

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GAME SHOW NETWORK, LLC and WORLDWINNER.COM, INC.,
Petitioner,

v.

JOHN H. STEPHENSON,
Patent Owner.

Case IPR2013-00289
Patent 6,174,237

Before SALLY C. MEDLEY, KEVIN F. TURNER, and
BENJAMIN D. M. WOOD, *Administrative Patent Judges*.

MEDLEY, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. BACKGROUND

Game Show Network, LLC and WorldWinner.com, Inc. (collectively “Petitioner”) filed a Petition (Paper 1; “Pet.”) seeking *inter partes* review of claims 1–19 of U.S. Patent No. 6,174,237 (“the ’237 patent”) pursuant to 35 U.S.C. §§ 311–319. On November 19, 2013, we instituted an *inter partes* review of claims 1–19 on two grounds of unpatentability (Paper 8; “Dec. on Inst.”).

Subsequent to institution, John H. Stephenson (“Patent Owner”) filed a Patent Owner Response (Paper 22; “PO Resp.”), and Petitioner filed a Reply (Paper 35; “Pet. Reply”).

Patent Owner filed a Motion to Exclude (Paper 41; “Mot. to Exclude”) Exhibits 1011, 1012, 1013, 1014, and 1021. Petitioner filed an Opposition to the Motion to Exclude (Paper 43; “Exclude Opp.”), and Patent Owner filed a Reply (Paper 44; “Exclude Reply”).

An oral hearing was held on July 10, 2014, and a transcript of the hearing is included in the record (Paper 50; “Tr.”).

The Board has jurisdiction under 35 U.S.C. § 6(c). This final written decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73.

For the reasons that follow, we determine that Petitioner has shown by a preponderance of the evidence that claims 1–19 of the ’237 patent are unpatentable.

A. The '237 Patent

The '237 patent relates to tournament play having a qualifying round and a playoff round. The qualifying round is played between a player, through a computer terminal, and a host computer. The playoff round is played between those players obtaining a predetermined level of performance in the qualifying round and the host computer. The playoff round is played under the same rules and conditions as in the qualifying round, except that all the players are playing simultaneously within a specific time frame. Ex. 1001, 1:15–24.

B. Illustrative Claim

Claim 1 of the '237 patent is the only independent claim:

1. A method of playing a game of skill tournament having a qualifying round and a playoff round, and played over an interactive computer system, said interactive computer system having a host computer system, a plurality of terminals, computers and compatible software, said method comprising the following steps:

a. playing a game of skill in a qualifying round between a single player and the host computer;

b. evaluating the results of said qualifying round to determine if said player qualifies to be classified within a specific performance level from a plurality of performance levels ranging from a low performance level to a high performance level;

c. evaluating the results of said qualifying round to determine if said player qualifies to be classified within a qualifying performance level taken from said plurality of performance levels;

d. distributing to said player a performance level award, said performance level award being dependent upon the specific performance level obtained;

e. playing said game of skill in a playoff round between said player and the host computer simultaneously along with other players, wherein each player has been classified within a qualifying performance level;

f. evaluating the results of said playoff round to determine a tournament winner and subsequent ranking of players; and

g. distributing tournament awards to tournament participants.

C. Prior Art

The pending grounds of unpatentability in this *inter partes* review are based on the following prior art:

PCT International Publication No. WO 97/39811, published Oct. 30, 1997 (“Walker”) (Ex. 1002).

D. Pending Grounds of Unpatentability

This *inter partes* review involves the following grounds of unpatentability:

References	Basis	Claims
Walker	35 U.S.C. § 102(b)	1–3, 5, and 8–19
Walker	35 U.S.C. § 103	4, 6, and 7

II. ANALYSIS

A. Level of Skill of Person in the Art

In support of its Petition, Petitioner relies on the testimony of its expert, Dr. E. James Whitehead, Jr. (*e.g.*, Ex. 1005). In support of its Response, Patent Owner relies on the testimony of its expert, Stacy A. Friedman (*e.g.*, Ex. 2007). Both Dr. Whitehead and Mr. Friedman testify as to the level of skill a person in the art would have had at the time of the invention. *See, e.g.*, Ex. 1005 ¶ 25; Ex. 2007 ¶ 45. Mr. Friedman testified, however, that he disagreed with Dr. Whitehead's assessment that a person in the art would have had an undergraduate degree and significant first-hand experience observing, administering, and/or participating in competitive tournaments. Ex. 2007 ¶¶ 46–47. According to Mr. Friedman, a person of ordinary skill in the art at the time of the invention would have had either (1) a degree in computer science and one year of experience designing computer gaming, or (2) no formal degree and three to four years of experience designing computer gaming applications.

