UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

GAMEVICE, INC.,

Plaintiff,

v.

NINTENDO CO., LTD., et al.,

Defendants.

Case No. 18-cv-01942-RS

ORDER DENYING GAMEVICE'S MOTION FOR SUMMARY JUDGMENT AND GRANTING NINTENDO'S MOTION FOR SUMMARY JUDGMENT

I. INTRODUCTION

This is a patent infringement action brought by Gamevice, Inc. ("Gamevice") against Nintendo of America, Inc. and Nintendo Co., Ltd. ("Nintendo"). The alleged infringing product is the Nintendo Switch ("Switch"). Parties now bring cross-motions for summary judgment. In its motion for summary judgment, Gamevice avers that Nintendo infringes on claims 3, 4, 7, and 16 of U.S. Patent No. 9,808,713 ("the '713 patent") and claim 6 of U.S. Patent No. 10, 391,393 ("the '393 patent") (together, the "asserted patents"). Conversely, Nintendo moves for summary judgment on the theory that the Switch does not infringe any of Gamevice's patents, seeking a judgment of noninfringement as a matter of law. For the reasons discussed below, Gamevice's motion is denied and Nintendo's motion is granted.

II. BACKGROUND

Previously, Nintendo filed a motion for summary judgment against Gamevice, which was granted in part and denied in part. Specifically, the prior order concluded that all asserted claims

except for claim 16 of the '713 patent were invalid as anticipated by the Switch. Gamevice then filed a motion for reconsideration as to the prior summary judgment order, arguing that the court neglected to analyze individually the validity of the asserted claims. The prior summary judgment order was consequently amended to reflect the correct mode of analysis and several claims were no longer deemed invalid because of anticipation by the Switch. As it stands, six of the remaining asserted claims are not invalid by anticipation: claims 3, 4, 6, 7, and 16 of the '713 patent and claim 6 of the '393 patent. These claims are entitled to a priority date preceding the Switch.

Gamevice and Nintendo now file cross-motions for summary judgment. Gamevice argues for summary judgment on the basis that Nintendo is precluded from asserting noninfringement because of judicial estoppel and law-of-the-case doctrine. Nintendo, conversely, argues that it is entitled to summary judgment because at least three of the claim limitations in the asserted claims are incongruous in the Switch and Gamevice's patents.

III. LEGAL STANDARD

Summary judgment is appropriate if the pleadings, discovery, and affidavits show "that there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law." Fed. R. Civ. Pro. 56(a). A genuine issue of material fact is one that could reasonably be resolved in favor of the nonmoving party, and which could "affect the outcome of the suit." *Anderson v. Liberty Lobby, Inc*., 477 U.S. 242, 248 (1986). The moving party bears the burden of proof to "make a showing sufficient to establish…the existence of an element essential to that party's case." *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986). If the movant succeeds in demonstrating the absence of a genuine issue of material fact, the burden then shifts to the nonmoving party to "set forth specific facts showing that there is a genuine issue for trial." *Id*. at 322 n.3; *see also* Fed. R. Civ. Proc. 56(c)(1)(B). Evidence must be viewed in the light most favorable to the nonmoving party and all justifiable inferences must be drawn in its favor. *See Anderson*, 477 U.S. at 255. It is not the task of the court to scour the record in search of a genuine issue of triable fact. *Keenan v. Allan*, 91 F.3d 1275, 1279 (9th Cir. 1996) (citation omitted). The non-moving party has the burden of identifying, with reasonable particularity, the evidence that

precludes summary judgment. *Id.* If the nonmoving party fails to make this showing, "the moving party is entitled to a judgment as a matter of law." *Celotex*, 477 U.S. at 322.

IV. DISCUSSION

A. Gamevice's Motion for Summary Judgment

Gamevice moves for summary judgment on the theory that the earlier finding of invalidity by anticipation of thirteen of the asserted claims "necessarily establishes that the Switch satisfies those same claim limitations for any claims that pre-date the Switch." Dkt. 255 at 1. Gamevice argues that under either judicial estoppel or law of the case doctrine, the Court must rule that the Switch infringes on the claims not deemed invalid by anticipation. *See* Dkt. 245. Nintendo disagrees, citing *Evans Cooling Systems, Inc. v. General Motors Corporation* to argue that Gamevice's accusations of infringement are only binding on Gamevice. Moreover, Nintendo argues that Gamevice's averments of infringement permitted Nintendo to plead in the alternative and assert infringement for its invalidity defense *only*, without losing its ability to maintain its position of noninfringement. 125 F.3d 1448 (Fed. Cir. 1997).

As a threshold matter, anticipation occurs when a single prior art reference "expressly or inherently describes each and every limitation set forth in the patent claim[s]." *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295 (Fed. Cir. 2022). An accused infringer challenging validity must prove its case by clear and convincing evidence. *Baxter Int'l, Inc. v. Cobe Laboratories, Inc.*, 88 F.3d 1054, 1058 (Fed. Cir. 1996). The Federal Circuit has held that where the entire basis of a patentee's suit is infringement, an accused infringer may assert anticipation by its own product in the form of alternative pleading to establish a *prima facie* case of invalidity, while still maintaining noninfringement as a defense. *See Evans Cooling*, 125 F.3d at 1451; *Vanmoor v. Wal-Mart Stores, Inc.*, 201 F.3d 1363, 1366 (Fed. Cir. 2000). This is because the patentee's own allegations of infringement may be relied upon by an accused infringer to establish their *prima facie* defense of invalidity by anticipation. *Id.*; *see also IXYS Corp. v. Adv. Power Tech., Inc.*, No. C 02-03942 MHP, 2004 WL 540513, at *5 (N.D. Cal. Mar. 18, 2004) (In *Evans Cooling*, "[t]he court's conclusion that the infringement claim itself fulfilled defendant's burden of

demonstrating identity…served principally to truncate litigation that was logically doomed to failure").

