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United States District Court  
For the Northern District of California

E-FILED on 05/14/09

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF CALIFORNIA  
SAN JOSE DIVISION

ARISTOCRAT TECHNOLOGIES,  
ARISTOCRAT PTY LIMITED and  
ARISTOCRAT TECHNOLOGIES, INC.,  
  
Plaintiffs,  
  
v.  
  
INTERNATIONAL GAME TECHNOLOGY  
and IGT,  
  
Defendants.

No. C-06-03717 RMW

ORDER STRIKING PORTIONS OF  
CREVELT'S DECLARATION,  
CONSTRUING CLAIMS OF UNITED  
STATES PATENT NOS. 7,056,215 AND  
7,108,603, AND DENYING DEFENDANTS'  
MOTION FOR SUMMARY JUDGMENT OF  
INDEFINITENESS

[Re Docket No. 157, 163, 174]

On March 18, 2009, the court held a claim construction hearing on the dispute between plaintiff Aristocrat Technologies, et al. (collectively "Aristocrat") and defendants International Game Technology and IGT (collectively "IGT") as to the construction of terms and language in the claims of United States Patent Nos. 7,056,215 ("215 Patent") and 7,108,603 ("603 Patent") assigned to Aristocrat. In connection therewith, IGT contended that certain opinions of Dwight Crevelt that Aristocrat offered in support of its proposed claim constructions had to be stricken because Aristocrat failed to adequately disclose them in the parties' Joint Claim Construction Statement. IGT

ORDER STRIKING PORTIONS OF CREVELT'S DECLARATION, CONSTRUING CLAIMS OF UNITED STATES PATENT NOS. 7,056,215 AND 7,108,603, AND DENYING DEFENDANT'S MOTION FOR SUMMARY JUDGMENT OF INDEFINITENESS  
C-06-03717 RMW  
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1 also moved for summary judgment that the patents-in-suit are indefinite and thus invalid. After  
2 consideration of the claims, specifications, prosecution histories, and other relevant evidence, and  
3 after hearing the arguments of the parties, the court strikes certain opinions of Mr. Crevelt, construes  
4 the disputed terms and language of the patents-in-suit and denies IGT's motion seeking adjudication  
5 that the patents are indefinite.

## 6 I. BACKGROUND

7 Aristocrat, the patentee, and IGT are competitors in the market for electronic gaming  
8 machines. Both patents at issue relate to a "slot machine game system with [an] improved jackpot  
9 feature." '215 Patent at 1:1-2; '603 Patent at 1:1-2. Both patents claim "a method of randomly  
10 awarding one progressive prize from a plurality of progressive prizes using a second game to select  
11 one progressive prize . . . ." '215 Patent at 8:49-53; '603 Patent at 8:10-12. The second game is  
12 displayed on the "occurrence of a random trigger condition" having a probability related to the  
13 amount the player has wagered. *Id.*

14 The specification describes a previous method of awarding jackpots called "combination  
15 based trigger arrangements." In the combination-type jackpot, the jackpot is awarded upon the  
16 occurrence of a particular game configuration (e.g., upon the occurrence of a particular combination  
17 of symbols). '215 Patent at 1:42-55; '603 Patent at 1:46-60. One imagines cherries across the center  
18 of a spinning-wheel slot machine, or a royal flush in video poker, as examples of a "particular  
19 combination of symbols" that would trigger a jackpot. According to the specification, these jackpot  
20 triggers have a number of disadvantages. First, because the jackpots are awarded upon the  
21 occurrence of low-probability events, most players never see them won. '215 Patent at 1:46-47; '603  
22 Patent at 1:60-61. Second, it is technically complex to develop a variety of games wide enough to  
23 satisfy consumer demand that nonetheless have mathematically exact (and sufficiently small)  
24 jackpot-trigger probabilities. '215 Patent at 1:64-2:2; '603 Patent at 2:1-6. Third, combination-  
25 triggered jackpots remove the operator's ability to vary the jackpot frequency. '215 Patent at 2:17-  
26 19; '603 Patent at 2:21-23.

1 The patents describe a method of awarding a jackpot using a second game which appears  
2 after the main game is complete. The second game is triggered with a probability related to the  
3 number of credits bet by the player in the base game. '215 Patent at 2:33-41; '603 Patent at 2:37-45.  
4 The preferred embodiments state that "during the feature game a second set of reel strips appears  
5 and a 'spin and hold' game commences. The feature prize score is calculated by the total of the  
6 points appearing on the centre line of all 5 reels." '215 Patent at 5:15-18; '603 Patent at 4:43-46.  
7 "Preferably, the feature game is a simplified game having a higher probability of success than the  
8 first game." '215 Patent at 4:28-29; '603 Patent at 3:57-58. This method has, according to the  
9 preferred embodiments, a number of advantages over previous jackpot systems. The jackpot award  
10 is independent of the type of main game, and therefore allows for greater flexibility in base-game  
11 type. '215 Patent at 5:21-31; '603 Patent at 4:48-53. Furthermore, the jackpot award need not be  
12 triggered upon the occurrence of some mathematically exact combination in the main game. '215  
13 Patent at 5:31-32; '603 Patent at 4:59-60. And the game designer and operator now have greater  
14 flexibility in determining jackpot hit rates, in-game player incentives, and networked uses of the  
15 jackpot feature. See '215 Patent at 5:33-50; '603 Patent at 5:3-5.

16 On June 12, 2006, Aristocrat filed suit alleging infringement of the '215 Patent (adding the  
17 '603 Patent when it issued) against IGT. On June 13, 2007, the court granted IGT's motion for  
18 summary judgment, holding that the patent was invalid. Aristocrat appealed to the Federal Circuit.  
19 On September 22, 2008, the Federal Circuit reversed and remanded to this court for further  
20 proceedings.

21 The first claim of the '215 Patent is reproduced below with the claim language for which the  
22 parties propose different constructions highlighted in bold.

