

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ELECTRONIC ARTS INC.,
Petitioner,

v.

WHITE KNUCKLE IP, LLC,
Patent Owner.

Case IPR2015-01595
Patent 8,529,350 B2

Before MICHAEL W. KIM, CARL M. DEFRANCO, and
CHRISTA A. ZADO, *Administrative Patent Judges*.

DEFRANCO, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

Electronic Arts Inc. (“EA”) filed a Petition (“Pet.”) for *inter partes* review of claims 1–23 of U.S. Patent No. 8,529,350 B2 (“the ’350 patent”), which is owned by White Knuckle IP, LLC (“White Knuckle”). Paper 1 (“Pet.”). In response, White Knuckle filed a statutory disclaimer of claims 11, 17–20, and 22, and, thus, those claims are no longer at issue.¹ Papers 6, 9. Thereafter, we instituted *inter partes* review of remaining claims 1–10, 12–16, and 23 because EA demonstrated a “reasonable likelihood” of unpatentability as to those claims. Paper 11 (“Dec.”). We declined, however, to institute on claim 21. Dec. 5–7.

In due course, White Knuckle filed a Patent Owner Response (Paper 18, “PO Resp.”), and EA followed with a Reply (Paper 20, “Petr. Reply”). Upon authorization, White Knuckle also filed a Sur-Reply on the issue of priority of invention over one of the asserted prior art references. Paper 22 (“PO Sur-Reply”). An oral hearing was held on October 26, 2016, and a transcript of the hearing is included in the record. Paper 37 (“Tr.”).

After reviewing the evidence and arguments of the parties, and pursuant to our jurisdiction under 35 U.S.C. § 6, we conclude EA has proven by a preponderance of the evidence that claims 1–10, 12–16, and 23 are unpatentable.

II. BACKGROUND

A. *Related Cases*

The ’350 patent is the subject of a co-pending district court action, *White Knuckle IP, LLC v. Electronic Arts Inc.*, No. 1:15-cv-00036 (N.D.

¹ See 37 C.F.R. § 42.107(e) (“No *inter partes* review will be instituted based on disclaimed claims”).

Utah), filed February 24, 2015. Pet. 5. A divisional of the '350 patent, U.S. Patent No. 8,540,575, is the subject of IPR2016-00634. Paper 33.

B. The '350 Patent

The '350 patent describes a system and method for updating the parameters of a sports video game. Ex. 1001, 2:20–30. For example, an updated parameter may include real-life performance statistics of a particular character or athlete in the video game. *Id.* at 3:2–5, 3:17–23, 3:65–4:15, 5:29–34, 6:20–23. And, with respect to the particular claims at issue here, an updated parameter may include real-life changes to a real-life stadium or field depicted in the video game, such as the color of the ivy-covered walls at Wrigley Field or the pattern of the outfield grass at Fenway Park. *Id.* at 4:49–67. As described, the updated parameters are recorded onto a server, and a user of the video game may connect to the server to download the updated parameters. *Id.* at 2:20–30. When downloaded, the updated parameters are stored on the video game unit and have the ability to change various attributes of the game to allow for a more realistic game experience. *Id.* at 2:28–30, 4:13–15. The system architecture and method for downloading the updated parameters to the video game unit are the same regardless of the type of parameter. *Id.* at 5:50–6:23, 7:48–8:6.

C. The Challenged Claims

Due to White Knuckle's statutory disclaimer, only claims 1–10, 12–16, and 23 of the originally challenged claims remain in this case. Of those, two are independent—claims 1 and 23. Claim 1 is directed to a “game medium” configured to update the parameters of a sports video game, as played in a video game machine, from a network server, and claim 23 is

directed to a method for doing the same. The other claims stem, directly or indirectly, from claim 1.

Central to the challenged claims is that the video game includes, as one of its parameters, “a real-life attribute of a real-life sports stadium or field” capable of being “updated” with “a real-life change” that may occur, for example, over the course of a season. Claim 1 is illustrative:

1. A game medium including read only memory (ROM) or random access memory (RAM) configured to provide a sports video game in conjunction with a video game machine, the sports video game including video game rules, video game character parameters, and video game stadium or field parameters, the game medium having rules and parameters stored thereon and being configured to cause the video game machine to perform a method comprising:

loading video game data stored by the game medium into memory for playing the video game, the video game data including one or more video game characters associated with corresponding real-life sports athletes, and one or more video game stadium or field parameters, the video game stadium or field parameters including a video game field or stadium attribute in the video game that corresponds to a real-life attribute of a real-life sports stadium or field;

receiving an updated video game stadium or field parameter from a data server via the network including the Internet, wherein the updated video game stadium or field parameter includes data that corresponds to a real-life change in the real-life sports stadium or field attribute;

changing a stadium or field parameter in the video game based on the updated video game stadium or field parameter received such that the video game stadium or field attribute more closely represents the changed real-life stadium or field attribute; and

enabling a user to control the one or more video game characters using a video game controller connected to the video game machine.

