

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. IPR2023-00132

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

PETITIONER'S REPLY

TABLE OF CONTENTS

I.	Introduction	1
II.	Dr. Zagal’s Testimony Should be Given Due Weight	1
III.	Ground 1: Hays Renders Claims 1-9 Obvious.....	2
	A. 1[b]: “checking what ... content to send based on ... factors”.....	2
	B. 1[a]/1[c]: “usable”.....	5
	C. 1[c]: “updated video-game content”.....	7
	D. Claim 4: “providing an in-game placement location ”.....	8
	E. Claim 5: “tracking what has been uploaded”.....	10
	F. Claim 6: “displaying ... based on user interaction”.....	11
IV.	Ground 2: Hays and Choi Render Claims 1-9 Obvious	13
	A. 1[b]: “checking what updated video-game content to send”.....	13
	B. Motivation to Combine Hays and Choi.....	14
V.	Ground 3: Hays and Chu render Obvious Claim 4	16
	A. Chu discloses “providing an in-game placement location”.....	16
	B. Motivation to Combine Hays (or Hays-Choi) with Chu	16
VI.	Ground 4: Hays and Van Datta Render Obvious Claim 6.....	18
	A. Van Datta teaches displaying an advertisement “at a location based on user interaction”	18
	B. Motivation to Combine Hays (or Hays-Choi) with van Datta.....	19
VII.	Ground 5: Levkovitz Renders Obvious Claims 1-3 and 5-9	20
	A. 1[a]/1[c]: “for use” or “usable”	20
	B. 1[c]: “uploading updated video-game content”	20

C.	Claim 5: “tracking what has been uploaded”	21
D.	Claim 6: displaying content “at a location based on user interaction”	22
VIII.	Ground 6: Levkovitz and Chu Render Obvious Claim 4	23
IX.	Ground 7: Levkovitz and van Datta Render Obvious Claim 6.....	23
X.	PO Provides No Evidence of Secondary Considerations	24
XI.	§311(b)	25
XII.	Conclusion.....	25

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)
1020	Transcript of Deposition of Dr. Robert Akl, October 24, 2024
1021	International Pub. No. WO 2005/086969 A2

I. INTRODUCTION

Having failed to convince the Board to deny institution, PO now reframes its arguments as claim construction arguments, interpreting “checking” for content to require a compatibility determination with the device and “usable” content to require affect on gameplay. Yet PO fails to cite to any intrinsic or extrinsic evidence to support these unreasonably narrow constructions—and the specification provides numerous examples inconsistent with PO’s position.

PO’s remaining arguments primarily rely on mischaracterizing or ignoring clear and express disclosures found within the prior art. For example, PO argues that “transmit” and “serve” do not constitute “uploading.” These arguments lack credence. PO also repeatedly ignores Dr. Zagal’s testimony regarding motivation to combine, instead alleging some disadvantage with combining the references as a whole, which is immaterial to Petitioner’s proposed obviousness combinations.

II. DR. ZAGAL’S TESTIMONY SHOULD BE GIVEN DUE WEIGHT

Throughout its Response, PO asserts that “Dr. Zagal’s testimony is due little weight” because he “parrots the petition, nearly verbatim.” *See, e.g.*, POR 11. The Board rejected this argument, correctly deciding that it would “give [Dr. Zagal’s] testimony the appropriate weight on the points for which it is offered.” ID at 7 n.1. This is entirely consistent with *Xerox*, which gave little weight to “conclusory and

unsupported” testimony supporting a “conclusory assertion.” *Xerox*, at 15. Well-reasoned opinions, however, should be given proper weight.

III. GROUND 1: HAYS RENDERS CLAIMS 1-9 OBVIOUS

A. 1[b]: “checking what ... content to send based on ... factors”

Hays discloses “checking what ... to send” based on a device type and service provider. Pet. 17-20. Advertisements are selected using factors such as “the specific *client type*” or a user’s “IP address,” which is associated with a *service provider*. EX1005, ¶¶40, 43, 44; EX1003, ¶100.¹

Hays teaches factors related to the mobile device. PO argues that Hays uses “factors related to the advertisement” while the claim requires factors “related to the mobile communication device.” POR 9-10. PO is wrong and misinterprets Hays. Advertisements are expressly chosen based on “the specific client type” requesting the advertisement, which includes “a type of game console,” such as “cellular or mobile phones.” EX1005, ¶¶40, 51.

