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Paper 11
Date: March 9, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ENTAIN CORPORATE SERVICES LTD.,
MGM RESORTS INTERNATIONAL, AND BETMGM LLC,
Petitioner,

v.

GAN (UK) LIMITED,
Patent Owner.

IPR2023-00027
Patent 8,821,296 B1

Before JAMES P. CALVE, JEREMY M. PLENZLER, and CARL M. DEFRANCO, *Administrative Patent Judges.*

CALVE, *Administrative Patent Judge*.

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

II. BACKGROUND

Entain Corporate Services Ltd., MGM Resorts International, and BetMGM, LLC (collectively "Petitioner") filed a petition seeking *inter partes* review of claims 1, 3–18, 21, and 22 (the "challenged claims") of U.S. Patent No. 8,821,296 B1 ("the '296 patent") (Ex. 1001) as reexamined (Ex. 1002). Paper 1 ("Pet."). GAN (UK) Limited ("Patent Owner") timely filed a Preliminary Response. Paper 9 ("Prelim. Resp.").

We have authority to determine whether to institute *inter partes* review. *See* 35 U.S.C. § 314 (2018); 37 C.F.R. § 42.4(a) (2022) ("The Board institutes the trial on behalf of the Director."). *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). Upon consideration of the evidence and arguments in the record, we determine that the information presented shows a reasonable likelihood that Petitioner would prevail with respect to at least one of the challenged claims. We therefore grant institution of *inter partes* review.

A. Related Proceedings

The parties identify the following proceeding in which the '296 patent is involved: *GAN (UK) Limited (F/K/A GameAccount Network, PLC, GAN PLC, and GAN (UK) PLC) v. MGM Resorts International and BetMGM, LLC*, Case No. 1:22-cv-00361-CJB (D. Del.). Pet. 85; Paper 6, 2, Paper 8, 2.

B. Real Parties in Interest

Petitioner identifies Entain Corporate Services Ltd., MGM Resorts International, and BetMGM, LLC as real parties in interest. Pet. 85. Patent Owner identifies GAN (UK) Limited as the real party in interest. Paper 6, 2.

C. The '296 Patent (Ex. 1001)

The '296 patent technology connects network (e.g., Internet) gaming systems with casino management systems for managing patron data, loyalty programs, and other data. Ex. 1001, 1:39–42. Figure 1 of the '296 patent is reproduced below to illustrate this linking system.

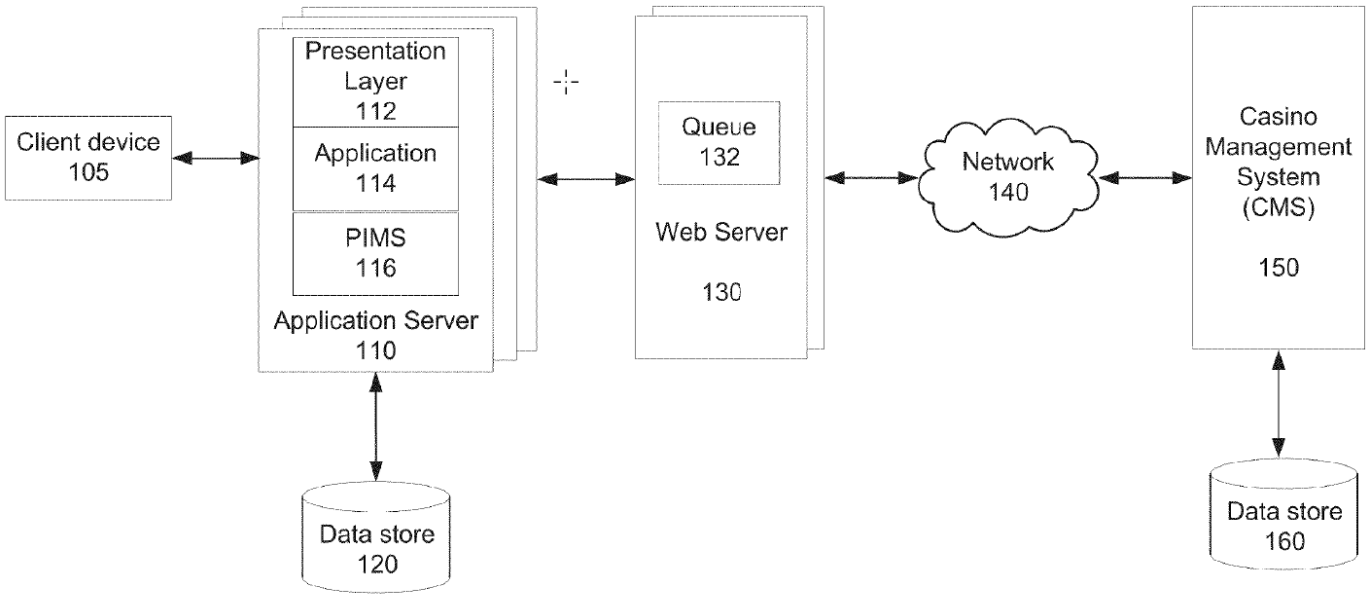


FIGURE 1

Figure 1 illustrates a system that links a network gaming service at application server 110 to casino management system (CMS) 150 so a user's patron data and loyalty programs may be accessed and shared between the two entities. Ex. 1001, 1:39–2:2, 2:51–52. Application server 110 includes executable modules that implement presentation layer 112, applications 114, and partner integration management system (PIMS) 116. *Id.* at 2:55–58.

Presentation layer 112 provides web pages and other content over the Internet or other networks to a user through a web browser. *Id.* at 2:59–62. User client device 105 may access network services at application server 110 via web pages rendered at a browser of client device 105. *Id.* at 2:62–65.

Data for users who have online accounts with a web service provided by application server 110 may be stored at data store 120. *Id.* at 2:66–67. The data may include user account and login information, address, phone number, loyalty credits, and a patron account identifier that references a patron account for the same user with CMS 150. *Id.* at 2:67–3:8.

Applications 114 include modules that implement logic for connecting web-based network services of application server 110 to a land-based system of CMS 150, and for accessing, managing, and modifying a user account associated with the web-based service or a patron account associated with the land-based service provided by CMS 150. *Id.* at 3:9–15.

PIMS 116 sends requests to particular CMSs associated with a user. *Id.* at 3:16–17. Application server 114 may request that PIMS 116 retrieve patron account information, access loyalty credits, or perform other actions with respect to CMS 150 for a particular user. *Id.* at 3:17–20. PIMS 116 determiners a communication preference of the CMS and instructs web server 130 to submit a request to the CMS of that user. *Id.* at 3:20–25.

CMS 150 may implement a management system for a land-based casino or other gaming facility and provide communications between aspects of the casino such as gaming machines, accounting, patron account creation and management, and other casino operations. *Id.* at 3:44–49.

Appellant's Figure 4 is reproduced below to illustrate a method for accessing an offline loyalty program from an online gaming account.

