

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

In re *Inter Partes* Review of:

U.S. Patent No. 7,927,206

For: Gaming Device Having A Re-triggering
Symbol Bonus Scheme

DECLARATION OF SCOTT BENNETT

Mail Stop PATENT BOARD

Patent Trial and Appeal Board

US Patent and Trademark Office

PO Box 1450

Alexandria, Virginia 22313-1450

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I, Scott Bennett, Ph.D., resident of Urbana, Illinois, hereby declare as follows:

I. INTRODUCTION AND QUALIFICATIONS

1. I have been retained by Covington & Burling LLP to provide my opinions concerning the public availability of certain documents at issue in *inter partes* review proceedings for U.S. Patent No. 7,927,206.

2. My curriculum vitae is Attachment A (Exhibit 1021 to Petition). From 1956 to 1960, I attended Oberlin College, where I received an A.B. in English. I then attended Indiana University, where I received an M.A. in 1966 and a Ph.D. in 1967, both in English. In 1976, I received a M.S. in Library Science from the University of Illinois. I also served at the University of Illinois at Urbana-Champaign in two capacities. First, from 1967 to 1974, I was an Assistant Professor of English; then from 1974 to 1981, I was an Instructor, Assistant Professor, and Associate Professor of Library Science.

3. From 1981 to 1989, I served as the Assistant University Librarian for Collection Management, Northwestern University. From 1989 to 1994, I served as the Director of The Milton S. Eisenhower Library at The Johns Hopkins University. From 1994 to 2001, I served as the University Librarian at Yale University. In 2001, I retired from Yale University.

4. Since then, I have served in multiple capacities for various organizations, including as a consultant on library space planning from 2004 to the

present, as a Senior Advisor for the library program of the Council of Independent Colleges from 2001 to 2009, as a member of the Wartburg College Library Advisory Board from 2004 to the present, and as a Visiting Professor at the Graduate School of Library and Information Science, University of Illinois at Urbana-Champaign, in the Fall of 2003. I was a founding partner of Prior Art Documentation Services, LLC, in 2015.

5. Over the course of my work as a librarian, professor, researcher, and author of numerous publications, I have had extensive experience with cataloging and online library management systems built around Machine-Readable Cataloging (MARC) standards. As a consultant, I have substantial experience in authenticating documents and establishing the date when they were available to persons exercising reasonable diligence.

6. In the course of more than fifty years of academic life, I have myself been an active researcher. I have collaborated with many individual researchers and, as a librarian, worked in the services of thousands of researchers at four prominent research universities. Members of my family are university researchers. Over the years, I have read some of the voluminous professional literature on the information seeking behaviors of academic researchers. And as an educator, I have a broad knowledge of the ways in which students in a variety of disciplines

learn to master the bibliographic resources used in their disciplines. In all of these ways, I have a general knowledge of the how researchers work.

7. My work in this matter is being billed at my standard consulting rate of \$88 per hour. My compensation is not in any way contingent upon the outcome of this or any other *inter partes* review. I have no financial or personal interest in the outcome of this proceeding or any related litigation.

II. SCOPE OF THIS DECLARATION

8. I am not a lawyer and I am not rendering an opinion on the legal question of whether any particular document is, or is not, a “printed publication” under the law.

9. I am, however, rendering my expert opinion on when and how each of the documents addressed herein was disseminated or otherwise made available to the public and the extent to which persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, could have located the documents before October 15, 2001.

10. I reserve the right to supplement my opinion in the future to respond to any arguments that the Patent Owner raises and to take into account new information as it becomes available.

III. MATERIALS CONSIDERED IN FORMING MY OPINION

11. In forming the opinions expressed in this declaration, I have reviewed Frank Legato, “World of Slots ’99,” Casino Journal, Vol. 12, No. 9 (September 1999) and the attachments referenced below. Each item is a type of material that experts in my field would reasonably rely upon in forming their opinions.

12. The following Attachments are true and accurate representations of library materials and online documents and records, as they are identified below. All attachments were secured on 24 August – 2 September 2016. All URLs were available on 9 September 2016. The documents were secured, at my request, by Helen Sullivan, a Managing Partner in Prior Art Documentation Services LLC (see <http://www.priorartdocumentation.com/hellen-sullivan/>). Ms. Sullivan’s primary responsibility in our partnership is to secure the bibliographic documentation used in attachments to our declarations.

- **Attachment 1a (Ex. 1021 to Petition):** Statewide Illinois Library Catalog record for Casino Journal (secured on 24 August 2016 from a password protected online service of the University of Illinois at Urbana-Champaign);
- **Attachment 1b (Ex. 1022 to Petition):** University of Central Florida Library catalog record for Casino Journal (secured on 2 September 2016 at

<https://ucf.catalog.fcla.edu/cf.jsp?t1=casino+journal&k1=ti&avli=&ADV=S&V=D&S=0981473430064461&I=0#top>);

- **Attachment 1c (Ex. 1023 to Petition):** Copy of Frank Legato, “World of Slots ’99,” Casino Journal, Vol. 12, No. 9 (September 1999): 56-94, from the University of Central Florida (secured on 2 September 2016 from Joanie Reynolds, Interlibrary Loan and Document Delivery Services, University of Central Florida Libraries at <http://library.ucf.edu/about/departments/interlibrary-loan/>); and
- **Attachment 1d (Ex. 1024 to Petition):** Copy of excerpt (page. 62) of Frank Legato, “World of Slots ’99,” Casino Journal, Vol. 12, No. 9 (September 1999): 62, from Northeastern State University (secured on 2 September from Misti Hanrahan, the InterLibrary Loan/Document Delivery department at Northeastern State University at <http://library.nsuok.edu/ill/>)

IV. **BACKGROUND INFORMATION**

13. *Persons of ordinary skill in the art.* I am told by counsel for Petitioner that the subject matter of this proceeding relates to casino gaming devices.

