

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LIGHT & WONDER, INC.,
Petitioner

v.

EVOLUTION MALTA LIMITED,
Patent Owner.

Case IPR2025-01072

U.S. Patent No. 11,011,014

**PETITIONER'S OPPOSITION TO
PATENT OWNER'S MOTION TO TERMINATE**

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UPDATED LIST OF PETITIONER EXHIBITS

- EX1001 U.S. Patent No. 11,011,014 (the “’014 Patent”)
- EX1002 File History for U.S. Patent No. 11,011,014
- EX1003 Declaration of Stacy Friedman
- EX1004 Curriculum Vitae of Stacy Friedman
- EX1005 U.S. Patent No. 10,629,024 (the “’024 Patent”)
- EX1006 File History of U.S. Patent No. 10,629,024
- EX1007 U.S. Pre-Grant Pub’l. No. 2008/0248853 (published Oct. 9, 2008) to Kido (“Kido”)
- EX1008 U.S. Pre-Grant Pub’l. No. 2016/0155296 (published June 2, 2016) to Baron (“Baron”)
- EX1009 U.S. Patent No. 9,600,974 to Yee (“Yee”)
- EX1010 Evolution’s LPR 1-10 Response to Defendants’ November 12, 2024 Invalidity and Unenforceability Contentions, *Evolution Malta Ltd. v. Light & Wonder, Inc.*, No. 2:24-cv-00993 (D. Nev. Dec. 3, 2024)
- EX1011 U.S. Patent No. 11,756,371 (the “’371 Patent”)
- EX1012 Partial File History of U.S. Patent No. 11,756,371
- EX1013 *Determine*, THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE (5th ed. 2012)
- EX1014 *Roulette*, WIKIPEDIA, <https://en.wikipedia.org/wiki/Roulette>
- EX1015 Complaint (D. Nev. No. 2:24-cv-00993, May 8, 2024, Dkt. 2-1)
- EX1016 U.S. Patent No. 7,674,172 to Miltenberger (“Miltenberger”)
- EX1017 U.S. Patent No. 9,646,459 to Hsu (“Hsu”)

UPDATED LIST OF PETITIONER EXHIBITS
(Continued)

- EX1018 U.S. Pre-Grant Pub'l. No. 2002/0167126 (published Nov. 14, 2002) to Raedt ("Raedt")
- EX1019 U.S. Patent No. 5,540,442 to Orselli ("Orselli")
- EX1020 Chart Comparing Independent Claims 1, 9, and 17 of the '014 Patent
- EX1021 Chart Comparing Dependent Claims of the '014 Patent
- EX1022 Order Granting Defendants' Motion to Dismiss (D. Nev. No. 2:24-cv-00993, Feb. 11, 2025, Dkt. 76)
- EX1023 First Amended Complaint (D. Nev. No. 2:24-cv-00993, Apr. 10, 2025, Dkt. 85)
- EX1024 Chart Comparing Independent Claims 1, 8, and 15 of the '024 Patent
- EX1025 Chart Comparing Dependent Claims of the '024 Patent
- EX1026 U.S. Pre-Grant Pub'l. No. 2011/0006477 (published Jan. 13, 2011) to Miller ("Miller")
- EX1027 WO 2015/139088 A1 to Witty ("Witty")
- EX1028 U.S. Pre-Grant Pub'l. No. 2008/0242393 (published Oct. 2, 2008) to Kido ("Kido 393")
- EX1029 U.S. Pre-Grant Pub'l. No. 2007/0060262 (published Mar. 15, 2007) to Kosaka ("Kosaka")
- EX1030 Chart Comparing Independent Claims 1, 11, and 21 of the '371 Patent
- EX1031 Chart Comparing Dependent Claims of the '371 Patent
- EX1032 John Scarne, SCARNE'S NEW COMPLETE GUIDE TO GAMBLING (1st Fireside ed. 1986)

UPDATED LIST OF PETITIONER EXHIBITS
(Continued)

