IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re *Ex Parte* Reexamination of:	)
	)
Patent No. 6,264,560	) Control Number: Not Yet Assigned
	)
Inventors: S. Goldberg	) Group Art Unit: Not Yet Assigned
J. Van Antwerp	)
	) Examiner: Not Yet Assigned
Issue Date: July 24, 2001	)
Application No. 90/140,979	) Box: *Ex Parte* **Reexam**
Filed: August 27, 1998	)
	)
For: Method and System for Playing Games	)
on a Network	)

Mail Stop *Ex Parte* Reexam
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir or Madam:

REQUEST FOR *EX PARTE* REEXAMINATION

The Electronic Frontier Foundation (EFF),[1] a not-for-profit public organization that

works to protect free expression in all forms of electronic media, by and through its undersigned

attorneys, respectfully requests *ex parte* reexamination of claims 1-3, 16, 18, 20, and 92 of U.S.

Patent No. 6,264,560 ("the '560 patent"), titled "Method and System for Playing Games on a

Network," to Sheldon F. Goldberg *et al.* [Exhibit 1]. This Request submits substantial new

questions of patentability based on prior art patents and printed publications not previously cited

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[1] EFF thanks the following individuals for their significant contributions of time, energy,
resources, and analyses to this petition: David Ahn, Shannon Appelcline, James Cameron, Ryan
Scher, Kevin Smith, Sriranga Veeraraghavan, Dennis Wang, and the following students in the
Cyberlaw Clinic at Harvard Law School's Berkman Center for Internet & Society: Darin Beffa,
Elliott Davis, Derek Fahnestock, Devika Kornbacher, Agnes Li, and Nick Schunemen.

by or presented to the Patent and Trademark Office. These prior art references either fully

anticipate or, in combination, render obvious the claims of the '560 patent. Consequently, EFF

respectfully requests that the Office order an *ex parte* reexamination of the '560 patent and issue

a certificate canceling claims 1-3, 16, 18, 20, and 92.

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TABLE OF PRIOR ART RELIED UPON

Appendix A   U.S. Patent No. 4,856,787 to Itkis, *Concurrent Game Network*, filed May 3, 1988 (continuation of Ser. No. 826,269, filed Feb. 5, 1986), issued Aug. 15, 1989

Appendix B   U.S. Patent No. 5,347,632 to Filepp *et al.*, *Reception System For An Interactive Computer Network And Method Of Operation*, filed Jul. 28, 1989, issued Sep. 13, 1994

Appendix C   Michael Maurer *et al.*, *Frequently Asked Questions About Poker*, rec.gambling Usenet Newsgroup (posted Feb. 28, 1995), http://groups.google.com/group/rec.answers/msg/9f0812cdfdd732e8[2]

Appendix D   Manual "Manny" Raposa, *BJ Tourney at the IP,* rec.gambling Usenet Newsgroup (posted Feb. 24, 1992), http://groups.google.com/group/rec.gambling/msg/eabdbc28789394b0

Appendix E   Caren Eliezer, *Navigating Main Street: a user's experience with interactive TV; GTE Main Street,* 9 The Seybold Report on Desktop Publishing No. 5, 3 (Jan. 15, 1995)

Appendix F   Netrek BRMH-1.7 Client Source Code, http://ftp.netrek.org/pub/netrek/mirrors/ftp.csua.berkeley.edu.old/netrek/old/BRMH-1-7.tar.gz (last modified Oct. 16, 1993)

Appendix G   Netrek Server2.5pl4 Server Source Code, http://ftp.netrek.org/pub/netrek/mirrors/ftp.solace.mh.se/netrek/servers/vanilla/Server2.5pl4.tar.gz (last modified Dec. 15, 1994)

Appendix H   Andy McFadden, *The History of Netrek, through Jan 1 1994*, rec.games.netrek Usenet Newsgroup (posted May 1, 1994), http://groups.google.com/group/rec.games.netrek/msg/66264d6b5a4b1470

Appendix I   Joseph Rumsey, *Re: Beta testers for port of BRM 3.0 to Win 3.1 / NT wanted*, rec.games.netrek Usenet Newsgroup (posted Feb. 12, 1994), http://groups.google.com/group/rec.games.netrek/browse_frm/thread/9400abb64afd9810/2ba31d76f61174d0

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[2] In citations to Usenet postings now available on Google Groups, the date used for a posting is the "Local" date included in the header information.

EXHIBITS

Exhibit 1   U.S. Patent No. 6,264,560 to Goldberg *et al.*, *Method And System For Playing Games On A Network* (filed Aug. 27, 1998), issued July 24, 2001.

Exhibit 2   Matthew Gray, *Internet Growth Summary*, http://www.mit.edu/people/mkgray/net/internet-growth-summary.html (last visited Dec. 17, 2007)

Exhibit 3   Peter H. Lewis, *Microsoft Seeks Internet Market; Netscape Slides*, N.Y. Times, Dec. 8, 1995, http://query.nytimes.com/gst/fullpage.html?res=9E00EEDE1F39F93BA35751C 1A963958260&sec=&spon=&pagewanted=all

Exhibit 4   Declaration of David Ahn, December 14, 2007

Exhibit 5   Declaration of Kevin Smith, December 17, 2007

Exhibit 6   Michele Kuester, *Web Ad Revenue Climbed 42.6 Percent in Third Quarter*, Jupiter Communications, Nov. 20, 1996, http://web.archive.org/web/19961228211028/http://www.jup.com/jupiter/release /nov96/adspend/adspend.shtml

TABLE OF AUTHORITIES

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I   THE '560 PATENT IS CAUSING SIGNIFICANT PUBLIC HARM AND IS RESTRAINING INNOVATION AND FREE EXPRESSION

United States Patent No. 6,264,560 claims methods and systems for playing various games that were widely known and practiced for years prior to the filing of the application that resulted in this patent. Now, with broad claims in hand, patentee Goldberg has embarked on a campaign of coercion against numerous small companies, demanding licensing fees that are excessive yet set just below the minimum cost of courtroom litigation. In particular, Goldberg has sent threatening letters to dozens of companies that offer multiplayer games via the Internet. Goldberg's aggressive assertion of the '560 patent is causing substantial public harm by stifling development in online gaming, especially by small businesses and hobbyists. In addition to the substantial new questions of patentability raised below, EFF respectfully requests consideration of Goldberg's actions, and the resulting public harm, when determining whether or not to reexamine the '560 patent.

II   STATEMENT POINTING OUT SUBSTANTIAL NEW QUESTIONS OF PATENTABILITY

Each of paragraphs A-I below sets forth a Substantial New Question (SNQ) of patentability regarding one or more of claims 1-3, 16, 18, 20, and 92. Each SNQ is addressed in greater detail in § III, below.

A.   Claims 1-3 Are Anticipated Under 35 U.S.C. § 102(a) by *Maurer*

A substantial new question of patentability as to at least claims 1-3 is raised by *Frequently Asked Questions About Poker* by Michael Maurer *et al.* ("*Maurer*").[3] *Maurer*, which is cited in the Information Disclosure Statement accompanying this Request, teaches each limitation of claims 1-3. *Maurer* qualifies as a prior art printed publication under 35 U.S.C. § 102(a) because it was

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[3] App. C.

published on February 28, 1995. The teachings of *Maurer* were not present during the prior examination of the '560 patent and thus are new. Because *Maurer* provides the basis for a rejection of claims 1-3 under 35 U.S.C. § 102(a), EFF believes that a reasonable examiner would consider its teachings important in determining whether or not claims 1-3 are patentable.

B.   Claim 1 Is Anticipated Under 35 U.S.C. § 102(b) by *Raposa*

A substantial new question of patentability as to at least claim 1 is raised by *BJ Tourney at the IP* by Manuel Raposa ("*Raposa*").[4] *Raposa*, which is cited in the Information Disclosure Statement accompanying this Request, teaches each limitation of claim 1. *Raposa* qualifies as a prior art printed publication under 35 U.S.C. § 102(b) because it was published on February 24, 1992. The teachings of *Raposa* were not present during the prior examination of the '560 patent and thus are new. Because *Raposa* provides the basis for a rejection of claims 1 under 35 U.S.C. § 102(b), EFF believes that a reasonable examiner would consider these teachings important in determining whether or not claim 1 is patentable.

C.   Claim 1 Is Obvious Under 35 U.S.C. § 103(a) Over *Raposa*

A substantial new question of patentability as to at least claim 1 is raised by *Raposa*.[5] *Raposa*, which is cited in the Information Disclosure Statement accompanying this Request, teaches or suggests each limitation of claim 1. *Raposa* qualifies as a prior art printed publication under 35 U.S.C. § 102(b) because it was published on February 24, 1992. The teachings and suggestions of *Raposa* were not present during the prior examination of the '560 patent and thus are new. Because *Raposa* provides the basis for a rejection of claims 1 under 35 U.S.C. § 103(a),

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[4] App. D.

[5] App. D.

EFF believes that a reasonable examiner would consider these teachings and suggestions important in determining whether or not claim 1 is patentable.

> **D.** **Claims 2 & 3 Are Obvious Under 35 U.S.C. § 103(a) Over *Raposa* in View of *Itkis***

A substantial new question of patentability as to at least claims 2 and 3 is raised by *Raposa*[6] combined with U.S. Patent No. 4,856,787 to Itkis entitled "Concurrent Game Network" ("*Itkis*").[7] As explained above, *Raposa* teaches or suggests the limitations of claim 1. Claims 2 and 3 depend from claim 1. *Itkis*, which is cited in the Information Disclosure Statement accompanying this Request, teaches each additional limitation of claims 2 and 3. *Itkis* qualifies as a prior art patent under 35 U.S.C. § 102(b) because it issued on February 5, 1986. The teachings of *Itkis* were not present during the prior examination of the '560 patent and thus are new. Because *Itkis* when combined with *Raposa* provides the basis for a rejection of claims 2 and 3 under 35 U.S.C. § 103(a), EFF believes that a reasonable examiner would consider these teachings important in determining whether or not claims 2 and 3 are patentable.

> **E.** **Claims 16 and 18 Are Obvious Under 35 U.S.C. § 103(a) Over *Maurer* and/or *Raposa* in View of *Filepp***

A substantial new question of patentability as to at least claims 16 and 18 is raised by *Maurer*[8] and/or *Raposa*[9] in view of U.S. Patent No. 5,347,632 to Filepp *et al.* entitled "Reception

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[6] App. D.

[7] App. A.

[8] *Maurer* [App. C].

[9] *Raposa* [App. D].

System For An Interactive Computer Network And Method Of Operation" ("*Filepp*").[10] As explained above, *Maurer* and *Raposa* each independently teach the limitations of claim 1, on which claims 16 and 18 are dependent. *Filepp*, which is cited in the Information Disclosure Statement accompanying this Request, teaches each additional limitation of claims 16 and 18. *Filepp* qualifies as a prior art patent under 35 U.S.C. § 102(b) because it issued on September 13, 1994. The teachings of *Filepp* were not present during the prior examination of the '560 patent and thus are new. Because *Filepp* when combined with either *Maurer* and/or *Raposa* provides the basis for a rejection of claims 16 and 18 under 35 U.S.C. § 103(a), EFF believes that a reasonable examiner would consider these teachings important in determining whether or not claims 16 and 18 are patentable.

F.   Claims 20 and 92 Are Anticipated Under 35 U.S.C. § 102(b) by *Eliezer*

A substantial new question of patentability as to at least claims 20 and 92 is raised by *Eliezer*.[11] *Eliezer*, which is cited in the Information Disclosure Statement accompanying this Request, teaches each limitation of claims 20 and 92. *Eliezer* qualifies as a prior art printed publication under 35 U.S.C. § 102(b) because it was published on January 15, 1995. The teachings of *Eliezer* were not present during the prior examination of the '560 patent and thus are new. Because *Eliezer* provides the basis for a rejection of claims 20 and 92 under 35 U.S.C. § 102(b), EFF believes that a reasonable examiner would consider its teachings important in determining whether or not claims 20 and 92 are patentable.

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[10] App. B.

[11] App. E.

G.   **Claim 20 Is Anticipated Under 35 U.S.C. § 102(b) by *Itkis***

A substantial new question of patentability as to at least claim 20 is raised by *Itkis*.[12] *Itkis*,

which is cited in the Information Disclosure Statement accompanying this Request, teaches each

limitation of claim 20. *Itkis* qualifies as a prior art patent under 35 U.S.C. § 102(b) because it

issued on February 5, 1986. The teachings of *Itkis* were not present during the prior examination

of the '560 patent and thus are new. Because *Itkis* provides the basis for a rejection of claim 20

under 35 U.S.C. § 102(b), EFF believes that a reasonable examiner would consider its teachings

important in determining whether or not claim 20 is patentable.

H.   **Claim 92 Is Rendered Obvious Under 35 U.S.C. § 103(a) Over the
          Combination of Two Components of Netrek: The BRM-Hadley Client
          Software Source Code and the Vanilla Server Software Source Code**

A substantial new question of patentability as to at least claim 92 is raised by the

combination of the source code for two components of the multi-user online game Netrek: the

BRM-Hadley (BRMH) Client Source Code[13] and the Vanilla Server Source Code.[14] The

combination of the BRMH Client and Vanilla Server source code, which are cited in the

Information Disclosure Statement accompanying this Request, teaches each limitation of claim 92.

The BRMH Client source code qualifies as a prior art printed publication under 35 U.S.C. § 102(b)

because it has been publicly accessible substantially continuously since October 16, 1993. The

Vanilla Server source code qualifies as a prior art printed publication under 35 U.S.C. § 102(b)

because it has been publicly accessible substantially continuously since December 15, 1994. The

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[12] *Itkis* [App. A].

[13] App. F.

[14] App. G.

teachings of the BRMH Client and Vanilla Server source code were not present during the prior

examination of the '560 patent and thus are new. Because the BRMH Client and Vanilla Server

source code provides the basis for a rejection of claims 1 under 35 U.S.C. § 103(a), EFF believes

that a reasonable examiner would consider these teachings important in determining whether or not

claim 92 is patentable.

I. Claim 92 Is Obvious Under 35 U.S.C. § 103(a) Over the Combination of *McFadden* and *Rumsey*

A substantial new question of patentability as to at least claim 92 is raised by *The History*

of Netrek by Andy McFadden ("*McFadden*")[15] combined with *Re: Beta testers for port of BRM 3.0*

to Win 3.1 / NT wanted by Joseph Rumsey ("*Rumsey*").[16] The combination of *McFadden* and

Rumsey, which are cited in the Information Disclosure Statement accompanying this Request,

teaches each limitation of claim 92. *McFadden* qualifies as a prior art printed publication under 35

U.S.C. § 102(b) because it was published on May 1, 1994. *Rumsey* qualifies as a prior art printed

publication under 35 U.S.C. § 102(b) because it was published on February 12, 1994. The

teachings of *McFadden* and *Rumsey* were not present during the prior examination of the '560

patent and thus are new. Because the combination of *McFadden* and *Rumsey* provides the basis

for a rejection of claim 92 under 35 U.S.C. § 103(a), EFF believes that a reasonable examiner

would consider these teachings important in determining whether or not claim 92 is patentable.

III   DETAILED EXPLANATION OF SUBSTANTIAL NEW QUESTIONS OF PATENTABILITY

The detailed explanation below sets forth the pertinency and manner of applying the newly-

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[15] App. H.

[16] App. I at 9-10.

cited prior art references to render each identified claim of the '560 patent invalid under 35 U.S.C § 102(a), § 102(b), or § 103(a). Because the '560 patent claims priority to three provisional applications filed on different dates, this Request assumes, for simplicity, the earliest possible priority date for all claims, namely, January 19, 1996, the date of the earliest-filed of the three provisional applications. As the examiner will understand, some of the claims may have a later priority date if derived from new matter introduced after the January 19, 1996 provisional application.

A.   Claims 1-3 Are Anticipated Under 35 U.S.C. § 102(a) by *Maurer*

Claim 1 recites a method of conducting a tournament in which different players are invited to join and play for multiple rounds, with each round ending at a discrete point such as a time limit or the completion of a certain number of card hands. Claim 1 also requires that some players from one round be grouped together differently in subsequent rounds (for example, winners being placed together) and that there be at least one rule change between rounds (for example, changing the amount of the maximum bet). Claim 2 requires at least some of the steps of the tournament of claim 1 to be performed by transmitting communications between nodes on a communications network. Claim 3 requires the communications network of claim 2 to include a portion of one of an Internet network, a cable television network, an interactive television network, and an intranet.

Maurer [Appendix C] is a February 28, 1995 posting to the Usenet Newsgroup rec.gambling titled "Frequently Asked Questions About Poker" that describes how to conduct poker tournaments, both in person and on the Internet. *Maurer* discloses, among other things, grouping winners of previous rounds at the same table during later rounds and increasing the betting limits during later rounds in order to raise the stakes. Those disclosures are significant because, had they been presented during prosecution, they would have eliminated the Examiner's

sole basis for allowing claims 1-3:

> 2.   The following is an examiner's statement of reasons for allowance:
>
> A method for conducting one or more cotrnaments comprising establishing a modified version of the game by changing a rule of the game while retaining another rule for the game and combining the winning players from different groups into one or more new groups for competing against one another in playing instances of the modified version of the game as claimed is not taught nor suggested by the prior art of record.

<div align="right">– Notice of Allowability, July 30, 1999 at 2.</div>

In fact, those concepts already existed in the prior art, as the Applicants admitted in the Background section of the provisional application to which the '560 patent claims priority:

> Additionally, there are blackjack tournaments having tournament entrants that compete against each other for tournament prizes. In such tournaments each entrant has a
>
> 15   fixed initial number of points that can be wagered in a pre-established number of tournament blackjack games to be played. Accordingly, the player having the highest number of points at the end of the tournament wins the tournament. Note that in such tournaments, there may be specific
>
> 20   guidelines established at the beginning of the tournament for varying the blackjack gaming rules between tournament games. For example, rules may vary on when a player may split pairs repeatedly during the same blackjack game.

<div align="right">– January 19, 1996 Provisional Application (No. 60/010,361)
at 5 (under "Background of the Invention")</div>

Maurer qualifies as prior art under 35 U.S.C. § 102(a) because it was published on Usenet as early as February 28, 1995. The charts below explain the pertinence and manner of applying *Maurer* to claims 1-3. As explained below, *Maurer* discloses each limitation of claims 1-3.