23 In a network of gaming machines, each of said gaming machines having a user  
24 interface activatable by a player to affect game display, each of said gaming machines  
25 being capable of accepting different wager amounts made by the player, a method of  
26 randomly awarding one progressive prize from a plurality of progressive prizes **using**  
27 **a second game to select said one progressive prize**, a display of said second game  
28 being triggered upon an occurrence of a random trigger condition having a  
probability of occurrence related to the amount of the wager, comprising:  
making a wager at a particular **gaming machine** in the network of **gaming**  
**machines;**  
initiating a first main game at said particular **gaming machine;**

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**causing a second game trigger condition to occur as a result of said first main game being initiated**, said second game trigger condition occurring randomly and having a probability of occurrence dependent on the amount of the wager made at said particular **gaming machine**, **said step of causing the second game trigger condition including:**

- (1) selecting a random number from a predetermined range of numbers;**
- (2) allotting a plurality of numbers from the predetermined range of numbers in proportion to the amount of the wager made at said particular gaming machine, said step of allotting including allotting one number for each unit of currency of the amount wagered; and**
- (3) indicating the occurrence of the second game trigger condition if one of the allotted numbers matches the selected random number;**

triggering a second game to appear at said particular gaming machine in response to said occurrence of said second game trigger condition, said second game appearing **after completion of said first main game;** randomly selecting said one progressive prize from said plurality of progressive prizes **that has been won;** displaying said second game to the player at said particular **gaming machine** in response to said triggering; activating said user interface at said particular **gaming machine** by said player during said displaying of said second game to affect the display of said second game; identifying to the player said one **progressive prize** from said plurality of **progressive prizes** that has been won; and awarding said one **progressive prize** from said plurality of **progressive prizes** that has been won.

**II. ANALYSIS**

**A. IGT's Motion to Strike the Crevelt Declaration**

IGT moves to strike the declaration of Dwight Crevelt for failure to adequately disclose his opinions as required by Patent Local Rule 4-3(d). The rule requires that any expert who will testify at the claim construction hearing to provide a summary of "each opinion to be offered in sufficient detail to permit a meaningful deposition of that expert." IGT contends that Aristocrat failed to adequately disclose Crevelt's opinions in the parties' Joint Claim Construction Statement filed February 6, 2007 and that IGT first learned of his opinions when Aristocrat filed its *Markman* brief and Crevelt's declaration on March 27, 2007.

The court finds that the following paragraphs of Crevelt's declaration were not timely disclosed and are stricken:

Paragraph of Crevelt Declaration	Opinion Not Adequately Disclosed
¶ 7	Prize money need not come from a "pool" and that prize money can come from any source.

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¶ 10	A second game trigger condition can occur as a result of testing a trigger condition in software.
¶ 16	The Torango Free Play apparatus was different from Aristocrat's invention.
¶ 19	The allotted number need not be identical to the selected random number for the trigger condition to occur.
¶ 21	A person of ordinary skill in the art would understand that the second feature game need not occur after the payment of winnings for the first main game.

**B. Standards for Claim Construction**

Construction of a patent, including terms of art within a claim, is exclusively within the province of the court. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 388 (1996). In determining the meaning of a disputed claim limitation, the intrinsic evidence, including the claim language, written description, and prosecution history, is the most significant. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005). Words of a claim "are generally given their ordinary and customary meaning" as understood by a person of ordinary skill in the art. *Id.* at 1312-13. Claims are read in view of the specification, which is the "single best guide to the meaning of the disputed term." *Id.* at 1315. A court "should also consider the patent's prosecution history, if it is in evidence." *Id.* at 1317. Finally, although it is generally less significant than the intrinsic record, extrinsic evidence can "shed useful light on the relevant art." *Id.*

**C. Construction of Disputed Terms and Language**

**1. "Gaming machine"**

Claim 1 of the '215 Patent and Claim 1 of the '603 Patent begin with the phrase "[i]n a network of gaming machines," and the phrase "gaming machine" appears frequently in the claims of both patents. '215 Patent at 8:45; '603 Patent at 8:8. The parties propose the following constructions of "gaming machines":

Term or Language Requiring Construction	Aristocrat's Proposed Construction	IGT's Proposed Construction
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"gaming machine"	gaming device (i.e., not limited to any particular type of game such as poker)	poker machine
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IGT relies for its construction on a sentence in the introductory paragraph in each patent which states: "[t]he present invention relates to apparatus for use with a system of linked poker machines and in particular the apparatus provides an improved jackpot mechanism for use with such a poker machine system." '215 Patent at 1:6-9; '603 Patent at 1:9-12. IGT contends that this statement defines the invention and that "the public is entitled to take the patentee at his word and the word was that the invention" is a poker machine. *Honeywell Int'l, Inc. v. ITT Industries, Inc.*, 452 F.3d 1312, 1318 (Fed. Cir. 2006) (holding "fuel injection system component" was limited to "fuel filter" because the written description called "the present invention" a fuel filter). In *Honeywell*, the court wrote that, although the prosecution history contained some suggestion that the invention, a "fuel injection system component," was broader than only fuel filters, "the entire specification of [the patent], as well as the sole drawing, describe the elements and operation of a fuel filter . . . . No other parts are described." *Id.* at 1316 (quoting district court order in *Honeywell Int'l v. ITT Indus.*, 330 F.Supp.2d 865, 879 (E.D.Mich. 2004)). As a result, the court held that the invention was limited to a fuel filter. *Id.* at 1318.

The patents here refer to "poker" only in their introductory paragraphs. The specifications include descriptions of "gaming machines" and the language strongly suggests that the term "gaming machine" should not be limited to a "poker machine." For instance, the patents state in their "Detailed Description of the Preferred Embodiments" sections:

Feature jackpots in this format exhibit significant differences over previous jackpot systems:

(i) A jackpot game is provided which is compatible with any existing game combination within an installation independent of the platform, denomination or type of game (e.g. slot machines, cards, keno, bingo or pachinko). This will allow for the linking of games combinations between game type, platform type, and denomination."