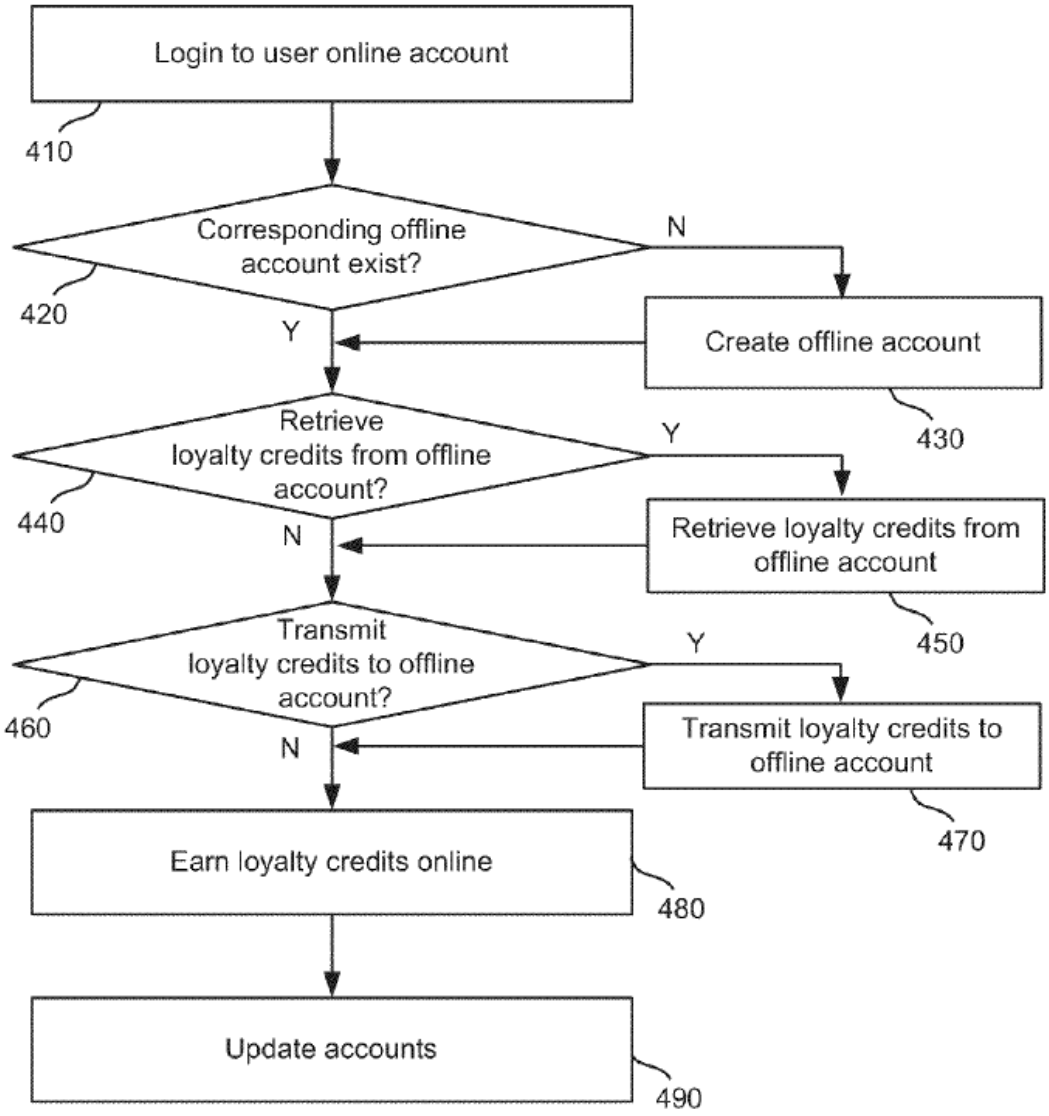


FIGURE 4

Figure 4 illustrates a method that determines whether a user who logs into an online account has an offline account and, if not, creates a patron account with the offline casino. *Id.* at 4:60–5:15. A determination is made to retrieve and transfer loyalty credits from the offline account to the online account and from the online account to the offline account. *Id.* at 5:16–45.

D. Challenged Claims

Petitioner challenges reexamined claims 1, 3–18, 21, and 22 of the '296 patent. Pet. 1. Claims 1, 11, and 18 are independent. Claims 3–10 depend from claim 1. Claims 12–17 depend from claim 11. Claims 21 and 22 depend from claim 18. Ex. 1001, 9:47–12:50 ('296 patent claims 1–20); Ex. 1002, 1:25–4:18 (reexamined claims 1, 11, 13, 17, 18, 21, and 22).

Reexamined claim 1 is reproduced below and is reformatted from the '296 patent with Petitioner's annotations added to identify each limitation:

1[pre] A method for communicating loyalty credit information, comprising:

1[a] accessing account information for a user's first account with an online gaming service, the user's first account associated with first loyalty credits;

1[b] accessing account information for a user's second account with a casino management system*, comprising:*

1[c] *determining, by an application server, the user does not have a second account with the casino management system;*

1[d] *upon determining, by the application server, that the user does not have a second account with the casino management system, creating, by the application server, a second account with the casino management system for the user,* the user's second account associated with second loyalty credits; and

accessing the user's second account; and

1[e] communicating loyalty credit information for the user between a server providing the online gaming service and machines providing the casino management system, wherein communicating loyalty credit information includes:

1[f] determining whether first loyalty credits from the user's first account are transferrable to the casino management system, and

> 1[g] transmitting a number of first loyalty credits from the user's first account with the online gaming service to the user's second account with the casino management system when it is determined that the first loyalty credits are transferrable to the casino management system, wherein the number of first loyalty credits transmitted is based on available first loyalty credits in the user's first account and user input.

Ex. 1002, 1:25–57 (reexamined claim 1) (emphasis in original).[1]

E. Asserted Grounds of Unpatentability

Petitioner asserts that the challenged claims are unpatentable on the following grounds (Pet. 2):

Claim(s)	35 U.S.C. §	Reference(s)/Basis
1, 3–6, 8–10	103[2]	Muskin,[3] Allen[4]
7	103	Muskin, Allen, Ellis[5]

[1] We adopt and apply below in our analysis Petitioner's designations for the elements of the challenged claims. *See* Pet. vii–xii, 13–77.

[2] The Leahy-Smith America Invents Act ("AIA") included revisions to 35 U.S.C. §§ 102, 103 that became effective on March 16, 2013. Pub. L. No. 112-29, §§ 3(b)–3(c), 3(n)(1), 125 Stat. 284, 285–87 (2011) took effect on September 16, 2011. Changes made to 35 U.S.C. §§ 102 and 103 in the AIA do not apply to any application for patent filed before March 16, 2013. Because the '296 patent has an effective filing date after March 16, 2013, we refer to the AIA versions of § 103 and § 102.

[3] US 2005/0170883 A1, published August 4, 2005 (Ex. 1010, "Muskin").

[4] US 9,318,000 B1, issued April 19, 2016 (Ex. 1007, "Allen").

[5] US 9,711,004 B1, issued July 18, 2017 (Ex. 1012, "Ellis").

1, 3–6, 8–15, 17	103	Muskin, Herrmann[6]
18, 21, 22	103	Muskin, Allen, Herrmann
16	103	Muskin, Herrmann, Ellis
1, 6, 9, 10	103	Pascal,[7] Allen
7	103	Pascal, Allen, Ellis
1, 6, 9–12, 15	103	Pascal, Herrmann
18, 21, 22	103	Pascal, Allen, Herrmann
16	103	Pascal, Herrmann, Ellis

Petitioner relies on the Declaration of Mr. David Crane. Ex. 1003. Patent Owner did not submit any declarations with its Preliminary Response.

III. DISCUSSION

F. Level of Ordinary Skill in the Art

Petitioner asserts that a person of ordinary skill in the art at the relevant time "would have had a bachelor's degree in computer or electrical engineering, computer science, or a similar field and two years of experience in computer system and data communication design." Pet. 6 (citing Crane Declaration, Ex. 1003 ¶ 28). Patent Owner does not dispute Petitioner's contention. *See generally* Prelim. Resp. We adopt Petitioner's proposed level of skill in the art for purposes of this Decision.

[6] US 2011/0014972 A1, published January 20, 2011 (Ex. 1011, "Herrmann").

[7] US 10,163,303 B1, issued December 25, 2018 (Ex. 1008, "Pascal").

G. Claim Interpretation

We interpret claims "using the same claim construction standard that would be used to construe the claims in a civil action held under 35 U.S.C. 282(b)." 37 C.F.R. § 42.100(b). Under this standard, we construe claims "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." *Id.* We construe the claims only to the extent necessary to determine whether to institute *inter partes* review. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) ("[W]e need only construe terms 'that are in controversy, and only to the extent necessary to resolve the controversy.'") (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)).

