

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PLR WORLDWIDE SALES LIMITED,

Petitioner,

v.

FLIP PHONE GAMES, INC.,

Patent Owner.

Case No. IPR2024-00132

U.S. Patent No. 9,731,202

PETITIONER'S PRELIMINARY REPLY

EXHIBIT LIST

Ex.	Description
1001	U.S. Patent No. 9,731,202 (“’202 patent”)
1002	File History for U.S. Patent No. 9,731,202
1003	Declaration of Dr. José Zagal
1004	<i>Curriculum Vitae</i> of Dr. José Zagal
1005	U.S. Patent Pub. No. 2008/0102947 (“Hays”)
1006	U.S. Patent Pub. No. 2007/0174490 (“Choi”)
1007	U.S. Patent No. 7,698,178 (“Chu”)
1008	U.S. Patent Pub. No. 2007/0088801 (“Levkovitz”)
1009	U.S. Patent No. 9,129,301 (“van Datta”)
1010	Steven Kent, <i>The Ultimate History of Video Games</i> (2001)
1011	Frans Mayra, “Mobile Games,” in the <i>International Encyclopedia of Digital Communications and Society</i> , 1st ed. (2015)
1012	N. Leavitt, “Will wireless gaming be a winner?” in <i>Computer</i> , Vol. 36, No. 1, pp. 24-27 (Jan. 2003)
1013	Jason Soh & Bernard Tan, “Mobile Gaming,” in <i>Communications of the ACM</i> , Vol. 51, No. 3, pp. 35-39 (Mar. 2008)
1014	Michael Zyda et al., “Educating the Next Generation of Mobile Game Developers,” in <i>IEEE Computer Graphics and Applications</i> , Vol. 27, No. 2, pp. 92-96 (Mar./Apr. 2007)
1015	Mark Andrejevic, “Productive Play 2.0: The Logic of In-Game Advertising” in <i>Media International Australia</i> , Vol. 130, No. 1, pp. 66-76 (Feb. 2009)

1016	Ilya Vedrashko, Advertising in Computer Games (Doc. No. 123290221) [Master's Thesis, Mass. Inst. of Technology], DSpace@MIT
1017	Exit Games, In-Game Advertising Goes Mobile [Press Release] (Mar. 21, 2006)
1018	Jussi-Pekka Partanen, Mobile Gaming: A Framework for Evaluating the Industry 2000-2005 (2001)
1019	<i>Samsung Electronics Co. v. Lynk Labs, Inc.</i> , IPR2022-00149, Paper 33 (PTAB June 26, 2023)

The Preliminary Response is devoted almost entirely to discretionary denial-based arguments. Though they all lack merit, the Board has granted permission to address two. *First*, Section 325(d) does not warrant denial because Hays and Levkovitz are not substantially the same as art cited during prosecution. *Second*, Petitioner’s claim construction positions are not inconsistent.

I. SECTION 325(D) DOES NOT WARRANT DENIAL

PO incorrectly argues that two of the Petition’s five references—Hays and Levkovitz—are “substantially the same” as the Willis reference, though they were not cited or considered by the examiner.

As an initial matter, PO’s 325(d) arguments apply **only** to Grounds 1 and 5. Grounds 2-4 and 6-7 rely on additional art—Choi, Chu, and van Datta. PO does **not** raise any 325(d) arguments for those references; thus, on this basis alone, 325(d)-based denial is inappropriate.

With respect to Grounds 1 and 5, PO’s 325(d) analysis fails to meet the standard for discretionary denial. In determining whether a Petition’s art is “substantially the same prior art,” PO must establish that “Petitioner relies on [the new art] in substantially the same manner as the Examiner cited [the previous art] during prosecution such that [the new art] discloses substantially the same information as [the previous art] in relevant part.” *Advanced Bionics, LLC v. MED-*

EL Elektromedizinische Geräte GmbH, IPR2019-01469, Paper 6 at 15 (P.T.A.B. Feb. 13, 2020) (precedential). PO has failed to do this.

Indeed, Hays and Levkovitz disclose the very limitations that were the basis for allowance. The Board held that in Willis, “advertising content is sent based on the **physical geographic location of the gamer**,” and “not **based on the console type**” as recited by the claims. Ex. 1002, 42; Pet. 4. Contrary to PO’s assertion (POPR 21), the Petition expressly states that Hays and Levkovitz, **unlike** Willis, “disclose a server selecting an advertisement **based on the type of the mobile communication device**.” Pet. 4; 17-20, 46-47.

Patent Owner nonetheless argues that both Hays and Levkovitz “provide advertisements to recipients based **in part** on their location.” POPR 21. But the Petition relies on Hays and Levkovitz for their disclosures that advertisements are provided based on **device/console type**. See Pet. 17-20, 46-47. For example, Hays discloses that the mobile device’s request for advertisements “indicates the **client type** ... which includes **a type of game console**,” and that the server “calculate[s] [a] weight of each advertisement based on ... the specific **client type**.” Ex. 1005, ¶¶40, 43; Pet. 17. These weights are used to “check[] which advertisement ... to send.” Pet. 18 (citing Ex. 1005, ¶43). Similarly, Levkovitz discloses that “the ad server may selectively serve content items ... based on parameters related to the mobile phone (i.e., device type), e.g., **manufacturer identifier, model identifier** ...” Ex.

