

IN THE UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF TEXAS  
LUFKIN DIVISION

ANASCAPE, LTD.

Plaintiff,

v.

MICROSOFT CORPORATION, and  
NINTENDO OF AMERICA, INC.,

Defendants.

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Hon. Ron Clark

Civil Action No. 9:06-CV-00158-RC

Oral Argument Requested

**DEFENDANTS' JOINT REPLY IN SUPPORT OF  
THEIR MOTION FOR PARTIAL SUMMARY JUDGMENT  
OF INVALIDITY OF CLAIMS 19-20, 22-23 OF THE '700 PATENT**

DEFS' JOINT REPLY IN SUPPORT OF THEIR MOTION FOR  
PSJ OF INVALIDITY OF CLAIMS 19-20, 22-23 OF THE '700 PATENT

## **I. INTRODUCTION**

Anascape's perfunctory Response offers little resistance to this Motion. It does not deny that Defendants have carried their initial burden of production under Fed. R. Civ. P. 56(c). It cites no evidence in its "Response to List of Undisputed Facts" that is not already cited by Defendants. It identifies no additional material fact. It does not deny that:

- Claims 19-20, 22-23 are invalid if they cannot be backdated to 1996 (because they're anticipated by the prior art Dual Shock and Dual Shock 2 controllers);
- The Patent Office found (preliminarily) that these claims cannot be backdated;
- Armstrong's CPA did not meet the statutory requirements for a patent application (breaking the required continuity of co-pending applications);
- The 1996 application's claims, Abstract, and Summary of the Invention all required a single<sup>1</sup> input member movable in six degrees of freedom (a "6 DOF input member"); and
- The 1996 application dismissed a prior art controller as "functionally and structurally deficient" because it lacked a 6 DOF input member.

And, as explained below, it does not dispute that:

- All "invention" embodiments in the 1996 application had a 6 DOF input member.

## **II. ARGUMENT**

### **A. The Gap Between The Applications Bars Backdating Of These Claims**

There is a three month gap between Mr. Armstrong's 1996 application (abandoned Aug. 2000) and his '700 Patent application (filed Nov. 2000). (Jt. Mot. at 8). This gap in continuity bars the '700 Patent claims from being backdated under 35 U.S.C. § 120. (*Id.*) Armstrong's August, 2000, CPA cannot fill this gap because it lacked the specification and drawing(s)

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<sup>1</sup> The controller may have multiple input members. The word "single" here means that (at least) one of the controller's input member(s) is movable in 6 DOF in relation to the controller—as distinct from, e.g., having six different input members each movable in only one DOF.

required of all U.S. patent applications by 35 U.S.C. §§ 111, 112. (*Id.*). Therefore, as a matter of law, these claims cannot be backdated to 1996. (*Id.* at 8-9).

Anascope has no response to this ground for summary judgment. It cites no authority permitting a trial court to disregard these statutory requirements. It argues (incorrectly) that the “invention” of the 1996 application did not include a 6 DOF input member and thus the CPA’s claims (not requiring a 6 DOF input member) introduced no “new matter.” But, Anascope does not argue that the CPA therefore qualified as a patent application under Sections 111, 120. Accordingly, this ground for summary judgment stands unrebutted.

**B. The 1996 Application Disclosed Controllers With Multiple Input Members, And Required One Of Them To Be Manipulatable In Six Degrees Of Freedom**

The 1996 application described “a controller having a single input member (a joystick or track ball) manipulatable in six degrees of freedom (6-DOF) relative to the controller, and every embodiment of that ‘invention’ included that single input 6-DOF member.” (Undisputed Material Fact No. 6). Anascope says it disputes this fact, but actually it disputes a straw man.

Anascope says “a reasonable jury would find that the embodiment shown at Figures 1-6 of the ’525 Patent uses two input members, instead of a single input, and that Figure 47 shows an input member capable of accepting inputs along only two axes.” (Response at 6) (emphases added). Defendants agree that the 1996 application disclosed controllers with multiple input members. (Fig. 9 has more than two dozen input members (A060)). But that is besides the point. The point—surely not lost on Anascope—is that all embodiments had an input member (trackball or joystick) that was manipulatable in six degrees of freedom. (Jt. Mot. at 2, 6-7).