i. The effect of the court's anticipation ruling

In Gamevice's motion for summary judgment, the primary contention between the parties is whether the court's prior anticipation ruling necessitates a finding of infringement in the instant order. Gamevice argues that if a product does not infringe asserted claims, then it cannot invalidate them, and so the converse must be true. Dkt. 262 at 7. To support its argument, Gamevice cites to *ThinkOptics, Inc. v. Nintendo of America, Inc.*

> The Federal Circuit's decision in *Vanmoor* prohibits plaintiffs from arguing that "a product contains each and every element of the patented invention for infringement purposes, but that the same product does not contain each and every element of the patented invention for invalidity purposes." *U.S. Ethernet Innovations, LLC v. Texas Instruments Inc.,* No. 6:11–cv–491, 2014 WL 1347994, at *2 (E.D. Tex. Apr. 3, 2014)

No. 6:1-cv-455, 2014 WL 3347531 at *2 (E.D. Tex., Jul. 3, 2014). This rule ensures that the plaintiff's defense against invalidity is logically consistent with its own allegations in a patent infringement case. However, the patentee in *ThinkOptics, Inc*. was not asserting infringement. Instead, the patentee was insisting that, for its anticipation argument, the defendant had failed to show that the accused product had "disclosed every element of the claimed invention." *Id*. The Court held that "*Vanmoor* has not been extended to cases where the asserted reference and accused products differ in relevant respects." *Id*. Since the patentee in that case was not alleging infringement, the defendant could not rely on the patentee's allegations to make an *Evans Cooling/Vanmoor* pleading. *See id*. That is not the case here, where the basis of Gamevice's suit is patent infringement.

The *Gammino* cases are instructive. *Gammino v. Southwestern Bell Tel., L.P*., 512 F. Supp. 2d 626 (N.D. Tex. 2007) ("*Gammino/SWB*") (affirmed only as to the invalidity claim by the Federal Circuit in *Gammino v. Southwestern Bell Tel., L.P* 267 Fed. App'x 949 (Fed. Cir. 2008)); *Gammino v. Sprint Comm'n Co. L.P*., No. 10-2493, 2011 WL 3240830 (E.D. Pa. Jul. 29, 2011) ("*Gammino/Sprint*"). In *Gammino/SWB*, the court "adopt[ed], without deciding" the patentee's

"interpretation of the claims of his patents" for the purposes of the defendant's motion for summary judgment of invalidity. *Gammino/SWB*, 512 F. Supp. 2d. at 632. However, the Court separately turned to claim construction to do a noninfringement analysis for the remaining claims and held that the patentee had "failed to meet his burden" that the accused product infringed the asserted patents in that case. *Id*. at 638, 643. Here, those claims are 3, 4, 6, 7, and 16 of the '713 patent, and claim 6 of the '393 patent. These claims (except for claim 6 of the '713 patent) are the basis of Gamevice's instant motion. Like Gammino, Gamevice may not receive the benefit of its infringement allegations without the necessary infringement analysis, which is precisely the result if its motion is granted. Gamevice insists that after finding invalidity, the *Gammino/SWB* court conducted claim construction for its noninfringement analysis of "ten *different* SWB services, which were not prior art to the Gammino patents." Dkt. 262 at 6 (emphasis in original). This argument confuses Gamevice's position. Gamevice seeks consistency with the court's prior summary judgment order, where the Switch was found to have anticipated most of the patents claims, but not for five of the remaining asserted claims for which Gamevice now seeks summary judgment. The five claims at issue now were given a priority date that pre-dated the Switch's introduction to the market. Indeed, if Gamevice's interpretation of *Gammino/SWB* is adopted, then the court should engage in a traditional infringement analysis of the six asserted claims, as, based on the court's prior summary judgment order, the Switch is not prior art to a claim with a priority date that precedes the Switch's on-sale date.

In *Gammino/Sprint*, which followed *Gammino/SWB*, the Court further explained this argument and stated that the patentee's infringement allegations allowed the Court to forego its traditional infringement analysis for a judgment of invalidity. 2011 WL 3240830 at *3. In that case, the Court made a collateral estoppel determination that a prior finding of invalidity could be raised as a defense to a "subsequent attempt to enforce the patent." *Id.* at *5. Where pertinent to the instant order, however, the court explained that, in *Gammino/SWB*:

> *Gammino's own interpretation* of the claims of his patents was a binding admission that prior art…[thus] invalidated the asserted claims of his patents. Importantly, because the court based its holding

> on Gammino's admissions, it did not perform the typical 'all-elements' analysis to determine if each component of Gammino's claims was present in Southwestern Bell's pre-existing products."

Id. at *3 (emphasis in original). This statement is instructive for two reasons. First, it explains what bears repeating, that the patentee's infringement allegations are binding on it but not, necessarily, the accused infringer. Second, it explains that because the Court's holding was based on essentially a limited stipulation that the accused product was infringing, a finding of invalidity by the Court allowed it to forego its traditional infringement analysis.[1] *Id*.; *see also id*. at *9 ("Because the Texas court invalidated Gammino's patents on the basis of his binding judicial admissions, it did not actually litigate the issues central to the validity of the unasserted claims" (internal citation omitted)). Gamevice correctly points out that in *Evans Cooling* and *Vanmoor*, all the asserted claims were invalidated and there was nothing left to litigate. This is not the case here. Six claims remain which were not determined to be invalid by anticipation. Gamevice insists that these claims be given the same treatment as any invalid claims in the cited cases. To the extent that Nintendo pled infringement for the purposes of its summary judgment motion of invalidity, Gamevice argues that pleading should be a binding admission by Nintendo and should permit the court to forego its traditional *Markman* infringement analysis. This argument is unworkable because it unfairly burdens the *Evans Cooling* pleader and allows the patentee to succeed on its infringement allegations, i.e. the entire basis of its suit, without satisfying its burden of proving infringement. *See Agawam Co. v. Jordan*, 74 U.S. 583, 609 (1868).

