Trials@uspto.gov
571-272-7822

Paper 51
Entered: November 7, 2014

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.)

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS
Sync your system to PACER to automate legal marketing.