Claim 1	*Frequently Asked Questions About Poker* (*Maurer*)
1. A method for conducting one or more tournaments, comprising:	*Maurer* discloses methods for conducting one or more poker tournaments. A:P12[17] ("A poker tournament is an event in which poker players compete for all or part of a prize pool."). Such tournaments can be conducted electronically or in person. A:P6 ("IRC poker is a real-time network poker game that allows people from around the world to play poker with each other via the Internet… An automatic program serves as the dealer and controls the action."); A:P3 ("Any cardroom with more than a few tables will have a sign-up desk or board for the various games being played. Usually someone will be standing here to take your name if a seat is not immediately available.").
identifying players requesting to join one of the tournaments, wherein each tournament includes a plurality of instances of a game for playing by each of the players identified, wherein for each of the players, at least one of the following (a) and (b) must be satisfied for the player to complete one of the tournaments: (a) a predetermined number of instances of the game must be played by the	*Maurer* discloses identifying players requesting to join one of the tournaments. A:P12 ("Each player pays an entry fee and initial buy-in for a set number of tournament chips."). In *Maurer*, each tournament includes a plurality of instances of a game for playing by each of the players identified. (Specifically, each "round" of poker in *Maurer* corresponds to a "game" in claim 1.) For each of the players, a predetermined number of instances of the game (rounds) must be played by the player to complete (*i.e.*, win) one of the tournaments. In *Maurer*, the predetermined number of rounds is two. A:P12. ("In most tournaments, tables are consolidated and seats redrawn when a certain number of players are eliminated, resulting in a 'final table' of contestants. Sometimes, each table plays until only one player remains, and then combines the survivors at a final table; this is called a 'shootout.'"). Each game consists of a group of players competing at the same table until a certain number of players are eliminated. In the second (and final) game, the winners of the first round of games compete at a final table. *Id*. ("In most tournaments, tables are consolidated and seats redrawn when a certain number of players are eliminated, resulting in a 'final table' of contestants. Sometimes, each table plays until only one player remains, and then combines the survivors at a final table; this is called a 'shootout.'").

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[17] Because *Maurer* [App. C] does not contain page numbers, this Request uses *Maurer's* own citation form. For example, *Maurer* uses "<u>A</u>:<u>P12</u>" to refer to the <u>A</u>nswer to question <u>P12</u>.

Claim 1	*Frequently Asked Questions About Poker* (*Maurer*)
player; (b) a predetermined amount of time must elapse between the commencement of the tournament and the termination of the tournament;	*See also id*. ("A 'satellite' is a tournament in which the prize is an entry to another tournament. Large tournaments like the $10,000 No-limit Hold'em event in the World Series of Poker generate a lot of satellites. Typically, the satellite buy-in is around 1/10 the tournament buy-in, so the top 10% of satellite finishers win a tournament buy-in. Sometimes a satellite will even have mini-satellites, in which the prize is an entry to the main satellite. A mini-satellite for the $10,000 event might have a $100 buy-in and award a $1,000 buy-in to a satellite that is awarding a $10,000 buy-in to the main event.").
for each tournament, the following steps are performed:	*Maurer* discloses performing the following steps for each tournament.
(A1) selecting the identified players to be included in the tournament;	*Maurer* discloses selecting the identified players for inclusion in the tournament. A:P12 ("Each player pays an entry fee and initial buy-in for a set number of tournament chips."). A:P3 ("If the game you want is full, your name will go on a list and the person running the list will call you when a seat opens up… Once a seat is available, the list person will vaguely direct you toward it, or toward a floorman who will show you where to sit").
(A2) grouping the players into groups, wherein for each group, the players therein compete against one another in playing instances of the game;	*Maurer* discloses grouping the players into groups consisting of players at the same table, wherein those players compete against one another in playing instances of the game. A:P12 ("In most tournaments, tables are consolidated and seats redrawn when a certain number of players are eliminated, resulting in a 'final table' of contestants. Sometimes, each table plays until only one player remains, and then combines the survivors at a final table; this is called a 'shootout.'").
(A3) determining one or more winning players for each group;	*Maurer* discloses determining one or more winning players for each group. A:P12 ("In most tournaments, tables are consolidated and seats redrawn when a certain number of players are eliminated, resulting in a 'final table' of contestants. Sometimes, each table plays until only one player

Claim 1	*Frequently Asked Questions About Poker* (*Maurer*)
	remains, and then combines the survivors at a final table; this is called a 'shootout.'").
(A4) establishing a modified version of the game by changing a rule of the game while retaining another rule for the game;	*Maurer* discloses established a modified version of the game by changing a betting rule while retaining other rules of the game. A:P12 ("The game's stakes increase with time to hasten the tournament's end."). A:P3 ("In structured-limit like $3-$6 (usually recognizable by a factor of two between betting limits), all betting and raising on early rounds is in units of $3, and on later rounds is in units of $6."). *See also* A:P12. ("A 'satellite' is a tournament in which the prize is an entry to another tournament. Large tournaments like the $10,000 No-limit Hold'em event in the World Series of Poker generate a lot of satellites. Typically, the satellite buy-in is around 1/10 the tournament buy-in, so the top 10% of satellite finishers win a tournament buy-in. Sometimes a satellite will even have mini-satellites, in which the prize is an entry to the main satellite. A mini-satellite for the $10,000 event might have a $100 buy-in and award a $1,000 buy-in to a satellite that is awarding a $10,000 buy-in to the main event.").
(A5) combining the winning players from different groups into one or more new groups for competing against one another in playing instances of the modified version of the game.	*Maurer* discloses combining the winning players from different groups (tables) into a new group (a final table) for competing against one another in playing instances of the modified version of the game. A:P12 ("In most tournaments, tables are consolidated and seats redrawn when a certain number of players are eliminated, resulting in a 'final table' of contestants. Sometimes, each table plays until only one player remains, and then combines the survivors at a final table; this is called a 'shootout.'"). *Id*. ("A "satellite" is a tournament in which the prize is an entry to another tournament. Large tournaments like the $10,000 No-limit Hold'em event in the World Series of Poker generate a lot of satellites. Typically, the satellite buy-in is around 1/10 the tournament buy-in, so the top 10% of satellite finishers win a tournament buy-in. Sometimes a satellite will even have mini-satellites, in which the prize is an entry to the main satellite. A mini-satellite for the $10,000 event might have a $100 buy-in and award a $1,000 buyin to a satellite that is awarding a $10,000 buy-in to the main event.").

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Claims 2 & 3	*Maurer*
2. A method as claimed in claim 1, wherein at least some of the steps of claim 1 are performed by transmitting communications on a communications network, wherein each player communicates with a game playing node on the communications network by using a network node spaced apart from each of the other players.	*Maurer* discloses conducting over the Internet using "Internet Relay Chat" (IRC) technology. Using IRC, players can not only be "spaced apart" but can be distributed around the world. A:P6 ("IRC poker is a real-time network poker game that allows people from around the world to play poker with each other via the Internet… An automatic program serves as the dealer and controls the action.").
3. A method as claimed in claim 2, wherein said communications network includes a portion of one of an Internet network, a cable television network, an interactive television network, and an intranet.	*Maurer* discloses conducting over the Internet using "Internet Relay Chat" (IRC) technology. Using IRC, players can not only be "spaced apart" but can be distributed around the world. A:P6 ("IRC poker is a real-time network poker game that allows people from around the world to play poker with each other via the Internet… An automatic program serves as the dealer and controls the action.").

As explained above, *Maurer* discloses each limitation of claims 1-3 and thus anticipates claims 1-3 under 35 U.S.C. § 102(a).

B.   Claim 1 Is Anticipated Under 35 U.S.C. § 102(b) by *Raposa*

Raposa [Appendix D] is a February 24, 1992 posting to the Usenet Newsgroup

rec.gambling titled "BJ Tourney at the IP" that describes a blackjack tournament to be held at the

Imperial Palace Casino. Like *Maurer*, *Raposa* discloses, among other things, grouping winners of previous rounds at the same table during later rounds and increasing the betting limits during later rounds.

Raposa qualifies as prior art under 35 U.S.C. § 102(b) because it was published on Usenet on February 24, 1992 – nearly four years prior to the earliest possible priority date of the '560 patent, January 19, 1996. The chart below explains the pertinency and manner of applying *Raposa* to render claim 1 anticipated under 35 U.S.C. § 102(b).

Claim 1	BJ Tourney at the IP (*Raposa*)
1. A method for conducting one or more tournaments, comprising:	*Raposa* discloses a method for conducting a blackjack tournament, as indicated by its title "BJ [BlackJack] Tourney [Tournament] at the IP."
identifying players requesting to join one of the tournaments, wherein each tournament includes a plurality of instances of a game for playing by each of the players identified, wherein for each of the players, at least one of the following (a) and (b) must be satisfied for the player to complete one of the tournaments: (a) a predetermined number of instances of the game must be played by the player;	*Raposa* discloses identifying players requesting to join a blackjack tournament via an invitation, an R.S.V.P. card, and a section on "Entry Information": *Raposa* (invitation and R.S.V.P.) ("You are cordially invited to participate in this breezy event that could privide [sic] you with a 'Wind' fall of cash. Just whisk the handy RSVP card back to us with your entry fee."). *Id.* ("Entry Information," disclosing methods for players to join the tournament) ("Entry Fee - $300 per entrant. No buy-in. (entry fee refunded if cancelled 72 hours prior to the tournament) … Re-entry - Each entrant will have the opportunity to re-enter Round 1 two times, if necessary, by paying a $100 re-entry fee each time you re-enter."). *Raposa* discloses a tournament that includes a plurality of game instances for the identified players to play against each other. Specifically, it discloses a tournament consisting of four rounds, pyramid style, with each round lasting "40 minutes plus 5 hands." Moreover, players who are not the highest money winners at the end of a round can re-enter the tournament two additional times. *Id.* ("Tournament Information") *(*"Tournament will consist of four

Claim 1	*BJ Tourney at the IP* (*Raposa*)
(b) a predetermined amount of time must elapse between the commencement of the tournament and the termination of the tournament;	rounds, pyramid fashion. Rounds will begin promptly at the scheduled times and will last 40 minutes plus 5 hands."). *Id.* ("Entry Information") (disclosing method for identified players to re-enter game, guaranteeing a plurality of instances of a game for those identified players).
for each tournament, the following steps are performed:	*Raposa* discloses, for each tournament, performing the following steps:
(A1) selecting the identified players to be included in the tournament;	*Raposa* discloses selecting the identified players to be included in the tournament. Specifically, it discloses an R.S.V.P. card, an entry fee, and a section on "Entry Information." Players who return the R.S.V.P. card with entry fee are selected to be included in the tournament. *Raposa* (R.S.V.P.) ("Just whisk the handy RSVP card back to us with your entry fee."). *Id.* ("Entry Information," disclosing methods for players to join the tournament) ("Entry Fee - $300 per entrant. No buy-in. (entry fee refunded if cancelled 72 hours prior to the tournament) … Re-entry - Each entrant will have the opportunity to re-enter Round 1 two times, if necessary, by paying a $100 re-entry fee each time you re-enter.").
(A2) grouping the players into groups,	*Raposa* discloses a tournament including the step of grouping the players into groups. Specifically, it discloses a tournament consisting of four rounds, pyramid fashion. *Raposa* ("Tournament Information") Tournament Information • Tournament will consist of four rounds, pyramid fashion" • Rounds will begin promptly at the scheduled times and will last 40 minutes plus 5 hands • A bet of at least $10 must be in action at all times, one hand per player. The final round will carry a minimum bet of $25

Claim 1	BJ Tourney at the IP (*Raposa*)

	…
	• At the end of Round 1, the two highest money winners from each table will advance to round 2. All others may re-enter Round 1 TWO MORE TIMES, if necessary, by paying the $100 re-entry fee each time you re-enter. In rounds 2 and 3, the highest money winner from each table will advance.
	
	Id. ("Other Info")
	
	   Other Info
	      Rounds 1, 2, and 3 - You will receive $750 in tournament chips at the table.
	
	      Final round - You will receive $1000 in tournament chips at the table.
	
	      Table Limits - Rounds 1, 2, and 3, $10 minimum and $300 maximum
	      Final Round, $25 minimum and $500 maximum

wherein for each group, the players therein compete against one another in playing instances of the game;	*Raposa* discloses, for each group, the players therein compete against each other in playing instances of the game. Specifically, the players play rounds, comprising "hands" of blackjack. *Raposa* ("Tournament Information") ("Tournament will consist of four rounds, pyramid fashion. … Rounds will begin promptly at the scheduled times and will last 40 minutes plus 5 hands.").
(A3) determining one or more winning players for each group;	*Raposa* discloses determining one or more winning players for each group. *Raposa* ("Tournament Information") ("At the end of Round 1, the two highest money winners from each table advance to round 2. . . . In rounds 2 and 3, the highest money winner from each table will advance.").
(A4) establishing a modified version of the game by changing a rule of the game while retaining another	*Raposa* discloses establishing a modified version of the game by changing a rule while retaining at least one other rule. First, it discloses that between rounds, the minimum and maximum bets change while the rest of the rules remain the same. *Raposa* ("Tournament Information") ("A bet of at least $10 must be in action at

Claim 1	*BJ Tourney at the IP* (*Raposa*)
rule for the game;	all times, one hand per player. The final round will carry a minimum bet of $25."); *id*. ("Other Info") ("Table Limits - Rounds 1, 2, and 3, $10 minimum and $300 maximum Final Round, $25 minimum and $500 maximum"). Second, it discloses a different amount of tournament chips in the final round versus rounds 1-3. *Id*. ("Rounds 1, 2, and 3 – You will receive $750 in tournament chips at the table. Final round – You will receive $1000 in tournament chips at the table.").
(A5) combining the winning players from different groups into one or more new groups for competing against one another in playing instances of the modified version of the game.	*Raposa* discloses combining winning players from different groups into one or more new groups for competing against each other in the modified version of the blackjack game. *Raposa* ("Tournament Information") ("At the end of Round 1, the two highest money winners from each table advance to round 2. . . . In rounds 2 and 3, the highest money winner from each table will advance.").

As explained above, *Raposa* discloses each limitation of claim 1 and thus anticipates claim 1 under 35 U.S.C. § 102(b).

C.   Claim 1 Is Obvious Under 35 U.S.C. § 103(a) Over *Raposa*

Claim 1 does not recite any structural limitations, such as computers, networks, or the like, for carrying out the recited method steps.[18]   Accordingly, a prior art reference need not teach or suggest any particular structure to anticipate or render obvious claim 1 because, in assessing

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[18]   Rather, Applicants chose to recite structural limitations only in the dependent claims such as claim 2 (a communications network), claim 3 (the Internet, cable or interactive TV, and an intranet), and claim 16 (a network).

novelty, "[w]hat matters is the objective reach of the claim."[19] Here, the objective reach of claim 1 clearly covers method steps performed by people as well as machines.

Should the Examiner wish to cite structure in rejecting claim 1, however, a substantial new question of patentability remains as to whether it would have been obvious to one of ordinary skill in the art to implement the teachings of *Raposa* using computers, networks, or other such structure.

According to both the United States Supreme Court and the Court of Appeals for the Federal Circuit, the answer to that question is "yes." In its recent opinion in *KSR International Co. v. Teleflex, Inc.*, the Supreme Court instructed "[i]f a person of ordinary skill in the art can implement a predictable variation § 103 likely bars its patentability."[20] Similarly, the Federal Circuit, in *Leapfrog Enterprises, Inc. v. Fisher-Price, Inc.*,[21] relied on *KSR* in affirming a finding that a claim was obvious because it was merely an update of older technology "using modern electronic components."[22] It found that the reason to update the older invention was "to gain the commonly understood benefits of such adaptation,"[23] noting that "[a]pplying modern electronics to older mechanical devices has been commonplace in recent years."[24] Even more to the point, the Federal Circuit recently held "[t]he routine addition of modern electronics to an otherwise

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[19] *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741-42 (2007) [hereinafter *KSR*].

[20] *Id.* at 1740.

[21] *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157 (Fed. Cir. 2007) [hereinafter *Leapfrog*].

[22] *Id.* at 1162.

[23] *Id.*

[24] *Id.* at 1161.

unpatentable invention typically creates a prima facie case of obviousness."[25]

As Applicants themselves admitted in the Background of the Invention, the use of computer networks ranging from the Internet to local area networks was quite well-known to those of ordinary skill in the art for implementing games and entertainment methods.[26] Thus, one of ordinary skill in the art at the time of the '560 patent application would have been capable of reliably updating the older technology of *Raposa* using a modern computer system and would have seen the benefit of doing so. Such a person clearly would have been motivated "to gain the commonly understood benefits of such adaptation."[27]

Raposa qualifies as prior art under 35 U.S.C. § 102(b) because it was published on Usenet on February 24, 1992 – nearly four years prior to the earliest possible priority date of the '560 patent, January 19, 1996. The chart below explains the pertinency and manner of applying *Raposa* to render claim 1 obvious under 35 U.S.C. § 103(a).

Claim 1	BJ Tourney at the IP (*Raposa*)
1. A method for conducting one or more tournaments, comprising:	*Raposa* discloses a method for conducting a blackjack tournament, as indicated by its title "BJ [BlackJack] Tourney [Tournament] at the IP." It would have been obvious to one of ordinary skill to implement the teachings of *Raposa* using computers, networks, or other such structure. *KSR*, 127 S. Ct. at 1740-42; *Leapfrog*, 485 F.3d at 1157, 1161-62; *In re*

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[25] *In re Comiskey*, 499 F.3d 1365, 1380 (Fed. Cir. 2007) (citing *Leapfrog*, 485 F.3d at 1161).

[26] '560 patent at 1:41-45 (citing previous examples of gaming systems on the Internet and noting that they have been difficult to "cost-effectively" implement – not for technical reasons – but because of legal restrictions).

[27] *Leapfrog*, 485 F.3d at 1162 (explaining that the reason for updating the older invention with "modern electronic components" was "to gain the commonly understood benefits of such adaptation").