The parties contend that no formal claim constructions are required. Pet. 6; Prelim. Resp. 19. We construe the following limitation to reach our decision and invite the parties to provide relevant arguments and evidence.

"a communication preference of the particular casino management system based on an identity of the user"

Claims 11 and 18 recite a partner integration system that determines "*a communication preference of the particular casino management system based on an identity of the user*." Ex. 1002, 2:1–4, 2:57–59. User loyalty credit information is communicated between an online gaming service server and machines providing a particular casino management system "according to the communication preference of the particular casino management system." *Id.* at 2:5–10, 2:61–66. We interpret this limitation to mean a communication preference of the casino where the user's second account is maintained and to which loyalty credit information is transmitted.

The plain language of both claims indicates that the communication preference belongs to the particular casino where the user has an account for storing loyalty credits. The user's identity determines the "*particular* casino management system" where the user has a second account for storing loyalty credits. Loyalty credit information is communicated for that user between that user's first account with the online gaming service (web-based gaming service in claim 18) and that same user's second account with "the particular casino management system" "*according to the communication preference of the particular casino management system*" where that user's second account is located. *Id.* at 2:5–24, 2:64–3:11.

> This meaning matches the '296 patent specification's description that
>
> PIMS 116 may generate *requests to be sent to a particular CMS associated with a particular user*. For example, applications 114 may request that PIMS 116 retrieve patron account information, access loyalty credits, or perform other actions with respect to CMS 150. PIMS 116 may receive the abstract request from application 114, *determine the communication preference of the particular CMS associated with the user associated with the request*, and instruct web server 130 to submit a request to the CMS associated with the user of the web service.

Ex. 1001, 3:16–25 (emphasis added).

"Examples of different types of CMS communications are discussed in more detail below with respect to FIGS. 2-3." *Id.* at 3:49–51. Figure 2 depicts asynchronous communications between a network gaming system and CMS 230 via XML or S2S protocol. *Id.* at 4:21–48. Figure 3 depicts synchronous communications between these entities using SOAP, XML, and HTTP protocols. *Id.* at 4:49–59.

H. Principles of Law

A "prior art reference—in order to anticipate under 35 U.S.C. § 102—must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements 'arranged as in the claim.'" *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008) (quoting *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983)). "A single prior art reference may anticipate without disclosing a feature of the claimed invention if such feature is necessarily present, or inherent, in that reference." *Allergan, Inc. v. Apotex Inc.*, 754 F.3d 952, 958 (Fed. Cir. 2014).

A patent claim is unpatentable under 35 U.S.C. § 103 if 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. 35 U.S.C. § 103; *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR*, 550 U.S. at 416. Similarly, "if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill." *Id.* at 417.

The question of obviousness is resolved based on 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 ordinary skill in the art; and (4) when in evidence, objective evidence of non-obviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

I. Ground 1: Alleged Obviousness Based on Muskin and Allen

Petitioner contends claims 1, 3–6, and 8–10 are unpatentable under § 103 over Muskin and Allen, which are § 102 prior art. *See* Pet. 2, 6–36.

1. Muskin (Ex. 1010)

Muskin's system allows players to register accounts with land-based and online casinos and link the accounts to transfer comps, points, and data between the accounts as illustrated in Figure 1, which is reproduced below.

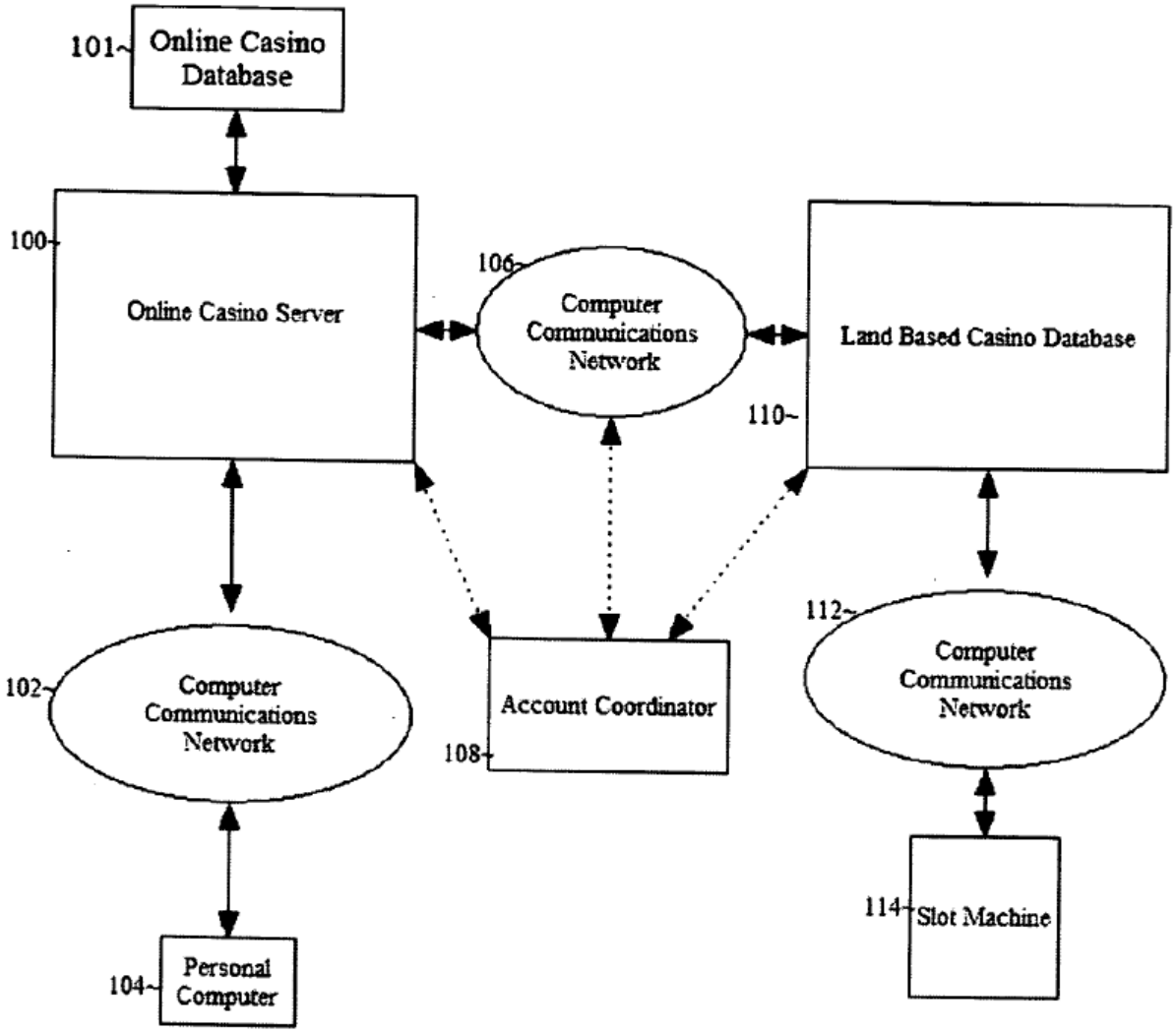


Figure 1

Figure 1 depicts online casino server 100 connected to land-based casino database 110 by computer communications network 106. Account coordinator 108 may coordinate accounts between these entities. Ex. 1010 ¶¶ 31, 32. Players access their online accounts at online casino server 100 via network 102. *Id.* ¶ 28. Players access their accounts at casino database 110 via slot machine 114 and network 112. *Id.* ¶ 29. Account coordinator 108 can associate players' online and casino accounts so comp points may be transferred from one account to the other, or players may merge accounts and comp points into a single account. *Id.* ¶¶ 11, 34–38, 40, 54–56, 72, 73.

2. Allen (Ex. 1007)

Allen allows players to create accounts for online wagering websites and wagering game establishments (i.e., casinos) and link those accounts. Ex. 1007, 2:35–3:29. Account server 101 links a casino wagering game machine 103 to a computer 105 used for online wagering. *Id.* at 3:45–49, Fig. 1. Players can have a casino account linked to an online account with different player identities, i.e., a casino player identity for a casino account and an online player identity for an online account. *Id.* at 2:51–56.

