

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DK CROWN HOLDINGS INC.,
Petitioner,

v.

DIOGENES LIMITED,
Patent Owner.

IPR2023-00268
Patent 11,200,779 B2

Before MELISSA A. HAAPALA, *Vice Chief Administrative Patent Judge*,
and LINDA E. HORNER and SCOTT C. MOORE, *Acting Senior Lead
Administrative Patent Judges*.

HORNER, *Administrative Patent Judge*.

ORDER
Conduct of the Proceedings
37 C.F.R. § 42.5(a)

This case is before us on delegated Director Review to determine whether to grant rehearing of the Decision Denying Institution (Paper 9). *See* Papers 11, 12. Petitioner, DK Crown Holdings Inc., recently contacted the Board by email requesting permission to file a motion to submit supplemental information in the form of recent testimony of Patent Owner’s expert, Dr. Vancura, from depositions conducted in related cases IPR2023-00262 and IPR2023-00267. Ex. 3101 (email from Eliot D. Williams to PTAB, dated November 29, 2023). Petitioner stated that the new testimony addresses the meaning of the claim term “continuously” that is the subject of the pending rehearing before the Delegated Review Panel. *Id.* Petitioner argues that this request should be granted because the deposition from which the new testimony arose was taken after the Board’s Decision Denying Institution. *Id.* Patent Owner opposes this request. Ex. 3102 (email from Gianni Minutoli to PTAB, dated November 30, 2023).

In the Order Delegating Rehearing (“DRP Order”), the Director instructs the Delegated Rehearing Panel (DRP) to “review the [Decision Denying Institution] and determine whether the record demonstrates that the Decision misapprehended or overlooked any issue raised in the Director Review request.” *DRP Order 2* (citing Delegated Rehearing Panel¹ §§ 2.C-D; *accord* 37 C.F.R. § 42.71(d)). Although the *DRP Order* allows the *DRP* to “request additional briefing if necessary,” it does not specifically provide for the introduction of new *evidence* into the record at the rehearing stage. *See* *DRP Order 2* (citing Delegated Rehearing Panel § 2.D).

¹ *Available at* www.uspto.gov/patents/ptab/decisions/delegated-rehearing-panel.

The Board’s Trial Practice Guide provides limited circumstances in which new evidence will be admitted on rehearing:

“Ideally, a party seeking to admit new evidence with a rehearing request would request a conference call with the Board prior to filing such a request so that it could argue ‘good cause’ exists for admitting the new evidence. Alternatively, a party may argue ‘good cause’ exists in the rehearing itself.” *Huawei Device Co., Ltd. v. Optis Cellular Tech., LLC*, Case IPR2018-00816, slip op. at 4 (PTAB Jan. 8, 2019) (Paper 19) (precedential). Absent a showing of “good cause” prior to filing the request for rehearing or in the request for rehearing itself, new evidence will not be admitted. *Id.*

Consolidated Trial Practice Guide 90 (November 2019).² We recognize that Patent Owner could not have included its request to submit this new evidence in its Director Review request because Dr. Vancura’s deposition took place after rehearing was requested in this case.³ That said, for the reasons that follow, we do not find good cause exists to grant the request for leave to file a motion to submit supplemental evidence on rehearing.

In the Petition, Petitioner asserted that “[n]o terms of the ’779 Patent Challenged Claims require construction beyond their plain and ordinary meaning.” Paper 2 (Petition), 23 (citing Ex. 1007 (Expert Declaration of Dwight Crevelt) ¶¶ 54–55)⁴. In the Patent Owner Preliminary Response,

² Available at

<https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf?MURL=Tri alPracticeGuideConsolidated>.

³ Dr. Vancura’s deposition was noticed to take place on November 13, 2023 and November 17, 2023. IPR2023-00262, Paper 18 (Notice of Deposition of Olaf Vancura, Ph.D.) and IPR2023-00267, Paper 16 (Notice of Deposition of Olaf Vancura, Ph.D.)

⁴ Elsewhere in his declaration, Petitioner’s expert testified that the prior art reference discloses a system that operates “continuously,” as claimed. *See, e.g.*, Ex. 1007 ¶¶ 95–127.

Patent Owner “agree[d], for the purposes of this preliminary response, that . . . the claim terms can be afforded their plain and ordinary meaning.” Paper 6 (Patent Owner Preliminary Response) (“POPR”), 11 (citing *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc)).

The POPR was accompanied by the Declaration of Olaf Vancura. Ex. 2001 (“Vancura Dec.”). Patent Owner did not rely on the Vancura Declaration for an explicit construction of the claim term “continuously.” Rather, the POPR relied on the Vancura testimony to distinguish the disclosure in the prior art reference from the claimed invention, presumably under the asserted plain and ordinary meaning of the term. For example, Patent Owner argued that Scott does not disclose “that the process and data retrieval for presenting a cash value is ‘continuous,’ *i.e.* [,] **ongoing at all times**” because “Scott’s disclosure shows that data retrieval is on an as-needed basis.” POPR 16 (citing Ex. 2001 ¶ 89). Notably, Dr. Vancura did not testify in the cited paragraph of his declaration to the “ongoing at all times” definition quoted above. *Compare* POPR 16, *with* Ex. 2001 ¶ 89. Patent Owner also argued that Scott’s data collection process operates at discrete points and stops when an offer is made and “[a] POSITA would have understood that any break in retrieving data related to a progress of the wagering event is **not** continuous retrieval as claimed.” *Id.* at 20 (citing Ex. 2001 ¶ 99). Thus, rather than proffering a definition of the claim term “continuously,” Patent Owner’s expert distinguished the prior art based on the asserted plain and ordinary meaning of the term.⁵

⁵ Petitioner did not seek leave to file a reply to the Patent Owner Preliminary Response.

Our directive in this request for rehearing is to review the Decision Denying Institution and determine whether the record demonstrates that the Decision misapprehended or overlooked any issue raised in the Director Review request. For purposes of this institution decision, both parties agree that the claim term “continuously” should be interpreted using its plain and ordinary meaning. We determine that we have sufficient evidence in the record before us to interpret this claim term without recourse to new evidence. Accordingly, we do not find good cause exists in this case to expand the record beyond that which was before the Board when it rendered the Decision Denying Institution. Our inquiry will be based on the record before the Board at the time the Decision was rendered.

For the reasons set forth above, it is:

ORDERED that Petitioner’s request for leave to file a motion to submit supplemental evidence is denied.

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Patent 11,200,779 B2

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