

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

SONY INTERACTIVE ENTERTAINMENT LLC,  
Petitioner,

v.

BOT M8, LLC,  
Patent Owner.

---

IPR2020-00922  
Patent 8,078,540 B2

---

Before, KALYAN K. DESHPANDE, JAMES A. TARTAL, and  
AMBER L. HAGY, *Administrative Patent Judges*.

TARTAL, *Administrative Patent Judge*.

JUDGMENT  
Final Written Decision  
Determining All Challenged Claims Unpatentable  
35 U.S.C. § 318(a)

We have jurisdiction to conduct this *inter partes* review under 35 U.S.C. § 6. This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a) (2018) and 37 C.F.R. § 42.73 (2019). For the reasons discussed below, we determine Sony Interactive Entertainment LLC (“Petitioner”)<sup>1</sup> has shown by a preponderance of the evidence that claims 1–6 (“the Challenged Claims”) of U.S. Patent No. 8,078,540 B2 (Ex. 1001, “the ’540 patent”) are unpatentable.

## I. INTRODUCTION

### A. Summary of Procedural History

Petitioner filed a Petition pursuant to 35 U.S.C. §§ 311–319 requesting an *inter partes* review of the Challenged Claims. Paper 2 (“Pet.”). We instituted an *inter partes* review of the Challenged Claims on all grounds of unpatentability asserted in the Petition. Paper 9 (“Inst. Dec.”). Bot M8, LLC (“Patent Owner”)<sup>2</sup> filed a Patent Owner Response. Paper 13 (“PO Resp.”). Petitioner filed a Reply to the Patent Owner Response. Paper 16 (“Pet. Reply”). Patent Owner filed a Sur-reply. Paper 17 (“PO Sur-reply”).

Oral argument was held and a transcript of the hearing appears in the record. Paper 25 (“Tr.”). Petitioner bears the burden of proving unpatentability of each claim challenged by a preponderance of the evidence, and the burden of persuasion never shifts to Patent Owner. *See* 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d); *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015).

---

<sup>1</sup> Petitioner identifies itself and Sony Corporation, Sony Corporation of America, and Sony Interactive Entertainment, Inc., as real parties in interest. Pet. 70.

<sup>2</sup> Patent Owner identifies no additional real parties in interest. Paper 4, 1.

### *B. Related Proceedings*

The parties identify *BOT M8, LLC v. Sony Corporation of America*, 3:19-cv-07027 (NDCA) as a related proceeding. Petitioner explains that the '540 patent was a subject of that case, but that it “has been dismissed due to failure to state of [sic] claim of infringement.” Pet. 70; Paper 4, 1. The parties identify no additional related matters. *See id.*

### *C. The '540 Patent*

The '540 patent, titled “Gaming Machine, Gaming Information Authentication and Acquisition Device, and Gaming Information Acquisition Device,” issued December 13, 2011, from an application filed on February 16, 2010, which was a continuation of an application filed on April 17, 2006, that issued as U.S. Patent No. 7,693,282 (“the '282 patent”). Ex. 1001, codes (21), (22), (45), (54), (63). The '540 patent is directed to “a gaming machine, a gaming information authenticating and loading device, and a loading device for loading gaming information, whereby gaming information recorded on a portable storage medium can be authenticated.” *Id.* at 1:18–22.

The '540 patent explains, as background, that in “gaming machines” a “gaming program” is supplied “by means of a storage medium,” such as a “compact flash memory,” and is used to control “gaming information” consisting of the operations required for playing the game. *Id.* at 1:23–42. In prior systems, according to the '540 patent, the storage medium is detachable and at risk of “illegal actions, such as duplicating or manipulating the gaming information stored on the medium.” *Id.* at 1:43–48. The '540 patent also states that prior systems authenticated only the storage medium, not “the actual gaming information,” which may have been manipulated in some way. *Id.* at 2:14–20.

The '540 patent purports to resolve the issues identified with the prior systems by describing a system “whereby the gaming information stored on a storage medium can be authenticated.” *Id.* at 2:37–42; *see also* Pet. 1 (stating that according to the '540 patent “the prior art only authenticated the medium on which the game program was stored, not the game program itself,” and purports to solve this problem “by authenticating the game program, not just the storage medium, thereby preventing game-program modification”).

Figure 1 of the '540 patent is reproduced below.

