

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DK CROWN HOLDINGS INC.,
Petitioner

v.

DIOGENES LIMITED,
Patent Owner.

IPR2023-00262
Patent 9,117,341 B2

**PATENT OWNER'S MOTION TO AMEND
AND REQUEST FOR PRELIMINARY GUIDANCE**

Table of Contents

I.	INTRODUCTION	1
II.	THE SUBSTITUTE CLAIMS SATISFY 37 C.F.R. 42.121	2
A.	REASONABLE NUMBER OF SUBSTITUTE CLAIMS.....	3
B.	THE SUBSTITUTE CLAIMS ARE RESPONSIVE TO THE INSTITUTED GROUNDS	3
C.	THE SUBSTITUTE CLAIMS DO NOT ENLARGE THE SCOPE OF THE ORIGINAL CLAIMS.....	4
D.	THE SUBSTITUTE CLAIMS DO NOT ADD NEW MATTER AND ARE SUPPORTED BY THE ORIGINAL DISCLOSURE AND PRIORITY APPLICATION	5
III.	THE SUBSTITUTE CLAIMS ARE PATENTABLE	21
A.	CLAIM CONSTRUCTION	21
B.	THE PRIOR ART DOES NOT DISCLOSE THE “WAGER” AND “REAL TIME AND CONTINUOUS” LIMITATIONS	23
1.	DeWaal.....	23
2.	Schugar or DeWaal in view of Schugar.....	24
3.	Scott.....	25
IV.	CONCLUSION.....	25
V.	APPENDIX A – LISTING OF PROPOSED SUBSTITUTE CLAIMS....	A-1

LISTING OF EXHIBITS

Exhibit No.	Description
EX2001	U.S. application No. 13/605,813 (the '813 application)
EX2002	U.S. application No. 14/275,136 (the '136 application)
EX2003	Declaration of Olaf Vancura
EX2004	Olaf Vancura CV
EX2005	Olaf Vancura Selected Patents
EX2006	August 30, 2023 Minutoli e-mail to Trials@USPTO.gov
EX2007	U.S. Patent No. 6,726,562
EX2008	U.S. Patent No. 6,173,955
EX2009	U.S. Patent 8,795,055
EX2010	U.S. Pat. No. 8,105,149
EX2011	Exhibit A30 of DraftKings' First Amended Invalidity Contentions
EX2012	Exhibit A14 of DraftKings' Initial Invalidity Contentions

I. INTRODUCTION

Pursuant to 37 C.F.R. § 42.121, Patent Owner (“PO”) submits this Motion to Amend (“MTA”) contingent upon a finding of unpatentability of the original challenged claims. PO also requests that the Board provide preliminary guidance in accordance with the pilot program. PO attaches the proposed substitute claims as Appendix A. PO proposes to substitute independent claim 1 with claim 41, which includes additional limitations not found in the prior art as determined in other non-instituted IPRs filed by the Petitioner. PO proposes to substitute dependent claim 10 for clarity purposes and to update the claim from which it depends.

The MTA and the accompanying declaration of Dr. Olaf Vancura (EX2003) demonstrate that the MTA and substitute claims meet all requirements of 37 C.F.R. § 42.121: each amendment proposes only one substitute claim for each conditionally canceled claim and is responsive to a ground of unpatentability involved in this proceeding, none of the amendments seeks to enlarge the scope of the claims or introduce new subject matter, and the MTA shows the changes sought and support in the original disclosure and the earlier filed disclosure for which benefit of the filing date of the earlier filed disclosure is sought for each substitute claim.

Moreover, although PO should not bear the burden of either persuasion or production regarding the patentability of the substitute claims as a condition of allowance, and the Board may not *sua sponte* question the patentability of the

proposed amended claims, *see Aqua Prods, Inc. v. Matal*, 872 F.3d 1290, 1296 (Fed. Cir. 2017), the MTA and supporting expert declaration demonstrate that the substitute claims are patentable over the references at issue in this case.

To satisfy the requirement of 37 CFR 42.121(a), PO requested a conference call via email on August 30, 2023 with the Board to discuss filing a motion to amend in this case. *See* EX2006. Although a conference call was not scheduled, PO's counsel reviewed orders provided by the Board in other cases concerning Information and Guidance on PO's MTA.

II. THE SUBSTITUTE CLAIMS SATISFY 37 C.F.R. 42.121

Under 35 U.S.C. §316(d)(1)(B), a patent owner may propose a reasonable number of substitute claims for each challenged claim. A patent owner must show that the amendments in the proposed substitute claims are responsive to a ground of unpatentability involved in the trial, do not seek to broaden a challenged claim, and are supported by the filed or earlier filed disclosures. 35 U.S.C. §316(d)(3); 37 C.F.R. § 42.121 (a)(2)).

If a patent owner has met these statutory requirements, then the Board considers whether the substitute claims are unpatentable by a preponderance of the evidence. *Western Digital Corp. v. Spex Tech, Inc.*, IPR2018-00082, paper 13, p. 4 (PTAB April 25, 2018). The Petitioner has the burden to show the amended claims to be unpatentable over the prior art. 35 U.S.C §316(e); *Aqua Products Inc.*, 872

F.3d at 1324. If aware, a patent owner must disclose any information material to patentability to comply with the duty of candor. 37 C.F.R. § 42.11.

A. REASONABLE NUMBER OF SUBSTITUTE CLAIMS

PO proposes only one substitute claim for each conditionally canceled claim, satisfying the general presumption that “only one substitute claim would be needed to replace each challenged claim.” 37 C.F.R. § 42.121(a)(3); Appendix A.