'215 Patent at 5:19-26; '603 Patent at 4:47-53. In addition to the reference to multiple types of games, the context of the statement is important. It describes some of the advantages of using a "spin and hold"-type feature game over "conventional combination-triggered jackpots." In a spin

1 and hold type game, a set of reels spin and, when the player stops the reels by pressing a button, the  
 2 feature-prize score is determined by the sum of the points that appear on the center line of those  
 3 reels. '215 Patent at 5:15-19; '603 Patent at 4:42-46, 7:12-18; *See also id.* at Fig. 3 (depicting set of  
 4 five reels). A "combination triggered" jackpot, by contrast, awards a jackpot upon the occurrence of  
 5 a particular game configuration (e.g., a certain combination of symbols). '215 Patent at 1:52-55;  
 6 2:26-29; '603 Patent at 1:56-60; 2:30-34. According to the specification, using a spin and hold  
 7 feature game has the advantage of being usable with different types of main games. *See* '215 Patent  
 8 at 5:21-25; '603 Patent at 4:47-58. In light of this claimed advantage in the preferred embodiments,  
 9 limiting "game machine" to "poker machine" is not supported by the specification. The court  
 10 therefore construes "gaming machine" as "gaming device which is not limited to any particular type  
 11 of game such as poker."

12 **2. "Progressive prize"**

13 Both patents claim "a method of awarding one progressive prize from a plurality of  
 14 progressive prizes . . . ." '215 Patent at 8:49-51; '603 Patent at 8:10-11. The specification does not  
 15 define "progressive prize", but the plain meaning of "progressive" and the disclosure in the  
 16 specification suggest that the prize increases according to some criteria. The '215 Patent abstract, for  
 17 example, states that "the jackpot controller is arranged to receive each of the machine operation  
 18 signals and to increment the value of a random jackpot prize on the occurrence of each of these  
 19 operation signals." The parties agree that the prize should be increased based on some criteria, but  
 20 disagree as to whether the prize must be paid from a "pool." The parties propose the following  
 21 constructions of "progressive prize":

Term or Language Requiring Construction	Aristocrat's Proposed Construction	IGT's Proposed Construction
"progressive prize"	a prize that increases based on some criteria (i.e., time, games played, marketing money, coin in/out, etc.).	a prize paid from a pool that increases based on some criteria.

26  
 27 IGT points to the following language from the "Summary of the Invention" where the patent  
 28 describes a "fifth aspect" of the invention:

ORDER STRIKING PORTIONS OF CREVELT'S DECLARATION, CONSTRUING CLAIMS OF UNITED STATES PATENT NOS. 7,056,215 AND 7,108,603, AND DENYING DEFENDANT'S MOTION FOR SUMMARY JUDGMENT OF INDEFINITENESS C-06-03717 RMW

1 such that the progressive feature jackpot is implemented using a central feature jackpot  
2 system connected to the network to provide an incrementing jackpot pool which  
3 increases in response to signals from the connected consoles, and the feature jackpot  
4 game on each machine awards a jackpot drawn from the jackpot pool.

5 '215 Patent at 3:19-24. The preferred embodiments also use the term "pool" to describe the jackpot  
6 system, stating that "the machine contributions go into the prize pool as with known prior art jackpot  
7 systems, while the overhead display shows the incrementing prize value." *Id.* at 5:64-67; '603 Patent  
8 at 5:24-27. Finally, IGT offers the testimony of Scott Olive ("Olive"), the inventor, that a  
9 progressive jackpot, understood by one skilled in the art, uses a system of networked gaming  
10 machines that share the same bonus pool. Def.'s Claim Construction Brief 3:7-14 (hereinafter "IGT  
11 CC"). Olive gives an example top prize, called a "Grand Progressive" which was a "fixed prize" of  
12 \$50,000 or two motorbikes. *Id.* Aristocrat responds that the claims themselves nowhere require that  
13 the prize come from a pool, and that Claim 1's requirement that the machine award "one progressive  
14 prize from a plurality of progressive prizes" indicates that the progressive prize need not come from  
15 a pool. Pls.' Reply Claim Construction Brief 5 (hereinafter "Reply CC").

16 The parties seem to have different understandings of the term "pool." In including "pool" in  
17 its construction, IGT seems to require that the prize amount is paid into by each of the networked  
18 machines and can also be paid out to any of them. Aristocrat, on the other hand, appears to suggest  
19 that a pool has contents of similar type (and therefore, according to Aristocrat, a plurality of  
20 progressive prizes, some of which may be supplemented by other sources, are not in a "pool"). The  
21 abstract of the '215 Patent supports what appears to be IGT's construction:

22 Each of the electronic gaming machines are provided with a network interface arranged  
23 to provide a signal onto the network on each occurrence of an operation of a respective  
24 machine and the jackpot controller is arranged to receive each of the machine operation  
25 signals and to increment the value of a random jackpot prize on the occurrence of each  
26 of these operation signals.

27 '215 Patent abstract. In fact, the reason the gaming machines are networked appears primarily to be  
28 to allow the prize to be increased by operation signals from each machine, and to be paid out to any  
of the networked machines. The court finds that the term "pool" relates to but inadequately captures  
this idea. Therefore, the court construes the term "progressive prize" to mean "a prize amount or  
value that increases based, at least in part, upon contributions from networked gaming machines."

3. "Game"

IGT's contends that the term "game" is indefinite, rendering the claim invalid. *See infra*. Arguing in the alternative, IGT proposes that the term "game" be construed in the following way. Aristocrat submits that the term needs no further construction.