14. I am told by counsel for Petitioner that persons of ordinary skill in this subject matter or art (“POSA”) would have at least three to five years of

experience with designing and developing gaming device systems with electronic displays. A POSA's experience would also include working with a multi-disciplinary team including creative artists, mechanical and electrical engineers, and regulatory specialists to develop a working, approvable gaming device.

15. In my opinion, in the 1990s and early 2000s, a POSA would have had access to a vast array of long-established print resources regarding the gaming industry and electrical/mechanical engineering as well as to a rich and fast changing set of online resources providing indexing information, abstracts, and full text services for gaming industry and electrical/mechanical engineering. These materials would include industry magazines such as Casino Journal.

16. *Library catalog records.* WorldCat is the world's largest public online catalog, maintained by the Online Computer Library Center, Inc., or OCLC, and built with the records created by the thousands of libraries that are members of OCLC. WorldCat records appear in many different catalogs, including the Statewide Illinois Library Catalog.

17. *Periodical publications.* A library typically creates a catalog record for a periodical publication when the library receives its first issue. When the institution receives subsequent issues/volumes of the periodical, the issues/volumes are checked in (often using a date stamp), added to the institution's holdings

records, and made available very soon thereafter—normally within a few days of receipt or (at most) within a few weeks of receipt.

18. The initial periodicals record will sometimes not reflect all of the subsequent changes in publication details (including minor variations in title, etc.).

V. CONSIDERATION OF INDIVIDUAL DOCUMENTS

A. Frank Legato, “World of Slots ’99,” Casino Journal, Vol. 12, No. 9 (September 1999): 56-94.

1. Authentication

19. “World of Slots ’99” is an article written by Frank Legato and published in the September 1999 (Volume 12, No. 9) issue of Casino Journal. This article is herein referred to as “Legato.”

20. Attachment 1a (Ex. 1021 to Petition) is a true and accurate copy of the Statewide Illinois Library Catalog record for Casino Journal. This records shows that Casino Journal is held by 45 libraries world-wide. An ordinarily skilled researcher would have no difficulty identifying and locating library copies of this periodical. Further, Attachment 1a appears to show that the September 1999 (Volume 12, No. 9) issue of Casino Journal is held by multiple libraries world-wide. An ordinarily skilled researcher would have no difficulty identifying and locating library copies of the September 1999 (Volume 12, No. 9) issue of Casino Journal.

21. The University of Central Florida is one library holding this periodical. Attachment 1b (Ex. 1022 to Petition) is a true and accurate copy of the University of Central Florida Library catalog record for Casino Journal, showing that the University of Central Florida holdings for Casino Journal include volume 12, number 9.

22. Attachment 1c (Ex. 1023 to Petition) is a true and accurate copy, in black and white, of Legato from the University of Central Florida Library. Attachment 1c includes the cover, table of contents, some preliminary matter, and the Legato article on pp. 56-94. Many full and partial-page ads appear within the sequence of pages for the Legato article. Attachment 1c is in a condition that creates no suspicion about its authenticity. Specifically, there are no visible alterations to the document, and Attachment 1c was found within the custody of a library – a place where, if authentic, it would likely be.

2. Public accessibility

23. Attachment 1c (Ex. 1023 to Petition) includes a library date stamp indicating that the September 1999 issue of Casino Journal was processed at the University of Central Florida Library on October 4, 1999. Based on my experience, I affirm this date stamp has the general appearance of date stamps that libraries have long affixed to periodicals in processing them. I do not see any

indications or have any reason to believe this date stamp was affixed by anyone other than library personnel on or about the date indicated by the stamp.

24. I infer from this date stamp that this issue of Casino Journal was accessible to readers at the University of Central Florida Library no later than mid-October 1999.

25. This date stamp indicates the September 1999 issue of Casino Journal had been mailed to the University of Central Florida Library and to other subscribers (including other library subscribers) sometime before October 4, 1999, because it takes some time for the item to arrive at, and to be processed by, the library. I therefore conclude that the September 1999 issue of Casino Journal would have been received by other subscribers, and that other subscribing libraries would have processed and made this issue available to their readers at about the same time.

26. For example, Attachment 1d (Ex. 1024 to Petition) is a true and accurate copy, in color, of Legato from the Northeastern State University Library. This copy includes the cover, table of contents, some preliminary pages, and p. 62 only of Legato. The Northeastern State University Library was unwilling to copy Legato in its entirety for fear of violating copyright protections. The cover, journal table of contents, and pages 4 and 62 of Attachment 1d are substantively identical to the equivalent material in Attachment 1c, except that Attachment 1c was

reproduced in black and white. The table of contents in Attachment 1d includes a library date stamp indicating the September 1999 issue of Casino Journal was processed at the Northeastern State University Library on September 21, 1999, somewhat earlier than, but in the same time frame as, processing at the University of Central Florida Library.

VI. **CONCLUSION**

27. Based on the evidence presented here—publication in an easily identified periodical and library date stamps—**it is my opinion that Frank Legato, “World of Slots ’99,” Casino Journal, Vol. 12, No. 9 (September 1999) was available to the public, including persons interested and ordinarily skilled in the subject matter or art, at least by mid-October 1999.**

ATTESTATION

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statement were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statement may jeopardize the validity of the application or any patent issued thereon.



September 14, 2016

Scott Bennett, Ph.D.
Managing Partner
Prior Art Documentation Services LLC

Date