Ocean Innovations, Inc. v. Archer is also illustrative to reveal that an accused infringer does not admit infringement by arguing that the asserted patent is invalid. 145 F. App'x 366 (Fed. Cir. 2005). In that case, the Court rejected the patentee's argument that the accused infringer "admitted infringement" by "advancing [an] alternative theory for non-liability," that is, noninfringement or, otherwise, invalidity. *Id*. at 371 n.3. Gamevice points out that the accused

[1] In *Markman v. Westview Instruments, Inc*., the Federal Circuit explained that "[a]n infringement analysis entails two steps. The first step is determining the meaning and scope of the patent claims asserted to be infringed. The second step is comparing the properly construed claims to the device accused of infringing." 52 F.2d 967, 976 (Fed. Cir. 1995).

infringer in *Archer* lost its invalidity defense whereas Nintendo prevailed for most of the asserted claims, so this proposition is inapplicable. This argument is unpersuasive. First, to the extent that Gamevice's motion focuses on five of the remaining claims that were *not* successfully deemed invalid (i.e. for which Nintendo lost its invalidity defense), it conforms to Gamevice's own interpretation of the *Archer* proposition. However, even if Gamevice is correct that the surviving claims must receive the same treatment as the invalid ones because Nintendo prevailed on its anticipation argument *at all*, *Archer* makes no mention that the defendant is barred from advancing an alternative theory of non-liability once it is successful on one.

Where applicable, the cases above can be synthesized to stand for the proposition that if the basis of plaintiff's lawsuit is patent infringement by the "device that was put on sale," a defendant is allowed to rely on the plaintiff's allegations to assert a defense of invalidity based on anticipation. *See Evans Cooling*, 125 F.3d at 1451. This is because the analyses for anticipation and infringement are the same. *See Peters v. Active Mfg. Co*., 129 U.S. 530, 537 (1889). Thus, because the Federal Circuit has provided defendants with a method to satisfy an evidentiary burden for their invalidity defense in the form of alternative pleading, it cannot require that raising a defense based on the plaintiff's allegations binds the defendant. This would turn the *Evans Cooling* rule, and, indeed, the principle of alternative pleading, on its head. If Gamevice's argument is accepted, it would render Nintendo's alternative pleading a concession of infringement, entirely collapsing Nintendo's ability to use the defense of invalidity and force it to abandon the position that it has maintained since the beginning – noninfringement of the asserted claims. Nintendo only pled satisfaction of all of the asserted patent claims to make a *prima facie* showing of invalidity, which it was permitted to do. Denying a defendant in a patent infringement suit the ability to raise objections of noninfringement where the Federal Circuit has provided a procedure to do so would be unjust.

ii. Judicial estoppel and law of the case doctrine

Gamevice argues that judicial estoppel or law of the case doctrine require the Court to hold that for five of the remaining asserted claims, the Switch infringes. In that Nintendo did not

concede infringement by making an *Evans Cooling* pleading, Gamevice's judicial estoppel and law of the case doctrine arguments must fail.

iii. Claims 3, 4, 7, and 16 of the '713 patent and claim 6 of the '393 patent

The balance of Gamevice's motion is mostly premised on its unpersuasive argument that Nintendo is bound by its alternative theory of non-liability, therefore the Court must hold the five claims at issue in the instant motion as infringed by the Switch. For the reasons discussed above, the remaining claims must undergo a traditional infringement analysis under *Markman*. *See* 52 F.2d at 976. Therefore, as to Gamevice's averments of infringement regarding claims 3, 4, 7, and 16 of the '713 patent and claim 6 of the '393 patent, the motion is denied for being premised on Gamevice's rejected argument.

B. Nintendo's Motion for Summary Judgment

Nintendo moves for summary judgment that the Switch does not infringe any of Gamevice's asserted patent claims and seeks a judgment of noninfringement as a matter of law. Pursuant to 35 U.S.C. § 271, direct infringement is the making, using, or selling of a patented invention in the United States during the patent term. A patent is directly infringed if a product practices "each and every element of the claimed invention." *BMC Res., Inc. v. Paymentech, L.P.*, 498 F.3d 1373, 1381 (Fed. Cir. 2007). A patent may be directly infringed in two ways, either by literal infringement or the doctrine of equivalents, or non-textual infringement.

There are two steps to a literal infringement analysis. "The first step is determining the meaning and scope of the patent claims asserted to be infringed. The second step is comparing the properly construed claims to the device accused of infringing." *Markman I*, 52 F.3d at 976 (internal citation omitted). The first step involves claim construction, where the Court must determine, as a matter of law, how a patent's claims must be construed. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 384-85 (1996); *see* Dkt. 241. The second step, whether the accused device infringes the construed claims under either literal infringement of the doctrine of equivalents, is a question of fact. *Markman II*, 517 U.S. at 384-85. Summary judgment of a literal infringement assertion is appropriate if the court determines that "no reasonable jury could find

that every limitation recited in the properly construed claim either is or is not found in the accused device." *Bai v. L & L Wings, Inc.*, 160 F.3d 1350, 1353 (Fed. Cir. 1998) (citing generally *Cole v. Kimberly-Clark Corp.*, 102 F.3d 524 (Fed. Cir. 1996)).

i. ITC Investigations

As a preliminary matter, parties disagree on the extent to which the ITC investigation may be relied upon to show infringement. Gamevice's expert reports will form the basis of their infringement contentions, and the ITC proceedings may be relied upon as persuasive authority, particularly where the claims have been construed here consistent with the ITC's determinations.

ii. Claim limitations

In its motion for summary judgment, Nintendo argues that Switch does not infringe on the asserted patents because at least three of the asserted patent's claim limitations cannot be proven by Gamevice. Nintendo argues that the "passageway" limitation, the "confinement structures" limitation, and the "apertures" that "secure" limitation are not practiced by the Switch. In addition to these limitations, Nintendo maintains that Gamevice incorrectly characterizes the "computing device" limitation of its claims as an "arbitrary collection of parts" that cannot be considered a computing device.

a. Passageway

The first limitation Nintendo insists that Gamevice cannot prove is the "passageway" limitation. The term "passageway" appears in claim 1 of each of the asserted patents and claim 16 of the '713 patent. This limitation was construed to mean "a space that accommodates a communication wire" in accordance with Gamevice's construction. Further, the term was construed this way because "the use of the article 'a'…connotes a discrete space rather than any free-floating and ambiguous zone through which the wire may pass." The asserted patents recite a "structural bridge" that is comprised of a "passageway." Claim 16 of the '713 patent, however, differs slightly, calling for "an electronics communication passageway between the first and second confinement structures."

