

April 29, 2008

Honorable Ron Clark
United States District Judge
Jack Brooks Federal Building
300 Willow Street, Suite 221
Beaumont, Texas 77701

**VIA E-MAIL AND
VIA HAND DELIVERY**

Subject: Supplemental Submission In Opposition to Plaintiff's In Limine Motion No. 19 and Request For Clarification of Construction of '700 Patent Claim Terms In Light of the *O2 Micro* Federal Circuit Decision and Anascape's Priority Date Contention (Civil Action No. 9:06cv158).

Dear Judge Clark:

Nintendo requests clarification or additional claim construction of the '700 patent claim 19 terms "providing outputs at least in part controlling objects and navigating a viewpoint", "operable" and "operating", in light of the *O2 Micro* Federal Circuit decision and Anascape's priority date contention.

"Operable", "Operating"

During claim construction, Defendants urged the Court to interpret the claim 19 phrase "hand operated controller" as requiring a single input member moveable in six degrees of freedom relative to a reference member of the controller. (See Nintendo's Claim Constr. Br. at 9 *et seq*; Microsoft's Claim Constr. Br. at 8 *et seq*.) The Court construed the term "controller" but declined to construe the term "operated", stating:

"hand operated" in the phrase "hand operated controller" is redundant, or merely emphasizes what is already clear from the specification—the controllers described by these patents are hand-held and operated by hand.

(1/11/08 Mem. Op. at 11 n. 5).

Relying on these claim construction rulings, Anascape has moved to preclude Defendants from arguing that the term “3-D graphics controller” or *any other claim term of the patent-in-suit* requires an input member or input members moveable on three linear axes and three rotational axes. (Anascape’s Motion In Limine No. 19 at 12.)

Meanwhile, Anascape says it will contend at trial that ‘700 patent claim 19 is entitled to the benefit of the July 5, 1996 filing date of the ‘525 patent (Joint Final Pretrial Order at 6). Anascape’s In Limine motion no. 19 is inconsistent with the inventor’s clear definition of the term “operate” and its derivatives “operable” and “operating” in the “Summary of the Invention” portion of the ‘525 patent specification which Anascape intends to rely on for priority:

For the purposes of this teaching, specification and claims, it is important to define the terms: “manipulate, *operate* and converter.”

* * * *

The term “*operate*”, and all derivatives (operated, *operating*, operable, operation, etc.) is used in the context of *the input member being operable in 6 DOF relative to the reference member. This means that the handle can be linearly moved along and/or rotated about the three mutually perpendicular axes in 6 DOF* and it does necessarily mean that sensors are being stimulated and that the device is outputting a signal representative of theT input operation.

(‘525 patent specification, col. 6 lines 65-67, col. 7 lines 15-22, emphasis added).

Federal Circuit case law is clear: When a patentee acts as his own lexicographer by defining claim terms in his patent specification, the inventor’s definition controls. *See, e.g., Sinorgchem Co. v. ITC*, 511 F.3d 1132, 1136 (Fed. Cir. 2007) (holding that the patent specification defined the claim term “controlled amount” to have a special meaning).

Nintendo anticipates that the experts at trial will disagree about the meaning of the claim 19 terms “operated” and “operating”, and requests the Court to now construe those terms.¹ See *O2 Micro International Limited v. Beyond Innovation Technology Co., Ltd.*, slip op. (Fed.Cir. No. 2007-1302, April 3, 2008) (judgment reversed where court declined to construe “only if” claim language and instead permitted the parties to argue different constructions at trial)

“Sensors Providing Outputs At Least In Part Controlling Objects And Navigating A Viewpoint”

During the claim construction phase, the Defendants asked the Court to construe the claim 19 term “navigating a viewpoint” (which occurs in three places in the claim) as meaning “positioning and orienting a user’s view, as opposed to controlling an object.” (Nintendo’s Claim Constr. Br. at 34 et seq.; Microsoft’s Claim Constr. Br. at 30.) The Court construed the phrase as meaning “positioning or orienting a user’s view” (2/4/08 Mem. Op. at 13). Nintendo understands the Court’s decision to construe this claim term as a determination that the term constitutes a positive claim limitation at least with respect to its second and third occurrences in claim 19. See Nintendo’s 3/20/08 Reply in Support of Summ. J. of Non-Infringement at 2 et seq. In contrast, Anascape contends that these associated claim 19 limitations are “simply functionally limitations” and that claim 19 does not require bidirectional proportional sensor outputs to actually control objects and navigate viewpoints as the claim clearly requires. See Anascape’s 3/25/08 Surreply in Opposition to Summ. J. at 4-5.

