

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DK CROWN HOLDINGS INC.,
Petitioner

v.

DIOGENES LIMITED,
Patent Owner.

IPR2023-00267
Patent 10,997,822 B2

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

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LISTING OF EXHIBITS

Exhibit No.	Description
EX2001	U.S. application No. 13/605,813 (the '813 application)
EX2002	U.S. application No. 17/109,616 (the '616 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 No. 8,795,055
EX2010	U.S. Patent 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 with respect to the original challenged claims. In addition, PO requests that the PTAB provide preliminary guidance in accordance with the pilot program. PO attaches the proposed substitute claims as Appendix A. PO proposes to substitute independent claims 1 and 15 with claims 30 and 32, respectively, which include additional limitations not found in the prior art as determined in another non-instituted IPR filed by the Petitioner. PO proposes to substitute claims 7 and 21 with claims 31 and 33, respectively, to make them consistent with the substitute independent claims.

The MTA and 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 the 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 claims 30 and 32 are 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 the prior art references disclose the elements of the original independent claims, which this motion conditionally seeks to amend. Compare Petition at 18-61 with Appendix A. The substitute dependent claims correspond to the original challenged dependent claims and are amended to be consistent with the independent claims. The dependent claim amendments are also responsive to the grounds of unpatentability because they have 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 claims 30 and 32 include 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 claims 30 and 32 add further limitations to, and narrow the scope of, original claims 1 and 15, respectively. EX2003, ¶55. Substitute claim 30 narrows the scope of claim 1 by adding three “real time and continuous” limitations 30[d-1] to [d-3]. EX2003, ¶56. Substitute claim 32 narrows the scope of claim 15 by adding three similar “real time and continuous” limitations 32[a-1] to [a-3], which have support in the specification as discussed in more detail below. EX2003, ¶57. An overlapping Board Panel held that similar limitations were not found in Scott. *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 APPLICATIONS**

Support for each substitute claim is found in the original filed disclosure of the '822 patent, and 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 '822 patent issued from application No. 17/109,616 ('616 application) (EX2002), which claims priority through continuation and continuation-in-part applications to 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. Support for each of the

substitute claims including the additional elements of the proposed claims is provided below with reference to the original filed disclosure of the '616 application and the earlier filed disclosure of the priority '813 application. EX2003, ¶¶68-85.

Claim Limitation	Support in the '616 and '813 applications
30[a] A system for processing a payment for a wager in connection with a wagering event, the system comprising:	...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)... EX2001, 4:2-11; 4:12-15, 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 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 14 A-N)... EX2002, [0043]; <i>see also</i> [0044], [0051], FIG. 1.
30[b] a communications interface;	...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). EX2001, 4:2-11; <i>see also</i> 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 a plurality of wager input devices such as wagering stations 14,

Claim Limitation	Support in the '616 and '813 applications
	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 14 A-N). EX2002, [0043]; <i>see also</i> FIG. 1.
30[c] a processor operatively coupled to the communications interface; and	...The central server system 12 may include one or more rack mounted server computers 120 each with at least one central processing unit (CPU) or other processing device and associated memory...The computers 120 ... are shown as being hardwired to each other and to the internet, but the respective computers or portions of the network may include either wired or wireless connectivity to the internet, to an intranet or an alternative networked communication system. EX2001, 5:29-6:10; 4:2-11. ...The central server system 12 may include one or more rack mounted server computers 120 each with at least one central processing unit (CPU) or other processing device and associated memory...The computers 120 ... are shown as being hardwired to each other and to the internet, but the respective computers or portions of the network may include either wired and/or wireless connectivity to the internet, to an intranet or an alternative networked communication system.... EX2002, [0047]; [0043].
30[d] a memory having programming instructions stored thereon, which, when executed by the processor, performs one or more operations, comprising:	...The processor is in communication with or operable to access or to exchange signals with at least one data storage or memory device. The processor and the memory device reside within the cabinet. The memory device stores program code and instructions, executable by the processor, to control the wager stations 14 and wagering terminals 16 and communicate with the central server system 12. The memory device also stores other data such as image data, event data, user input data, ticket tracking assignment generators, payable data or information and applicable rules that relate to the operation of the wager stations 14 and wagering terminals 16 and the particular type of buy-out method and process described herein. EX2001, 4:29-5:9; <i>see also</i> 5:29-6:10.