1008, ¶6; Pet. 46-47. Thus—unlike Willis—Hays and Levkovitz both expressly disclose serving advertisements based on device type. Had the Examiner been aware of Hays and Levkovitz, the claims would not have been allowed.

PO also argues that the “ten-year examination ... weighs heavily against institution,” citing to *Juniper Networks*, POPR 19. However, as *Juniper* makes clear, prosecution length is only a factor “where some of the references were at issue.” *Id.* at 10 n.5; CBM2016-0075, Paper 16 at 8 (“[T]hose references were presented to **and extensively considered** by the Office.”). None of the references here were considered by the Office and, as explained, they are materially different from those that were.

II. THERE IS NO INCONSISTENT CLAIM CONSTRUCTION HERE

PO argues that the Petition should be denied for “abuse of process” because Petitioner has taken inconsistent claim construction positions in the District Court. POPR 23-28. But Petitioner’s positions are not inconsistent.¹

It is axiomatic that one may “ascribe some meaning” to a term that is nevertheless indefinite. *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898 (2014); *Interval Licensing, LLC v. AOL, Inc.*, 766 F.3d 1364, 1371-72 (Fed. Cir.

¹ Indeed, the Petition states that it takes “no position ... as to whether the claims are indefinite.” Pet. 14; *see also* Ex. 1003, ¶¶72-73.

2014) (terms indefinite for lack of objective boundaries). As a result, the Board “need not necessarily determine the outer boundaries of a claim” to decide “whether the asserted prior art anticipates a claim or renders it obvious.” *Mylan Pharms. Inc. v. Horizon Pharma USA*, IPR2017-01995, Paper 72 at 5-6 (Mar. 28, 2019); *Standard Oil Co. v. American Cyanamid Co.*, 774 F.2d 448, 453 (Fed. Cir. 1985) (affirming indefiniteness and obviousness).

Here, the claims require delivering advertisements based on indefinite “factors.”² The claim goes on to ***expressly identify*** three examples of such “factors.” The Petition identifies those examples in the prior art. Thus, there is nothing inconsistent with arguing in the litigation that the full scope of the claim is undetermined, while arguing here that the ***specific examples*** expressly set forth in the claims are found in the prior art.

Even if Petitioner’s claim constructions were inconsistent, denial would nevertheless be inappropriate. The Board has consistently found that Petitioner may rely on a construction it believes is incorrect. *Western Digital Corp. v. SPEX Techs., Inc.*, IPR2018-00082, Paper 11 at 12 (Apr. 25, 2018) (“Petitioner [need not] express

² Petitioner initially identified several terms as indefinite as a placeholder position pending PO’s contentions, but Petitioner has since dropped most of those positions. Petitioner asserts indefiniteness only for the term “one of the factors.”

its subjective agreement regarding correctness of its proffered claim constructions”); *Philip Morris Products, S.A. v. Rai Strategic Holdings, Inc.*, IPR2020-00921, Paper 13 at 42-44 (Aug. 5, 2021) (“[A] petitioner [need not] express a subjective belief in the correctness of its proffered claim constructions, [and can] rely[] on claim constructions that it believes are incorrect.”).

None of the decisions Patent Owner relies on hold otherwise. In *Resmed* and *Kiosoft*, the Board held that in the context of *Fintiv* Factor 6 regarding the **merits** of the Petition, inconsistent positions favored denial. But as explained by Petitioner, which Patent Owner does not dispute, the *Fintiv* factors overall do not favor denial. Pet. 59-60. In *Comcast*, the Board denied CBM review because of a means-plus-function claim construction issue that was not raised in a parallel IPR proceeding and was “central” to both trials. CBM2018-00033, Paper 9, at 7, 11. But the terms at issue here are not means-plus-function terms, nor are they central to this trial. *Facebook* similarly turned on Petitioner’s failure to construe means-plus-function terms pursuant to 37 C.F.R. § 42.104(b)(3). IPR2017-00998, Paper 13, at 16-17. No means-plus-functions terms are at issue here. The Board also faulted Petitioner for failing to disclose its district court claim construction positions. *Id.*, at 17. Here, however, Petitioner’s claim construction positions were not made or disclosed until nearly three months **after** the Petition was filed. Ex. 2001 (dated January 30, 2024).

For the foregoing reasons, institution should not be denied.

Date: March 5, 2024

Respectfully submitted,

By: /s/ James M. Glass
James M. Glass

Counsel for Petitioner

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on March 5, 2024, true and correct copies of the foregoing document were served in its entirety on the following parties via Electronic Mail

mmorlock@kilpatricktownsend.com
jlee@kilpatricktownsend.com
arinehart@kilpatricktownsend.com
kkoballa@kilpatricktownsend.com

Date: March 5, 2024

By: /s/ James M. Glass
James Glass
QUINN EMANUEL URQUHART
& SULLIVAN, LLP
51 Madison Avenue, 22nd Floor
New York, NY 10010
Tel: (212) 849-7000
Fax: (212) 849-7100

Counsel for Petitioner