It is not necessary for us to resolve the apparent dispute to reach a determination on the merits, and both parties agree that we need not resolve, between Mr. Friedman and Dr. Whitehead, who is correct. Tr. 7–8, 25–27. For purposes of this decision, we find that the level of ordinary skill in the art is reflected by the prior art of record. *Okajima v. Bourdeau*, 261 F.3d. 1350, 1355 (Fed. Cir. 2001) (the prior art itself can reflect the appropriate level of skill in the art.)

B. Claim Interpretation

Consistent with the statute and legislative history of the Leahy–Smith America Invents Act, Pub. L. No. 112–29, 125 Stat. 284 (2011) (“AIA”), the Board interprets claims using the “broadest reasonable construction in light of the specification of the patent in which [they] appear[.]” 37 C.F.R. § 42.100(b); *see also* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,766 (Aug. 14, 2012). There is a “heavy presumption” that a claim term carries its ordinary and customary meaning. *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002). Also, we must be careful not to read a particular embodiment appearing in the written description into the claim if the claim language is broader than the embodiment. *See In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (“limitations are not to be read into the claims from the specification”).

1. “Playing a game of skill in a qualifying round between a single player and the host computer”

In the Decision on Institution, based on the arguments presented by Petitioner in the Petition and by Patent Owner in its Preliminary Response, we interpreted the above quoted claim 1 term to mean playing a game of skill in a qualifying round, where the game includes only one human player and is at least administered by a host computer. Dec. on Inst. 6–9. Petitioner agrees with this interpretation. Pet. 13; Pet. Reply 7. Patent Owner argues that the interpretation is incorrect, and that “playing a game of skill in a qualifying round between a single player and the host computer” means “playing a game of skill in a qualifying round where a single human player plays against a host computer opponent;” or stated another way, the

phrase requires both the single player and host computer to play the game in competition with each other. PO Resp. 23.¹ The interpretation proposed by Patent Owner would exclude single-player games of skill² while the original interpretation would include single-player games of skill. We are not persuaded that our original interpretation should be modified.

We begin with the language of claim 1, the sole independent claim. The preamble of claim 1 recites a method of playing a game of skill tournament having a qualifying round and a playoff round, and played over an interactive computer system. The first step of the method recites “playing a game of skill in a qualifying round between a single player and the host computer.” Thus, claim 1 requires playing a game of skill *between* a single player and the host computer.

Both parties agree that “between” means “by the common action of: jointly engaging.” PO Resp. 24 (citing Ex. 2001, 109); Pet. Reply 10. Patent Owner argues that the word “between” means that both the human player and host computer are playing the game as opponents or in competition. PO Resp. 24. As Petitioner points out, however, the definition of “between” includes cooperation—not just competition—between two parties. Pet. Reply 10; Ex. 1020, 91:2–13. The word *between*, in the context of claim 1, does not mean necessarily that the host computer is in competition with the single player. Nor are we persuaded by Patent Owner’s

¹ The parties also refer to this concept (e.g., playing the game in competition with each other) as “head-to-head competition.” *See, e.g.*, Pet. 12; PO Resp. 17; Pet. Reply 10–11.

² Single-player games of skill refers to those games where only one person is in competition (no opponent), such as traditional solitaire, trivia, crossword puzzles, etc. *See, e.g.*, Pet. 12; PO Resp. 24–25; Pet. Reply 8.

argument that “playing” a game requires the computer to play the game as a computer opponent. PO Resp. 24, 27; Ex. 2007 ¶¶ 58–59. Claim 1 does not require the computer to play the game as an opponent or for the single player and the host computer to compete against each other. As we determined in the Decision on Institution, claim 1 encompasses playing games of skill where a single player plays the game of skill, e.g., “single-player games” while the computer can “play” by administering the game, e.g., by keeping score, operating the game, and monitoring the player’s progress. Dec. on Inst. 7.

