United States District Court,
D. Nevada.

Cynthia Jean GOFF, as administrator of the estate of Lawrence J. Torango,
Plaintiff.
v.
HARRAH'S OPERATING COMPANY, INC., Harvey's Tahoe Management Company, Inc., Harrah's Laughlin, Inc., Aristocrat Leisure Limited, Aristocrat Technologies, Inc., and International Game Technology,
Defendants.

No. 3:03-CV-0690-ECR-RAM

Sept. 11, 2007.

Margo Piscevich, Piscevich & Fenner, Reno, NV, Peter C. Warner, Peter C. Warner, PC, Tempe, AZ, for Plaintiff.

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ORDER

EDWARD C. REED**, District Judge.**

United States Patent 6,241,608 ('608) lists Lawrence Torango as its owner. The Estate of Lawrence J. Torango, administered by Plaintiff Cynthia Goff, now owns that patent. Count VII of the Amended Complaint (# 9), originally filed by Mr. Torango on January 30, 2004, seeks a declaratory judgment that Mr. Torango is the inventor of the invention claimed in the ' 608 patent. Defendant International Game Technology ("IGT") filed a Counterclaim (# 301) on August 7, 2006 seeking a declaratory judgment that Torango had assigned the '608 patent to IGT (Counterclaim II), and for correction of inventorship pursuant to 35 U.S.C. s. 256 (Counterclaim VII). The first step in resolving these claims is claim construction.

Pursuant to a Joint Claim Construction and Prehearing Statement (# 512) filed by Plaintiff Goff and Defendant IGT, IGT and Goff filed their respective claim construction briefs (514, 515) on April 27, 2007 and their respective responses (521, 522) on May 18, 2007. When Defendants Harrah's and Aristocrat announced that they intended to take a position on the claim construction of the '608 patent at the claim construction hearing, this Court ordered (# 566) that they file a brief prior to the *Markman* hearing. They filed their brief (# 574) on July 23, 2007, to which IGT and Goff responded (581, 582) on July 27, 2007. The Court heard oral argument on July 31, 2007.

The claims will be construed as set forth below.

I. BACKGROUND

The abstract of the patent describes the invention as follows:

A linked progressive gaming system and method of operation is disclosed that is capable of accepting wagers in different currencies and different denominations of the same currency and allowing players in diverse locations to play for common progressive prizes. The system periodically computes each current prize value using the data acquired from each gaming device, and displays the values at each location where participating gaming devices are located, in the currency used at each particular location. Multiple prizes may be supported simultaneously. Each gaming device may be linked to one or more prizes. *Progressive prize award events may be triggered by random events associated with play based on wagers made on gaming devices or by the central system based on prize criteria exceeding a boundary limit*. A Free Play apparatus is disclosed that allows non-progressive gaming devices, as well as other traditional games, to participate in progressive play.

'608 Patent, page 1 (emphasis supplied). Similarly, the "summary of invention" section of the patent describes the objectives of the invention as follows:

One of the objectives of this invention is to allow players using gaming devices which accept wagers in different currencies or varying denominations within a particular currency, to share in the possibility of winning common progressive prizes. A critical element in the practical application of this objective is the ability to enable gaming devices or other gaming apparatus containing no linked progressive prize hardware or software logic, to be linked to progressive prizes. The linkage is enabled without modification to the essential characteristics of the gaming device or game apparatus as represented by the gaming device's hardware or software or the playing characteristics. [para.] *Another objective* of this invention is to teach a method whereby a boundary criterion such as a maximum value, or, an expiration *date and time, or other criteria may be specified for a prize. Then, when random play has not created a prize award event by the time the boundary criteria is reached, the method enables the system to randomly select one or more of the current participants as a winner*.

'608 Patent, 4:23-41 (emphasis supplied). Thus, and as is elaborated further by the patent specification, the patent generally suggests that Mr. Torango had invented both (1) a method of connecting many gambling machines and games together remotely and internationally, sharing a common prize pot to which the games would contribute despite differences in game mechanics, currencies, and local gaming regulations; and (2) a method that allows a prize to be awarded *either* non-deterministically (i.e., randomly, based on individual play) *or* deterministically (i.e., based on a boundary determined not by the random play on an individual game device, but rather on other criteria such as a date and time).