Ex. 1001, 8:20–50 (emphases added).

D. The Instituted Grounds

EA asserts three grounds of unpatentability for the claims under challenge (Pet. 19):

(1) claims 1–5, 7–9, 12, 14–16, and 23 would have been obvious over FIFA 2001 News,² FIFA MRA Support,³ FIFA 2001 Manual,⁴ and FIFA 2001 Guide⁵ (collectively, “the FIFA 2001 References”);

(2) claims 1, 2, 8, 10, 13, 16, and 23 would have been obvious over Pisanich,⁶ Madden 2000 Manual,⁷ and Madden 2000 Card⁸; and

(3) claims 6 and 15 would have been obvious over Pisanich, Madden 2000 Manual, Madden 2000 Card, Madden 2000 Updates,⁹ and Madden Playoff Update.¹⁰

² *FIFA 2001 Online—News Archive for September 2000, October 2000, November 2000, December 2000, January 2001, February 2001, March 2001, April 2001, May 2001, June 2001*, archived on June 17, 2001, Apr. 25, 2001, and July 26, 2001 (“FIFA 2001 News”) (Exs. 1007, 1008, 1009).

³ *FIFA-MRA, Support System—Installation, Loading Files (Games, Patches & Favorites), Launching the MRA, and Skins*, archived on Mar. 3, 2001, Apr. 22, 2001, and Apr. 23, 2001 (“FIFA MRA Support”) (Exs. 1012, 1013, 1014).

⁴ Electronic Arts, Inc., *EA Sports FIFA 2001 Major League Soccer™ Manual* (2000) (“FIFA 2001 Manual”) (Ex. 1011).

⁵ Electronic Arts, Inc., *FIFA 2001 Major League Soccer™ Install Guide* (2000) (“FIFA 2001 Guide”) (Ex. 1026).

⁶ PCT Int’l Pub. No. WO 02/062436 A2, pub. Aug. 15, 2002 (Ex. 1006).

⁷ Electronic Arts, Inc., *EA Sports Madden NFL™ 2000 Reference Manual* (1999) (“Madden 2000 Manual”) (Ex. 1018).

⁸ Electronic Arts, Inc., *EA Sports Madden NFL™ 2000 Reference Card* (1999) (“Madden 2000 Card”) (Ex. 1017).

In a preliminary proceeding, we instituted trial because EA demonstrated a “reasonable likelihood” of succeeding on those three grounds. Dec. 7–14. We now decide whether EA has proven the challenged claims unpatentable by a “preponderance of the evidence.” 35 U.S.C. § 316. In doing so, we also decide whether Pisanich qualifies as prior art to the ’350 patent.

III. ANALYSIS

A. *Claim Construction*

The only term EA proposes for our construction—“performance parameter”—is found in claim 21, a claim on which we declined to institute for lack of clarity and definiteness. Dec. Inst. 5–7. That term aside, neither party raises any additional term in need of construction. Nor do we perceive any term in need of an express construction for purposes of this decision.

B. *Claims 1–5, 7–9, 12, 14–16, and 23—Obviousness Over the FIFA 2001 References*

In challenging claims 1–5, 7–9, 12, 14–16, and 23, EA Sports relies on a number of publications describing the soccer video game, “FIFA 2001,” which are referred to collectively as the “FIFA 2001 References.” Pet. 21–48. To begin, EA points to FIFA 2001 News, which is a collection of webpages from the website, www.fifa2001.com, describing various “updates” for download by users of the FIFA 2001 game in the 2000/2001 timeframe. *See* Pet. 19–20 (citing Exs. 1007–1009). In addition, EA relies on FIFA MRA Support, which is a collection of webpages from the website,

⁹ Electronic Arts, Inc., *EASports.com Madden 2000 Downloads*, archived on March 2, 2000 (“Madden 2000 Updates”) (Ex. 1015).

¹⁰ Electronic Arts, Inc., *EA Sports Madden NFL^(TM) 2000 Roster Update–Playoff Week 1* (01/07/00) (“Madden Playoff Update”) (Ex. 1016).

www.fifa-mra.com, describing various “patches” available for the FIFA 2001 game in the relevant time frame. *Id.* (citing Exs. 1012–1014). EA also points to FIFA 2001 Manual and FIFA 2001 Guide for their teachings of various hardware and software requirements of the FIFA 2001 game. *Id.* (citing Exs. 1011, 1026). As far as publication of the FIFA 2001 References, EA presents several affidavits attesting to their availability before the critical date. *See* Exs. 1010, 1027, 1029 ¶¶ 5–6, 1030 ¶¶ 4–18.

