

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DRAFTKINGS INC., A DELAWARE CORPORATION,
Petitioner,

v.

AG 18, LLC,
Patent Owner.

IPR2022-01442
Patent 10,497,220 B2

Before JOSIAH C. COCKS, GEORGE R. HOSKINS, and
FRANCES L. IPPOLITO, *Administrative Patent Judges*.

COCKS, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

Petitioner, DraftKings, Inc., A Delaware corporation, filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 1–30 (“the challenged claims”) of U.S. Patent No. 10,497,220 B2 (Ex. 1001, “the ’220 patent”). Patent Owner, AG 18, LLC d/b/a/ Arrow Gaming (*see* Paper 3, 1), filed a Preliminary Response (Paper 11, “Prelim. Resp.”). We have authority under 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted unless the information presented in the Petition shows that “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a); *see also* 37 C.F.R. § 42.4(a) (“The Board institutes the trial on behalf of the Director.”).

A decision to institute under § 314 may not institute on fewer than all claims challenged in the petition. *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018). In addition, if the Board institutes trial, it will “institute on all grounds in the petition.” PTAB Consolidated Trial Practice Guide, 5–6 (Nov. 2019); 37 C.F.R. § 42.108(a); *see also PGS Geophysical AS v. Iancu*, 891 F.3d 1354, 1360 (Fed. Cir. 2018) (interpreting the statute to require “a simple yes-or-no institution choice respecting a petition, embracing all challenges included in the petition”).

Having considered the arguments and evidence presented in the Petition, for the reasons described below, we institute an *inter partes* review.

A. Real Parties-In-Interest

Petitioner identifies itself, DraftKings Inc., a Nevada corporation, and Crown Gaming Inc., as real parties-in-interest. Pet. 4.¹ Patent Owner identifies itself as the only real party-in-interest. Paper 3, 1.

B. Related Matters

The parties state that the '220 patent is the subject of *AG 18, LLC v. DraftKings, Inc.*, Case No. 2-21-cv-15737 (D.N.J.). Pet. 4; Paper 3, 1.

C. The '220 Patent

The '220 patent is titled “Location Based Restrictions On Networked Gaming.” Ex. 1001, code (54). The Abstract of the '220 patent is reproduced below:

A system and method for peer-to-peer gaming is described. One embodiment includes a system for peer-to-peer gaming, the system comprising an at least one gaming client, wherein the at least one gaming client is configured to accept a selection of an at least one gaming option from a player, and allow the player to play a game based on the selection of the at least one gaming option; an administration server, wherein the administration server is configured to receive the selection of the at least one gaming option from the at least one gaming client, and initiate the game for the player based on the selection of the at least one gaming option; and an at least one gaming server, wherein the at least one gaming sever is configured to run the game and transmit data about the game to the administration server.

Id. at code (57).

¹ Petitioner states that it and Crown Gaming Inc. are wholly-owned subsidiaries of Draft Kings Inc., a Nevada corporation. Pet. 4.

Figure 1 of the '220 patent is reproduced below:

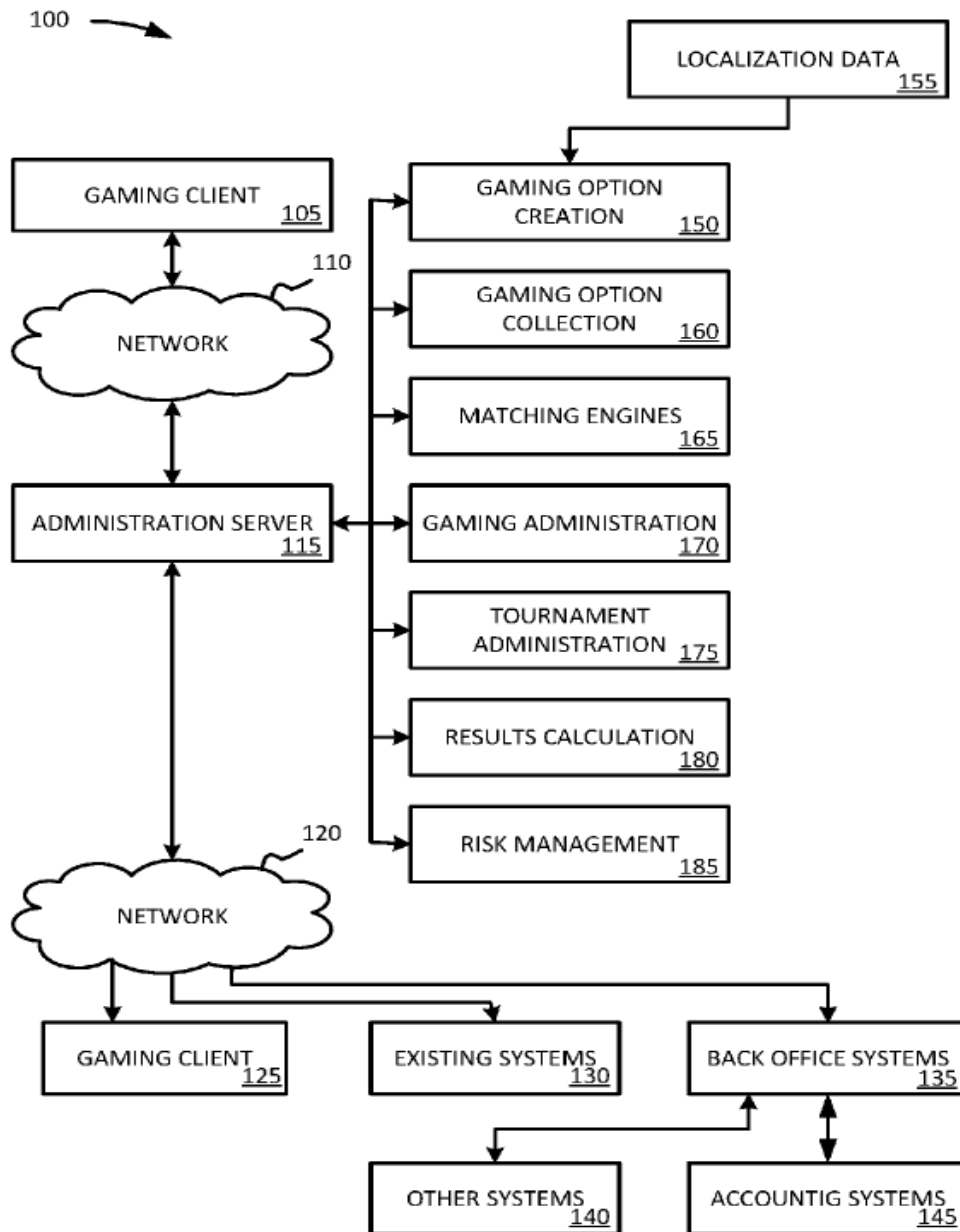


FIG. 1

Figure 1 above “illustrates a high level network architecture of some embodiments of a system for peer-to-peer gaming.” *Id.* at 3:12–13.

Administration server 115 can include or be communicably coupled to various “modules” for performing functions of the gaming system, such as

gaming option creating module 150, gaming option collection module 160, matching engine module 165, game administration module 170, tournament administration module 175, results calculation module 180, and risk management module 185. *Id.* at 7:41–46. “Gaming option creation module 150 can take information from localization data module 155 to determine which games are available on administration server 115.” *Id.* at 7:46–49.

