

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

ANASCAPE, LTD

*Plaintiff,*

v.

MICROSOFT CORP. AND  
NINTENDO OF AMERICA, INC.

*Defendant.*

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Civil Action No. 9:06-CV-158

JUDGE RON CLARK

**ORDER DENYING MOTIONS FOR SUMMARY JUDGMENT**

Before the court is Defendant Microsoft Corporation’s Motion for Summary Judgment of Non-Infringement of U.S. Patent No. 6,906,700 (“the ‘700 patent”) [Doc. #203], Defendant Nintendo of America, Inc.’s Motion for Summary Judgment of Non-Infringement [Doc. #202] and Defendants’ Joint Motion for Partial Summary Judgment of Invalidity of Claims 19-20, 22-23 of the ‘700 patent [Doc. #205].

The party moving for summary judgment under Fed. R. Civ. P. 56 has the initial burden of demonstrating that there is no genuine issue as to any material fact and that it is entitled to judgment as a matter of law. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 256, 106 S. Ct. 2505, 2514 (1986). Defendants have not demonstrated as a matter of law that the accused products do not infringe the ‘700 patent, or that claims 19-20 and 22-23 of the ‘700 patent are invalid. The motions for summary judgment are denied.

**A. Non-Infringement**

Determination of infringement, whether literal or under the doctrine of equivalents is “a two-step process in which we first determine the correct claim scope, and then compare the

properly construed claim to the accused device to determine whether all of the claim limitations are present either literally or by a substantial equivalent.” *Renishaw PLC v. Marposs Societa’ Per Azioni*, 158 F.3d 1243, 1247-48 (Fed. Cir. 1998). Claim construction is an issue of law. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 116 S. Ct. 1384 (1996). A determination of infringement, whether literal or under the doctrine of equivalents, is normally a question of fact. *Biovail Corp. Int’l v. Andrx Pharms., Inc.*, 239 F.3d 1297, 1300 (Fed. Cir. 2001).

#### 1. Microsoft’s Motion for Summary Judgment of Non-Infringement

\_\_\_\_\_ Microsoft argues that its accused Xbox controllers and Xbox 360 controllers do not infringe claims 12-15 and 32-33 of U.S. Patent No. 6,906,700 because the controllers do not have one or more input members capable of movement in all six degrees of freedom (6DOF). This is a repetition of the argument rejected in the court’s claim construction order. *See* Doc. #182. The court expressly stated: “. . . the claims of the ‘700 patent clearly describe devices that control movement in three dimensions (or 6DOF) . . . .” *Id.* at p. 8. At the hearing, Microsoft did not dispute Plaintiff Anascape, Ltd.’s statement that there is no substantial disagreement about whether the claims of the ‘700 patent describe a controller that manipulates a game in 6DOF or in three dimensions. *See* Tr. p. 19, ll. 21-25. Anascape provides evidence that special software could map or assign a physical movement of an input member along or about an axis to create an graphic object on a screen that is perceived as capable of movement in 6DOF.

Having to draw all inferences in favor of Anascape, the court can not determine on the record before it, whether Microsoft’s accused products are reasonably capable of an infringing use. The court therefore denies Microsoft’s motion for summary judgment on non-infringement of the ‘700 patent.

## 2. Nintendo's Motion for Summary Judgment of Non-Infringement

Nintendo contends that none of its accused controllers infringe the '700 patent because (1) three<sup>1</sup> of the accused controllers allow only rotational movement on the x axis and on the y axis -- movement in two, not six, degrees of freedom, and (2) none of the accused controllers<sup>2</sup> have a second or third element which satisfy the "navigating a viewpoint" limitation.

Anascape produces evidence that the Wii Remote is moveable in 6DOF. Anascape also presents evidence that the outputs of the accused bidirectional sensors of each Nintendo accused product are capable of controlling objects and navigating viewpoints.

Based on a careful and thorough review of the record and the arguments presented, the court finds that genuine issues of material fact exist as to whether the Wii Remote allows movement in 6DOF and whether the other accused products could be capable of infringing uses without substantial alteration. The court therefore denies Nintendo's motion for summary judgment on non-infringement.

### **B. Invalidity**

Defendants argue that claims 19-20 and 22-23 of the '700 patent are invalid because they are not entitled to the filing date of the July 1996 application, and are therefore rendered invalid by the Sony Dual Shock controllers. Defendants' argument turns on whether the July 1996 application sufficiently describes the invention claimed in the '700 patent, namely controllers

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<sup>1</sup>These are the GameCube controller, the GameCube Wavebird wireless controller, and the Wii Classic controller connected to the Wii Remote.

<sup>2</sup>These are the GameCube controller, the GameCube Wavebird wireless controller, the Wii Classic controller connected to the Wii Remote, and the Wii Nunchuk Controller connected to the Wii Remote

failing to provide any 6DOF movement and controllers providing 6DOF movement via operation of multiple input members.

Anascape contends that the '525 patent disclosed the claims asserted in this case. Anascape argues that based on the testimony from Kazunori Koshiishi, an engineer at Nintendo Co. Ltd., a reasonable jury could find that Figure 2 of the '525 patent discloses a controller that uses multiple input members that do not move on three linear and three rotational axes.

35 U.S.C. § 112, ¶ 1 provides that “[t]he specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same. . . .” For purposes of claiming priority under a previous patent application, 35 U.S.C. § 120 provides that “[a]n application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States . . . shall have the same effect, as to such invention, as though filed on the date of the prior application. . . .” The accused infringer bears the burden of proving lack of priority by clear and convincing evidence. *Chiron Corp. v. Genentech, Inc.*, 368 F.3d 1247, 1252, 1259 (Fed. Cir. 2004).

A specification in a parent patent or patent application adequately describes an invention if it “reasonably convey[s] to one of skill in the art that the inventor possessed the later-claimed subject matter at the time the parent application was filed.” *Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 1158 (Fed. Cir. 1998). “A disclosure in a parent application that merely renders the later-claimed invention obvious is not sufficient to meet the written description requirement; the disclosure must describe the claimed invention with all its limitations.” *Id.* Such compliance is a

question of fact. *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir. 1991).

Interpreting the available evidence in a light most favorable to Anascape, the court cannot find at this time that Defendants have proven by clear and convincing evidence that claims 19-20 and 22-23 of the '700 patent were not disclosed in the earlier '525 patent.

IT IS THEREFORE ORDERED that Defendant Microsoft Corporation's Motion for Summary Judgment of Non-Infringement of U.S. Patent No. 6,906,700 ("the '700 patent") [Doc. #203] is **DENIED**.

IT IS FURTHER ORDERED that Defendant Nintendo of America, Inc.'s Motion for Summary Judgment of Non-Infringement [Doc. #202] is **DENIED**.

IT IS FURTHER ORDERED that Defendants' Joint Motion for Partial Summary Judgment of Invalidity of Claims 19-20, 22-23 of the '700 patent [Doc. #205] is **DENIED**.

IT IS FURTHER ORDERED that Plaintiff's Motion for Leave [Doc. #239] is **DENIED as moot**.

So **ORDERED** and **SIGNED** this **27** day of **March, 2008**.



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Ron Clark, United States District Judge