Claim Limitation	Support in the '616 and '813 applications
	...The processor is in communication with or operable to access or to exchange signals with at least one data storage or memory device. The processor and the memory device reside within the cabinet. The memory device stores program code and instructions, executable by the processor, to control the wager stations 14 and wagering terminals 16 and communicate with the central server system 12. The memory device also stores other data such as image data, event data, user input data, ticket tracking assignment generators, payable data or information and applicable rules that relate to the operation of the wager stations 14 and wagering terminals 16 and the particular type of buy-out method and process described herein. EX2002, [0045].
<u>30[d-1] 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 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....EX2001, 22:13-15. It is further contemplated that the ability to trade or sell your tickets ... 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.... 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

Claim Limitation	Support in the '616 and '813 applications
	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, [0078]. 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....EX2002, [0102]. It is further contemplated that the ability to trade or sell tickets ... 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.... EX2002, [0103].
<u>30[d-2]</u> <u>recalculating, in</u> <u>real time and</u> <u>based on the</u> <u>continuously</u> <u>received data,</u> <u>wager information</u> <u>for the wager,</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.... EX2001, 22:13-15. It is further contemplated that the ability to trade or sell your tickets ... 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.... 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

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	odds, and attributed value, of the remaining tickets after each round or leg of the pool. EX2002, [0078]. 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....EX2002, [0102]. It is further contemplated that the ability to trade or sell tickets ... 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, [0103].
<u>30[d-3]</u> <u>continuously</u> <u>evaluating the</u> <u>recalculated</u> <u>wager information</u> <u>to determine an</u> <u>amount of a</u> <u>system cash out</u> <u>offer,</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.... EX2001, 22:13-15. It is further contemplated that the ability to trade or sell your tickets ... 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.... 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

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	odds, and attributed value, of the remaining tickets after each round or leg of the pool. EX2002, [0078]. 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.... EX2002, [0102]. It is further contemplated that the ability to trade or sell tickets ... 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, [0103].
30[e] <u>transmitting</u> ~~receiving~~, over the communications interface, a ~~designated~~ <u>the</u> amount <u>of the</u> <u>system cash out offer to for a</u> ~~value of the wager on the wagering event from~~ a first input device,	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; <i>see also</i> 12:4-7. ...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. In a first implementation it is anticipated that only the system operator will be able to offer the buy-out option to the active tickets holders using the central server system 12 to communicate the offers. EX2001, 23:22-24. 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

Claim Limitation	Support in the '616 and '813 applications
	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; 14:17-26. By way of example, upon presentation of the ticket to one of the wager stations 14 or wager terminals 16, the ticket will be verified and the system will present the offer to purchase the whole ticket will be displayed on the display devices, and the player will have the option to accept or reject the offer via an input to the wager station 14 or wager terminal 16. The player can also be presented with the option to sell any fraction of a ticket he/she wishes to sell through the wager station 14 or wager terminal 16. EX2001, 14:17-22. 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, [0044]; [0068]. ...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]. In a first implementation it is anticipated that only the system operator will be able to offer the buy-out option to the active tickets holders using the central server system 12 to communicate the offers. EX2002, [0106].

Claim Limitation	Support in the '616 and '813 applications
	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]; [0048]. By way of example, upon presentation of the ticket to one of the wager stations 14 or wager terminals 16, the ticket will be verified and the system will present the offer to purchase the whole ticket will be displayed on the display devices, and the player will have the option to accept or reject the offer via an input to the wager station 14 or wager terminal 16. The player can also respond, or alternatively be presented with the option, to sell any fraction of a ticket he/she wishes to sell through the wager station 14 or wager terminal 16. EX2002, [0076].
30[f] <u>soliciting</u> ~~receiving~~, over the communications interface, a <u>solicited</u> cash out offer from a second input device,	...it is also contemplated that the system operator may use the central server system 12 to solicit offers from third parties that would be communicated to the active ticket holder. In this embodiment, the central server system 12 could communicate the details of the outstanding active tickets through all or a select number of wagering terminals 16 and allow bids for the outstanding active tickets to be submitted via the wagering terminals 16. As another alternative embodiment, it is contemplated that the system operator could facilitate the ability of members of the public to buy and sell active tickets in a Betfair type exchange. Thus, it is also contemplated that