Nintendo anticipates that at trial, the expert witnesses will disagree about whether this language constitutes a positive claim limitation (as Nintendo contends) or merely a theoretical capability (as

¹ Were a final judgment to be entered finding claim 19 valid and infringed, Defendants would contend on appeal that the terms “operable” and “operating” must be construed in accordance with the inventor’s special definition set forth in his ‘525 patent specification. To the extent Anascape may contend that the term “operable” is not a positive claim limitation because it occurs in the claim preamble, Nintendo notes that “hand operating” appears in the body of claim 19. See e.g., *Eaton Corp. v. Rockwell International Corp.* 323 F3d 1332 (Fed. Cir. 2003) (reversing trial court’s determination that claim preamble was merely a statement of intended use, stating that “[w]hen limitations in the body of the claim rely upon and derive antecedent basis from the preamble, then the preamble may act as a necessary component of the claimed invention”).

Anascape contends).² Therefore, in view of *02 Micro*, Nintendo requests the Court to clarify its construction of the phrases “sensors providing outputs at least in part controlling objects and navigating a viewpoint.”

Sincerely,

GERMER GERTZ, L.L.P.

By: 
Charles W. Gochringer, Jr.

CWG/rr
Enclosures

² See Deposition of Dr. Howe, Anascape’s technical expert, at 78:20-80:2, attached hereto.

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EXHIBIT: 366

UNITED STATES DISTRICT COURT

EASTERN DISTRICT OF TEXAS

LUFKIN DIVISION

No. 9:06-CV-158

ANASCAPE LIMITED,

Plaintiff

vs.

MICROSOFT CORPORATION and

NINTENDO OF AMERICA,

Defendants

VIDEOTAPED DEPOSITION OF ROBERT HOWE, Ph.D.

Thursday, March 27, 2008 9:51 a.m

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2 Q. Okay. So, then, based on those two
3 statements, if we assume, then, that the left -- I'm
4 sorry, that the right thumb stick is the "second
5 element" defined in Claim 19, then based on those
6 answers, you have not indicated anything in your report
7 to suggest, to state that the second element controls
8 objects in either of those two games. Right?

9 MR. GARZA: Object to form.

10 A. Okay. That -- let's see. There are a few
11 points there, a few clarifications there which -- let
12 me make an answer, and again you will tell me I trust
13 if that wasn't -- didn't answer your specific question.

14 Q. Or let me just make sure you understand my
15 question.

16 A. Okay.

17 Q. I want to assume that the right joystick
18 is the claimed second element in Claim 19.

19 A. Very good.

20 Q. And you have already told me that there is
21 nothing in your report stating that the right joystick
22 for Blood Omen 2 or Animal Crossings, the only two
23 games in Exhibit E, there is nothing in your report
24 that that right joystick controls objects in either of
25 those two games?

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2 MR. GARZA: Object to form.

3 A. Let's see. So, the -- I think it's clear
4 in my report that in terms of this element of Claim 19,
5 which begins, "The second element moveable on two
6 mutually perpendicular axes" is capable of controlling
7 objects and navigating a viewpoint.

8 Q. Okay. My question, though, is not whether
9 it's capable. I want you to assume that I'm asking you
10 whether based on your previous two statements about the
11 right thumb stick in those two games you will agree
12 with me, won't you, then that there is nothing in your
13 report to indicate that the second element of Claim 19
14 controls objects?

15 MR. GARZA: Object to form.

16 Q. I'm not talking about the capability, and
17 you've already basically answered. I just want to make
18 sure that we have your clear answer.

19 A. So, I did not cite a specific example in a
20 specific video game of the many video games that can be
21 played. I did not list one particular example of the
22 right thumb stick controlling an object.

23 Q. Okay. And it's your belief, of course,
24 that you don't have to do that to prove infringement.
25 Right?

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2 A. That's correct.

3 Q. Now, if it turns out that you're wrong
4 about that, you would agree with me that your report
5 does not establish infringement. Wouldn't you?

6 MR. GARZA: Object to form.

7 A. Let's see. There are several steps in
8 there, and I need to take that apart a little bit in
9 order to answer it. So, let's see, you've stated the
10 hypothetical idea that if capability is not all that's
11 required, then there is no demonstration of
12 infringement. Is that part of your question?

13 Q. That is my question.

14 A. Okay. So, a hypothetical question I
15 haven't thought about before. You'll have to give me a
16 second to --

17 Q. Understood. That is fine.

18 A. -- give it a little thought. Well, I
19 think it's -- the short answer is no.

20 Q. No, that -- so, let me make sure I
21 understand what that answer means. Could you explain
22 the "no"? I think we've lost the context of what yes
23 or no means.

24 A. Yes. I understand.

25 Q. Okay.

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