Each of these modules can be embodied as special-purpose hardware (e.g., one or more ASICs, PLDs, FPGAs, or the like), or as programmable circuitry (e.g., one or more microprocessors, microcontrollers, or the like) appropriately programmed with software and/or firmware, or as a combination of special purpose hardware and programmable circuitry.

Id. at 8:66–9:5.²

The ’220 patent also notes that “real-money wagering” is legally permitted in some “legal gaming jurisdictions,” e.g., “Nevada and Indian reservations” but that in other jurisdictions, such real-money wagering is not permitted, or is limited. *See, e.g., id.* at 7:29–31; 10:14–16; 12:65–13:7. As a result, certain game options may not be legally available to certain users, and, thus, should not be provided to such users as an available gaming option. The ’220 patent describes a purpose of its disclosure addresses such a circumstance by “us[ing] information about the location of the user, such as legal jurisdiction and casino location, to determine which game options are presented to the player.” *See, e.g., id.* at 10:14–17; 13:17–20. More specifically, the ’220 patent characterizes its system as a “flexible gaming

² The acronyms “ASCIS” and “PLDs,” stand, respectively, for “application-specific integrated circuits,” and “programmable logic devices.” Ex. 1001, 22:49–51. The acronym “FPGAs” does not appear to be defined in the ’220 patent, but we understand that it likely stands for: field programmable gate array.

platform” that can be “dynamically adjusted for localization requirements such as language, currency and legal issues.” *Id.* at 7:29–40.

D. Challenged Claims

Petitioner challenges claims 1–30 of the ’220 patent (the “Challenged Claims”). Claims 1, 8, 15, 21, and 30 are independent claims. Claim 8 is representative and is reproduced below:

8. A gaming system comprising:

[a] at least one processor;

[b] at least one communication interface; and

[c] a memory containing a plurality of program instructions configured to cause the at least one processor to:

[d] estimate a current location of a player using the gaming system;

[e] dynamically create a customized list of available games for a player at the current location of the player,

[f] wherein the customized list of available games restricts limits on wagers in those games based on the current location of the player; and

[g] wherein the limits on wagers are set to non-monetary based wagering when the current location restricts monetary gambling;

[h] present the customized list of available games to a player gaming client through the communication interface;

[i] receive, from the player gaming client through the communication interface, a selection of a game from the customized list of available games;

[j] initiate the game; and

[k] compensate the player with player winnings.

Ex. 1001, 27:9–31 (lettering [a] through [k] added for convenience of reference to the limitations of the claim).³

³ We use the same lettering designations as appears in the Petition. *See* Pet. 7–8.

E. Alleged Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
8, 9, 14–16, 19	102	Bryson ⁴
8, 9, 14–16, 19	103	Bryson “in view of the knowledge of a [person of ordinary skill in the art]” ⁵
1–3, 6, 26–30	103	Bryson, Harkham ⁶
10, 17, 20	103	Bryson, Amaitis ⁷
4, 7, 25	103	Bryson, Harkham, Amaitis
11–13, 18	103	Bryson, Schlottmann ⁸
5	103	Bryson, Harkham, Amaitis, Oberberger ⁹
21–24	103	Bryson, Frenkel, ¹⁰ Amaitis

Pet. 14. In addition to the references listed above, Petitioner relies on the Declaration of Mark C. Nicely (Ex. 1003). In challenging the above-noted grounds, Patent Owner relies on the Declaration of Dr. Stephen H. Lane (Ex. 2001).

⁴ U.S. Patent No. US 8,460,109 B2 issued June 11, 2013 (“Bryson,” Ex. 1004).

⁵ See Pet. 14.

⁶ U.S. Patent Application Publication No. US 2002/0094869 A1 published July 18, 2002 (“Harkham,” Ex. 1008).

⁷ U.S. Patent Application Publication No. US 2007/0054739 A1 published Mar. 8, 2007 (“Amaitis,” Ex. 1005).

⁸ U.S. Patent Application Publication No. US 2007/0298857 A1 published Dec. 27, 2007 (“Schlottmann,” Ex. 1006).

⁹ U.S. Patent Application Publication No. US 2009/0088253 A1 published Apr. 2, 2009 (“Oberberger,” Ex. 1009).

¹⁰ U.S. Patent Application Publication No. US 2007/0015584 A1 published Jan. 18, 2007 (“Frenkel,” Ex. 1007).

II. ANALYSIS

A. *Whether the Exercise of Discretion to Deny the Petition Under 35 U.S.C. § 325(d) is Warranted*

Patent Owner requests that we exercise our discretion to deny institution under 35 U.S.C. § 325(d). Prelim. Resp. 14–26.¹¹ In its Petition, Petitioner preemptively argued that discretionary denial under § 325(d) is not warranted. Pet. 85–90. We have discretion to deny review when “the same or substantially the same prior art or arguments previously were presented to the Office.” 35 U.S.C. § 325(d). In that respect, § 325(d) provides that the Director may elect not to institute a proceeding if the challenge to the patent is based on matters previously presented to the Office. *Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 7 (PTAB Feb. 13, 2020) (precedential) (“*Advanced Bionics*”).

In evaluating matters under § 325(d), the Board uses the following two-part framework: (1) determining whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of the first part of the framework is satisfied, determining whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims. *Id.* at 8. The

¹¹ Although on a few occasions, Patent Owner generally references 35 U.S.C. § 314 in connection with its discretionary denial arguments (*see, e.g.*, Prelim. Resp. 14, 15, 22, 25), it is apparent that that the principal thrust of Patent Owner’s request, if not the entire thrust, is grounded in Patent Owner’s belief that the Petition is based on the same or substantially the same art and arguments that previously were presented to the Office, such that discretionary denial under § 325(d) is warranted.

Board institutes trial on behalf of the Director. 37 C.F.R. § 42.4(a); *Advanced Bionics*, Paper 6 at 7 n.7.

In applying the two-part framework, we consider several non-exclusive factors, including:

(a) the similarities and material differences between the asserted art and the prior art involved during examination; (b) the cumulative nature of the asserted art and the prior art evaluated during examination; (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection; (d) the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art; (e) whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art; and (f) the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments.

Becton, Dickinson & Co. v. B. Braun Melsungen AG, IPR2017-01586, Paper 8 at 17–18 (PTAB Dec. 15, 2017) (precedential as to Section III.C.5, first paragraph) (“*Becton, Dickinson*”). If, after review of factors (a), (b), and (d), we determine that the same or substantially the same art or arguments previously were presented to the Office, then factors (c), (e), and (f) relate to whether the petitioner demonstrates that the Office erred in a manner material to the patentability of the challenged claims. *Advanced Bionics*, Paper 6 at 10.

1. *Advanced Bionics Part 1: Whether the Same Art or Arguments were Previously Presented to the Office*

The principal reference on which Petitioner bases its proposed eight grounds of unpatentability is Bryson. According to Patent Owner, Bryson’s teachings are “identical or cumulative” to those of another reference,

Miltenberger.¹² Prelim. Resp. 14. The record reflects that Miltenberger was a reference that was applied by the Examiner during prosecution in rejecting claims of the application that became the '220 patent. *See, e.g.*, Prelim. Resp. 14–15; Pet. 19; Ex. 1002, 221–226. Patent Owner makes such contentions as: (1) Bryson incorporates Miltenberger's teachings by reference; (2) Petitioner relies on the same teachings from Bryson that existed in Miltenberger; and (3) Petitioner has not demonstrated error in the Office's assessment of those alleged same teachings. Prelim. Resp. 16–25. Patent Owner thus concludes that all of the above-noted *Becton, Dickinson* factors weigh in favor of denying institution under § 325(d). *Id.* at 25–26.