Dependent claim 10, which indirectly depends from claim 1, specifies that the game of skill is a card game that includes solitaire. Ex. 1001, 6:64. In the Decision on Institution, we determined that playing solitaire does not require head-to-head competition. Dec. on Inst. 7. Patent Owner argues, and Petitioner does not disagree, that solitaire can be played by two players—“double solitaire.” PO Resp. 24; Pet. Reply 10; Ex. 2004; Ex. 2005. It is not disputed, however, that “solitaire” is traditionally a single-player game, and that the Specification of the ’237 patent does not describe a two-player version of solitaire. Ex. 2007 ¶ 59; Ex. 1020, 102:8–9, 109:23–110:11. We are not persuaded by Patent Owner’s argument that claim 10 is limited to a two-player version of solitaire, but excludes the traditional single-player version of solitaire. PO Resp. 24. There is nothing in the Specification of the ’237 patent that would have indicated to a person of ordinary skill in the art that Patent Owner intended to exclude traditional single-player versions of games of skill. Moreover, Patent Owner’s argument is based on the premise that we should construe narrowly claim 1 to exclude single player games, and then to make all other dependent claims

fit that narrow construction. Patent Owner's position is contrary to the legal requirements of claim construction. Rather, we look to the use of terms in other claims, such as dependent claims, to ascertain the meaning of terms in broader independent claims. *See* 35 U.S.C. 112, ¶ 4; *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342 (Fed. Cir. 2001); Tr. 35 (“Mr. Leach: . . . And the fact that a claim has a specific limitation in claim 1, you don't broaden it out just because it may not capture every variant that's in a dependent claim. Judge Turner: Well, I think I do. I think that's what the court is telling me I have to do, doesn't it?”).

We next look to the specification to determine if our construction is consistent with the specification. Patent Owner argues that the Specification uses the terms “between” and “against” interchangeably, and that the Specification describes embodiments where the computer is competing against a single player. PO Resp. 24 (citing Ex. 2002, Abstract). Even so, we disagree, that “against” should be read into the claim in place of “between” as Patent Owner urges us to do. Claim 1 recites “between” not “against” and Patent Owner has not shown that it defined the term “between” in the Specification of the '237 patent with reasonable clarity, deliberateness, and precision to mean “against.” *See In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994).

At issue in this case, is the meaning of the following portion of the Specification of the '237 patent:

The qualifying round is played between a single player through a computer terminal and a host computer. The host computer has the ability to act as a game sponsor by keeping score, operating the game, monitoring the player's progress and to distribute awards when appropriate. Also, the host computer

has the ability to act as another player if the game requires more than a single player.

PO Resp. 27–28 (citing Ex. 1001, col. 2, ll. 7–15).

Petitioner argues that the above paragraph is consistent with the “at least administered by the host computer” construction, because the second and third sentences describe an embodiment where the host computer acts as a sponsor by administrating the game, but does not act necessarily as an opponent for single player games. Pet. 12; Pet. Reply 7–8. Patent Owner argues that the above paragraph is consistent with its construction that the host computer acts as an opponent, because the paragraph describes that the computer acts as an opponent at all times. PO Resp. 27–29. In other words, Patent Owner interprets the first sentence to mean that the host computer plays as an opponent, the second sentence to mean that the host computer additionally can act as a game sponsor, and the third sentence to mean that the computer additionally can act as yet another opponent (e.g., as a team against the single player) if the game requires more than a single computer player. PO Resp. 28–29; Ex. 2007 ¶¶ 62–66.

We have reviewed the expert testimony from both sides with respect to how a person of ordinary skill in the art would interpret the above paragraph. *See, e.g.*, Ex. 1005 ¶ 35; Ex. 2007 ¶¶ 62–66; We give more weight to Dr. Whitehead’s testimony³ than we do to Mr. Friedman’s testimony, because we find that Dr. Whitehead’s testimony is consistent with the words from the above recited paragraph of the Specification, while

³ Patent Owner argues that the Board should give Dr. Whitehead’s testimony little weight. PO Resp. 9–10. We are not persuaded by the arguments, because the evidence to which we are directed does not support the conclusion that Dr. Whitehead’s declaration was “spoon-fed” to him as asserted. *Id.*