Gamevice's expert witness, Dr. Singhose, contends that the "upper frame in the Switch," is

the "structural bridge" that is comprised of the "passageway." Gamevice argues that the claim recites a structural bridge that merely "comprises" of a passageway, "so there is no requirement that the structural bridge be physically co-extensive with the passageway." Gamevice further contends that the passageway need not be straight as wire, by its nature, is flexible. Nintendo argues that there is a portion of the structural bridge that is "choked off" from any communication wires, and, thus, by definition, cannot accommodate the wires. This, Nintendo argues, runs afoul of the claim as construed. Nintendo also insists that the circuitous nature of the communication wires in the purported "structural bridge" indicates that there is no "passageway."

Whether the "passageway" must comprise entirely the space Gamevice defines as the structural bridge or whether it may just be a part of it is a disputed material fact. The claim recites "the passageway promotes communication between the first communication link and the computing device, the passageway further promotes communication between the second communication link and the computing device." The fact that a portion of the upper frame cannot accommodate a communication wire, and is therefore not a passageway, does not necessarily mean that the remainder of the upper frame, which can accommodate a communication wire, is not a passageway either. The term "comprises" means "including but not limited to" which requires the inclusion, at least, of what is recited. *See CIAS, Inc. v. All. Gaming Corp.,* 504 F.3d 1356, 1361 (Fed. Cir. 2007). Further, whether the passageway need be non-circuitous to be considered a passageway is also a disputed fact, because, as Gamevice points out, wires are flexible by nature. Thus, the "passageway" limitation cannot provide a basis for judgment as a matter of law.

b. Confinement structures

The "confinement structures" limitation, however, breaks in the opposite direction. Nintendo insists that Gamevice cannot prove that the Switch practices the "confinement structures" limitation. This term was construed as "physical components that hold(s) a computing device." Dkt. 241. The term appears in claim 1 of each asserted patent and claim 16 of the '713 patent. Gamevice argues that the rails on the sides of the Switch are confinement structures that

are "separate and distinct components." Dkt. 267 at 12. To support its argument, Gamevice insists that the rails are screwed onto the "computing device" and a user must attach the Joy Con controllers to the rails and "hold[s] the controllers, which are connected to the [rails], which in turn are holding the computing device." Dkt. 267 11-12. Nintendo disagrees. It argues that the rails are part of the Switch and "do not hold or confine any part of the Switch that Gamevice says is the 'computing device.'" Dkt. 263-4 at 18.

Gamevice's arguments are unpersuasive. First, the rails do not hold all components of what Gamevice asserts is the computing device. Dkt. 263-4 at 19. Specifically, the back cover of the "computing device" is not "held" by the rails simply because they are in "pressing contact with the computing device and fastened using screws." Singhose Decl. ¶ 41. Furthermore, the patent specification language that the confinement structures are meant to apply "sufficient compression load…on the computing device" to hold them, but simply being "in contact" with the computing device cannot comport with this specification. Gamevice's observation that a user holds the Joy Con controllers which are attached to the console by the rails also does not translate to the rails holding the "computing device." Simply attaching two rails to the side of the device do not constitute "confinement structures" and Gamevice cannot prove this limitation in the Switch.

c. "Apertures" that "secure"

Claims 1 and 16 of the '713 patent recite a "pair of control modules" with "input module apertures" that "secure[s] an instructional input device." The term "input module apertures" has not been construed by the court, however Gamevice contends that the Joy Con controllers contains features that satisfy the "input model apertures" limitations of the '713 patent. Specifically, Gamevice argues that the Joy-Con controllers are "a pair of control modules," each of which "has buttons and a joystick that extend up through the holes of the Joy-Con." Nintendo insists that the holes in the Joy-Cons do not secure the buttons and joysticks, only let them "pass through and move within" because there is a .2mm ring around the holes. Furthermore, the joysticks are secured by screws. Dkt. 263-4 at 20.

The plain and ordinary meaning of the term aperture is just "hole." While the apertures

themselves cannot secure anything, the parties agree that the buttons are held in by a flange at the bottom. Nintendo argues that this means the flange, not the apertures, are securing the buttons. Gamevice disagrees because "if the holes were bigger than the flange, the buttons would fall out." Even if the Joy-Con's buttons, consisting of a flange and circuit board, comport with the claim limitation, the joysticks are not secured with the apertures but with screws. Gamevice concedes that the joysticks are part of what it deems the "pair of control modules" as recited by the patent but has failed to argue persuasively that the joysticks are secured by the "input model apertures" and not the screws. The fact that a gap exists between the apertures and joysticks to facilitate their easy movement further supports Nintendo's argument that the apertures do not secure the joysticks. Thus, Gamevice cannot prove this claim limitation.

d. Computing device

Nintendo argues that the Switch console itself is a computing device but insists that Gamevice's theory of what constitutes a "computing device" is overbroad and consists of elements that are not "electronic equipment[s] controlled by a CPU," per the claim construction. Dkt. 263-4 at 21-22 (quoting Dkt. 241 at 19). The ITC determined that Gamevice's "parts-of-the-Switch" theory, as Nintendo calls it, does not comport with the "computing device" limitation. Dkt. 268 at 11. This argument is immaterial for the purposes of a noninfringement analysis, which requires a two-step analysis: "First, the claim must be properly construed to determine its scope and meaning. Second, the claim as properly construed must be compared to the accused device or process." *Carroll Touch, Inc. v. Electro Mech. Sys.*, Inc., 15 F.3d 1573, 1576 (Fed. Cir. 1993). The limitation "computing device," both parties agree, is present in the Switch. Whether Gamevice cannot show "distinct limitations" as recited by the patent is an issue of material fact a juror is entitled to make.