More specifically, in its Petition, EA specifies where the FIFA 2001 References collectively teach the capability of accessing and downloading updates for the FIFA 2001 game to a video game machine for changing various parameters and attributes of real-life stadiums depicted in the game, as required by the claims under challenge. Pet. 29–38. EA also relies on the Declaration of David P. Crane as support for what a skilled artisan would have understood the FIFA 2001 References to teach and why a skilled artisan would have combined their teachings to arrive at the claimed invention. Ex. 1003 ¶¶ 117–171. After careful consideration, we are persuaded, by a preponderance of the evidence, that claims 1–5, 7–9, 12, 14–16, and 23 are unpatentable over the FIFA 2001 References.¹¹

Notably, FIFA 2001 News and FIFA MRA Support disclose numerous “updates” to the original parameters of the FIFA 2001 video game, many of which reflect changes to various attributes of real-life FIFA-

¹¹ We reject White Knuckle’s argument that EA “fails to precisely specify where each element of the claims is found in” the FIFA 2001 References. PO Resp. 21. The Petition clearly illustrates otherwise. *See* Pet. 29–38 (mapping specific claim elements to prior art descriptions and screenshots). And, contrary to White Knuckle’s suggestion, there is no prohibition against referencing earlier portions of a claim chart to avoid redundancy, particularly where limitations are similar in scope.

league stadiums. Exs. 1007, 1008; *see also* Ex. 1003 ¶¶ 89–106. For example, according to FIFA 2001 News, game players can access a “Downloads Section” online, and retrieve updates that include screenshots of real-life advertising boards, flags, and turfs found in FIFA-league stadiums. Ex. 1008, 4 (disclosing update for Nou Camp stadium of “turf” and “Snow” conditions), 20–21 (disclosing updates of “Regular and Champions League adboards” and “Ajax adboards”); *see also* Ex. 1007, 19–20 (“We have yet another huge update of patches and add-ons in the Downloads section” including “Sene A ad boards” and “Napoli flags”), 23–24 (“Biggest Downloads Update Ever! . . . This includes over 25 new kits plus a host of other quality new updates and add-ons for FIFA 2001” including “Ajax flags, Feyencord flags (screen shot), Champions league graphics and a turf”), 60 (“New Downloads” including “Wembley . . . and Stade de France . . . grass turfs” and “Premiership Ad Boards”). FIFA 2001 News identifies specific dates for these updates, all of which occur after the November 8, 2000 release date of the FIFA 2001 game but before the critical date of the patent at issue.

In addition to updates available through the “Downloads” database, FIFA 2001 News discloses that users may also retrieve updates through a “Patches Database,” which includes a collection of “super patches” for “updating your favourite FIFA games,” including “FIFA 2001.” Ex. 1008, 17. For example, there is disclosed a “Greek Super Patch” for updating “Stadium flags for all the Greek teams,” “Greek ad boards,” and “Riot Police around the stadium.” *Id.* Another super patch includes updates for “new Italian adboards” and “2 new stadia.” *Id.* at 20. And, with respect to a “Manchester United Mega Patch,” FIFA 2001 News discloses updates for

“current Manchester United adboards,” “correct turfs for Old Trafford,” and “realistic home and away kits.” Ex. 1007, 97; *see also* Ex. 1012, 7 (disclosing a directory of “favorite patches” for updating “Turfs” and “Stadiums”).

EA’s declarant, Mr. Crane, attests to the FIFA 2001 References teaching updates to the stadium parameters of the FIFA 2001 game, and their availability on the “EA server” for downloading, via the internet, to a video game machine, such as a personal computer (“PC”). Ex. 1003 ¶¶ 92–93, 96–98, 100 (quoting Ex. 1007, 37). According to Mr. Crane, FIFA 2001 News teaches the architecture for updating FIFA 2001 game by disclosing that a video game user would link to a “Downloads section” or “Patches Database” on the FIFA 2001 website to retrieve the updated parameter. Ex. 1003 ¶¶ 100, 101 (quoting Ex. 1007, 31–32; Ex. 1008, 17); *see also* Exs. 1007, 6, 8, 17, 23, 38, 39, Ex. 1008, 4, 11, 12. Once downloaded, the updated parameter would “automatically install itself . . . in the FIFA 2001 directory” on the PC for updating various attributes of the FIFA 2001 game to reflect real-life changes to the stadium depicted in the game. Ex. 1003 ¶ 100 (quoting Ex. 1007, 37). We give considerable weight to Mr. Crane’s testimony, as it coincides with the disclosures of the FIFA 2001 References.