Term or Language Requiring Construction	Aristocrat's Proposed Construction	IGT's Proposed Construction
"game"	game	<p>In the context of these claims, this term is indefinite and provides no clear criteria to distinguish between what is a first game and what is a second game.</p> <p>At the time, a person of ordinary skill would have understood the term to mean: A gambling activity played according to a set of rules. A game does not require user interaction. A game has a distinct beginning and ending. A game begins when a player irrevocably commits a wager that is not part of any previous game. A game ends when all transactions for the game have finished, including the loss or return of the wager and award of all prizes won. Second screen bonus features, free plays and the like are not separate games.</p>

IGT contends that "game" is a term of art with a technical meaning to those skilled in the art. Because, according to IGT, the specification gives insufficient guidance as to the meaning of the term "game," the court should look to industry regulations to determine an appropriate construction. IGT CC at 5. IGT's lengthy construction is composed largely of limitations culled from a variety of gaming regulations. *Id.* Australian regulations define a "game" as "a gambling activity played according to a set of rules." IGT CC at 6 (citing *Australia/New Zealand Gaming Machine National Standards*, Rev. 1.0 §§ 3.264-65 at 3-42 (1997), attached to Irvine Decl. at Ex. L). Nevada gaming regulations require that "gaming devices" have the capacity to display complete play histories of the

1 nine games immediately preceding the most recent one. *Id.* (citing *State of Nevada, Regulations of*  
2 *the Nevada Gaming Commission and State Gaming Control Board: Technical Standards for*  
3 *Gaming Devices*, § 1.080(7)(November 1997), attached to Irvine Decl. at Ex. O). And  
4 Australian/New Zealand gaming regulations also provide that games begin and end with a wager and  
5 either loss or payment, respectively. *Australia/New Zealand Gaming Machine National Standards*,  
6 Rev. 1.0 §§ 3.264-65 at 3-43. Finally, the standards promulgated by Gaming Laboratories  
7 International, called the *GLI-11: Gaming Devices in Casinos*,<sup>1</sup> define "second screen bonus features,  
8 or free plays, as all part of a single game, and not as separate games." IGT CC at 6 (citing *Gaming*  
9 *Laboratories International, GLI-11: Gaming Devices in Casinos*, Ver. 1.4 § 4.2.4 at 66 (June 30,  
10 2006), attached to Irvine Decl. at Ex. N.).

11 These limitations do not appear in the specification. Rather, the specification distinguishes  
12 "games" broadly by type of game (e.g., slot machines, cards, keno, bingo, or pachinko) ('215 Patent  
13 at 5:23-24; '603 Patent at 4:49-53), and by the different prizes available from the game (a "jackpot  
14 feature game" is played for a jackpot prize (*see* '215 Patent at 6:23-28), whereas a "main game"  
15 would likely award smaller "combination-triggered" prizes (*see id.* at 1:64-2:2)). The court finds  
16 that the term "game" as used in the specification and claims is meant to encompass a wide variety of  
17 game types. Indeed, the specification describes flexibility in game type and jackpot award as  
18 advantages over a single-game arrangement. *See id.* at 5:20-30, 43-45 ("Jackpot hit rates can now be  
19 changed without making changes to the base game. This was previously not possible using  
20 combination triggered jackpots.") The court finds that limiting games to gambling activities played  
21 according to a set of rules is appropriate since the subject matter of the payment relates both to  
22 gambling and games. Further limitation is not necessary. Accordingly, the court construes the term  
23 generally, that is "a gambling activity played according to a set of rules."

24 **4. "Using a second game to select said one progressive prize"**

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27 <sup>1</sup> According to IGT's brief: "Like a restatement or uniform act in the law, the GLI-11 is an industry  
28 standard having widespread acceptance and setting forth the industry usage of "game" and  
"completion" of a "game." IGT CC at 6 n. 4.

1 Aristocrat and IGT agree that the preamble language "using a second game to select said one  
2 progressive prize" ('215 Patent at 8:50-51; '603 Patent at 8:12) requires no further construction, but  
3 disagree as to whether it constitutes a claim limitation. IGT argues that the language appears in the  
4 preamble, and thus is not a limitation because it is not "necessary to give life, meaning, and vitality  
5 to the claim." See *Bristol-Myers Squibb Co. v. Ben Venue Labs., Inc.*, 246 F.3d 1368, 1373 (Fed.  
6 Cir. 2001). But a preamble term can limit the invention if it "recites an essential structure or steps,"  
7 *Catalina Marketing Int'l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 808 (Fed. Cir. 2002), or if the  
8 terms can only be understood in the context of the preamble. *Pitney Bowes, Inc. v. Hewlett-Packard*  
9 *Co.*, 182 F.3d 1298, 1305-6 (Fed. Cir. 1999). But a preamble is not limiting, for example, "where a  
10 patentee defines a structurally complete invention in the claim body and uses the preamble only to  
11 state a purpose or intended use for the invention." *Catalina Marketing*, 289 F.3d at 808.

12 *Pitney Bowes* concerned the construction of terms in the preamble of a patent entitled  
13 "Apparatus and Method for Generating Images by Producing Light Spots of Different Sizes," which  
14 related to the technology of laser printing. *Pitney Bowes*, 182 F.3d at 1301. The court found that the  
15 claim reference to "generated shapes" could only be understood in the context of the preamble  
16 language "producing on a photoreceptor an image of generated shapes made up of spots." *Id.* at  
17 1306. Therefore, the court construed the preamble and the remainder of the claim as "one unified  
18 and internally consistent recitation of the claimed invention." *Id.*

19 In this case the preamble of Claim 1 of each patent recites the step of "using a second game  
20 to select said one progressive prize." '215 Patent at 50-51; '603 Patent at 8:12. Although the  
21 remainder of the claim recites selecting one progressive prize, it does not specifically say the second  
22 game is used to make the selection. See '215 Patent at 9:10-25 ("triggering . . . randomly selecting . .  
23 . displaying . . . activating . . . identifying . . . awarding . . ."). These steps are only understandable  
24 in the context of the process they describe: "using a second game to select said one progressive  
25 prize." Further, the preamble refers to the game machines as having a "user interface" and the  
26 remainder of the claim refers back to the preamble's description when it recites the step of  
27 "activating said user interface." *Id.* at 8:46, 9:18. Therefore, the court finds that the preamble  
28 constitutes a claim limitation.