B. THE SUBSTITUTE CLAIMS ARE RESPONSIVE TO THE INSTITUTED GROUNDS

Substitute independent claim 41 is responsive to one or more grounds of unpatentability at issue in this proceeding. *See* 37 C.F.R. §42.121(a)(2)(i). Specifically, Petitioner has asserted that prior art references disclose the elements of original independent claim 1, which this motion conditionally seeks to amend. Compare Petition at 19-48 with Appendix A, *infra*.

Substitute dependent claim 42 corresponds to the original challenged dependent claim 10 and is amended for clarity and to reflect its new dependency from substitute independent claim 41. The dependent claim amendment is also responsive to the grounds of unpatentability because the dependent claim has not been substantively amended. *See Western Digital Corp. v. SPEX Technologies Inc.*, IPR2018-00082, Paper 13, Decision at 8 (PTAB April 25, 2018).

**C. THE SUBSTITUTE CLAIMS DO NOT ENLARGE THE SCOPE
OF THE ORIGINAL CLAIMS**

Substitute independent claim 41 includes additional limitations, to address each prior art ground in the trial, that do not enlarge the scope of the claims in any way. Instead, the amendments shown in substitute independent claim 41 add further limitations to original claim 1 and only narrow the scope of original claim 1. EX2003, ¶55. For example, certain claim 1 “wager” limitations have been narrowed from their original form to include limitations previously held to be missing from DeWaal, even when combined with other references (Schugar, Scott) in IPR2023-00261, IPR2023-00263, IPR2023-00264, and IPR2023-00265. Specifically, the original preamble has been amended to additionally recite “the wagering event comprising a defined number of legs.” The original “receiving a wager” limitation has been narrowed to additionally recite “the wager coinciding with each of the defined number of legs.” Moreover, the original first “identifying” limitation has been narrowed to recite “identifying one or more winners for completed legs of each of the defined number of legs based on the wager...,” which is substantially similar to the first “identifying” limitation previously found missing from DeWaal, even when combined with other references cited by the Petitioner. EX2003, ¶56. The only changes to that limitation are for consistency purposes with the “real time and continuous” limitations mentioned below. Overlapping Board panels previously

held that these similar “wager” limitations were not found in the prior art in other IPRs. *See* IPR2023-00261, paper 8, 11-13; IPR2023-00263, paper 8, 10-13; IPR2023-00264, paper 9, 11-20; IPR2023-00265, paper 9, 13-17.

Substitute claim 41 further narrows the scope of claim 1 by adding three “real time and continuous” limitations 41[c-1] to [c-3]: “continuously receiving data in real time related to the wagering event; recalculating, in real time and based on the continuously received data, wager information for one or more wagers associated with players participating in the wagering event; [and] continuously evaluating the recalculated wager information.” EX2003, ¶57. An overlapping Board Panel previously held that similar limitations were not found in the Scott reference. *See* IPR2023-00268, paper 9, 12-20.

**D. THE SUBSTITUTE CLAIMS DO NOT ADD NEW MATTER
AND ARE SUPPORTED BY THE ORIGINAL DISCLOSURE
AND PRIORITY APPLICATION**

Support for each substitute claim is found in the original filed disclosure of the ’341 patent, and also in an earlier filed disclosure for which benefit of the filing date of the earlier filed disclosure is sought. *See* 37 C.F.R. §§ 42.121(b)(1)-(2). The ’341 patent issued from application No. 14/275,136 (’136 application) (EX2002), filed May 12, 2014, which is a continuation of application No. 13/958,028, filed on Aug. 2, 2013, now Pat. No. 8,721,439, which is a continuation-in-part of application No. 13/605,813 (’813 application) (EX2001), filed on Sep. 6, 2012, now Pat. No.

8,602,884. These applications share substantially the same disclosure with respect to the relevant claim limitations discussed herein. Written description support for each of the substitute claims including the additional elements of the substitute claims is provided below with reference to the original filed disclosure of the '136 application (EX2002) and the earlier filed disclosure of the priority '813 application (EX2001). *See also* EX2003, ¶¶69-86.

Claim Limitation	Support in the '136 and '813 applications
41 [pre] A method of conducting a wagering event for one or more players, <u>the wagering event comprising a defined number of legs</u> , wherein a player is presented with at least one of a buy-out offer and a partial buy-out offer prior to completion of the wagering event, the method comprising the steps of:	The present invention is directed to ... a unique pool betting product where players make selections in a number of different events which occur in sequential legs or time periods. EX2001, 2:15-17. A unique differentiator of the pool product of the present invention is that after some and preferably most of the legs have been completed, players who have correct (win) predictions for each of the events or legs that are completed and thus remain in contention for the Jackpot Pool ..., will be offered an opportunity to sell their tickets (in whole or in part)... Thus for example the game operator will offer the player a fractional amount of the potential Jackpot Pool to buy the ticket for the still pending game(s) and thereby provide the player the opportunity to cash in and avoid the risk of being eliminated on a later leg or the final event. EX2001, 2:29-3:7; <i>see also</i> 12:17-26, 15:8-12. The present disclosure is directed to ... a unique betting product where players make selections in a number of different legs which, as defined below, can include any of a variety of different discrete events (e.g., an auto race), partial events (e.g., an inning of a baseball game, a set in tennis), components of events (e.g., one or more at bats by a particular player in baseball game or numbers selected in a particular position in a lottery drawing), multiple