Claim Limitation	Support in the '616 and '813 applications
	the central server system 12 could allow the posting of available buy back options so that the public could place buy-back offers for example though the wagering terminals 14 and the ticket holder could select the buy-back bid of his or her choosing. EX2001, 23:22-24:4. 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.... 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.... EX2001, 22:29-23:2. ...it is also contemplated that the system operator may use the central server system 12 to solicit offers from third parties that would be communicated to the active ticket holder. In this embodiment, the central server system 12 could communicate the details of the outstanding active tickets through all or a select number of wagering terminals 16 and allow bids for the outstanding active tickets to be submitted via the wagering terminals 16. As another alternative embodiment, it is contemplated that the system operator could facilitate the ability of members of the public to buy and sell active tickets like in the manner of a person to person betting exchange, such as, without limitation, of the type offered by Betfair. Thus, it is also contemplated that the central server system 12 could allow the posting of available buy-back options so that the public could place buy-back offers for example though the wagering terminals 14 and the ticket holder could select the buy-back bid of his or her choosing. EX2002, [0106]. 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.... EX2002, [0102].

Claim Limitation	Support in the '616 and '813 applications
	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... EX2002, [0103].
30[g] identifying an acceptance of the <u>solicited</u> cash out offer from the first input device prior to the end of the wagering event,	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. The Offers 454 routine stores all the offer made, accepted and declined. EX2001, 8:25-29; <i>see also</i> 19:22-24, 20:4-10, 25:23-29. ...it is also contemplated that the system operator may use the central server system 12 to solicit offers from third parties that would be communicated to the active ticket holder. In this embodiment, the central server system 12 could communicate the details of the outstanding active tickets through all or a select number of wagering terminals 16 and allow bids for the outstanding active tickets to be submitted via the wagering terminals 16. As another alternative embodiment, it is contemplated that the system operator could facilitate the ability of members of the public to buy and sell active tickets in a Betfair type exchange. Thus, it is also contemplated that the central server system 12 could allow the posting of available buy back options so that the public could place buy-back offers for example through the wagering terminals 14 and the ticket holder could select the buy-back bid of his or her choosing. EX2001, 23:22-24:4, 20:4-10. 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. The Offers 454 routine stores all the offer made, accepted and declined. EX2002, [0056]; <i>see also</i> [0096], [0111].

Claim Limitation	Support in the '616 and '813 applications
	...it is also contemplated that the system operator may use the central server system 12 to solicit offers from third parties that would be communicated to the active ticket holder. In this embodiment, the central server system 12 could communicate the details of the outstanding active tickets through all or a select number of wagering terminals 16 and allow bids for the outstanding active tickets to be submitted via the wagering terminals 16. As another alternative embodiment, it is contemplated that the system operator could facilitate the ability of members of the public to buy and sell active tickets like in the manner of a person to person betting exchange, such as, without limitation, of the type offered by Betfair. Thus, it is also contemplated that the central server system 12 could allow the posting of available buy-back options so that the public could place buy-back offers for example though the wagering terminals 14 and the ticket holder could select the buy-back bid of his or her choosing. EX2002, [0106], [0096].
30[h] processing the <u>solicited</u> cash out offer, and	If the ticket holder decides to cash in the ticket in response to the offer, the ticket holder may communicate the acceptance via the computing system 18, smart phone 20, or tablet computer 22, to the central server system 12. Alternatively, the ticket holder would present the ticket to one of the wagering stations 14 or wagering terminals 16 which in turn communicate the acceptance to the central server system 12, and upon verification, provide the ticket bearer with a payout in the form of cash, a voucher or check. EX2001, 20:4-10. If the ticket holder decides to cash in the ticket in response to the offer, the ticket holder may communicate the acceptance via the computing system 18, smart phone 20, or tablet computer 22, to the central server system 12. Alternatively, the ticket holder would present the ticket to one of the wagering stations 14 or wagering terminals 16 which in turn communicate the acceptance to the central server system 12, and upon verification, provide the ticket bearer with a payout in the form of cash, a voucher or check. EX2002, [0096].