Claim 1	BJ Tourney at the IP (*Raposa*)
	Comiskey, 499 F.3d at 1380.
identifying players requesting to join one of the tournaments, wherein each tournament includes a plurality of instances of a game for playing by each of the players identified, wherein for each of the players, at least one of the following (a) and (b) must be satisfied for the player to complete one of the tournaments: (a) a predetermined number of instances of the game must be played by the player; (b) a predetermined amount of time must elapse between the commencement of the tournament and the termination of the tournament;	*Raposa* discloses identifying players requesting to join a blackjack tournament via an invitation, an R.S.V.P. card, and a section on "Entry Information": *Raposa* (invitation and R.S.V.P.) ("You are cordially invited to participate in this breezy event that could privide [sic] you with a 'Wind' fall of cash. Just whisk the handy RSVP card back to us with your entry fee."). *Id.* ("Entry Information," disclosing methods for players to join the tournament) ("Entry Fee - $300 per entrant. No buy-in. (entry fee refunded if cancelled 72 hours prior to the tournament) … Re-entry - Each entrant will have the opportunity to re-enter Round 1 two times, if necessary, by paying a $100 re-entry fee each time you re-enter."). *Raposa* discloses a tournament that includes a plurality of game instances for the identified players to play against each other. Specifically, it discloses a tournament consisting of four rounds, pyramid style, with each round lasting "40 minutes plus 5 hands." Moreover, players who are not the highest money winners at the end of a round can re-enter the tournament two additional times. *Id.* ("Tournament Information") (*"Tournament will consist of four rounds, pyramid fashion. Rounds will begin promptly at the scheduled times and will last 40 minutes plus 5 hands."). *Id.* ("Entry Information") (disclosing method for identified players to re-enter game, guaranteeing a plurality of instances of a game for those identified players). It would have been obvious to one of ordinary skill to implement the teachings of *Raposa* using computers, networks, or other such structure. *KSR*, 127 S. Ct. at 1740-42; *Leapfrog*, 485 F.3d. at 1157, 1161-62; *In re Comiskey*, 499 F.3d at 1380.
for each tournament, the following steps are performed:	*Raposa* discloses, for each tournament, performing the following steps: It would have been obvious to one of ordinary skill to implement the

Claim 1	*BJ Tourney at the IP* (*Raposa*)
	teachings of *Raposa* using computers, networks, or other such structure. *KSR*, 127 S. Ct. at 1740-42; *Leapfrog*, 485 F.3d. at 1157, 1161-62; *In re Comiskey*, 499 F.3d at 1380.
(A1) selecting the identified players to be included in the tournament;	*Raposa* discloses selecting the identified players to be included in the tournament. Specifically, it discloses an R.S.V.P. card, an entry fee, and a section on "Entry Information." Players who return the R.S.V.P. card with entry fee are selected to be included in the tournament.
	Raposa (R.S.V.P.) ("Just whisk the handy RSVP card back to us with your entry fee.").
	Id. ("Entry Information," disclosing methods for players to join the tournament) ("Entry Fee - $300 per entrant. No buy-in. (entry fee refunded if cancelled 72 hours prior to the tournament) … Re-entry - Each entrant will have the opportunity to re-enter Round 1 two times, if necessary, by paying a $100 re-entry fee each time you re-enter.").
	It would have been obvious to one of ordinary skill to implement the teachings of *Raposa* using computers, networks, or other such structure. *KSR*, 127 S. Ct. at 1740-42; *Leapfrog*, 485 F.3d. at 1157, 1161-62; *In re Comiskey*, 499 F.3d at 1380.
(A2) grouping the players into groups,	*Raposa* discloses a tournament including the step of grouping the players into groups. Specifically, it discloses a tournament consisting of four rounds, pyramid fashion.
	Raposa ("Tournament Information")
	Tournament Information • Tournament will consist of four rounds, pyramid fashion" • Rounds will begin promptly at the scheduled times and will last 40 minutes plus 5 hands • A bet of at least $10 must be in action at all times, one hand per player. The final round will carry a minimum bet of $25 … • At the end of Round 1, the two highest money winners from each table will advance to round 2. All others may re-enter Round 1 TWO MORE TIMES, if

Claim 1	*BJ Tourney at the IP* (*Raposa*)

	necessary, by paying the $100 re-entry fee each time you re-enter. In rounds 2 and 3, the highest money winner from each table will advance.
	
	Id. ("Other Info")
	
	   Other Info
	     Rounds 1, 2, and 3 - You will receive $750 in
	     tournament chips at the table.
	
	     Final round - You will receive $1000 in tournament
	     chips at the table.
	
	     Table Limits - Rounds 1, 2, and 3, $10 minimum and
	     $300 maximum
	     Final Round, $25 minimum and $500 maximum
	
	It would have been obvious to one of ordinary skill to implement the teachings of *Raposa* using computers, networks, or other such structure. *KSR*, 127 S. Ct. at 1740-42; *Leapfrog*, 485 F.3d. at 1157, 1161-62; *In re Comiskey*, 499 F.3d at 1380.

wherein for each group, the players therein compete against one another in playing instances of the game;	*Raposa* discloses, for each group, the players therein compete against each other in playing instances of the game. Specifically, the players play rounds, comprising "hands" of blackjack. *Raposa* ("Tournament Information") ("Tournament will consist of four rounds, pyramid fashion. … Rounds will begin promptly at the scheduled times and will last 40 minutes plus 5 hands."). It would have been obvious to one of ordinary skill to implement the teachings of *Raposa* using computers, networks, or other such structure. *KSR*, 127 S. Ct. at 1740-42; *Leapfrog*, 485 F.3d. at 1157, 1161-62; *In re Comiskey*, 499 F.3d at 1380.
(A3) determining one or more winning players for each group;	*Raposa* discloses determining one or more winning players for each group. *Raposa* ("Tournament Information") ("At the end of Round 1, the two highest money winners from each table advance to round 2. . . . In rounds 2 and 3, the highest money winner from each table will advance."). It would have been obvious to one of ordinary skill to implement the

Claim 1	BJ Tourney at the IP (*Raposa*)
	teachings of *Raposa* using computers, networks, or other such structure. *KSR*, 127 S. Ct. at 1740-42; *Leapfrog*, 485 F.3d. at 1157, 1161-62; *In re Comiskey*, 499 F.3d at 1380.
(A4) establishing a modified version of the game by changing a rule of the game while retaining another rule for the game;	*Raposa* discloses establishing a modified version of the game by changing a rule while retaining at least one other rule. First, it discloses that between rounds, the minimum and maximum bets change while the rest of the rules remain the same. *Raposa* ("Tournament Information") ("A bet of at least $10 must be in action at all times, one hand per player. The final round will carry a minimum bet of $25."); *id.* ("Other Info") ("Table Limits - Rounds 1, 2, and 3, $10 minimum and $300 maximum Final Round, $25 minimum and $500 maximum"). Second, it discloses a different amount of tournament chips in the final round versus rounds 1-3. *Id.* ("Rounds 1, 2, and 3 – You will receive $750 in tournament chips at the table. Final round – You will receive $1000 in tournament chips at the table."). It would have been obvious to one of ordinary skill to implement the teachings of *Raposa* using computers, networks, or other such structure. *KSR*, 127 S. Ct. at 1740-42; *Leapfrog*, 485 F.3d. at 1157, 1161-62; *In re Comiskey*, 499 F.3d at 1380.
(A5) combining the winning players from different groups into one or more new groups for competing against one another in playing instances of the modified version of the game.	*Raposa* discloses combining winning players from different groups into one or more new groups for competing against each other in the modified version of the blackjack game. *Raposa* ("Tournament Information") ("At the end of Round 1, the two highest money winners from each table advance to round 2. . . . In rounds 2 and 3, the highest money winner from each table will advance."). It would have been obvious to one of ordinary skill to implement the teachings of *Raposa* using computers, networks, or other such structure. *KSR*, 127 S. Ct. at 1740-42; *Leapfrog*, 485 F.3d. at 1157, 1161-62; *In re Comiskey*, 499 F.3d at 1380.

As explained above, *Raposa* teaches or suggests each limitation of claim 1 and thus renders it obvious under 35 U.S.C. § 103(a).

D.   Claims 2 & 3 Are Obvious Under 35 U.S.C. § 103(a) Over *Raposa* in View of *Itkis*

Claim 2 recites the method of claim 1 in which each player communicates with a game playing node over a communications network using a network node spaced apart from each of the other players. Claim 3 recites the method of claim 2 in which the communications network includes a portion of an Internet network, a cable television network, an interactive television network, or an intranet. *Raposa* [Appendix D] does not expressly disclose a communications network. *Itkis* [Appendix A], however, discloses a method of playing blackjack – including tournaments of any form – over a communications network, including an intranet. As explained below, one of ordinary skill in the art would have had reason to combine *Raposa* with *Itkis*. Accordingly, claims 2 and 3 are obvious under § 103(a) over the combination of *Raposa* and *Itkis*.

In light of *KSR*, it is no longer necessary to cite a teaching, suggestion, or motivation to combine references when making an obviousness rejection. Rather, as *KSR* points out, there are various ways to show that a combination of prior art teachings is obvious. For example, a combination of prior art teachings is likely to be obvious if it would yield predictable results,[28] so the key question to ask is "whether the improvement is more than the predictable use of prior-art elements according to their established functions."[29] As *KSR* explained, a combination is obvious when it creates no synergy, *i.e.*, when the two technologies "in combination [do] no more than they would in separate, sequential operation" or when the applicant "'simply arranges old elements with each performing the same function it had been known to perform' and yields no more than one

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[28] *KSR*, 127 S. Ct. at 1739.

[29] *Id*. at 1740.

would expect from such an arrangement."[30]

   KSR also emphasized that design and market incentives can provide a reason to combine prior art teachings in a manner that is not novel,[31] and the "proper question" to ask is whether "[one] of ordinary skill, facing the wide range of needs created by developments in the field of endeavor, would have seen a benefit to [combine]."[32] The Federal Circuit applied this guidance in *Leapfrog*, where it affirmed a finding of obviousness for a patent claim that was merely an update of older technology "using modern electronic components."[33] It found that the reason to update the older invention was "to gain the commonly understood benefits of such adaptation,"[34] noting that "[a]pplying modern electronics to older mechanical devices has been commonplace in recent years."[35]

   Recent decisions from the Board of Patent Appeals and Interferences have adhered to this approach. In *Ex parte Catan*,[36] for example, the Board cited both *Leapfrog* and *KSR* in affirming a finding of obviousness for a claim directed to credit card processing that substituted a bioauthentication device known in the prior art for a manual authentication means known in the

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[30] *Id.*

[31] *Id*.

[32] *Id* at 1744.

[33] *Leapfrog*, 485 F.3d at 1162.

[34] *Id.*

[35] *Id*. at 1161.

[36] *Ex Parte Catan*, Appeal No. 2007-0820 (BPAI 2007) (precedential opinion) [hereinafter *Catan*], *available at* http://www.uspto.gov/web/offices/dcom/bpai/prec/fd070820.pdf (last visited Dec. 18, 2007).

prior art[37] – merely the application of modern electronics to older methods. In so deciding, the

Board explained that combining these features of the prior art was not "uniquely challenging or

difficult for one of ordinary skill in the art" and "appear[ed] to present no unexpected

technological advance in the art," adding "[t]he function remains the same."[38] The Board also

noted that a person of ordinary skill in the art would have recognized the commonly understood

benefits to combine at the time of the invention.[39]

Under these authorities, it is clear that one of ordinary skill in the art would have had a

reason to combine *Raposa* with *Itkis*.

First, *Itkis* discloses a system in which "[t]he slave game device is capable of playing

concurrently a number of menu selectable card and chance games, such as poker, bingo, blackjack

and keno."[40] This open-ended language explicitly invites application to all formats of chance

games, and it specifically mentions blackjack, the very subject of *Raposa*. *Itkis* goes on to state

that "[i]t should be clearly understood without a restriction of the scope of this invention that

games other than bingo, poker, blackjack, and keno as mentioned above can be played with the

help of the suggested game network."[41] *Itkis* even specifically contemplates a tournament

structure: "A conceivable variation of the resource pooling approach is the concept of clustering

slave game devices 7 playing the same card game against the card dealer (the casino). For

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[37] *Id.* at 17-18.

[38] *Id.* at 18.

[39] *Id.* at 20 (recognizing the benefits of upgrading a PIN system with a bioauthentication device, such as increased reliability, selective control, and the avoidance of forgotten PIN codes).

[40] *See Itkis* [App. A] at Abstract.

example, several players may play a common blackjack or poker game using their slave game

devices 7."[42] Thus, those of ordinary skill in the art would have had a strong motivation to

combine.

Also, the combination of *Raposa* with *Itkis* yields predictable results because the results of

the *Raposa* tournament structure do not change simply by carrying it out on the computer system

of *Itkis*. Thus, the combined technologies do no more than they would in separate, sequential

operation and are no more than the predictable use of prior art elements according to their

established functions. Claims 2 and 3 represent simply arrangements of old elements with each

performing the same function it had been known in the art to perform and yielding no more than

one would expect from such an arrangement.

Moreover, a person of ordinary skill in the art at the time of the '560 patent application

would have faced strong market incentives to combine *Raposa* with *Itkis* to create a computerized

tournament because the Internet boom revealed the obvious benefits of doing so. As the

Background section of the '560 patent admits, local and wide-area networks were popular in the

prior art,[43] gaming systems on the Internet existed in the prior art, and "many players" back then

had an "interest in playing casino-type games."[44] Prior to the application for the '560 patent,

people everywhere were implementing old technologies on the Internet out of recognition of the

world wide web's extensive reach and ease of implementation. The Internet's explosive increase

in popularity at that time is further evident from the deluge of new Internet host machines, which

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[41] *Id.* at 5:33-37.

[42] *Id.* at 5:55-60.

[43] '560 patent at 1:35-36.

more than doubled in number from October 1994 to January 1996,[45] and by the significant

investments made in Internet technologies by companies like Microsoft, which launched its

Internet Explorer web browser software in 1995.[46] Certainly, scores of people skilled in the art

were eager to cash in on the technology surge by implementing existing ideas on the Internet.

Thus, a person of ordinary skill in the art would have had many strong reasons to apply the

teachings of *Itkis* to any method of conducting a blackjack tournament, including but not limited to

the one disclosed in *Raposa*.

Itkis qualifies as prior art under 35 U.S.C. § 102(b) because it issued on August 15, 1989 –

over six years prior to the earliest possible priority date of the '560 patent, January 19, 1996.

Raposa qualifies as prior art under 35 U.S.C. § 102(b) because it was published on Usenet on

February 24, 1992 – nearly four years prior to the earliest possible priority date of the '560 patent.

The charts below explain the pertinency and manner of applying *Raposa* to claims 2 and 3 in view

of *Itkis*.

Claim 2	*BJ Tourney at the IP* (*Raposa*) in View of U.S. Patent No. 4,856,787 (*Itkis*)
A method as claimed in claim 1,	As explained above, *Raposa* discloses the limitations of claim 1.
wherein at least	*Itkis* discloses playing network tournament games via steps performed by

[44] '560 patent at 1:41-46.

[45] Matthew Gray, *Internet Growth Summary*, http://www.mit.edu/people/mkgray/net/internet-growth-summary.html (last visited Dec. 18, 2007) [Ex. 2].

[46] Peter H. Lewis, *Microsoft Seeks Internet Market; Netscape Slides*, N.Y. Times, Dec. 8, 1995, http://query.nytimes.com/gst/fullpage.html?res=9E00EEDE1F39F93BA35751C1A963958260&sec=&spon=&pagewanted=all [Ex. 3].

Claim 2	*BJ Tourney at the IP* (*Raposa*) in View of U.S. Patent No. 4,856,787 (*Itkis*)
some of the steps of claim 1 are performed by transmitting communications on a communications network,	transmitting communications on a communications network: *Itkis* at Abstract ("A distributed game network comprising a master game device and a number of slave game devices. The slave game device is capable of playing concurrently a number of menu selectable card and chance games, such as poker, bingo, blackjack and keno."). *Id.* at 1:41-44 ("The present invention is a distributed game network comprising a master game device and a number of slave game devices. The master and slave game devices communicate with each other over the network."). *Id.* at 2:52-54 ("The master game device is interconnected with the slave game devices 7 via a communication network 6."). *Id.* at 3:35-40 (noting that "the techniques of computer realization of individual card and chance games such as poker, keno, and bingo are well known and described in multiple U.S. patents"). *Id.* at 3:66-4:2 ("The communication between the master game device 1 and the slave game devices 7 is bidirectional. The slave 7 receives commands and data from the master 1 and sends back the game status information and accounting data being generated by the task 29.").
wherein each player communicates with a game playing node on the communications network	*Itkis* discloses each player communicates with the master game device (*i.e.*, game playing node) via a communication network. *Itkis* at 2:68-3:2 ("[T]he player operates the slave gaming device 7 by entering his or her commands . . . ."). *Id.* at 2:52-54 ("The master game device is interconnected with the slave game devices 7 via a communication network 6."). *Id.* at 3:66-4:2 ("The communication between the master game device **1** and the slave game devices **7** is bidirectional. The slave **7** receives commands and data from the master **1** and sends back the game status information and accounting data being generated by the task **29**.).
by using a network node spaced apart from each of the	*Itkis* discloses players using slave devices (*i.e.*, network nodes) spaced apart from each other:

Claim 2	BJ Tourney at the IP (*Raposa*) in View of U.S. Patent No. 4,856,787 (*Itkis*)
other players.	*Itkis* at 1:41-43 ("The present invention is a distributed game network comprising a master game device and a number of slave game devices."). *Id*. at 5:61-6:5 ("It should be understood without a restriction of the scope of the invention that a broad variety of the communication media, communication protocols, and communication network architectures can be utilized in the suggested game network. In particular, coaxial cables, fiber optics, common carrier channels, and radio channels are suitable media, and various various [sic] packet switching protocols[.]"). *Id*. at 5:38-43 ("For example, a player could be playing two or more bingo games at once, specifically one local bingo game restricted to a specific location (*e.g.* a single casino) and a regional bingo game (*e.g.* a game encompassing several casinos).").

Claim 3	BJ Tourney at the IP (*Raposa*) in View of U.S. Patent No. 4,856,787 (*Itkis*)
3. A method as claimed in claim 2,	As explained above, *Raposa* in light of *Itkis* discloses the limitations of claim 2.
wherein said communications network includes a portion of one of an Internet network, a cable television network, an interactive television network, and an intranet.	*Itkis* illustrates the a communications network in Fig. 1 using an intranet topology: Fig. 1 The specification describes the communications network of Fig. 1 broadly, in a manner that one of ordinary skill in the art would recognize to

Claim 3	*BJ Tourney at the IP* (*Raposa*) in View of U.S. Patent No. 4,856,787 (*Itkis*)
	encompass intranets. Notably, *Itkis* contemplates the use of packet switching protocols, which many intranets use: *Itkis* at 5:61-6:6 ("It should be understood without a restriction of the scope of the invention that a broad variety of the communication media, communication protocols, and communication network architectures can be utilized in the suggested game network. In particular, coaxial cables, fiber optics, common carrier channels, and radio channels are suitable media, and various various [sic] packet switching protocols, such as Carrier Sence [sic] Multiple Access and token passing, are applicable.").