- EX1033 *Roulette*, CAESARS (1996),
https://web.archive.org/web/19961031041803fw_/http://www.caesars.com/GamingGuide/Roulette.Content.html
- EX1034 *Roulette*, MICROGAMING SYS. (1999),
<https://web.archive.org/web/19990503024445/http://www.microgaming.com:80/html/roulette.html>
- EX1035 Richard Marosi, *Casino Boss Can't Cash In on Game He Developed*, L.A. TIMES (Nov. 3, 2002)
- EX1036 Andrew W. Scott, *Baccarat Without the Juice*, GAMING (Jan./Feb. 2013)
- EX1037 Rakesh Wadhwa, NO-COMM'N BACCARAT (2d ed. 2006)
- EX1038 U.S. Patent No. 4,836,553 to Suttle (“Suttle”)
- EX1039 U.S. Patent No. 5,288,081 to Breeding (“Breeding”)
- EX1040 U.S. Patent No. 5,685,774 to Webb (“Webb”)
- EX1041 Letter from Keith Cooper, State of Nevada Gaming Control Board to John Piccoli, D.P. Stud, Incorporated, approving the operation of “E Z Baccarat” (Dec. 24, 2003)
- EX1042 U.S. Patent No. 7,435,172 to Hall (“Hall”)
- EX1043 Ultimate Texas Hold ‘Em, U.S. Trademark Application Serial No. 77/726,392 (filed May 24, 2010)
- EX1044 Benjamin Spillman, *Global Gaming Expo 2006: Take My Game, Please*, LAS VEGAS REV. J. (Nov. 20, 2006)
- EX1045 Richard N. Velotta, *Seeking a Place at the Gaming Table*, LAS VEGAS SUN (May 12, 2009)

UPDATED LIST OF PETITIONER EXHIBITS
(Continued)

- EX1046 *Roulette*, WIZARD OF ODDS (2016)
<https://web.archive.org/web/20161119154345/http://lwizardofodds.com:80/games/roulette/basics/> (describes Roulette win probabilities)
- EX1047 *Top Hat™ Twenty-One*, ROBERTWINTER.COM (May 29, 2006)
https://web.archive.org/web/20060529010957/https://www.robertwinter.com/slot/odyssey/images/flyers/th_f.jpg
- EX1048 *Rapid Roulette*, SHUFFLE MASTER INC. (May 7, 2005)
- EX1049 *Winning Games*, WAGERWORKS (Mar. 10, 2007)
- EX1050 *Putting It All on the Table*, DIGIDEAL (n.d.)
- EX1051 *This Month in Physics History, July 1654: Pascal's Letters to Fermat on the 'Problem of Points,'* APS125 (July 2009),
aps.org/archives/publications/apsnews/200907/physicshistory.cfm
- EX1052 *Wheel Poker*, WIZARD OF ODDS (Apr. 21, 2010),
<https://web.archive.org/web/20120201095611/https://wizardofodds.com/games/video-poker/tables/wheel-poker/>
- EX1053 *Bonus Spin*, AGS (2016),
<https://web.archive.org/web/20170227055308/http://www.playags.com/portfolio/bonus-spin>
- EX1054 U.S. Patent No. 7,901,285 to Tran (“Tran”)
- EX1055 U.S. Patent No. 6,659,866 to Frost (“Frost”)
- EX1056 U.S. Pre-Grant Pub’l. No. 2014/0094244 (published Apr. 3, 2014) to Baron (“Baron and Haushalter”)
- EX1057 U.S. Patent No. 6,457,715 to Friedman (“Friedman ’715”)

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(Continued)