Claim Limitation	Support in the '616 and '813 applications
30[i] transmitting, over the communications interface, a value of the <u>solicited</u> cash out offer to the first input device.	The wagering stations 14 and wagering terminals 16 may further include a ticket and/or voucher printer to print wager receipts and potentially vouchers representing cash-out values and successful play awards or negotiable instruments such as checks. The wagering stations 14 and wagering terminals 16 may also include a ticket or voucher reader and/or a cash dispenser. Preferably, the bill collector, ticket or voucher reader and cash dispenser would be integrated into a single sub-unit. EX2001, 4:22-28. The wagering stations 14 and wagering terminals 16 may further include one or more of a display, a card reader/writer and/or a ticket and/or voucher printer to visually display, store on a card and/or a player account(s), and/or print wager receipts and potentially vouchers representing cash-out values and successful play awards.... The wagering stations 14 and wagering terminals 16 may also include a ticket or voucher reader and/or a dispenser for dispensing a monetary amount, such as, without limitation, cash, virtual currency and/or tokens, etc.... EX2002, [0044].
31. The system of claim ~~[[1]]~~ <u>30</u>, wherein the one or more operations further comprise: adjusting the ~~designated~~ amount <u>of the system cash out offer for the value of the wager on the wagering event after the initial designated amount is received.</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 to a greater precision the potential odds, and attributed value, of the remaining tickets after each round or leg of the pool. Thus, in the example above, if one of the remaining 3 potentially winning tickets has predicted the final score of the final soccer match as 2-1, while another has selected the final score as being 1-10, then the more likely score of 2-1 will have a higher attributed value than the ticket having selected 1-10. In that event, the ticket holder of the 2-1 score match may be offered more, as that ticket's attributed value (or expected value in mathematical probability terms) will be higher. EX2001, 15:13-23; <i>see also</i> 14:7-16, 14:27-15:12, 15:13-23, 15:24-16:4, 16:5-13.

Claim Limitation	Support in the '616 and '813 applications
	The ticket buy back process may include an interactive process that bids the ticket holder in a sequence of events for the ticket. For example, the system operator might originally offer the client \$100,000 for a ticket that has 5 correct scores, if the client declines to sell the ticket, the system operator might revert to offer \$105,000. EX2001, 22:22-25. 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. Thus, in the example above, if one of the remaining 3 potentially winning tickets has predicted the final score of the final soccer match as 2-1, while another has selected the final score as being 1-10, then the more likely score of 2-1 will have a higher attributed value than the ticket having selected 1-10. In that event, the ticket holder of the 2-1 score match may be offered more, as that ticket's attributed value (or expected value in mathematical probability terms) will be higher. EX2002, [0078]; <i>see also</i> [0074], [0079]-[0084]. The ticket buy back process may include an interactive process that bids the ticket holder in a sequence of events for the ticket. For example, the system operator might originally offer the client \$100,000 for a ticket that has 5 correct scores, if the client declines to sell the ticket, the system operator might revert to offer \$105,000. EX2002, [0103].
32[a] A non-transitory computer readable medium having instructions stored	See element 30[d]; <i>see also</i> EX2001, 4:29-5:9, 7:5-14, 11:25-12:3; EX2002, [0045], [0051], [0067]; EX2010 (U.S. Pat. No. 8,105,149), 10:33-58 (incorporated by reference at EX2001, 25:3-14 and EX2002, [0110]).

Claim Limitation	Support in the '616 and '813 applications
thereon, which, when executed by a processor, performs one or more operations, comprising:	
<u>32[a-1]</u> <u>continuously</u> <u>receiving data in</u> <u>real time related</u> <u>to a wagering</u> <u>event;</u>	See element 30[d-1].
<u>32[a-2]</u> <u>recalculating, in</u> <u>real time and</u> <u>based on the</u> <u>continuously</u> <u>received data,</u> <u>wager information</u> <u>for a wager;</u>	See element 30[d-2].
<u>[32[a-3]</u> <u>continuously</u> <u>evaluating the</u> <u>recalculated</u> <u>wager information</u> <u>to determine an</u> <u>amount of a</u> <u>system buy-out</u> <u>offer;</u>	See element 30[d-3].
32[b] causing a central server system to <u>transmit</u> ~~receive a~~ <u>designated the</u> <u>amount of the</u> <u>system buy-out</u>	See element 30[e].