As explained above, the combination of *Itkis* with *Raposa* provides each limitation of

claims 2 and 3 and thus renders those claims obvious under 35 U.S.C. § 103(a).

E.   Claims 16 and 18 Are Obvious Under 35 U.S.C. § 103(a) Over *Maurer* and/or *Raposa* in View of *Filepp*

Claim 16 recites implementing the tournament of claim 1 over a network and presenting

interactive advertisements to the user over that network. *Maurer* [Appendix C] and *Raposa*

[Appendix D] each discloses the tournament of claim 1, as explained above, but neither discloses

presenting interactive advertisements over a network on which a tournament is being played.

Filepp [Appendix B] supplies the missing elements by disclosing an interactive computer network

that presents advertising to users over time and, if a user responds to an advertisement, presents

further information to the user. As explained below, one of ordinary skill in the art would have

had reason to combine *Maurer* and/or *Raposa* with *Filepp*. Accordingly, claims 16 and 18 are

obvious under § 103(a) over the combination of *Filepp* with *Maurer* and/or *Raposa*.

There are numerous reasons why one of ordinary skill in the art would have known to

combine *Filepp* with either *Maurer* or *Raposa*.

First, the relatedness and compatibility of the references themselves suggest their

combination. *Filepp* teaches the presentation of interactive advertisements over an interactive computer network that offers gaming technology,[47] and *Maurer* and *Raposa* each disclose such gaming technology. Moreover, both *Filepp* and *Maurer* disclose game-playing on an interactive computer network. Thus, one of ordinary skill in the art would have looked to *Maurer* and/or *Raposa* to supply the gaming technology described in *Filepp*.

Also, the combination of *Filepp* with either *Maurer* or *Raposa* yields predictable results because those references provide no more in combination (a network game with interactive advertising) than they would have done in separate, sequential operation (a network game on one hand, and interactive advertising on the other). Claims 16 and 18 thus represent the simple arrangement of old elements (*Filepp* and either *Maurer* or *Raposa*) with each performing the same function it had been known to perform and yielding no more than one would expect from such an arrangement.[48]

Additionally, the widespread recognition of the value of advertising revenue on the Internet at the time of the application for the '560 patent would have provided a strong market incentive to combine the advertising technology of *Filepp* with the gaming technology of *Maurer* or *Raposa*. The Background section of the '560 patent admits that local and wide-area data communication networks were popular in the prior art and that there was a need to cost-effectively provide gaming

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[47] *Filepp* [App. B] at 78:23-28 (interactive computer network includes partitioned applications classified as "games").

[48] *KSR*, 127 S. Ct. at 1740 (instructing that a combination is obvious when it creates no synergy, *i.e.*, when the two technologies "in combination [do] no more than they would in separate, sequential operation" or when the applicant "'simply arranges old elements with each performing the same function it had been known to perform' and yields no more than one would expect from such an arrangement.").

over the Internet.[49] And the surge in online advertising revenue, which increased approximately

five times from 1995 to 1996,[50] is further evidence that ordinarily skilled artisans were well aware

of how to make Internet applications more cost-effective.

Thus, a person of ordinary skill in the art would have had many strong reasons to apply the

teachings of *Filepp* to any type of gaming technology, including but not limited to those disclosed

in *Maurer* and *Raposa*.

Filepp qualifies as prior art under 35 U.S.C. § 102(b) because it issued on September 13,

1994 – over a year before the earliest possible priority date of the '560 patent, January 19, 1996.

Maurer qualifies as prior art under 35 U.S.C. § 102(a) because it was published on Usenet as early

as February 28, 1995. *Raposa* qualifies as prior art under 35 U.S.C. § 102(b) because it was

published on Usenet on February 24, 1992 – nearly four years prior to the earliest possible priority

date of the '560 patent. The charts below explain the pertinency and manner of applying *Maurer*,

Raposa, and *Filepp* to claims 16 and 18.

Claim 16	Frequently Asked Questions About Poker (*Maurer*) or BJ Tourney at the IP (*Raposa*) in View of U.S. Patent No. 5,347,632 (*Filepp*)
16. The method as claimed in claim 1,	As explained above at pp. 8-16, *Maurer* and *Raposa* each independently discloses the limitations of claim 1.

[49] '560 patent at 1:35-45 ("with the popularity of local and wide-area data communication networks") and ("it has been difficult to cost-effectively provide a network gaming system on such networks as the Internet").

[50] Michele Kuester, *Web Ad Revenue Climbed 42.6 Percent in Third Quarter*, Jupiter Communications, Nov. 20, 1996, http://web.archive.org/web/19961228211028/http://www.jup.com/jupiter/release/nov96/adspend/adspend.shtml (comparing World Wide Web ad revenue for the third quarter of 1996 to World Wide Web ad revenue for the fourth quarter of 1995) [Ex. 6].

Claim 16	*Frequently Asked Questions About Poker* (*Maurer*) or *BJ Tourney at the IP* (*Raposa*) in View of U.S. Patent No. 5,347,632 (*Filepp*)
wherein advertising is presented to the players on a network during one of the tournaments,	*Filepp* discloses a method of presenting advertising to players on a network while they are interacting with an application, *e.g.* a tournament game. *Filepp* at 6:48-51 ("The user may, through RS 400, bank, send and receive messages, review advertisements, place orders for merchandise, and perform other transactions."). *Id.* at 9:27-32 ("Continuing with reference to FIG. 3*b*, advertisements 280 provided over network 10 … may be included in any partition of a page. Advertisements 280 may be presented to the user on an individual basis from queues of advertisements . . . ."). *Id.* at 78:23-30 ("[T]he user may also enter a keyword at display field 270 within window partition 275 as a 'best guess' of the mnemonic character string that is assigned to a partitioned application the user desires (*e.g.*, the user may input such english [sic] words as 'news,' 'pet food,' 'games,' etcetera). Where the user enters a character string it is displayed in field 270, and then searched by RS 400 native code . . . ."). *Id.* at FIGS. 3a and 3b (showing an "ad partition" displayed simultaneously with a "body partition," which can include applications such as a game); *id.* at FIG. 4c (disclosing advertisement object 510).

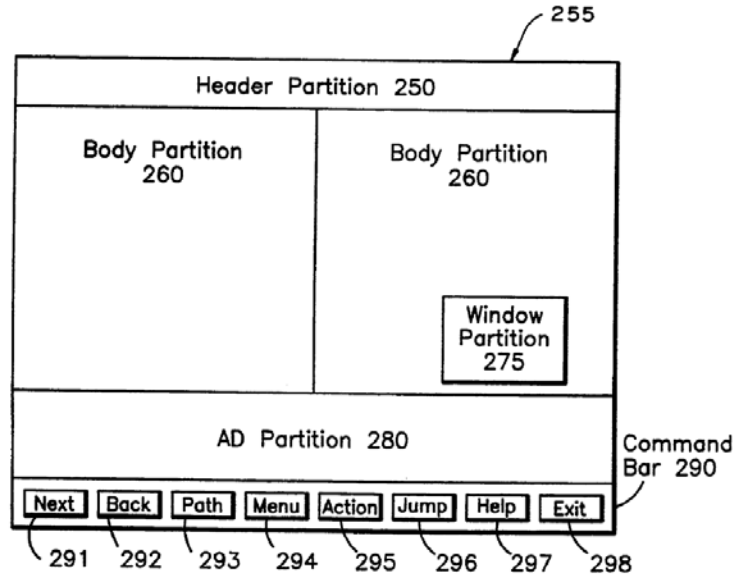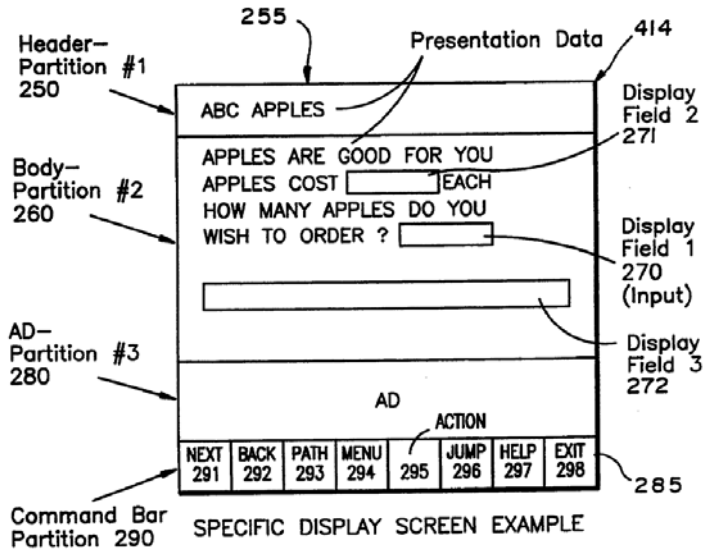| Claim 16	*Frequently Asked Questions About Poker* (*Maurer*) or *BJ Tourney at the IP* (*Raposa*) in View of U.S. Patent No. 5,347,632 (*Filepp*)

FIG. 3a

FIG. 3b |
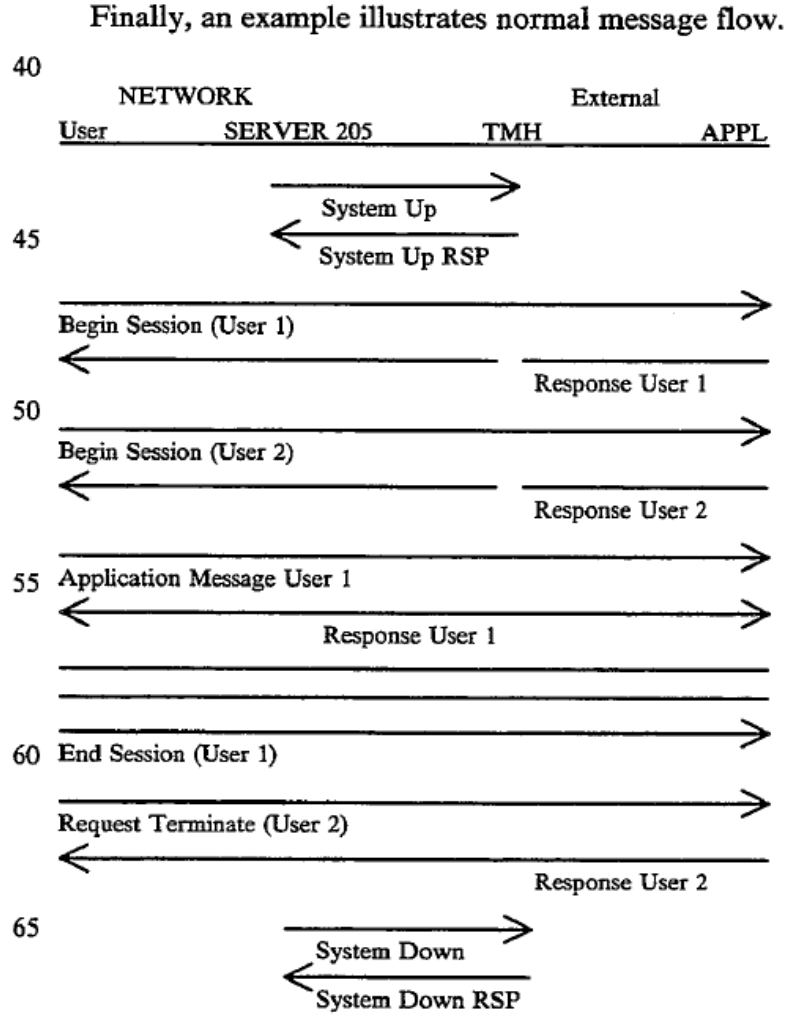| further including: for each of one or more | *Filepp* discloses players accessing the network, and transmitting requests for accessing applications, *e.g.*, tournament games, to a providing node |

Claim 16	*Frequently Asked Questions About Poker* (*Maurer*) or *BJ Tourney at the IP* (*Raposa*) in View of U.S. Patent No. 5,347,632 (*Filepp*)
of the players accessing the network, the following steps are performed: first transmitting, from the player, a corresponding request for accessing a providing node of the network,	of the network. *Filepp* at Abstract ("User inputs are received by the personal computer and are translated into personal computer-independent data objects and executable code objects which are then processed by the network."). *Id.* at 4:12-18 ("In this arrangement, many users each accesses network 10 with a conventional personal computer … which has been provided with applications software … to constitute a reception system (RS) 400."). *Id.* at 6:48-51 ("The user may, through [use of the system], bank, send and receive messages, review advertisements, place orders for merchandise, and perform other transactions."). *Id.* at 26:28-32 ("In normal processing, reception system applications send requests to host applications. Host applications return responses to these requests. The Reception System application initiates this dialogue."). *Id.* at 38:39-68 (illustration of normal message flow between user and network):

Claim 16	*Frequently Asked Questions About Poker* (*Maurer*) **or** *BJ Tourney at the IP* (*Raposa*) **in View of U.S. Patent No. 5,347,632** (*Filepp*)
	Finally, an example illustrates normal message flow. **40** **NETWORK** External User SERVER 205 TMH APPL System Up **45** System Up RSP Begin Session (User 1) Response User 1 **50** Begin Session (User 2) Response User 2 **55** Application Message User 1 Response User 1 **60** End Session (User 1) Request Terminate (User 2) Response User 2 **65** System Down System Down RSP *Id.* at 75:57-60 ("In conventional time-sharing networks that support large conventional databases, the host receives user requests for data records; locates them; and transmits them back to the users."). *Id.* at 78:23-30 ("[T]he user may also enter a keyword at display field 270 within window partition 275 as a 'best guess' of the mnemonic character string that is assigned to a partitioned application the user desires (*e.g.*, the user may input such english [sic] words as 'news,' 'pet food,' 'games,' etcetera). Where the user enters a character string it is displayed in field 270, and then searched by RS 400 native code . . . ."). *Id.* at 82:36-38 ("Service software 430 provides functions specific to

Claim 16	*Frequently Asked Questions About Poker* (*Maurer*) or *BJ Tourney at the IP* (*Raposa*) in View of U.S. Patent No. 5,347,632 (*Filepp*)
	providing interaction between the user and interactive network 10[.]”). *Id.* at 82:66-83:2 (“The operating environment 450 manages communication and synchronization of service software 430, by supporting a request/response protocol and managing the interface between the native software 420 and external software 437.”).
said providing node provides at least a portion of the game,	*Filepp* discloses players accessing the network, where the providing node provides an application, *e.g.*, a tournament game, to the user. *Filepp* at Abstract (“An interactive computer system network enables a user to … perform desired transactional services, such as banking and shopping, through any of a plurality of types of personal computers. User inputs are received by the personal computer and are translated into personal computer-independent data objects and executable code objects which are then processed by the network.”). *Id.* at 78:14-28 (“In window 275, the user is presented and may select from a variety of displayed options that include among others, the Directory command, the Index command, and the Guide command, which when selected, have the effect noted above. Additionally, the user can select a command termed Viewpath which will presents the keywords that currently make up the list of keywords associated with the user’s Path command, and from which list the user can select a desired keyword. Alternatively, the user may also enter a keyword at display field 270 within window partition 275 as a ‘best guess’ of the mnemonic character string that is assigned to a partitioned application the user desires (*e.g.*, the user may input such english [sic] words as ‘news,’ ‘pet food,’ ‘games,’ etcetera).”). *Id.* at 4:12-18 (“In this arrangement, many users each accesses network 10 with a conventional personal computer … which has been provided with applications software … to constitute a reception system (RS) 400.”). *Id.* at 26:28-32 (“In normal processing, reception system applications send requests to host applications. Host applications return responses to these requests. The Reception System application initiates this dialogue.”). *Id.* at 38:39-68 (illustration of normal message flow between user and

Claim 16	*Frequently Asked Questions About Poker* (*Maurer*) or *BJ Tourney at the IP* (*Raposa*) in View of U.S. Patent No. 5,347,632 (*Filepp*)
	network): Finally, an example illustrates normal message flow. *Id.* at 82:36-38 ("Service software 430 provides functions specific to providing interaction between the user and interactive network 10[.]"). *Id.* at 75:57-60 ("In conventional time-sharing networks that support large conventional databases, the host receives user requests for data records; locates them; and transmits them back to the users."). *Id.* at 78:38-43 ("If the string entered by the user matches a keyword existing on one of the keyword tables and is thus associated with a specific PTO, RS 400 fetches and displays associated objects of the

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Claim 16	*Frequently Asked Questions About Poker* (*Maurer*) or *BJ Tourney at the IP* (*Raposa*) in View of U.S. Patent No. 5,347,632 (*Filepp*)
	partitioned applications and builds the entry page in accordance with the page composition dictated by the target PTO.").
	Id. at 82:36-38 ("Service software 430 provides functions specific to providing interaction between the user and interactive network 10[.]").
	Id. at 82:66-83:2 ("The operating environment 450 manages communication and synchronization of service software 430, by supporting a request/response protocol and managing the interface between the native software 420 and external software 437.").
wherein said request has associated therewith a network address for identifying the providing node;	*Filepp* discloses that the requests include a network address for identifying the providing node.
	Filepp at 4:22-25 ("This [information and switch/file server] structure maintains active application databases and delivers requested parts of the databases on demand to the plurality of RS 400's, shown in FIG. 2.").
	Id. at 4:31-39 ("Still further, server unit 205 is seen to be connected to information layer 100 and its various elements, which act as means for producing, supplying, and maintaining the network databases and other information necessary to support network 10. Continuing, switch/file[] [server] layer 200 is also seen to include gateway systems 210 connected to server 205. Gateways 210 couple layer 200 to other sources of information and data; *e.g.*, other computer systems.").
	Id. at 6:10-12 ("RS 400 includes a means to communicate with network 10 to retrieve objects in response to events occurring at RS 400 and to send and receive messages.").
	Id. at 7:13-18 ("Switch and file server layer 200 and cache/concentrator layer 300 together constitute a delivery system 20 which delivers requested data to the RS 400's of reception layer 401 and routes data entered by the user or collected at RS 400's to the proper application in network 10….").
	Id. at 23:49-66 ("[T]he DIA-defined data which flows through network 10 consists of a set a headers preface the end-user to end-user message text. Further, as in the case of objects, messages are organized in a family of types based on the specific form of its header. Particularly, there are 'FMO' headers which contain routing and control information;