Hays also describes using the device’s IP address, which is a selection based on the service provider. EX1005, ¶44; Pet. 18. A device’s IP address is “related to the mobile communication device.” POR 9-10. PO even admits that “Hays describes ‘Internet service providers’ as an example of ‘demographic information about a gameplayer,’ which Hays may use in its weighting system.” POR 12. PO

¹ All emphases added unless noted otherwise.

argues that since such factors are used to “rank[] advertisements in comparison to other available advertisements,” they do not meet the checking limitation, but provides no explanation as to why. This argument appears to be related to PO’s argument that Hays selects advertisements using “factors associated with the advertisements” not “factors related to the mobile communication device,” which is wrong. POR 10.

PO’s narrow construction is unsupported. PO interprets the term to require checking “a compatibility determination with the user’s mobile device.” POR 10-11. Yet PO does not provide *any* claim construction analysis as required by the Federal Circuit. “Checking what ... to send” is an ordinary phrase with an ordinary meaning. PO provides no recognized rationale to depart from that ordinary meaning—they have not argued any disavowal or lexicography. *Thorner v. Sony Computer Entertainment America LLC*, 669 F.3d 1362, 1366 (Fed. Cir. 2011). The claim plainly does not require performing a check based on device compatibility—it can, for example, perform the check based on a service provider which is not related to device compatibility.

The ’202 patent’s specification also provides several examples of providing content without checking device compatibility. For example, “a particular service provider may wish to provide an initial message that thanks the user.” EX1001, 10:41-42. No compatibility check is described, nor would there to be one for a

simple message. The patent also describes “a particular service provider ... provid[ing] content that includes the service provider’s logo,” which also does not require checking compatibility.

Hays applies to mobile devices. PO criticizes Dr. Zagal’s testimony that a POSITA would “combine Hays’s teachings of weighing advertisements based on the type of game console ... and Hays’s teachings of various mobile communication devices that constitute game consoles.” POR 12-13 (quoting EX1003, ¶104). As explained by Dr. Zagal, such a combination is only necessary to the extent PO argues that these disclosures in Hays are from different embodiments, which PO does not assert. EX1003, ¶103; EX1005, ¶¶43, 51. Regardless, PO’s argument that “[a] POSITA would not have been motivated to apply a method for weighing advertisements to be sent to a game console to mobile devices” flies in the face of Hays’s express disclosure that a game console ***includes*** “cellular or mobile phones.” EX1005, ¶51 (“[T]he term ... ‘game console’ ... refers to any of the above devices ...”). Moreover, PO is simply incorrect that advertisements to game consoles could not apply to mobile devices because of “technical limitations at the time, including bandwidth, storage, and processing limitations” for the simple fact that at the time of the patent’s earliest filing date of 2007, there were several Internet-capable portable game consoles on the market that could easily render advertisements, including the PlayStation Portable (released in 2004) and the Nintendo DS (also

released in 2004). EX1020, 7:24-9:3 (testifying that portable consoles were available by 2005).

B. 1[a]/1[c]: “usable”

As explained in the Petition, Hays discloses advertisements usable “during gameplay,” such as “a game character ... holding a can of Pepsi and ask[ing] player if they would like a drink.” Pet. 21 (quoting EX1005, ¶¶21, 79).

PO interprets the term “usable” to require an effect on gameplay or game functionality and cannot merely be “skins.” Pet. 14-15. Again, PO provides this contrived definition without considering their ordinary meaning and without explaining why the Board should depart from it. The claims use ordinary words and convey their meaning clearly. Indeed, PO’s expert admits that its definition is inconsistent with the specification. For example, a shirt “might be updated to include a logo” or a poster “might advertise an upcoming movie.” EX1001, 6:47-50; EX1020, 26:3-18 (“[J]ust having something on a shirt ... that doesn’t disclose for use yet.”). The content could also be “displayed in a pop-up window” without affecting gameplay. *Id.*, 8:6-7.

Regardless, Hayes teaches that the advertisement affects gameplay, such as uploading a “bot[] or electronic agent[] ... or real character[] in the game,” such as “a game character ... holding a can of Pepsi and ask[ing the] player if they would like a drink.” EX1005, ¶79. The content is delivered to the game in a way that

affects gameplay—namely, an advertisement where the player has the option to drink the advertised product.

