

UNITED STATES INTERNATIONAL TRADE COMMISSION
WASHINGTON, D.C.

In the Matter of

**CERTAIN PORTABLE GAMING
CONSOLE SYSTEMS WITH
ATTACHABLE HANDHELD
CONTROLLERS AND
COMPONENTS THEREOF**

Inv. No. 337-TA-1111

Order No. 18

On October 1, 2018, respondents Nintendo of America, Inc. and Nintendo Co., Ltd. (collectively, "Nintendo") filed a motion seeking leave to supplement the notice of prior art. Motion Docket No. 1111-011. Complainant Gamevice, Inc. ("Gamevice") opposed the motion. As indicated below, Nintendo's motion is denied.

I. BACKGROUND

Ground Rule 2 requires:

Any party asserting invalidity or noninfringement of a patent claim must file on or before the date set in the procedural schedule, notice of any prior art consisting of the following information: the country, number, date, and name of the patentee of any patent; the title, date and page numbers of any publication to be relied upon as anticipation of the patent claim, or as showing the state of the art; and the name and address of any person who may be relied upon as the prior inventor or as having prior knowledge of or as having previously used or offered for sale the invention of the patent claim.

...

In the absence of such notice, proof of the said matters may not be introduced into evidence at the trial except upon a timely written motion showing good cause.

Order No. 16 (Amended Ground Rules) at 3. The procedural schedule required Nintendo to file its notice of prior art by August 31, 2018. *See* Order No. 9 (Amended Procedural Schedule) at 1.

Nintendo’s proposed supplemental notice of prior art seeks to include three Godfroid-related items:

I. PATENTS

| Country/ Authority | Number | Title | Issue/ Pub. Date | Patentee/ Applicant |
|-----------------------|--------------------------|------------|---------------------|------------------------|
| <u>EU</u> | <u>300 5453- 001</u> | <u>N/A</u> | <u>03/09/2011</u> | <u>Godfroid</u> |

* * *

II. PRINTED PUBLICATIONS

| Title | Author | Date | Relevant Pages |
|--|-----------------|-------------------|----------------|
| <u>Gamepad controller 2012</u> <u>http://godfroid- design.wixsite.com/johan-godfroid- /gamepad-controller-2012</u> | <u>Godfroid</u> | <u>N/A</u> | <u>N/A</u> |
| <u>Filing relating Benelux Office for Intellectual Property i-DEPOT No. 035978</u> | <u>Godfroid</u> | <u>04/18/2012</u> | <u>N/A</u> |

* * *

IV. PRIOR INVENTORS

Nintendo amends this notice to identify Johan Godfroid as a prior inventor of the asserted claims, it is Nintendo’s understanding that the addresses of Mr. Godfroid are within Complainant’s possession.

See Mot., Ex.1 at 9, 15, 22 (the above tables are excerpts from Nintendo’s proposed, supplemented notice of prior art).¹

¹ Nintendo’s motion does not fully develop an argument concerning the proposed “Prior Inventors” supplement.

Nintendo argues that although it was diligent in pursuing requested discovery, it “did not include the Godfroid reference because, at the time, Nintendo’s counsel was unaware that Mr. Godfroid had disclosed his designs to Gamevice’s inventors . . . and that Gamevice’s inventors had no corroborating evidence of its supposed conception.” Mot. at 10.

Nintendo argues that it failed to include the Godfroid reference because “Gamevice produced the Godfroid reference two days before Nintendo’s notice of prior art was due.” Mot. at 8. Nintendo explains that Gamevice did not respond to initial production requests for almost three months, and did not provide responsive emails until August 24. *Id.* at 8-9. Due to the size of the document production, over 10,000 emails, Nintendo states it did not uncover the Godfroid letter until Saturday, September 8. *Id.* at 10-11. Therefore, Nintendo argues that good cause exists to supplement the notice of prior art. *Id.* at 10.

In opposition, Gamevice argues that “Nintendo failed to diligently search for the publicly available reference prior to the August 31, 2018 deadline and has provided no explanation for why it could not have found this art sooner.”² Opp’n at 8. Gamevice argues that “Nintendo’s failure to identify Godfroid in its Notice of Prior Art is solely the result of [Nintendo’s] own lack of diligence”³ *Id.* at 1. Gamevice also argues that Nintendo’s claim that the Godfroid reference was publicly available is evidence that Nintendo should have identified Godfroid in

² Gamevice notes that Nintendo received the relevant emails a week prior to the deadline to file the notice of prior art. Opp’n at 9.