Petitioner observes that during the course of prosecution of the application underlying the '220 patent, the Applicant, in challenging the Examiner's rejections based on Miltenberger, argued that the reference lacks disclosure of “‘dynamically’ creating a ‘customized list’ of player gaming options based on the current location of the player.” Pet. 19 (citing Ex. 1002, 242–243, 132). Petitioner contends that the presence of those claim limitations prompted the Examiner to allow the pertinent claims and permit the '220 patent to issue. *Id.* (citing Ex. 1002, 119–126, 120–121, 83–88). Petitioner expresses that it has relied on teachings of Bryson to account for what the Applicant argued was missing from Miltenberger. In particular, Petitioner argues the following:

Bryson expressly discloses what the Applicant said was missing from Miltenberger: that the gaming options presented to a user will “depend on device location” such that “wagering games and/or wagering game attributes may be provided according to the legal requirements,” including jurisdictional

¹² U.S. Patent Application Publication No. US 2007/0202941 A1 published Aug. 30, 2007 (“Miltenberger,” Ex. 2003).

“[w]agering limits.” Bryson—which is included in each ground in this Petition—is therefore not “substantially similar” to any art previously presented to the Office, and the Board “need not address part two of the analysis.”

Id. at 89.

Petitioner, thus, is of the view that our exercise of discretion under 35 U.S.C. § 325(d) is not warranted.

Although, as Patent Owner notes, Bryson does indicate that it incorporates by reference Miltenberger’s teachings (*see* Prelim. Resp. 16; Ex. 1004, 23:35–37), the record before us simply does not convey that it is the entirety, or even the majority, of any incorporated content that forms the basis of the Petition’s proposed grounds of unpatentability based on Bryson.¹³ We agree with Petitioner that Miltenberger seemingly does not describe content associated with the development of “player communities,” or, in connection with those communities, the presentation of only legal gaming options to a player based on device location. *See, e.g.*, Pet. 88 n.13. It is Petitioner’s view that such disclosure is distinctly present in Bryson and is offered to account for limitations of the claims that Patent Owner expressly represented were absent from Miltenberger’s disclosure. *See, e.g.*, Ex. 1002, 242–243, 132. It is clear, in our view, that Petitioner relies on content in Bryson that goes beyond Miltenberger’s teachings, and that such content is offered to present new prior art teachings and new argument that previously were not presented to the Office. That Bryson and Miltenberger may share some other content, as emphasized by Patent Owner (*see, e.g.*, Prelim. Resp. 19–21), simply does not give rise to a determination that

¹³ There is no indication in the record that Bryson previously was before the Examiner during prosecution of the application that matured as the ’220 patent.

Bryson's additional disclosure should not now be considered on its own merit in evaluating the patentability of claims of the '220 patent.

Furthermore, because the record readily conveys that Petitioner's reliance on, and discussion of, Bryson does not constitute the same or substantially the same art or argument previously presented to the office, there was no need for Petitioner to show how "the USPTO previously erred" as urged by Patent Owner. *See* Prelim. Resp. 24. That is not an inquiry that is germane to the situation at hand.

We have considered Patent Owner's arguments pertaining to its request for our exercise of discretionary denial pursuant to § 325(d). We do not agree with Patent Owner that Petitioner's Petition, and in particular its reliance on Bryson for its proposed grounds, is underpinned by prior art or argument that were previously presented to the Office. Accordingly, our inquiry into the two-part framework of *Advanced Bionics* need not go further than consideration of the first part of the framework in our determination that discretionary denial under § 325(d) is not appropriate here.

2. Conclusion — 325(d)

We do not exercise our discretion to deny institution of an *inter partes* review based on 35 U.S.C. §325(d).¹⁴

¹⁴ To the extent that Patent Owner's general references to 35 U.S.C. § 314(a) in its Preliminary Response constitute an attempted request for our exercise of discretion in some other context, we conclude that Patent Owner has not made any adequate or sufficient showing that discretionary denial is warranted under § 314(a).

B. Principles of Law

A petition must show how the construed claims are unpatentable under the statutory grounds it identifies. 37 C.F.R. § 42.104(b)(4). Petitioner bears the burden of demonstrating a reasonable likelihood that it would prevail with respect to at least one challenged claim for a petition to be granted. 35 U.S.C. § 314(a).

A patent claim is unpatentable as anticipated under 35 U.S.C. § 102 “if each and every limitation is found either expressly or inherently in a single prior art reference.” *WhitServe, LLC v. Computer Packages, Inc.*, 694 F.3d 10, 21 (Fed. Cir. 2012) (quoting *Celeritas Techs., Ltd. v. Rockwell Int’l Corp.*, 150 F.3d 1354, 1361 (Fed. Cir. 1998)). A claim is unpatentable under § 103(a) if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) when in evidence, objective indicia of non-obviousness (i.e., secondary considerations). *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).¹⁵

“In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed.

¹⁵ At this stage, neither party presents any objective indicia of non-obviousness.

Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)). This burden of persuasion never shifts to Patent Owner. See *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (discussing the burden of proof in *inter partes* review).

At this preliminary stage, we determine whether the information presented shows a reasonable likelihood that Petitioner would prevail in establishing that at least one of the challenged claims would have been obvious over the proposed prior art. We analyze the asserted grounds with the above-noted principles in mind.

C. Level of Ordinary Skill in the Art

In determining the level of skill in the art, we consider the type of problems encountered in the art, the prior art solutions to those problems, the rapidity with which innovations are made, the sophistication of the technology, and the educational level of active workers in the field. *Custom Accessories, Inc. v. Jeffrey-Allan Indus. Inc.*, 807 F.2d 955, 962 (Fed. Cir. 1986); *Orthopedic Equip. Co. v. U.S.*, 702 F.2d 1005, 1011 (Fed. Cir. 1983).

Petitioner contends the following in connection with a person of ordinary skill in the art:

A person of ordinary skill in the art (“POSITA”) at the time of the ’220 Patent would be a person with a bachelor’s degree in computer engineering, electrical engineering, computer science, applied mathematics, or a similar field, and at least two years of experience in the development of gambling game hardware or software functionality. A person with less education but more relevant practical experience may also meet this standard.

Pet. 20 (citing Ex. 1003 ¶ 30).

Patent Owner does not appear to dispute Petitioner’s proposed level of skill, but does separately state that a person of ordinary skill in the would have a “Bachelor of Science degree in an engineering discipline, and at least two years of programming experience developing games and game-related software system.” Prelim. Resp. 26, n.2. We do not see any substantive distinction between the parties’ respective assessments of the level of ordinary skill in the art. For purposes of this Decision, and for completeness, we adopt Petitioner’s assessment as reasonable and consistent with the prior art and the ’220 patent. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (the prior art may reflect an appropriate level of skill in the art). We note, however, that, as each party’s assessment is substantively equivalent, our determinations as a part of this Decision would be the same were we to expressly adopt Patent Owner’s assessment.