When a player creates a casino account in a wagering game establishment, a casino player identity is created based on a username and a security credential indicated by the player. *Id.* at 2:60–62. The casino player identity allows the user to log into the casino account on wagering game machines so account information (e.g., game progress, wagering statistics, rewards) can be collected and stored. *Id.* at 3:1–4. An online account is created based on an online player identity so a player can use the online player identity to log into the online account. *Id.* at 3:12–21.

Figures 1 and 4 are reproduced below to illustrate this method.

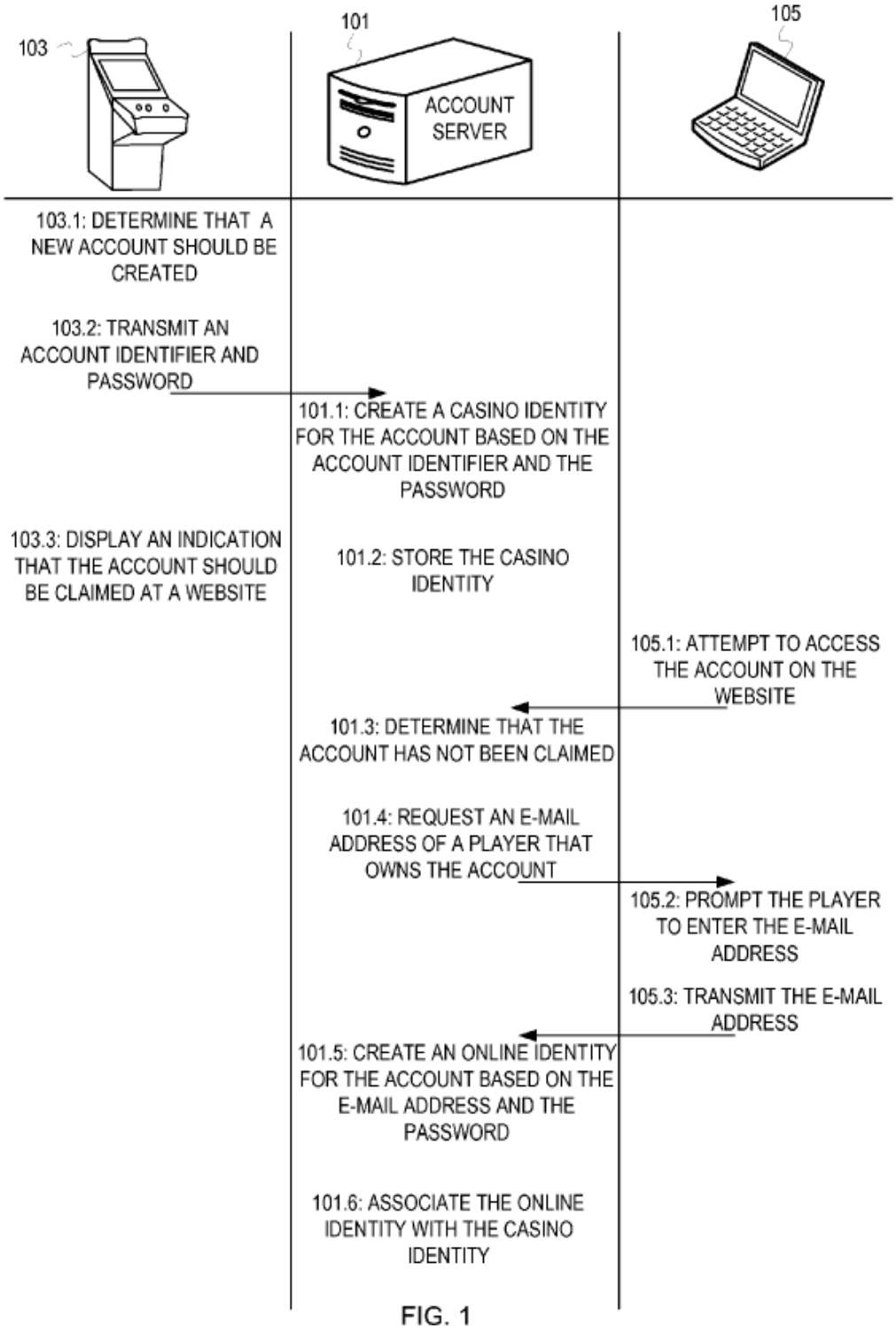


FIG. 1

Figure 1 depicts account server 101 that links online identities and accounts with casino identities and accounts. Ex. 1007, 3:45–4:56.

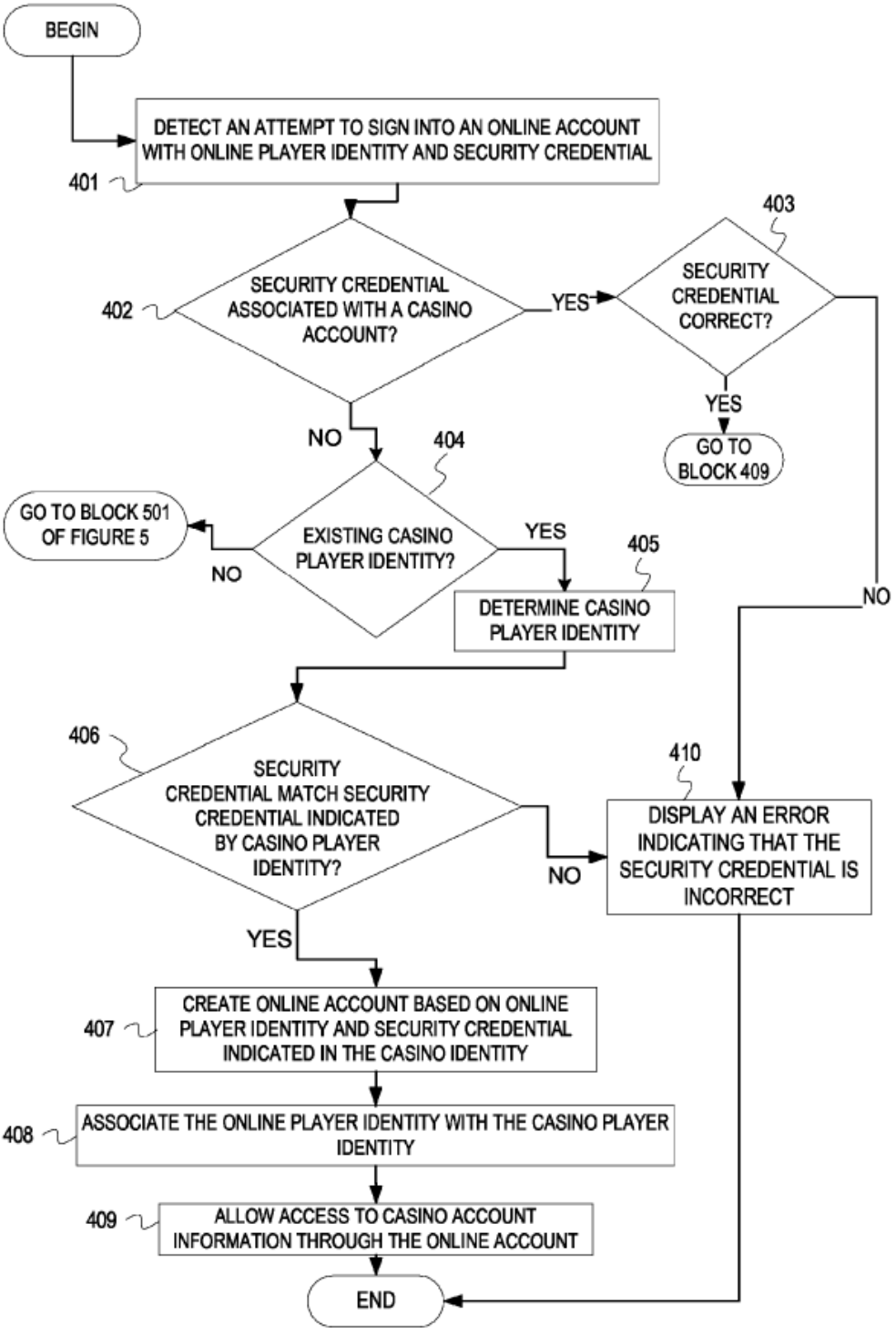


FIG. 4

Figure 4 illustrates a process that creates a casino account based on an online account and links those accounts. *Id.* at 8:45–9:33, *id.* at Fig. 5 (503).