PO mischaracterizes this teaching as merely an “in-game can on which the skin of the brand Pepsi may be displayed” which does not otherwise “alter[] the functionality of the game based on whether a Pepsi ad is displayed on this particular unit versus if the can were left blank or displayed a fictional brand.” POR 16. Yet the character is not a pre-existing character simply skinned with the Pepsi logo—instead, the “system may *send bots or electronic agents*” such as a character “holding a can of Pepsi and ask[ing the] player if they would like a drink.” EX1005, ¶79. Thus, Hays teaches that the character and its player interaction *is* the delivered advertisement. Another example of an interactive advertisement is “a game character eating a brand name energy bar to boost her power in the game.” *Id.*, ¶19; see also EX1005, ¶21 (“[S]pecific advertisements may be presented in the appropriate available ad units at the appropriate time *during gameplay*.”).

These examples are not like the hyperlinks in Gatto distinguished during prosecution. POR 17-18. In fact, Hays's disclosures are like the '202 patent's disclosure of a shirt that “might be updated to include a logo” or a poster that “might advertise an upcoming movie.” EX1001, 6:45-50. By contrast, during prosecution, the examiner mapped “updated content” to Gatto's “‘promotional items’ available for download via email hyperlink”—contrary to PO's assertion, it was *not* the

hyperlinks themselves that were the updated content. EX1002, 188; POR 17-18. The examiner further contended that the hyperlinked content was usable within the email (alleged to be a “video game”). EX1002, 188. But the applicant argued that ***linked promotional items*** were not usable, since “it would not make sense for an email to provide hyperlinks to ***content that is usable in the email itself.***” EX1002, 188. In other words, the problem with Gatto was that the updated content was linked by the hyperlinks and not within the email itself. By contrast, in both the '202 patent and Hays, the content itself (such as an advertisement) is usable within the game (such as, in the '202 patent, being displayed on a t-shirt (EX1001, 6:46-48) or, in Hays, as an interactive soda can (EX1005, ¶79)).

C. 1[c]: “updated video-game content”

PO argues that Hays's advertisements are not ***updated*** content because they are “pre-designated content and advertisements in the game when it is obtained by a user.” POR 19. PO fundamentally misunderstands Hays's disclosure, which expressly states that the device “may request and ***receive advertisements*** from the advertisement management service system.” EX1005, ¶32; ¶79 (“[T]he advertisement management service system may ***send*** bots or electronic agents into the game as advertising units or real characters in the game, which advertise or promote a product (e.g., a game character may move around a screen holding a can of Pepsi and ask player if they would like a drink).”). Thus, the advertisements are

not pre-loaded and instead are sent to update content within the video game. EX1003, ¶79.

PO cites to Hays's teaching that "[w]hen a game is shipped, it may have a fixed set of available ad units grouped into Zones (typically delineated by game levels or areas of play)." POR 19 (quoting EX1005, ¶19). This, however, only indicates that some areas are pre-designated as ad units for which **delivered advertisements** are displayed—the advertisements are still used as an update to that particular area. EX1005, ¶30 ("The advertisement server 114 may ... **select appropriate advertisements to serve to current available ad units** that the gameplayer will see."). Moreover, Hays expressly discloses "send[] ... advertising units." *Id.*, ¶79. PO is incorrect that Hays's advertisements or even its ad units cannot be updated.

D. Claim 4: "providing an in-game placement location "

As discussed in the Petition, Hays teaches designating the "ad unit" (*i.e.* a "space") within the game in which an advertisement should appear, providing an "in-game placement location." Pet. 23-25; EX1005, ¶18; EX1003, ¶¶111-15.

PO argues "the ad units are 'standardized' and not related to any specific in-game placement location." POR 21. But "standardized available ad units" refers to standardized **types** of ad units such as "signs," "structure," or "logos." EX1005, ¶73. Different retailers can select a standardized type that is appropriate to that retailer,

such as “McDonald’s” selecting a “branded fast food restaurant” structure. *Id.*, ¶¶73-74 (“standard advertisement unit **type**.”).

However, the device still needs to know the in-game location to display the advertisement. Hays’s ad units are “**spaces ... within the game**” and refer to specific objects located in specific areas, such as “Jumbotron screens, in a sports stadium, posters on walls, T-shirts on a game character, items used by game characters.” EX1003, ¶112 (quoting EX1005, ¶18). The ’202 patent similarly discloses the locations are not necessarily “positions along the axes” but instead specific objects. EX1001, 12:28-32 (“[A] first location may be where the shirt 230 is hanging.”). PO’s own expert conceded the claim is met if providing “a location ... in relation to an object.” EX1020, 31:21-32:1. Thus, by designating the ad unit, *i.e.* a location in relation to an object, the system provides an **in-game location**.