Anascope’s Response does not dispute this indisputable fact. For example, Anascope cites to Figs. 1-6, but does not deny that the trackball 12 in Figs. 1-6 is manipulatable in six degrees of freedom. Similarly, Anascope notes the sensors of Fig. 47, but does not deny that the handle 300 in which those sensors are placed is a 6-DOF input member. (*See* A071-076 (Figs. 20-28)).

Further, the 1996 application identified many features as merely preferred or otherwise optional—including the collet in Figs. 1-6. It is telling, therefore, that Anascope cannot find a

single syllable in the 1996 application suggesting that its 6-DOF input member was optional. In other words, the 1996 application itself is clear and convincing evidence that a single input member movable in six degrees of freedom was a required feature of the “invention.”

On this record, no reasonable Jury could find that the 1996 application described the “invention” Mr. Armstrong claimed six years later (after seeing Sony’s controllers).

**C. A Bicycle Is Not A Unicycle**

A hypothetical will help illustrate the flaws in Anascape’s attempts to avoid summary judgment. Suppose Inventor X files a patent application describing unicycles. Each embodiment has only a single wheel and each application claim requires that there be only a single wheel. Further, X’s application dismisses a prior device on multiple grounds, including a criticism that the device was “functionally and structurally deficient” because it had more than one wheel. Later, X sees a bicycle, and likes what he sees. So, X files a new patent application with a new claim reciting “at least one wheel.” He later argues that this broadened claim can be backdated to his unicycle application because (1) his unicycle had at least one wheel, so the later-filed claim “reads on” that earlier disclosure (*cf.* Response at 4), and (2) persons of skill in the art would have known they could modify the unicycle to have two wheels (*cf. id.* at 7). X is wrong. The claim cannot be backdated because it claims a different invention than that described in his first application. (*See* Jt. Mot. at 5-6).

**D. It Is Irrelevant That It Was Obvious How To Change The 1996 Design**

Anascape argues that it would have been obvious to modify Mr. Armstrong’s 1996 disclosed “invention” to replace its 6-DOF input member with two 3-DOF input members. (Response at 7). That is irrelevant as a matter of law. *See Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997) (“Entitlement to a filing date does not extend to subject matter which is not disclosed, but would be obvious over what is expressly disclosed. It extends only to that which is disclosed.”). The question is whether the 1996 application clearly shows that its author possessed the later-claimed invention, not whether others could have invented it after reading the application.

**E. Anascape Distinguishes None Of The Pertinent Case Law**

As explained above, it is undisputed that all embodiments in the 1996 application had a 6 DOF input member; that all of the original claims, the Abstract, and the Summary of the Invention expressly required such a 6 DOF input member; and that the 1996 application dismissed the Chang controller as “functionally and structurally deficient” because it lacked a 6 DOF input member. These facts are equal to or stronger than those in the four cases cited by Defendants, where an alleged inventor unsuccessfully tried to broaden patent claims by omitting a feature he’d previously described as a non-optional part of his invention. (Jt. Mot. at 5-6). Anascape does not even try to distinguish those cases from this case.

For example, *Tronzo v. BioMet, Inc.*, 156 F.3d 1154 (Fed. Cir. 1998), concerned an artificial hip socket that included a cup implant for insertion into a hip bone. The patent owner sought to preserve the validity of later-filed patent claims by claiming priority to an ancestor application. *Id.* at 1158. The ancestor application described the cup as having a truncated conical shape. *Id.* at 1159. As here, the only description of a cup with a different shape was found in discussing the prior art, and the ancestor application criticized that alternative shape as inferior. *Id.* Later-filed patent claims, however, recited the cup implant generically, without specifying its particular shape. The Federal Circuit reversed a jury’s verdict, holding that the claims were broader than the ancestor application’s disclosure and therefore not entitled to the ancestor’s filing date (and thus were invalid). *Id.* at 1160.