Claim 16	*Frequently Asked Questions About Poker* (*Maurer*) **or** *BJ Tourney at the IP* (*Raposa*) **in View of U.S. Patent No. 5,347,632** (*Filepp*)
	FM2 headers which contain transport level information; FM4 headers which contain gateway information; FM8 headers which obtain information for secondary routing; *i.e.* messages passed through from node to node; FM9 headers which contain network management information; and FM64 headers which contain application-to-application management information, where, for example, applications running at RS 400 need be rendered compatible with applications running on an external computer connected to network 10 through a gateway 210.").
	Id. at 24:14-22 ("With regard to destination routing, the basic premise of DIA is that each message flowing through network 10 carries a DIA header (FM0) that identifies its source and destination ids. Accordingly, switching applications exist which map destination ids to resources and route messages appropriately. In accordance with the invention, in order to send a reply, the recipient application simply swaps the content of the destination and source id fields and return message.").
	Id. at 26:28-34 ("In normal processing, reception system applications send requests to host applications. Host applications return responses to these requests. The Reception System application initiates this dialogue. Sending nodes are responsible for inserting the proper 'source id' (SID) and 'destination id' (DID) into the FM0.").
	Id. at 28:1-25 ("In accordance with the invention, the DIA headers are arranged in a predetermined form base [sic] on their function. More particularly, FMO headers, also known as Type 'O' headers are required for every message within the network. Header Type O provides information necessary for routing and message correlation. Its fields include . . . Source Id [:] Identification of end-user sending current message . . . Destination Id [:] Identification of message destination. All messages are routed by destination id. When responses to messages are sent back to original source, the source id and destination id fields must be swapped.").
first receiving, from the providing node via the network, said one or more interactive game presentations for presenting on at least	*Filepp* discloses receiving, from the providing node via the network, one or more interactive applications, *e.g.*, interactive game presentations, for presenting on at least a portion of a display of a player node by which the player accesses the network. *Filepp* at 5:56-68 ("Objects carry application programs and information for display at monitor screen 414 of RS 400. Application program

Claim 16	*Frequently Asked Questions About Poker* (*Maurer*) or *BJ Tourney at the IP* (*Raposa*) in View of U.S. Patent No. 5,347,632 (*Filepp*)
a portion of a display of a player node by which the player accesses the network,	objects, called pre-processor and post-processors, set up the environment for the user's interaction with network 10 and respond to events created when the user inputs information at keyboard 424 of RS 400. Such events typically trigger a program object to be processed, causing one of the following: . . . the receiving of information for use in programs or for presentation in application-dependent fields on monitor screen 414 . . . ."). *Id.* at 26:27-32 ("In normal processing, reception system applications send requests to host applications. Host applications return responses to these requests. The Reception System application initiates this dialogue."). *Id.* at 78:14-28 ("In window 275, the user is presented and may select from a variety of displayed options that include among others, the Directory command, the Index command, and the Guide command, which when selected, have the effect noted above. Additionally, the user can select a command termed Viewpath which will presents the keywords that currently make up the list of keywords associated with the user's Path command, and from which list the user can select a desired keyword. Alternatively, the user may also enter a keyword at display field 270 within window partition 275 as a 'best guess' of the mnemonic character string that is assigned to a partitioned application the user desires (*e.g.*, the user may input such english [sic] words as 'news,' 'pet food,' 'games,' etcetera).").
and wherein said interactive game presentations are interactive, via the network, between the player and said providing node;	*Filepp* discloses interactive applications, *e.g.* game presentations that are interactive, via the network, between the player and the providing node. *Filepp* at Abstract ("An interactive computer system network enables a user to … perform desired transactional services, such as banking and shopping, through any of a plurality of types of personal computers. User inputs are received by the personal computer and are translated into personal computer-independent data objects and executable code objects which are then processed by the network."). *Id.* 1:11-19 ("This invention relates generally to a distributed processing, interactive computer network intended to provide very large numbers of simultaneous users; *e.g.* millions, with access to a large number; *e.g.*, thousands, of applications which include pre-created, interactive text/graphic sessions; and more particularly, to a computer network in

Claim 16	*Frequently Asked Questions About Poker* (*Maurer*) or *BJ Tourney at the IP* (*Raposa*) **in View of U.S. Patent No. 5,347,632** (*Filepp*)
	which the interactive text/graphic sessions are comprised of pre-created blocks of data and program instructions . . . ."). *Id.* at 3:42-51 ("FIG. 1 is a block diagram of the interactive computer network in accordance with the invention . . . FIGS. 4*a*, 4*b*, 4*c* and 4*d* are schematic drawings that illustrate the structure of objects, and object segments utilized within the interactive network in accordance with the invention . . . ."). *Id.* at 4:9-12 ("With reference to FIGS. 1, 2, the invention includes a plurality of reception units within reception layer 401 of interactive computer network 10 for displaying information and providing transactional services."). *Id.* at 38:39-68 (illustration of normal message flow between user and network):

Claim 16	*Frequently Asked Questions About Poker* (*Maurer*) or *BJ Tourney at the IP* (*Raposa*) in View of U.S. Patent No. 5,347,632 (*Filepp*)
	Finally, an example illustrates normal message flow. 40 NETWORK External User SERVER 205 TMH APPL System Up 45 System Up RSP Begin Session (User 1) Response User 1 50 Begin Session (User 2) Response User 2 55 Application Message User 1 Response User 1 60 End Session (User 1) Request Terminate (User 2) Response User 2 65 System Down System Down RSP *Id.* at 78:14-28 ("In window 275, the user is presented and may select from a variety of displayed options that include among others, the Directory command, the Index command, and the Guide command, which when selected, have the effect noted above. Additionally, the user can select a command termed Viewpath which will presents the keywords that currently make up the list of keywords associated with the user's Path command, and from which list the user can select a desired keyword. Alternatively, the user may also enter a keyword at display field 270 within window partition 275 as a 'best guess' of the mnemonic character string that is assigned to a partitioned application the user desires (*e.g.*, the user may input such english [sic] words as 'news,' 'pet

Claim 16	*Frequently Asked Questions About Poker* (*Maurer*) or *BJ Tourney at the IP* (*Raposa*) in View of U.S. Patent No. 5,347,632 (*Filepp*)
	food,' 'games,' etcetera)."). *Id.* at 82:36-38 ("Service software 430 provides functions specific to providing interaction between the user and interactive network 10[.]").
first presenting, by the player node, concurrently with at least one of the interactive game presentations, a first advertising presentation for providing information related to one of a product and a service,	*Filepp* discloses presenting, by the player node, concurrently with at least one of the interactive applications, *e.g.* tournament games, a first advertising presentation for providing information related to one of a product and a service. *Filepp* at Abstract ("An interactive computer system network enables a user to . . . perform desired transactional services, such as banking and shopping, through any of a plurality of types of personal computers. . . . User characteristics are monitored by the system in order to generate and display specific advertisements to the user based on individual usage characteristics and predetermined interests."). *Id.* at 6:48-51 ("The user may, through [use of the system], bank, send and receive messages, review advertisements, place orders for merchandise, and perform other transactions."). *Id.* at 9:27-32 ("Continuing with reference to FIG. 3*b*, advertisements 280 provided over network 10 … may be included in any partition of a page. Advertisements 280 may be presented to the user on an individual basis from queues of advertisements . . . ."). *Id.* at FIGS. 3a and 3b (showing an 'ad partition' displayed simultaneously with a 'body partition,' which can include applications such as a game); *id.* at FIG. 4c (disclosing advertisement object 510).

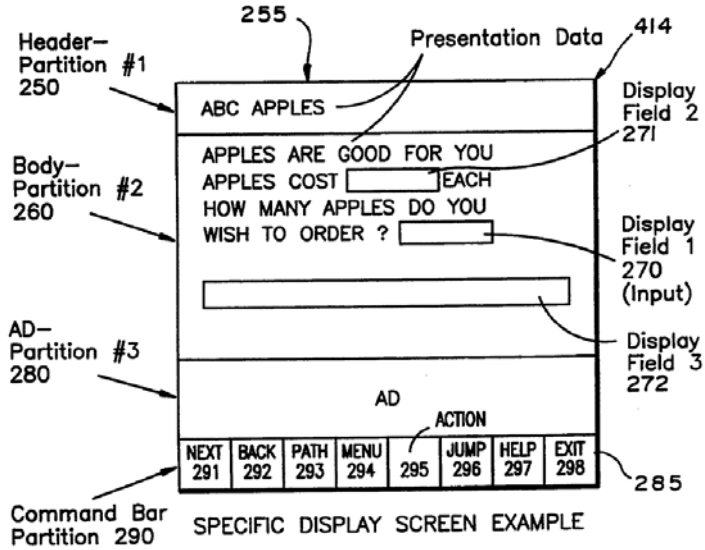| Claim 16	*Frequently Asked Questions About Poker* (*Maurer*) or *BJ Tourney at the IP* (*Raposa*) in View of U.S. Patent No. 5,347,632 (*Filepp*)
	Id. at 95:67-96:4 ("The page illustrated in FIG. 3*(b)* corresponds to a partitioned application that permit's [sic] a personal computer user to purchase apples. It shows how the monitor screen 414 of personal computer 405 might appear to the user. The displayed page includes a number of page partitions and corresponding page elements.").
wherein said first advertising presentation is received via the network from some node of the network, and displayed on at least a portion of said display;	*Filepp* discloses receiving a first advertising presentation via the network from some node of the network, and displayed on at least a portion of said display. *Filepp* at 9:27-32 ("Continuing with reference to FIG. 3*b*, advertisements 280 provided over network 10 … may be included in any partition of a page. Advertisements 280 may be presented to the user on an individual basis from queues of advertisements . . . ."). *Id.* at 10:43-51 ("In accordance with the method aspect of the invention and as shown in FIG. 4*c*, the network objects are organized as a family of objects each of which perform a specific function in support of the interactive session. More particularly, the network object family is seen to include 6 members: page format objects 502, page element object 504, window objects 506, program objects 508, advertisement objects 510 and

Claim 16	*Frequently Asked Questions About Poker* (*Maurer*) or *BJ Tourney at the IP* (*Raposa*) in View of U.S. Patent No. 5,347,632 (*Filepp*)
	page template objects 500.").
second presenting, by the player node over time, one or more additional advertising presentations, each said additional advertising presentation for providing information related to one of a product and a service,	*Filepp* discloses second presenting, by the player node over time, one or more additional advertising presentations, each said additional advertising presentation for providing information related to one of a product and a service. *Filepp* at 91:14-25 ("Ad manager 442 is invoked by object interpreter 435 to return the object-id of the next … available advertisement to be displayed. Ad manager 442 maintains a queue of advertisement object id's targeted to the specific user currently accessing the interactive network 10. Advertisement objects are pre-fetched from interactive system 10 from a personalized queue of advertisements that is constructed using data previously collected from user generated events and/or reports of objects used in the building of pages or windows, compiled by data collection manager 466 and transmitted to interactive system 10."). *Id.* at 92:13-20 ("If this is the first request for an advertisement object id that ad manager 442 has received during this user's session, ad manager 442 moves the advertisement list from the GEV into its own storage area, which it uses as an advertisement queue and sets up its queue management pointers, knowing that the first two advertisement objects have been pre-fetched.").
wherein each of at least some of said additional advertising presentations is: (a) received via the network from said some node,	*Filepp* discloses at least some of the additional advertising presentations received via the network via the network from said some node. *Filepp* at 10:43-51 ("In accordance with the method aspect of the invention and as shown in FIG. 4*c*, the network objects are organized as a family of objects each of which perform a specific function in support of the interactive session. More particularly, the network object family is seen to include 6 members: page format objects 502, page element object 504, window objects 506, program objects 508, advertisement objects 510 and page template objects 500."). *Id.* at 91:14-25 ("Ad manager 442 is invoked by object interpreter 435 to return the object-id of the next … available advertisement to be displayed. Ad manager 442 maintains a queue of advertisement object id's targeted to the specific user currently accessing the interactive

Claim 16	*Frequently Asked Questions About Poker* (*Maurer*) or *BJ Tourney at the IP* (*Raposa*) in View of U.S. Patent No. 5,347,632 (*Filepp*)
	network 10. Advertisement objects are pre-fetched from interactive system 10 from a personalized queue of advertisements that is constructed using data previously collected from user generated events and/or reports of objects used in the building of pages or windows, compiled by data collection manager 466 and transmitted to interactive system 10."). *Id.* at 92:1-8 ("Whenever the advertisement queue has more empty positions than replenishment threshold, a transaction is made to the advertisement queue application in high function system 110 shown in FIG. 2, via object/communications manager interface 443 for a number of advertisement object id's equal to the threshold. A response message includes a list of advertisement object id's, which ad manager 442 enqueues."). *Id.* at 92:13-20 ("If this is the first request for an advertisement object id that ad manager 442 has received during this user's session, ad manager 442 moves the advertisement list from the GEV into its own storage area, which it uses as an advertisement queue and sets up its queue management pointers, knowing that the first two advertisement objects have been pre-fetched."). *Id.* at 92:21-36 (describing the ability to fetch advertising presentations locally or over the network).
and (b) displayed on at least a portion of said display without the player providing an input that causes said additional advertising presentation to be displayed;	*Filepp* discloses at least some of the additional advertising presentations displayed on at least a portion of said display without the player providing an input that causes said additional advertising presentation to be displayed.

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Claim 16	*Frequently Asked Questions About Poker* (*Maurer*) or *BJ Tourney at the IP* (*Raposa*) in View of U.S. Patent No. 5,347,632 (*Filepp*)
	FIG. 3b *Filepp* at 9:27-30 ("Continuing with reference to FIG. 3*b*, advertisements 280 provided over network 10, like page elements, also include information for display on page 255, and may be included in any partition of a page."). *Id.* at 95:67-96:4 ("The page illustrated in FIG. 3*(b)* corresponds to a partitioned application that permit's a personal computer user to purchase apples. It shows how the monitor screen 414 of personal computer 405 might appear to the user. The displayed page includes a number of page partitions and corresponding page elements."). *Id.* at 91:14-18 ("Ad manager 442 is invoked by object interpreter 435 to return the object-id of the next … available advertisement to be displayed. Ad manager 442 maintains a queue of advertisement object id's targeted to the specific user currently accessing the interactive network 10."). *Id.* at 92:13-20 ("If this is the first request for an advertisement object id that ad manager 442 has received during this user's session, ad manager 442 moves the advertisement list from the GEV into its own storage area, which it uses as an advertisement queue and sets up its queue management pointers, knowing that the first two advertisement objects

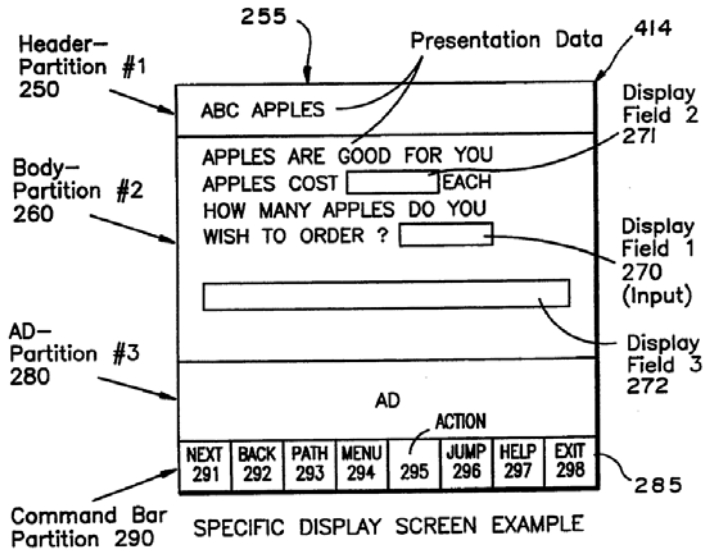| Claim 16	*Frequently Asked Questions About Poker* (*Maurer*) **or** *BJ Tourney at the IP* (*Raposa*) **in View of U.S. Patent No. 5,347,632** (*Filepp*)
	have been pre-fetched."). *Id.* at FIGS. 3a and 3b (showing an 'ad partition' displayed simultaneously with a 'body partition,' which can include applications such as a game); *id.* at FIG. 4c (disclosing advertisement object 510). FIG. 3a

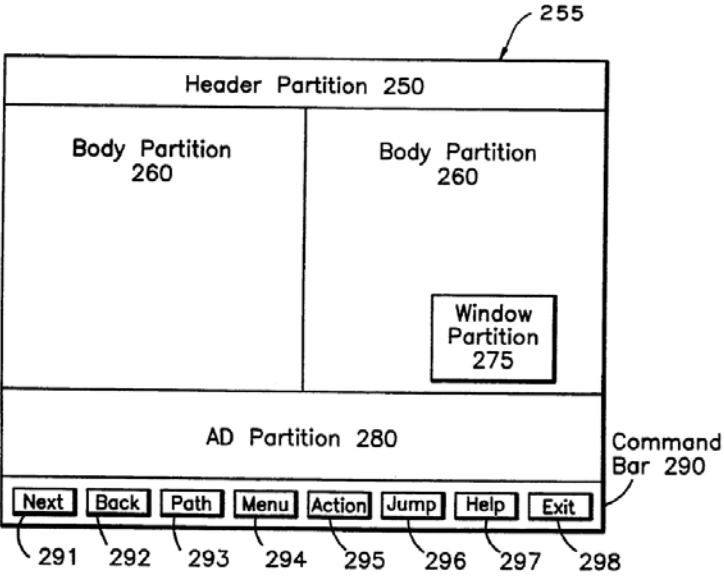| Claim 16	*Frequently Asked Questions About Poker* (*Maurer*) or *BJ Tourney at the IP* (*Raposa*) in View of U.S. Patent No. 5,347,632 (*Filepp*)
	FIG. 3b
second transmitting, via the network, data indicative of an action by the player in response to one of said first and said additional advertising presentations,	*Filepp* discloses second transmitting, via the network, data indicative of an action by the player in response to one of said first and said additional advertising presentations. *Filepp* at Abstract ("An interactive computer system network enables a user to … perform desired transactional services, such as banking and shopping, through any of a plurality of types of personal computers."). *Id.* at 96:15-18 ("In advertisement 280, presentation data and a field representing a post-processor that will cause the user to navigate to a targetable advertisement, is presented.").
wherein said data is transmitted: (i) from said player node,	*Filepp* discloses that said data is transmitted from said player node. *Filepp* at 82:36-38 ("Service software 430 provides functions specific to providing interaction between the user and interactive network 10[.]"). *Id.* at 82:66-83:2 ("The operating environment 450 manages communication and synchronization of service software 430, by

