1	Filed	on behalf of:	Paper No. 2/	
2		IGT		
4		101		
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15				
16		UNITED STATES PATENT AND TR	ADEMARK OFFICE	
17				
18				
19		BEFORE THE BOARD OF PAT	TENT APPEALS	
20		AND INTERFEREN	ICES	
21				
22				
23		. Legal iGaming, In	c.	
24		Junior Party		
25		(Application 10/658,	836	
26		Inventors: Rolf E. Carlson and Micl		
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 Part	_	
35			•	
36		Patent Interference No. 105	,747 (RES)	
37		Technology Center 2		
38		.,		
39				
40		IGT MOTION LIS	ST	
4.1				



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 writt						
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						
11	additional discovery into the basis for the naming of, and subsequent removal						
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						
14	additional discovery absent a specific basis for expecting that the discovery w						
15	be productive, IGT presents the following detailed basis:						
16	a. The '836 Application, as originally filed, consisted of the specification a						
17	figures of Legal iGaming's prior U.S. Application No. 08/358,242 and						
18	preliminary amendment to incorporate by reference (i) four addition						
19	applications owned by Legal iGaming, and (ii) IGT's involved patent a						
20	a related application owned by IGT. The preliminary amendment a						



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copied verbatim the claims of IGT's involved patent. Thus, five prior

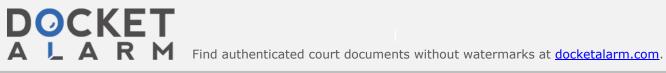
1		applications owned by Legal iGaming constitute the entirety of the as-filed
2		disclosure in the '836 Application, save for the material copied directly
3		from IGT to provoke the Interference.
4	b.	Michael W. Saunders was not named as an inventor in any of the five
5		prior applications owned by 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.



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Saunders contributed is present in any of the claims of those five prior

I		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. Application No. 09/732,650, filed December 7, 2000, now issued as U.S. Patent 17 No. 7,127,069. 18 6. 19 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



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upon the motions list presented by Legal iGaming.

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