IPR2013-00289

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GAME SHOW NETWORK, LLC AND WORLDWINNER.COM

Petitioners

v.

JOHN H. STEPHENSON

Patent Owner

Case IPR2013-00289

Patent 6,174,237

OPPOSITION TO PETITIONERS' MOTION TO TERMINATE, OR TO ALTERNATIVELY STAY, THE *EX PARTE* REEXAMINATION OF THE '237 PATENT

Patent Owner John Stephenson ("Stephenson") hereby opposes Petitioners' Motion to Terminate, or To Alternatively Stay, the *Ex Parte* Reexamination of the '237 Patent ("*Ex Parte* Reexamination Request"). *See* Paper 27.

I. The Board Explicitly Authorized the *Ex Parte* Reexamination Process as the Preferred Vehicle for Claim Amendments

Petitioners' request to terminate or, alternatively, stay the *Ex Parte* Reexamination Request should be denied. Clear precedent authorizes the use of the *ex parte* reexamination process as the preferred method for seeking claim amendments while *inter partes* review is pending. *See Idle Free Systems, Inc. v. Bergstrom, Inc.*, IPR2012-00027 ("*Idle Free*"). This case is no exception.

A. The claims of the *Ex Parte* Reexamination Request constitute a "remodeling of [the] claim structure"

Petitioners state, "The eight proposed claims that Stephenson seeks in the *ex parte* reexamination are nearly identical to the original claims of the '237 Patent," and "this IPR is the proper proceeding for minor claim amendments." Paper 27, pp. 2 and 3. This characterization of the amended claims is wrong.

The Board has explicitly noted that *ex parte* reexamination is the preferred approach when, as here, a party seeks a "remodeling of its claim structure according to a different strategy." *Idle Free*, Paper 26, p. 6.

New claim 20 of the *Ex Parte* Reexamination Request recites "playing a game of skill in a qualifying round between a single player and the host computer**,**

wherein said playing includes the single player and host computer playing against each other." Ex. 1009. The emphasized portion of claim 20 represents a wholly new limitation that significantly changes the scope of any claim in the present *inter partes* review as construed by the Panel. This subject matter will therefore not be considered by the Panel in the *inter partes* review.

Further, Petitioners fail to even address the significant remodeling represented by the limitations of claims 21-28. For example, claim 21 further limits claim 20 by reciting "said host computer tailors the host computer's play to the player's chosen play." *Id.* This concept (i.e., the host tailoring its play to the player's play) falls squarely outside any of the granted claims of the '237 patent and the issues in the present *inter partes* review. Other dependent claims, such as claim 22, further remodel the existing claim structure and differentiate from the *inter partes* review subject matter by reciting "said player's turn and said host computer's turn alternate, one after another."

The new limitations of claim 20, as well as those of dependent claims 21-28, represent a significant change from the original claims of the '237 Patent that are currently before the Panel. The *Ex Parte* Reexamination Request is thus well within the guidelines for the filing of reexaminations provided in *Idle Free*.

B. Amendment of claims in *Ex Parte* Reexamination is consistent with this Board's guidance and precedent; dismissal would unfairly prejudice the Patent Owner

Stephenson's actions are consistent with this Panel's guidance. Specifically, Stephenson discussed the possibility of filing an *ex parte* reexamination to seek claim amendments during the conference call of January 16, 2014. *See* Paper 21. The Patent Owner specifically stated it would likely amend to recite the player playing "against" the computer, as recited in proposed claim 20. The Panel's Order summarizing this conference call states, "Patent Owner may pursue new claims in another type of proceeding before the Office during the trial." Paper 21, p. 2.

If Petitioners' motion is granted Patent Owner would be greatly prejudiced, especially as the deadline for amendment in the *inter partes* review has passed. Stephenson would be unfairly denied an opportunity to seek claim amendments using the very process suggested in numerous Board decisions and this Panel's guidance in this case.

Further, Stephenson's *Ex Parte* Reexamination Request is not contrary to Congressional intent. Because the new claims are significantly different in scope, allowing the reexamination to proceed, contrary to Petitioners' assertion, will ensure the present *inter partes* review reaches a "prompt, efficient, and final determination of the patentability of the '237 Patent." See Paper 27, p. 1.

Nothing about Stephenson's filing of the *Ex Parte* Reexamination Request

taints the present process. Rather, had Stephenson presented the new claims in the present *inter partes* review, that would have added complexity and potential delays. Stephenson was proactive about disclosing its intent to file an *ex parte* reexamination with claims consistent with what it filed in fact, and was appropriately guided that such a filing was a proper alternative.

C. There is no duplicate effort for the *Ex Parte* Reexamination

Petitioner alleges duplication of effort between the *inter partes* review and the *ex parte* reexamination processes. Petitioner fails to even specify the additional distinctions of claims 21-28, let alone support its allegation of duplicated effort. Because the changes are substantial, there is no little or no duplicate effort by either tribunal, since each is examining different "inventions" (i.e., claim sets). Petitioners' conclusory allegations do not prove the contrary.

Petitioner claims it is "inevitable" that it will seek a second *inter partes* review if its motion is denied. Paper 21 at p. 4. Any patent, and certainly one that goes through an *inter partes* review and reexamination process, is presumed valid. Petitioners' assumption that any new claim will be the subject of a second *inter partes* review and later found to be invalid regardless of its scope is as unwarranted as the requested relief.

II. Petitioners' Request for Termination is Without Precedent

The Board has given clear direction to patent owners: the *ex parte*

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