

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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LIGHT & WONDER, INC.,  
Petitioner,

v.

EVOLUTION MALTA LIMITED,  
Patent Owner.

IPR2025-01072

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**PATENT OWNER EVOLUTION'S MOTION TO TERMINATE**

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2001	2024 Evolution Annual Report
2002	2021 Evolution Annual Report
2003	Evolution Interim Report, January to June 2025
2004	Evolution Press Release: Five wins for Evolution Group at EGR B2B Awards including Live Casino Supplier of the Year for 12th year running (July 8, 2021) <a href="https://www.evolution.com/news/five-wins-for-evolution-group-at-egr-b2b-awards-including-live-casino-supplier-of-the-year-for-12th-year-running/">https://www.evolution.com/news/five-wins-for-evolution-group-at-egr-b2b-awards-including-live-casino-supplier-of-the-year-for-12th-year-running/</a>
2005	Evolution’s Lightning Roulette Voted GOTY At EGR (Oct. 30, 1018) <a href="https://lcb.org/news/evolution-s-lightning-roulette-voted-goty-at-egr">https://lcb.org/news/evolution-s-lightning-roulette-voted-goty-at-egr</a>
2006	Global Gaming Awards, Vegas 2018 Winners <a href="https://www.globalgamingawards.com/vegas/2018/">https://www.globalgamingawards.com/vegas/2018/</a>
2007	Global Gaming Awards Las Vegas 2018 winners revealed (Oct. 8, 2018) <a href="https://www.gamblinginsider.com/news/6039/global-gaming-awards-las-vegas-2018-winners-revealed">https://www.gamblinginsider.com/news/6039/global-gaming-awards-las-vegas-2018-winners-revealed</a>
2008	Evolution Press Release: Evolution and Scientific Games strike land-based Lightning Roulette deal (May 25, 2021) <a href="https://www.evolution.com/news/evolution-and-scientific-games-strike-land-based-lightning-roulette-deal/">https://www.evolution.com/news/evolution-and-scientific-games-strike-land-based-lightning-roulette-deal/</a>
2009	2022 American Gambling Awards Nominations <a href="https://www.gambling.com/us/awards/winners/2022">https://www.gambling.com/us/awards/winners/2022</a>
2010	Lightning Roulette U.S. from Evolution is the American Gambling Awards Gaming Product of the Year (Nov. 18, 2022) <a href="https://www.businesswire.com/news/home/20221118005067/en/Lightning-Roulette-U.S.-from-Evolution-is-the-American-Gambling-Awards-Gaming-Product-of-the-Year">https://www.businesswire.com/news/home/20221118005067/en/Lightning-Roulette-U.S.-from-Evolution-is-the-American-Gambling-Awards-Gaming-Product-of-the-Year</a>
2011	Lightning Roulette Product Page <a href="https://games.evolution.com/live-casino/live-roulette/lightning-roulette/">https://games.evolution.com/live-casino/live-roulette/lightning-roulette/</a>
2012	Press Release re: FanDuel Extension (Nov. 14, 2024)

