

UNITED STATES PATENT AND TRADEMARK OFFICE
PATENT TRIAL AND APPEAL BOARD

Patent Interference No. 105,747 (RES)
(Technology Center 2400)

Zynga Inc.,
Junior Party
(Application 10/658,836;
Inventors: Rolf E. Carlson and Michael W. Saunders),

v.

IGT,
Senior Party
(Patent 7,168,089;
Inventors: Binh T. Nguyen, Michael M. Oberberger and
Gregory Hopkins Parrott).

Before: FRED E. McKELVEY, RICHARD E. SCHAFER, and
RICHARD TORCZON, *Administrative Patent Judges*.

Opinion for the Board filed by SCHAFER, *Administrative Patent Judge*.

Dubitante opinion filed by TORCZON, *Administrative Patent Judge*.

Concurring opinion filed by McKELVEY, *Administrative Patent Judge*.

DECISION - MOTIONS - 37 CFR § 41.125(a)

- 1 I.
- 2 The interference is before a motions panel for consideration of non-priority
- 3 motions.
- 4 There was no oral argument.

1 Four substantive motions are currently pending:

2 1. IGT Motion 2¹ (Paper 94) for a judgment that Zynga's involved
3 claims lack sufficient written descriptive support under 35 U.S.C. § 112, ¶ 1
4 (2010);

5 2. Zynga's Substantive Motion 1 (Paper 89) to substitute a new count
6 and designate all of the parties' currently involved claims as corresponding to the
7 new count;

8 3. Zynga's contingent Motion 2 (Paper 90) for the benefit of the filing
9 dates of Applications 09/698,507 and 60/161,591 as to the proposed new count;
10 and

11 4. Zynga's Substantive Motion 3 (Paper 91) for a judgment that IGT's
12 involved claims are unpatentable over prior art.

13 We grant IGT's Motion 2. Because we find that Zynga's specification does
14 not provide written descriptive support for its involved claims, it is inappropriate
15 and unfair to allow this interference to continue based upon the unsupported
16 claims. We therefore terminate this interference with a judgment against Zynga
17 and dismiss Zynga's motions as moot. See 37 CFR §41.201 (definition of
18 threshold issue).

19 II.

20 This interference is between Zynga's Application 10/658,836 and IGT's
21 Patent 7,168,089. The interference was declared on March 5, 2010, between Legal
22 iGaming, Inc. and IGT. Zynga is the successor-in-interest to Legal iGaming. The
23 interference was suspended due to Legal iGaming's bankruptcy proceeding. *In re*
24 *Legal iGaming, Inc.*, Case No. 11-12771-BTB (Bankr. E.D. Nev). During the

¹ IGT Substantive Motion 1 (Paper 25), asserting no interference-in-fact between the parties' claimed subject matter, was previously denied in a panel decision. Paper 50.

1 bankruptcy, Legal iGaming’s intellectual property rights were sold to Atwater
2 Ventures, Ltd. which subsequently assigned its interests to Zynga.² The
3 bankruptcy was terminated on April 5, 2013.

4 III.

5 The subject matter claimed relates to the authorization of electronic transfers
6 between networked computer gaming machines or devices, particularly casino-type
7 gaming machines. The parties employ an “authorization agent” or “gaming
8 server” that determines whether to allow the transfer. In Zynga’s claims the agent
9 approves the transfer of “gaming information.” In IGT’s claims the agent approves
10 the transfer of “gaming software.” We reproduce Zynga’s Claim 29 and IGT’s
11 Claim 1 below with paragraphing, bracketing, strikethrough, and emphasis added:

12 Zynga Claim 29

13 29. In an *authorization agent*, a method of generating a
14 gaming transaction record used to facilitate a *transfer of gaming*
15 *information* between two gaming devices, the method
16 comprising:
17 receiving a *gaming transaction request* from a first
18 gaming device;
19 authenticating an identity of the first gaming device;
20 generating a gaming transaction record comprising
21 gaming transaction information;
22 and sending a message to the first gaming device wherein
23 the message includes information authorizing the first gaming
24 device to *transfer the gaming information to the* [a³] second
25 gaming device wherein the first gaming device and the second
26 gaming device are separate from the *authorization agent*,
27 whereby the first gaming device transfers the gaming
28 information to the second gaming device in response to the
29 message;

² Legal iGaming, Atwater, and Zynga will collectively be referred to as “Zynga.”