5. "Causing a second game trigger condition to occur as a result of first main game being initiated"

The parties dispute whether the second game trigger condition must necessarily occur as a result of the first main game being initiated. The parties propose the following constructions:

Term or Language Requiring Construction	Aristocrat's Proposed Construction	IGT's Proposed Construction
"causing a second game trigger condition to occur as a result of said first main game being initiated"	<p>Causing a trigger condition for a second game to occur as a result of the first main game being initiated.</p> <p>A second game trigger condition can occur as a result of testing of a trigger condition in software.</p>	Satisfying the second game trigger condition by initiating the first main game. Initiating the first main game is sufficient to, and always does, satisfy the second game trigger condition

The claim language under dispute is immediately followed by: "said second game trigger condition occurring randomly and having a probability of occurrence dependent on the amount of the wager made at the particular gaming machine . . . ." '215 Patent at 8:60-64; '603 Patent at 8:22-25. This language makes clear that the main game's initiation does not *always* satisfy the second game trigger condition; rather, it happens according to a specified probability. Nonetheless, IGT contends that its construction of the disputed language is the correct one because, first, it comports with the plain meaning of the language, and second, prosecution-history amendments preclude adopting Aristocrat's proposed construction.

Although the disputed language, in isolation, might be read to require that initiation of the first main game always satisfies the second game trigger condition, the language that follows puts the disputed language in proper context. Claim construction takes the context in which the disputed term appears into account. *Pause Technology, LLC v. TiVo, Inc.*, 419 F.3d 1326, 1331 (Fed. Cir. 2005)(improper to ignore later language appearing in the claim). In fact, the claim itself effectively defines "causing a second game trigger condition" in the same limitation stating, "said step of causing the second game trigger condition including . . . (1) selecting . . . (2) allotting . . . (3) indicating . . . ." '215 Patent at 8:64-9:9; '603 Patent at 8:26-34. The probability calculation that

1 potentially produces the second game is described in the specification. The "Summary of the  
2 Invention" states:

3 According to a second aspect, the present invention provides a random prize awarding  
4 system associated with a network of gaming consoles, the system being arranged to offer  
5 a feature outcome on a particular console when a trigger condition occurs as a result of  
6 a game being played on the respective console[,] the prize awarding system including  
7 trigger means arranged to test for a trigger condition and to initiate the feature outcome  
8 on the respective console when the trigger condition occurs, the trigger condition being  
9 determined by an event having a probability related to credits bet per game on the  
10 respective console.

11 '215 Patent 2:42-52. The clear meaning of the language in question, construed in the context of the  
12 claim, supports Aristocrat's construction.

13 IGT also contends that amendments made during prosecution foreclose Aristocrat's proposed  
14 construction. During prosecution, Aristocrat's patent counsel deleted the term "determining the  
15 trigger condition of the first game being initiated" and replaced it with "causing a second game  
16 trigger condition." Irvine Decl. Ex. G at 3. This amendment was one of a number of amendments  
17 and did not produce the final claim language. The remarks included with the amendment distinguish  
18 prior art, which the examiner found invalidating on obviousness grounds, on the basis that the prior  
19 art did not describe or suggest: 1) a plurality of prizes from which one is chosen; 2) choosing the one  
20 prize through a second game; and 3) that a second game occurs after the completion of the first  
21 game. *See id.* at 10-11. The amendment did not relate to whether the trigger condition necessarily  
22 followed from the initiation of the first main game. Later in the remarks, patent counsel states that,  
23 in relation to then-claim 110: "Claim 110 further defines the step of causing a second game trigger  
24 condition to occur to include . . . ." *Id.* at 12. IGT's argument that Aristocrat is barred by its  
25 prosecution amendment is without merit.

26 The court concludes that initiating the first main game does not always cause a trigger of the  
27 second game to occur. If a second game is triggered, it, of course, is triggered by initiation of the  
28 first game. "Causing a second trigger condition to occur as a result of said main game being  
initiated" needs no interpretation.

**6. "Said step of causing the second game trigger condition to occur including:  
(1) selecting . . . (2) allotting . . . (3) indicating . . . ."**

1 IGT contends that the language "said step of causing the second game trigger condition to  
2 occur including: (1) selecting . . . (2) allotting . . . (3) indicating . . . ." ('603 Patent at 25-34; '215  
3 Patent at 8:59-9:9) requires that the numbered steps be performed in the order they appear. IGT CC  
4 at 11. Aristocrat responds that the "selecting" and "allotting" steps need not be performed in the  
5 stated order. The parties propose the following constructions:

Term or Language Requiring Construction	Aristocrat's Proposed Construction	IGT's Proposed Construction
Said step of causing the second game trigger condition to occur including: (1) selecting . . . (2) allotting . . . (3) indicating . . . ."	No requirement for enumerated order	Each of the three steps enumerated in the "causing" step (that is (1) selecting . . . (2) allotting . . . (3) indicating . . .) must be performed in the enumerated order each time the main game is initiated.

11 To determine whether the steps of a method claim must be performed in the order in which  
12 they are recited, the court looks first to whether, as a matter of logic or grammar, the steps must be  
13 performed in the order written. *Alitris v. Symantec Corp.*, 318 F.3d 1363, 1369 (Fed. Cir. 2003). If  
14 not, the court looks second to whether the specification "directly or implicitly requires such a narrow  
15 construction." *Id.* at 1370.

16 The language of the claim, besides using numerals before each component of the "causing . .  
17 ." step, does not require any particular order of performance. The use of "including" does not  
18 suggest that the following actions are performed in the order stated. IGT argues that because (1)  
19 introduces "a predetermined range of numbers" from which the plurality of numbers in (2) is  
20 allotted, (1) must come before (2). IGT CC at 12. The court agrees with Aristocrat that the  
21 occurrence of "a predetermined range of numbers" in (1) is merely an artifact of how the claim was  
22 drafted, and is not enough to require performance in the stated order.

23 However, the logic of the enumerated actions does imply some order. The final action,  
24 "indicating the occurrence of the second game trigger condition if one of the *allotted* numbers  
25 matches the *selected* random number" cannot be performed until a random number has been selected  
26 and a plurality of numbers allotted to the player. *See* '215 Patent at 9:7-9 (emphasis added).  
27 Aristocrat appears to concede that the indicating step must be performed last. *See* Reply CC at 9.

