

Robert J. Gunther, Jr.

May 11, 2008

+1 212 230 8830 (t)  
+1 212 230 8888 (f)  
robert.gunther@wilmerhale.com

**By Email and Fax**

Honorable Ron Clark  
United States District Court  
300 Willow Street, Suite 221  
Beaumont, Texas 77701

RE: *Anascape v. MS & Nintendo (Case No. 9:06-CV-00158-RC)*

Dear Judge Clark:

During a discussion of the priority issue at the close of trial last Thursday, the Court expressed the view that, in assessing the issue of whether the asserted '700 claims are properly completely described by the 1996 application, the only comparison that the jury should make is between the asserted '700 claims and the 1996 application, i.e., the jury should not consider the changes to the '700 specification in the application filed in 2000 in making that assessment. This letter is in response to the Court's request for authority to support Nintendo's position that the changes made to the '700 application filed in November 2000 are relevant to assessing whether the written description of the 1996 application properly completely describes the asserted claims, which were drafted in 2002 to cover the accused GameCube controller.

In *Chiron Corp. v. Genentech, Inc.*, 363 F.3d 1247, 1255 (Fed. Cir. 2004), the Federal Circuit determined that an earlier Chiron patent application did not provide support for new matter contained in later filed claims. As a result, Chiron's later-filed claims were not entitled to the priority date of the earlier application and, therefore, the claims were anticipated by intervening prior art. The court made clear that the written description requirement prevents patent applicants from updating their *specifications or claims*—both of which have occurred in the instant case:

The written description requirement prevents applicants from using the amendment process to update their disclosures (*claims or specification*) during their pendency before the patent office. Otherwise applicants could add new matter to their disclosures and date them back to their original filing date, thus defeating an accurate accounting of the priority of invention. See 35 U.S.C. 132. Priority is always a vital issue in patent prosecution—often determining entitlement to an invention. (emphasis added)

*Reynolds Metals Co. v. Continental Group, Inc.*, 525 F. Supp. 950 (N.D. Ill. 1981) is also directly relevant to this issue. In that case, Continental asserted that Reynolds was infringing its '976 patent relating to a non-detachable opening device for beverage cans. The '976 patent was filed in 1976 as a continuation of two earlier applications filed in 1972 and 1974. *Id.* at 970-71. At trial, Continental maintained that the asserted claims were entitled to the priority date of the

Judge Clark  
May 11, 2008  
Page 2

1972/1974 applications in order to pre-date two prior art patents to Cudzic dated after the 1972/1974 applications but before the 1976 application. *Id.* The court determined that, despite the fact that the '976 patent was labeled as a continuation of the 1972/1974 applications, both the '976 *specification and claims* contained new matter not present in the 1972/1974 applications. In making that determination, the court stated that:

Thus, if an application is, in fact, a true continuation application, it is entitled to the filing date of the original or parent application. If, however, it *discloses and claims* subject matter not common to or not supported by the parent application, it is not a true continuation application and any claims therein that include new matter are only entitled to the actual filing date of the later-filed application, and not the earlier parent application.

*Id.* at 970 (emphasis added).

As the above quote demonstrates, the *Reynolds* court evaluated both the specification of the '976 patent as well as the '976 patent claims in assessing whether the later-filed claims were properly completely supported by the 1972/1974 applications. In determining that both the *specification and claims* of the '976 patent contained new matter, the court noted that, prior to filing the application for the '976 patent in 1976, the inventor had seen the Cudzic prior art device, which became available after the 1972/1974 applications. *Id.* at 971. The court held that the '976 inventor attempted to enlarge the disclosures of Figure 28 in the 1976 application, as well in the issued '976 claims in an effort to appropriate the prior Cudzic inventions as his own. Accordingly, the court found that the asserted claims were only entitled to the 1976 filing date and could not get back to either the 1972 or the 1974 applications. In performing its analysis, the court did not limit itself to a comparison of the later-issued claims to the 1972/1974 applications; rather, the court engaged in a full comparison of both the 1976 specification and the issued claims as compared with the disclosure of the 1972/1974 applications. *Id.*

Here as in *Reynolds*, the issues presented with respect to the priority date issue are whether the '700 application filed in 2000 contains new matter as compared to the 1996 application, *and* whether the claims drafted in 2002 are properly completely described by the 1996 application. These issues are directly interrelated. Mr. Armstrong admitted on cross-examination that he had seen the GameCube controller when he filed the 2000 application, in which he deleted all seven paragraphs from the 1996 application relating to Chang and changed the references from single input member 6DOF controller to at least one input member 3-D controller. Trial Tr. at 327:7-329:16. He further admitted that he had a disassembled GameCube controller in his hands when he drafted the asserted '700 claims in 2002. Trial Tr. at 363:14-364:12. In deciding the crucial issue of whether these claims are entitled to the date of the 1996 application, the jury should not be told to ignore the changes that Mr. Armstrong made to the 1996 application. Rather, these changes, as well as the full breath of the asserted claims, should

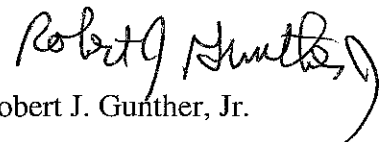
Judge Clark  
May 11, 2008  
Page 3

be used, as they were by the court in *Reynolds*, to determine whether the 1996 application properly completely describes the asserted claims.

In addition, the written description inquiry is not tested objectively. *See, Chiron Corp. v. Genentech*, Civ. No. S-00\_1252 WBS (E.D. Cal.) August 26, 2002 Memorandum Re: Jury Instructions at 13-14, attached hereto. In *Chiron*, the court refused to give a jury instruction that the written description issue is tested objectively. The court noted that the experts in that case were all familiar with the level of ordinary skill in the art and that “[t]heir subjective understanding of the patent and patent applications is relevant to what a hypothetical person of ordinary skill at the time would have understood.” Since experts are permitted, as part of the written description inquiry to provide their subjective understanding as to what the relevant patent and applications were intended to cover, then surely the words of Mr. Armstrong (who is both the inventor and a person of ordinary skill) contained in the 2000 application, including the changes, are relevant to determining what he understood the 1996 application to cover and not cover.

In this case, both Anascape and Nintendo have elicited testimony that Mr. Armstrong made changes to the ‘700 application without any objection by either side. *See, e.g.*, Trial Tr. at 158:8-159:159:24 (Armstrong direct examination); 304:20-347:10 (Armstrong cross-examination). The fact that Mr. Armstrong, after seeing the GameCube controller, decided to change the 2000 specification to delete the criticisms of Chang and make the other changes referenced above is perhaps the best real world evidence that the 1996 application does not support the multiple input member claims that he wrote specifically to cover the GameCube controller. In assessing the critical issue of priority the jury should not be instructed to ignore this directly relevant evidence.

Respectfully submitted,



Robert J. Gunther, Jr.

cc: All counsel of record (by email)