

Mail Stop Interference
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Entered: October 21, 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)

Before: RICHARD E. SCHAFER, JAMESON LEE, and SALLY C.
MEDLEY, *Administrative Patent Judges*.

Opinion by SCHAFER, *Administrative Patent Judge*.

Decision - Interlocutory Motions - 37 C.F.R. § 41.125(b)

IGT has filed a motion asserting that the subject matter of its and iGaming's claims are patentably distinct and do not interfere. We deny the motion.

The Parties' Subject Matter

The subject matter claimed by each party relates to the authorization of transfers between networked computer gaming machines, particularly casino-type gaming machines. Each of the parties employs an “authorization agent” that is used to determine whether to allow the transfer. In iGaming’s claims the authorization is for transfer of “gaming information.” In IGT’s claims the authorization is for transfer of “gaming software.”

The Parties' Positions

IGT argues that iGaming’s claimed subject matter relating to the transfer of “gaming information” does not anticipate or render obvious transfer of “gaming software” as those phrases are used in the parties’ respective claims.¹ Paper 25, p. 1.

iGaming has filed a somewhat curious response. Paper 36. Notwithstanding that it copied claims to provoke an interference with IGT’s patent, iGaming says that it

does not oppose IGT’s requested relief that the Board determine that iGaming’s claimed inventions relating to the transfer of “gaming information” would not be anticipated or obvious in view of IGT’s claimed inventions relating to the transfer of “gaming software,” or vice versa.

Paper 36, p. 3, ll. 12-15. iGaming further states that it “takes no position on either the anticipation or obviousness analysis on this motion” Paper

¹ For the purpose of determining whether an interference-in-fact is present, the claims are interpreted according to the general rule that claim language is interpreted in light of the specification of which they are a part. The exception to the general rule set forth in *Agilent Techs., Inc. v. Affymetrix Inc.*, 567 F.3d 1366, 1375 (Fed. Cir. 2009), does not apply because written description is not at issue in this motion.

36, p. 3, ll. 15-17. Instead of challenging IGT's arguments on no interference-in-fact, it challenges IGT's proposed construction of certain of the phrases used in the parties' claims:

[T]he Board, in making its determination as to whether there is no interference-in-fact in this matter, is respectfully requested to reject the claim constructions proposed by IGT and adopt those proposed by iGaming.

Paper 36, p. 17, ll. 10-12.

Analysis

A.

IGT has the burden of proving entitlement to the relief requested. 37 C.F.R. § 41.121(b). An interference exists if a claim of one party, when taken as prior art, anticipates or renders obvious a claim of the other party and vice versa. 37 C.F.R. § 41.203(a). Under this standard, IGT must prove that iGaming's claims, when presumed to be prior art, neither would have anticipated, nor have rendered obvious, the subject matter of any IGT's claims or vice versa. *Yorkey v. Diab*, 605 F.3d 1297, 1300, 94 USPQ2d 1444, 1447 (Fed. Cir. 2010). In other words, in order for IGT to show that the parties do not interfere, it must show that there is no pair of claims --one coming from each party-- that meet the two-way test for interference-in-fact. On the other hand, if there remains a single pair of claims that satisfy the two-way test, then IGT has failed to satisfy its burden.

B.

In IGT's view, the subject matter of iGaming's claims does not describe or render obvious the use of a "software authorization agent" that authorizes and monitors the transfer of gaming "software" from one gaming machine to another. Paper 25, p. 1. By "gaming software" IGT means the code or set of instructions executed on a gaming computer to play the game.

Paper 25, p. 4. IGT's Claim 84 is representative and is reproduced in the margin with paragraphing and emphasis added.²

iGaming's claims do not refer to a "software authorization agent" or to "gaming software." Rather, those claims specify an "authorization agent" that authorizes the transfer of "gaming information". See e.g., Paper 36, p. 9. iGaming says "gaming information" is any information associated with game play or a gaming device." Paper 36, p. 8. iGaming's Claim 112 is representative and reproduced in the margin with added paragraphing and bolding.³

² IGT Claim 84:

84. In a first gaming device, a method of transferring **gaming software** to a second gaming device, said method comprising:

receiving a **gaming software transaction** request from the second gaming device;

sending the **gaming software transaction** request to a gaming **software authorization agent** that approves or rejects the transfer of **gaming software**;

receiving an authorization message from the gaming **software authorization agent**

wherein the authorization message includes information indicating whether the first gaming device is authorized to transfer the **gaming software** to the second gaming device; and

transferring the **gaming software** to the second gaming device;

wherein the gaming **software** is for at least one of

- a) a game of chance played on a gaming machine,
- b) a bonus game of chance played on a gaming machine,
- c) a device driver for a for a device installed on a gaming machine,
- d) a player tracking service on a gaming machine and
- e) an operating system installed on a gaming machine.

³ iGaming Claim 112:

112. In a first gaming device, a method of transferring **gaming information** to a second gaming device, said method comprising:

receiving a **gaming transaction** request;

sending the **gaming transaction** request to a gaming **authorization agent** that authorizes the transfer of **gaming information**;

receiving a message on the first gaming device from the authorization agent

wherein the message includes information authorizing the first gaming device to transfer the gaming information to the second gaming device

IGT's motion takes iGaming's claims as presumed prior art and argues that its claimed subject matter is patentably distinct from iGaming's subject matter. Paper 25, pp. 8-14. We will take iGaming's Claim 112 as representative of the presumed prior art and compare it with IGT's Claim 84.

Comparing the two claims, we see two differences. First, iGaming's Claim 112 requires that the gaming machines be separate from the authorization agent, a requirement not found in IGT's Claim 84. The second difference relates to what is authorized to be transferred and the content of the transfer. In iGaming's Claim 84 it is "gaming information." In IGT's Claim 112 it is "gaming software."

The first difference does not patentably distinguish the subject matter. While the requirement that the authorization agent be separate from the gaming machines is not a requirement of IGT's Claim 84, there is no language in Claim 84 that excludes that concept. Indeed, as indicated by IGT's specification and drawings, the use of an authorization agent separate from the gaming machines is contemplated as part of its invention. *See*, Patent 7,168,089, Figs. 8-12 and Claim 1.

We also think the references in IGT's Claim 112 to "gaming software" do not recite a patentable distinction of iGaming's Claim 84. The characterization of what is to be transferred does not appear to create any functional differences between the parties' methods. In this regard, we think the issue here is analogous to that raised when printed matter is relied upon to distinguish claims from the prior art, and that the issue is governed by the

wherein the first gaming device and the second gaming device are separate from the authorization agent; and
transferring the gaming information to the second gaming device;
wherein the **gaming information** is for
a game of chance played on a gaming machine.

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