D. Claim Construction

We construe claims in the same manner used in a civil action under 35 U.S.C. § 282(b) “including construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.” 37 C.F.R. § 42.100(b). When applying that standard, we interpret the claim language as it would have been understood by one of ordinary skill in the art in light of the specification. *Wasica Fin. GmbH v. Cont’l Auto. Sys., Inc.*, 853 F.3d 1272, 1279–80 (Fed. Cir. 2017). Thus, we give claim terms their ordinary and customary meaning as understood by an ordinarily skilled artisan. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (en banc). Only terms that are in controversy need to be construed,

and then only to the extent necessary to resolve the controversy. *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co. v. Matal*, 868 F.3d 1013, 1017 (Fed. Cir. 2017).

Petitioner contends that claims 11, 12, 18, 21, and 24 include recitation of one or more “modules” that “are either ‘configured to’ perform, or that ‘oversee,’ certain recited functionality, without reciting sufficient structure for performing those functions” (the “Module Terms”). Pet. 20. As a result, Petitioner contends that the Module Terms are subject to 35 U.S.C. § 112 ¶ 6. *Id.*¹⁶ Petitioner provides a table identifying the ten Module Terms and also where functions claimed as a part of those terms are also described in the ’220 patent. *Id.* at 21–22. For instance, with respect to one of the Module Terms, a “gaming option creation module,” Petitioner points to description in the Specification of the ’220 patent residing at column 7, lines 46 through 49, and column 10, lines 13 through 17. Pet. 21. Those portions of the ’220 patent include description of the operation of gaming option creation module 150.

Petitioner further points to description in the ’220 patent setting forth that a “‘module’ . . . ‘can be embodied as special-purpose hardware (e.g., one or more ASICS, PLDs, FPGAs, or the like), or as programmable circuitry (e.g., one or more microprocessors, microcontrollers, or the like)

¹⁶ As Patent Owner notes (Prelim. Resp. 56–57), Petitioner expresses that it does not “conced[e]” that the Module Terms satisfy 35 U.S.C. § 112, and vaguely characterizes the constructions of those Module Terms that Petitioner as being what it “infers Patent Owner’s construction to be.” Pet. 20. Despite that somewhat inapt hedging on Petitioner’s part, we regard the constructions that it offers for the Module Terms to be those that Petitioner is, itself, presenting for evaluation of its proposed grounds in the Petition.

appropriately programmed with software and/or firmware, or as a combination.” Pet. 22 (quoting Ex. 1001, 8:57–9:10). Petitioner, thus, contends that “the corresponding structure for each ‘module’ would include one or more processors implementing an algorithm performing these functionalities.” *Id.* (citing Ex. 1003 ¶ 125; Ex. 1001, 8:57–9:10).

Patent Owner agrees that the noted Module Terms are understood to invoke § 112 ¶ 6. Prelim. Resp. 63. Patent Owner, however, generally expresses that it does not agree with any of the constructions offered by Petitioner for those terms. *Id.*¹⁷ Patent Owner provides specificity as to its basis of disagreement in connection with a single term, “a gaming option creation module.” *Id.* at 63–67. Patent Owner advances the following:

Properly construed, the algorithm of “a gaming option creation module,” is an algorithm that collects particular games, game types, tournament types, and betting types—which are displayed as options on a client splash screen—for player selection for gameplay, as depicted in FIG. 3 and described in 12:3–13 and 12:45–13:16, and as a part of a larger algorithm as

¹⁷ We note that Patent Owner, citing to *Callminer, Inc. v. Mattersight Corporation*, IPR2020-00272, Paper 8 at 10-14 (PTAB June 18, 2020), also contends that Petitioner’s constructions are procedurally defective in being non-compliant with 37 C.F.R. § 42.104(b)(3). See Prelim. Resp. 56–60. The Board’s prior decision in *Callminer* is distinguished from the facts presented here. In *Callminer*, the petition had “fail[ed] to explain or identify what the structure” was, because the petition provided “unexplained string citations to *voluminous portions* of the specification such as relying on *multiple columns of material* and *multiple figures*, without identifying what portions of the citations contain the alleged structure.” *Callminer*, IPR2020-00272, Paper 8 at 12–13 (emphases added). By contrast, the table citations in the present Petition are short and to the point, and the Petition states what Petitioner believes constitutes the corresponding structure. See Pet. 20–22.

depicted in FIGS. 5, 8, 9, 10. This is the proper construction under § 112 ¶ 6.

Prelim. Resp. 64.

Figures 3, 5, 8, 9, and 10 are described generally as illustrating examples of user-interface screens (Fig. 3) and various examples of methods by which a system could implement peer-to-peer gaming in accordance with embodiments in the '220 patent. *See* Ex. 1001, 3:18–20, 25–27, 34–43. The portions of columns 12 and 13 referenced by Patent Owner describe the user-interface screen of Figure 3 (Ex. 1001, 12:3–13) and a description of “Gaming Options” available to a player in the course of the operation of systems of the '220 patent (*id.* at 12:45–13:16). Thus, the identified content presents illustration of the graphical display that is presented to a player to allow the player to interface with the gaming system in the course of game play, and a description of game play options available for selection by a player, which may be displayed on the noted screen.

Although Patent Owner characterizes the above-noted disclosure as constituting an “algorithm” that delineates the particular structure of the claimed “gaming option creation module,” it is difficult, on this record, to agree with that determination. Indeed, although the Specification of the '220 patent provides description of the operation and configuration of “gaming option creation module 150” (*see, e.g.,* Ex. 1001, Figs. 1, 2; 7:46–49; 10:13–17), the entirety of the content of the '220 patent identified by Patent Owner omits any reference to gaming option creation module 150. Furthermore, the '220 patent specifically links the gaming option creation module to components readily identified as structural, such as “special-purpose hardware (e.g., one or more ASICS, PLDs, FPGAs, or the like)” and “programmable circuitry (e.g., one or more microprocessors,

microcontrollers, or the like)” (*see, e.g.*, Ex. 1001, 8:61–9:5) that form no part of Patent Owner’s assertion as to the corresponding structure of the claimed gaming option creation module. The omission of any assessment of the description of any gaming option creation module (e.g., component 150) in the ’220 patent, or the readily identifiable structural components attributed to such a module, casts doubt on the correctness of Patent Owner’s claim construction position.

On the record before us, we are not satisfied that Patent Owner has established the corresponding structure of the claimed gaming option creation module. We are mindful of Patent Owner’s argument that Petitioner’s proffered constructions of the Module Terms are deficient on the merits, because Petitioner “fails to properly address *the algorithms*” per Federal Circuit and PTAB case law concerning means-plus-function limitations, “and instead merely identifies structure and generic functions.” Prelim. Resp. 60 (emphasis added) (citing Pet. 32–35). We, however, also do not agree with Patent Owner, at this time, that Petitioner’s constructions are offered entirely “absent any explanation” and provide “no clarity.” See Prelim. Resp. 56–60. Nevertheless, we do not need to address these arguments at the present time. They might lead to a subset of the claims of the ’220 patent surviving the present proceeding, but do not affect the patentability of several other claims at issue in the present proceeding, including independent claims 1, 8, 15, and 30. See 35 U.S.C. § 314(a) (authorizing institution of *inter partes* review if there is a reasonable likelihood Petitioner would prevail with respect to at least *one* of the challenged claims). Thus, we leave resolution of these issues raised by Patent Owner to a full trial on the merits, which will afford Petitioner the

opportunity to defend the Petition against Patent Owner's arguments, if Patent Owner opts to maintain them in its post-institution Papers.