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2013	L&W's Responses and Objections to Evolution's First Set of Interrogatories (Oct. 7, 2024) (excerpts)
2014	March 29, 2021 License Agreement between Evolution and L&W
2015	Evolution's February 28, 2022 Letter to L&W
2016	L&W's March 17, 2022 Letter to Evolution
2017	Dkt. No. 125, Second Amended Complaint in <i>Evolution Malta Limited v. Light &amp; Wonder, Inc.</i> , Case No. 2:24-cv-00993-CDS-EJK (D. Nev.)
2018	L&W's Invalidity Contentions (Nov. 2024)
2019	L&W's Supplemental Invalidity Contentions (Aug. 2025)
2020	Dkt. No. 67, Order Denying Motion to Stay Discovery (Nov. 7, 2024)
2021	Dkt. No. 84, Minutes of Proceedings
2022	Dkt. No. 122, Order Denying Joint Stipulation to Stay Discovery (June 25, 2025)
2023	Dkt. No. 151, Order Denying Stipulation to Extend Discovery (July 28, 2025)
2024	Dkt. No. 156, Defendants' Motion to Dismiss Plaintiffs' Second Amended Complaint (Aug. 9, 2025)
2025	Dkt. No. 157, Order Granting Joint Stipulation to Stay Discovery (Aug. 11, 2025)
2026	L&W's July 22, 2025 Letter to Evolution
2027	Lightning Roulette Fact Sheet (June 2020)
2028	C. Barboianu, <i>Roulette Odds and Profits: The Mathematics of Complex Bets</i> (2007) (excerpt)
2029	S. Bourie, <i>Understanding Roulette Odds and Payouts</i> , American Casino Guide Book <a href="https://www.americancasino guidebook.com/roulette/understanding-roulette-odds-and-payouts.html">https://www.americancasino guidebook.com/roulette/understanding-roulette-odds-and-payouts.html</a>
2030	L. Hoofe, <i>Roulette Odds and Payouts</i> , Gambling Zone <a href="https://www.gamblingzone.com/uk/roulette/odds/">https://www.gamblingzone.com/uk/roulette/odds/</a>
2031	Bets, Odds, and Payouts: A list of all the bets on the roulette table, RouletteStar*

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	<a href="https://www.roulettestar.com/guide/bets-odds/">https://www.roulettestar.com/guide/bets-odds/</a>
2032	A guide to understanding roulette odds, Casino.org <a href="https://www.casino.org/roulette/odds/">https://www.casino.org/roulette/odds/</a>
2033	G. Pelayes, <i>Roulette Table Payout: Maximizing Your Potential Wins</i> , Vegas Aces (Aug. 1, 2024) <a href="https://www.vegas-aces.com/articles/roulette-table-payout-maximize-wins/">https://www.vegas-aces.com/articles/roulette-table-payout-maximize-wins/</a>
2034	NJ Regulations N.J. Admin. Code § 13:69F-5.2 – Roulette: payout odds
2035	L&W’s Responses and Objections to Evolution’s First Set of Interrogatories (Oct. 25, 2024) (excerpts)
2036	Lightning Roulette Game on Evolution’s Website <a href="https://www.evolution.com/games/lightning-roulette/">https://www.evolution.com/games/lightning-roulette/</a>
2037	Evolution Gaming Wins Product Innovation of the Year at G2E, Real Money Action (Oct. 12, 2018)
2038	<i>The 2018 Global Gaming Awards Las Vegas Categories</i> <a href="https://stargambling.net/news/global-gaming-awards-2018-vegas.html">https://stargambling.net/news/global-gaming-awards-2018-vegas.html</a> (last visited Sep. 23, 2025).
2039	<i>Evolution and Scientific Games Strike Land-based Lightning Roulette Deal</i> , PR NEWSWIRE (May 27, 2021), <a href="https://www.prnewswire.com/news-releases/evolution-and-scientific-games-strike-land-based-lightning-roulette-deal-301300565.html">https://www.prnewswire.com/news-releases/evolution-and-scientific-games-strike-land-based-lightning-roulette-deal-301300565.html</a>
2040	Plaintiffs’ Motion for Reconsideration of Order Compelling Arbitration (ECF 163), No. 2:24-cv-00993 (D. Nev. Oct. 10, 2025), ECF 164
2041	Casey Decl. re: ’014 patent
2042	[RESERVED]
2043	[RESERVED]
2044	D. Lubin, <i>The Essentials of Casino Game Design</i> (2016)
2045	Friedman Dep. Tr.
2046	Dkt. No. 176, Order Granting the Defendants’ Motion to Dismiss, <i>Evolution Malta Limited v. Light &amp; Wonder, Inc.</i> , No. 2:24-cv-00993-CDS-NJK (D. Nev. March 30, 2026)