Claim Limitation	Support in the '136 and '813 applications
	independent events (e.g., two football games that may occur sequentially or concurrently) and/or compilations of events (e.g., a championship series). EX2002, [0005]. ...A unique differentiator of the product of the present disclosure may be that at any desired time after initiation of an event (such as at any time after a "ticket" is purchased until completion of an event, after each leg has been completed, between legs, including potentially as a leg is "in-play", and/or during a designated span of time before, during and/or after any of the legs), any desired number of players who remain eligible for a prize ...or to win or have correct (win) predictions for each of the events or legs that are completed, may be offered a "buy-out" or an opportunity to sell their tickets (in whole or alternatively may be in part (i.e., a fractional amount) ... Thus, for example, the game operator (or any other entity) may offer the player a fractional amount of the potential Jackpot Pool to buy the ticket for the still pending game(s) and thereby provide the player the opportunity to cash in and avoid the risk of being eliminated on a later leg or the final event. EX2002, [0008]; <i>see also</i> [0048], [0049].
41[a] providing one or more wagering input devices in communication with a system controller through which <u>the</u> one or more players may participate in a wagering event, said system controller being adapted for:	... The system includes a network, based on a central server system 12 being interconnected through the internet 10 to a plurality of wager input devices such as wagering stations 14, wagering terminals 16, and internet connected computing systems 18, smart phones 20, tablet computers 22 and televisions 24 each of which is representative of a plurality of each type of wager input device (e.g. wagering stations 14 A-N). As will also be discussed below, the concepts herein may also be applied to gaming machines, so gaming machine 26 is depicted as an additional input device to the central server system 12 in FIG. 1. EX2001, 4:2-11; <i>see also</i> 7:5-8, 12:13-16, FIG. 1. ... The system includes a network, including a system controller, for example, such as based on a central server system 12 being interconnected through the internet 10 to

Claim Limitation	Support in the '136 and '813 applications
	a plurality of wager input devices such as wagering stations 14, wagering terminals (including self-service wagering terminals) 16, and internet connected computing systems 18, smart phones 20, tablet computers 22 and televisions 24 each of which is representative of a plurality of each type of wager input device (e.g. wagering stations 14A-N). ... As will also be discussed below, the concepts herein may also be applied to gaming machines, so gaming machine 26 is depicted as an additional input device to the central server system 12 in Fig. 1. EX2002, [0016]; <i>see also</i> [0024], [0040], FIG. 1.
41[b] initiating the wagering event for <u>the</u> one or more players;	...a central server system controller configured to communicate with the at least one wagering device, said central server system controller programmed to: initiate a multi-leg event pool by the generation of a game having a series of events, the correct selection of the results of the series of the events resulting in the award of at least a portion of a jackpot, and accepting bets on the multi-leg event from players. EX2001, original claim 1; <i>see also</i> 7:5-8, 12:13-16, 11:18-24. ...providing one or more wagering input devices in communication with a system controller through which one or more players may participate in a wagering event, said system controller being adapted for: initiating the wagering event for one or more players. EX2002, original claim 1; <i>see also</i> [0024], [0038], [0040].
41[c] receiving a wager via the one or more wagering input devices in response to a player desiring to participate in the wagering event, <u>the wager coinciding with each of the defined number of legs;</u>	The present invention is directed to ... a unique pool betting product where players make selections in a number of different events which occur in sequential legs or time periods. Those players who correctly select all of the winners of each leg have an opportunity to share the proceeds of the stakes of all the other players, less a deduction to cover operating costs and operator profit, and have the opportunity to win a Jackpot Pool and potentially a Bonus Pool and Consolation Pool. EX2001, 2:15-20.

Claim Limitation	Support in the '136 and '813 applications
	The wagering stations 14 may be configured so that users can be the party placing a wager, while the wagering terminals 16 may be configured for an operator at a commercial location such as a store or betting facility. EX2001, 4:15-18. The present disclosure is directed to ... a unique betting product where players make selections in a number of different legs which, as defined below, can include any of a variety of different discrete events (e.g., an auto race), partial events (e.g., an inning of a baseball game, a set in tennis), components of events (e.g., one or more at bats by a particular player in baseball game or numbers selected in a particular position in a lottery drawing), multiple independent events (e.g., two football games that may occur sequentially or concurrently) and/or compilations of events (e.g., a championship series). Those players who correctly select all (or some predefined portion) of the winners of each leg have an opportunity to solely obtain and/or share in the proceeds of the stakes of all the other players, less any applicable deduction to cover operating costs and/or operator profit, and have the opportunity to win a prize. For example, in multi-leg event pools, prizes may include without limit a full or fractional portion of a Jackpot Pool..., potentially a Bonus Pool ... and/or a possible Consolation Pool EX2002, [0005]. The wagering stations 14 may be configured so that users can be the party placing a wager, while the wagering terminals 16 may be configured for an operator at a commercial location such as a store or betting facility. EX2002, [0017].
41[c-1] <u>continuously receiving data in real time related to the wagering event;</u>	It is also contemplated that the server system 12 will have the ability to receive additional data via the input device 26, for example various odds on respective wagers concerning the sporting match or event, that may impact the attributed value calculated for any given ticket. That additional information could be used to calculate with