1 Turning to the specification, IGT argues that the flowcharts in both patents demonstrate that  
 2 the selection step should precede the allotting step. See '215 Patent at Fig. 2; '603 Patent at Fig. 2.  
 3 The flowchart does indeed order the selecting step (numbered 21) before the allotting one (numbered  
 4 23). *Id.* But the flowchart, and the rest of the specification, do not "directly or implicitly require"  
 5 that the steps ordered as shown should constitute a claim limitation. The claim, read in light of the  
 6 specification, requires only that the third step come last. Because this is evident from the language  
 7 of the disputed term, the court agrees that no further construction is necessary.

8 **7. "Allotting a plurality of numbers from the predetermined range of  
 9 numbers"**

10 The parties disagree as to what "allotting a plurality of numbers from the predetermined  
 11 range of numbers" means. They propose the following interpretations:

Term or Language Requiring Construction	Aristocrat's Proposed Construction	IGT's Proposed Construction
"allotting a plurality of numbers from the predetermined range of numbers"	<p>Giving to the player a plurality of numbers from a range of numbers determined in advance.</p> <p>In the case of a computer implementation of the method, the term "predetermined" can include "programmed" as in computer programming.</p>	<p>Selecting and assigning two or more numbers from the entire predetermined range of numbers. Each number within the predetermined range must be available for selection and assignment. This excludes selecting and assigning only one single number.</p> <p>The predetermined range of numbers is a range of numbers that is determined before making a wager and before initiating the first main game.</p>

21 **a. "Allotting a Plurality of Numbers"**

22 The '215 Patent describes two possible ways of determining whether the feature game trigger  
 23 condition has been satisfied. In both embodiments, a single random number is selected from within  
 24 a range. In the first embodiment, a game is allotted a set of numbers within that range. '215 Patent  
 25 at 6:18-23; '603 Patent at 51-65. The size of that set of numbers (that is, the number of allotted  
 26 numbers) is equal to the number of credits the player has bet. '215 Patent at 6:18-23; '603 Patent at  
 27 51-65. The trigger condition is satisfied when the random number matches one of the numbers in  
 28

1 the allotted set. '215 Patent at 6:18-23; '603 Patent at 51-65. In the second embodiment, the game  
2 is allotted a single number corresponding to the number of credits bet. '215 Patent at 6:27-37; '603  
3 Patent at 55-60. If, within the range of numbers, the randomly selected number is less than the  
4 single allotted number (called the "player value"), the feature-game trigger condition is satisfied.  
5 '215 Patent at 6:27-37; '603 Patent at 55-60. At issue is whether, as described in the second  
6 embodiment, the allotting of a single number is foreclosed by the claim's requirement that a  
7 "plurality of numbers" be allotted.

8 "Plurality" means at least two. *York Prods., Inc. v. Cent. Tractor Farm & Family Ctr.*, 99  
9 F.3d 1568, 1575 (Fed. Cir. 1996). Neither party disagrees. The dispute is whether "allotting a  
10 plurality of numbers" includes allocating "a single number" which is equal to, or proportional to, the  
11 number of credits bet and the trigger value is compared with the "single player value" and a jackpot  
12 feature awarded if the trigger value is less than or equal to the player value. '215 Patent at 6:28-32;  
13 '603 Patent at 5:58-60. Aristocrat contends that the single number or single player value referred to  
14 in the specification is a plurality of numbers because it represents the number and all those numbers  
15 less than the number. Aristocrat further points out that IGT's interpretation would exclude coverage  
16 of the alternative embodiment of the patent and that a claim interpretation that excludes a preferred  
17 embodiment "is rarely, if ever, correct." *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1583  
18 (Fed. Cir. 1996).

19 IGT points out, however, that the claim language expressly states "allotting a plurality of  
20 numbers" and the description of the alternative embodiment in the specification expressly says "*a*  
21 *number* is allocated" and refers to "the range of numbers below *the allotted number.*" IGT CC at 16  
22 (quoting '215 Patent at 6:18-23 (emphasis added)). Therefore, argues IGT, the claim language  
23 cannot include the alternative embodiment. The court disagrees. If Claim 1 of the '215 Patent is  
24 read in the context of the specification as a whole, the allocation of a number representing a range of  
25 numbers falls within the coverage of "allotting a plurality of numbers."

26 IGT also argues that Aristocrat gave up coverage of the alternative embodiment during  
27 prosecution to get around prior art and that Aristocrat abandoned claims that would have read on the  
28 alternative embodiment. Neither argument has merit. Nothing Aristocrat said during prosecution

1 gave up a claim that involved allocating one number (e.g., 20) to represent a plurality of numbers  
2 (e.g., 1-20) nor does it appear that Aristocrat intentionally narrowed its claims. *See SuperGuide*  
3 *Corp. v. DirectTV Enterprises, Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004). Under the alternative  
4 embodiment, then, each of the numbers below the player value are "allotted" to the player. The  
5 embodiment is therefore covered by the claim language.

6 **b. "Predetermined Range of Numbers"**

7 IGT contends that Aristocrat defined, in the prosecution history, "predetermined range of  
8 numbers" as a range of numbers determined before the beginning of the game. IGT CC at 18. IGT  
9 points to a prosecution-history document which distinguishes two pieces of prior art, the "Surprise  
10 Software Specification," and the "Torango '460 Patent" because "the range of the random number  
11 generator in the pending claims does not change during game play." Irvine Decl. Ex. D at 3. The  
12 specification supports this reading. The abstract of the '215 Patent states that the range is selected  
13 "prior to each game" and the flowchart in Fig. 2 refers to the range as "predetermined" in the first  
14 step. Aristocrat responds that the claims do not support this construction of "predetermined range"  
15 and that a person of skill in the art would understand the term otherwise. Pls.' Claim Construction  
16 Brief 13 (hereinafter "Aristocrat CC"). The court finds that the Aristocrat's statements in the  
17 prosecution history constitute a "clear disavowal of claim coverage." *SuperGuide*, 358 F.3d at 875.  
18 The predetermined range of numbers must therefore be determined before the beginning of the main  
19 game.