Anascape (Response at 5) cites a genus-species case, *Bilstad v. Wakalopulos*, 386 F.3d 1116, 1125 (Fed. Cir. 2004), but *Bilstad* states that a case such as *Tronzo* (and, thus, this case) is an “exception” to the genus-species line of cases it followed: “Another exception [“to the general rule that disclosure of a species provides sufficient written description support for a later filed claim directed to the genus”] is presented in *Tronzo v. Biomet, Inc.*, 156 F.3d 1154 (Fed. Cir. 1998). In *Tronzo*, this court held that substantial evidence did not support the jury’s verdict that claims to a hip prosthesis of generic shape were supported by a parent disclosing only a trapezoidal shape. We said, ‘Instead of suggesting that the ’589 patent [the parent] encompasses

additional shapes, the specification specifically distinguishes the prior art as inferior and touts the advantages of the conical shape of the '589 cup. Such statements make clear that the '589 patent discloses only conical shaped cups and nothing broader.’”

**F. The Court’s *Markman* Ruling Supports This Motion**

Anascape seeks solace in its successful *Markman* argument that these claims, drafted in 2002, do not require a 6 DOF input member. (Response at 5). But that claim construction is the source of these claims’ invalidity, not their salvation. The same was true in *Liebel Flarsheim Co. v. Medrad, Inc.*, 481 F.3d 1371 (Fed. Cir. 2007). There, as here, a patent owner obtained a broad claim construction after successfully resisting arguments that the specification limited the scope of the claims. The trial court, however, later granted summary judgment that the claims were invalid because the narrow disclosure was not enabling and did not provide adequate written description for the claims’ broad scope. *Id.* at 1376-77. The Federal Circuit affirmed invalidity for lack of enablement (and did not reach written description), noting the irony: “The motto, ‘beware of what one asks for,’ might be applicable here.” *Id.* at 1380.

Although this Court’s *Markman* ruling is the foundation for the present Motion, it did not decide the backdating issue presented by this Motion. Both the record and the issue are different. For claim construction, the most important part of the record is the language of the claims (here, drafted in 2002 and later), along with the rest of the Patent Office record up to issuance. Here, in contrast, the only Patent Office record that counts is the 1996 application itself. *Lockwood*, 107 F.3d at 1572 (“Lockwood argues that the district court erred by looking solely at the applications themselves. We do not agree. It is the disclosures of the applications that count.”). Also, the issue here is whether the 1996 application provided a written description of the later-claimed “invention” that was complete, unambiguous, specific, and equally broad. (Jt. Mot. at 5). This issue was not addressed in the *Markman* ruling.

**G. Anascape’s “Evidence” Is Improper And Unhelpful**

Anascape’s unsworn and hearsay “expert” reports (Exs. 4, 37) are not summary judgment evidence. *See* Fed. R. Civ. P. 56(e), Local Rule CV-56(d). Further, neither the

reports nor the deposition testimony argued by Anascape (Response at 7), appears in its “Response to List of Undisputed Material Facts” (*id.* at 3).

Even if considered, these reports would not help Anascape defeat this Motion. On the contrary, Mr. Howe’s report would bolster this Motion. In trying to argue Anascape’s position, Mr. Howe (perhaps unwittingly) admits that all embodiments in the 1996 application included a single 6 DOF input member: “Bristow characterizes the claims in the CPA dated August 4, 2000, as ‘broader’ than the disclosure of the original ’525 Application because it did not require a single input member capable of being manipulated relative to a reference member in six degrees of freedom. See Bristow Report at 42. I disagree. Although the embodiments of the ’525 Application all have a single input member, the disclosure did not limit the invention to only controllers that have a single input member.” (Response, Ex. 4 at ¶ 155). (Emphases added). And, he concedes that the 1996 application contained “language that shows that it [a 6 DOF input member] is ‘an object’ or ‘a primary object’ of the invention.” (*Id.*)

### **III. CONCLUSION**

The Court should grant partial summary judgment because (1) Anascape concedes that the two Sony Dual Shock controllers<sup>2</sup> are anticipatory prior art to these claims if they cannot be backdated to 1996, (2) the claims cannot be backdated under the governing statutes and case law, and (3) no material facts are genuinely disputed.

Dated: March 17, 2008

Respectfully submitted,

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<sup>2</sup> This Motion’s Fogerty Declaration contained an evidence-authentication error. Defendants apologize for this error, and submit the Declaration of John D. Vandenberg explaining it, and submitting substitute evidence.

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## **CERTIFICATE OF SERVICE**

The undersigned certifies that on the 17th day of March, 2008, the foregoing pleading was electronically filed with the Court. Pursuant to Local Rule CV-5, this constitutes service on Anascape's counsel of record:

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