Claim Limitation	Support in the '136 and '813 applications
	greater precision the potential odds, and attributed value, of the remaining tickets after each round or leg of the pool. EX2001, 15:13-18. It is also envisioned that cash-in buy back may also operate during live play and offer continuous cash-in ability as soon as it is technically possible, for example at the half-time of a match or during the running of a match when possible. EX2001, 22:13-15. It is further contemplated that the ability to trade or sell your tickets back to the system operator will be continuous and in these circumstances, the bid will be extremely time sensitive. Additionally, as discussed above the player or ticket holder will have the option to sell a fraction of his ticket to the system operator. EX2001, 22:29-23:2. It is also contemplated that the server system 12 will have the ability to receive additional data via the input device 26, for example various odds on respective wagers concerning the sporting match or event, that may impact the attributed value calculated for any given ticket. That additional information could be used to calculate with greater precision the potential odds, and attributed value, of the remaining tickets after each round or leg of the pool. EX2002, [0050]. It is also envisioned that cash-in buy back may also operate during live play and offer continuous cash-in ability as soon as it is technically possible, for example at the half-time of a match or during the running of a match when possible. EX2002, [0071]. It is further contemplated that the ability to trade or sell tickets back to the system operator may be continuous, and also in these circumstances, the bid may be extremely time sensitive. Additionally, as discussed above, the player or ticket holder may have the option to sell a fraction of their

Claim Limitation	Support in the '136 and '813 applications
	ticket to the system operator or other third party. EX2002, [0072].
41[c-2] <u>recalculating, in real time and based on the continuously received data, wager information for one or more wagers associated with players participating in the wagering event;</u>	It is also contemplated that the server system 12 will have the ability to receive additional data via the input device 26, for example various odds on respective wagers concerning the sporting match or event, that may impact the attributed value calculated for any given ticket. That additional information could be used to calculate with greater precision the potential odds, and attributed value, of the remaining tickets after each round or leg of the pool. EX2001, 15:13-18. It is also envisioned that cash-in buy back may also operate during live play and offer continuous cash-in ability as soon as it is technically possible, for example at the half-time of a match or during the running of a match when possible. EX2001, 22:13-15. It is further contemplated that the ability to trade or sell your tickets back to the system operator will be continuous and in these circumstances, the bid will be extremely time sensitive. Additionally, as discussed above the player or ticket holder will have the option to sell a fraction of his ticket to the system operator. EX2001, 22:29-23:2. It is also contemplated that the server system 12 will have the ability to receive additional data via the input device 26, for example various odds on respective wagers concerning the sporting match or event, that may impact the attributed value calculated for any given ticket. That additional information could be used to calculate with greater precision the potential odds, and attributed value, of the remaining tickets after each round or leg of the pool. EX2002, [0050]. It is also envisioned that cash-in buy back may also operate during live play and offer continuous cash-in ability as soon as it is technically possible, for example at the half-

Claim Limitation	Support in the '136 and '813 applications
	time of a match or during the running of a match when possible. EX2002, [0071]. It is further contemplated that the ability to trade or sell tickets back to the system operator may be continuous, and also in these circumstances, the bid may be extremely time sensitive. Additionally, ...the player or ticket holder may have the option to sell a fraction of their ticket to the system operator or other third party. EX2002, [0072].
41[c-3] <u>continuously evaluating the recalculated wager information;</u>	It is also contemplated that the server system 12 will have the ability to receive additional data via the input device 26, for example various odds on respective wagers concerning the sporting match or event, that may impact the attributed value calculated for any given ticket. That additional information could be used to calculate with greater precision the potential odds, and attributed value, of the remaining tickets after each round or leg of the pool. EX2001, 15:13-18. It is also envisioned that cash-in buy back may also operate during live play and offer continuous cash-in ability as soon as it is technically possible, for example at the half-time of a match or during the running of a match when possible. EX2001, 22:13-15. It is further contemplated that the ability to trade or sell your tickets back to the system operator will be continuous and in these circumstances, the bid will be extremely time sensitive. Additionally, as discussed above the player or ticket holder will have the option to sell a fraction of his ticket to the system operator. EX2001, 22:29-23:2. It is also contemplated that the server system 12 will have the ability to receive additional data via the input device 26, for example various odds on respective wagers concerning the sporting match or event, that may impact the attributed value calculated for any given ticket. That additional information could be used to calculate with

Claim Limitation	Support in the '136 and '813 applications
	greater precision the potential odds, and attributed value, of the remaining tickets after each round or leg of the pool. EX2002, [0050]. It is also envisioned that cash-in buy back may also operate during live play and offer continuous cash-in ability as soon as it is technically possible, for example at the half-time of a match or during the running of a match when possible. EX2002, [0071]. It is further contemplated that the ability to trade or sell tickets back to the system operator may be continuous, and also in these circumstances, the bid may be extremely time sensitive. Additionally, ... the player or ticket holder may have the option to sell a fraction of their ticket to the system operator or other third party. EX2002, [0072].
41[d] identifying one or more <u>winners for completed legs of each of the defined number of legs based on the wager</u> ~~players eligible to win~~ from among <u>the</u> players participating in the wagering event;	A unique differentiator of the pool product of the present invention is that after some and preferably most of the legs have been completed, players who have correct (win) predictions for each of the events or legs that are completed and thus remain in contention for the Jackpot Pool ..., will be offered an opportunity to sell their tickets (in whole or in part) ... EX2001, 2:29-3:4. After some percentage... of the sporting events have occurred, the server system 12 will be configured to identify the remaining potential winning ticket or tickets for the Jackpot Pool, i.e. those tickets that have correctly selected each of the results of the events of the completed legs. Upon determining the number of remaining potential winners of the Jackpot Pool, the system will determine the likelihood of each ticket winning the Jackpot Pool, and on that basis make a determination as to the attributed value of the ticket based on its respective probability of winning the Jackpot Pool. The server system 12 then makes the determination of what the appropriate amount would be for an offer to buy-out all, or potentially a portion of, each or

