

Mail Stop Interference
P.O. Box 1450
Alexandria Va 22313-1450
Tel: 571-272-4683
Fax: 571-273-0042

Entered: May 3, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Legal iGaming, 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).

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

Order - Authorizing Motions – 37 C.F.R. § 41.121

A telephone conference call was held on January 19, 2010, at
approximately 4:00 p.m., involving:

1. Brenton R. Babcock, Esq., Frederick S. Berretta, Esq.,
and Eric M. Nelson, Esq., for Legal iGaming;
2. Michael H. Longmeyer, Esq., and Robert B. Reeser III,
Esq. for IGT; and
3. Richard E. Schafer, Administrative Patent Judge.

The principal purpose of the conference call was to discuss the parties' proposed motions.

IGT's Proposed Motions

1. A motion that no interference-in-fact exists between the parties respective claims;
2. A motion that iGaming's claims are not supported by a written description required by 35 U.S.C. § 112, ¶ 1;
3. A motion for additional discovery related to the inventorship of iGaming's patent;
4. A motion that iGaming committed inequitable conduct in naming its inventor(s);
5. A motion contingent on the grant of iGaming's motion for benefit to be accorded the benefit of the filing date of Application 90/732,650; and
6. A motion for judgment based upon priority.

IGT's motion for no interference-in-fact was authorized. The motion shall be filed on or before **May 28, 2010**. All evidence relied upon to support the motion shall be filed with the motion. No opposition is authorized at this time. However, iGaming shall promptly advise the board if it does not plan to file an opposition or it plans to file a paper in support of the motion. The parties may stipulate to change the due date as set forth in Paper 3 at page 2.

IGT's motion that iGaming's claims are not supported by a written description was authorized.

IGT's motion for additional discovery relating to the changes of the named inventors during the prosecution of iGaming's involved application was not authorized. IGT sought discovery to obtain information for use in opposing an iGaming motion for the benefit of the filing dates of earlier

applications. While the record of iGaming's application shows that the inventorship was changed, IGT has not provided sufficient additional facts suggesting that iGaming's current inventorship is either incorrect or that the handling of the inventorship during iGaming's prosecution was inappropriate. Additionally, IGT, in opposing a motion for benefit, may attempt to show that the iGaming's purported benefit applications do not provide an adequate disclosure of an embodiment within the scope of the count.

IGT's auxiliary motion relating to any inequitable conduct uncovered as a result of the additional discovery was not authorized.

IGT's motion for benefit of the filing date of its Application 09/732,650 was authorized.

IGT's motion for priority is deferred until the second phase of the interference.

Legal iGaming's Proposed Motions

Legal iGaming proposed the following motions:

1. A motion to substitute a new Count including, as an additional alternative, one or more of iGaming's independent claims;
2. A motion for the benefit of iGaming's Applications 09/698,507 and 60/161,591;
3. A motion for no interference-in-fact contingent on the denial of iGaming's previously listed motions;
4. A motion that the IGT's involved claims are unpatentable under 35 U.S.C. § 102(e) or 103(a) in view of iGaming's patent 7,260,834 which is asserted to be entitled to the October 26, 1999, filing date of iGaming's Application 60/161,591.

5. A motion to cancel iGaming's Claim 93 and replace it with a new Claim 93 to correct a typo; and

6. A motion for judgment based upon priority.

iGaming's motions 1, 2 and 4 were authorized.

With respect to iGaming's motion to substitute a count, iGaming was advised that a motion relying on the theory that its best proofs are outside the count must (1) make a proffer of the embodiment its proofs would show and (2) show that the embodiment proved would interfere-in-fact with at least one of IGT's claims.

iGaming's motion 3 appears to be unnecessary at this time in light of IGT's intent to file a motion for no-interference in fact.

iGaming's motion to cancel its Claim 93 was not authorized. Claim 93 will be construed for the purpose of this interference that the word "software" in the second clause means "information." In other words, Claim 93 will be construed as if it were amended as suggested by iGaming. If appropriate, iGaming may file an amendment in its application upon return to ex parte examination.

iGaming's motion for judgment based upon priority of invention was deferred until the second phase of the interference.

Any Responsive motions must be authorized. A conference call should be arranged if, after review of the opponent's motions, the filing of a responsive motion is desired.

/Richard E. Schafer/
Administrative Patent Judge

cc (via e-mail):

Counsel for Legal iGaming:

Brenton R. Babcock, Esq.
Salima A. Merani, Ph.D., Esq.
Frederick S. Berretta, Esq.
Eric M. Nelson, Esq.
James P. Skelley, Esq.
KNOBBE, MARTENS, OLSON & BEAR, LLP
2040 Main Street, 14th Floor
Irvine, CA 92614
Tel: (949) 760-0404
Fax: (949) 760-9502
E-mail: BoxIGAM@kmob.com

Counsel for IGT:

Michael H. Longmeyer, Esq.
Robert B. Reeser III, Esq.
ARMSTRONG TEASDALE LLP
One Metropolitan Square, Suite 2600
St. Louis, MO 63210-2740
Phone: 314-621-5070
Facsimile: 314-621-5065
E-Mail: mlongmeyer@armstrongteasdale.com
E-Mail: rreeser@armstrongteasdale.com