Claim Limitation	Support in the '616 and '813 applications
~~offer to for a value of the wager on the wagering event from a first input device;~~	
32[c] causing the central server system to <u>solicit</u> ~~receive~~ one or more of a <u>solicited</u> buy-out offer ~~comprising the value of the wager~~ or a <u>solicited</u> partial buy-out offer ~~comprising a portion the value of the wager from~~ a second input device;	See element 30[f]. See also: 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. The offer could be for a partial portion of the ticket, for example an equal fifty percent share.... EX2001, 15:8-9. g) communicate the offer price to the active ticket holder for all or a portion of the active ticket; EX2001, 24: 17-18; 19:22-26. 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

Claim Limitation	Support in the '616 and '813 applications
	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, [0074]. The offer may be for 100% of the ticket, or alternatively could be for a partial portion of the ticket... EX2002, [0077]. g) communicate the offer price to the active ticket holder for all or a portion of the active ticket; EX2002, [0107]; [0096].
32[d] causing the central server system to identify an acceptance of the one or more of the <u>solicited</u> buy-out offer or the <u>solicited</u> partial buy-out offer from the first input device prior to the end of the wagering event;	See element 30[g].
32[e] causing the central server system to process the one or more of the <u>solicited</u> buy-out offer or the <u>solicited</u> partial buy-out offer; and	See element 30[h].
32[f] causing the central server system to transmit <u>a value of the one or more of the solicited buy-out</u>	See element 30[i].

Claim Limitation	Support in the '616 and '813 applications
<u>offer or the solicited partial buy-out offer at least a portion of the one or more of the value and the portion of the value to the first input device.</u>	
33. The non-transitory computer readable medium of claim [[15]] 32, causing the central server system to adjust the ~~designated~~ amount <u>of the system buy-out offer for the value of the wager on the wagering event after the initial designated amount is received.</u>	See claim 31.

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, ¶¶58-60. PO submits that no other

construction of the claims is required. This Board, however, “encourage[d] further briefing on the construction of [“causing the central server system to receive one or more of a buy-out offer comprising the value of the wager or a partial buy-out offer comprising a portion the value of the wager”] during trial.” Institution Decision, 9-10. PO submits that the construction of this 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.*, IPR2023-00268, paper 9, 12-20. EX2003, ¶63. Nevertheless, PO submits the following:

Claim Term	Petitioner’s Proposed Construction	PO’s Proposed Construction
“causing the central server system to receive one or more of a buy-out offer comprising the value of the wager or a partial buy-out offer comprising a portion the value of the wager”	“causing the central server system to receive either a buy-out offer comprising the value of the wager or a partial buy-out offer comprising a portion the value of the wager.” Petition, 31-32.	“causing the central server system to receive one or more of a buy-out offer comprising the value of the wager or a partial buy-out offer comprising a portion of the value of the wager”

PO submits that plain and ordinary meaning of “one or more of” is the proper construction of this term. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312-13 (Fed. Cir. 2005) (claim terms “generally given their ordinary and customary meaning.”) (citation omitted). Specifically, a POSITA would have understood the term to mean receiving a buy-out offer, a partial buy-out offer or both a buy-out offer and a partial buy-out offer. EX2003, ¶¶64-65. Petitioner’s proposed construction limits the term

to receiving “*either* a buy-out offer ... *or* a partial buy-out offer,” which is inconsistent with the claim language and unduly narrows it. EX2003, ¶66.

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

The substitute claims further limit original claims 1 and 15 by reciting “real time and continuous” processing steps. None of the prior art of record or otherwise known to PO teach or suggest the amended limitations, even if combined. EX2003, ¶86. 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. Accordingly, PO reserves the right to submit remarks and expert testimony in response to new arguments raised in any opposition to this motion. In addition, PO is not aware of any information material to patentability.

1. Scott

PO submits that the substitute 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, ¶¶87, 105-109. By failing to disclose, teach or suggest many of the limitations of the substitute claims, Scott cannot anticipate or render obvious the substitute claims, even if combined with other prior art such as DeWaal or Schugar. *Id.*, ¶110.