White Knuckle argues that the updates taught by the FIFA 2001 References are directed to “fixing ‘bugs’ or changing non-real features” of the game’s software, not updating the game’s parameters to reflect real-life changes in an actual stadium or field. PO Resp. 11–13. We disagree for two reasons. First, White Knuckle provides only attorney argument, without any evidentiary support, for its assertion that the “updates” in the FIFA 2001 References relate *solely* to software bugs or non-real features. *See* PO Resp.

12–13. Moreover, while we agree that some of the updates may relate to “bug fixes” (*see, e.g.*, Ex. 1007, 37), other updates relate expressly to changing the game’s parameters based on real-life changes to a team’s actual stadium or field. Indeed, FIFA 2001 News contemplates expressly that “FIFA 2001 will have . . . a number of *realistic licensed stadiums* to choose from, awesome realistic crowd chants plus much more.” Ex. 1007, 16 (Oct. 6, 2000) (emphasis added).

Confirming that realism, FIFA 2001 News notes the availability of a number of patches for updating the game’s realistic stadiums, including, for example, a “Fifa On Line Super Patch” featuring “*new Italian adboards*” and “*2 new stadia*,” and a “World Leagues Superpatch” that “help[s] enhance [the] gaming experience by *updating* many league kits, *graphic changes*, *new stadiums*.” Ex. 1008, 20–21 (Dec. 6, 2000) (emphases added). FIFA 2001 News even describes a “Mexican League Patch” that will include “real life replicas [of] stadiums.” *Id.* at 12 (Dec. 16, 2000). We find those disclosures as indicative of, not fixing bugs in the game, but rather changing the visual graphics of the game to reflect the most up-to-date attributes of real-life stadiums.

White Knuckle also argues that EA failed to provide a rationale for combining the FIFA 2001 References. PO Resp. 14. That is not the case. As explained in the Petition, the FIFA 2001 References are all directed to solving the same problem, namely, providing the most realistic gaming experience through the availability of updates to various parameters of the video game, including updates that reflect changes to the real-life stadiums and fields depicted in the game. *See* Pet. 28–29. A skilled artisan would have realized the benefit of combining the FIFA 2001 References from the

references themselves, as they describe features of the same video game system, FIFA 2001, and illustrate contemporaneously how actual users were playing the game. Ex. 1003 ¶ 118. Indeed, FIFA 2001 News cross-references FIFA MRA Support extensively, even providing direct links to relevant pages of the MRA website.¹² Ex. 1008, 1, 4, 6 (“MRA Patches Database,” “the MRA site”); Ex. 1009, 1, 3 (same).

Finally, White Knuckle faults EA’s proffer of the FIFA 2001 References as “improperly relying on the video game itself,” as opposed to “printed publications” required by 35 U.S.C. § 311(b). PO Resp. 25–27. We disagree. The Petition clearly shows that EA relies on *webpage descriptions* of the FIFA video game, which were published online and captured by Internet Archive, a popular digital library of website records, prior to the critical date. *See* Pet. 19–20, 23–38 (quoting passages and displaying screenshots from Exs. 1007–1009, 1012–1014, 1026). The captured webpages were then retrieved by the Internet Archive’s Wayback Machine and properly authenticated by knowledgeable witnesses. Exs. 1010, 1027, 1029, 1030; *see also U.S. v. Bansal*, 663 F.3d 634, 667–68 (3rd Cir. 2011) (addressing authentication needed for Wayback Machine documents). Documentary evidence generated by the Wayback Machine generally has been accepted as prior art in patent cases. *See, e.g., Keystone Retaining Wall Sys., Inc. v. Basalite Concrete Prods., LLC*, 2011 WL

¹² White Knuckle also attempts to distinguish the claimed invention by arguing that it provides “natural randomness” of a game’s parameter, whereas the FIFA 2001 References purportedly do not. PO Resp. 1, 9, 15–16. We reject this argument for the simple reason that the claims do not require such a feature, and, thus, White Knuckle improperly imports a limitation into the claims.

6436210, at *9 n.9 (D. Minn. 2011); *Cave Consulting Group, LLC v. OptumInsight, Inc.*, 2015 WL 740379, at *9 (N.D. Cal. 2015). As such, White Knuckle’s arguments are unavailing. We find that each of the FIFA 2001 References properly qualifies as a printed publication.

For the reasons discussed above, we are persuaded that the combination of FIFA 2001 News and FIFA 2001 MRA Support teaches a sports video game with the capability of updating the game’s stadium and field parameters to correspond to real-life changes in the real-life soccer stadium or field depicted in the game, as required by independent claims 1 and 23. *See* Ex. 1003 ¶¶ 124–128.