Mr. Friedman’s testimony is not. The first sentence is a general description and the second and third sentences explain the role of the host computer in the context of the first sentence. Importantly, the third sentence explains that “if the game requires more than a single player” the host computer has the ability to act as another player beyond the “single [human] player.” We disagree with Patent Owner that reference to “single player” in the third sentence means “single [computer] player” as Patent Owner asserts. PO Resp. 28–29. We agree with Petitioner and its expert that a person of ordinary skill in the art would have read the paragraph to mean that the game that may be played by the system can be a single player game, where the computer merely sponsors the game but does not play as an opponent. Moreover, there are several examples of games listed in the Specification that even Patent Owner’s expert Mr. Friedman recognizes are traditionally single player games, such as solitaire, word search, crossword puzzles, and trivia games. Ex. 1001, 3:43–52; Ex. 2007 ¶ 59; Ex. 1020, 102:8–9, 109:23–110:11. The description of these traditional single player games further supports the reading of the above paragraph to include single player games where the host computer would not play the game in competition, but would merely administer the game. The Specification is, therefore, consistent with our previous interpretation. Dec. on Inst. 6–9.

Applying the broadest reasonable interpretation of the claims in light of the Specification of the ’237 patent, “playing a game of skill in a qualifying round between a single player and the host computer” means playing a game of skill in a qualifying round, where the game includes only one human player and is at least administered by a host computer.

2. *“Playing said game of skill in a playoff round between said player and the host computer simultaneously along with other players”*

In the Decision on Institution, based on the arguments presented by Petitioner in the Petition and by Patent Owner in its Preliminary Response, we interpreted the above quoted claim 1 term to mean “playing the game of skill in a playoff round at least administered by the host computer and in which the human player involved in the qualifying round and at least two other human players are playing at the same time.” Dec. on Inst. 9–10. Petitioner agrees with this interpretation. Pet. 15. Patent Owner argues that the interpretation is incorrect, because the phrase does not require at least two other human players are playing (in addition to the “said player”) at the same time. PO Resp. 30. Patent Owner argues that “other players” means “at least one other player.” In addition, Patent Owner argues that the claim requirement “simultaneously” should be construed to mean that there is some overlap in play.⁴ *Id.*

Patent Owner is arguing for a broader interpretation than the one in the Decision on Institution. Instead of our construction of “at least two other human players,” Patent Owner’s proposed broader construction includes “at least one other human player.” We need not resolve this issue for purposes of this decision. Patent Owner’s broader construction encompasses our narrower construction and would include at least two other human players.

⁴ The disputed term includes language that is similar to step (a) regarding the playing between a player and computer. Patent Owner, however, does not present arguments regarding playing a game between a player and the host computer in the context of the disputed limitation. To the extent that Patent Owner does make such arguments, the analysis for both steps (a) and (e) regarding playing a game of skill between a player and host computer would be the same.

Moreover, we need not resolve the issue of whether “simultaneously” means that there is some overlap in play, because our construction of simultaneously to mean at the same time would include some overlap in play and even Patent Owner recognizes that the distinction is minor. PO Resp. 31.

Applying the broadest reasonable interpretation of the claims in light of the Specification of the '237 patent, “playing said game of skill in a playoff round between said player and the host computer simultaneously along with other players” means playing the game of skill in a playoff round at least administered by the host computer and in which the human player involved in the qualifying round and at least two other human players are playing at the same time.

3. *“Evaluating the results of said qualifying round”*

Claim 1 recites “evaluating the results of said qualifying round” in steps (b) and (c). Patent Owner argues that the “evaluating the results” steps mean that a single human player is evaluated based solely on the single human player’s performance (against the computer) and not based on comparing that performance against any other player who played a game of skill. PO Resp. 33–34. Petitioner disagrees with Patent Owner’s proposed construction and argues that there is no requirement in the claims that the “evaluating the results” steps are based on a single player’s performance (e.g., “absolute criteria”). Pet. Reply 2–3. Petitioner argues that the claim does not preclude evaluating the results of the qualifying round based on evaluating multiple performances of multiple players that participated in a qualifying round. Petitioner concludes that the evaluating limitations cover

either an absolute evaluation of a single player's performance or a relative evaluation of multiple players' performances. *Id.* at 4.

We did not construe the meaning of the term "evaluating the results of said qualifying round" in connection with the Decision on Institution. We do so here, because it is an issue that is germane to our patentability determination.