V. CONCLUSION

For the reasons above, Gamevice's motion for summary judgment is denied. Nintendo's motion for summary judgment is granted because Gamevice cannot raise a genuine issue of material fact as to the confinement structures and the "apertures" that "secure." Thus, claims 3, 4,

6, 7, and 16 of the '713 patent and claim 6 of the '393 patent, all of which recite those limitations, are not infringed by the Switch. Nintendo's administrative motion to file under seal certain exhibits attached to the declaration of David Pekarek Krohn and an unredacted version of its Motion for Summary Judgment, Dkt. 263, is also granted. Nintendo's motion is narrowly tailored and only requests sealing of "confidential and commercially sensitive information." *See In re Elec. Arts, Inc.*, 298 F. App'x 568, 569 (9th Cir. 2008).

IT IS SO ORDERED.

Dated: October 31, 2023

RICHARD SEEBORG
Chief United States District Judge

United States District Court
Northern District of California

UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

GAMEVICE, INC.,

Plaintiff,

v.

NINTENDO CO., LTD., et al.,

Defendants.

Case No. 18-cv-01942-RS

ORDER GRANTING IN PART AND DENYING IN PART MOTION FOR SUMMARY JUDGMENT

I. INTRODUCTION

Following briefing by both parties in this patent infringement action, an order issued construing ten claims pursuant to *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995). *See* Dkt. 241. Because Defendant Nintendo Co., Ltd. ("Nintendo"), had also filed a motion for summary judgment that turned on the construction of three of these terms, the order instructed the parties to file "supplemental briefing as to the disposition of the motion based on the adopted constructions." *Id.* at 18. This briefing having now been submitted, the motion is granted in part and denied in part. All of the asserted claims that incorporate the term "computing device" are not entitled to an earlier priority date, and they are thus invalid as anticipated by the Nintendo Switch.

II. BACKGROUND

The background of this case is related in greater detail in prior orders. As relevant to this motion, Plaintiff Gamevice, Inc. ("Gamevice") asserts that Nintendo has infringed three of its patents (the "Asserted Patents"), all of which were filed between 2017 and 2019: U.S. Patent No.

9,808,713 ("the '713 patent"), filed on July 28, 2017; U.S. Patent No. 9,855,498 ("the '498 patent"), also filed on July 28, 2017; and U.S. Patent No. 10,391,393 ("the '393 patent"), filed on December 21, 2018. These patents were preceded by two other, related patents: U.S. Patent No. 9,126,119 ("the '119 patent"), filed on February 2, 2015; and U.S. Patent No. 9,592,453 ("the '453 patent"), filed on August 31, 2015. The parties agree that the Nintendo Switch, the accused infringing product, was first sold in the United States on March 3, 2017. *See* Dkt. 230 ("Motion"), at 9; Dkt. 233 ("Opp."), at 5.

Nintendo moved for summary judgment on two grounds, only one of which remains viable following the entry of the claim construction order.[1] Because the Switch indisputably predates the three Asserted Patents, Nintendo argues that it constitutes prior art and, therefore, that it is entitled to summary judgment because the asserted claims are all anticipated. Gamevice, in turn, argues that it is entitled to the priority filing date of the '119 patent — that is, February 2, 2015 — because the patent provides written description support for the asserted claims.

III. LEGAL STANDARD

Under Federal Rule of Civil Procedure 56, summary judgment is appropriate if "there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law." Fed. R. Civ. P. 56(a). While the moving party has the initial burden of identifying the portions of the record which demonstrate the absence of a genuine issue of material fact, the non-moving party must set forth "specific facts showing that there is a genuine issue for trial." *Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 587 (1986). The Court must view the facts and draw all reasonable inferences in the light most favorable to the non-moving party. *Scott v. Harris*, 550 U.S. 372, 378 (2007). However, "[w]here the record taken as a whole could not lead a rational trier of fact to find for the non-moving party, there is no 'genuine issue for trial,'"

[1] Nintendo initially argued that it was entitled to summary judgment if its proffered construction of "fastening mechanisms" was adopted. *See* Motion, at 3–5. Since a different construction was adopted, this argument is moot. Nintendo's procedurally incorrect request for reconsideration included in its supplemental briefing, *see* Dkt. 243, at 18–20, need not be entertained. *See* Civ. L.R. 7-9.

Matsushita, 475 U.S. at 587, and "a scintilla of evidence in support of the [non-moving party's position] will be insufficient" for the case to withstand summary judgment. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 252 (1986).

IV. DISCUSSION

Nintendo moves for summary judgment on the grounds that the claims of the Asserted Patents are invalid because they are all anticipated by prior art — that is, by the Nintendo Switch. Anticipation occurs when a single prior art reference "expressly or inherently describes each and every limitation set forth in the patent claim[s]." *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295 (Fed. Cir. 2002). Nintendo here bears the "burden to prove facts establishing anticipation by clear and convincing evidence." *Mentor H/S, Inc. v. Med. Device All., Inc.*, 244 F.3d 1365, 1377 (Fed. Cir. 2001). However, once Nintendo establishes a "prima facie case of invalidity," its burden is met, and Gamevice is "obligated to come forward with evidence to the contrary." *PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299, 1305 (Fed. Cir. 2008) (quoting in part *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1573 (Fed. Cir. 1985)). For the purposes of this motion, Nintendo "pleads in the alternative and accepts Gamevice's allegations that the Nintendo Switch satisfies each limitation of the asserted claims." Dkt. 243, at 10. This suffices to establish a prima facie showing of invalidity. *See Vanmoor v. Wal-Mart Stores, Inc.*, 201 F.3d 1363, 1366 (Fed. Cir. 2000); *IXYS Corp. v. Adv. Power Tech., Inc.*, No. C 02-03942 MHP, 2004 WL 540513, at *5 (N.D. Cal. Mar. 18, 2004) (rationalizing this principle because there is "no logical space between plaintiff's infringement allegation and defendant's invalidity defense; the facts [cannot] support one without identically buttressing the other").