We are also persuaded that the FIFA 2001 References teach other aspects of the claimed invention. For example, with respect to the “video game controller” recited by claims 1, 8, and 23, both FIFA 2001 News and FIFA 2001 Manual describe various types of game controllers from which the user can manipulate the game characters and choose several options for the game, such as receiving updated parameters. Ex. 1011, 2, 4, 12–14 (describing input devices such as keyboard, mouse, Microsoft Sidewinder™, and Gravis Gamepad™ Pro); Ex. 1007, 37 (“click on Start . . . Check For Update”). The controller is capable of being “automatically connected to the EA server” to download the updated parameters, which are “automatically install[ed] . . . in the FIFA 2001 directory” on the PC. Ex. 1007, 37; *see also* Ex. 1003 ¶¶ 100, 110, 112, 129 (attesting to the game controller). Based on this evidence, we are persuaded that a skilled artisan would have been led to combine the teachings of FIFA 2001 News and FIFA MRA Support, with the game controller taught by FIFA 2001 Manual, because the references speak to the same video game—FIFA 2001—and illustrate,

contemporaneously, the steps and actions of users who were actually playing the game. Ex. 1003 ¶¶ 117, 118.

Insofar as the type of storage medium recited in claims 1 and 16, FIFA 2001 Guide describes that the FIFA 2001 game is stored on a CD-ROM, which, in turn, is installed in the PC and includes various files that are loaded into memory for executing and playing the game on the PC.

Ex. 1026, 1, 4–7, 14, 16; Ex. 1003 ¶ 119. In our view, storing a sports video game on a CD-ROM was well-known in the relevant time frame, as taught by FIFA 2001 Guide, and such a game medium would have been an obvious and predictable choice for loading and executing the video soccer game described in FIFA 2001 News in the memory of a PC. *See* Ex. 1003 ¶¶ 120–123. Also, with respect to claim 5’s recitation that the stadium feature being updated is “ivy,” we are persuaded by EA Sports’ assertion that the selection of ivy or other greenery would have been an obvious design choice from a finite number of plantings suitable for a sports venue. *See id.* ¶¶ 97, 146.

In sum, while we have yet to consider White Knuckle’s evidence of secondary considerations, we find initially that the evidence weighs in favor of determining that claims 1–5, 7–9, 12, 14–16, and 23 would have been obvious over the FIFA 2001 References.

C. Claims 1, 2, 6, 8, 10, 13, 15, 16, and 23—Obviousness Over Pisanich and the Madden References

EA challenges claims 1, 2, 6, 8, 10, 13, 15, 16, and 23 as obvious over Pisanich and a number of references directed to the acclaimed video game, *Madden NFL™ 2000*, which includes Madden 2000 Manual, Madden 2000 Card, Madden 2000 Updates, and Madden Playoff Update (collectively, “the Madden References”). Pet. 42, 56. In its Petition, EA specifies where each

element of the challenged claims is taught or suggested by Pisanich and the Madden references. *Id.* at 48–55, 60. EA also proffers the declaration of Mr. Crane to explain why a skilled artisan would have combined Pisanich with the Madden References to arrive at the claimed invention. Ex. 1003 ¶¶ 197–225, 263–266.

In response, White Knuckle disputes only whether Pisanich is prior art to the challenged claims. PO Resp. 3–8. White Knuckle contends Pisanich is not prior art because the claimed invention was conceived by the inventor before the effective date of Pisanich and diligently reduced to practice within the relevant time frame. *Id.* at 3. As evidence of prior conception, White Knuckle proffers the Declaration of Athanasios Angelopoulos, the inventor listed on the '350 patent. *Id.* at 5 (citing Ex. 2009). In recounting his conception, Mr. Angelopoulos testifies that “[p]rior to August 14, 2002,” he invited a co-worker, Mr. David Huffaker, to his residence and described to him the idea of updating a sports video game. Ex. 2009 ¶¶ 5(a), 5(b). According to Mr. Angelopoulos, his description included the “updated video game parameter” feature, including the specific embodiment “in which a stadium attribute, ivy on the home run wall of Wrigley Field, changes color depending on the yearly season.” *Id.* ¶ 5(b)(ii). Mr. Angelopoulos testifies that, around the same time, he also conceived the specific embodiment of “a stadium parameter in which a video game shows the number 9 in grass of Fenway Park,” although his declaration is silent as to whether he discussed that particular embodiment with anyone at the time. *Id.* ¶ 5(c).