We begin with the plain language of the claim. First, we agree with Petitioner that there is nothing in the language itself that explains how the evaluating is performed. That is, there is nothing in claim 1 itself that suggests that the evaluating must be done based on the single player's performance of the game of skill in isolation of any other factors or criteria. Thus, we are not persuaded by Patent Owner's argument that the disputed language means evaluating a single player "into predetermined, absolute performance levels independent of their performance relative to others in the qualifying round." PO Resp. 36. The claim is based on evaluating the results of the *qualifying round*, not the results of the one single game that the one single human player played. There is nothing in the claim language that specifies that the *qualifying round* is based on a single game played by a single human player despite Patent Owner's argument to the contrary. *See Id.* at 33. While the "game of skill" recited in step (a) refers to a game played by a single player, the qualifying round is not so limiting. The qualifying round may include other single players playing their own games of skill between themselves and the host computer. Claim 1 does not put limits on what constitutes the qualifying round or the evaluating of a qualifying round. Indeed, step (e) of claim 1 recites the playoff round to be "between said player . . . and other players" that qualified from the

qualifying round, which could include the participation of multiple human players in the qualifying round. As Petitioner points out, too, Patent Owner's expert admitted that the qualifying round could include multiple players. Pet. Reply 4; Ex. 1020, 58:8–60:16. Based on the plain language of claim 1, the evaluating steps evaluate the qualifying round, which could include more than one game and more than one player. Accordingly, the evaluating steps may be based (1) on the multiple performances of the multiple players that participated in the qualifying round or (2) on the absolute evaluation of a single player's performance. Claim 1 is broad and covers both scenarios.

We have considered the examples in the specification to which Patent Owner directs our attention regarding evaluating a single player's performance based on whether the player has scored a sufficient number of points to qualify for the qualifying round—an absolute criterion. However, those are examples and there is nothing in the Specification which suggests that we should limit our reading of claim 1 to include them. Claim 1 is silent with respect to how a player's performance is evaluated, and, based on the record before us, we decline to read limitations from the specification into the claims.

Applying the broadest reasonable interpretation of the claims in light of the Specification of the '237 patent, the steps of “evaluating the results of said qualifying round” may be based (1) on the multiple performances of the multiple players that participated in the qualifying round or (2) on the absolute evaluation of a single player's performance.

4. *“Performance level award increases as a player qualifies for higher performance level classifications”*

Claim 4 depends directly from claim 1 and recites “wherein said performance level award increases as a player qualifies for higher performance level classifications.” The “said performance level award” is in reference to the performance level award of claim 1 step (d) which is dependent upon the performance level obtained in connection with a qualifying round. Patent Owner argues that the limitation “as a player qualifies” requires that the higher performance level classification be determinable while the player is playing, not after the qualifying round is complete. PO Resp. 39. Stated another way, Patent Owner argues that the player must be able to know that they have qualified for a higher performance level award as they are playing, not afterwards. *Id.* Petitioner disagrees and argues that claim 4 says nothing about when the player knows that he or she has qualified for a higher performance level. Pet. Reply 14.

We did not construe the meaning of the term “wherein said performance level award increases as a player qualifies for higher performance level classifications” in connection with the Decision on Institution. We do so here, because it is an issue that is germane to our patentability determination.

There is no requirement, in the claims themselves, that specifies when the performance level classification is determined—it could be during, or after the player has played the qualifying round. We disagree with Patent Owner that the plain language of “as a player qualifies” means that the determination is performed while the player is playing the game of skill. The term “as a player qualifies” does not mean “as a player plays the game.”

The Specification of the '237 patent supports the construction that the performance level classification may be determined after the player has played the qualifying round because it describes that “after each player has completed the qualifying round, the results are analyzed.” Ex. 1001, 5:23–24.

Applying the broadest reasonable interpretation of claim 4 in light of the Specification of the '237 patent, “wherein said performance level award increases as a player qualifies for higher performance level classifications” includes determining the higher performance level classification, and thus the award, after a player plays the game.

5. *“Said game of skill is based on the memory reaction of the player”*

Claim 15 depends directly from claim 1 and recites “wherein said game of skill is based on the memory reaction of the player.” In the Decision on Institution, based on the arguments presented by Petitioner in the Petition and by Patent Owner in its Preliminary Response, we interpreted the above quoted claim 15 term to mean that the game of skill involves assessing both a player’s memory and how quickly the player reacts. Dec. on Inst. 12. Patent Owner disagrees that “memory reaction” involves the assessment of two things—memory and reaction, but involves the assessment of “reaction involving memory.” PO Resp. 32–33. We see no distinction between the two constructions, and in any event, the construction of claim 15 does not matter to our determination of the patentability of that claim. Accordingly, we adopt our previous construction. Dec. on Inst. 12.