In addition, Dr. Zagal explained why it is obvious to provide in-game location because “a POSITA would be motivated to provide a mechanism to inform the game ... where to place the advertisement, as that would fulfill the contractual obligations to the advertiser.” EX1003, ¶115. Dr. Akl fails to address Dr. Zagal’s testimony. He instead argues that “[b]ecause the ad units are predesignated, a POSITA would understand that Hays does not send location information with the ads” which is nonresponsive. EX2004, ¶80. Predesignated ad units does not solve the problem of informing the device the location of ad units to display advertisements.

E. Claim 5: “tracking what has been uploaded”

The Petition provided several examples from Hays of tracking. Neither PO or its expert address Hays's tracking of “frequency caps,” which requires tracking uploaded advertisements and their frequency. EX1005, ¶45; Pet. 26 (citing EX1003, ¶117).

PO's arguments likewise fail with respect to Hays's remaining teachings. For example, Hays discloses an “active session database 124” which is “used to **track** and record **all communications and data** sent and received from the” mobile device. Pet. 25 (quoting EX1005, ¶38). Despite tracking “**all** communications,” PO argues that Hays's tracked data is only for “session[s],” and therefore fails to track all uploaded data and does not “show what has been uploaded.” POR 22.

Yet the session for tracking all data corresponds with what PO admits is the “period a user is playing a game.” POR 23 (citing EX1005, ¶38). Indeed, the session begins when the player logs in and ends when they log-out. EX1005, ¶¶38-39. As a result, all “updated video-game content” uploaded to the player's device is tracked.

Hays also describes “services that **track** and audit the quality of presentation of the in-game advertisements,” including “advertisement impressions.” EX1005, ¶25; Pet. 26. PO argues “this [data] is related to the advertisement itself, not the ‘mobile communications device.’” POR 23. This argument makes little sense, since Hays describes that it is the advertisements which are uploaded to the mobile

communications device. Pet. 20-21; EX1005, ¶43. PO also argues that “at most [Hays] describes information regarding the presentation of an advertisement, rather than when an advertisement has been uploaded.” POR 23. But tracking “advertisement impressions” includes when and how often an advertisement is uploaded. EX1003, ¶118.

Finally, PO argues that Hays “tracks only what has been *seen* by the user,” whereas the claim requires tracking both seen and unseen video-game content. POR 23-24. Nothing in any of the claims requires unseen content. Nevertheless, Hays “track[s] ... ***all communications***” uploaded to the device, which includes any unseen advertisements. EX1005, ¶38. Indeed, Hays states that an “[a]dvertisement stays static as long as the user is in the zone, per session,” indicating that an advertisement may change when the user is out of the zone. EX1005, ¶62.

F. Claim 6: “displaying ... based on user interaction”

The Petition provided four examples of Hays disclosing displaying advertisements “at a location based on user interaction.” Pet. 26-28 (quoting EX1005, ¶¶78, 120, 80, 62, 79). PO only addresses three of them. PO and Dr. Akl do not address Hays’s disclosure of an “[a]dvertisement [that] stays static as long as the user is in the zone” (EX1005, ¶62) which means whether an “ad is displayed at a particular location ... is based on the user interaction of continuing the current gameplay session or logging off and starting a new session.” EX1003, ¶122.

Nevertheless, PO's arguments as to the other three examples are wrong. PO argues that Hays's teaching of displaying "mini games" when "a level is completed" or displaying "advertising at the beginning and end of a game and in between game levels" only specifies display "at a specific time," not a location. POR 24-25. However, as Dr. Zagal explained, such content is displayed "at a specific location," and their presence at that specific location is triggered by user interaction. EX1003, ¶120. Indeed, PO concedes that the mini-game is displayed at a specific location, but argues the location is "pre-set" and not based on user interaction. POR 25. PO does not cite to anything in Hays that the location is "pre-set." Regardless, the user interaction of completing a level causes the content to be displayed at a particular location. That is all the claim requires.

PO also argues that "mini games" are "built into the application and are simply re-skinned with ad graphics," and thus not updated content. POR 25. However, the ad graphics are updated content. And the "mini game ... is effectively an advertisement." EX1005, ¶78.