A central disputed issue in this claim construction is whether the '608 patent actually ends up stating a claim delimiting a method of awarding prizes either non-deterministically or deterministically as the specification, in our view, quite clearly suggests. FN1 This question involves the language of Claim 10. On its face, Claim 10 describes a deterministic system in which a prize award is occasioned by a boundary. Plaintiff Goff argues that the claim must be construed as limited to a system that combines deterministic and non-deterministic elements.

FN1. For the reasons stated below, IGT's argument that the specification does not make this suggestion is without merit.

II. DISCUSSION

A. Claim Construction Analysis Principles

"Because co-inventors need not contribute to the subject matter of every claim of the patent, inventorship is determined on a claim-by-claim basis." Gemstar-TV Guide Intern., Inc. v. Int'l Trade Comm'n, 383 F.3d 1352, 1381 (Fed.Cir.2004).

"[I]nventorship analysis, like an infringement or invalidity analysis, first requires the construction of each disputed claim to determine the subject matter encompassed thereby." Id. at 1381-82. Claim construction is a question of law reserved for the court. Markman v. Westview Instruments, Inc., 517 U.S. 370, 384 (1996). In construing a claim term, a court must give it the "ordinary and customary meaning" as that "term would have to a person of ordinary skill in the art in question at the time of the invention." Phillips v. AWH Corp., 415 F.3d 1303, 1312-13 (Fed.Cir.2005) (en banc) (citations omitted).

Phillips notes that sometimes the ordinary meaning of a term to one skilled in the art is "readily apparent even to lay judges." *Id*. at 1314. For terms whose meanings are not readily apparent, *Phillips* advises:

the court looks to those sources available to the public that show what a person of skill in the art would have understood disputed claim language to mean. Those sources include "the words of the claims themselves, the remainder of the specification, the prosecution history, and extrinsic evidence concerning relevant scientific principles, the meaning of technical terms, and the state of the art."

Id. (citations omitted). The first three categories (claims, specification, and prosecution history) are considered intrinsic evidence, while everything existing outside of the patent and its history is considered extrinsic evidence. Vitronics Corp. v. Conceptronics, Inc., 90 F.3d 1576, 1582, 1584 (Fed. Cir1986).

Of primary importance to discerning a term's meaning is the language of the claims which define the scope of the patent owner's property right. *See* Phillips, 415 F.3d at 1312 ("It is a 'bedrock principle' of patent law that 'the claims of a patent define the invention to which the patentee is entitled the right to exclude.' ") (quoting Innova/Pure Water, Inc. v. Safari Water Filtration Systems, Inc., 381 F.3d 1111, 1115 (Fed.Cir.2004)).

"In light of the statutory directive that the inventor provide a 'full' and 'exact' description of the claimed invention, the specification necessarily informs the proper construction of the claims." Id. at 1316. As stated by *Phillips,*

[u]ltimately, the interpretation to be given a term can only be determined and confirmed with a full understanding of what the inventors actually invented and intended to envelop with the claim. The construction that stays true to the claim language and most naturally aligns with the patent's description of the invention will be, in the end, the correct construction.

Id. (quoting Renishaw PLC v. Marposs Societa' per Azioni, 158 F.3d 1243, 1250 (Fed.Cir.1998)). The

prosecution history of the patent, although considered intrinsic evidence and useful to the claim construction inquiry, is accorded slightly less weight. *Id*. at 1317.

Extrinsic evidence, which "can shed useful light on the relevant art," is considered "less significant than the intrinsic record in determining 'the legally operative meaning of claim language.' " *Id*. at 1317 (citations omitted). Extrinsic evidence "consists of all evidence external to the patent and prosecution history, including expert and inventor testimony, dictionaries, and learned treatises." *Id*.

B. Relationship of the Claim to the Specification

On the one hand, the Federal Circuit has forcefully asserted that the claims in a patent "define the scope of the right to exclude [and] the claim construction inquiry, therefore, begins and ends in all cases with the actual words of the claim[.]" Renishaw, 158 F.3d at 1248 (quoting Abtox, Inc. v. Exitron Corp., 122 F.3d 1019, 1023 (Fed.Cir.1997)). *See also* Scimed Life Systems, Inc., v. Advanced Cardiovascular Systems, Inc., 242 F.3d 1337, 1340 (Fed.Cir.2001) (" *SciMed* ") ("one of the cardinal sins of patent law [is] reading a limitation from the written description into the claims"); Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed.Cir.1996) ("we look to the words of the claims themselves ... to define the scope of the patented invention"); Markman v. Westview Instruments, Inc., 52 F.3d 967, 979-81 (Fed.Cir.1995) (en banc) ("The written description part of the specification itself does not delimit the right to exclude. That is the function of claims."), aff'd 517 U.S. 370 (1996); McCarty v. R. Co., 160 U.S. 110, 116 (1895) ("The difficulty is once begin to include elements not mentioned in the claim, in order to limit such claim, and avoid a defense of anticipation, we should never know where to stop.").

