–19 of U.S. Patent No. 9,808,713 ("the '713 patent") and claims 1–4, 6, 7, and 12 of U.S. Patent No. 10,391,393 ("the '393 patent");

WHEREAS, on November 21, 2023, the Court entered judgment in this matter holding: (1) claim 12 of the '393 patent invalid as indefinite; (2) claims 3, 4, 6, 7, and 16 of the '713 patent and claim 6 of the '393 patent not infringed by the Nintendo Switch; and (3) claims 1–2, 8, 17–19 of the '713 patent, 1–2 of the '498 patent, and claims 1–4, and 7 of the '393 patent invalid as anticipated in view of Gamevice's infringement allegations by the Nintendo Switch, or, alternatively, as not infringed;

WHEREAS, on October 29, 2024, the Patent Trial and Appeal Board (PTAB) issued a Final Written Decision that the asserted claims of the '393 patent are unpatentable over prior art, Gamevice did not appeal that determination, and that determination is now final; and

WHEREAS, on January 16, 2026, the Federal Circuit affirmed the Court's judgment of noninfringement and remanded to this Court to consider vacating the anticipation aspects of its prior judgment.

THEREFORE, it is hereby ORDERED that: (1) claim 12 of the '393 patent is invalid as indefinite; (2) in view of the PTAB's unpatentability determination, Gamevice has no claim for infringement of claims 1–4, 6, and 7 of the '393 patent; and (3) all asserted claims of the '498 and '713 patent are not infringed by the accused Nintendo Switch. Final Judgment is therefore entered in favor of Nintendo and against Gamevice as to all claims for relief pleaded by Gamevice against Nintendo, and Gamevice's Complaint is hereby DISMISSED WITH PREJUDICE.

It is further ORDERED that final judgment is entered in favor of Nintendo against Gamevice on the First Counterclaim for Declaration of Noninfringement of Nintendo of America Inc. ("NOA"). The Court determines and declares that NOA has

not directly or indirectly infringed on any valid claim of the '498 patent or the '713 patent, literally or under the doctrine of equivalents.

It is further ORDERED that final judgment is also entered in favor of Nintendo against Gamevice on the Second Counterclaim for Declaration of Invalidity of NOA to the extent that the Court determines and declares that claim 12 of the '393 patent is indefinite and thus invalid.

It is further ORDERED that Nintendo is the prevailing party, Gamevice shall pay all costs taxed in this matter, and the stay of execution of judgment is hereby lifted.

IT IS SO ORDERED

Dated: _____