The key question, then, is whether Gamevice is entitled to the priority filing date of the '119 patent. This question turns on whether the '119 patent provides written description support for the terms "computing device" and "structural bridge," as those terms are used in the asserted claims. Nintendo argues the '119 patent does not, while Gamevice argues it does, and that there are disputes of fact bound up in this inquiry that render summary judgment inappropriate.

///

A. The Written Description Requirement

As the Federal Circuit has noted, it is "elementary patent law that a patent application is entitled to the benefit of the filing date of an earlier filed application only if the disclosure of the earlier application provides support for the claims of the later application." *In re Chu*, 66 F.3d 292, 297 (Fed. Cir. 1995). Not only is this an explicit requirement of federal law, *see* 35 U.S.C. § 112, it also simply makes sense as a way to "protect[] the quid pro quo between inventors and the public" that lies at the core of patent law: the public "receives meaningful disclosure" of the invention, and the inventor herself is granted the right to exclude the public "from practicing the invention for a limited period of time." *ICU Med., Inc. v. Alaris Med. Sys., Inc.*, 558 F.3d 1368, 1377 (Fed. Cir. 2009) (internal quotation marks omitted) (quoting *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 323 F.3d 956, 970 (Fed. Cir. 2002)). The written description requirement helps maintain this balance by "ensur[ing] that the scope of the right to exclude, as set forth in the claims, does not overreach the scope of the inventor's contribution to the field of art as described in the patent specification." *Reiffin v. Microsoft Corp.*, 214 F.3d 1342, 1345 (Fed. Cir. 2000).

To satisfy the written description requirement, the party seeking entitlement to the earlier filing date must be able to "convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention," where "the invention" means "whatever is now claimed." *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563–64 (Fed. Cir. 1991) (emphasis omitted). The earlier patent "need not recite the claimed invention [verbatim] but must do more than merely disclose that which would render the claimed invention obvious." *ICU Med.*, 558 F.3d at 1377. In other words, the earlier patent "must describe the claimed invention with all its limitations." *Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 1158 (Fed. Cir. 1998) (citing *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997)); *see Martin v. Mayer*, 823 F.2d 500, 505 (Fed. Cir. 1987) ("It is not a question of whether one skilled in the art *might* be able to construct the patentee's device from the teachings of the disclosure. . . . Rather, it is a question whether the application necessarily discloses that particular device." (internal quotation marks omitted)), *superseded on other grounds as recognized by Kubota v. Shibuya*, 999 F.2d 517 (Fed. Cir. 1993).

Whether the written description requirement is met in a particular case is a question of fact, but it is "amenable to summary judgment in cases where no reasonable fact finder could return a verdict for the non-moving party." *PowerOasis*, 522 F.3d at 1307.

A consistently thorny issue in applying this standard is determining whether an earlier patent discloses a "species" sufficient to support later claims within the "genus" of the earlier species — in other words, whether an early, narrow disclosure can support a later, broader one. As a general matter, "disclosure of a species may be sufficient written description support for a later claimed genus including that species," but the question ultimately depends, again, on what the disclosure reasonably conveys to a person skilled in the art. *Bilstad v. Wakalopulos*, 386 F.3d 1116, 1124–25 (Fed. Cir. 2004). For instance, in *Tronzo v. Biomet, Inc.*, the Federal Circuit reversed a jury finding that the plaintiff's patent, relating to artificial hip sockets and "cup implants," was entitled to the earlier filing date of its "parent application." 156 F.3d at 1158. The parties disputed whether the parent application disclosed a device that was "generic as to the shape of the cup," thus supporting the patent at issue, or whether it disclosed only a cup that was conical in shape. *Id.* Reviewing the patent specification, the Federal Circuit found the parent application referred to "*only* conical shaped cups and nothing broader," a conclusion bolstered by the fact that the specification "specifically distinguishe[d] the prior art as inferior and tout[ed] the advantages of the conical . . . cup." *Id.* at 1159. Expert testimony also supported this finding, and the Court held that the plaintiff's patent claims were invalid as anticipated by intervening prior art.

B. The '119 Patent

As noted above, both parties agree that the Nintendo Switch was on sale in the United States before the Asserted Patents were filed. In light of Gamevice's averments (and Nintendo's alternative pleading) that the Switch reads on the claims in the Asserted Patents, it is prior art, and Gamevice's claims are anticipated unless they are entitled to the filing date of the '119 patent.[2]

[2] It is no longer necessary to examine the '453 patent in light of the fact that claim 12 of the '393 patent was held indefinite (and thus invalid) in the claim construction order. *See* Dkt. 241, at 9.

Nintendo argues it is entitled to summary judgment because the '119 patent does not provide written description support for two of the claim terms as construed by the *Markman* order: (1) "computing device," meaning "electronic equipment controlled by a CPU," and (2) "structural bridge," meaning "a physical apparatus that secures two or more components to each other across a distance." Dkt. 241, at 19. In Nintendo's view, the '119 patent discloses far narrower versions of each; Gamevice, meanwhile, contends that the '119 patent provides sufficient support for each of these terms as they are used in the asserted claims.