20 **c. Must Each Number in the Predetermined Range Be Available for**  
21 **Allotment?**

22 IGT also proposes that the claim requires that "each number within the predetermined range  
23 must be available for selection and assignment." Aristocrat responds that this means, "[i]n other  
24 words, if a particular IGT machine one[-]dollar machine had a 100,000 range of possible numbers  
25 from which numbers could be given to the player based on his or her bet size, but the particular slot  
26 machine, not surprisingly, did not accept \$100,000 wagers, the IGT machine would not infringe."  
27 Aristocrat CC at 13. IGT does not respond in its claim construction brief, and the court agrees that  
28 the limitation has no basis in the claim language.

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**d. Construction of Language**

The court construes the language at issue as "giving to the player two or more numbers from a range of numbers. The range of numbers must be determined before the beginning of the first main game. Each number in the predetermined range need not be available for allotment."

**8. "Indicating the occurrence of the second game trigger condition if one of the allotted numbers matches the selected random number"**

Aristocrat and IGT have two disputes over the construction of the limiting language "indicating the occurrence of the second game trigger condition if one of the allotted numbers matches the selected random number." First, the parties disagree as to whether two numbers can "match" when one is less than the other. Second, they dispute whether "indicating the occurrence" of the second game trigger condition must be displayed to the user, and when that indication must occur. The parties propose the following constructions:

Term or Language Requiring Construction	Aristocrat's Proposed Construction	IGT's Proposed Construction
indicating the occurrence of the second game trigger condition if one of the allotted numbers matches the selected random number"	indicating the occurrence of the second game trigger condition if one of the allotted numbers matches the selected random number	If one of the allotted numbers is identical to the selected random number, alerting the player during the first main game that a second game will appear after the first game is complete. This indication is different from and precedes the appearance and display of the second game.

**a. "match"**

IGT contends that one of the allotted numbers has to be identical to the selected random number in order for an indication of the second game trigger condition to occur. In other words, the numbers have to be identical. Since the court has construed "allotting a plurality of numbers" to include allotting the numbers represented by the player value, the dispute regarding the term "match" has little significance. Accordingly, even if the court were here to adopt IGT's construction, the embodiment at issue would still be covered by the claim language under the court's above construction.



**9. "After completion of said first main game"**

The parties propose the following constructions of the phrase "after completion of said first main game":

Term or Language Requiring Construction	Aristocrat's Proposed Construction	IGT's Proposed Construction
"after completion of said first main game"	after completion of the first main game.	after all transactions for the first main game have finished, including the loss or return of the wager and award of all the prizes won

IGT asserts that a person of ordinary skill in the art would understand from gaming-industry regulations that a game was "complete" when "all transactions have finished, including the loss or return of the wager and award of all prizes won." IGT CC at 23 (citing Irvine Decl. Exs. N, M, L). As Aristocrat points out, extrinsic evidence may not be used to vary or contradict the manifest meaning of the claims. *See Vitronics Corp. v. Conceptronic, Inc.*, 80 F.3d 1576, 1585 (Fed. Cir. 1996). Here, the specification and claims state that the second game's purpose is to determine the award of the "one progressive prize from [the] plurality of progressive prizes." Because the award of the one progressive prize must occur after the feature game, it cannot be part of the first main game. "All prizes" are not awarded during the first main game as IGT's proposed construction appears to require. However, without construction the term does not clearly delineate between the first main game and a second feature game. Because the first main game can be of any type, some type-independent criteria is necessary to distinguish the first main game from any second feature game. The court therefore construes the term "after completion of the first main game" as "after the wager has been lost or a non-progressive prize has been awarded pursuant to the rules of the first main game."

**10. "Randomly selecting said one progressive prize from said plurality of progressive prizes that has been won"**

IGT argues that the phrase "that has been won" in the phrase "randomly selecting said one progressive prize from said plurality of progressive prizes that has been won" refers to the "plurality of progressive prizes" and therefore requires that the player win at least two progressive prizes

1 before winning one of them again. Aristocrat contends "that has been won" merely refers to one  
2 progressive prize that has been won.

Term or Language Requiring Construction	Aristocrat's Proposed Construction	IGT's Proposed Construction
"randomly selecting said one progressive prize from said plurality of progressive prizes that has been won"	randomly selecting one progressive prize from the plurality of progressive prizes that has been won. There is no requirement that two or more prizes be won or any temporal restriction	winning two or more progressive prizes and then selecting one of those two or more progressive prizes

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9 The specification and the claims nowhere contemplate the winning of multiple progressive  
10 prizes in the main game, or any time before the second game. Rather, the second game is directed  
11 towards selecting the one progressive prize that the player has won. Each step including the  
12 disputed wording ("randomly selecting said one progressive prize . . .", "identifying to the player  
13 said one progressive prize . . ." and "awarding said one progressive prize . . .") is each sensibly  
14 construed as referring to the one progressive prize, selected by the second game, that the player has  
15 won. '215 Patent at 9:14-25. The court therefore adopts the following construction: "randomly  
16 selecting the one progressive prize that has been won from the number (at least two) of progressive  
17 prizes available."

18 **C. IGT's Motion for Summary Judgment on Indefiniteness**

19 Summary judgment is appropriate "if the pleadings, the discovery and disclosure materials on  
20 file, and any affidavits show that there is no genuine issue as to any material fact and that the movant  
21 is entitled to judgment as a matter of law." Fed. R. Civ. P. 56(c); *see Celotex Corp. v. Catrett*, 477  
22 U.S. 317, 322 (1986); *Ethicon Endo-Surgery, Inc. v. U.S. Surgical Corp.*, 149 F.3d 1309, 1315 (Fed.  
23 Cir. 1998).