- EX1058 U.S. Patent No. 7,651,096 to Friedman (“Friedman ’096”)
- EX1059 U.S. Patent No. 8,074,992 to Friedman (“Friedman ’992”)
- EX1060 *Sic Bo*, WIZARD OF ODDS (Jan. 21, 2005),
<https://web.archive.org/web/20111007213531/http://wizardofodds.com/sicbo/rules.html>
- EX1061 *Spectacular*, THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE (5th ed. 2012)
- EX1062 Defendants’ Motion to Dismiss Original Complaint (D. Nev. No. 2:24-cv-00993, July 24, 2024, Dkt. 34)
- EX1063 Evolution’s Motion for Leave to File Second Amended Complaint (D. Nev. No. 2:24-cv-00993, Apr. 10, 2025, Dkt. 90)
- EX1064 Defendants’ Motion to Dismiss First Amended Complaint (D. Nev. No. 2:24-cv-00993, May 15, 2025, Dkt. 114)
- EX1065 Joint Stipulation to Extend Fact Discovery Cut Off Deadline Only (D. Nev. No. 2:24-cv-00993, July 25, 2025, Dkt. 150)
- EX1066 U.S. District Courts, Federal Court Management Statistics (June 30, 2025)
- EX1067 Defendants’ Motion to Compel Arbitration (D. Nev. No. 2:24-cv-00993, Feb. 7, 2025, Dkt. 74)
- EX1068 Order Resolving Defendants’ Motions [Granting Motion to Compel Arbitration of Trade Secret Claims] (D. Nev. No. 2:24-cv-00993, Sep. 30, 2025, Dkt. 163)
- EX1069 Parties’ Joint Status Report (D. Nev. No. 2:24-cv-00993, Apr. 30, 2026, Dkt. 179)

UPDATED LIST OF PETITIONER EXHIBITS
(Continued)

EX1070 Minute Order [Staying case pending arbitration] (D. Nev. No. 2:24-cv-00993, May 5, 2026, Dkt. 180)

When Acting Director Stewart referred L&W's Petition to the merits panel, the claims of the '014 Patent had already been held invalid under 35 U.S.C. § 101. Evolution is now asking this panel to second-guess the Acting Director's decision by recycling the same arguments she rejected. There is no basis for that. And Evolution altogether ignored the panel's request that it identify authority for terminating this instituted IPR—because no such authority exists. Evolution is taking its shot in the current climate at the Office, but the law and the equities are not on its side. L&W prepared and filed its Petition at great expense to protect itself from a patent that Evolution refuses to let die. L&W overcame the significant hurdle of discretionary denial, and it should not be stripped of the proceeding it earned, particularly when Evolution has refused to provide a covenant not to sue, a release, or a waiver of its right to appeal.

I. BACKGROUND

On February 11, 2025, the district court found the '014 Patent claims invalid under § 101 and dismissed Evolution's patent infringement claims without prejudice. Ex. 1022. Evolution refused to accept the ruling and filed multiple amended complaints reasserting the '014 Patent. Ex. 1023; Ex. 2017. L&W moved to dismiss the amended complaints on the same grounds. Ex. 2024.

On May 30, 2025, L&W filed its Petition, explaining in the opening paragraph that “the district court has already held the patent ‘invalid under *Alice*’” but that Evolution “nevertheless continues to assert its invalid patent . . . thus prompting this petition.” Paper 1 at 1.

On August 25, 2025, Evolution filed its Request for Discretionary Denial, devoting an entire section to why the § 101 invalidation allegedly warranted denial—citing the same *Google*, *Highlevel*, and *Hulu* cases it relies on here. Paper 6 at 31-33.

On October 17, 2025, Acting Director Stewart denied the request. She expressly noted the § 101 ruling and Evolution’s amended complaint, yet concluded that discretionary denial was not appropriate. Paper 11 at 2-3.

On December 17, 2025, the Board instituted trial on all grounds after rejecting Evolution’s merits arguments. Paper 14 at 12-18. Since then, the trial has progressed substantially: Evolution deposed L&W’s expert Stacy Friedman (Ex. 2045), Evolution filed its Patent Owner Response (Paper 19), and L&W’s Reply is already in preparation.