On the other hand, the Federal Circuit has in numerous cases found that the specification does have a limiting effect on the scope of patent claims, FN2 for the most part reconciling these findings with the axiom that claim construction "begins and ends in all cases with the actual words of the claim" by considering the claim terms to be "defined" by the specification. *See* Phillips, 415 F.3d at 1316 ("our cases recognize that the specification may reveal a special definition given to a claim term by the patentee that differs from the meaning it would otherwise possess"). Where the inventor acts as his or her own lexicographer, "the inventor's lexicography governs." *Id*. After *Phillips,* it is clear that the manner in which a term can be "defined" by the specification may be implicit. *See* MBO Laboratories, Inc. v. Becton, Dickinson & Co., 474 F.3d 1323, 1329 (Fed.Cir.2007) ("The words of patent claims have the meaning and scope with which they are *used* in the specification and the prosecution history.") (emphasis supplied); SciMed, 242 F.3d at 1344 ("[T]he written description can provide guidance as to the meaning of the claims, thereby dictating the manner in which the claims are to be construed, even if the guidance is not provided in explicit definitional format.").

FN2. *See* Phillips, 415 F.3d at 1315 ("the specification 'is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term.' ") (quoting Vitronics, 90 F.3d at 1582); Microsoft Corp. v. Multi-Tech Systems, Inc., 357 F.3d 1340, 1347 (Fed.Cir.2004) ("One purpose for examining the specification is to determine if the patentee has limited the scope of the claims.") (quoting Watts v. XL Sys., Inc., 232 F.3d 877, 882 (Fed.Cir.2000)) (brackets omitted).

The Federal Circuit has also found "[i]n other cases" that "the specification may reveal an intentional disclaimer, or disavowal, of claim scope by the inventor." Phillips, 415 F.3d at 1316.FN3 In such a case,

"the inventor has dictated the correct claim scope, and the inventor's intention, *as expressed in the specification,* is regarded as *dispositive*." *Id*. (emphasis supplied).FN4 The extent to which particular claim terms in these "other cases" must be redefined by the disavowal is unclear. *See* Phillips, 415 F.3d at 1323 (characterizing the disavowal cases as a separate line of cases from the "lexicography" cases); CCS Fitness, Inc. v. Brunswick Corp., 288 F.3d 1359, 1366-67 (Fed.Cir.2002) (also discussing limitations based on "disavowal" of scope as distinct from limitations based on the inventor's "lexicography"); *see also* SciMed, 242 F.3d at 1341 (where the specification "makes clear that the invention does not include a particular feature, that feature is deemed to be outside the reach of the claims of the patent, even though the language of the claims, read without reference to the specification, might be considered broad enough to encompass the feature in question."). In any case, *Phillips* reaffirmed that where there is a disavowal of scope in the specification, that disavowal is very simply "dispositive." 415 F.3d at 1316.FN5

FN3. Although the *Phillips* court conspicuously avoided the phrase "clear disavowal," cases before and since have used that phrase. *See, e.g.,* Andersen Corp. v. Fiber Composites, LLC, 474 F.3d 1361, 1373 (Fed.Cir.2007).

FN4. The *Phillips* court repeatedly emphasized "the intention" of the inventor in this context, but it did not state how this intent is to be factored into an inquiry into the ordinary and customary meaning of the words of the claim. In light of the overall emphasis in the *Phillips* decision on the "ordinary meaning ... to the ordinary artisan," 415 F.3d at 1321, it seems evident that the *Phillips* court was not intending to carve a subjective test into the standard applied in claim construction.

FN5. *See also* CCS Fitness, Inc. v. Brunswick Corp., 288 F.3d 1359, 1367 (Fed.Cir.2002) (describing definition and disavowal as two of instances where interpretations of claim terms will four separate specification, and further characterizing these as depend on the the rule that claim terms will have their ordinary exceptions to meaning).