Claim Limitation	Support in the '136 and '813 applications
	all of the remaining potentially winning tickets. EX2001, 14:7-16. It is also envisioned that cash-in buy back may also operate during live play and offer continuous cash-in ability as soon as it is technically possible, for example at the half-time of a match or during the running of a match when possible. EX2001, 22:13-15. It is further contemplated that the ability to trade or sell your tickets back to the system operator will be continuous and in these circumstances, the bid will be extremely time sensitive. Additionally, as discussed above the player or ticket holder will have the option to sell a fraction of his ticket to the system operator. EX2001, 22:29-23:2. A unique differentiator of the product of the present disclosure may be that at any desired time after initiation of an event (such as at any time after a “ticket” is purchased until completion of an event, after each leg has been completed, between legs, including potentially as a leg is “in-play”, and/or during a designated span of time before, during and/or after any of the legs), any desired number of players who remain eligible for a prize ... or to win or have correct (win) predictions for each of the events or legs that are completed, may be offered a “buy-out” or an opportunity to sell their tickets (in whole or alternatively may be in part (i.e., a fractional amount)...EX2002, [0008]. After some percentage... of the sporting events have occurred, the server system 12 may be configured to identify the remaining potential winning ticket or tickets for the Jackpot Pool, i.e., those tickets that have correctly selected each of the results ... of the events of the completed legs, or remain eligible for the consolation prize for selecting a certain percentage of the actual winners.... Upon determining the number of remaining potential

Claim Limitation	Support in the '136 and '813 applications
	winners of the Jackpot Pool, the system will determine the likelihood of each ticket winning the Jackpot Pool ..., and on that basis make a determination as to the attributed value of the ticket based on its respective probability of winning the Jackpot Pool.... The server system 12 then makes the determination of what the appropriate value would be for a ticket in order to make an offer to buy-out to one or more players.... EX2002, [0046]. It is also envisioned that cash-in buy back may also operate during live play and offer continuous cash-in ability as soon as it is technically possible, for example at the half-time of a match or during the running of a match when possible. EX2002, [0071]. It is further contemplated that the ability to trade or sell tickets back to the system operator may be continuous, and also in these circumstances, the bid may be extremely time sensitive. Additionally, as discussed above, the player or ticket holder may have the option to sell a fraction of their ticket ... EX2002, [0072].
41[e] initiating at least one of a buy-out offer and partial buy-out offer to any number of the one or more <u>winners based on said evaluating players that are eligible to win</u>, said buy-out offer or partial buy-out offer being initiated at any time before the wagering event has been completed;	...The Cash-In 422 program is responsible for determining when an offer to buy-out a ticket holder will be made, and the price that will be offered. Within the Cash-In 422 program, the Offers Generation 452 routine is the trading engine that, when triggered, will generate a set of offers over all of the tickets that are still potential winners and then publish the offers and receive/process the acceptance of these offers via the Merchant API 420. EX2001, 8:23-28. After some percentage... of the sporting events have occurred, the server system 12 will be configured to identify the remaining potential winning ticket or tickets for the Jackpot Pool, i.e. those tickets that have correctly selected each of the results of the events of the completed legs. Upon determining the number of remaining potential winners of the Jackpot Pool, the system will determine the

Claim Limitation	Support in the '136 and '813 applications
	likelihood of each ticket winning the Jackpot Pool, and on that basis make a determination as to the attributed value of the ticket based on its respective probability of winning the Jackpot Pool. The server system 12 then makes the determination of what the appropriate amount would be for an offer to buy-out all, or potentially a portion of, each or all of the remaining potentially winning tickets. EX2001, 14:7-16; <i>see also</i> 14:17-26. ... The Cash-In 422 program is responsible for determining when an offer to buy-out a ticket holder will be made, and the price that will be offered. Within the CashIn 422 program, the Offers Generation 452 routine is the trading engine that, when triggered, will generate a set of offers over all of the tickets that are still potential winners and then publish the offers and receive/process the acceptance of these offers via the Merchant API 420. EX2002, [0029]. After some percentage... of the sporting events have occurred, the server system 12 may be configured to identify the remaining potential winning ticket or tickets for the Jackpot Pool, i.e., those tickets that have correctly selected each of the results... of the events of the completed legs, or remain eligible for the consolation prize for selecting a certain percentage of the actual winners.... Upon determining the number of remaining potential winners of the Jackpot Pool, the system will determine the likelihood of each ticket winning the Jackpot Pool..., and on that basis make a determination as to the attributed value of the ticket based on its respective probability of winning the Jackpot Pool.... The server system 12 then makes the determination of what the appropriate value would be for a ticket in order to make an offer to buy-out to one or more players.... EX2002, [0046]; <i>see also</i> [0048].
41[f] identifying any acceptances of said at least one of a buy-out offer and partial	The Available offers POST 434 routine is used to determine what bet trading offers are currently available to the customer. The Accept Offer POST 436 routine is used

Claim Limitation	Support in the '136 and '813 applications
buy-out offer that have been initiated;	to accept an offer. The Decline Offer POST 438 routine is used to decline an offer. EX2001, 8:6-8; 8:25-29, 20:4-10. The Available offers POST 434 routine is used to determine what bet trading offers are currently available to the customer. The Accept Offer POST 436 routine is used to accept an offer. The Decline Offer POST 438 routine is used to decline an offer. EX2002, [0027]; [0029], [0065].
41[g] completing the wagering event; and	j) receive input on the completion of the final events/legs of the pool; k) distribute the Jackpot Pool to holders of the winning active ticket(s). EX2001, 24:21-22. j) receive input on the completion of the final events/legs of the pool; k) distribute the Jackpot Pool to holders of the winning active ticket(s). EX2002, [0076].
41[h] determining if any of the players have won.	j) receive input on the completion of the final events/legs of the pool; k) distribute the Jackpot Pool to holders of the winning active ticket(s). EX2001, 24:21-22. j) receive input on the completion of the final events/legs of the pool; k) distribute the Jackpot Pool to holders of the winning active ticket(s). EX2002, [0076].
42[a] The method of claim [[1]] 41, wherein the multi outcome wagering event comprises one or more virtual games, said method further comprising:	The display devices of the gaming device are configured to display at least one and preferably a plurality of game or other suitable images, symbols and indicia such as any visual representation or exhibition of the movement of objects such as mechanical, virtual or video reels and wheels, dynamic lighting, video images, images of people, characters, places, things and faces of cards, and the like. EX2010 (U.S. Pat. No. 8,105,149), 12:8-14 (incorporated by reference at EX2001, 25:3-14 and EX2002, [0079]).