Patent Owner Evolution Malta Limited respectfully requests that the Board vacate its institution decision and terminate this IPR without entering a final written decision. On March 30, 2026, the Nevada district court granted Petitioner Light & Wonder, Inc.’s (“L&W”) motion to dismiss, finding U.S. Patent Nos. 10,629,024, 11,011,014, and 11,756,371 invalid for being directed to patent ineligible subject matter under 35 U.S.C. § 101. EX2046. In view of the court’s decision, maintaining this IPR is an inefficient use of the Board’s resources, and the IPR should be de-instituted and terminated. *Sinclair Pharma Limited v. Hydrafacial LLC*, IPR2025-00145, Paper 41 (Squires, Feb. 12, 2026); *Hulu, LLC v. Piranha Media Distribution, LLC*, IPR2024-01252, Paper 27 (Stewart, Apr. 17, 2025) (informative).

**I. L&W Chose to Litigate Validity in District Court, Which Has Now Adjudicated Validity Substantially Earlier Than the Board Is Expected To**

Evolution filed a patent infringement action in Nevada against L&W on May 28, 2024. EX1015, 1. From the start of the litigation, L&W chose to aggressively pursue invalidity in district court and prioritized doing so over filing this IPR. L&W filed this IPR on May 30, 2025, just days before § 315(b)’s 1-year bar. Before submitting the petition, L&W made numerous filings in the parallel litigation, including: a first motion to dismiss under § 101 (filed July 24, 2024), invalidity and non-infringement contentions (Nov. 12, 2024), and a second motion

to dismiss under § 101 (May 15, 2025). *See* EX1022, 1; EX2018. The parties also had a court mandated settlement conference on April 9, 2025. EX2021. The parties have been litigating validity in district court for almost two years now.

The district court case is well ahead of this IPR. On March 30, 2026, the Nevada district court granted L&W's motion to dismiss, finding the challenged claims invalid under § 101. The district court dismissed Evolution's patent infringement claims with prejudice, including every challenged claim in this IPR. EX2046. In contrast, a final written decision in the IPR is not due until December 17, 2026. Thus, the district court adjudicated validity almost nine months earlier than the Board is expected to.

## **II. Office Policy Provides that Institution Should Be Vacated and an IPR Terminated When Another Forum Has Found the Claims Invalid**

It is the Office's policy to manage IPR proceedings with the goal of improving PTAB efficiency, maintaining PTAB capacity to conduct AIA proceedings, and reducing pendency in *ex parte* appeals. Interim Processes for PTAB Workload Management (Mar. 26, 2025). To that end, the Office has found that where another forum has already adjudicated the validity or patentability of challenged patent claims, it is an inefficient use of PTO and Board resources to review those claims for patentability on other grounds. *Id.* The Office has applied this rationale both to deny and to decline to maintain IPRs where the challenged

claims have been found invalid by another tribunal, regardless of whether that decision is subject to a pending appeal.

In *Hulu, LLC v. Piranha Media Distribution, LLC*, a decision designated as Informative, the Acting Director vacated an institution decision in view of a district court's finding of invalidity under § 101. IPR2024-01252, Paper 27 (Apr. 17, 2025). The Acting Director explained that “where a district court already has found the challenged claims invalid, the efficiency and integrity of the patent system is best served by denying institution.” *Id.*, 3. The Office has reached that same conclusion in multiple proceedings where the district court's decision was still subject to appeal. *E.g.*, *Shopify Inc. v. DKR Consulting LLC*, IPR2025-00130, Paper 10, 7-8 (May 29, 2025); *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, 5-6 (June 2, 2025).

Although *Hulu* concerned discretionary denial at the institution stage, the Acting Director's reasoning in that case applies to post-institution as well. The *Hulu* decision reflects the Office's broader policy that continuing PTAB proceedings after a judicial invalidity determination undermines the efficiency and integrity of the patent system and the Office.