In Alloc, Inc. v. International Trade Commission, 342 F.3d 1361 (Fed.Cir.2003), the Federal Circuit provided some general guidance, announcing a broad test for claim limitations from the specification that turns largely on the language of the specification. That test is "whether the specification refers to a limitation only as a part of less than all possible embodiments or whether the specification *read as a whole* suggests that the very character of the invention requires the limitation be a part of every embodiment." Id. at 1370 (emphasis supplied). In its comprehensive discussion of claim construction in *Phillips,* the en banc panel neither cited the *Alloc* decision nor explicitly embraced *Alloc's* test.FN6 The test has, however, been subsequently cited and applied on several occasions by the Federal Circuit. *See, e.g.,* Andersen Corp. v. Fiber Composites, LLC, 474 F.3d 1361, 1368 (Fed.Cir.2007) (applying the test); *see also* Microsoft Corp. v. Multi-Tech. Sys., Inc., 357 F.3d 1340, 1368 (Fed.Cir.2004) (applying the test prior to *Phillips*).

FN6. The *Phillips* court disapproved "either strictly limiting the scope of the claims to the embodiments disclosed in the specification or divorcing the claim language from the specification ." 415 F.3d at 1324. Read literally, without caution, the *Alloc* test appears to simply divorce the specification from the claim.

More generally, the Federal Circuit has also characterized the obligation to read claims in light of the

specification and the prohibition against reading a limitation from the specification into the claim as "twin axioms" in "inherent tension," Liebel-Flarsheim Co. v. Medrad, Inc., 358 F.3d 898, 904 (Fed.Cir .2004), requiring courts to negotiate a "balance." Alloc, 342 F.3d at 1370. The Circuit has repeatedly acknowledged that this balance is difficult to negotiate.FN7 *See, e.g.,* Phillips, 415 F.3d at 1323; Liebel-Flarsheim Co., 358 F.3d at 905; Comark Communications, Inc. v. Harris Corp., 156 F.3d 1182, 1186-87; SciMed, 242 F.3d at 1347 (Dyk, J., concurring). It has even characterized the court's application of these twin axioms as akin to walking a "tightrope." Andersen Corp. v. Fiber Composites, LLC, 474 F.3d 1361, 1373 (Fed.Cir.2007). However, at a high level of generality, the teaching of *Phillips* is that it is "entirely appropriate for a court, when conducting claim construction, to rely *heavily* on the written description for guidance as to the meaning of the claims." 415 F.3d at 1317 (emphasis supplied). *Accord On* Demand Machine Corp. v. Ingram Industries, Inc., 442 F.3d 1331, 1337-38 (Fed.Cir.2006) ("[T]he court in *Phillips,* resolving conflict, stressed *the dominance* of the specification in understanding the scope and defining the limits of the terms used in the claim.") (emphasis supplied). *See also* Alloc, 342 F.3d at 1370 ("[T]his court recognizes that it must interpret the claims in light of the specification, yet avoid impermissibly importing limitations from the specification. That balance turns on how *the specification* characterizes the claimed invention.") (emphasis supplied).FN8

FN7. By way of example, the en banc panel in *Phillips* embraced and affirmed the prior panel's understanding of the legal standard, which differed from the more formal standard propounded by the dissent, but it nevertheless reversed the outcome. 415 F.3d at 1310.

FN8. Clearly, generalizations remain hazardous. *Compare On* Demand Machine Corp., 442 F.3d at 1340 ("[T]he role of the specification is to describe and enable the invention. In turn, the claims *cannot be* of broader scope than the invention that is set forth in the specification.") (emphasis supplied), with Intamin Ltd. v. Magnetar Technologies, Corp., 483 F.3d 1328, 1335 (Fed.Cir.2007) ("[A] narrow disclosure in the specification does not necessarily limit broader claim language."); Acumed LLC v. Stryker Corp., 483 F.3d 800, 805 (Fed.Cir.2007) (same). *See generally* Donald S. Chisum, CHISUM ON PATENTS s. 18.03[2] (2007) (analyzing in some detail cases of the Federal Circuit between 2003 and 2004, noting that the Circuit oscillated between "literalist" and "contextualist" approaches to claim interpretation, and finding that the Federal Circuit's en banc decision in *Phillips* emphasizes contextualism); Jeffrey A. Lefstin, *The* Measure of Doubt: Dissent, Indeterminacy, and Interpretation at the Federal Circuit, 58 HASTINGS L.J. 1025 (2007).