³ As presented by Zynga, there is no antecedent in Claim 29 for “the second gaming device”.

1 wherein the *gaming information* is for a game of
2 chance played on a gaming machine.

3 IGT Claim 1

4 1. In a *software authorization agent*, a method of
5 generating a gaming software transaction record used to
6 facilitate a *transfer of gaming software* between two gaming
7 devices, the method comprising:
8 receiving a *gaming software transaction request* from a
9 first gaming device;
10 authenticating an identity of the first gaming device;
11 generating a *gaming software transaction record*
12 comprising gaming software transaction information that is
13 used to approve or reject the transfer of gaming software from a
14 second gaming device to the first gaming device
15 sending an authorization message to the first gaming
16 device
17 wherein the authorization message includes information
18 indicating whether the first gaming device is *authorized to*
19 *transfer the gaming software* to the second gaming device and
20 wherein the first gaming device and the second gaming
21 device are separate from the *software authorization agent*;
22 wherein the gaming software is for at least one of a) a
23 game of chance played on a gaming machine, b) a bonus game
24 of chance played on a gaming machine, c) a device driver for a
25 device installed on a gaming machine, d) a player tracking
26 service on a gaming machine and e) an operating system
27 installed on the gaming machine.

28 Legal iGaming's Clean Copy of Claims, Paper 14, p. 2; IGT Clean Copy of
29 Claims, Paper 9, p. 2.

30 IV.

31 IGT Substantive Motion 2 (Paper 94) argues, inter alia, that the concept of
32 using an "authorization agent" in Zynga's claims is not described in Zynga's
33 specification: Paper 94, pp. 12-17.

34 A.

1 Relying on *Robertson v. Timmermans*, 603 F.3d 1309, 1312, (Fed. Cir.
2 2010) and *In re Spina*, 975 F.2d 854, 856 (Fed. Cir. 1992), IGT argues that because
3 Zynga copied the claims from IGT’s published application, “authorization agent”
4 should be construed in light of IGT’s specification. Paper 94, pp. 3-4.

5 Zynga disagrees arguing that the claims are not copies of IGT’s claims.
6 Paper 118, p. 2. For example, Zynga argues that there are several differences,
7 including that its claims generically specify the use of an “authorizing agent” while
8 IGT’s claims specify a “software authorizing agent.” We also observe that
9 Zynga’s claims require the authorization agent control the transfer of “gaming
10 information,” while IGT’s claims require that the authorization agent control the
11 transfer of “gaming software.” Because of the differences, Zynga argues, the
12 claims are not copies and cases holding that the originating disclosure provides the
13 meaning of the pertinent claim language do not compel that its claims be
14 interpreted in light of IGT’s disclosure. Paper 118, p. 2.

15 IGT does not contest that there are differences between its claims and
16 Zynga’s. However, it argues that Zynga’s claims are “essentially copied” and
17 remain closer in substance to IGT’s claims than to any of the Zynga’s original
18 claims. Paper 135, p. 2, ll. 3-8.

19 B.

20 A review of the prosecution history of Zynga’s involved application shows
21 that Zynga submitted claims copied from IGT’s published application (U.S. Patent
22 Application Publication 2002/0116616 (Aug. 22, 2002) (Ex. 1010).
23 Application 10/658,836, Transmittal letter filed August 21, 2003 (Ex 2010, Board
24 page 1209). As originally copied from IGT’s published application, Zynga
25 included claims that that were identical to claims in IGT’s involved application.
26 Application 10/658,836, Amendment filed August 21, 2003 (Ex 2010, starting at
27 Board page 1265). Thus, Zynga’s copied claims required the use of a software

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