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I. Introduction

U.S. Patent 6,174,237 (“the ‘237 Patent”) (Exhibit A) is the subject of pending litigation in District Court as well as a pending *inter partes* review. In the *inter partes* review, the Patent Trial and Appeal Board (“PTAB”) determined that there is a reasonable likelihood that the “Petitioner would prevail [in its invalidly assertion] with respect to claims 1-19 of the ‘237 Patent.” PTAB November 19, 2013 Decision, Institution of *Inter Partes* Review, Case IPR2013-00289 (“PTAB Decision, Institution of *Inter Partes* Review”) (Exhibit B) at 2, 21. The *inter partes* review was instituted based upon prior art including WO 97/39811 to Walker Asset Management, L.P. (“Walker”) (Exhibit C), which was not previously considered by the Patent and Trademark Office (“PTO”).

The fact that an *inter partes* review has been instituted on the ‘237 Patent is of critical relevance to the present request for *ex parte* reexamination. The legal standard for granting a request for an *inter partes* review is higher than the legal standard for granting a request for an *ex parte* reexamination (i.e., the “reasonable likelihood” of prevailing standard of the *inter partes* review is a more restrictive, higher standard than the “substantial new question of patentability” standard that governs *ex parte* reexaminations). *Neste Oil Oyj v. Dynamic Fuels, LLC*, No. 12-1744-GMS, 2013 U.S. Dist. LEXIS 92416, at *13-14 (D. Del. July 2, 2013) (Exhibit D); *Capriola Corp. v. LaRose Indus., LLC*, No. 8:12-cv-2346-T-23TBM, 2013 U.S. Dist. LEXIS 65754, at *5-6 (M.D. Fla. Mar. 11, 2013) (Exhibit E).

Therefore, when the PTAB determines that the standard for the institution of an *inter partes* review has been met, the standard for granting an *ex parte* reexamination is also met as a matter of law. The PTAB recently confirmed this in its *Idle Free* decision. *Idle Free Systems, Inc. v. Bergstrom, Inc.*, Case IPR2012-00027 (JL) Patent 7,591,303, Patent Trial and Appeal

Board Representative Orders, Decisions and Notices, 2013 Pat. App. LEXIS 6302, June 11, 2013, Decided (Exhibit F). Here, the PTAB's conclusion that there is a reasonable likelihood that the Petitioner, Game Show Network, LLC and WorldWinner.com. Inc. (collectively referred to herein as "Game Show Network"), will prevail in its invalidity assertion against the '237 Patent serves as the basis for the Inventor's, John H. Stephenson, present request for *ex parte* reexamination.

Included as part of the request for *ex parte* reexamination is an amendment (new claim 20) filed in accordance with 37 C.F.R. 1.510(e). Applying the patentee's proposed claim construction asserted in the *inter partes* review, new claim 20 clarifies the subject matter of original claim 1. New claim 20 is narrower in scope than claim 1 as construed by the PTAB and is patentable over Walker even if it is finally determined in the *inter partes* review that original claim 1 is not.

The PTAB analysis is subject to change during the pending *inter partes* review based on the parties' pleadings and arguments at the hearing. Further, any final decision of the PTAB is subject to appeal by either party. The statements made herein are not intended to waive any right to appeal or otherwise contest the PTAB finding in the *inter partes* review. Regardless of the outcome of the *inter partes* review, the present request for reexamination will not be moot. At the very least, an issue will remain as to whether new claim 20, which has a different scope than any of the claims pending in the *inter partes* review, is patentable over Walker.

II. Background of Relevant Technology

As explained in the PTAB's Decision, Institution of *Inter Partes* Review:

[T]he '237 Patent is related to tournament play having a qualifying round and a playoff round. The qualifying round is played between a player, through a

computer terminal, and a host computer. The playoff round is played between those players obtaining a predetermined level of performance in the qualifying round and the host computer. The playoff round is played under the same rules and conditions as in the qualifying round, except that all the players are playing simultaneously within a specific time frame. Ex. 1001, 1:15-24. Awards are distributed to players in both the playoff and qualifying rounds.

The PTAB Decision, Institution of *Inter Partes* Review, at 3.

III. Procedural Background

The inventor and patent owner, John Stephenson (“Stephenson”) manufactures and sells gaming products that are protected by the ‘237 Patent. In 2013, Stephenson asserted the ‘237 Patent against Game Show Network in an infringement proceeding in the U.S. District Court of Delaware. *Stephenson v. Game Show Network, LLC*, No. 12-614-SLR (D. Del. Filed Mar. 27, 2013). The Stephenson litigation has been stayed pending *inter partes* review of the ‘237 Patent. Prior to the stay, the parties had exchanged some discovery, but neither party had filed any substantive briefs.

On May 17, 2013, Game Show Network filed a petition requesting *inter partes* review of claims 1-19 of the ‘237 Patent, citing Walker as new prior art not before the PTO during prosecution. On November 19, 2013, the PTAB granted Game Show Network’s request to institute *inter partes* review of the ‘237 Patent based upon Walker, alone and in combination with secondary references.

Based upon guidance from the PTAB Board (see, e.g., the *Idle Free* decision), Stephenson decided to file the present request for *ex parte* reexamination, asking the PTO to consider a claim amendment adding new claim 20, which is fully supported by the specification of the ‘237 Patent. New claim 20 differs in scope from original claim 1. The limitations added to claim 20 further distinguish claim 20 from Walker.

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