24 Section 112 of the Patent Act requires that the claims "particularly point[] out and distinctly  
25 claim[] the subject matter which the applicant regards as his invention." 35 U.S.C. § 112, ¶ 2.  
26 Claim indefiniteness is a conclusion drawn from the court's construction of the claims, and is  
27 therefore a question of law. *Atmel Corp. v. Information Storage Devices, Inc.*, 198 F.3d 1374, 1378  
28 (Fed. Cir. 1999); *Exxon Research and Engineering Co. v. U.S.*, 265 F.3d 1371, 1376 (Fed. Cir. 2001)

1 (rejecting the argument that indefiniteness turns on an underlying factual issue that should not have  
2 been resolved on summary judgment). In considering whether a patent is indefinite, a court must  
3 determine whether those skilled in the art would understand what is read in light of the specification.  
4 *Bancorp Services, LLC v. Hartford Life Insurance Co.*, 359 F.3d 1367, 1371 (Fed. Cir. 2004).

5 Still, a difficult issue of claim construction does not render a claim indefinite. *Exxon*, 265  
6 F.3d at 1375. "If a claim is insolubly ambiguous, and no narrowing construction can properly be  
7 adopted," then the claim is indefinite. *Id.* But if "the meaning of the claim is discernible, even  
8 though the task may be formidable and the conclusion may be one over which reasonable persons  
9 will disagree, we have held the claim sufficiently clear to avoid invalidity on indefiniteness  
10 grounds." *Id.* Finally, in light of the statutory presumption of patent validity, close questions of  
11 indefiniteness are resolved in favor of the patentee. *Id.* at 1380.

12 Aristocrat amended the claims during prosecution after they were rejected by the examiner as  
13 obvious in view of Luciano, et al. (United States Patent No. 6,050,895) ("Luciano") and Torango  
14 (United States Patent No. 6,592,460) ("Torango"). See IGT's Mot. Summ. J. 7, 8; Wichman Decl.  
15 Ex. D-6, D-7. In particular, IGT argues that the distinction between a "first main game" and a  
16 "second game" was added to distinguish Torango, and that the limitation "after completion of the  
17 first main game" was added to distinguish Luciano. IGT contends that these amendments render the  
18 patent invalid because they do not "reasonably apprise those skilled in the art" as to their scope.  
19 *Amgen, Inc. v. Chugai Pharmaceutical Co., Ltd.*, 927 F.2d 1200, 1217 (Fed. Cir. 1991). As the court  
20 wrote in *Amgen*, "when the meaning of claims is in doubt, especially when, as is the case here, there  
21 is close prior art, they are properly declared invalid [for indefiniteness]." *Id.* at 1218.

22 The extent to which § 112 requires claims to clearly distinguish prior art has been the subject  
23 of a Federal Circuit case issued since briefing on summary judgment in this case completed. In  
24 *Young v. Lumenis*, 492 F.3d 1336, 1342 (Fed. Cir. 2007), the court considered whether the term  
25 "near" was indefinite because it failed to distinguish prior art. The district court in *Young* relied on  
26 the above-quoted language in *Amgen*, and determined that "in light of [ ] strikingly similar prior art,  
27 the Court does not see how . . . the patent adequately delineates the scope of the invention." *Id.* at  
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1 1342-43. The Federal Circuit reversed, concluding that *Amgen* did not support the district court's  
2 decision. *Id.* at 1347. The court wrote:

3 Unlike the situation in *Amgen*, here the intrinsic evidence does provide guidance on the  
4 meaning of the term "near." When the intrinsic evidence resolves the claim construction,  
5 a term is not "insolubly ambiguous," and thus reference to the prior art is not needed.  
6 That is the situation here. In addition, there were no office actions issued by the PTO  
7 during the original prosecution rejecting the claims over the prior art. There were also  
8 no amendments or arguments filed by the patentee. Thus, unlike in *Amgen*, the claims  
9 were not amended to include vague language in order to overcome close prior art.

10 *Id.* If the specification is clear, then, no reference to the prior art is necessary. If it is not, then the  
11 prosecution history, amendments to distinguish prior art, and arguments offered to the PTO, are  
12 properly considered as part of the indefiniteness inquiry.

13 Because the court finds, in the above claim construction, that the intrinsic evidence resolves  
14 the claim construction as to the terms "game" and "after completion of said first main game," the  
15 terms are not "insolubly ambiguous." IGT's motion for summary judgment on indefiniteness is  
16 therefore denied.

### 17 III. ORDER

18 For the reasons stated above, the court:

- 19 1. Strikes paragraphs 7, 10, 16, 19 and 21 of the declaration of Dwight Crevelt in support of  
20 Aristocrat's Claim Construction Brief;
- 21 2. Denies IGT's motion for summary judgment that the '215 Patent and the '603 Patent are  
22 invalid; and
- 23 3. Construes the disputed claim language as follows:

24 Disputed Language	25 Court's Construction
26 "gaming machine"	27 gaming device which is not limited to any particular type of game such as poker
28 "progressive prize"	a prize amount or value that increases based, at least in part, upon contributions from networked gaming machines.
"game"	a gambling activity played according to a set of rules
"using a second game to select said one progressive prize"	claim limitation in preamble

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"causing a second game trigger condition to occur as a result of first main game being initiated"	No construction required
"said step of causing the second game trigger condition to occur including: (1) selecting . . . (2) allotting . . . (3) indicating . . ."	No construction required
"allotting a plurality of numbers from the predetermined range of numbers"	giving to the player two or more numbers from a range of numbers. The range of numbers must be determined before the beginning of the first main game. Each number in the predetermined range need not be available for allotment
"indicating the occurrence of the second game trigger condition if one of the allotted numbers matches the selected random number"	If one of the allotted numbers is identical to the selected random number, alerting the player during the first main game that a second game will appear after the first game is complete. This indication is different from and precedes the appearance and display of the second game.
"after completion of said first main game"	after the wager has been lost or a non-progressive prize has been awarded pursuant to the rules of the first main game
"randomly selecting said one progressive prize from said plurality of progressive prizes that has been won."	randomly selecting the one progressive prize that has been won from the number (at least two) of progressive prizes available

DATED: 05/14/09

  
RONALD M. WHYTE  
United States District Judge