“[A]n inventor’s testimony, standing alone, is insufficient to prove conception—some form of corroboration must be shown.” *Price v. Symsek*, 988 F.2d 1187, 1194–95 (Fed. Cir. 1993) (citation omitted). “An evaluation

of *all* pertinent evidence must be made so that a sound determination of the credibility of the inventor's story may be reached." *Id.* at 1195 (citation omitted). Here, to corroborate Mr. Angelopoulos's testimony, White Knuckle introduces the declaration of the co-worker, Mr. Huffaker, with whom Mr. Angelopoulos met and first described his invention. Ex. 2010. Mr. Huffaker testifies that he was a licensed attorney engaged by Mr. Angelopoulos to assist him in reducing the invention to practice and drafting the application for the '350 patent. *Id.* ¶¶ 4(a), 5(a). Accompanying the declarations of Mr. Huffaker and Mr. Angelopoulos is a series of exhibits, consisting of emails and attachments sent around the time of their meeting, which White Knuckle submits as additional evidence of corroboration, namely Exhibits 2004, 2006, 2007, and 2008.¹³

We address first the exhibits described in the declarations as evincing prior conception. The exhibits consist of three emails from Mr. Angelopoulos to Mr. Huffaker, dated July 19, 2002, July 23, 2002, and July 28, 2002, each forwarding an attachment along the lines of a flow chart, a block diagram, and draft claims, respectively. *See* Exs. 2004, 2006, 2007. Mr. Angelopoulos testifies that the exhibits "show features of the Subject '350 Claims conceived by me." Ex. 2009 ¶¶ 5(d), 5(e), 5(f). Similarly, Mr. Huffaker testifies that the exhibits "show features of the Subject '350 Claims conceived by Mr. Angelopoulos." Ex. 2010 ¶¶ 4(d), 4(e), 4(f). Although each of the exhibits contemplates broadly an "update" to a video game, not a

¹³ To the extent White Knuckle relies on Exhibit 2005, a Wikipedia page, as evidence of prior conception, we find it probative of little, if anything. *See* PO Resp. 5. At best, it shows the date that Ted Williams's number was inscribed in the outfield of Fenway Park. Ex. 2005, 19. It does not indicate Mr. Angelopoulos's knowledge at the time.

single one of them describes the update in terms of a “stadium or field parameter,” as required by the challenged claims. *See* Ex. 2004, 2–4, Ex. 2006, 2, Ex. 2007, 2–4. It follows then, from the face of this evidence, that Mr. Angelopoulos did not yet possess the feature of updating a *stadium or field parameter* of a sports video game. Yet, that very feature is what led to allowance of the claims in the first instance. *See* Ex. 1002, 185–186, 202–211, 299–300 (inventor emphasizing that updating “stadium or field” parameter distinguishes over prior art); *see also id.* at 309, 314–315 (Board determining that prior art “lacks a teaching of updating a stadium or a field parameter”). Because the emails and attachments proffered by White Knuckle do not disclose the claimed feature of updating a stadium or field parameter, we find that White Knuckle has failed to demonstrate adequately that the inventor, Mr. Angelopoulos, had possession of the claimed invention early enough to eliminate Pisanich.

The only evidence that arguably corroborates Mr. Angelopoulos’s recollection of conceiving the update to a stadium or field parameter is the testimony of Mr. Huffaker. To that end, Mr. Huffaker recounts that, sometime “[p]rior to August 14, 2002,” Mr. Angelopoulos described to him specific embodiments in which an updated parameter causes a video game to change the grass in Fenway Park or the ivy in Wrigley Field. Ex. 2010 ¶¶ 4(b)(ii), 4(c). But, in so testifying, Mr. Huffaker simply repeats, almost verbatim, the words of Mr. Angelopoulos’s declaration. *Compare* Ex. 2010 ¶ 4 (Huffaker Decl.) *with* Ex. 2009 ¶ 5 (Angelopoulos Decl.). Moreover, we find it difficult to ignore Mr. Huffaker’s failure to produce any contemporaneous records of his discussions with Mr. Angelopoulos about the Fenway Park and Wrigley Field embodiments, despite acting as Mr.

Angelopoulos's patent counsel to provide "assistance in reducing his invention to practice." Ex. 2010 ¶¶ 4(a), 5. In the absence of such records, particularly given the professional training and incentives to document an inventor's work, we find that Mr. Huffaker's cursory testimony lacks sufficient corroboration of Mr. Angelopoulos's conception of the claimed invention before the effective date of Pisanich, i.e., August 14, 2002. Thus, Pisanich is prior art to the challenged claims.