On March 30, 2026, the district court again found the claims invalid under § 101. Ex. 2046. Evolution promptly notified L&W of its intent to seek termination. L&W responded that it would consider consenting only if Evolution would agree to

a covenant not to sue, a release of all patent claims, a waiver of its right to appeal, and an agreement not to reassert the patents against L&W:

From: Bennett, Jennifer D. <jenniferbennett@jonesday.com>
Sent: Tuesday, April 7, 2026 8:48 PM
To: Broughan III, Thomas A. <tbroughan@sidley.com>; Nightingale, Joshua R. <jrnightingale@jonesday.com>
Cc: Fukuda, Ching-Lee <clfukuda@sidley.com>
Subject: Re: IPR2025-01072, -01073, -01078

Counsel,

L&W cannot consider consenting to a termination of the IPRs without receiving certain written assurances from Evolution regarding the patents as set forth below.

First, Evolution must agree to a covenant not to sue on any claim of the Haushalter patents.

Second, Evolution must provide a release of any and all claims relating to the Haushalter patents.

Third, Evolution must agree that it will not appeal, seek reconsideration of, or otherwise challenge the district court's order (Dkt. 156) granting dismissal of the Haushalter patent claims under 35 U.S.C. § 101.

Fourth, Evolution will not seek leave to file any further amended complaint or initiate any new action reasserting the Haushalter patents.

If we are in agreement in principle on these conditions above then we can memorialize these assurances in writing. But, absent Evolution's agreement to the foregoing, L&W opposes Evolution's request, and L&W will oppose any motion to terminate. Please let us know if you want to discuss.

Thanks,
Jennifer

Evolution rejected these conditions without discussion and filed its Motion to Terminate on April 24, 2026. Paper 21.

L&W's Reply is due June 3, 2026—less than a month away. The oral hearing is September 16, 2026. The Final Written Decision is due December 17, 2026. Meanwhile, the parties' broader dispute is far from over: the district court has compelled arbitration of Evolution's trade secret misappropriation claims, and the district court case is stayed pending the outcome of the arbitration. *See* Exs. 1068, 1069, and 1070.

II. THE CLAIMS HAD ALREADY BEEN HELD INVALID WHEN ACTING DIRECTOR STEWART REFERRED THIS PETITION

As explained above, Acting Director Stewart granted institution notwithstanding the first § 101 invalidation. She noted that Evolution had filed an amended complaint reasserting the '014 Patent and that the district court had stayed the proceeding without scheduling a trial date. Paper 11 at 2. The Acting Director was thus fully aware that the claims had been found invalid under § 101—and that Evolution was continuing to assert the '014 Patent regardless—yet she referred the Petitions to the Board. *Id.* at 2-3.

Nothing has materially changed. The district court has again found the claims invalid under § 101—for the second time. Ex. 2046. But Evolution's posture is the same: it refuses to let the '014 Patent die, it has taken no steps to foreclose its ability to reassert the patent, and no trial date has been set in the district court proceedings. Indeed, while Evolution characterizes the most recent dismissal as “with prejudice” (Paper 21 at 2), nowhere in the Court's Order does it explicitly state the dismissal is with prejudice. L&W offered to consent to termination if Evolution would agree to a covenant not to sue, a release, and a waiver of its appeal rights. *See* Section I above. Evolution refused and filed its motion instead. That refusal confirms the '014 Patent remains a live threat to L&W and that the circumstances are materially

the same as when Acting Director Stewart referred this Petition. There is no basis for the panel to second-guess her.

III. EVOLUTION CITES NO AUTHORITY THAT THE PANEL IS AUTHORIZED TO TERMINATE THIS TRIAL

The panel asked Evolution to address its authority to grant the requested relief. Evolution’s motion altogether ignores that request—because no such authority exists. Evolution’s five cited cases do not fill the gap. Three—*Google*, *Highlevel*, and *Shopify*—are decisions denying institution, not terminating a proceeding post-institution. *See Google LLC v. TJTM Techs., LLC*, IPR2025-00586, Paper 12 (Aug. 14, 2025); *Highlevel, Inc. v. Etison LLC d/b/a Clickfunnels*, IPR2025-00235, Paper 11 (June 2, 2025); *Shopify Inc. v. DKR Consulting, LLC*, IPR2025-00130, Paper 10 (May 29, 2025). None involves a panel terminating a proceeding mid-trial.