When a player tries to sign into an online account, the account server determines if the online player identity is associated with a casino account. *Id.* at 9:1–15. If so, the account server determines if the user's security credential is correct for that account (block 403) and allows access to the casino account if the credential is correct (block 409). *Id.* at 9:20–26, 10:1–2. If the online player identity is not associated with a casino account (block 402), the account server determines if the player has an existing casino player identity. *Id.* at 9:17–19, 9:27–31. If the user lacks a casino player identity (block 404), operations continue at block 501 of Figure 5, and the account server determines "the online player identity is *not associated with a casino account* and the wagering game player does not have a casino player identity, *because a casino account has not been created for the player (see block 404 of FIG. 4*)." *Id.* at 9:31–33, 10:13–19 (emphasis added).

If the player lacks a casino account, the account server determines a casino player identity and security credential for a *new* casino account so the player can log into wagering games in wagering game establishments. *Id.* at 10:19–35, Fig. 5 block 503 ("Create a casino account based on the casino player identity and security credential"). "When a new account is created in a wagering game establishment, a casino player identity is created for the account [and] [t]he casino player identity can be used to access the account in wagering game establishments." *Id.* at 10:35–39. The account server associates the online player identity with the casino player identity for the new casino account. *Id.* at 10:45–47. The account server indicates that the player should use the casino player identity and security credential to log into the new casino account (block 505) and use the online player identity and online security credential to log into the online account. *Id.* at 10:48–53.

3. Motivation to Combine Muskin and Allen

Petitioner contends that Muskin and Allen are analogous because they are directed to associating and sharing data between online and land-based casino accounts. Pet. 11–12 (citing Ex. 1010 ¶¶ 32, 34, 41; Ex. 1007, 3:47–50, 4:11–15, 5:22–24, 10:45–46). Petitioner asserts that a skilled artisan would have combined Allen's account server with Muskin as a combination of prior art elements by known functions to yield predictable results and create a better user experience of allowing a user to seamlessly create and associate online and casino accounts. *Id.* at 12. Petitioner also asserts that a skilled artisan would have been motivated to combine Muskin and Allen for the financial benefits of improving Muskin's associating or creating of new accounts for new users to increase their use of wagering game machines and online casinos with a reasonable expectation of success. *Id.* at 12–13.

Petitioner's expert, Mr. Crane, testifies that Muskin and Allen focus on associating online and land-based casino accounts, and a skilled artisan would have been motivated to combine Allen's account manager with Muskin's account coordinator to create a better user experience by allowing users to create and/or associate their online and casino wagering accounts seamlessly. Ex. 1003 ¶¶ 97–103. Mr. Crane testifies that a skilled artisan would have recognized the financial incentive to improve methods to create and associate accounts for new users to increase players who use wagering game machines and online casinos by extending wagering game experiences to the Internet to reinforce the player's loyalty, coordinate benefits earned at both sites to reward players for play, and increase casino profits seamlessly as both references teach. *Id.* ¶ 103. Mr. Crane testifies that a skilled artisan would have had a reasonable expectation in doing so. *Id.* ¶ 104.

4. Independent Claim 1

Petitioner cites Muskin to teach limitations 1[pre]–1[g] of the claimed method for communicating loyalty credit information between affiliated establishments by associating and accessing account information of a user's first account at an online gaming service and first loyalty credits associated with the user's first account with the user's second account with a casino management system to transmit first loyalty credits to the casino account. Petitioner relies on Allen for determining *by an application server* that a user does not have a second account with a casino management system and, upon making this determination, creating, by the application server, a second user account with the casino management system in limitations 1[c] and 1[d]. Petitioner also cites Muskin for associating a user's online and casino accounts in order to transmit loyalty credits to the casino account. Pet. 13–24 (citing Ex. 1007, 3:47–50, 4:11–15, 9:27–33, 10:33–44, Figs. 1, 4, 5; Ex. 1010 ¶¶ 11, 21–23, 28, 29, 35, 38, 40, 56, 57, 71–75, Fig. 1). Mr. Crane provides supporting testimony to the same effect. Ex. 1003 ¶¶ 105–142.

5. Patent Owner's Arguments

Patent Owner argues that the Petition fails to demonstrate that Allen determines by the application server that the user does not have a second account with the casino management system in Figure 4 and creates such a second account in Figure 5. Prelim. Resp. 47. Patent Owner asserts that Allen determines whether a player has a casino *identity* rather than a second *account*, and the Petition improperly conflates the terms. *Id.* Patent Owner asserts that Allen distinguishes between a player account and identity, and the Petition fails to explain why determining that a player lacks a casino *identity* is the same as determining a player lacks a casino *account*. *Id.* at 48.

6. Analysis

In Allen, players create separate player identities for their online and casino accounts. An online account is created based on the online player identity and the online player identity allows the player to log into the online account. Ex. 1007, 3:12–21. Similarly, "[t]he casino player identity allows the user to log into the casino account on wagering games machines so that account information . . . can be collected and stored." *Id.* at 3:1–4. "When the casino account is claimed by the online account, the player provides an online player identity that is separate from the casino player identity." *Id.* at 3:12–14. A player identity is used to access a related player account.

To link online and casino accounts, Allen's account server first must determine if a user has a casino player identity. *Id.* at 9:1–31, Fig. 4 (404). "If the user does not have a casino player identity, operations continue to block 501 of FIG. 5" to *create a new casino account* for the player *by first creating a new casino player identity* for that account. *Id.* at 10:13–44.

Allen thus determines whether a player has a casino player identity to determine whether the player has a casino player account. Ex. 1007, 10:13–25 (the online player identity is not associated with a casino account and the *player does not have a casino player identity because a casino account has not been created for the player*). Allen searches an *account* database for a casino player *identity* and security credential. *Id.* at 9:40–46, Fig. 4 (406).

If a player lacks a casino player identity, operations continue at block 501 of Figure 5. *Id.* at 9:27–33 (cited in Pet. 17). Figure 5 is a process for wagering game players to get online access when they lack a casino player identity (and a casino account) by creating a casino player identity and a casino account so the player has online access. *Id.* at 10:13–67; Pet. 15–19.

Allen's teachings make clear that "the wagering game player does not have a casino player identity, because a casino account has not been created for the player (see block 404 of FIG. 4)." Ex. 1007, 10:17–19. As a result,

> At block 503, the account server creates a casino player identity based on the account identifier and the security credential. *When a new account is created in a wagering game establishment, a casino player identity can be created for the account* . . . . The *casino player identity can be used to access the account in wagering game establishments* without the account ever being claimed online.

Ex. 1007, 10:33–40 (emphasis added) (cited in Pet. 20 ("The account server creates a casino account in step 503. Allen, 10:33–44.")).

Step 503 of the Figure 5 flowchart indicates that the application server will "CREATE A *CASINO ACCOUNT* BASED ON THE *CASINO PLAYER IDENTITY* AND SECURITY CREDENTIAL." Ex. 1007, Fig. 5 (503); *id.* at 10:33–44 (emphasis added).

