

BAKER & HOSTETLER LLP
ATTORNEYS AT LAW
COSTA MESA

1 Kevin W. Kirsch (*pro hac vice*)
kkirsch@bakerlaw.com
2 BAKER & HOSTETLER LLP
312 Walnut Street, Suite 3200
3 Cincinnati, OH 45202-4074
Telephone: (513) 929-3499
4 Facsimile: (513) 929-0303

5 Jared A. Brandyberry (*pro hac vice*)
jbrandyberry@bakerlaw.com
6 BAKER & HOSTETLER LLP
1801 California Street, Suite 4400
7 Denver, CO 80212-2662
Telephone: (303) 764-4072
8 Facsimile: (303) 861-7805

9 James J. Pisanelli, Bar No. 4027
JJP@pisanellibice.com
10 Christopher R. Miltenberger, Bar No. 10153
CRM@pisanellibice.com
11 PISANELLI BICE PLLC
400 South 7th Street, Suite 300
12 Las Vegas, Nevada 89101
Telephone: (702) 214-2100
13 Facsimile: (702) 214-2101

14 *Attorneys for Bally Gaming, Inc.*

15 **UNITED STATES DISTRICT COURT**

16 **DISTRICT OF NEVADA**

17 BALLY GAMING, INC.,

18 Plaintiff,

19 v.

20 EUNIVERSE, INC.,

21 Defendant.

22 BALLY GAMING, INC. ,

23 Plaintiff,

24 v.

25 WORLDWINNER.COM., INC.,

26 Defendant.

Lead Case No. 3:03-cv-0062-LRH-VPC

Relevant to Case No. 3:03-cv-0063-LRH-VPC

Judge Larry R. Hicks

Magistrate Judge Valerie P. Cooke

**PLAINTIFF BALLY GAMING, INC.'S
OPPOSITION TO DEFENDANT
WORLDWINNER.COM, INC.'S MOTION
TO DISMISS FOR FAILURE TO STATE A
CLAIM PURSUANT TO FED. R. CIV. P. 12
(b)(6)**

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

TABLE OF CONTENTS

I. INTRODUCTION..... 1

II. STATEMENT OF FACTS..... 4

III. LEGAL STANDARDS 4

IV. LEGAL SUPPORT 8

a. Worldwinner Must Demonstrate by Clear and Convincing Evidence that the Patent-in-Suit Claims Unpatentable Subject Matter under 35 U.S.C. § 101..... 8

b. All Inferences Must Be Drawn In Favor of the Non-Moving Party on a Motion to Dismiss Subject Matter under 35 U.S.C. § 101..... 9

c. Defendant’s Motion is Premature and Should be Denied because Claim Construction is Necessary to Adequately Evaluate Whether the Patent-In-Suit Claims Patentable Subject Matter under 35 U.S.C. § 101..... 10

d. 35 U.S.C. § 101..... 11

i. Defendant’s Congress and the Courts Have Not Ruled that Business Methods and Software are Unpatentable Subject Matter under 35 U.S.C. § 101 13

V. ARGUMENT 14

a. Alice Step One: The Claims of the ’918 Patent Are Not Directed To an Abstract Idea of Profitable Awarding Prizes to Game Players 14

i. Worldwinner Fails to Properly Apply the Alice Test 14

ii. Worldwinner Conflates Novelty with Patent Eligibility..... 17

iii. Worldwinner’s Arguments Rely on Unsupported Rhetoric..... 18

iv. The ’918 Patent Is Not Directed to Abstract Ideas 18

b. Alice Step Two: The ’918 Patent Provides an Inventive Concept To Transform an Abstract Idea Into A Patent-Eligible Invention..... 20

V. CONCLUSION..... 22

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>AbbVie Inc. v. Mathilda & Terence Kennedy Inst. of Rheumatology Trust</i> , 764 F.3d 1366 (Fed. Cir. 2014).....	9
<i>Accenture Global Servs., GmbH v. Guidewire Software, Inc.</i> , 728 F.3d 1336 (Fed. Cir. 2013).....	10
<i>Alice Corp. Pty. Ltd. v. CLS Bank Int’l</i> , 134 S.Ct. 2347 (June 19, 2014).....	<i>passim</i>
<i>Ameranth Inc. v. Genesis Gaming Solutions, Inc.</i> , 2014 WL 7012391 (C.D. Cal. November 12, 2014).....	8
<i>Ameritox, Ltd. v. Millenium Health, LLC</i> , 2015 WL 728501 (W.D.Wis., February 19, 2015)	15
<i>Arrhythmia Research Technology v. Corazonix Corp.</i> , 958 F. 2d 1053 (Fed. Cir. 1992).....	9
<i>Association for Molecular Pathology v. Myriad Genetics, Inc.</i> , 133 S. Ct. 2107 (2013).....	12
<i>Bancorp Servs., L.L.C. v. Sun Life Assurance Co.</i> , 687 F.3d 1266 (Fed. Cir. 2012).....	10
<i>Bascom Research, LLC v. LinkedIn, Inc.</i> , 2015 WL 149480 (N.D. Cal. Jan. 5, 2015)).....	8, 9
<i>Bell Atl. Corp. v. Twombly</i> , 550 U.S. 544 (2007).....	9
<i>Bilski, v. Kappos</i> , 561 U.S. 593, 130 S. Ct. 3218 (2010).....	3, 11-14, 21
<i>California Institute of Technology v. Hughes Communications</i> , 2014 WL 5661290 (C.D.Cal., Nov. 3, 2014).....	14
<i>Certified Measurement, LLC v.. Centerpint Energy Houston Electric LLC</i> , 2015 WL 1432324 (E.D. Tex. March 19, 2015).....	10, 11
<i>CLS Bank v. Alice Corp.</i> , 717 F.3d 1269 (Fed. Cir. 2013).....	13, 17