Evolution’s two post-institution cases—*Sinclair* and *Hulu*—are equally unavailing. First, both were decided by the Director, not a panel. *Hulu* was decided by Acting Director Stewart after a request for Director Review. IPR2024-01252, Paper 27 at 1. *Sinclair* was decided *sua sponte* by Director Squires. IPR2025-00145, Paper 41 at 1. Neither grants a panel the authority to terminate an IPR mid-trial.

Second, both are factually distinguishable. In *Sinclair*, the Director de-instituted because the ITC had adjudicated the “same patent, prior art, and asserted grounds,” creating “a risk of inconsistent decisions.” IPR2025-00145, Paper 41 at

2. That concern is absent here. The district court’s § 101 ruling does not involve the prior art grounds asserted in this IPR. No tribunal has adjudicated whether the ’014 Patent is anticipated or obvious in view of Kido, Yee, and Baron, and none will before the Board’s Final Written Decision here.

Hulu is likewise readily distinguishable. There, the § 101 invalidation occurred before institution, and the decision was made shortly after institution, *before* the Patent Owner’s Response. *Hulu*, IPR2024-01252, Paper 27 at 1. This case is far more advanced. The Patent Owner Response has been filed, Evolution has deposed L&W’s expert, L&W’s Reply is due in less than a month, the oral hearing is set for September 16, 2026, and the Final Written Decision is due later this year on December 17, 2026. Terminating now “would waste the significant resources that the parties and the Board have already expended on the proceeding.” *Mylan Pharms. Inc. v. Horizon Pharma USA, Inc.*, IPR2017-01995, Paper 20 (Mar. 28, 2019) (denying motion to terminate).

IV. TERMINATION WOULD UNFAIRLY PREJUDICE L&W

L&W filed its Petition knowing that the ’014 Patent had already been held invalid under § 101. It took that step anyway—at great expense—because Evolution refused to accept the district court’s ruling and continued to assert the patent. L&W prepared petitions totaling over 240 pages challenging all 65 asserted claims across

three related patents, supported by a 339-page expert declaration. L&W then overcame Evolution's extensive request for discretionary denial, briefed institution, and prepared for trial. It is simply unfair to allow Evolution to unilaterally pull the plug on this proceeding after L&W cleared each of those hurdles.

Further, this proceeding is in the home stretch. L&W's Reply is due June 3, 2026—less than a month away. The oral hearing is September 16, 2026. The Final Written Decision is due December 17, 2026. The bulk of the work is done. Terminating now would not conserve resources—it would squander them. And it would deprive L&W of this specialized forum, where unpatentability is assessed under a preponderance-of-the-evidence standard by a panel with expertise in prior art analysis. That forum cannot be replicated in district court, where L&W would face a clear-and-convincing standard and where any renewed §§ 102/103 validity challenge would not occur for years, if ever.

While the Office may be sensitive to perceived inefficiencies from parallel proceedings, the equities do not support termination here. Evolution continues to threaten L&W with the '014 Patent. It has refused a covenant not to sue, refused to release its claims, and refused to waive its right to appeal. And the parties' broader dispute is also far from over—the trade secret misappropriation claims are proceeding in arbitration and the district court case is stayed. *See* Exs. 1068, 1069,

and 1070. If the Federal Circuit reverses the § 101 decision—and it will review that question *de novo*, see *Mobile Acuity Ltd. v. Blippar Ltd.*, 110 F.4th 1280, 1288 (Fed. Cir. 2024)—L&W will be right back where it started, but without the IPR proceeding it earned. The panel should not allow that result.

V. CONCLUSION

For the reasons above, the Board should deny Evolution’s motion to terminate this IPR trial.

Respectfully submitted,

Dated: May 8, 2026

/Joshua R. Nightingale/

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CERTIFICATE OF SERVICE

The undersigned hereby certifies the foregoing document, PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION TO TERMINATE, and corresponding exhibits were served via electronic mail on the date below, upon the following:

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