2. Schugar or Scott in view of Schugar

The Ground 2 Scott-Schugar combination does not disclose the “real time and continuous” limitations as properly construed. EX2003, ¶¶111, 122-124. Petitioner is expected to argue that Schugar cures Scott’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.” 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. EX2003, ¶123. Schugar does not anticipate or render the substitute claims obvious for the same reasons. *Id.*, ¶124.

3. DeWaal

DeWaal does not disclose the “real time and continuous” limitations as properly construed. EX2003, ¶¶125, 146-148. Petitioner is expected to argue that DeWaal discloses these limitations because it has a “central server or controller for monitoring purposes only.” EX2011, 190-192. But that controller merely responds to user inputs or makes determinations at discrete points of time (e.g., end of round). EX[1004], ¶[0123]. This discrete activity (e.g., after each round, responsive to player input, etc.) fails to disclose the “continuously” limitations. EX2003, ¶147.

4. DeWaal in view of general knowledge of a POSITA

The Ground 4 combination of DeWaal in view of the general knowledge of a POSITA does not disclose the “real time and continuous” limitations as properly construed. EX2003, ¶149-152. The knowledge of a POSITA as alleged by the Petitioner (i.e., “receiving a buy-out offer ‘from a second input device,’ as recited in limitations 1[f] and 15[f]”) or as evidenced by Schugar/Scott do not overcome the shortcomings of DeWaal’s discrete, non-realtime, processing. Both Scott and Schugar fail to teach or suggest the “real time and continuous” limitations and cannot cure DeWaal’s deficiencies. EX2003, ¶152.

5. DeWaal in view of Schugar

The Ground 5 DeWaal-Schugar combination does not disclose the “real time and continuous” limitations for the reasons discussed for Ground 4. EX2003, ¶153.

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,

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V. APPENDIX A – LISTING OF PROPOSED SUBSTITUTE CLAIMS

Patent Owner 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.

30. (substitute for claim 1, if found unpatentable) A system for processing a payment for a wager in connection with a wagering event, the system comprising:

a communications interface;

a processor operatively coupled to the communications interface; and

a memory having programming instructions stored thereon, which, when executed by the processor, performs one or more operations, comprising:

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 the wager,

continuously evaluating the recalculated wager information to determine an
amount of a system cash out offer,

transmitting ~~receiving~~, over the communications interface, ~~a designated~~ the
amount of the system cash out offer to ~~for a value of the wager on the wagering~~
~~event from~~ a first input device,

soliciting receiving, over the communications interface, a solicited cash out offer from a second input device,

identifying an acceptance of the solicited cash out offer from the first input device prior to the end of the wagering event,

processing the solicited cash out offer, and

transmitting, over the communications interface, a value of the solicited cash out offer to the first input device.

31. (substitute for claim 7, if found unpatentable) The system of claim [[1]] 30, wherein the one or more operations further comprise:

adjusting the ~~designated~~ amount of the system cash out offer ~~for the value of the wager on the wagering event after the initial designated amount is received.~~

32. (substitute for claim 15, if found unpatentable) A non-transitory computer readable medium having instructions stored thereon, which, when executed by a processor, performs one or more operations, comprising:

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

recalculating, in real time and based on the continuously received data,
wager information for a wager;

continuously evaluating the recalculated wager information to determine an amount of a system buy-out offer;

causing a central server system to transmit ~~receive a designated~~ the amount of the system buy-out offer to ~~for a value of the wager on the wagering event from~~ a first input device;

causing the central server system to solicit ~~receive~~ one or more of a solicited buy-out offer ~~comprising the value of the wager~~ or a solicited partial buy-out offer ~~comprising a portion the value of the wager~~ from a second input device;

causing the central server system to identify an acceptance of the one or more of the solicited buy-out offer or the solicited partial buy-out offer from the first input device prior to the end of the wagering event;

causing the central server system to process the one or more of the solicited buy-out offer or the solicited partial buy-out offer; and

causing the central server system to transmit a value of the one or more of the solicited buy-out offer or the solicited partial buy-out offer ~~at least a portion of the one or more of the value and the portion of the value~~ to the first input device.

33. (substitute for claim 21, if found unpatentable) The non-transitory computer readable medium of claim ~~[[15]]~~ 32, causing the central server system to adjust the ~~designated~~ amount of the system buy-out offer ~~for the value of the wager on the wagering event after the initial designated amount is received.~~

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
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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:

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