Claim Limitation	Support in the '136 and '813 applications
	In one embodiment, a base or primary game may be a poker game wherein the gaming device enables the player to play a conventional game of video draw poker EX2010 (U.S. Pat. No. 8,105,149), 16:60-64 (incorporated by reference at EX2001, 25:3-14 and EX2002, [0079]).
42[b] initiating the buy-out offer prior to completion of the one or more virtual games, but after an outcome of the one or more virtual games has been determined,	After some percentage... of the sporting events have occurred, the server system 12 will be configured to identify the remaining potential winning ticket or tickets for the Jackpot Pool, i.e. those tickets that have correctly selected each of the results of the events of the completed legs. Upon determining the number of remaining potential winners of the Jackpot Pool, the system will determine the likelihood of each ticket winning the Jackpot Pool, and on that basis make a determination as to the attributed value of the ticket based on its respective probability of winning the Jackpot Pool. The server system 12 then makes the determination of what the appropriate amount would be for an offer to buy-out all, or potentially a portion of, each or all of the remaining potentially winning tickets. EX2001, 14:7-16; <i>see also</i> 8:23-28, 14:17-26. ... the slot machine could be programmed such that once a first level of jackpot indicators appear in a winning sequence according to a first random number generation, the selection and display of the remaining indicator is paused and an offer to buy-out the player is presented. For example, a person with four "\$" on the first four reels and the last real spinning is one step from a jackpot, (e.g. \$2,000,000) and if the machine has a 20/1 odds to get the last real on a "\$" then the operator would offer to buy-the spin for \$100,000, or any fraction of it for the proportionate amount.... EX2001, 25:15-25; <i>see also</i> 26:23-26. After some percentage... of the sporting events have occurred, the server system 12 may be configured to identify the remaining potential winning ticket or tickets for the Jackpot Pool, i.e., those tickets that have correctly selected each of the results ... of the events of the

Claim Limitation	Support in the '136 and '813 applications
	completed legs, or remain eligible for the consolation prize for selecting a certain percentage of the actual winners.... Upon determining the number of remaining potential winners of the Jackpot Pool, the system will determine the likelihood of each ticket winning the Jackpot Pool..., and on that basis make a determination as to the attributed value of the ticket based on its respective probability of winning the Jackpot Pool The server system 12 then makes the determination of what the appropriate value would be for a ticket in order to make an offer to buy-out to one or more players.... EX2002, [0046]; <i>see also</i> [0029], [0048]. ...the slot machine could be programmed such that once a first level of jackpot indicators appear in a winning sequence according to a first random number generation, the selection and display of the remaining indicator or indicators is paused and an offer to buy-out the player is presented. For example, a person with four "\$" on the first four reels and the last reel spinning is one step from a jackpot, (e.g. \$2,000,000) and if the machine has a 20/1 odds to get the last reel on a "\$" then the operator could offer to buy-the spin for \$100,000, or any fraction of it for the proportionate amount.... EX2002, [0080]; [0083].
42[c] said buy-out offer including a price that is at least partially based on random-number-generated <u>probabilities outcomes</u>.	After some percentage... of the sporting events have occurred, the server system 12 will be configured to identify the remaining potential winning ticket or tickets for the Jackpot Pool, i.e. those tickets that have correctly selected each of the results of the events of the completed legs. Upon determining the number of remaining potential winners of the Jackpot Pool, the system will determine the likelihood of each ticket winning the Jackpot Pool, and on that basis make a determination as to the attributed value of the ticket based on its respective probability of winning the Jackpot Pool. The server system 12 then makes the determination of what the appropriate amount would be for an offer to buy-out all, or potentially a portion of, each or all of the remaining potentially winning tickets. EX2001, 14:7-16; <i>see also</i> 8:23-28, 14:17-26.

Claim Limitation	Support in the '136 and '813 applications
	...the slot machine could be programmed such that once a first level of jackpot indicators appear in a winning sequence according to a first random number generation, the selection and display of the remaining indicator is paused and an offer to buy-out the player is presented. For example, a person with four "\$" on the first four reels and the last reel spinning is one step from a jackpot, (e.g. \$2,000,000) and if the machine has a 20/1 odds to get the last reel on a "\$" then the operator would offer to buy-the spin for \$100,000, or any fraction of it for the proportionate amount.... EX2001, 25:15-25; <i>see also</i> 26:23-26. After some percentage... of the sporting events have occurred, the server system 12 may be configured to identify the remaining potential winning ticket or tickets for the Jackpot Pool, i.e., those tickets that have correctly selected each of the results ... of the events of the completed legs, or remain eligible for the consolation prize for selecting a certain percentage of the actual winners.... Upon determining the number of remaining potential winners of the Jackpot Pool, the system will determine the likelihood of each ticket winning the Jackpot Pool..., and on that basis make a determination as to the attributed value of the ticket based on its respective probability of winning the Jackpot Pool.... The server system 12 then makes the determination of what the appropriate value would be for a ticket in order to make an offer to buy-out to one or more players.... EX2002, [0046]; <i>see also</i> [0029], [0048]. ...the slot machine could be programmed such that once a first level of jackpot indicators appear in a winning sequence according to a first random number generation, the selection and display of the remaining indicator or indicators is paused and an offer to buy-out the player is presented. For example, a person with four "\$" on the first four reels and the last reel spinning is one step from a jackpot, (e.g. \$2,000,000) and if the machine has a 20/1