Aside from the prior art status of Pisanich that we discuss above, and the effect of certain secondary considerations that we discuss below, White Knuckle does not further contest EA's proof of obviousness, in particular, rebutting neither that all of the claim elements are found in Pisanich and the Madden references, nor that a skilled artisan would have had reason to combine them to come up with the claimed invention. *See* PO Resp. 1, 3–8. As such, any potential arguments by White Knuckle in that regard are waived. *See* Paper 12, 3 (warning patent owner that "any arguments for patentability not raised and fully briefed in the response will be deemed waived."). Indeed, during oral argument, White Knuckle's counsel expressly conceded that Pisanich teaches the critical feature of the claimed invention. Tr. 61:3–23 (acknowledging that "the essential, the critical feature of [the claims] showing updates that correspond to a real-life change in something, . . . I would concede that that element is taught, that critical element is taught in Pisanich."). And, under further questioning, White Knuckle's counsel clarified that only "secondary considerations" stood in the way of "whether other aspects of the claimed invention are taught by the combination [of Pisanich and the Madden References]." *Id.* at 62:4–22.

We need not further address the grounds relying on Pisanich and the Madden references, aside from addressing secondary considerations, as a dispute no longer exists about the force of EA’s proof of obviousness, particularly in view of White Knuckle’s concessions. *See In re Nuvasive, Inc.*, 842 F.3d 1376, 1380–81 (Fed. Cir. 2016) (holding that Board need not address the issue of public accessibility in its final decision where patent owner explicitly confirmed that it “no longer contested” the issue); *see also In re Watts*, 354 F.3d 1362, 1367–68 (Fed. Cir. 2004) (holding that patent owner’s failure “to argue his current interpretation of the prior art below” prevented “the Board’s informed judgment on this issue”). Thus, before assessing secondary considerations, we find, at least initially, that EA’s evidence, coupled with White Knuckle’s concessions, weigh in favor of determining that claims 1, 2, 6, 8, 10, 13, 15, 16, and 23 would have been obvious over Pisanich and the Madden references.¹⁴

D. Secondary Considerations

We now turn to the issue of whether White Knuckle’s evidence of secondary considerations undermines our initial findings of obviousness.¹⁵

¹⁴ We are mindful of the caution against improper burden shifting pronounced in *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364 (Fed. Cir. 2016), in which the Board was reversed for placing the burden on patent owner to explain why petitioner’s rationale from an *uninstituted* ground was not applicable to the instituted ground at issue. *Id.* at 1377–78. The difference here is that the patent owner, White Knuckle, was given a full and fair opportunity to respond to the grounds *as instituted*, yet chose willingly and expressly to concede the propriety of EA’s evidence of obviousness.

¹⁵ In its response, White Knuckle only argues secondary considerations in regard to EA’s challenge based on the FIFA 2001 References. PO Resp. 12, 17. However, we consider them as applying also to the challenge based on

In that regard, White Knuckle introduces evidence of “credible praise and commercial success” of an online video game released by EA under the name, “NCAA Football 2008,” that purportedly embodies the claimed invention. PO Resp. 17, 19 (discussing Ex. 2012). For two reasons, we find that White Knuckle’s evidence is entitled to little weight, and, thus, fails to outweigh the evidence and concessions of obviousness discussed above.

First, with respect to commercial success, White Knuckle relies on an internet article by “Inside Sports Geeks” that purports to list the quantity of NCAA Football 2008 games sold over a three-week period. PO Resp. 19 (discussing Ex. 2015). The issue of admissibility aside, the article reflects solely the total number of units sold in the first three-weeks of the video game’s release. Ex. 2015, 1. Although the article charts the quantity of units sold by EA against the quantity of a presumably similar video game sold by a competitor, no further information is provided—there is no indication of dollar amounts, annual sales figures, market share, or growth in market share. *See id.* Evidence relating solely to the quantity of units sold over a short period of time provides a very weak showing of commercial success. *In re Huang*, 100 F.3d 135, 140 (Fed. Cir. 1996). More probative is whether the sales are substantial in terms of the relevant market. *Id.* But White Knuckle offers no such proof. *See* PO Resp. 19. Because White Knuckle’s evidence of commercial success is more weak than probative of anything, we assign it little weight.

Second, in its assertions of commercial success and industry praise, White Knuckle relies on an MIT Review Journal article as providing the

Pisanich and the Madden References, given remarks to that effect by White Knuckle’s counsel during oral argument. *See* Tr. 62:4–22.

requisite nexus between the alleged success and praise of the NCAA Football 2008 video game and the critical feature of the claimed invention. PO Resp. 17–19. Specifically, White Knuckle points to the MIT article’s praise of a “live weather” feed that brings a “level of realism” to the NCAA Football 2008 game, including snow on the field, and affects how the game is played. Ex. 2012, 1–2. According to White Knuckle, that live weather feature shows that EA’s NCAA Football 2008 video game embodies the “updated stadium or field parameter” of the claimed invention. PO Resp. 11–19.