Neither party contests the Decision on Institution construction for the claim 1 phrase “game of skill,” “evaluating the results of said playoff round

to determine a tournament winner and subsequent ranking of players” or the order of steps (b) and (c) construction of claim 1, and we discern no reason on the record before us to change the construction of these terms. Dec. on Inst. 5–6, 10–12. Accordingly, we adopt those constructions here.

C. Claims 1–3, 5, and 8–19 are Anticipated by Walker

With respect to the alleged anticipation of claims 1–3, 5, and 8–19 over Walker, we have reviewed the Petition, Patent Owner Response, and Petitioner Reply, as well as the evidence discussed in each of those papers. We are persuaded, by a preponderance of the evidence, that claims 1–3, 5, and 8–19 are unpatentable under 35 U.S.C. § 102(b) as anticipated by Walker.

1. Walker

Walker describes a method and system for a distributed electronic tournament system in which remotely located players participate in a tournament through input/output devices connected to a central controller that manages the tournament. Ex. 1002, Abstract.

Figure 1 of Walker, reproduced below, illustrates a portion of the electronic tournament system.

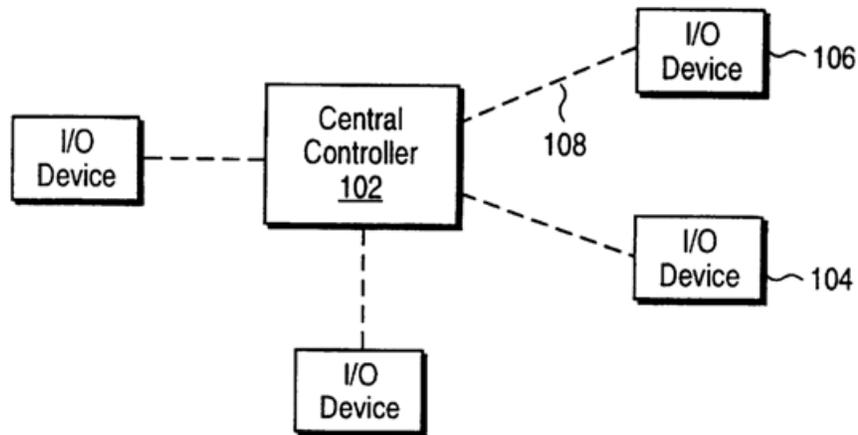


FIG. 1

Figure 1 depicts a distributed electronic tournament system.

Figure 1 of Walker shows a plurality of input/output (I/O) devices 104, 106 (plurality of terminals) connected to central controller 102 (host computer) through network 108, such as the Internet. *Id.* at 9. Operating system software runs the central controller hardware and controls and coordinates all tournament software applications, including running tournament games, registering players, accepting entry fees, and coordinating prize payment. *Id.*

Players may participate in various strategy games (games of skill), such as chess, checkers, bridge, or puzzles like crossword or jigsaw. *Id.* at 15, 16:4–5. Walker describes a “qualifying round” of play in which a player may qualify to advance to the next level. *Id.* at 14:6–15. Host computer 102 participates in the qualifying round by administering the game, such as by keeping a player’s score and determining whether the player qualifies to

advance to the next round (e.g., playoff round). *Id.* at 15:15–20. Walker describes single-player games, such as trivia and crossword puzzles. *Id.* at 3:3–10, 15:11, 17–18. For the example of trivia play, Walker describes a single human player having completed twenty questions of the first round (qualifying round), and that the host computer then would determine, based on the player’s performance, whether the player had qualified to advance to the next round. *Id.* at 15:15–20.

Walker also describes that the tournament system evaluates the results of play, and as the tournament progresses, more and more players are eliminated. Moreover, when a player advances from one game session to the next, the player may qualify for a prize or recognition. *Id.* at 15:29–16:2. Lastly, a tournament winner is determined after a final round of an elimination tournament and prizes are awarded. *Id.* at 15:20–21.