Claim Limitation	Support in the '136 and '813 applications
	odds to get the last reel on a "\$" then the operator could offer to buy-the spin for \$100,000, or any fraction of it for the proportionate amount.... EX2002, [0080]; [0083].

III. THE SUBSTITUTE CLAIMS ARE PATENTABLE

A. CLAIM CONSTRUCTION

PO and its expert agree with the overlapping Board Panel’s construction that “‘continuously’ performing a task ... exclude[s] performing that task at discrete time points.” IPR2023-00268, paper 9, 10; EX2003, ¶¶58-61. PO also agrees with prior Board Panels that “the wager (1) enters the player into the event (and thus, is set before the event) and (2) is of a nature such that it serves as the metric by which the player is evaluated at each leg to determine whether they remain eligible to win the event.” *See* IPR2023-00261, paper 8, 7-8; IPR2023-00263, paper 8, 7-8; IPR2023-00264, paper 9, 7-8; IPR2023-00265, paper 9, 11-12; EX2003, ¶¶62-65.

PO submits that no other construction of the claims as amended is required. This Board, however, “encourage[d] further briefing on the construction of the ‘at least one of’ term during trial.” Institution Decision, 6-7 (referring to the language “at least one of a buy-out offer and partial buy-out offer”). PO submits that the construction of the “at least one of” term is not needed to render a decision in this proceeding as the amended claims have multiple other limitations not present in the prior art. *See, e.g.*, IPR2023-00261, paper 8, 11-13; IPR2023-00263, paper 8, 10-13; IPR2023-00264, paper 9, 11-20; IPR2023-00265, paper 9, 13-17; IPR2023-00268,

paper 9, 12-20; EX2003, ¶¶66-67. Nevertheless, PO submits the following:

Claim Term	Petitioner’s Proposed Construction	PO’s Proposed Construction
“at least one of a buy-out and partial buy-out”	“the presentation of both a buy-out offer and a partial buy-out offer that a player can alternatively select, or accept or decline” Petition, 11-12.	“the ability to offer a full buy-out and partial buy-out”

PO disagrees with Petitioner that there have been “plain and unmistakable statements of disavowal of claim scope made by Applicant during the prosecution of the ’341 Patent” limiting the “at least one of” term to “the presentation of both a buy-out offer *and* a partial buy-out offer that a player can alternatively select, or accept or decline.” Petition, 11-12. Petitioner alleges that these statements were made to overcome a rejection based on the Acres reference. Petition, 9-11. PO acknowledges that the Examiner rejected the claims of the ’341 patent over Acres, arguing that Acres disclosed a “full” buy-out alone. Petition, 9-11. PO overcame this rejection by arguing that “Claim 1, for example, recites a unique *ability* to offer both a buy-out offer and a partial buy-out offer to any number of players that are involved in a wagering event.” EX[1002], 86 (bolding added). PO reiterated that “Acres fails to disclose or even contemplate the claimed *capability* to provide both a ‘buy-out’ and ‘partial buy-out’ feature”” and further argued that “Acres does not appear to disclose the claimed feature of a ‘partial buy-out’ and ‘buy-out’ that *may be* offered

as alternatives to players.” *Id.* at 86-87 (emphasis added). The bolded language in these statements are consistent with PO’s proposed construction.

PO never argued that a buy-out and partial buy-out “must” be presented as alternatives—instead, PO argued that the buy-outs “*may* be offered as alternatives.” EX[1002], 87 (emphasis added). Thus, the record fails to support Petitioner’s proposed construction requiring both full *and* partial buy-outs to be presented so that a player can alternatively select, or accept or decline. The plain language of the record supports a system that has the *ability* to offer both a full and a partial buy-out, regardless of the offer actually conveyed (*e.g.*, full buy-out, partial buy-out, or both).

**B. THE PRIOR ART DOES NOT DISCLOSE THE “WAGER” AND
“REAL TIME AND CONTINUOUS” LIMITATIONS**

The substitute claims further limit original claim 1 by reciting revised “wager” limitations and newly added “real time and continuous” processing steps. None of the prior art of record or otherwise known to PO, even if combined, teach or suggest the amended limitations. EX2003, ¶87. PO notes that it is Petitioner’s burden to establish that the substitute claims are unpatentable – it is not the PO’s burden to establish that the substitute claims are patentable. PO reserves the right to submit remarks and expert testimony in response to new arguments raised in any opposition to this motion. PO is not aware of any information material to patentability.

1. DeWaal

DeWaal does not teach or suggest the “wager” limitations of the substitute claims. EX2003, ¶¶90, 111-116; IPR2023-00261, paper 8, 11-13; IPR2023-00263, paper 8, 10-13; IPR2023-00264, paper 9, 11-20; IPR2023-00265, paper 9, 13-17. Moreover, DeWaal does not disclose the “real time and continuous” limitations. EX2003, ¶¶90, 117-119. Petitioner is expected to argue that DeWaal discloses these limitations because, in one embodiment, “each individual gaming device randomly generates the game outcomes” and a central server or controller exists “for monitoring purposes only.” EX2011, 190-192. But any such monitoring of DeWaal’s discrete activity (e.g., after each round, responsive to player input, etc.) fails to disclose or render obvious the “continuously” limitations as properly construed. EX2003, ¶118. By failing to disclose, teach or suggest many of the limitations of the substitute claims, DeWaal cannot anticipate or render obvious the substitute claims. EX2003, ¶119.

