

Patent Suit Against Nintendo Given New Life By Fed. Circ.

By **Ryan Davis**

Law360 (April 1, 2022, 6:39 PM EDT) -- The Federal Circuit on Friday revived a suit accusing Nintendo of infringing a patent with the controllers for its Wii and Switch video game systems, ruling that a Washington federal judge relied too heavily on a Nintendo expert witness in granting the company summary judgment.

The appeals court reversed a decision by U.S. District Judge Ricardo S. Martinez that Nintendo did not infringe the patent asserted by Genuine Enabling Technology LLC, and concluded that he incorrectly construed a key claim term.

The Federal Circuit remanded the case to the district court to consider whether Nintendo infringes under what it said was the correct interpretation of the term.

The appeals court's precedential opinion explained that intrinsic evidence, meaning the claims and specification of a patent and its prosecution history, is important in claim construction, although courts can rely on extrinsic evidence, like expert testimony, in certain scenarios.

However, extrinsic evidence cannot be used to contradict the terms of the claims, the court said. It ruled that is what happened in this case, when the district court relied on testimony from a Nintendo expert to reach a conclusion about how to interpret the claims that is not in line with the words of the patent.

"We are left, therefore, with the conclusion that the district court relied on extrinsic evidence upon extrinsic evidence to draw a bright line in claim scope not suggested anywhere in the intrinsic record," the court said.

Genuine's patent describes technology that lets computers receive sound input from a microphone. The application for the patent was initially rejected by the examiner as obvious based on an earlier patent, but was allowed after inventor Nghi Nho Nguyen amended the claims to distinguish them from that patent.

Genuine alleged that Nintendo's controllers infringe because they sense audible signals based on the movement of the player's hands.

During the infringement suit, Genuine and Nintendo disputed the meaning of the term "input signal" in the patent. Genuine said it encompassed the range of frequencies that humans can hear, from 20 hertz to 20,000 hertz, and that Nintendo's controllers generate frequencies at that level.

Nintendo **argued**, and the district judge agreed, that due to the amendment of Genuine's claims during prosecution, "input signal" refers only to signals over 500 hertz, and that the Wii and Switch controllers do not produce signals anywhere near that level.

Nintendo presented testimony from an expert, Howard Chizeck, that the earlier patent described frequencies up to 500 hertz, so Genuine's patent only covers frequencies higher than that. However, the Federal Circuit ruled that number "has no basis anywhere in the intrinsic record."

"The district court erred by relying on expert testimony to limit the claim scope in a manner not contemplated by the intrinsic record," the appeals court concluded.

The record shows that, as Genuine argued, the term "input signal" instead refers to any signal above 20 hertz, the level humans can hear, the Federal Circuit said. It remanded the case to determine if Nintendo's devices infringe under that interpretation.

Counsel for Genuine declined to comment on the ruling. Counsel for Nintendo could not immediately be reached for comment Friday.

Judges Jimmie Reyna, Pauline Newman and Kara Farnandez Stoll sat on the panel for the Federal Circuit.

The patent at issue is U.S. Patent No. 6,219,730.

Genuine is represented by Devan Padmanabhan, Erin Dungan and Paul Robbennolt of Padmanabhan & Dawson PLLC.

Nintendo is represented by Jerry Riedinger, Kevin Zeck, Andrew Dufresne and David Pekarek Krohn of Perkins Coie LLP.

The case is Genuine Enabling Technology LLC v. Nintendo Co. Ltd., case number 20-2167, in the U.S. Court of Appeals for the Federal Circuit.

--Editing by Kelly Duncan.