The Office has applied its policy of not reviewing claims that another forum has found invalid in the post-institution context as well. For example, in *Sinclair*

*Pharma Limited v. Hydrafacial LLC*, the Director de-instituted an IPR eight months after it was instituted in view of a subsequent invalidity determination by the ITC. *See* IPR2025-00145, Paper 41. In *Sinclair*, the Board instituted an IPR on June 2, 2025. *See* IPR2025-00145, Paper 12. On August 25, 2025, an ITC administrative law judge (ALJ) found the challenged claims of the patent invalid. *Id.*, Paper 42, 3-4 (Pet’r Rehr’g Req., Mar. 16, 2026). After the patent owner filed its response and the petitioner filed its reply, the Director *sua sponte* initiated Director Review of institution in view of the ALJ’s invalidity decision. Paper 40. On February 12, 2026, the Director “determine[d] this IPR should be de-instituted because the ITC already has adjudicated validity of the challenged patent based on the same challenges asserted in this IPR.” IPR2025-00145, Paper 41. As the Director noted, it would have been an inefficient use of the Office’s resources to continue the IPR in those circumstances, and thus, the Director vacated the institution decision and terminated the IPR.

### **III. The Institution Decision Should Be Vacated and the IPR Terminated Because the Nevada Court Has Now Found All Claims Invalid**

The institution decision here should be vacated and this IPR terminated because the district court found all of the patent claims challenged in this IPR to be invalid. In this scenario, for the same reasons that the Board has terminated IPRs in related contexts, it would be inefficient for the Board to maintain this

proceeding and review the patentability of the challenged claims under other grounds.

Substantial efficiency can be achieved by terminating this IPR. This proceeding is still in early stages of the trial phase, well ahead of where *Sinclair* was when institution was vacated. Here, only Due Date 1 (Patent Owner Response) in the Scheduling Order has been reached. Due Date 2 (Petitioner's Reply) is not until June 3, 2026, and Due Date 8 (oral argument) is not until September 16, 2026. Beyond the institution decision, the Board has not yet needed to make significant investments in this case. In contrast, the district court has already adjudicated validity and dismissed Evolution's patent infringement claims. EX2046. Terminating the IPR now would conserve both Board and party resources and avoid duplicative work.

L&W may argue that the IPR should not be terminated because Evolution can appeal the district court's decision and the Federal Circuit may ultimately reverse. The patent owner in *Hulu* made that same argument, and the Acting Director rejected it. She explained that, "[i]n the event the Federal Circuit reverses the district court's decision, Petitioner may raise such invalidity arguments in the district court on remand. Under these circumstances, that is the better and more efficient approach." *Id.*, 2-3. The Office has applied the same rationale in multiple cases where the district court's § 101 decision was still subject to appeal. *E.g.*,

*Shopify*, IPR2025-00130, Paper 10, 7-8 (denying institution where district court found claims invalid under § 101 and the appeal was pending); *Google*, IPR2025-00586, Paper 12 (same); *Highlevel*, IPR2025-00235, Paper 11, 5-6 (same). The Acting Director’s rationale in *Hulu* applies equally to this case.

In its invalidity contentions in district court, L&W includes the same three references—Kido (EX1007), Yee (EX1009), Barron (EX1008)—and same anticipation and obviousness grounds it has asserted in this IPR. EX2018, 6-7; EX2019, 7-10. L&W has not advanced any unique arguments in this IPR that it cannot raise in court. In fact, in its contentions, L&W has advanced thousands of grounds of invalidity based on 31 primary references and numerous additional secondary references. EX2019, 7-9, 19-37. Therefore, if the district court’s § 101 decision is reversed, L&W will have an expansive set of invalidity grounds from which it can choose, including the exact same grounds raised in this IPR. And by vacating the institution decision, no estoppel under § 315(e)(2) will apply to L&W. Thus, as in *Hulu*, L&W would not suffer material prejudice from termination of this IPR.

#### **IV. Conclusion**

Accordingly, Evolution requests that the Board vacate the institution decision and terminate this proceeding.

Dated: April 24, 2026

Respectfully submitted,

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**CERTIFICATE OF SERVICE**

I hereby certify that on this 24th day of April, 2026, copies of this Patent Owner's Motion to Terminate have been served on the following counsel of record for Petitioner Light & Wonder, Inc.:

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