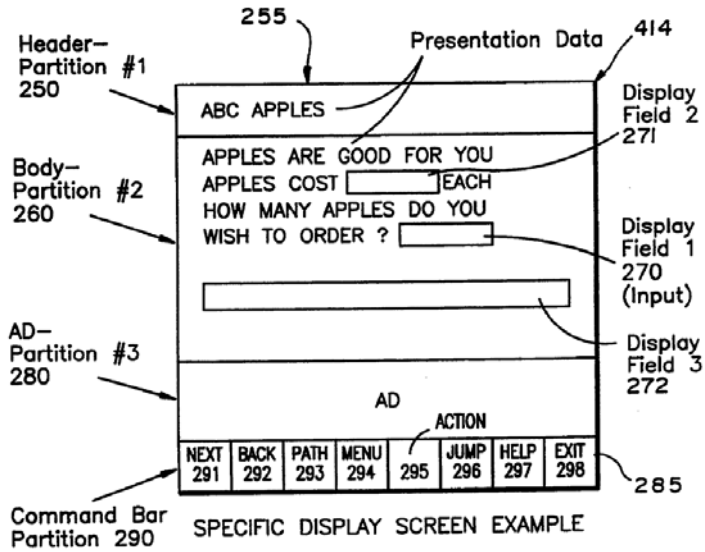| Claim 16	*Frequently Asked Questions About Poker* (*Maurer*) or *BJ Tourney at the IP* (*Raposa*) in View of U.S. Patent No. 5,347,632 (*Filepp*)
	supporting a request/response protocol and managing the interface between the native software 420 and external software 437."). *Id.* at 91:26-30 ("Advertisement objects 510 are PEOs that, through user invocation of a 'LOOK' command, cause navigation to partitioned applications that may themselves support, for example, ordering and purchasing of merchandise.").
and (ii) to a destination node of the network, said destination node identified at said player node by a destination network address used for transmitting said data;	*Filepp* discloses that said data is transmitted to a destination node of the network, said destination node identified at said player node by a destination network address used for transmitting said data. *Filepp* at 6:10-12 ("RS 400 includes a means to communicate with network 10 to retrieve objects in response to events occurring at RS 400 and to send and receive messages."). *Id.* at 7:13-18 ("Switch and file server layer 200 and cache/concentrator layer 300 together constitute a delivery system 20 which delivers requested data to the RS 400's of reception layer 401 and routes data entered by the user or collected at RS 400's to the proper application in network 10."). *Id.* at 23:49-66 ("[T]he DIA-defined data which flows through network 10 consists of a set a headers preface the end-user to end-user message text. Further, as in the case of objects, messages are organized in a family of types based on the specific form of its header. Particularly, there are 'FMO' headers which contain routing and control information; FM2 headers which contain transport level information; FM4 headers which contain gateway information; FM8 headers which obtain information for secondary routing; *i.e.* messages passed through from node to node; FM9 headers which contain network management information; and FM64 headers which contain application-to-application management information, where, for example, applications running at RS 400 need be rendered compatible with applications running on an external computer connected to network 10 through a gateway 210."). *Id.* at 24:14-17 ("With regard to destination routing, the basic premise of DIA is that each message flowing through network 10 carries a DIA header (FM0) that identifies its source and destination ids."). *Id.* at 26:28-34 ("In normal processing, reception system applications

Claim 16	*Frequently Asked Questions About Poker* (*Maurer*) or *BJ Tourney at the IP* (*Raposa*) in View of U.S. Patent No. 5,347,632 (*Filepp*)
	send requests to host applications. Host applications return responses to these requests. The Reception System application initiates this dialogue. Sending nodes are responsible for inserting the proper 'source id' (SID) and 'destination id' (DID) into the FM0."). *Id.* at 28:1-25 ("In accordance with the invention, the DIA headers are arranged in a predetermined form base on their function. More particularly, FMO headers, also known as Type 'O' headers are required for every message within the network. Header Type O provides information necessary for routing and message correlation. Its fields include: . . . Source Id [:] Identification of end-user sending current message . . . Destination Id [:] Identification of message destination. All messages are routed by destination id. When responses to messages are sent back to original source, the source id and destination id fields must be swapped."). *Id.* at 82:36-38 ("Service software 430 provides functions specific to providing interaction between the user and the interactive network 10[.]").
second receiving, via the network, another presentation for presenting to the player at said player node, wherein said another presentation is responsive to said step of second transmitting.	*Filepp* discloses second receiving, via the network, another presentation for presenting to the player at said player node, wherein said another presentation is responsive to said step of second transmitting. *Filepp* at 9:35-38 ("Individual queues of advertisements are constructed based upon data collected on the partitioned applications that were accessed by a user, and upon events the user generated in response to applications."). *Id.* at 91:14-25 ("Ad manager 442 is invoked by object interpreter 435 to return the object-id of the next … available advertisement to be displayed. Ad manager 442 maintains a queue of advertisement object id's targeted to the specific user currently accessing the interactive network 10. Advertisement objects are pre-fetched from interactive system 10 from a personalized queue of advertisements that is constructed using data previously collected from user generated events and/or reports of objects used in the building of pages or windows, compiled by data collection manager 466 and transmitted to interactive system 10."). *Id.* at 92:37-38 (noting that the ad manager had the "ability to provide

Claim 16	*Frequently Asked Questions About Poker* (*Maurer*) or *BJ Tourney at the IP* (*Raposa*) in View of U.S. Patent No. 5,347,632 (*Filepp*)
	advertisements that have been targeted to each individual user . . . .”). *Id.* at 5:56-67 (“Objects carry application programs and information for display at monitor screen 414 of RS 400. Application program objects, called pre-processor and post-processors, set up the environment for the user’s interaction with network 10 and respond to events created when the user inputs information at keyboard 424 of RS 400. Such events typically trigger a program object to be processed, causing one of the following: . . . the receiving of information for use in programs or for presentation in application-dependent fields on monitor screen 414 . . . .”). *Id.* at 6:10-12 (“RS 400 includes a means to communicate with network 10 to retrieve objects in response to events occurring at RS 400 and to send and receive messages.”). *Id.* at 10:43-51 (“In accordance with the method aspect of the invention and as shown in FIG. 4*c*, the network objects are organized as a family of objects each of which perform a specific function in support of the interactive session. More particularly, the network object family is seen to include 6 members: page format objects 502, page element object 504, window objects 506, program objects 508, advertisement objects 510 and page template objects 500.”). *Id.* at 26:28-32 (“In normal processing, reception system applications send requests to host applications. Host applications return responses to these requests. The Reception System application initiates this dialogue.”). *Id.* at 82:66-83:2 (“The operating environment 450 manages communication and synchronization of service software 430, by supporting a request/response protocol and managing the interface between the native software 420 and external software 437.”).

Claim 18	*Frequently Asked Questions About Poker* (*Maurer*) or *BJ Tourney at the IP* (*Raposa*) in View of U.S. Patent No. 5,347,632 (*Filepp*)
18. The method of claim 16, wherein at	*Filepp* discloses that the steps of first and second presenting are in response to a communication from an Internet service provider.

Claim 18	*Frequently Asked Questions About Poker* (*Maurer*) or *BJ Tourney at the IP* (*Raposa*) in View of U.S. Patent No. 5,347,632 (*Filepp*)
least one of said steps of first and second presenting is in response to a communication: (a) from an Internet service provider connecting the user to the network,	Specifically, *Filepp* teaches a system capable of supporting millions of users who connect to the network using ordinary personal computers that dial in using telephone modems. Given the substantial number ("millions") of users, type of client machine (ordinary PCs), and method of connection (telephone modem) taught by *Filepp*, one of ordinary skill in the art at the time of the Goldberg application (*i.e.*, circa 1996) would have understood the users described by *Filepp* to include Internet users connecting (necessarily) through an Internet service provider. *Filepp* at 1:11-15 ("This invention relates generally to a distributed processing, interactive computer network intended to provide very large numbers of simultaneous users; *e.g.* millions, with access to a large number; *e.g.*, thousands, of applications . . . ."). *Id*. at 3:44-45 ("FIG. 2 is a schematic diagram of the network illustrated in FIG. 1"). *Id*. at 6:51-64 ("In the preferred embodiment, network 10 provides information and transaction processing services for a large number of users simultaneously accessing the network via the public switched telephone network (PSTN), broadcast, and/or other media with their RS 400 units. Services available to the user include display of information such as movie reviews, the latest news, airlines reservations, the purchase of items such as retail merchandise and groceries, and quotes and buy/sell orders for stocks and bonds. Network 10 provides an environment in which a user, via RS 400 establishes a session with the

Claim 18	*Frequently Asked Questions About Poker* (*Maurer*) or *BJ Tourney at the IP* (*Raposa*) in View of U.S. Patent No. 5,347,632 (*Filepp*)
	network and accesses a large number of services.").
and (b) to said some network node so that said some network node transmits one or more of: said first advertising presentation, and said additional advertising presentations to the player node.	*Filepp* discloses that the communication is sent to said some network node so that said some network node transmits the advertising presentations to the player node. *Filepp* at 6:48-51 ("The user may, through [use of the system], bank, send and receive messages, review advertisements, place orders for merchandise, and perform other transactions."). *Id*. at 9:27-28 ("Continuing with reference to FIG. 3*b*, advertisements 280 provided over network 10 . . . ."). *Id*. at 91:19-25 ("Advertisement objects are pre-fetched from interactive system 10 from a personalized queue of advertisements that is constructed using data previously collected from user generated events and/or reports of objects used in the building of pages or windows, compiled by data collection manager 466 and transmitted to interactive system 10."). *Id*. at 92:21-36 (describing the ability to fetch advertising presentations locally or over the network).

As explained above, the combination of *Maurer* and/or *Raposa* with *Filepp* provides each

limitation of claims 16 and 18 and thus renders those claims obvious under 35 U.S.C. § 103(a).

F.   Claims 20 and 92 Are Anticipated Under 35 U.S.C. § 102(b) by *Eliezer*

Claim 20 recites a method of playing an ordinary card game in which two players play

simultaneous yet independent games against a computer opponent. Claim 20 thus represents a

computer implementation of an old concept, *e.g.*, the game of blackjack as played in casinos long

before the '560 application, and the prior art confirms this. Namely, *Eliezer* [Appendix E]

discloses an interactive cable television network on which the users can play simultaneous and

independent games, including blackjack, against a computer opponent.

Claim 92 broadly recites a method of playing a multiplayer game on a communications network in which a game playing node transmits to a first user the ranking of a second user and then updates it to present a change in the ranking while the first user is playing the game. According to claim 92, the ranking is indicative of a proficiency of the second user in playing the game. Thus, claim 92 covers virtually any multiplayer game in which the players' scores are updated. Likewise, *Eliezer* [Appendix E] discloses a multiplayer game on an interactive cable television network in which a game playing node transmits to each user the rankings of each other user and then updates the rankings as they change during play. In *Eliezer*, the ranking takes the form of the other user's "cumulative score," which satisfies the language of claim 92 because each user's cumulative score is indicative of that user's proficiency in playing the game.

Eliezer is a printed publication and was published on January 16, 1995 – over a year prior to the earliest possible priority date of the '560 patent, January 19, 1996. *Eliezer* therefore qualifies as prior art under 35 U.S.C. § 102(b). The charts below explain the pertinency and manner of applying *Eliezer* to claims 20 and 92.

Claim 20	*Navigating Main Street: a user's experience with interactive TV; GTE Main Street* (*Eliezer*)
20. A method of playing a card game, comprising:	*Eliezer* discloses a method of playing blackjack over an interactive TV network. *Eliezer* at 1 ("Main Street is an interactive television service_the only real product in the interactive tv market today, we believe. … Main Street offers an assortment of services: games, news, home banking and shopping, etc."). *Id*. at 4 ("While the game show and QB1 attract the most interest, card games such as poker and blackjack and board games such as checkers and reversi require the

Claim 20	*Navigating Main Street: a user's experience with interactive TV; GTE Main Street* (*Eliezer*)
	most complicated software.").
generating electronic card representations for playing the card game;	*Eliezer* discloses generating electronic card representations for playing the card game. *Eliezer* at 4 ("Its computer generates the card and table images that go to each individual user (up to six players can join a virtual game table), keeps track of scoring and keeps the game moving, allowing only 20 seconds before a time-out.").
receiving player identification information prior to at least a first player playing the card game wherein said identification information is used to identify additional information related to the first player for use in subsequent instances of the card game;	*Eliezer* discloses receiving player identification information (a subscriber ID) prior to at least a first player playing the card game. *Eliezer* at 3 ("Main Street takes care of dialing, logging on and password security via subscriber id; users don't even know they're doing it."). That identification information is used to identify additional information (card combinations and score) related to the first player for use in subsequent instances of the card game. *Id.* at 4 ("Its computer generates the card and table images that go to each individual user (up to six players can join a virtual game table), keeps track of scoring and keeps the game moving, allowing only 20 seconds before a time-out.").
first playing a first instance of the card game between the first player and a substantially electronic game playing module, wherein said game playing module is dealt a first sequence of said card representations;	*Eliezer* discloses playing a first instance of the card game between the first player and a substantially electronic game playing module. *Eliezer* at 4 ("Its computer generates the card and table images that go to each individual user (up to six players can join a virtual game table) . . . ."). The rules of blackjack require, and thus *Eliezer* discloses, that the dealer (game playing module) is dealt a first sequence of card representations. *See, e.g.*, '560 patent

Claim 20	*Navigating Main Street: a user's experience with interactive TV; GTE Main Street* (*Eliezer*)
	at 2:2-10 ("The card game of blackjack is a game of chance played between a designated player known as a 'dealer' and one or more other players. Basically, each player plays against the dealer in the sense that each player attempts to achieve a collection or hand of cards having a total score for the hand closer to the value 21 than the score of the hand of the dealer. However, if a player's card hand goes over 21, the player may lose any wagers bet on the hand regardless of the value of the card hand of the dealer."); *id*. at 2:18-21 ("In one conventional method for playing blackjack, at the commencement of a blackjack hand, each player initially is provided with two cards and the dealer also receives two cards.").
second playing a second instance of the game between a second player and said game playing module, wherein said first and second card game instances overlap in time and wherein said game playing module is dealt a second sequence of card representations for playing said second instance of the card game;	*Eliezer* discloses eight different blackjack tables, each table having six people, playing at the same time. *Eliezer*. at 6 ("For example, the poker and blackjack games require their own machines to generate the screens for each player and to keep track of scoring. There are eight different tables, with up to six people that can be playing at a time."). Thus, any person at the first table satisfies the claimed "first player," and any person at any of the remaining tables satisfies the claimed "second player."
wherein said first and second sequences dealt to the game playing module have at least different card representations in at least one identical card representation position, in each of said first and second sequences.	*Eliezer* discloses eight blackjack tables playing separate games, and thus having different card representations in at least one identical card representation position, at the same time. *Eliezer* uses a dedicated game playing computer ("machine") for blackjack that is distinct from the machines used for other games, such as poker. *Eliezer* at 6 ("For example, the poker and blackjack games require their own machines to generate the screens for each player and to keep track of scoring. There are eight different tables, with up to six people that can be playing at a time.").

Claim 92	*Navigating Main Street: a user's experience with interactive TV; GTE Main Street* (*Eliezer*)
92. A method of playing a game on a communications network, comprising:	*Eliezer* describes a method of playing games on an interactive TV communications network. *Eliezer* at 1 ("Main Street is an interactive television service_the only real product in the interactive tv market today, we believe."). *Id.* ("Main Street offers an assortment of services: games, news, home banking, and shipping, etc.").
receiving at a game playing node on the network, a contact by each of a plurality of users, via a corresponding node on the network for the user, for initiating a corresponding instance of the game between the game playing node and the user's corresponding node, and at least some of said instances overlap in time;	*Eliezer's* system, GTE Main Street, functions as the game playing node on the interactive TV network. *Eliezer* at 6 ("When a user clicks the 'on' button on the Main Street box, the box dials the Main Street Data General Aviion computer, a Unix machine that acts as a traffic cop for all service requests. It handles the log-on procedure, getting the background screens from the media server. Next to the server is a proprietary teletext inserter and video switcher, which handles the communications switching between channels for access to the video games and switching between users for executing requests. … Other dedicated computers handle reverse and checkers (also played against others logged in), AccuWeather and QB1"). Each user has a network node comprising an interface box, a cable decoder, and a remote-control module. *Id.* at 2 ("When you call the 800 number to sign up, the staff makes an appointment for an installer to come to your home and connect an interface box to both your cable decoder and your phone line."); *id.* at 3 ("The remote-control module is used to communicate with Main Street."). QB1 is one game offered by *Eliezer*. *Id.* at 4 ("QB1 and the new Press Your Luck games are the most interesting…"). GTE Main Street's game playing node initiates multiple, concurrent instances of QB1 corresponding to contacts from users' network nodes. *Id.* at 6 ("Users who select th[e] [QB1] service are switched transparently to the second of Main Street's two channels, where full-motion video is broadcast to all those logged on to that game.").
transmitting game plays between said game playing node and a first of the users, for the	Game plays of QB1 are transmitted between the game playing node and a first of the users. Specifically, game plays are transmitted from each user to the GTE Main Street game playing node. *Eliezer* at 4 ("Using the remote control, you enter your guess as to whether the next play will be a pass or a run, long or short, and right, middle or left.").

Claim 92	*Navigating Main Street: a user's experience with interactive TV; GTE Main Street* (*Eliezer*)
corresponding instance of the game;	Although this limitation is satisfied by the transmission of game plays from the users to the game playing node, it is additionally satisfied by the transmission of game plays from the game playing node to the users, *i.e.*, the transmission of video footage of football plays. *Id.* ("QB1 and the new Press Your Luck games are the most interesting, in that they make use of full-motion video and allow user participation during the showing of the game. QB1 lets you play along with the NFL game being broadcast nationally, but you watch it on a Main Street channel (via NTN Communications satellite) instead of a broadcast channel.").
transmitting from the game playing node to the corresponding node of the first user, the ranking of a second of the users, wherein said ranking is indicative of a proficiency of the second user in playing the game, and said ranking is updated to present a change in said ranking while the first user is playing the game.	The GTE Main Street game playing node of *Eliezer* transmits to each user the cumulative scores of the other users, which are updated during game play to present changes. *Eliezer* at 4 ("An overlay on the tv screen displays your call and cumulative score alongside the scores of other logged-on contestants."). Each cumulative score, by definition, is indicative of a proficiency of the corresponding user in playing the game. The cumulative scores inherently correspond to rankings because higher scores indicate greater proficiency than lower scores.