Lastly, we observe that Patent Owner also generally challenges the claim construction standard employed by both Petitioner and Petitioner's Declarant, Mr. Nicely. In Patent Owner's view, each of the Petition and Mr. Nicely's testimony should be regarded as applying the incorrect "broadest reasonable interpretation" standard for claim construction rather than the "ordinary and customary standard," such that the Petition should be denied. Prelim. Resp. 67. Patent Owner makes that contention on the basis that the Petition does not articulate what standard is being applied therein, and Mr. Nicely includes a statement in his Declaration that "the prior art discussed herein discloses the Challenged Claims under any reasonable interpretation." *Id.* at 67–68 (quoting Ex. 1003 ¶ 123).

As discussed above, in an *inter partes* review, claim terms are given their ordinary and customary meaning. 37 C.F.R. § 42.100(b). We do not discern any meaningful basis to conclude that the Petition, or Mr. Nicely, employs a different claim construction standard than that enunciated in § 42.100(b). Although the Petition does not expressly specify a claim construction standard, Mr. Nicely is unequivocal in his Declaration, that other than the mean-plus function terms of the claims (i.e., the Module Terms), he is giving all other terms their "ordinary and customary meaning." Ex. 1003 ¶ 123; *see also* Ex. 1003 ¶ 18 ("I understand that claim terms are given their ordinary and customary meaning as would be understood by a [person of ordinary skill in the art] in the context of the entire disclosure."). We do not share Patent Owner's view that such characterization is "vague." *See* Prelim. Resp. 68. We also do not share Patent Owner's view that Mr. Nicely's statement that the challenged claims of the '220 patent are

disclosed in the prior art “under any reasonable interpretation” is an assessment that the “broadest” reasonable standard has been applied. *See* Prelim. Resp. 68–69. We do not discern that either Mr. Nicely or the Petition advances any claim construction regarded as one that is the “broadest” reasonable construction. There is nothing incongruous with an assessment that the ordinary and customary meaning of a term is also a “reasonable” understanding of the term.

We conclude that, for purposes of deciding whether to institute an *inter partes* review, we determine that it is unnecessary to make explicit the meaning of any claim term.

E. Mr. Nicely’s Declaration

Patent Owner briefly requests that we give Mr. Nicely’s Declaration “no weight” (1) on the general theory that his testimony is “a conclusory reproduction or paraphrasing of the attorney arguments asserted in the Petition,” and (2) because Mr. Nicely allegedly improperly employed the broadest reasonable claim construction standard as the basis for his Declaration. Prelim. Resp. 70–71. As discussed above, we do not agree with Patent Owner that Mr. Nicely’s testimony is based on the broadest reasonable interpretation standard for claim construction. Furthermore, we decline to wholly discount Mr. Nicely’s testimony simply because, in some instances, it uses similar phrasing as, or makes similar conclusions to, the arguments presented in the Petition. We proceed to evaluate Petitioner’s grounds of unpatentability, and give appropriate consideration of the evidence and arguments offered by Petitioner in support of those grounds, as well as evaluate the evidence and arguments offered by Patent Owner in challenging the propriety of the grounds. *See* 37 C.F.R. § 42.108(c) (2021)

(Board considers “information presented in the petition” and “a patent owner preliminary response . . . including any testimonial evidence” when deciding whether to institute review) (as amended at *PTAB Rules of Practice for Instituting on All Challenged Patent Claims and All Grounds and Eliminating the Presumption at Institution Favoring Petitioner as to Testimonial Evidence*, 85 Fed. Reg. 79129 (Dec. 9, 2020)).

F. Grounds Based on Bryson alone or Bryson and the knowledge of a skilled artisan

Petitioner first contends that claims 8, 9, 14–16, and 19 are anticipated by Bryson or, alternatively, that those claims would have been rendered obvious based on Bryson taken with the knowledge of a skilled artisan.¹⁸ See Pet. 28–48. Patent Owner does not agree. See Prelim. Resp. 28–54.

1. Overview of Bryson

Bryson is titled “Gaming Community Management and Personalization.” Ex. 1004, code (54). Bryson summarizes its disclosure as follows:

The present invention involves methods and devices for controlling many aspects of a player’s gaming experience, including game themes presented, game denomination, pay models, content and promotions. Some implementations of the invention provide a casino operator the necessary tools to create subsets of customers, often referred to herein as “communities,” and to control the gaming experiences of players in these communities. In some such implementations, communities may be created and/or modified according to various criteria, some of which may be weighted more heavily than others. Specific

¹⁸ In the Petition, these grounds are designated as “Grounds 1 and 2.” Pet. 28; see *id.* at 14.

marketing messages, promotions, etc., may be provided to attract and retain players having similar characteristics and preferences.

Id. at 1:33–45.

Bryson also discloses that its invention provides for “the flexible creation and/or modification of player communities” and that an “operator (and/or central system) may provide wagering games, wagering game attributes, etc., according to a player’s community, location and/or device.”

Id. at 5:40–47.

Figure 1 of Bryson is reproduced below.