1. "Computing Device"

Nintendo first argues that the '119 patent does not demonstrate that the inventors of the Asserted Patents had prior possession of a "backless, screenless computing device." Motion, at 14. Instead, every figure "shows a computing device with both a back and a screen," while the specification notes that the computing device "may take the form of a tablet computer, smartphone, notebook computer, or other portable computing device" — language that is repeated in the Asserted Patents. *Compare* Dkt. 230-11 ("'119 Patent"), at 3:17–197, *with* Dkt. 213-1 ("'498 Patent"), at 4:34–36, *and* Dkt. 213-2 ("'713 Patent"), at 4:34–36, *and* Dkt. 213-3 ("'393 Patent"), at 4:43–45. Gamevice contends that the '119 patent language is not so limited, and that it adequately supports the adopted construction of "computing device" such that "[a] person of skill in the art would . . . understand that disclosure to include many portable devices, such as the single-board computers of the day that had no backs and no screens." Dkt. 244, at 12. In other words, Gamevice argues that to the extent the '119 patent discloses only one species (a computing device with a back and a screen), it nevertheless discloses the "broader genus of 'computing devices.'" Opp., at 8.

Both parties acknowledge the salient differences here between the narrow and broad readings of "computing device." On the narrow end are "complete, finished devices," that include a back and a screen — picture an iPhone, an iPad, or an Amazon Kindle. The broad end includes a range of devices "with the ability to perform computing functions, i.e., devices with a CPU, a memory, and ways to input and output data from the CPU." *See* Motion, at 14–18; Opp., at 10–12.

A single-board computer, such as the Raspberry Pi, *see* Dkt. 229-7, would fit into the broad category but not the narrow one. The parties also both recognize that the '119 patent includes images of only "complete, finished" computing devices, but Gamevice contends these are merely preferred embodiments that should not be construed to limit the scope of the patent.

The claim language itself spells immediate trouble for Gamevice's argument. Claim 1 of the '119 patent describes the computing device as follows: "a computing device, the computing device providing a plurality of sides, each of the plurality of sides are disposed between an *electronic display screen of the computing device and a back of the computing device*." '119 Patent, at 9:64–67 (emphasis added). Compare this to how "computing device" is described in claim 1 of each Asserted Patent. The '713 patent defines it as "a computing device, the computing device providing an upper, lower, left and right side, collectively the sides of the computing device, and an electronic display screen, the electronic display screen having a corresponding side adjacent each of the sides of the computing device." '713 Patent, at 17:48–53. The '498 patent describes it as "a computing device, comprising an electronic display screen," while the '393 patent simply states that the invention includes "a computing device." '498 Patent, at 17:48–49; '393 Patent, at 17:54. The '119 patent is thus the only one of these patents that explicitly claims the computing device with reference to a screen and a back; those features are not added via subsequent dependent claims, as they are in the Asserted Patents.

The specification further supports the contention that the computing devices taught by the '119 patent are narrower than those in the Asserted Patents. As Nintendo observes, every depiction of a computing device in the '119 patent shows a device with a screen and a back. *See* '119 Patent figs. 1–4, 8–10, 12–16, 25. Gamevice cites to Figure 6 and its corresponding description as intrinsic evidence that the computing device need not include a back, but these are not to the contrary. Figure 6 is a "block diagram," which is simply a "functional diagram" that shows how the computing device interacts with other components of the invention via "hardware (a CPU and a screen), software (video game), firmware (device driver), and a communication protocol." Stein Decl. ¶ 301. The specification's statement that the computing device "may take the form of a

tablet computer, smart phone, notebook computer, or other portable computing device" further reinforces that the inventors possessed only computing devices with screens and backs. '119 Patent, at 3:17–19. The fact that this identical list of devices is included in each of the Asserted Patents is irrelevant: whereas these devices may just be preferred embodiments in the Asserted Patents, and thus should not necessarily limit how "computing device" should be read in those contexts, in the '119 patent they demonstrate the limited breadth of what the inventors possessed and what the patent discloses. Finally, Nintendo's expert, Dr. Stein, reviewed the '119 patent and concluded that a person of ordinary skill in the art "would understand that the computing device recited in claim 1 is a complete computing device, such as a smartphone, tablet computer, notebook computer, or other portable computing device." Dkt. 231-12 ("Stein Decl.") ¶ 302. Gamevice's expert, Dr. Slocum, did not address the '119 patent in his declaration.

Further, it is unclear how the invention described in the '119 patent would function with a screenless, backless computing device. As Nintendo points out, Dr. Slocum suggests it would not. In his deposition, Dr. Slocum was asked if the Gamevice invention would work with a "backless and screenless computing device." The following exchange occurred:

> Q. [counsel for Nintendo] So in order to make this invention work, you have to put a back and sides on the computing device right? And a screen?
>
> A. [Dr. Slocum] Because a single-board computer by itself in this invention, you'll drip sweat on it and you'll have a mess.
>
> Q. It won't work?
>
> A. It will work for a little bit before it shorts out.

Dkt. 233-4, at 345–346. While Dr. Slocum was expressly reviewing the specification of one of the Asserted Patents, there is no material difference between these specifications and the '119 specification that would support the notion that the earlier device *would* function with a backless, screenless computing device. This evidence is persuasive, as exemplified by *Rivera v. ITC*, 857 F.3d 1315 (Fed. Cir. 2017). There, the plaintiff, who had designed a "pod adapter assembly" to be used with a single-serve coffee brewer, accused the defendant of patent infringement based on the

defendant's "beverage capsules" that included an "integrated mesh filter." *Id.* at 1318. One of the relevant questions was whether the plaintiff's invention could accept loose coffee grounds, or whether it must accept coffee grounds contained in "pods." The Federal Circuit found persuasive an expert's statement that the plaintiff's invention "would not function, because inserting loose-grain coffee or loose-leaf tea into the containers shown in the embodiments would clog the brewing chamber." *Id.* at 1321. Likewise here, attempting to use a backless, screenless computing device would likely cause the invention not to function.