As explained above, *Eliezer* discloses each limitation of claims 20 and 92 and thus anticipates claims 20 and 92 under 35 U.S.C. § 102(b).

G.   Claim 20 Is Anticipated Under 35 U.S.C. § 102(b) by *Itkis*

Itkis [Appendix A] teaches two users playing two independent yet simultaneous card games against a single computer system. *Itkis* also discloses the ability for the users to provide

identification information (*e.g.*, a smart game card) before game play begins and using that

information to identify additional information for use during game play (*e.g.*, a current account

balance). *Itkis* does not explicitly describe some of the basics of blackjack. As the Federal Circuit

has counseled, however, the "common knowledge of technologists" can supply such missing

details inherently.[51] And *Itkis* does just that by disclosing that the rules of blackjack were well-

known in the prior art.[52] Similarly, and importantly, the Background section of the '560 patent

admits that the rules of blackjack were well-known in the prior art.[53] Accordingly, *Itkis* provides

sufficient detail to anticipate claim 20.

    Itkis qualifies as prior art under 35 U.S.C. § 102(b) because it issued on August 15, 1989 –

over six years prior to the earliest possible priority date of the '560 patent, January 19, 1996. The

charts below explain the pertinency and manner of applying *Itkis* to claim 20.

Claim 20	U.S. Patent No. 4,856,787 (*Itkis*)
A method of playing a card game, comprising:	*Itkis* discloses a method of playing a card game. *Itkis* at Abstract ("A distributed game network comprising a master game device and a number of slave game devices. The slave game device is capable of playing concurrently a number of menu selectable card and chance games, such as poker, bingo, blackjack, and keno.").

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[51] *Continental Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1991).

[52] *Itkis* at 3:35-40 ("[s]ince the techniques of computer realization of individual card and chance games such as poker, keno, and bingo are well known and described in multiple U.S. patents, we ommit [sic] the detail [sic] description of software and hardware realization of the individual games as applicable to the slave game device 7.").

[53] *See generally* '560 patent at cols. 2-3 (describing the rules of blackjack); *id.* at 2:11-13 (describing how games of blackjack are "typically played"); *id.* at 2:18-21 (describing "one conventional method for playing blackjack"); *id.* at 3:54-58 (describing "all known variations of blackjack").

Claim 20	U.S. Patent No. 4,856,787 (*Itkis*)
generating electronic card representations for playing the card game;	*Itkis* discloses generating electronic card representations for playing the card game. *Itkis* at 3:25-30 ("Each of the tasks 15 has a display window associated with the task as illustrated in FIG. 4, wherein the window 20 displays two bingo cards 21, the bingo tableau 22 and the bingo pattern 23; the window 24 displays five poker cards 25, and the window 26 displays the keno card 27."). *Id*. at Fig. 4 (showing electronic card representations for playing the card game):
receiving player identification information prior to at least a first player playing the card game	*Itkis* discloses receiving player identification information (e.g., game card identification number) prior to at least a first player playing the card game. *Itkis* at 1:48-49 ("Each slave game device sends to the master game device the local game status and accounting information."). *Id*. at 2:63-65 ("In the process of a game, the master game device 1 is used by a game operator, slave game device 7 is utilized by a player."). *Itkis* at 5:25-28 ("[T]he game device 7 . . . reads from the microprocessor 43 the current account balance and the game card identification number.").

Claim 20	U.S. Patent No. 4,856,787 (*Itkis*)
wherein said identification information is used to identify additional information related to the first player for use in subsequent instances of the card game;	*Itkis* discloses using the identification information (game card identification number) to identify additional information related to the first player (account balance) for use in subsequent instances of the card game. The game card identification number can be used by the master game device to identify the first player's running account balance, which is updated during subsequent instances of the game based on the outcomes of game bets and then written back to the game card associated with that identification number. *Itkis* at 5:25-28 ("[T]he game device 7 . . . reads from the microprocessor 43 the current account balance and the game card identification number."). *Id*. at 5:25-28 ("In particular, the game device 7 writes to the card 42 outcomes of the bets and reads from the microprocessor 43 the current account balance and the game card identification number."). *Id*. at 1:63-68 ("The slave game device is also equipped with a smart game card reader and writer. The smart game card associated with the slave game device is equipped with an imbedded microprocessor keeping track of bets and outcomes of games.").
first playing a first instance of the card game between the first player and a substantially electronic game playing module,	*Itkis* discloses first playing a first instance of the card game between the first player and a substantially electronic game playing module. *Itkis* at 1:50-53 ("The slave game devices execute in real time (play) concurrently a number of menu-selectable card and chance games, such as bingo, keno, poker, blackjack, and the like."). *Id*. at 3:12-20 ("Being a general purpose computer, the master game device is running under a multitasking operating system enabling a concurrent service of all the slave devices 7 . . . . The operating system 14 governs concurrently a number of tasks 15. Each task 15 executes an individual game."). *Id.* at 5:55-58 ("A conceivable variation of the resource pooling approach is the concept of clustering slave game devices 7 playing the same card game against the card dealer (the casino)."").
wherein said game playing module is dealt a first sequence	*Itkis* discloses the game playing module (*i.e.*, master game device) being dealt a first sequence of card representations. For example, the master game device is dealt a sequence of cards when playing blackjack

Claim 20	U.S. Patent No. 4,856,787 (*Itkis*)
of said card representations;	against slave devices because the dealer in blackjack always receives cards. '560 patent at 2:18-21 ("In one conventional method for playing blackjack, at the commencement of a blackjack hand, each player initially is provided with two cards and the dealer also receives two cards."). *Itkis* at 5:55-58 ("A conceivable variation of the resource pooling approach is the concept of clustering slave game devices 7 playing the same card game against the card dealer (the casino)."). *Id*. at 3:35-38 ("[T]he techniques of computer realization of individual card and chance games such as poker, keno, and bingo are well known and described in multiple U.S. patents. . . .").
second playing a second instance of the game between a second player and said game playing module,	*Itkis* discloses second playing a second instance of the game between a second player and the game playing module. *Itkis* at 5:55-60 ("A conceivable variation of the resource pooling approach is the concept of clustering slave game devices 7 playing the same card game against the card dealer (the casino) For example, several players may play a common blackjack or poker game using their slave game devices 7."). *Id*. at 2:12-16 ("It is the primary objective of this invention to introduce a game network providing each player with an opportunity to select and play simultaneously a variety of different games while facilitating concurrent playing of multiple game cards for the selected games."). *Id*. at 1:41-53 ("The present invention is a distributed game network comprising a master game device and a number of slave game devices. . . . The slave game devices receive from the master game device commands and random data, such as bingo patterns and bingo and keno numbers called by the game operator. Each slave game device sends to the master game device the local game status and accounting information. The slave game devices execute in real time (play) concurrently a number of menu-selectable card and chance games, such as bingo, keno, poker, blackjack, and the like.").
wherein said first and second card game instances overlap in time and	*Itkis* discloses the first and second card game instances overlapping in time. *Itkis* at 1:41-53 ("The present invention is a distributed game network

Claim 20	*U.S. Patent No.* **4,856,787** (*Itkis*)
	comprising a master game device and a number of slave game devices. … The slave game devices receive from the master game device commands and random data, such as bingo patterns and bingo and keno numbers called by the game operator. Each slave game device sends to the master game device the local game status and accounting information. The slave game devices execute in real time (play) concurrently a number of menu-selectable card and chance games, such as bingo, keno, poker, blackjack, and the like.").
	Id. at 5:55-60 ("A conceivable variation of the resource pooling approach is the concept of clustering slave game devices 7 playing the same card game against the card dealer (the casino) For example, several players may play a common blackjack or poker game using their slave game devices 7.").
	Id. at 1:25-35 (distinguishing *Itkis* from the prior art by noting the art did not disclose "provisions for concurrent playing of multiple games with multiple sets of game cards in each of the multiple games being played.").
	Id. at 2:12-16 ("It is the primary objective of this invention to introduce a game network providing each player with an opportunity to select and play simultaneously a variety of different games while facilitating concurrent playing of multiple game cards for the selected games.").
wherein said game playing module is dealt a second sequence of card representations for playing said second instance of the card game;	*Itkis* discloses the game playing module being dealt a second sequence of card representations for playing said second instance of the card game. For example, the master game device is dealt a sequence of cards when playing a second blackjack game against slave devices because the dealer in blackjack always receives cards. '560 patent at 2:18-21 ("In one conventional method for playing blackjack, at the commencement of a blackjack hand, each player initially is provided with two cards and the dealer also receives two cards.").
	Itkis at 5:55-58 ("A conceivable variation of the resource pooling approach is the concept of clustering slave game devices 7 playing the same card game against the card dealer (the casino)."
	Id. at 3:35-38 ("[T]he techniques of computer realization of individual card and chance games such as poker, keno, and bingo are well known and described in multiple U.S. patents. . . .").

REQUEST FOR *EX PARTE* REEXAMINATION
U.S. Patent No. 6,264,560

Claim 20	U.S. Patent No. 4,856,787 (*Itkis*)
wherein said first and second sequences dealt to the game playing module have at least different card representations in at least one identical card representation position, in each of said first and second sequences.	*Itkis* discloses the first and second sequences dealt to the game playing module having different card representations in at least one identical card representation position, in each of said first and second sequences. *Itkis* at 5:55-60 ("A conceivable variation of the resource pooling approach is the concept of clustering slave game devices 7 playing the same card game against the card dealer (the casino). For example, several players may play a common blackjack or poker game using their slave game devices 7."). Inherently, each participant in a common blackjack or poker game must have at least different card representations in at least one identical card representation position because no two cards in a poker or blackjack deck are ever the same. *Id*. at 2:12-16 ("It is the primary objective of this invention to introduce a game network providing each player with an opportunity to select and play simultaneously a variety of different games while facilitating concurrent playing of multiple game cards for the selected games."). *Id*. at 1:41-53 ("The present invention is a distributed game network comprising a master game device and a number of slave game devices. . . . The slave game devices receive from the master game device commands and random data, such as bingo patterns and bingo and keno numbers called by the game operator. Each slave game device sends to the master game device the local game status and accounting information. The slave game devices execute in real time (play) concurrently a number of menu-selectable card and chance games, such as bingo, keno, poker, blackjack, and the like.").

As explained above, *Itkis* discloses each limitation of claim 20 and thus anticipates claim 20 under 35 U.S.C. § 102(b).

H. Claim 92 Is Rendered Obvious Under 35 U.S.C. § 103(a) Over the Combination of the Two Components of Netrek: The BRM-Hadley Client Software Source Code and the Vanilla Server Software Source Code

Netrek is a multi-user battle simulation game with a Star Trek theme played over a communications network. Netrek comprises a server that functions as a game playing node and communicates with the players' client software via the network. Among other features, the server communicates to each player the rankings of all current players, which then can be displayed on

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each player's screen.

The substantial new question of patentability addressed herein relies on a combination of two prior art printed publications: (1) the source code for version 1.7 of the BRMH Netrek client software [Appendix F] and (2) the source code for version 2.5pl4 of the Vanilla Netrek Server software [Appendix G].

The Declaration of David Ahn, attached hereto as Exhibit 4, attests to the date and public accessibility of the BRMH-1.7 client source code and the Vanilla 2.5pl4 Server source code. The Ahn declaration is submitted pursuant to MPEP § 2216, which provides that "[a]ffidavits or declarations or other written evidence which explain the contents or pertinent dates of prior art patents or printed publications in more detail may be considered in reexamination."[54]

As confirmed by the Ahn declaration, the source code for version 1.7 of the Netrek BRMH client was publicly accessible via one or more file transfer protocol (FTP) sites by at least October 16, 1993[55] – over two years prior to the earliest possible priority date of the '560 patent, January 19, 1996. Similarly, the source code for version 2.5pl4 of the Netrek Vanilla Server was publicly accessible via one or more FTP sites by at least December 15, 1994[56] – over one year prior to the earliest possible priority date of the '560 patent. Thus, both sets of source code qualify as prior art

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[54] Patent & Trademark Office, *Manual of Patent Examining Procedure* § 2216 (8th ed., rev. 5, Aug. 2006) [hereinafter MPEP]. *Cf. id*. at § 2258(I)(E) ("Affidavits or declarations or other written evidence which explain the contents or pertinent dates of prior art patents or printed publications in more detail may be considered in reexamination, but any rejection must be based upon the prior art patents or printed publications as explained by the affidavits or declarations or other written evidence. The rejection in such circumstances cannot be based on the affidavits or declarations as such, but must be based on the prior art patents or printed publications.").

[55] Declaration of David Ahn, ¶¶ 9-15 [hereinafter Ahn Dec.] [Ex. 4].

[56] *Id.*

printed publications under 35 U.S.C. § 102(b).

As provided below, a person of ordinary skill in the art would have had many strong reasons to combine the Netrek BRMH 1.7 client source code with the Vanilla 2.5pl4 Netrek Server software source code.

As explained above, *KSR* abolished the teaching/suggestion/motivation (TSM) test as a formal requirement for obviousness rejections, and suggested alternative reasons why a person of ordinary skill in the art might have combined prior art references, including (1) the combination would have yielded predictable results or created no synergy[57] and (2) design or market incentives provided a reason to combine in a manner that was not novel.[58] Regarding design and market incentives, the Court instructed that the "proper question" to ask is whether "[one] of ordinary skill, facing the wide range of needs created by developments in the field of endeavor, would have seen a benefit to [combine]."[59]

Subsequently, the Board of Patent Appeals and Interferences cited *KSR* and the Federal Circuit's decision in *Leapfrog* in affirming an examiner's finding of obviousness, explaining that combining features of the prior art was not "uniquely challenging or difficult for one of ordinary skill in the art" and "appear[ed] to present no unexpected technological advance in the art," adding

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[57] *KSR*, 127 S. Ct. at 1740 (presenting the key question as "whether the improvement is more than the predictable use of prior-art elements according to their established functions." and explaining that a combination is obvious when it creates no synergy, *i.e.*, when the two technologies "in combination [do] no more than they would in separate, sequential operation" or when the applicant "'simply arranges old elements with each performing the same function it had been known to perform' and yields no more than one would expect from such an arrangement.").

[58] *Id.*

[59] *Id.* at 1744.

"[t]he function remains the same."[60] The Board also noted that a person of ordinary skill in the art would have recognized the commonly understood benefits to combine at the time of the invention.[61]

Under these authorities, one of ordinary skill in the art would have had a ample reason to combine any available client and server source code files of Netrek, including the BRMH-1.7 client and Vanilla 2.5p14 Server, because their sole purpose was to be combined to create the game of Netrek. Clearly, one of ordinary skill in the art would have seen an obvious benefit to combining and would have had a strong design incentive to do so: the incentive of making the software work for its intended purpose. That combination would have yielded predictable results, with no synergistic effect, because client and server components, by definition, were written to work together in order to carry out the specified functions. And combining multiple source code files by compiling them and using them together was not "uniquely challenging or difficult," but rather well within the grasp of those of ordinary skill at the time without need for undue experimentation.[62]

Also, the BRMH 1.7 client and Vanilla 2.5pl4 Server would have provided no more in combination (a client and server operating as a distributed Netrek system) than they would have done in separate, sequential operation (a Netrek client in one instance, and a Netrek server in the other, capable of carrying out the client and server functions, respectively, of a distributed Netrek

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[60] *Catan*, Appeal No. 2007-0820 at 17-18.

[61] *Id.* at 20.

[62] Ahn Dec. Ex. L at 1 (newsgroup posting declaring "It's really not hard to grab some code and take a look."); Ahn Dec. Ex. M (discussion on rec.games.netrek regarding compilation of the Vanilla 2.5pl4 Server source code).

system). That combination thus represents the simple arrangement of old elements, with each

performing the same function it had been known to perform and yielding no more than one would

expect from such an arrangement.[63]

Moreover, the United States Patent and Trademark Office recently published a list of

rationales for determining obviousness, at least some of which bear directly on the question of

whether one of ordinary skill in the art would have combined the BRMH-1.7 client and Vanilla

2.5pl4 Server source code. Those rationales include:

- "Combining prior art elements according to known methods to yield predictable results"; (*Rationale (A)*)

- "Simple substitution of one known element for another to obtain predictable results"; (*Rationale (B)*)

- "'Obvious to try' – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success"; (*Rationale (E)*) and

- "Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention." (*Rationale (G)*)[64]

Numerous messages posted to the rec.games.netrek Usenet newsgroup ("Netrek

newsgroup") during 1994, over one year prior to the earlier priority date for the '560 patent,

support these rationales. Some of those postings explicitly taught and/or suggested combining

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[63] *KSR*, 127 S. Ct. at 1740 (instructing that a combination is obvious when it creates no synergy, *i.e.*, when the two technologies "in combination [do] no more than they would in separate, sequential operation" or when the applicant "'simply arranges old elements with each performing the same function it had been known to perform' and yields no more than one would expect from such an arrangement.").

[64] Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*, § III, 72 Fed. Reg. 57,526, 57,529 (Patent & Trademark Office Oct. 10, 2007) [hereinafter Obviousness Guidelines].

Netrek clients and servers according to known methods to yield predictable results.[65] One example

is the Frequently Asked Questions (FAQ) message that users posted periodically[66] The version of

the FAQ posted on July 21, 1994 provided such advice as:

- "Netrek is set up as a client/server combination."[67]

- "First, you need to get a client binary for your machine … Once you have the binary, rename it to something logical like 'netrek' and run it with 'netrek -h <hostname> -p <port>'. Read the Netrek Server List to find a server near you; the nearer, the better."[68]

- "You have a standard blessed client (or an unblessed client) but the server accepts only RSA clients; read the netrek FTP list to find out where you can get one."[69]

- "If you don't have a local server, using a UDP client on a UDP server could reduce your lag considerably"[70]

That FAQ message further referenced an "FTP List" posting also dated July 21, 1994,[71]

which identified various clients and servers that could be combined for playing Netrek, including

version 1.7 of the BRM-Hadley (BRMH) client source code and version 2.2 of the Vanilla Server

source code.[72] A subsequent posting to rec.games.netrek, dated August 9, 1994, announced that

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[65] *See Obviousness Guidelines*, § III(G), 72 Fed. Reg. at 57,529 (teaching, suggestion, or motivation in the prior art).