**Fig. 1**

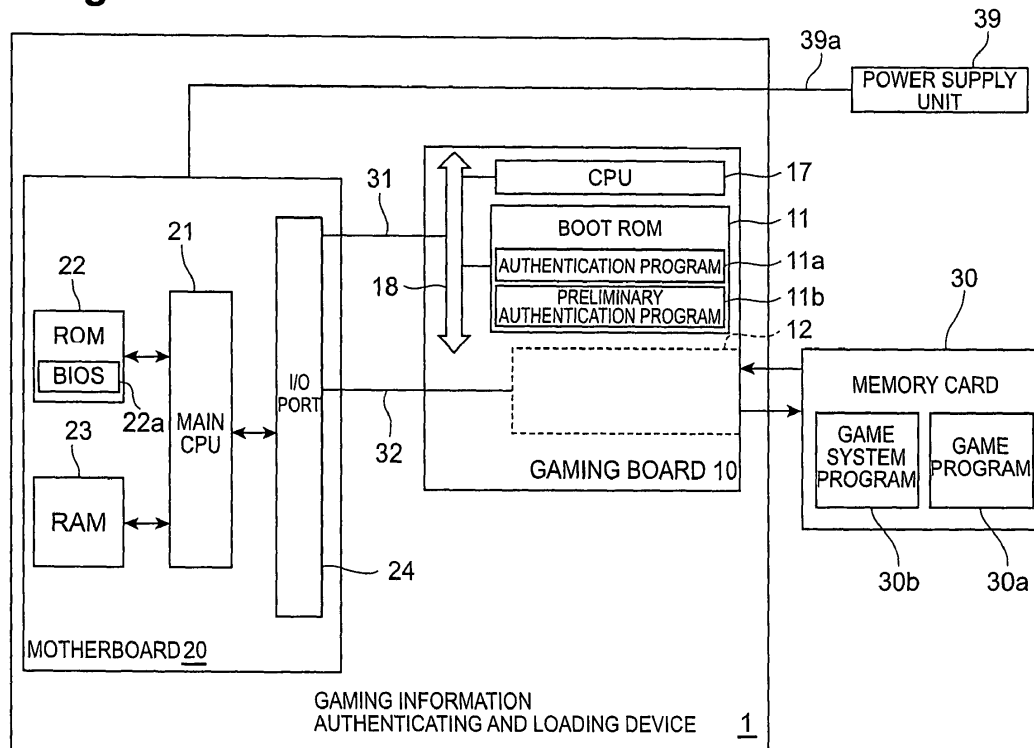


Figure 1 is “a block diagram showing the general constitution of a gaming information authenticating and loading device 1,” including gaming board 10 (a “loading device”) and motherboard 20 (a “processing device”). *Id.* at 5:25–30. Game program 30a and game system program 30b “form the

gaming information . . . and are stored on memory card 30.” *Id.* at 5:34–39. Gaming board 10, with card slot 12, CPU 17, and boot ROM 11, “loads a game program 30a and a game system program 30b . . . in the motherboard 20 from a memory card 30.” *Id.* at 5:40–46. PCI bus 31 transmits signals between motherboard 20 and gaming board 10. *Id.* at 5:49–52. “[C]ard slot 12 is connected to the motherboard 20 by means of an IDE bus 32.” *Id.* at 6:18–19.

“The boot ROM 11 stores an authentication program (first authentication program) 11a, a preliminary authentication program (second authentication program) 11b, . . . and a program (boot code) . . . for booting (starting up) the CPU 17 and the preliminary authentication program 11b.” Ex. 1001, 5:52–58. Authentication program 11a “states a procedure (authentication procedure) for authenticating the gaming information, in other words, checking and verifying that the gaming information, which is the object of the authenticating and loading process, has not been manipulated.” *Id.* at 61–65. “[P]reliminary authentication program 11b states a procedure (authentication procedure) for authenticating the authentication program 11a” to verify “that the authentication program 11a has not been manipulated.” *Id.* at 6:8–13.

Motherboard 20 is a “generic motherboard” and includes CPU (Central Processing Unit) 21, ROM (Read Only Memory) 22, RAM (Random Access Memory) 23, and I/O port 24 connected to PCI bus 31 and IDE bus 32. *Id.* at 6:25–32; *see also id.* at 11:12–17 (stating that “motherboard 20 is constituted by a commercially available generic motherboard, the motherboard 20 has highly generic characteristics and, consequently, it is possible to reduce manufacturing costs”). ROM 22 stores programs, such as BIOS 22a (standard BIOS on the motherboard 20), which

# 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.