³ Gamevice states that: “Nintendo identifies the Godfroid reference it seeks leave to assert in a supplemental notice of prior art as a patent and series of printed publications: ‘EU [Patent] No. 002096453-0001,’ dated March 9, 2012 to Godfroid; two webpages that purportedly date to 2012; a third undated webpage; and ‘[f]ilings related [to] Benelux Office of Intellectual Property i-DEPOT No. 035978.’” *See* Opp’n at 6 (citing to Kinsel Decl. Ex. 1 at 9, 14-15). The “two webpages” that Gamevice mentions may not be related to Godfroid because Nintendo does not provide an author for the first webpage, and Nintendo names “Turner” as the author for the second webpage. *See* Mot., Ex. 1 at 14.

advance of the notice deadline. *Id.* at 2. Additionally, Gamevice further argues that “any delay in obtaining the Gamevice emails at issue was the result of Nintendo’s failure to provide the search terms . . . until over three months after it served its document requests in May 2018.” *Id.* at 9.

II. APPLICABLE LEGAL STANDARDS

In *Certain Road Milling Machines and Components Thereof*, the administrative law judge explained:

Ground Rule 2 requires respondents to file a timely motion showing good cause exists to amend the notice of prior art. *See* Order No. 2 (Ground Rules); *see also Certain Network Devices, Related Software and Components Thereof (I)*, Inv. No. 337-TA-944, Order No. 16 at 2 (July 31, 2015). In determining whether good cause exists, administrative law judges in other investigations have considered: (1) the party’s diligence in searching for prior art; (2) the difficulty of identifying the prior art in question; (3) the potential prejudice the amendment would cause to any non-moving party; and (4) whether the prior art addresses the merits of the case. *Certain Recombinant Factor VIII Products*, Inv. No. 337-TA-956, Order No. 14 at 2-3 (Oct. 27, 2015).

Certain Road Milling Machines and Components Thereof, Inv. No. 337-TA-1067, Order No. 21 at 3 (Feb. 8, 2018).

III. ANALYSIS AND CONCLUSION

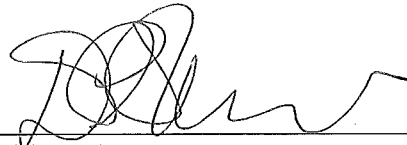
Having considered the parties’ arguments, the administrative law judge has determined to deny respondents’ motion.⁴ Nintendo has not shown that good cause exists to supplement the notice of prior art.

⁴ The parties generally focus their arguments on Nintendo’s diligence. *See* Mot. at 10 (“[T]he most heavily weighted factor in a motion to amend a prior art notice is a movant’s diligence.”) (quoting *Certain Microelectromechanical Systems and Products Containing the Same*, Inv. No. 337-TA-876, Order No. 19 at 1-2 (Aug. 29, 2013); *see also* Opp’n at 10 (“Accordingly, because Nintendo has failed to demonstrate the ‘most heavily weighted factor’ in a motion to amend – the

Nintendo has not shown it was diligent in identifying the Godfroid reference, nor has it shown that the reference was difficult to identify. Nintendo acknowledges that the Godfroid reference was publicly available. For instance, in its proposed supplemental notice of prior art, Nintendo identifies Godfroid as a patent. *See, e.g.,* Mot., Ex. 1 at 9 (identifying patent number “002096453-0001”). Nintendo’s motion also indicates that the webpages it identified are publically available “printed publications.” *Id.* at 15.

Moreover, the belated addition of new alleged prior art would unduly disrupt the procedural schedule. Therefore, respondents have failed to show good cause to amend the prior art notice.

Accordingly, Motion No. 1111-011 is denied.



David P. Shaw
Administrative Law Judge

Issued: November 20, 2018

movant’s own diligence – this motion should be denied.”). The administrative law judge considers the four factors identified in *Certain Road Milling Machines*.

**CERTAIN PORTABLE GAMING CONSOLE SYSTEMS WITH ATTACHABLE
HANDHELD CONTROLLERS AND COMPONENTS THEREOF**

INV. NO. 337-TA-1111

PUBLIC CERTIFICATE OF SERVICE

I, Lisa R. Barton, hereby certify that the attached **Order No. 18** has been served upon the following parties as indicated, on NOV 20 2010.



Lisa R. Barton, Secretary
U.S. International Trade Commission
500 E Street SW, Room 112A
Washington, DC 20436

| | |
|--|--|
| FOR COMPLAINANT GAMEVICE, INC.: | |
| Jeffrey S. Gerchick, Esq. QUINN EMANUEL URQUHART & SULLIVAN, LLP 1300 I Street, NW, Suite 900 Washington, DC 20005 | <input type="checkbox"/> Via Hand Delivery <input type="checkbox"/> Express Delivery <input checked="" type="checkbox"/> Via First Class Mail <input type="checkbox"/> Other: _____ |
| FOR RESPONDENTS NINTENDO CO. LTD.; AND NINTENDO OF AMERICA, INC.: | |
| Grant Kinsel, Esq. PERKINS COIE LLP 1201 Third Avenue, Suite 4900 Seattle, WA 98101 | <input type="checkbox"/> Via Hand Delivery <input type="checkbox"/> Express Delivery <input checked="" type="checkbox"/> Via First Class Mail <input type="checkbox"/> Other: _____ |