

DECEMBER 13, 2006

Planet Bingo, LLC v. GameTech Int'l, Inc.

No. 05-1476, Federal Circuit (Newman, Mayer, Rader)

The doctrine [of equivalents provides] additional coverage for the exclusive right to protect a patent holder in the event of an unforeseeable change [but it may not be expanded] beyond its purpose to allow recapture of subject matter excluded by a deliberate and foreseeable claim drafting decision.

On December 13, 2006, the Federal Circuit, inter alia, affirmed the district court's summary judgment that GameTech did not infringe U.S. Patents No. 5,482,289 and No. 5,727,786, which related to alternative methods of playing bingo by coupling numbers with additional "indicia" or "markings," such as colors or shading patterns, to produce more winning combinations for more prizes. The Federal Circuit stated:

The district court determined that GameTech did not infringe either literally or under the doctrine of equivalents because the accused device does not determine the winning combination until after the first bingo ball is drawn; i.e., until after the game begins. This court affirms the district court's ruling that Rainbow Bingo does not literally infringe these claims because it does not determine the winning combination until after drawing the first ball. Rainbow Bingo certainly contains a "progressive . . . predetermined winning combination," indeed it would be impossible to play without one. However, the '289 and '786 patents use this term to set that winning combination before the game begins. In this sense, Rainbow Bingo does not disclose to a player the predetermined winning combination until after the game is underway. Thus, Rainbow Bingo does not contain a necessary limitation. The district court correctly found that GameTech does not literally infringe the claims.

Asserting infringement under the doctrine of equivalents, Planet Bingo argues that the Rainbow Bingo game incorporates only an insubstantial variation from the claims because the progressive predetermined winning combination appears right after, rather than right before, the first bingo ball is drawn. Equivalents are questions of fact reviewed under the clearly erroneous standard. Planet Bingo bears the burden of showing that the accused method may perform substantially the same step, in substantially the same way, with substantially the same result.

According to Planet Bingo, the timing of the predetermined winning combination does not affect the game's prize amounts, odds, or other essential characteristics. Further, Planet Bingo argues, players of Rainbow Bingo will know of the blue, purple, ruby, and emerald progressive combinations before the first bingo ball is drawn. The only thing, argues Planet Bingo, that a player of Rainbow Bingo will not know before the first bingo ball is drawn is where those progressive combinations will be locked in. GameTech in turn argues that waiting for the first ball to be drawn does make a substantial difference in the game because it increases the excitement.

The district court found, contrary to Planet Bingo's assertion, that "after" and "before" are very different. The district court determined that it could not substitute this change without ignoring entirely the claim limitation. The district court also relied on a line of cases from this court construing the doctrine of equivalents "narrowly." The district court determined that the game method in which the winning combination is not known until after the game begins cannot be equivalent to a game method where this occurs before because "after is opposite of before, not equivalent."

[T]he doctrine of equivalents must not expand to eliminate a claim element entirely. The doctrine does provide additional coverage for the exclusive right to protect a patent holder in the event of an unforeseeable change. Here, the patents contain a distinct limitation, which was part of the bargain when the patent issued. This court cannot overlook that limitation or expand the doctrine of equivalents beyond its purpose to allow recapture of subject matter excluded by a deliberate and foreseeable claim drafting decision.

[I]n this case, the difference in timing creates a difference of knowing the winning combination before the game starts or after the game starts. Rainbow Bingo always determines the winning combination after start of the game. Therefore, it cannot be "predetermined." This court upholds the district court's refusal to find infringement by equivalents.

For more information on these issues or other intellectual property law matters, please contact Lawrence M. Sung, Ph.D. at lsung@nixonpeabody.com or (202) 585-8221.

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