C. Claim 3

Before turning to Claim 10, we note that one term in Claim 3 was in dispute when the parties filed their claim construction briefs. With the formerly disputed term underlined, the language of Claim 3 is as follows:

3. A method of operating a progressive wagering system, the system comprising at least one device driver and a central system, the method comprising the following steps:

(A) the central system establishing a *win number* for a progressive prize;

(B) the central system transmitting the *win number* to the device driver; and

(C) the device driver qualifying all messages relating to acquisition data and prize related event conditions with the win number.

'608 Patent, 22:65-23:7.

The upshot of the differing proposed constructions and the arguments for and against them was that the parties disagreed about whether the win number played an "active" or a "passive" role in the method. Plaintiff Goff and Defendant IGT now agree, however, that "win number" means: "A unique number assigned the set of a progressive prize's system activity data used for the purpose of controlling the accumulation of wagers made to each prize-award event and any prize-related events." (Joint Brief Regarding 7/31/07 Claim Construction Hearing 1 n. 1 (# 558).) This definition substantially comports with the definition in the specification and we therefore adopt it. *See Phillips,* 415 F.3d 1316 ("the inventor's lexicography governs").

D. Claim 10

The claim and specification describe a method of organizing a gaming system in which every game (e.g., keno, bingo, or a table game) is connected to a "gaming environment manager," which in turn is connected to the central system that coordinates the game as a whole. With the disputed terms underlined, Claim 10 of the '608 patent reads as follows:

10. A method of operating a progressive wagering system, the system comprising a central system in communication with at least one gaming environment manager, comprising the following steps:

(A) determining a *boundary* for a progressive prize;

(B) the central system determining when the progressive prize has achieved the *boundary;*

(C) the central system sending a message to the gaming environment manager instructing it to detect play on a *linked gaming device;*

(D) the gaming environment manager detecting play on a *linked gaming device;* and

(E) the gaming environment manager creating a *prize award event* for the gaming device.

'608 Patent, 24:13-28.

Although the parties devote substantial argument to the first disputed term, "boundary," we construe these terms in the order that we deem to be the most logical and informative:

1. Prize Award Event

IGT would define a "prize award event" as a "predictable occurrence of awarding the progressive prize of Step (A)." Goff would define the term as "an occurrence of awarding the progressive prize of Step (A)." Oddly enough, however, IGT appears to argue that Goff's proposal is more or less acceptable. This is because, despite Goff's argument that the claim presupposes random play, Goff defines "prize award event" as an occurrence solely occasioned by Step A, which would seem to require that a "prize award event" be a solely deterministic outcome.

Again, notwithstanding Goff's proposed construction, Goff argues that the term "prize award event" cannot be construed as an exclusively deterministic, predictable outcome. We agree. First, in construing "prize award event" we look to the patent as a whole, not simply the role that a prize award event has in Claim 10. The specification defines "prize award" as follows:

The condition that results from the win of a progressive prize on a gaming device and the subsequent prize award event that ensures all jurisdiction rules are enforced in regards to meter collection and calculation of the final prize amount.

'608 Patent, 7:28-32. This definition does not compel or even imply that the award is "predictable" based on a boundary and there is no reason to conclude that prize award event means an award occasioned by Step A. More tellingly, the term "prize award event" is used at various points in the specification in a manner that makes it clear that a prize may be triggered by either random play or a boundary. The abstract, for example, states:

Progressive *prize award events* may be triggered by random events associated with play based on wagers made on gaming devices *or* by the central system based on prize criteria exceeding a boundary limit.

'608 Patent, Abstract, page 1 (emphasis supplied). The specification later references the "prize award event" without mentioning a predictable boundary at all:

[T]his invention specifies a Free Play apparatus that uses the total wager amount, which may be represented in different currencies, and the wager amount of a specific bet made by a player, to dynamically compute the odds of a *prize award event*.

Id., 3:66-4:3. The specification also explains that it would be an advantage of the system to "force" a prize award event when a random prize does not occur:

Under certain circumstances, it would be advantageous to be able to establish a maximum amount of a prize, or to establish a date and time, or other criteria related to a boundary, beyond which a *prize award event* may be forced upon one or more participating players.