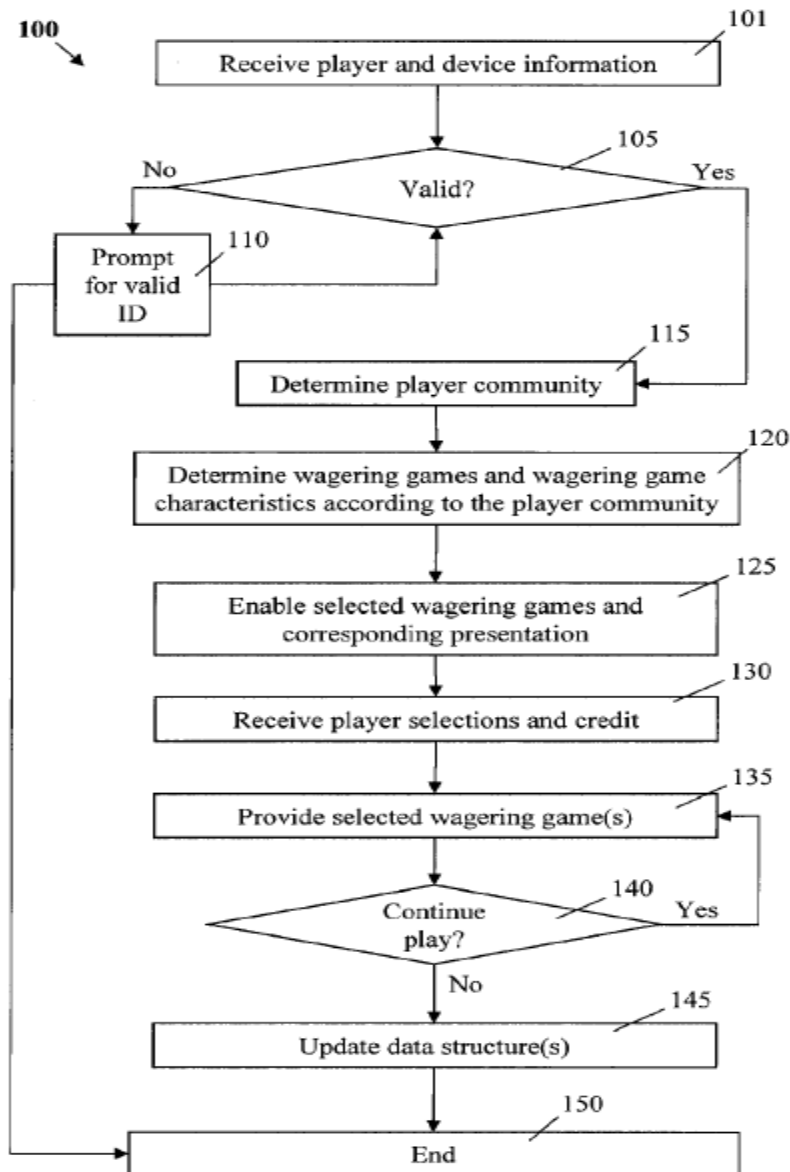


Fig. 1

Figure 1 above illustrates a flow chart outlining aspects of Bryson's disclosure. *Id.* at 4:27–28. In flow chart 100, information about an associated player and device is received at step 101, and that information is authenticated or verified at step 105. *Id.* at 5:48–57; 6:25–29. Further, “[i]f the player and/or device can satisfy the authentication/verification challenge of step 105, the player's community is determined. This process may be

performed, e.g., by a device (such as a server) or a central system, with reference to a database of players and player communities.” *Id.* at 6:30–34. At step 125, a determined wagering game presentation is provided to a player. *Id.* at 7:49–50. “Step 125 may vary according to various factors, including the characteristics of the player community, the type and location of the device used for gaming and the provisioning mode.” *Id.* at 7:50–53. Bryson further discloses that “the presentation may depend on device location” and that “wagering games and/or wagering game attributes may be providing according to the legal requirements of a device’s jurisdiction.” *Id.* at 8:24–27.

2. Discussion

In reviewing the Petition and the grounds based on Bryson alone or Bryson and the knowledge of a person of ordinary skill in the art, we discern that Petitioner lays out in detail where it believes all of the limitations required by claims 8, 9, 14–16, and 19 are accounted for by the prior art. *See, e.g.*, Pet. 28–48. Petitioner supports its position in that respect through recourse to the testimony of Mr. Nicely (Ex. 1003).

Patent Owner focuses its challenges to the above-noted grounds on three limitations recited in claim 8, in particular, limitations 8[e], 8[g], and 8[k]. We focus first on those challenged limitations.

- a) *Limitation 8[e]: “dynamically create a customized list of available games for a player at the current location of the player”*

In connection with the above-noted limitation, Petitioner contends that Bryson discloses “dynamically customizing and personalizing ‘aspects of a player’s gaming experience’” through its disclosure of assigning players to

“player communities” and “presentation of wagering games and gaming options to each player according to their assigned community, the player’s location, and the type of device being used (e.g., mobile device, remote computer, gaming machine).” Pet. 32–33 (citing Ex. 1003 ¶¶ 163–165; Ex. 1004, 1:11–36; 5:40–47; 6:30–39). To that end, Petitioner characterizes Bryson as setting forth a “multi-step process.” As urged by Petitioner, Bryson teaches first determining a player’s pre-assigned community or, if none yet assigned, assigning a player to a community based on various factors. *Id.* at 33. Next, Petitioner contends that “Bryson teaches dynamically altering the list of wagering games and options based on the ‘location of the device used for gaming.’” *Id.* at 34 (citing Ex. 1003 ¶¶ 131, 166; Ex. 1004, 7:49–67). Petitioner, thus, contends that Bryson teaches what is required by limitation 8[e]. *Id.* at 35.

Patent Owner discounts Petitioner’s assessment of Bryson’s teachings. Patent Owner’s first challenge is directed to the “dynamically” aspect of the claim. According to Patent Owner, in connection with determining a player’s community, Bryson teaches only that such a community is established by an “operator” and is, therefore, not done “dynamically.”¹⁹ *See, e.g.*, Prelim. Resp. 31. In support of that premise, Patent Owner points to content of Bryson stating that a “casino operator” may establish communities, and that an “operator” is provided tools allowing for the creation of player communities. *Id.* at 32–33 (citing Ex. 1004, 1:33–45;

¹⁹ Consistent with the prosecution history of the ’220 patent (*see, e.g.*, Ex. 1002, 242–243), Patent Owner appears to regard the term “dynamically” as essentially synonymous with the term “automatically,” which in Patent Owner’s view is distinguished from action by, for instance, a human operator.

5:40–47). Patent Owner, thus, urges that Bryson’s teachings are limited strictly to “casino-operator set communities.” *See, e.g., id.* at 34.

Although, as Patent Owner notes, Bryson does clearly provide for an operator to establish a player’s community, we regard Bryson’s teachings as more expansive on that matter than argued by Patent Owner. Indeed, portions of Bryson on which Patent Owner relies state only that in “some implements of the invention” does a casino operator create player communities. *See* Ex. 1004, 1:36–39. In other portions, Bryson makes clear that the actions of an operator, including the creation of player communities, may, instead, be performed by a “server” of a “central system.” *See id.* at 6:30–34 (“If the player and/or device can satisfy the authentication/verification challenged of step 105, the player’s community is determined. This process may be performed e.g., by a device (*such as a server*) of a central system.” (emphasis added)); *id.* at 5:45–47 (“The operator (*and/or the central system*) may provide wagering games, wagering game attributes, etc., according to a player’s community, location, and/or device type.” (emphasis added)).

We do not discern that Patent Owner accounts adequately for the entirety of Bryson’s teachings, in particular, the description of a “central system” in lieu of an “operator” to perform operations such as the determination of a player’s community. On this record, it is not apparent why such operation of a central system would not constitute the determination of such communities automatically or “dynamically.”

Patent Owner further argues that Bryson assigns players to communities based only on “player information” that is not “location information.” Prelim. Resp. 33. Patent Owner contends that Petitioner has not shown that Bryson’s community assignment is based on location

determination, and thus does not account for “dynamically creat[ing] a customized list of available games for a player at the current location of the player.” *Id.* at 39–42. Patent Owner appears to focus its positions on Bryson’s disclosure as to its “authentication” process (i.e., step 105). In that respect, Patent Owner argues that Petitioner “conflates” teachings in Bryson concerning community creation and aspects of location determination that arise as a part of an authentication process. *Id.* at 41–42. Patent Owner, therefore, is of the view that any creation of lists of available games is not based on the current location of a player. *Id.* at 42.