2. Claim 1

Petitioner relies on Walker as teaching the method of playing a game of skill tournament limitations of claim 1. Pet. 19–29. Patent Owner argues that Walker does not anticipate claim 1 because Walker does not describe 1) the steps (b) and (c) of “evaluating the results of said qualifying round” and 2) playing a game of skill in a qualifying round between a single player and the host computer.

a. Evaluating the results of said qualifying round

Patent Owner argues that Walker does not describe that the evaluating of results of the qualifying round is determined based on a single player’s performance. PO Resp. 35. Patent Owner argues that Walker instead

describes that the evaluating is determined based on the player's performance as well as the performance of other players in the qualifying round, directing attention to the following description in Walker:

Another preferred embodiment includes the step of determining whether a player has qualified for advancement to the next game session. This includes the step of the central controller reviewing the player's score *after the just-concluded game session*. This score is *compared to the scores obtained by all of the other players* in the session.

PO Resp. 35 (citing Ex. 1002, 14 (emphasis added by Patent Owner)).

Patent Owner's argument is based on its proposed construction of claim 1. As discussed above in the claim construction section, we disagree with Patent Owner that the broadest reasonable interpretation of the evaluating steps is based on any particular criteria. No criteria are claimed. Rather, the "evaluating the results of said qualifying round" steps are broad and may be based (1) on the multiple performances of the multiple players that participated in the qualifying round or (2) on the absolute evaluation of a single player's performance.

As Patent Owner has highlighted with respect to the above passage from Walker, Walker describes evaluating the results based on the multiple performances of the multiple players that participated in the qualifying round, and, therefore, Walker describes the disputed limitation.

b. "Playing a game of skill in a qualifying round between a single player and the host computer"

Patent Owner argues that Walker does not describe a host computer acting as an opponent playing a human player in either a qualifying round or

playoff round. PO Resp. 37. Patent Owner's arguments are based on a narrow claim interpretation that we have not adopted.

As discussed above in the claim construction section, we disagree with Patent Owner that the broadest reasonable interpretation of the "playing a game of skill . . . between a single player and the host computer" means that the host computer competes against the single player. Applying the broadest reasonable interpretation of the claims in light of the Specification of the '237 patent, "playing a game of skill in a qualifying round between a single player and the host computer" means playing a game of skill in a qualifying round, where the game includes only one human player and is at least administered by a host computer.

Petitioner has shown, by a preponderance of the evidence, that Walker describes the disputed limitation. Pet. 20–21. For example, Walker describes a "qualifying round" of play in which a player may qualify to advance to the next level. Ex. 1002, 14:6–15. Host computer 102 participates in the qualifying round by administering the game, such as by keeping a player's score and determining whether the player qualifies to advance to the next round (e.g., playoff round). *Id.* at 15:15–20.

Patent Owner argues that absent from the Petition is a description of what is performing the claimed method, and that such absence highlights the requirement of the claims that the computer system plays the game as required by every claim. PO Resp. 37–38. The argument is not persuasive because it is not commensurate in scope with what is claimed. None of the claims recite that "the computer system plays the game." Moreover, Patent Owner has not shown specifically what is missing from the Petition, or that the Petition does not address how the Walker reference anticipates claim 1,

for example. Claim 1 is a method claim and recites various steps. The method steps do not recite which of the components of the “interactive computer system” are performing the steps. Rather, the method steps primarily are functional in nature. The Petition focuses on this functional language of the claims in its Petition. *See, e.g.*, Pet. 19–29.

Accordingly, we determine that Petitioner has shown by a preponderance of the evidence that the claim 1 is unpatentable.

3. Dependent Claims 2, 3, 5, and 8–19

Patent Owner makes no arguments regarding the additional limitations recited in dependent claims 2, 3, 5, and 8–19. PO Resp. 33–38. Upon review of Petitioner’s evidence and analysis, we are persuaded that Petitioner has demonstrated that Walker discloses the limitations of dependent claims 2, 3, 5, and 8–19. Pet. 30–40. Accordingly, we determine that Petitioner has shown by a preponderance of the evidence that the dependent claims 2, 3, 5, and 8–19 are unpatentable.

D. Claims 4, 6, and 7 are Obvious in View of Walker

With respect to the alleged obviousness of claims 4, 6, and 7 over Walker, we have reviewed the Petition, Patent Owner Response, and Petitioner Reply, as well as the evidence discussed in each of those papers. We are persuaded, by a preponderance of the evidence, that claims 4, 6, and 7 are unpatentable under 35 U.S.C. § 103 as obvious in view of Walker.

