Keywords: Claim construction; infringement; doctrine of equivalents; "predetermined"

General: The doctrine of equivalents does not apply when an accused device contains the antithesis of the claims, and the doctrine does not apply when the subject matter was either foreseeable or deliberately excluded. No infringement was found under the doctrine of equivalents because the term "predetermined" was found to be limiting.

Planet Bingo, LLC v. GameTech International, Inc.
No. 05-1476 (Fed. Cir., 2006)
Decided December 13, 2006

I. Facts

Planet Bingo, LLC (Planet Bingo) is the exclusive licensee of both U.S. Patent No. 5,482,289 (the '289 patent) and U.S. Patent No. 5,727,786 (the '786 patent). The patents claim alternative methods of playing bingo by coupling numbers with additional markings, such as colors or shading patterns. The additional markings overlay a traditional bingo game to produce more possible winning combinations for more prizes. For example, a player may achieve a classic bingo (e.g., a straight line) and then achieve another winning combination with an additional marking (e.g., a straight line that is also all red). The additional markings may either be on the bingo balls, as in the '289 patent, or with a marked bingo flashboard, as in the '786 patent.

GameTech International, Inc. (GameTech) began to exhibit their own version of bingo at trade shows. The accused version, "Rainbow Bingo," also includes an additional layer of markings, with different colors assigned to the columns of a bingo matrix, and different figures assigned to the rows. The "Rainbow Bingo" game determines the additional winning combinations only after drawing the first bingo ball.

Planet Bingo brought suit against GameTech in the District of Nevada for infringement of certain claims in the '289 and '786 patents. GameTech asserted that their Rainbow Bingo does not establish a "progressive … predetermined winning combination," which is a limitation in both the '289 and '786 patents. A magistrate judge held a *Markman* hearing and construed the claim limitations in favor of GameTech. The district court later adopted this claim construction to support its finding that GameTech did not infringe either literally or under the doctrine of equivalents because the accused Rainbow Bingo does not determine the winning combination until *after* the first bingo ball is drawn.

II. Issue

1. Did the district court properly find that GameTech's Rainbow Bingo did not literally infringe the '289 and '786 patents?

2. Did the district court properly find that GameTech's Rainbow Bingo did not infringe the '289 and '786 patents under the doctrine of equivalents?

III. Discussion

1. Yes. The district court properly construed the limitation "progressive … predetermined winning combination" to mean the precise elements necessary to achieve bingo in a particular game are known before the first bingo ball is drawn. The Federal Circuit looked to the claim

language, the claim preamble, the specification, and the summary to find meaning in the word "predetermined."

Claim language – In analyzing claim language, the Federal Circuit found that the claims recite a "predetermined winning combination," and not "predetermined rules" for identifying a winning combination. For example, while the *rules* may dictate that a "red bingo" will be an additional win, the *winning combination* is more specific and may identify particular squares, colored red, that will produce the additional win. So although Planet Bingo had argued that "predetermined winning combination" merely requires that the participants in the game know, before the start of play, the predetermined rules for winning with an additional combination, the Federal Circuit found that this argument is not supported by claim construction analysis since the claims could have recited "predetermined rules" rather than "predetermined winning combination."

Preamble – The preamble of the '289 claim calls for "a game" of bingo, which means that the "predetermined winning combination" is established for an individual game, rather than rules for the overall play.

Specification – The specifications of both the '289 and '786 patents also explain that the game determines the "winning combination" before the first bingo ball is drawn, thus making it "predetermined."

Summary – The summary for the '786 patent states that a predetermined group of bingo numbers was to be selected at the beginning of each game.

The Federal Circuit concluded that the '289 and '786 patents use "predetermined winning combination" to set the winning combination before the game begins. Rainbow Bingo does not disclose to the player the winning combination until after the game is underway. Thus, Rainbow Bingo does not contain that limitation and does not literally infringe.

2. Yes. The district court did not clearly err in refusing to find infringement by the doctrine of equivalents because the determination of the winning combination after the first bingo ball is drawn was more than an insubstantial variation from the claims. In discussing whether revealing the winning combination before or after the game would be an insubstantial variation, the Federal Circuit quotes the district court in stating that "after is opposite of before, not equivalent." On the subject of opposites, the Federal Circuit stated that "this court has refused to apply the doctrine in other cases where the accused device contained the antithesis of the claimed structure."

   Further, since "predetermined winning combination" is an element of the claims, the Federal Circuit refused to "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." The discussion on foreseeability suggested that while the disputed differences in technically complex inventions may be less foreseeable, differences in less technical inventions, such as a bingo game, would be more foreseeable.

   Note
   Additionally, GameTech had challenged that a prior art bingo game, Hotball, anticipated Planet Bingo's patents. The Federal Circuit upheld the district court's holding that claims 2 and 5 of the '289 patent are invalid because they are anticipated by Hotball.