We agree with Petitioner that "Allen's account server determines whether a user account exists and if not, creates one" by determining if a user has an existing casino player identity in step 404 of Allen's Figure 4 and, if not, continuing operations at block 501 of Figure 5 so "[t]he account server creates a casino account in step 503." Pet. 16–20. These contentions are supported by Allen's operations flowcharts in Figures 4 and 5 and by Allen's teachings regarding these flowcharts, which are cited in the Petition and Mr. Crane's supporting testimony. *See* Pet. 16–20 (citing Ex. 1007, 4:11–15, 9:27–33, 10:33–44; Ex. 1003 ¶¶ 115–130). Mr. Crane's testimony is supported by the same teachings in Allen. Ex. 1003 ¶¶ 115–117 (citing Ex. 1007, 9:27–33), 123, 124 (citing Ex. 1007, 10:13–44, Figs. 4, 5).

On this record, we find that Petitioner has established a reasonable likelihood of establishing that at least claim 1 would be unpatentable over Muskin and Allen.

7. Claims 3–6 and 8–10

Petitioner relies on Muskin to teach a method that determines whether second loyalty credits from the user's second account are retrievable by the online gaming system and retrieves second loyalty credits from the second account with the casino management system in claim 3. Mr. Crane testifies to the same effect. Pet. 24–25 (citing Ex. 1010 ¶ 74; Ex. 1003 ¶¶ 143–146).

Petitioner relies on Muskin to teach retrieving second loyalty credits by the online gaming service to use with the user's first account with the online gaming service in claim 4, communicating user identification information to the casino management system before second loyalty credits are retrieved in claim 5, and the first loyalty credits are transferrable to the casino management system when they are usable in the user's second account with the casino management system in claim 6. Petitioner also cites Muskin to teach second loyalty credits of the second account are displayed for the user in an interface provided by the online gaming system in claim 8, updated loyalty credit information for the user is communicated between the server providing the online gaming service and the machines providing the casino management system when the user earns additional loyalty credits in claim 9, and the casino management system communicates user login information to the online gaming service before the first loyalty credits are transmitted in claim 10. Mr. Crane testifies in support. Pet. 25–29 (citing Ex. 1010 ¶¶ 22, 28, 38, 39, 41, 56, 69, 71, 73, 74; Ex. 1003 ¶¶ 147–169).

Petitioner's arguments and evidence are sufficient for institution.

Patent Owner does not argue or otherwise contest Petitioner's contentions for claims 3–6 and 8–18. *See generally* Prelim. Resp.

On this record, we find that Petitioner has established a reasonable likelihood of establishing that claims 3–6 and 8–10 would be unpatentable over Muskin and Allen.

J. Ground 2: Alleged Obviousness Based on Muskin, Allen, Ellis

Petitioner asserts unpatentability of claim 7 under § 103 over Muskin, Allen, and Ellis, which is § 102 prior art. *See* Pet. 2, 29–34. Petitioner cites Ellis to teach a system and method that process and manage wagering credits by queueing messages if an account management server is unavailable and dequeueing messages when the server is available so wagering transactions are not lost. Pet. 29–34 (citing Ex. 1012, 1:27–30, 7:16–32, 8:15–22, Fig. 1; Ex. 1003 ¶¶ 171–180). Petitioner asserts that a skilled artisan would have queued messages in the Muskin-Allen combination to avoid losing wagering transactions during interrupted connections of the account management system as Ellis teaches. Mr. Crane's testimony supports these contentions. *See* Pet. 30–31 (citing Ex. 1012, 8:17–22; Ex. 1003 ¶¶ 171, 173). We find Petitioner's contentions and evidence are sufficient for institution.

Patent Owner does not dispute Petitioner's contentions for claim 7. *See generally* Prelim. Resp. On this record, we find that Petitioner has established a reasonable likelihood of establishing that claim 7 would be unpatentable over Muskin, Allen, and Ellis.

K. Ground 3: Alleged Obviousness Based on Muskin, Herrmann

Petitioner contends that claims 1, 3–6, 8–15, and 17 are unpatentable under 35 U.S.C. § 103 over Muskin and Herrmann, which is § 102 prior art. *See* Pet. 2, 34–44.

1. Herrmann (Ex. 1011)

Herrmann's unified platform and interface allow marketing in casinos and the gaming industries by managing consumer engagement across many networks, applications, platforms, and marketing channels in impactful, profitable ways. Ex. 1011 ¶¶ 2, 9, 10. Users define preferences for content delivery channels and create and associate an external casino account with an online content system. *Id.* ¶¶ 65, 69–71, Fig. 5.

> When a user creates an online account, Herrmann's interface 306 can
>
> a) determine the existence of an account within the casino management system for the user that is initiating the [online] registration b) *if an account does not exist*, [create] a new player club account in the casino management system [and] c) communicat[e] the id of that player account, as identified by the casino management system, to the online system.

Id. ¶ 79 (emphasis added), Fig. 3. Different interfaces can transfer account data between online and casino accounts. *Id.* ¶¶ 258–289, 302–306. Casino preferences are provided to transfer data to accounts at online systems.

> For example, casino management system "A" may only allow data to be loaded, processed and updated by it initiating a connection to the online system's FTP component and it transferring that data in a "batch" format. In another example, casino management system "B" may prefer data to be transferred in real time, using a SOAP protocol, with requests for data being initiated by the online system.

Id. ¶ 304. Account data may be transferred from online accounts to casino management systems using such protocols. *Id.* ¶ 305. A SOAP interface can be used to communicate with a casino management system to transfer account data. *Id.* ¶ 261. FTP and other interfaces (e.g., XML, HTTP) can be used to transfer data between online and casino systems. *Id.* ¶¶ 263–271.

2. Motivation to Combine Muskin and Herrmann

Petitioner contends that a skilled artisan would have been motivated to combine Herrmann's interface preferences with Muskin as a combination of prior art elements by their known functions to yield predictable results that create a better user experience and allow a user to create and/or associate online and casino accounts where both references associate accounts in land-based casinos and online systems seamlessly for more revenue and returns on investment with a reasonable expectation of success. Pet. 35–36 (citing Ex. 1011 ¶¶ 8, 62, 76, 77, Fig. 2; Ex. 1003 ¶¶ 181–189).

3. Independent Claim 1

Petitioner uses Muskin to teach every limitation except 1[c] and 1[d] as for Ground 1. Pet. 37. Petitioner cites Herrmann with Muskin to teach limitations 1[c] and 1[d]. *Id.* at 37–39. Petitioner asserts that Herrmann registers and associates online accounts with external casino accounts that are identified with a user. *Id.* at 37 (citing Ex. 1011 ¶¶ 11, 30, 33; Ex. 1003 ¶¶ 193–196). Petitioner asserts that Herrmann's interface 306 between an online system and casino management system is an application server that (1) determines whether an account exists in the casino management system for a user who registers an online account and (2) if a casino account does not exist, creates a player account in the casino management system, and (3) communicates the ID of the new casino account to the online system. *Id.* at 37–38 (citing Ex. 1011 ¶ 79; Ex. 1003 ¶ 194). Mr. Crane offers supporting testimony. Ex. 1003 ¶¶ 190–201. Petitioner asserts that a skilled artisan would have combined Herrmann with Muskin to create and associate online and casino accounts seamlessly to share content. *Id.* at 38–39 (citing Ex. 1003 ¶ 195). We find the contentions and evidence sufficient for institution.

4. Dependent Claim 3–6 and 8–10

Petitioner relies on Muskin to teach claims 3–6 and 8–10 for the same reasons as Ground 1 and render those claims obvious with Herrmann for the same reasons as claim 1. Pet. 39 (citing Ex. 1003 ¶¶ 105–114, 131–142, 190–201, 202–209). Mr. Crane testifies in support. Ex. 1003 ¶¶ 202–209. We find Petitioner's contentions and evidence sufficient for institution.

5. Independent Claim 11

Petitioner contends that Muskin teaches or suggests limitations 11[a], 11[b], 11[e], and 11[f] for the same reasons that Muskin taught the similar limitations 1[a], 1[b], 1[e], and 1[f] for Ground 1. Pet. 40–44. Mr. Crane provides supporting testimony to the same effect. Ex. 1003 ¶¶ 108–114, 201, 202, 210–225.