2. Schugar or DeWaal in view of Schugar

The Ground 2 combination of DeWaal in view of Schugar does not teach or suggest the “wager” limitations of the substitute claims. EX2003, ¶¶120, 132-133; IPR2023-00261, paper 8, 11-13; IPR2023-00263, paper 8, 10-13; IPR2023-00264, paper 9, 11-20; IPR2023-00265, paper 9, 13-17. DeWaal in view of Schugar does not disclose the “real time and continuous” limitations either. EX2003, ¶¶120, 134-135. Petitioner is expected to argue that Schugar cures DeWaal’s deficiencies

because it allegedly discloses “After each game in the series (and even during particular games), payout odds for each team winning the series can change to reflect the current conditions (as described herein and/or known in the art) and players can make wagers during the series.” EX2011, 191; EX2012, 182-184. But recording game states at discrete points of time, for a later determination that occurs after an event has concluded fails to disclose the “continuously” limitations as properly construed. EX2003, ¶¶134-135. By failing to disclose, teach or suggest many of the limitations of the substitute claims, Schugar cannot cure the deficiencies of DeWaal, nor can it anticipate or render obvious the substitute claims by itself or in combination with other art such as e.g., Scott. EX2003, ¶136.

3. Scott

Scott (EX1006) was not cited in the present IPR, but has been cited in related proceedings IPR2023-00261, IPR2023-00267, and IPR2023-00268. PO submits that the amended claims are allowable over Scott. In particular, the “real time and continuous” limitations are not disclosed by Scott even when viewed in light of knowledge of a POSITA. IPR2023-00268, paper 9, 12-20; EX2003, ¶¶137, 155-160.

IV. CONCLUSION

For each original claim the Board finds unpatentable, PO respectfully requests that the Board grant this motion to amend as to the substitute claim.

Dated: September 29, 2023

Respectfully submitted,

/s/ Gianni Minutoli

Gianni Minutoli

Reg. No. 41,198

DLA Piper LLP (US)

One Fountain Square

11911 Freedom Drive, Suite 300

Reston, Virginia 20190-5602

Tel: (703) 773-4045

Email: gianni.minutoli@dlapiper.com

V. APPENDIX A – LISTING OF PROPOSED SUBSTITUTE CLAIMS

PO presents the following proposed substitute claims in marked-up form with underlining indicating inserted text and brackets or strikethrough indicating deleted text from the original patent claims.

41. (substitute for claim 1, if found unpatentable) A method of conducting a wagering event for one or more players, the wagering event comprising a defined number of legs, wherein a player is presented with at least one of a buy-out offer and a partial buy-out offer prior to completion of the wagering event, the method comprising the steps of:

providing one or more wagering input devices in communication with a system controller through which the one or more players may participate in a wagering event, said system controller being adapted for:

initiating the wagering event for the one or more players;

receiving a wager via the one or more wagering input devices in response to a player desiring to participate in the wagering event, the wager coinciding with each of the defined number of legs;

continuously receiving data in real time related to the wagering event;

recalculating, in real time and based on the continuously received data,
wager information for one or more wagers associated with players participating in
the wagering event;

continuously evaluating the recalculated wager information;

identifying one or more winners for completed legs of each of the defined
number of legs based on the wager ~~players eligible to win~~ from among the players
participating in the wagering event;

initiating at least one of a buy-out offer and partial buy-out offer to any
number of the one or more winners based on said evaluating ~~players that are~~
~~eligible to win~~, said buy-out offer or partial buy-out offer being initiated at any
time before the wagering event has been completed;

identifying any acceptances of said at least one of a buy-out offer and partial
buy-out offer that have been initiated;

completing the wagering event; and

determining if any of the players have won.

42. (substitute for claim 10, if found unpatentable) The method of claim
[[1]] 41, wherein the multi outcome wagering event comprises one or more virtual
games, said method further comprising:

initiating the buy-out offer prior to completion of the one or more virtual
games, but after an outcome of the one or more virtual games has been determined,

said buy-out offer including a price that is at least partially based on random-number-generated ~~probabilities~~ outcomes.

CERTIFICATE OF COMPLIANCE

I, Gianni Minutoli, certify that this paper complies with the type-volume limitation of 37 C.F.R. § 42.24 because it is less than 25 pages, excluding the parts of the paper exempted by 37 C.F.R. § 42.24(a).

Dated: September 29, 2023

/s/ Gianni Minutoli

Gianni Minutoli

Reg. No. 41,198

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6, I hereby certify that on September 29, 2023 the foregoing Patent Owner's Motion to Amend and Request for Preliminary Guidance was served via email on the following counsel of record for the Petitioner:

Eliot Williams
G. Hopkins Guy III
Jamie R. Lynn
Thomas C. Martin
Andrew D. Wilson
Eliot.Williams@BakerBotts.com;
Hop.Guy@BakerBotts.com;
Jamie.Lynn@BakerBotts.com;
Tommy.Martin@bakerbotts.com;
Andrew.Wilson@BakerBotts.com; and
DLDraftKingsvDiogenes@BakerBotts.com.

/s/ Gianni Minutoli

Gianni Minutoli