

1 Filed on behalf of:  
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Paper No. 21

3 IGT  
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Date Filed: \_\_\_\_\_

16 **UNITED STATES PATENT AND TRADEMARK OFFICE**  
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18 **BEFORE THE BOARD OF PATENT APPEALS**  
19 **AND INTERFERENCES**  
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23 Legal iGaming, Inc.  
24 Junior Party  
25 (Application 10/658,836  
26 Inventors: Rolf E. Carlson and Michael W. Saunders),  
27

28 v.  
29

30 IGT  
31 Senior Party  
32 (Patent 7,168,089  
33 Inventors: Binh T. Nguyen, Michael M. Oberberger and  
34 Gregory Hopkins Parrott).  
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36 Patent Interference No. 105,747 (RES)  
37 Technology Center 2400  
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39 **IGT MOTION LIST**  
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1 **IGT MOTION LIST**

2 Pursuant to Part D of the Declaration of Interference, Bd. R. 120 and 204, and SO  
3 ¶¶ 104.2.1, 120 and 204, the following is a list of the motions that Senior Party IGT (“IGT”)  
4 presently intends to file:

- 5 1. A motion for judgment that Junior Party Legal iGaming, Inc. (“Legal iGaming”)  
6 has no standing in this Interference, because there is no interference-in-fact.
- 7 2. A motion for judgment that Legal iGaming has no standing in this Interference,  
8 because all claims of its involved application are unpatentable for lack of written  
9 description under 35 U.S.C. 112 paragraph 1.
- 10 3. A miscellaneous motion pursuant to Bd. R. 150(c), SO ¶¶ 123 and 150.2 for  
11 additional discovery into the basis for the naming of, and subsequent removal of,  
12 Michael W. Saunders as an inventor of Legal iGaming’s involved application  
13 (“the ‘836 Application”). Recognizing that the Board will not grant a motion for  
14 additional discovery absent a specific basis for expecting that the discovery will  
15 be productive, IGT presents the following detailed basis:
- 16 a. The ‘836 Application, as originally filed, consisted of the specification and  
17 figures of Legal iGaming’s prior U.S. Application No. 08/358,242 and a  
18 preliminary amendment to incorporate by reference (i) four additional  
19 applications owned by Legal iGaming, and (ii) IGT’s involved patent and  
20 a related application owned by IGT. The preliminary amendment also  
21 copied verbatim the claims of IGT’s involved patent. Thus, five prior

1 applications owned by Legal iGaming constitute the entirety of the as-filed  
2 disclosure in the '836 Application, save for the material copied directly  
3 from IGT to provoke the Interference.

4 b. Michael W. Saunders was not named as an inventor in any of the five  
5 prior applications owned by Legal iGaming that constituted the entirety of  
6 the original disclosure in the '836 Application. Nevertheless, the '836  
7 Application originally named Michael W. Saunders, along with Rolf E.  
8 Carlson (the sole named inventor in the five prior applications), as an  
9 inventor.

10 c. As a matter of law, Mr. Saunders properly could be named as an inventor  
11 only if he contributed to the conception of the invention claimed in the  
12 copied claims in the '836 Application.

13 d. Mr. Saunders was not named as an inventor in the five prior applications  
14 on which the entirety of the disclosure in the '836 Application is based,  
15 and for which junior party Legal iGaming is expected to move to be  
16 accorded the benefit of filing dates. Therefore, if Mr. Saunders was newly  
17 entitled to be named as an inventor for the '836 Application, this would  
18 constitute strong evidence that the material he contributed to the claims is  
19 not supported in those five prior applications, hampering any priority  
20 claim by Legal iGaming. On the other hand, if material which Mr.  
21 Saunders contributed *is* present in any of the claims of those five prior

1 applications, a question arises as to why Mr. Saunders was not named as  
2 an inventor in such prior applications.

3 e. After Legal iGaming had made certain amendments to the claims it copied  
4 from IGT's involved patent, Legal iGaming submitted a Request to  
5 Amend Inventorship (dated January 9, 2008) in the '836 Application. The  
6 Request deleted Mr. Saunders as a named inventor based on the claims as  
7 then presented.

8 f. Additional discovery into the basis for Mr. Saunders' original entitlement  
9 to inventorship, and removal therefrom, is necessary at least because:

10 (1) Through changes in the claimed inventorship, certain matter in the  
11 '836 Application may effectively have been admitted by Legal  
12 iGaming to be new matter with respect to the five prior  
13 applications owned by Legal iGaming (for which it may otherwise  
14 move to be accorded the benefit of filing dates);

15 (2) It will establish whether any material in the presently presented  
16 claims of the '836 Application is still attributable to Mr. Saunders,  
17 who is no longer named as an inventor; and

18 (3) Legal iGaming may have been motivated to erroneously exclude  
19 Mr. Saunders from inventorship with respect to the claims in the  
20 '836 Application in order to avoid a finding (i) that the material  
21 contributed to the claims by a new inventor is not supported in the

1 five prior applications for which Legal iGaming may move to be  
2 accorded benefit, or alternately (ii) that Mr. Saunders was  
3 improperly omitted as an inventor in such prior applications.

4 4. The preceding motion for additional discovery is primarily directed to identifying  
5 whether certain matter in the claims of the '836 Application has been admitted to  
6 be new matter through changes in the claimed inventorship, rather than to  
7 uncovering evidence of inequitable conduct. However, if the preceding motion  
8 for additional discovery does uncover evidence that Legal iGaming submitted  
9 incorrect information regarding Mr. Saunders' inventorship (with respect to the  
10 '836 Application and/or the five prior applications owned by Legal iGaming) in  
11 bad faith or with intent to deceive the United States Patent and Trademark Office,  
12 IGT intends to file a motion for judgment on the basis that the '836 Application is  
13 unpatentable due to inequitable conduct.

14 5. A motion, contingent upon a claim construction that would permit a successful  
15 motion by Legal iGaming to be accorded a priority date earlier than the filing date  
16 of IGT's involved patent, to be accorded the benefit of the filing date of U.S.  
17 Application No. 09/732,650, filed December 7, 2000, now issued as U.S. Patent  
18 No. 7,127,069.

19 6. Contingent on the outcome of preliminary motions, a motion for judgment based  
20 on priority.

21 7. IGT also may request permission to file certain responsive motions contingent  
22 upon the motions list presented by Legal iGaming.

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