Patent Owner’s above-noted arguments focus on Bryson’s disclosure at column 6, lines 25 through 27 describing that Bryson’s step 105 “may involve player identification, but also device authentication and/or location determination.” Patent Owner chastises Petitioner for not addressing that disclosure (Prelim. Resp. 37 n.5), yet we do not discern that any location determination as a part of Bryson’s authentication process is the location determination aspect of Bryson’s teachings on which Petitioner relies in its Petition. Rather, Petitioner focuses on Bryson’s disclosure, such as the following: (1) a central system may provide “wagering games, wagering game attributes, etc., according to a player’s community, location, and/or device”; (2) the process of determining a player’s community may involve a central system “according to player information, e.g., according to a player’s indicated wager gaming preferences, indicated experience level and/or other factors”; (3) “[a] determined wagering game presentation is then provided the player,” and “may vary according to various factors, including the characteristics of the player community, the type and location and location of the device used for gaming and the provisioning mode”; and (4) that “wagering games and/or wagering attributes may be provided according to

the legal requirements of a device’s jurisdiction.” Pet. 33–35 (citing Ex. 1004, 5:40–47; 6:30–39; 7:49–67; 8:24–29). Taken together those teachings reasonably convey that a player’s location may be a factor considered by the central system in taking an action, such as assigning a player to a community, and also providing a list of games available to the player, including only those games that are legal in the jurisdiction in which a player resides. In other words, Bryson’s described operation of providing gaming information to a player based, for instance, on a player’s “location” or “jurisdiction,” is done irrespective of any authentication practice that may also factor in a player’s location as a part of that practice.

Accordingly, we have considered the Petition in connection with limitation 8[e], and also Patent Owner’s opposing view on the matter. For purposes of this Decision, we conclude that Petitioner has shown adequately that Bryson’s teachings account for the requirement of limitation 8[e].

b) Limitation 8[g]: “wherein the limits on wagers are set to non-monetary based wagering when the current location restricts monetary gambling”

In connection with limitation 8[g], Petitioner points first to disclosure in Bryson pertaining to “enforcement of location and jurisdiction-specific ‘wagering rules’ by applying ‘wagering limitations to the wagering games and options that are made available to player.” Pet. 36 (referencing prior content of the Petition addressing claim 8; citing Ex. 1003 ¶ 167). Petitioner additionally relies on Bryson’s teachings as to “‘provid[ing] the play of games for free’ using ‘simulated,’ non-monetary ‘wagers’ that do ‘not affect a player’s [account] balance.’” *Id.* (citing Ex. 1003 ¶ 167 (in turn citing Ex. 1004, 17:31–37, Fig. 4 (“freeplay players”))). Petitioner reasons the following:

A [person of ordinary skill in the art] would have understood Bryson's disclosure of limiting wagering amounts based on jurisdictional rules to disclose setting wagering limits to "non-monetary based wagering," such as Bryson's disclosed "simulated wagering" mode, to "provide the play of games for free" when the current location restricts monetary gambling.

Id. (citing Ex. 1003 ¶ 167).

Alternatively, Petitioner contends the following:

A [person of ordinary skill in the art] also would have found it obvious to limit the games and gaming options to the player in the "wagering game presentation" to only display Bryson's "free," "simulated," and non-monetary-based wagering game options when restricted in the current location, because doing so would have complied with regulations in numerous jurisdictions where "freeplay" or simulated wagering is allowed, but monetary wager-based gaming is not. Doing so would have furthered one of Bryson's stated goals of "increas[ing] player patronage" by allowing players to play non-monetary versions of popular games where monetary gaming is not allowed.

Id. at 36–37 (citing Ex. 1003 ¶¶ 168–169).

Patent Owner appears to argue limitation 8[g] in concert with limitation 8[k] ("compensate the player with player winnings"). *See* Prelim. Resp. 46–51. We address limitation 8[k] more thoroughly below, but focus here on the particular requirements of limitation 8[g].

Culling out Patent Owner's position as it pertains to limitation 8[g], what appears to be the thrusts of Patent Owner's argument are (1) that Bryson's disclosure of "games for free with simulated wagers" does not actually involve "wagering," or specifically "non-monetary wagering," as is envisioned by limitation 8[g], and (2) that Bryson's "consequence-free game simulation" does not account for "a current location of a player" as required by limitation 8[g]. *See* Prelim. Resp. 47–50.

With respect to item (1) above, we note that Bryson, itself, describes the play of “games for free” as involving “wagers.” Ex. 1004, 17:31–35. That those “wagers” are characterized as “simulated,” provides little, if any basis, to conclude that they are somehow not wagers. *See id.* Moreover, the Specification of the ’220 patent provides context for the meaning of wagers, as it specifies that the forms of winnings as a result of game playing “include[e], but [are] not limited to: points, credits, or hard currency.” *See* Ex. 1001, 11:6–8. Intrinsic to that description is the reasonable understanding that the type of wagering involved in game play to produce those noted winnings is expansive and includes each of monetary based wagering (e.g. hard currency) as well as non-monetary based wagering (e.g., points). Patent Owner does not explain meaningfully why Bryson’s “simulated wagering” is not reasonably encompassed by the meaning of wagering that readily emerges from the ’220 patent. That is so, even though Bryson indicates that such simulated wagering does not affect a “player’s balance.” *See* Ex. 1004, 17:35–37. It follows readily and reasonably that the referenced “balance” is a player’s monetary balance, and that such monetary balance is not impacted in connection with the simulated wagering contemplated by Bryson’s “free” games.

With respect to item (2), as noted by Petitioner (*see* Pet. 34–35), Bryson teaches that the wagering games that are presented as available options may be influenced by the “legal requirements of a device’s jurisdiction.” Ex. 1004, 8:24–29. We are mindful that a reference stands for all of its specific teachings, as well as the inferences one of ordinary skill in this art would have reasonably been expected to draw therefrom. *In re Fritch*, 972 F.2d 1260, 1264–65 (Fed. Cir. 1992); *see also Perfect Web Technologies, Inc. v. InfoUSA, Inc.*, 587 F.3d 1324, 1329 (Fed. Cir. 2009)

(“hold[ing] that while an analysis of obviousness always depends on evidence that supports the required *Graham* factual findings, it also may include recourse to logic, judgment, and common sense available to the person of ordinary skill that do not necessarily require explication in any reference or expert opinion”).

In this case, it follows logically that a skilled artisan would infer that Bryson’s teachings involving assessment of a player’s location or jurisdiction in determining whether monetary gaming is legal in that location or jurisdiction (*see, e.g.*, Ex. 1004, 5:40–47; 7:49–53; 8:24–29) would apply in connection with Bryson’s disclosure of “free” games involving only simulated wagering (*see, e.g., id.* at 17:31–37). Thus, for purposes of this Decision, we find Petitioner’s argument to that effect persuasive (*see* Pet. 36–37), and credit Mr. Nicely’s supporting testimony (*see* Ex. 1003 ¶¶ 168–169). Indeed, teachings pertaining to assessing the legality of monetary gaming alongside presentation of games involving simulated non-monetary wagering seem to be in harmony with one another rather than dissonant, as is seemingly implied by Patent Owner (*see* Prelim. Resp. 48–50). In our view, and based on the current record, we are not satisfied that Patent Owner’s view adequately accounts for what a person of ordinary skill in the art, who is also a person of ordinary creativity, would have gleaned from the teachings of Bryson. *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007) (“A person of ordinary skill is also a person of ordinary creativity, not an automaton”)

Accordingly, we conclude, for purposes of this Decision, that Petitioner has accounted adequately for limitation 8[g] in the prior art.

c) *Limitation 8[k]: “compensate the player with player winnings”*

In addressing limitation 8[k], Petitioner advances the following:

Bryson discloses “allow[ing] a remote client to provide game play of games where a monetary balance is adjusted based upon the outcome of the game,” and “allow[ing] funds to be [] transferred from the account” via “credit cards, debit cards, bank accounts, wire transfers, etc.” Bryson therefore discloses compensating the player with monetary winnings based on the outcome of games.