1. Dependent Claim 4

Claim 4 depends directly from claim 1 and recites “wherein said performance level award increases as a player qualifies for higher performance level classifications.” The “said performance level award” refers to the performance level award of claim 1 step (d), which in turn refers to the performance level obtained in a qualifying round. In other words, claim 1 step (d) requires, “distributing to said player a performance level award, said performance level award being dependent upon the specific performance level obtained” in a qualifying round. Thus, the performance level award recited in claim 4 is dependent on the performance level obtained from the qualifying round.

Walker describes that a player may be awarded a prize after a qualifying round. Ex. 1002, 16:1–2. Walker further teaches that an award a player may receive at the end of a tournament (after the playoff round) increases as a player qualifies for higher performance level classifications. *Id.* at 13:29–30. The difference, however, between claim 4 and Walker is that Walker does not describe that an award a player may receive after a qualifying round “increases as a player qualifies for higher performance level classifications.” Petitioner argues that it would have been obvious to provide multiple levels of awards after a qualifying round because doing so would promote competition by providing an incentive to perform at the highest possible level during the qualifying round. Pet. 48; Ex. 1005 ¶ 78.

Patent Owner argues that Walker does not describe using a pre-established absolute list of performance levels for determining advancement to a subsequent playoff round. PO Resp. 40. The argument is based on Patent Owner’s proposed construction of the terms of claim 4. In particular,

Patent Owner argues that claim 4 requires that the higher performance level classification be determinable while the player is playing, not after the qualifying round, which would result in using a pre-established list of performance levels for determining advancement to a subsequent playoff round. *Id.* at 39.

Patent Owner's arguments are based on a narrow interpretation of claim 4. As discussed above in the claim construction section, we disagree with Patent Owner that the plain language of "as a player qualifies" means that the determination is performed while the player is playing the game of skill. The term "as a player qualifies" does not mean "as a player plays the game." As discussed above, "wherein said performance level award increases as a player qualifies for higher performance level classifications" includes determining the higher performance level classification, and thus the award, after a player plays the game. Moreover, as discussed above in the claim interpretation section, there is nothing in claim 1 that limits how the evaluating is performed and claim 1 could include evaluating each player that played in a qualifying round based on each other's performances (e.g., relative) and not necessarily based on an absolute evaluation as Patent Owner argues.

Patent Owner's arguments are based on a narrow claim construction. We decline to adopt such a construction for the reasons provided above. Patent Owner makes no other arguments regarding the propriety of Petitioner's obviousness showing with respect to claim 4.

2. *Dependent Claims 6 and 7*

Although Patent Owner categorizes claims 6 and 7 separately, the arguments are directed to claim 1. PO Resp. 40–42. We have addressed those arguments.

E. Patent Owner’s Motion to Exclude

Patent Owner moves to exclude Exhibits 1011, 1012, 1013, 1014, and 1021. Mot. to Exclude 1. In its Reply, Petitioner relies on the exhibits to show alleged inconsistent positions taken by Patent Owner in connection with the meaning of “playing a game of skill between a single player and a host computer” in an earlier district court proceeding involving Patent Owner and a third party. Pet. Reply 13. We did not and need not consider such arguments or evidence in connection with the Reply. We have determined that Petitioner has demonstrated, by a preponderance of the evidence, that all of the claims 1–19 are unpatentable, without considering Petitioner’s arguments regarding the alleged inconsistent positions taken by Patent Owner in the earlier district court proceeding.⁵ Accordingly, we *dismiss* Patent Owner’s Motion to Exclude.

III. CONCLUSION

We conclude that Petitioner has demonstrated by a preponderance of the evidence that claims 1–3, 5, and 8–19 are anticipated under 35 U.S.C.

⁵ During oral hearing, counsel for Petitioner represented that it was his expectation that the Board would not, nor need not, rely on the Exhibits 1011, 1012, 1013, 1014, and 1021 to render a final decision. Tr. 15:3–7, 18:16–20.

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§ 102 by Walker, and that claims 4, 6, and 7 would have been obvious under 35 U.S.C. § 103 over Walker.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that claims 1–19 of the '237 patent have been shown by a preponderance of the evidence to be unpatentable; and

FURTHER ORDERED that Patent Owner's Motion to Exclude is *dismissed*.

This is a final decision. Parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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