Id., 4:16-20; *see also* id. 5:1-7. We find no basis in the patent to conclude that the prize award events based on random play or on a boundary must be for separate progressive prizes as IGT briefly suggested at oral argument. FN9 Indeed, the generic term "prize award event" appears to be used in the patent partly because of the possibility that a prize may be awarded by multiple criteria.

FN9. The specification indicates otherwise, stating:
Another objective of this invention is to teach a method whereby a boundary criterion such as a maximum value, or, an expiration date and time, or other criteria may be specified for a prize. Then, when random play has not created a *prize award event* by the time the boundary criteria is reached, the method enables the system to randomly select one or more of the current participants as a winner.

In sum, neither proposed construction uses "prize award event" as it is both explicitly and implicitly defined

by the specification. We construe the term "prize award event" as follows: "An occurrence of awarding the progressive prize triggered either by random play or by the central system based on a boundary."

2. Boundary

IGT would have us define the term "boundary" as:

A criterion, such as a maximum value or an expiration date and time, utilized by the central system so that the central system may trigger a prize award event if the boundary is achieved.FN10

FN10. We note that this proposed language uses the word boundary in construing the word boundary, which is a practice that we do not accept.

Goff, on the other hand, would have us define the term as:

A criterion, such as a maximum value or a date and time, that is used in triggering a prize award event when random play has not created the prize award event by the time the criterion is reached.

Id., 4:38-41.

The parties' diverging definitions arise from two disputed issues: (1) whether the central system "triggers" the prize, and (2) whether the specification limits this claim's scope to implementations that first allow prizes to be awarded non-deterministically, and failing that, award them deterministically. We take up each issue in turn.

IGT's proposed language is framed in the active voice and states that the central system triggers the win. Goff's proposed language uses the passive voice-"that is used in triggering"-to avoid specifying the exact role of the central system.FN11 Goff asserts that the claim and specification do not require that the central system store the boundary, and Goff's expert also points out that the prize will only be triggered if there is play on a device (Step D).

FN11. Goff's argument in support of the proposed language actually goes a step farther than Goff's proposed language. Goff argues that the central system does not trigger the award, whereas the language simply leaves it unclear what, other than the boundary, triggers the award.

In Claim 10, the central system needs to determine whether the boundary has been met (Step B) in order for the prize to be awarded by the gaming environment manager in Step E. Thus, the central system utilizes the boundary even if, for whatever unexplained reason, it does not know what it is. Goff's arguments pertaining to other parts of the mechanism are not persuasive. But for Step B, there is no Step E, and the central system thus triggers Step E. The specification also indicates that Step B always results in Step E. '608 Patent, 20:34-38. Thus, in addition to being a trigger, Step B is *both* a necessary and a sufficient trigger for Step E-at least insofar as the method works as disclosed. The fact that game play is required does not mean that the central system does not cause Step E. In sum, we construe the central system as triggering the prize of Step E.

We next turn to the issue of the scope of Claim 10, an issue we touched upon in construing "prize award

event." We agree with Goff that the term "boundary" is not clear within the confines of Claim 10. When considered within the context of the patent as a whole, however, the term is not particularly ambiguous or challenging. One does not need a particularly advanced education or training to comprehend that if X < Y, then Y provides a boundary for X. Based on the claim language, a criterion (e.g., X becomes greater than Y) could be anything that, if true, triggers the central system to send the message (Step C) that will ultimately result in a prize award on a gaming device (Step E).

IGT essentially argues that we should leave it at that. IGT's position is not entirely unreasonable when the claim language is read in isolation, but reading the patent as a whole, we do not agree.FN12 In light of the usage of the term "prize award event" in Claim 10 it is absolutely clear that the claim's scope is not limited solely to a system utilizing a boundary. Our conclusion that random play is *required* by the claim is derived from our reading of the specification as a whole, Alloc, Inc., 342 F.3d at 1370, and most significantly, from the ' 608 patent's statements describing the advantages of this invention: "This invention introduces *an element* of predictability into *the* prize award event to facilitate the creation of progressive prizes associated with certain timed social events or other needs, *while retaining* the feature of randomly awarded prizes and more than one player winning a particular prize." '608 Patent, 20:5-9 (emphasis supplied).FN13 IGT places great emphasis on the Federal Circuit's pre- *Phillips* statement that a "clear disavowal" must be in the form of "words or expressions of manifest exclusion or restriction." Liebel-Flarsheim Co., 358 F.3d at 906 (quoting Teleflex, Inc. v. Ficosa North America Corp., 299 F.3d 1313, 1327 (Fed.Cir.2002). Whether or not this standard survives *Phillips,* and good arguments can be made on either side of that issue,FN14 we do not find that the *Teleflex* standard applies here. *See On* Demand Machine Corp., 442 F.3d at 1340 (Fed.Cir.2006) ("[W]hen the scope of the invention is clearly stated in the specification, and is described as the advantage and distinction of the invention, *it is not necessary to disavow explicitly a different scope*. ") (emphasis supplied); SciMed, 242 F.3d at 1344 (even where claim language could have been interpreted differently when read independently, a claim's scope must be read in light of the specification). *Cf.* Markman, 517 U.S. at 389 ("[A claim] term can be defined only in a way that comports with the instrument as a whole."); Markman, 52 F.3d at 978 (claims are part of "a fully integrated written instrument").