Pet. 40 (citing Ex. 1003 ¶ 176; Ex. 1004 13:3–15).

Patent Owner does not appear to dispute that Bryson teaches compensating a player with monetary winnings based on the outcome of game-play. Rather, Patent Owner tethers its dispute with respect to limitation 8[k] to association with limitation 8[g]. In that regard, Patent Owner contends that when the requirement of limitation 8[k] is considered with respect to the “non-monetary based wager” aspects of limitation 8[g], the result is that limitation 8[k] requires compensating a player with “non-monetary winnings.” *See, e.g.*, Prelim. Resp. 46–47. Patent Owner argues that such a result is not disclosed or taught in Bryson. *See id.* at 47–48.

We are mindful that the Petition does not, on its face, seemingly address the potential of compensating a player with non-monetary winnings. But, it is evident, or at least undisputed on this record, that Bryson contemplates player compensation based on monetary winnings. Notably, limitation 8[k] does not specify that winnings must only be those that are non-monetary. Patent Owner contends that such requirement is imposed when the provision of limitation 8[g] pertaining to “non-monetary based wagering” is implicated in the scenario where a player’s location restricts

monetary gambling. Yet, that contention raises a clear question as to why, in a scenario in which a player's location has been determined not to prohibit monetary gambling, such location determination coupled with monetary based wagering resulting in compensation that is monetary winnings is inadequate to satisfy claim 8. As discussed above, Bryson's teachings are understood reasonably to teach or suggest such a scenario. On that basis, we determine, for purposes of this Decision, that Petitioner's reliance on Bryson's teachings appears to account for limitation 8[k]. The parties are free to further address the issue during trial.

d) Remaining limitations of claim 8

Supported by the testimony of Mr. Nicely, Petitioner lays out where all the remaining limitations of claim 8 are present in Bryson. *See, e.g.*, Pet. 28–31, 35–36, and 37–40. Patent Owner argues that “Bryson does not render obvious claim 8 as a whole” and generally states that the Petition does not account for limitations 8[f], 8[g], 8[h], 8[i], and 8[j]. *See* Prelim. Resp. 51–53. Having the considered Petitioner's detailed assessment of how Bryson's teachings account for the above-referenced limitations of claim 8, alongside the general statement of disagreement of Patent Owner, we do not discern on the current record any deficiencies in Petitioner's approach in accounting for the remaining limitations of claim 8.

e) Claims 9, 14–16, and 19

Claims 9 and 14 depend from claim 8. Claim 15 is an independent claim, from which claims 16 and 19 depend. The Petition lays out how Petitioner believes all the features of claims 9, 14–16, and 19 are accounted for based on Bryson's teachings. *See* Pet. 40–48. With respect to claim 15,

Patent Owner contends that Petitioner has presented claim 15 as having limitations that are substantially similar to claim 8, and that Patent Owner's arguments as to claim 8 also apply to claim 15. Prelim. Resp. 53. As discussed above, and on this record, we do not determine that Patent Owner has identified deficiencies in the Petition that preclude institution of *inter partes* review. We reach the same determination as to claim 15.

With respect to dependent claims 9, 14, 16, and 19, Patent Owner does not offer any distinct arguments directed to those claims. On this record, we do not discern deficiencies in the Petition in accounting for the requirements of each of claims 9, 14, 16, and 19.

G. Ground Based on Bryson and Harkham

Petitioner contends that claims 1–3, 6, and 26–30 are unpatentable based on Bryson and Harkham, and lays out where all the features of those claims are accounted for by the prior art.²⁰ See Pet. 49–56. Claims 1 and 30 are independent claims. Claims 2, 3, 6, and 26–29 ultimately depend from claim 1. Patent Owner contends that “Petitioner relies on Bryson for the same limitations for claims 1 and 30 as it does with respect to Grounds 1/2” and that “Ground 3 fails for the same reasons as described in Grounds 1/2.” Prelim. Resp. 54. As discussed above, on the current record, we do not determine that Petitioner's first two proposed grounds based on Bryson (i.e., those grounds designated as Grounds 1 and 2 in the Petition) have the

²⁰ In the Petition, this ground is designated as “Ground 3.” Pet. 49; *see id.* at 14.

deficiencies urged by Patent Owner. We make that same determination with respect to the Ground based on Bryson and Harkham.²¹

H. Ground Based on Bryson, Frenkel, and Amaitis

Petitioner contends that claims 21–24 would have been unpatentable based on Bryson, Frenkel, and Amaitis, and points out in detail how the features of those claims are accounted for by the prior art.²² Pet. 73–86. Patent Owner’s opposition to this ground is premised on its proposed construction of the term “gaming option creation module.” Prelim. Resp. 54–55. On that basis, Patent Owner argues that Petitioner’s proposed ground is deficient. *Id.* at 55.

As discussed above (*see supra* § II.D), on this record, we do not determine that Patent Owner’s proposed claim construction of “gaming option creation module” is correct, or that Petitioner’s proposed claim construction is incorrect. We leave resolution of the issues raised by Patent Owner to a full trial on the merits.

I. Remaining Grounds

The Petition includes four additional proposed grounds of unpatentability applied to claims of the ’220 patent.²³ The Petition explains where all of the features of the relevant claims are accounted for by the prior

²¹ In doing so, we note that independent claims 1 and 30 do not appear to include the potential issue raised in claim 8 pertaining to the compensation of a player with “non-monetary” winnings.

²² In the Petition, this ground is designated as “Ground 8.” Pet. 73; *see id.* at 14.

²³ These grounds are designated as Grounds 4 through 7 in the Petition. *See* Pet. 14, 57, 63, 67, 71.

art. *See* Pet. 57–72. Patent Owner contends that for the same reasons that it advanced for Petitioner’s “Grounds 1–3 or 8,” the “Grounds 4–7” also are deficient. Prelim. Resp. 55. As discussed above, we do not determine, at this time, that any of the grounds based on Bryson alone or taken with any of the knowledge of a person of ordinary skill in the art, Harkham, Frenkel, or Amaitis (i.e., the Grounds 1–3 and 8 referenced by the parties) are deficient. On the current record, we also do not discern deficiencies in the other four grounds proposed by Petitioner (i.e., the parties’ identified Grounds 4–7).

III. CONCLUSION

Petitioner has shown a reasonable likelihood that it would prevail with respect to at least one of the challenged claims.

IV. ORDER

In consideration of the foregoing, it is

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review of claims 1–30 of the ’220 patent is instituted with respect to all grounds set forth in the Petition; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4(b), *inter partes* review of the ’220 patent shall commence on the entry date of this Order, and notice is hereby given of the institution of a trial.

FOR PETITIONER:

Eliot Williams
Hopkins Guy
Jamie Lynn
Thomas Martin
Andrew Wilson
BAKER BOTTS LLP
eliot.williams@bakerbotts.com
hop.guy@bakerbotts.com
jamie.lynn@bakerbotts.com
tommy.martin@bakerbotts.com
andrew.wilson@bakerbotts.com

FOR PATENT OWNER:

Miguel Bombach
Fareid Asphahani
PERKINS COIE LLP
bombach-ptab@perkinscoie.com
asphahani-ptab@perkinscoie.com