Petitioner asserts that Herrmann's system can be operated as part of another system such as a partner integration management system of a casino management system and accessed through public or private networks to provide content based on a communication preference of a user identity using delivery channels that convey communications/content to the user. Pet. 40–42 (citing Ex. 1011 ¶¶ 10, 11, 15, 18, 74, Fig. 5).

Herrmann's system manages the delivery of content with mechanisms for delivering content. Ex. 1011 ¶ 10. Users can configure preferences to deliver content and preferences for a delivery mechanism. *Id.* Users register an account, associate the user account with an external account, and identify channels to convey communications and content to the user. *Id.* ¶ 11. Users define delivery channel preferences in a profile of a user account and an external account generated for the user by an external account generation system such as a casino management system. *Id.* ¶ 15; *see* Pet. 40–41.

Herrmann teaches process 500 for associating external accounts with an online system to deliver user content. Ex. 1011, Fig. 5 (cited in Pet. 42). The process registers a user for an online account, seeks information for existing external user accounts, and associates the existing accounts with the user's new online account. *Id.* ¶ 63, Fig. 5 (steps 502, 504). The process identifies a delivery channel in a user profile for delivering content and then delivers content to a user. *Id.* ¶¶ 65, 67, Fig. 5 (steps 508, 510); Pet. 41–43.

Petitioner contends that a skilled artisan would have understood and found it obvious to use a delivery channel preference based on a user profile as a delivery channel preference of a particular casino management system because the casino would want to use the same user-defined delivery preferences for channel information as the online system to engage customers better. Pet. 41–44 (citing Ex. 1003 ¶¶ 217–222).

Mr. Crane testifies that Muskin and Herrmann teach or suggest to determine by a partner integration management system, a communication preference of a particular casino management system and communicating content based on that communication preference by delivering content on a preferred delivery channel, based on Muskin communicating loyalty credits for the user between an online gaming server and a casino management system and Herrmann communicating such content by a user's preference. Ex. 1003 ¶¶ 215–223 (citing Ex. 1011 ¶¶ 8, 10, 11, 15, 18, 63, 67, 74). We find the contentions and evidence sufficient for institution.

6. Claim 12, 13–15, and 17

Petitioner asserts that Muskin and Herrmann teach creating a casino account in claim 12 for the same reasons as the similar limitations 1[b]–1[d] of claim 1. Pet 44 (citing Ex. 1003 ¶¶ 112–130, 193–198, 226, 227).

Petitioner asserts that the limitations of claims 13–15 and 17 are substantially similar to the limitations of claims 3, 4, 6, and 8, and Muskin teaches or suggests these limitations for the same reasons as Ground 1 for the limitations of claims 3, 4, 6, and 8. Pet. 44 (citing Ex. 1003 ¶¶ 143–148, 153–160, 228–232). We find these contentions sufficient for institution.

7. Patent Owner's Arguments

Patent Owner does not present arguments for Ground 3 apart from arguing that Grounds 3–5 should be denied under 35 U.S.C. § 325(d). *See* Prelim. Resp. 28–46. We address these arguments below.

8. Analysis

On this record, we find that Petitioner has established a reasonable likelihood that claims 1, 3–6, 8–15, and 17 would be unpatentable over Muskin and Herrmann.

L. Ground 4: Alleged Obviousness by Muskin, Allen, Herrmann

Petitioner contends that claims 18, 21, and 22 are unpatentable over the combination of Muskin, Allen, and Herrmann. Pet. 44–54. Petitioner contends that Muskin and Allen are combinable for the reasons provided for Ground 1, and Herrmann is combinable with Muskin-Allen for the reasons provided for Ground 3. Pet. 44–45.

For claim 18, Petitioner asserts Muskin to teach limitations 18[pre], 18[a], 18[b], 18[e], and 18[f] for substantially the same reasons as similar limitations of claim 1 under Ground 1. Petitioner cites Herrmann to teach limitation 18[c] for similar reasons as limitation 11[c] under Ground 3. *Id.* at 45–50. Petitioner cites Muskin and Herrmann with Allen's modules for limitation 18[d]. *Id.* at 48. Petitioner relies on Mr. Crane's supporting testimony. *Id.* at 45–50 (citing Ex. 1003 ¶¶ 136–142, 237–253).

For claims 21 and 22, Petitioner cites Muskin, Allen, and Herrmann to teach synchronous and asynchronous communications supported by the testimony of Mr. Crane. *Id.* at 50–54 (citing Ex. 1003 ¶¶ 254–266).

Patent Owner does not present arguments for Ground 4 apart from arguing that Grounds 3–5 should be denied under 35 U.S.C. § 325(d). *See* Prelim. Resp. 28–46. We address these arguments below.

On this record, we find that Petitioner has established a reasonable likelihood that claims 18, 21, and 22 would be unpatentable over Muskin, Allen, and Herrmann.

M. Ground 5: Alleged Obviousness by Muskin, Herrmann, Ellis

Petitioner contends that claim 16 is unpatentable over Muskin, Herrmann, and Ellis. Petitioner contends that a skilled artisan would have been motivated to combine Herrmann's account interface with Muskin for the reasons set forth in Ground 3 and to queue messages in the Muskin-Herrmann system in the manner taught by Ellis for the reasons set forth in Ground 2. Pet. 54. Petitioner relies on Muskin and Herrmann to teach the limitations of claim 11 from which claim 16 depends for the same reasons as Ground 3 and Ellis to teach the limitations of 16 that are substantially similar to those of claim 7 (i.e., queuing a message with loyalty credit information when the casino management system is not available) for the reasons set forth in Ground 2. *Id.* (citing Ex. 1003 ¶¶ 170–177, 181–189, 267–273).

Patent Owner argues only that Grounds 3–5 should be denied under 35 U.S.C. § 325(d). *See* Prelim. Resp. 28–46. We address these arguments below. On this record, we find that Petitioner has established a reasonable likelihood that claim 16 would be unpatentable over Muskin, Herrmann, and Ellis.

N. Requested Denial of Grounds 3–5 under 35 U.S.C. § 325(d)

Patent Owner asserts that Grounds 3–5 with Muskin and Herrmann are "cumulative grounds [that] should be denied under 35 U.S.C. § 325(d)." Prelim. Resp. 28. We decline to do so for the following reasons.

Section 325(d) provides in pertinent part:

> In determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.

35 U.S.C. § 325(d).

We apply the following two-part framework under § 325(d):

> (1) 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 first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.

Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH, IPR2019-01469, Paper 6, 8 (Feb. 13, 2020) (precedential).

To determine whether the Petition presents "the same or substantially the same" art or arguments previously presented to the Office, we consider the factors set forth in *Becton, Dickinson*.[8] *Id.* at 7 n.8. *Becton, Dickinson* provides a non-exclusive set of factors to use in applying the framework of 35 U.S.C. § 325(d).

[8] *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (Dec. 15, 2017) (precedential as to § III.C.5, first paragraph) ("*Becton, Dickinson*").

Under *Becton, Dickinson*, we consider:

> (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; (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.

See Becton, Dickson, Paper 8 at 17–18.

In assessing the similarity of the prior art and arguments presented to the Office in examination and reexamination, we consider *Becton, Dickinson* factors (a), (b), and (d). If, after our review of factors (a), (b), and (d), we determine that substantially the same art or arguments previously were presented to the Office, we then consider factors (c), (e), and (f) to determine whether Petitioner has demonstrated material error by the Office. *Advanced Bionics*, IPR2019-01469, Paper 6, 10.