Gamevice insists at several points that, regardless of how the '119 patent discloses only computing devices with backs and screens, it should not be read to preclude the broader genus of computing devices since it was "well within the knowledge of a person of ordinary skill in the art that the claimed computing device need not be a complete, finished device," given what was known of single-board computers at the time. Opp., at 12. Thus, a person of ordinary skill in the art could simply "add[] either a back or a screen to a rudimentary computing device" to create the invention disclosed in the patent. However, the Federal Circuit has repeatedly stated that, while "[t]he knowledge of ordinary artisans may be used to inform what is actually in the specification," it may not "teach limitations that are not in the specification, even if those limitations would be rendered obvious by the disclosure in the specification." *Rivera*, 857 F.3d at 1322 (citing *Lockwood*, 107 F.3d at 1571). Thus, even if it would have concededly been "obvious" for a person of ordinary skill in the art to add a back or a screen, this does not suffice to show that the '119 patent inventors had possession of such a broad range of computing devices.

The immediate case bears a striking resemblance to *ICU Medical, Inc. v. Alaris Medical Systems, Inc.*, a case involving "medical valves used in the transmission of fluids to or from a medical patient." 558 F.3d at 1372. The plaintiff's patents claimed priority to a 1992 patent, which included only medical valves with a spike, while the infringement claims involved medical valves without a spike. The defendant argued the priority patent was limited only to medical valves with spikes, while the plaintiff argued the "specification's disclosure of valves with a spike support[ed] claims that [we]re neutral regarding whether the valve must include a spike." *Id.* at 1377. The

district court granted summary judgment of invalidity in favor of the defendant, and the Federal Circuit affirmed. The Court noted that the specification, figures, and descriptions described "only medical valves with spikes," *id.* at 1378, and the fact that it would have been "obvious" that the valve could function without a spike was not enough to show that the inventors possessed spikeless valves, *id.* at 1379. Analogously here, the specification reveals only computing devices with backs and screens, and the "obviousness" of adding these features to a backless, screenless computing device is not enough. Gamevice, perhaps tellingly, does not attempt to show why *ICU Medical*'s logic should not apply equally in this case.

Gamevice has therefore failed to show that there is a dispute of material fact as to whether the '119 patent provides written description support for "computing device" in the Asserted Patents. It does not. As such, the Asserted Patents are not entitled to the '119 patent's priority date, and the motion is granted in this respect.

2. "Structural Bridge"

Similar to its contentions regarding the use of the term "computing device," Nintendo argues that the '119 patent fails to provide written description support for the term "structural bridge" the way it is claimed in the Asserted Patents. More specifically it argues that the '119 patent "uses the term 'structural bridge' only with reference to a structural bridge that is external to the computing device and not as an internal part of a console." Dkt. 243, at 12. Thus, like with "computing device," this narrow disclosure of an external structural bridge cannot support the broader disclosure Gamevice ostensibly claims in the Asserted Patents. Gamevice disputes this, noting that nothing in the '119 patent requires "a specific positional relationship between the [structural] bridge and the computing device." Opp., at 17. As such, the external structural bridge is merely a preferred embodiment, and it should not be read to limit the scope of what was disclosed by the '119 patent.

While these arguments bear many similarities to the parties' dispute as to the breadth of the term "computing device," the '119 patent is not so limiting as to the term "structural bridge." Unlike with "computing device," which claim 1 of the '119 patent expressly requires to include a

screen and a back, none of the claim language in the '119 patent requires the structural bridge to be "a physical apparatus that secures two or more components to each other across a distance *and which is external to the computing device*" or the like. Nor does the specification state that the structural bridge is even "preferably" external to the computing device. This is significant given that the claims disclose several types of structural bridge — claim 9 discloses a "ridged structure," claim 10 discloses a "removable rigid structure," claim 11 discloses a "flexible structure," and claim 12 discloses a "removable flexible structure" — but none of them require any specific physical or geometric relationship to the computing device. '119 Patent, at 10:56–63. Indeed, as Gamevice points out, the inventors did specify particular geometric relationships of different components in other portions of the '119 patent. *E.g.*, *id.* at 8:15–21.

Nintendo relies primarily on the fact that the diagrams depict only an external structural bridge, but this appears only to disclose a preferred embodiment, which need not be interpreted to pigeonhole the claimed structural bridge. *See Lampi Corp. v. Am. Power Prods., Inc.*, 228 F.3d 1365, 1378 (Fed. Cir. 2000) ("Although the patent drawings show only identical half-shells, that does not compel the conclusion that the written description of the [prior] patent is so narrowly tailored as to preclude [plaintiff] from claiming non-identical half-shells in the [instant] patent." (citations omitted)). Further, to the extent the parties and their experts disagree as to how a person of ordinary skill in the art would interpret the scope of a "structural bridge" as disclosed in the '119 patent specification, this raises a dispute of fact that precludes summary judgment. *Compare* Dkt. 244, at 9 ("A person of ordinary skill in the art would have reasonably understood that the inventor had possession of a structural bridge that is internal or partially internal to the computing device."), *with* Motion, at 24 ("Dr. Stein concluded . . . that '[a] person of ordinary skill in the art . . . would not understand that the inventors possessed a "structural bridge" that was other than part of the game controller as of the filing date of the '119 patent.'" (quoting Stein Decl. ¶ 282)). The motion is therefore denied in this respect.

V. CONCLUSION

For the reasons discussed above, the asserted claims using the term "computing device" are

not entitled to the priority filing date of the '119 patent. The motion for summary judgment is granted in part, and these claims — i.e., all asserted claims except claim 16 of the '713 patent — are therefore invalid as anticipated by the Nintendo Switch. The motion is otherwise denied.

IT IS SO ORDERED.

Dated: March 14, 2023

RICHARD SEEBORG
Chief United States District Judge

United States District Court
Northern District of California