

Filed on behalf of Game Show Network, LLC and WorldWinner.com, Inc.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Game Show Network, LLC and WorldWinner.com, Inc.,

Petitioners,

v.

Patent Owner of

U.S. Patent 6,174,237 to Stephenson

Case IPR2013-00289

**PETITIONERS' REPLY IN SUPPORT OF THEIR MOTION TO
TERMINATE, OR TO ALTERNATIVELY STAY, THE *EX PARTE*
REEXAMINATION OF THE '237 PATENT**

Stephenson's attempt to pursue his proposed amended claims in an *ex parte* reexamination undermines the promptness, efficiency, and finality of the IPR process. This tactic is a transparent bid to circumvent the more rigorous scrutiny of this IPR, hoping for a second chance to salvage his patent and subject Petitioners (and hence the PTO) to further protracted and costly legal proceedings.

Contrary to Stephenson's assertions (Opp. at 3), the PTAB has not encouraged patent owners to file an *ex parte* reexamination to sidestep an IPR for routine claim amendments that could readily be handled in an IPR. In *Idle Free*, the PTAB explained that a patent owner *can* submit a *reasonable number* of substitute claims *in the IPR*, but that **23** substitute claims was not a *reasonable number* for just two existing claims. IPR2012-00027, Paper 26 at 11. The PTAB explained that such a complex claim set could be pursued outside the IPR:

If a patent owner desires a *complete remodeling of its claim structure according to a different strategy*, it may do so in another type of proceeding before the Office.

Id. at 6. *Idle Free* is not a broad endorsement to file an *ex parte* reexamination to pursue an uncomplicated claim set that can easily be handled in the IPR process.

Further, Stephenson's assertion that this Panel encouraged him to pursue his proposed claims in an *ex parte* reexamination (Opp. at 3) is incorrect. The Panel authorized *a motion to amend in the IPR*, and indicated that Stephenson could file an *ex parte* reexamination *if* he sought a "*complete remodeling* of claim structure."

Stephenson did not follow the Panel's clear guidance. His proposed claims are not a "*complete remodeling* of claim structure." Indeed, Stephenson argued

that proposed Claim 20 “is *largely identical* to Claim 1 of the ’237 patent” (Ex. 1009 at 17), clearly showing that Claim 20 could have been submitted as a substitute for existing Claim 1. Similarly, each of proposed Claims 22-28 could have been submitted as a substitute for one of the existing dependent claims.

Because the proposed claims include new limitations, Stephenson argues that he seeks a *complete remodeling* of his existing claims. Opp. at 1-2. This argument is flawed because the rules *require* substitute claims to include new limitations that narrow the claims, as well as to respond to a ground of invalidity. See 37 C.F.R. § 42.121(2). Mere compliance with these rules does not *remodel* the claims at all, let alone *completely* remodel them. And while the new claims are a bit narrower, Stephenson exaggerates the differences. Computers and humans played “*against each other*” long ago, and Stephenson did not invent reacting to an opponent’s moves or simply *taking turns*. Ex. 1009 at 15-16 (Claims 20-22).

Stephenson could have—and should have—submitted his proposed claims in this IPR to allow the PTAB to decide whether those claims are patentable. Thus, he has no basis to complain that termination of the *ex parte* reexamination would unfairly deprive him of the right to pursue new claims. He disregarded the Panel’s guidance and instead filed the *ex parte* reexamination, in a transparent attempt to avoid more rigorous scrutiny in this IPR, thereby undermining the promptness, efficiency, and finality of the IPR process. The PTAB should not countenance this tactic, which would allow Stephenson (and encourage likely untold numbers of future patent owners) to flagrantly and unabashedly circumvent IPR proceedings. Thus, the Board should terminate the *ex parte* reexamination.

IPR2013-00289

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: March 12, 2014 By: Brenton R. Babcock/

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of **PETITIONERS' REPLY IN SUPPORT OF THEIR MOTION TO TERMINATE, OR TO ALTERNATIVELY STAY, THE EX PARTE REEXAMINATION OF THE '237 PATENT** is being served on March 12, 2014, via email pursuant to 37 C.F.R. § 42.6(e) per agreement of the parties, to counsel for Stephenson at the email address set forth below:

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Dated: March 12, 2014

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