1. Similarity of the Prior Art and Arguments

Muskin was presented to the Office during reexamination of the '296 patent as the parties agree. *See* Pet. 79; Prelim. Resp. 31. Patent Owner asserted that Muskin presented a substantial new question of patentability for the then-existing, issued claims of the '296 patent. Ex. 1006, 186–192. Patent Owner asserted that Muskin *anticipated* claims 1–6, 8–15, 17, and 18 of the '296 patent and rendered claims 7, 16, 19, and 20 obvious in view of Niblett and claims 7 and 16 obvious in view of Block. *Id.* at 194–239.

The Examiner "agreed that Muskin raises a substantial new question of patentability with respect to at least claims 1–6, 8–15, 17, and 18 of the '296 patent." *Id.* at 123. The Examiner rejected claims 1–6, 8–15, 17, and 18 under 35 U.S.C. § 102(a)(2) as anticipated by Muskin. *Id.* at 109. The Examiner rejected claims 7, 16, 19, and 20 under 35 U.S.C. § 103 as obvious over Muskin and Niblett. *Id.* at 109–110. After claims 1, 11, and 18 were amended to include limitations that now appear in those claims (Ex. 1002, 1:25–3:12), the Examiner found the claims to be patentable as follows:

> Examiner finds that the prior art references of record in this Reexamination proceeding do not teach the claimed features of ***accessing account information for a user's second account with a casino management system, comprising: determining, by an application server, the user does not have a second account with the casino management system; upon determining, by the application server, that the user does not have a second account with the casino management system, creating, by the application server, a second account with the casino management system for the user*** or ***determining, by a partner integration management system, a communication preference of the particular casino management system based on an identity of the user*** **as in independent claims 11 and 18.** Accordingly, claims 1, 3-18, and 21-22 are confirmed.

Ex. 1006, at 8. These new limitations defined around Muskin and Niblett.

The Petition presents new prior art and arguments for the new claims. Pet. 34–54. The Petition cites Herrmann (Ex. 1011) to teach new limitations 1[c] and 1[d] in combination with Muskin. *Id.* at 34–39. The Petition cites Herrmann for claims 11 and 18 to teach the new communication preferences limitations 11[c], 11[d], 18[c], 18[d] and Allen for claim 18 to teach one or more modules in combination with Muskin and Herrmann. *Id.* at 40–54. For claim 16, the Petition relies on Ellis to teach message queuing. *Id.* at 54.

We agree with Petitioner that the Petition does not present the same or substantially the same art or arguments presented in reexamination because the Examiner did not combine Muskin with Allen or Herrmann to reject any of claims 1, 11, and 18 after amendment as the Petition does. Pet. 81–82.

The Petition asserts Muskin for the limitations of the '296 patent that Muskin disclosed in reexamination *in combination with* teachings of Allen and Herrmann that were not cited in reexamination and are not cumulative of prior art evaluated during reexamination for the new limitations added in reexamination to define around Muskin. These material differences in the claims and prior art are not cumulative of prior art asserted in reexamination.

Patent Owner argues that the Herrmann References[9] were *cited* during reexamination, have similar teachings as Herrmann (Ex. 1011) relied on in the Petition, and claim priority from the same provisional application as Herrmann (Ex. 1011). Prelim. Resp. 31–34. Patent Owner argues that the similarity of the Herrmann References to teachings of Herrmann (Ex. 1011) relied on in the Petition means the Office considered Muskin in combination with Herrmann. *Id.* at 33–35. Patent Owner contends that Herrmann '466 teaches a distributed computer system that provides a clearing house to trade and transfer player credits and points using a web or application server and player delivery and marketing preferences and communication preferences for a user to receive content. Prelim. Resp. 35–40.

[9] A Notice of References Cited from the '296 patent file history (Ex. 1005, 54) was cited in the '296 patent reexamination (Ex. 1006, 310). It cites (1) US 8,246,466, issued August 2012 ("Herrmann '466"); (2) US 8,192,289, issued June 2012 to Herrmann; and (3) US 8,187,087, issued May 2012 to Herrmann (collectively "the Herrmann References"). Ex. 1006, 310.

Yet, the Petition cites Herrmann to teach an application server that determines that a user does not have an account with a casino and upon the determining, creates a user account with the casino management system. Pet. 37–39; Ex. 1003 ¶¶ 193–198. Patent Owner has not identified the same or similar teachings in the Herrmann References or their use in a rejection in reexamination to teach or suggest such a feature. *See* Prelim. Resp. 31–40.

Even if the Herrmann References contain teachings similar to those cited in the Petition for Herrmann (Ex. 1011), there is no evidence that the Examiner considered such teachings during reexamination. Prelim. Resp. 31–40. The Examiner found that Muskin lacked an application server that created an account upon determining a user lacks an account with a casino management system and found claims 1 and 3–10 patentable on that basis. Ex. 1006, 7. The Examiner cited Niblett for "determining a communication preference, [but] the communication preference is not based on an identity of the user" in claims 11–18. Ex. 1006, 7–8 (confirming the patentability of claims 11–18 on this basis). The Examiner did not consider Muskin with any of the Herrmann References to teach or suggest these new limitations.

Nor did Patent Owner argue during the '296 reexamination that the Herrmann References teach a web/application server 1306, account data transfers, or player preferences for delivery mechanisms and marketing channels as Patent Owner now asserts. *See* Prelim. Resp. 34–40; Ex. 1006.

We find no overlap in arguments made during reexamination and the prior art asserted in the Petition. The Herrmann References were not applied or argued during reexamination. They were cited by the Examiner during reexamination only to make them of record without applying their teachings to any original claims or new claims added in reexamination. Ex. 1006, 310.

Petitioner presents new prior art in combination with Muskin and new arguments regarding the limitations that were added during reexamination to define around Muskin. Herrmann, Allen, and Ellis were not considered by the Examiner during reexamination, alone or in combination with Muskin. Herrmann's communication preference for particular casinos that hold user accounts of users of online gaming services is relevant to limitations 11[c], 11[d], 18[c], and 18[d] under our claim construction. The Petition cites Herrmann's casino communication preferences for the communication types of claims 21 and 22. These teachings also are relevant to the patentability of claims 11 and 18 under our claim construction. Pet. 50–54, 76–77.

Our analysis of *Becton, Dickinson* factors (a), (b), and (d) indicates that the Petition asserts prior art with material differences from the prior art that was involved during reexamination. The teachings of Herrmann, Allen, and Ellis are not cumulative of the prior art evaluated during reexamination. Nor do we find any overlap in arguments presented in the Petition regarding the teachings of these references as to the limitations that were added during reexamination to obtain the '296 patent reexamination certificate and any of the arguments considered by the Examiner during reexamination. Petitioner relies on these new teachings in combination with Muskin to present new arguments that were not evaluated during reexamination and do not overlap with arguments made during reexamination.

2. Whether Petitioner demonstrates that the Office erred

In view of our determination that the same or substantially the same prior art and arguments were not presented or considered in reexamination, we do not consider whether the Office erred. *See* Pet. 83.

O. Discretionary Denial under 35 U.S.C. § 314(a)

In view of Petitioner's showing of a reasonable likelihood that at least one claim in each of Grounds 1–5 is unpatentable, we decline to exercise our discretion under 35 U.S.C. § 314(a) to deny institution based on Petitioner's alleged improper incorporation by reference of Mr. Crane's declaration, in Grounds 6–10[10], to establish Pascal's entitlement to priority of Provisional application No. 61/780,874. Prelim. Resp. 24–27, 49–50. Petitioner has provided evidence of priority. Pet. 57–58.

IV. CONCLUSION

For the reasons discussed above, we are persuaded that Petitioner has demonstrated a reasonable likelihood of prevailing in establishing that at least one of claims 1, 3–18, 21, and 22 of the '296 patent is unpatentable.

V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that *inter partes* review of the '296 patent is instituted as to claims 1, 3–18, 21, and 22 on 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, notice is hereby given of the institution of a trial on the grounds of unpatentability authorized above; the trial commences on the entry date of this decision.

[10] We refer to the grounds based primarily on Pascal as Grounds 6–10.

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