FN12. In our view, this issue turns to a great extent on the claim construction principles that *either* a court or an ordinary artisan must apply to this claim. We have considered but do not weigh heavily the expert opinions that have been submitted.

FN13. With respect to this implementation of a boundary, the '608 patent chiefly discusses and distinguishes United State Patent 5,280,909 as the most closely related prior art. *See* '608 Patent, 19:56-20:9. United States Patent 5,885,158 ('158) was disclosed in the prosecution of the '608 patent without comment. The parties disagree about whether the '158 patent anticipates the '608 patent as we construe it, and relatedly, they apparently also disagree about how to construe patent ' 158. We have considered these arguments for the limited purpose of construing the '608 patent but express no opinion at this time on these issues.

FN14. *See also* Irdeto Access, Inc. v. Echostar Satellite Corp., 383 F.3d 1295, 1302 (Fed.Cir.2004) (cautioning that *Teleflex* and *Liebel-Flarsheim* must be read closely in light of their facts, and that the decisions do not stand for the principle that redefinition cannot be by implication).

Accordingly, we adopt the following construction of the term boundary: "A criterion, such as a maximum

value or a date and time, that the central system uses in triggering a prize award event when random play has not created the prize award event by the time the criterion is reached."

3. Linked Gaming Device

IGT would define a "linked gaming device" as "a gaming device associated with the progressive prize based on total wager amount." Goff would define it as "a gaming device qualified based on total wager amount to compete for the progressive prize."

The patent's specification defines "gaming device" as:

[a] device used as a game of chance where a player may place wagers to participate in play in return for the chance of winning prizes such as a slot machine. Also, devices that control games or other gaming devices such as the Free Play Apparatus used to control non-progressive gaming devices, keno, bingo, table games or others such as roulette.

'608 Patent, 7:5-10. The specification also succinctly defines "linked game" as: "[a] game that is *associated with* one or more progressive prizes." *Id.,* 7:17-18 (emphasis supplied). In the context of Claim 3, the parties have stipulated that "associated" and "qualified" are synonymous. Goff now resists that equivalency *in this claim*.

In support of Goff's proposed language, she cites our prior construction of "total wager mount" in Patent 6,592,460:

The theoretical sum of all wagers made for each prize award event. The total wager amount must be of a value that will support all the criteria for the prize starting value, increment values, and any other values generated as a result of contribution percents applied against wagers. The total wager amount serves as a link between devices and a progressive prize.

(Order of Dec. 30, 2005 (# 220), p. 14). Goff argues that, "given that total wager amount serves as a link between devices and a progressive prize, a 'linked gaming device' is not merely a gaming device 'associated' with the progressive prize based on total wager amount. A 'linked gaming device' is a gaming device 'qualified' based on total wager amount to compete for the progressive prize." (Plaintiff's Response (# 522) 24.)

We are not persuaded that Goff's embellishment is necessary. The Federal Circuit has stated that "a claim term should be construed consistently with its appearance in other places in the same claim or in other claims of the same patent." Rexnord Corp. v. Laitram Corp., 274 F.3d 1336, 1342 (Fed.Cir.2001); *see also* Phillips, 415 F.3d at 1314 ("claim terms are normally used consistently throughout the patent").

We adopt IGT's construction of "linked gaming device" as "a gaming device associated with the progressive prize based on total wager amount."

III. CONCLUSION

IT IS, THEREFORE, HEREBY ORDERED that the disputed claim terms are to be construed as set forth above.

D.Nev.,2007.
Goff v. Harrah's Operating Co., Inc.

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