Although there is a presumption of nexus when the patent owner shows the asserted praise or success is tied to a specific product embodying the claimed invention, that presumption is rebuttable when the patent challenger “respond[s] by presenting evidence that shows the proffered objective evidence was due to extraneous factors other than the patented invention.” *WBIP, LLC v. Kohler Co.*, 829 F.3d 1317, 1329–1330 (Fed. Cir. 2016) (internal quotes and citation omitted). Here, EA responds with evidence from the MIT article itself, which touts the NCAA Football 2008 game’s success as due in part to “many other new features,” including “new trick plays, a highlight reel, and advanced animations,” as well as the fact that “[t]he game is playing far smoother than it [was] a year ago.” Reply 20 (citing Ex. 2012, 2). White Knuckle offers no rebuttal to EA’s evidence that the MIT article ascribes the game’s success to these extraneous features. Thus, EA succeeds in rebutting the presumption of nexus. *See Ormco Corp. v. Align Tech., Inc.*, 463 F.3d 1299, 1312–13 (Fed. Cir. 2006) (evidence that success was due to “unclaimed or non-novel features” of product “clearly rebuts the presumption that [product’s] success was due to the claimed and

novel features”). In the absence of any further proof, White Knuckle falls short of tying the success of NCAA Football 2008 to the claimed invention. As such, we attribute little, if any, weight to White Knuckle’s evidence of commercial success and industry praise.

Furthermore, even assuming the success and praise of NCAA Football 2008 was attributable to the live-weather update feature, the evidence shows that live-weather feeds for video games already existed in the prior art, as reflected in Pisanich. Evidence of industry praise attributable to a feature already known in the prior art is not a persuasive secondary consideration. *South Alabama Med. Sci. Found. v. Gnosis S.P.A.*, 808 F.3d 823, 826–27 (Fed. Cir. 2015). Here, Pisanich (which is prior art, as determined above) illustrates that a live-weather feed for a sports video game was well-known. Ex. 1006¹⁶; *see also* Ex. 1003 ¶¶ 179–183. As such, White Knuckle’s evidence of success and praise, insofar as it concerns live-weather feeds for video games, must fail because it is “focused on conventional features in the prior art.” *ClassCo, Inc. v. Apple, Inc.*, 838 F.3d 1214, 1220 (Fed. Cir. 2016).

In the end, upon weighing all the evidence, we conclude that White Knuckle’s relatively weak evidence of commercial success and industry praise fails to undermine our initial findings of obviousness with respect to the ground based on the FIFA 2001 References, as well as the grounds based on Pisanich and the Madden References.

¹⁶ Specifically, Pisanich discloses a video “football” game that incorporates “real world data” into the game “to effect the ongoing gaming experience of a player.” Ex. 1006, 4:16–6:10, Figs. 1, 2. The data includes “weather conditions” stored “in real time” on a “game data server” for downloading to a player’s game unit. *Id.* at 7:1–9:16

E. EA's Motion to Exclude

EA seeks to exclude Exhibits 2005 and 2011–2015 and portions of Exhibits 2009 and 2010. Paper 27 (“Petr. Mot.”), Paper 34 (“Petr. Reply”). White Knuckle proffers these exhibits as evidence of prior invention and secondary considerations. PO Resp. 3–8, 17–19. EA argues, in turn, that Exhibits 2005 and 2011–2015 are inadmissible hearsay (Petr. Reply 1–3) and that Exhibits 2009 and 2010 are improper opinion testimony and lack proper foundation (Mot. 5–11).

Although EA’s arguments have some merit, we need not consider them further because, even accounting for White Knuckle’s evidence, we have determined that Pisanich is prior art to the claimed invention and that secondary considerations fail to overcome EA’s proof of obviousness. Accordingly, EA’s motion to exclude is *dismissed* as moot.

IV. CONCLUSION

After considering the totality of the evidence, including White Knuckle’s evidence of secondary considerations, we conclude that EA has demonstrated, by a preponderance of the evidence, that the challenged claims are unpatentable under 35 U.S.C. § 103, in particular, that claims 1–5, 7–9, 12, 14–16, and 23 would have been obvious over the FIFA 2001 References and that claims 1, 2, 6, 8, 10, 13, 15, 16, and 23 would have been obvious over Pisanich and the Madden References.

V. ORDER

Accordingly, it is hereby:

ORDERED that claims 1–10, 12–16, and 23 of the ’350 patent are held *unpatentable*;

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FURTHER ORDERED that Petitioner's Motion to Exclude is
dismissed; and

FURTHER ORDERED that any party seeking judicial review of this
Final Written Decision must comply with the notice and service
requirements of 37 C.F.R. § 90.2.

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