1 *CMG Fin. Servs., Inc. v. Pac. Trust Bank, F.S.B.*,
 2 50 F.Supp.3d 1306 (C.D. Cal. Aug. 9, 2014)..... 8

3 *Data Distrib. Techs., LLC v. Brer Affiliates, Inc.*,
 4 2014 WL 4162765 (D.N.J. Aug. 19, 2014)..... 11

5 *DDR Holdings, LLC v. Hotels. Com, LP*,
 6 773 F. 3d 1245 (Fed. Cir. 2014) 22

7 *Diamond v. Chakrabarty*,
 8 47 U.S. 303 (1980). 11

9 *Diamond v. Diehr*,
 10 450 U.S. 175 (1980)..... *passim*

11 *Email Link Corp. v. Treasure Island, LLC*,
 12 2012 WL 4482576 (D. Nev. September 25, 2012) 9

13 *Funk Bros. Seed Co. v. Kalo Co.*,
 14 333 US 127 (1948)..... 12

15 *Helios Software, LLC v. SpectorSoft Corp.*,
 16 2014 WL 4796111 (D. Del. Sept. 25, 2014) 22

17 *In re Bilski*,
 18 545 F.3d 943 (Fed. Cir. 2008)..... 12

19 *In re Stac Elecs. Sec. Litig.*,
 20 89 F.3d 1399 (9th Cir. 1996)..... 9, 10

21 *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*,
 22 132 S. Ct. 1289 (2012) 3, 11-14

23 *Messaging Gateway Solutions, LLC v. Amdocs, Inc.*,
 24 2015 WL 1744343 (D.Del., April 15, 2015)) 14-15

25 *Microsoft Corp. v. i4i LP*,
 26 131 S. Ct. 2238 (2011) 2, 8

27 *Nazomi Communications, Inc. v. Samsung Telecommunications, Inc.*,
 28 2012 WL 967968 (N.D. Cal., July 5, 2012) 15

NL Indus., Inc. v. Kaplan,
 792 F.2d 896 (9th Cir.1986)..... 9

Rockwell Automation, Inc. v. Beckhoff Automation,
 23 F. Supp. 3d 1236 (D. Nev. May 30, 2014)..... 10

1 *Shelcore, Inc. v. Durham Indus., Inc.*,
 2 745 F.2d 621 (Fed.Cir.1984)..... 16

3 *Smartflash LLC v. Apple Inc.*,
 4 2015 WL 661174 (E.D. Tex., Feb. 13, 2015). 15

5 *StoneEagle Services, Inc. v. Pay-Plus Solutions, Inc.*,
 6 2015 WL 518852 (M.D.Fla., February 9, 2015)..... 16

7 *Tuxis Techs., LLC v. Amazon.com, Inc.*,
 8 2014 WL 4382446 (D. Del. Sept. 3, 2014) 8

9 *Ultramercial, Inc. v. Hulu, LLC*,
 10 722 F.3d 1335 (Fed. Cir. 2013)..... 8, 10

11 *WildTangent, Inc. v. Ultramercial, LLC*,
 12 134 S. Ct. 2870 (2014)..... 8, 10

13 *Wolf v. Capstone Photography, Inc.*,
 14 2014 WL 7639820 (C.D. Cal. October 28, 2014)..... 8

15 **Statutes**

16 35 U.S.C. § 101 *passim*

17 35 U.S.C. § 102 13, 17

18 35 U.S.C. § 103 13

19 35 U.S.C. § 282 2, 8

20 **Rules**

21 Federal Rule of Civil Procedure 12(b)(6) 1, 9, 10, 17

22 **Other Authorities**

23 U.S. Patent No 5,816,918..... *passim*

24 Leahy–Smith America Invents Act,
 25 112 P.L. 29, § 14, 125 Stat. 284, 327–28 (2011) 14

26 Mark J. Patterson & M. Andrew Pitchford, First to File,
 27 47 Tenn. B.J. 14, 16 (November 2011)..... 14

28

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.