[66] Ahn Dec., ¶ 8.

[67] Ahn Dec. Ex. E at 2.

[68] *Id.* at 2- 3.

[69] *Id.* at 5.

[70] *Id.* at 7.

[71] *Id.* at 2.

[72] Ahn Dec. Ex. G at 1 (contents identifying lists of clients and servers), 3 (identifying BRMH-1.7

the Vanilla Server had been updated to version 2.5pl4.[73]

Given (1) the suggestion that the BRMH-1.7 client and Vanilla 2.2 server could be used together and (2) the suggestion that version 2.5pl4 of the Vanilla Server advantageously provided an update to version 2.2, one of ordinary skill in the art would have been motivated to combine the BRMH 1.7 client and Vanilla 2.5pl4 Server in order to play Netrek.[74] Alternatively viewed, one of ordinary skill in the art would have been motivated to combine the BRMH 1.7 client with the Vanilla 2.2 Server and then substitute the version 2.5pl4 of the server for version 2.2.[75] One of ordinary skill in the art certainly would have known how to combine any client and server, which required the routine methods of compiling and then running the compiled software. And such compilation would have yielded predictable results, namely the results specified by the source code instructions.[76]

Furthermore, given that a relatively small number of choices for client and server software were identified on rec.games.netrek, it would have been obvious for one of ordinary skill in the art to try combining each, eventually arriving at the combination of the BRMH-1.7 client and the Vanilla 2.5pl4 Server.[77]

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client), 6 (identifying Vanilla server ver. 2.2).

[73] Ahn Dec. Ex. J at 1.

[74] *See Obviousness Guidelines*, § III(G), 72 Fed. Reg. at 57,529 (teaching, suggestion, or motivation in the prior art).

[75] *See Obviousness Guidelines*, § III(B), 72 Fed. Reg. at 57,529 (simple substitution of one known element for another).

[76] *See Obviousness Guidelines*, § III(A), 72 Fed. Reg. at 57,529 (combining prior art elements according to known methods to yield predictable results).

[77] *See Obviousness Guidelines*, § III(E), 72 Fed. Reg. at 57,529 (obvious to try).

Accordingly, the postings on rec.games.netrek would have motivated a person of ordinary

skill in the art to combine the BRMH-1.7 client source code with the Vanilla 2.5pl4 Server.

The chart below explains the pertinency and manner of applying the source code for the

BRMH 1.7 Netrek client with the Vanilla 2.5pl4 Netrek Server to render claim 92 obvious under

35 U.S.C. § 103(a). Pursuant to MPEP §§ 2216 and 2258, the chart contains footnotes that cite a

Declaration by Netrek co-author Kevin Smith [Exhibit 5], which explains the source code

instructions.[78]

Claim 92	Source Code For Netrek
92. A method of playing a game on a communications network, comprising:	The Netrek source code defines computer instructions for playing a game. Netrek Server2.5pl4 Source Code [hereinafter "Server2.5pl4"], C:*Server\ntserv\main.c* at line 295 [App. G at 504] ("/* Reentry point of game */"), line 312 [App. G at 504] ("exitGame();"), line 339 [App. G at 505] ("/* put observer in game */"), line 342 [App. G at 505] ("/* Put player in game */"), line 349 [App. G at 505] ("'GOD->ALL","%s (%s@%s) is banned from the game.'"), line 351 [App. G at 505] ("'You are banned from the game.'"), line 381 [App. G at 505] ("leaving the game").[79] The Netrek source code causes the game to be played on a communications network using the TCP or UDP communications protocol. *See* Netrek BRMH-1.7 Source Code [hereinafter "BRMH-1.7"], C:*client\socket.c* at lines 535-629 [App. F at 386-88] (client's *callServer* function initiates contact with a Netrek server), lines 391-501 [App. F at 383-85] (client's *connectToServer* function initiates contact with a Netrek server). *See* Server2.5pl4, C:*Server\newstartd\newstartd.c* at lines 129-73 [App. G at 291-92] (server's *newstartd* program loops while waiting for client

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[78] Declaration of Kevin Smith [hereinafter "Smith Decl."] [Ex. 5].

[79] Smith Decl. at ¶ 3 ("Netrek is a multi-user game played over the Internet using a central server running Netrek server software. Players playing Netrek connect to a Netrek server using host computers running Netrek client software."); *id.* at ¶ 8 ("the user's client software contacts the Netrek server software with a request to begin game play"); *id.* at ¶ 10 ("The client software receives game play data transmitted from the server via the *readFromServer* function"); *see generally id.* at ¶ 11-14.

Claim 92	Source Code For Netrek
	contact), lines 155-70 [App. G at 291-92] (*ntserv* program spawned by client contact); C:*Server\\ntserv\\main.c* at line 136 [App. G at 501] (server calls *connectToClient* function); C:*Server\\ntserv\\socket.c* at lines 442-88 [App. G at 601-02] (server opens a TCP/IP or UDP communications socket to the client); C:*Server\\ntserv\\main.c* at lines 144-364 [App. G at 501-505] (server creates a client instance), line 367 [App. G at 505] (server's *input( )* function waits for client input).[80] The Netrek source code defines a server that operates at a centralized game playing computer (node) on the network. *See generally* Server2.5pl4 [App. G] (Server2.5pl4 source code defines a game-playing server). *See id.*, Server2.5pl4, C:*Server\\newstartd\\newstartd.c* at lines 129-73 [App. G at 291-92] (server's *newstartd* program loops while waiting for client contact), lines 155-70 (*ntserv* program spawned by client contact) [App. G at 291-92]; C:*Server\\ntserv\\main.c* at line 136 [App. G at 501] (server calls *connectToClient* function); C:*Server\\ntserv\\socket.c* at lines 442-88 [App. G at 601-02] (server opens a TCP/IP or UDP communications socket to the client); C:*Server\\ntserv\\main.c* at lines 144-364 [App. G at 501-505] (server creates a client instance), line 367 [App. G at 505] (server's *input( )* function waits for client input).[81] The Netrek source code defines a client that can operate independently and simultaneously at each of multiple user nodes on the network. Each individual user instantiates the client in order to play the game via communication with the server node. *See generally* BRMH-1.7 [App. F] (BRMH-1.7 source code defines a game-playing client). *See id.*, C:*client\\socket.c* at lines 535-629 [App. F at 386-88] (client's *callServer* function initiates contact with a Netrek server), lines 391-501 [App. F at 383-85] (client's *connectToServer* function initiates contact with a Netrek server), lines 652-716 [App. F at 388-89] (client's *readFromServer* function receives game play data from server), lines 975-1005, 1149-1168 [App. F at 394-97] (client's *handleTorp* and *handleStatus* routines process game play data), lines 1537-1634 [App. F at 404-06] (client's *sendServerPacket* command transmits game play data to the server).[82]

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[80] Smith Decl. [Ex. 5] at ¶¶ 3, 5, 8-9.

[81] *Id.* at ¶ 3, 5, 8-9.

[82] *Id.* at ¶ 3, 8-10.

Claim 92	Source Code For Netrek
receiving at a game playing node on the network, a contact by each of a plurality of users, via a corresponding node on the network for the user, for initiating a corresponding instance of the game between the game playing node and the user's corresponding node, and at least some of said instances overlap in time;	In Netrek, each user node contacts the game playing node (server) via that user's network node, for initiating a corresponding instance of the game. *See* BRMH-1.7, C:*client\socket.c* at lines 535-629 [App. F at 386-88] (client's *callServer* function initiates contact with a Netrek server), lines 391-501 [App. F at 383-85] (client's *connectToServer* function initiates contact with a Netrek server). *See* Server2.5pl4, C:*Server\newstartd\newstartd.c* at lines 129-73 [App. G at 291-92] (server's *newstartd* program loops while waiting for client contact), lines 155-70 [App. G at 291-92] (*ntserv* program spawned by client contact); C:*Server\ntserv\main.c* at line 136 [App. G at 501] (server calls *connectToClient* function); C:*Server\ntserv\socket.c* at lines 442-88 [App. G at 601-02] (server opens a TCP/IP or UDP communications socket to the client); C:*Server\ntserv\main.c* at lines 144-364 [App. G at 501-05] (server creates a client instance), line 367 [App. G at 505] (server's *input()* function waits for client input).[83] Netrek enables multiple users to play instances of the game against each other, *i.e.*, simultaneously. *See* Server2.5pl4, C:*Server\newstartd\newstartd.c* at line 73 [App. G at 290] (MAXPROG setting allows up to 16 clients to play Netrek simultaneously).[84] Thus, at least some of the instances of the game overlap in time.
transmitting game plays between said game playing node and a first of the users, for the corresponding instance of the game;	In Netrek, game plays are transmitted between the server and each user playing an instance of the game. *See* BRMH-1.7, C:*client\socket.c* at lines 652-716 [App. F at 388-89] (client's *readFromServer* function receives game play data transmitted from the server), lines 1537-1634 [App. F at 404-06] (client's *sendServerPacket* command transmits game play data from the client back to the server). *See also* C:*client\server.c* at line 1896 [App. F at 411] (*sendDetMineReq* function calls *sendServerPacket* function), line 2067 [App. F at 414] (*sendMessage* function calls *sendServerPacket* function).[85]
transmitting from the game playing node	In Netrek, the server transmits to each user the ranking of each of the other users during game play. *See* Server2.5pl4, C:*Server\ntserv\data.c* at

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[83] *Id*. at ¶ 3, 8-9.

[84] *Id*. at ¶ 3, 8.

[85] *Id*. at ¶ 10.

Claim 92	Source Code For Netrek
to the corresponding node of the first user, the ranking of a second of the users, wherein said ranking is indicative of a proficiency of the second user in playing the game, and said ranking is updated to present a change in said ranking while the first user is playing the game.	lines 170-88 [App. G at 406] (server calculates user rankings); BRMH-1.7, C:*client**playerlist.c* at lines 77-145 [App. F at 289-90] (client's *pline* function, called by client routines such as *playerlist2* and *playerlist3*, receives user ranking information transmitted from server), line 133 [App. F at 290] (client function *pline* outputs the ranks of the users).[86] The ranking for each user is indicative of a proficiency of that user in playing the game. *See* BRMH-1.7, C:*client**playerlist.c* at 107-24 [App. F at 289-90] (proficiency information includes user rank (line 136), kills (line 105), losses (line 106), ratio (line 111), offensive rating (line 118), planet rating (line 119), bombing rating (line 122), and defense rating (line 122)); *id.*, C:*client**inform.c* at lines 105-38 [App. F at 165] (displaying a variety of information about a selected user, including bombing rating, planet rating, offensive rating, defensive rating, kills, and hours played).[87] During game play, the server periodically updates the rankings, thereby presenting changes in the rankings. *See* Server2.5pl4, C:*Server**ntserv**data.c* at lines 170-88 [App. G at 406] (array for storing rank data that, when accessed to display a user's rank, returns the latest ranking and thereby provides an update as to any recent ranking changes).[88]

As explained above, the source code for the BRMH-1.7 Netrek client when combined with the source code for the Netrek Vanilla 2.5pl4 Server discloses each limitation of claim 92 and thus renders claim 92 obvious under 35 U.S.C. § 103(a).

I.   Claim 92 Is Obvious Under 35 U.S.C. § 103(a) Over the Combination of *McFadden* and *Rumsey*

In February 1994, Joseph Rumsey posted a comment in the rec.games.netrek newsgroup [Appendix I, hereinafter "*Rumsey*"]. Later that year, in May 1994, Andy McFadden published his

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[86] *Id*. at ¶ 11-14.

[87] *Id*. at ¶ 11-14.

"History of Netrek" to the same newsgroup [Appendix H, hereinafter "*McFadden*"]. *McFadden* discloses a multi-player game played over a communications network in which kills are used as an indicator of proficiency. *Rumsey* discloses that the number of opponent kills are displayed on the game screen and are updated during game play. Combined, *McFadden* and *Rumsey* disclose every element of claim 92. As explained below, one of ordinary skill in the art would have had reason to combine *McFadden* with *Rumsey*. Accordingly, claim 92 is obvious under § 103(a) over the combination of *McFadden* with *Rumsey*.

There are numerous reasons why one of ordinary skill in the art would have known to combine *McFadden* with *Rumsey*.

First, a motivation to combine *McFadden* with *Rumsey* is inherent in the fact that both describe the same piece of operational software – Netrek. In addition, both were posted to the same Netrek newsgroup within a single six-month period. Thus, not only would there have been a motivation to combine those references, but in a very real sense they were combined (in the same newsgroup) long before '560 patent priority date.

Also, the combination of *McFadden* with *Rumsey* yields predictable results because those references provide no more in combination (a multiplayer network game that displays each player's proficiency) than they would have done in separate, sequential operation (a multiplayer network game and the display of game players' proficiencies). Claim 92 thus represents the simple arrangement of old elements with each performing the same function it had been known to perform (multiplayer network gaming, and the display of player's proficiencies) and yielding no

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[88] *Id*. at ¶ 11-14.

more than one would expect from such an arrangement.[89]

Thus, a person of ordinary skill in the art would have had many strong reasons to apply the teachings of *Rumsey* to the multiplayer network gaming technology disclosed by *McFadden*.

McFadden qualifies as prior art under 35 U.S.C. § 102(b) as a printed publication published on May 1, 1994 – over a year prior to the earliest possible priority date of the '560 patent, January 19, 1996. Similarly, *Rumsey* qualifies as prior art under 35 U.S.C. § 102(b) as a printed publication published on February 15, 1994.[90] The charts below explain the pertinency and manner of applying *McFadden* and *Rumsey* to claim 92.

Claim 92	The History of Netrek (*McFadden*) Combined With *Beta testers for port of BRM 3.0 to Win 3.1 / NT wanted* (*Rumsey*)
A method of playing a game on a communications network, comprising:	*McFadden* discloses that Netrek is played on the Internet, a "communications network." *McFadden* at § 0.2 ("Netrek is a real-time graphical multiplayer arcade/strategy game played over the Internet.").[91]
receiving at a game playing node on the network, a contact by each of a plurality of users, via a corresponding	*McFadden* discloses that the server (*i.e.*, game playing node) receives a contact from every player (*i.e.*, a plurality of users) via a client program (*i.e.*, a corresponding node on the network) in order to play the game. *McFadden* at § 2.1.2 ("Architecture") ("In Netrek, every player has a client program that connects to the server.").

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[89] *KSR*, 127 S. Ct. at 1740 (instructing that a combination is obvious when it creates no synergy, *i.e.*, when the two technologies "in combination [do] no more than they would in separate, sequential operation" or when the applicant "'simply arranges old elements with each performing the same function it had been known to perform' and yields no more than one would expect from such an arrangement.").

[90] *See* App. I at 9.

[91] Because *McFadden* [App. H] does not contain page numbers, this Request uses *McFadden's* own citation form. For example, *McFadden* uses "0.2" to refer to the topic "What is Netrek?".

Claim 92	*The History of Netrek* (*McFadden*) Combined With *Beta testers for port of BRM 3.0 to Win 3.1 / NT wanted* (*Rumsey*)
node on the network for the user, for initiating a corresponding instance of the game between the game playing node and the user's corresponding node, and	
at least some of said instances overlap in time;	*McFadden* discloses that at least some of the players' games overlap in time. *McFadden* at § 1.2.1 ("Birth of an Empire") ("[A]ll four teams can (and often did) play against each other at the same time.").
transmitting game plays between said game playing node and a first of the users, for the corresponding instance of the game;	*McFadden* discloses transmitting game plays between the client program (corresponding to each user) and the server (*i.e.*, game playing node). *McFadden* at § 2.1.2 ("Architecture") ("In Netrek, every player has a client program that connects to the server."). *Id.* ("The Xtrek server used a shared memory segment to communicate between processes. Like Conquest, it had an independent game daemon that updated everything 10 times per second, advancing ships and torpedos [*sic*], checking for collisions, and marking players as dead. For each player, a separate 'xtrek' process updated the display and took user input. An important distinction (perhaps THE distinction) between Xtrek and Netrek is the way the server sends information to the player.").
transmitting from the game playing node to the corresponding node of the first user, the ranking of a second of the users,	*Rumsey* discloses the server (*i.e.*, game playing node) sending data on the number of kills to the users. *Rumsey* at 9-10 ("Kill messages are also improved with short packets. Just a few bytes are sent, who died, who killed them, and how many armies. The client fills in the text.").
wherein said ranking	*McFadden* discloses kills as indicative of proficiency in Netrek.

Claim 92	*The History of Netrek (McFadden) Combined With Beta testers for port of BRM 3.0 to Win 3.1 / NT wanted (Rumsey)*
is indicative of a proficiency of the second user in playing the game, and	*McFadden.* at § 3.3.2 ("Destruction Inflicted") ("However, Smith liked the idea of ranks, so in the Fall of 1989 he added the concept of Destruction Inflicted (DI). This took planet taking and bombing into account as well as kills and deaths. Ranks were added, and promotions were based on the new player ratings and the amount of time the person had spent playing.").
said ranking is updated to present a change in said ranking while the first user is playing the game.	*Rumsey* discloses updating the number of kills during game play. *Rumsey* at 10 ("[I]t uses that same packet to update kills on the playerlist.").

As explained above, the combination of *McFadden* with *Rumsey* provides each limitation of claim 92 and thus renders that claim obvious under 35 U.S.C. § 103(a).

IV   CONCLUSION

In view of the substantial new questions of patentability raised by the newly-cited prior art identified above, a new *ex parte* reexamination should be instituted pursuant to 35 U.S.C. § 304 and claims 1-3, 16, 18, 20, and 92 of the '560 patent canceled as anticipated or obvious.

Dated: January 31, 2008

> Respectfully Submitted,
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>
>
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Certificate of Service in Compliance With 37 C.F.R. § 1.510(b)(5)

The undersigned certifies that a complete copy of this Request for Reexamination was served on the purported patent owner's counsel of record:

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in accordance with 37 C.F.R. § 1.510(b)(5), via First Class Mail.

Dated: January 31, 2008

By:_____/s/ Bradley A. Waugh_____
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