Finally, Hays's insertion of a character "holding a can of Pepsi" that interacts with the player displays an advertisement "based on the location of the player's character, which is therefore based on the user interaction of arriving at that location." EX1005, ¶79; EX1003, ¶123; Pet. 28. PO simply asks the Board to

simply ignore Dr. Zagal's testimony. POR 26. But as discussed above, Dr. Zagal's testimony must be given due weight.

IV. GROUND 2: HAYS AND CHOI RENDER CLAIMS 1-9 OBVIOUS

The Petition provided the Hays-Choi combination as an alternative ground of obviousness for limitation 1[b] and claim 8. Pet. 30-31. As discussed herein, PO's arguments against this combination fail.

A. 1[b]: "checking what updated video-game content to send"

As the Petition explained, Choi describes "ad targeting" by using "user demographic and contextual information," some of which comes "from the carrier" because "a users' carrier implies a certain demographic." EX1006, ¶¶83, 86; Pet. 35; EX1003, ¶138.

PO does not dispute that the user's carrier is used as a proxy for demographic information. PO instead argues that Choi does not describe what to do with the carrier information or that it is used with ad targeting. POR 27-29. But Choi teaches "[a]d targeting *depends on collection of user demographic* and contextual information." EX1006, ¶83; ¶60 "[D]emographic indicators can be extracted during code analysis *for the purpose of ad targeting*"; ¶64 ("[D]emographic information, ... *influence[s] the ad content*.").

Moreover, PO ignores the proposed combination—"to combine Hays with Choi's teaching of 'request[ing] demographic information from the carrier' of the

mobile communication device to use in the selection of advertisements.” EX1003, ¶131; Pet. 32. The combination explicitly uses Choi's method of obtaining demographic information from the carrier to affect Hays's selection of advertisements.

PO also argues that the claim requires “using carrier information, not demographic information.” The claim requires checking which updated content to send “based on ... a telecom service.” That is precisely what Hays-Choi combination renders obvious: checking which advertisement to send based on carrier information used as a proxy for or to obtain demographic information.

B. Motivation to Combine Hays and Choi

Dr. Zagal provided several reasons why a POSITA would combine Hays and Choi. EX1003, ¶¶129-36; Pet. 31-34. PO does not address any of them. Instead, PO argues there is lack of motivation due to some alleged disadvantages. Even if PO's purported disadvantages were true (they are not), it is “not necessary to show that a combination is the *best* option, only that it be a *suitable* option.” *Intel Corp. v. PACT XPP Schweiz AG*, 61 F.4th 1373, 1379-80 (Fed. Cir. 2023) (emphasis in original); *Allied Erecting & Dismantling Co. v. Genesis Attachments, LLC*, 825 F.3d 1373, 1381 (Fed. Cir. 2016) (“A given course of action often has simultaneous advantages and disadvantages, and this does not necessarily obviate motivation to combine.”).

PO's arguments also fail for other reasons. PO first argues that "both Choi and Hays already describe systems for targeting advertisements based on other factors." POR 29. But while Hays selects advertisements based on predicted demographic information, Hays "does not expressly describe how to obtain such predicted demographic information." EX1003, ¶133. Thus, a POSITA would be motivated because "Choi provides one way of obtaining predicted demographic information by obtaining the user's carrier." *Id.*

Next, PO argues that Choi "provides no explanation of how to use the collected information." POR 30. This is incorrect, as explained above—Choi does explain that the information is used for targeted advertising, and the proposed combination is to use the information with Hays's targeted advertising.

Finally, PO argues that Hays sends advertisements "regardless of the specific game" whereas Choi has a "focus on a specific game." POR 30-31. This distinction has no bearing on whether a POSITA would be motivated to use carrier information for targeted advertising—which Choi clearly teaches. *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1076 (Fed. Cir. 2015) ("[A] reference must be considered for **everything it teaches** by way of technology and is not limited to the particular invention it is describing and attempting to protect."). Finally, Hays expressly states its system works for a specific game. EX1005, ¶27 ("[A]t least **one** game publisher system 110 that publishes **a game title**.").

V. GROUND 3: HAYS AND CHU RENDER OBVIOUS CLAIM 4

The Petition provided the Hays-Chu combination as an alternative ground to claim 4, which recites “providing an in-game placement location associated with the updated video-game content.” Again, PO’s arguments are unavailing.

A. Chu discloses “providing an in-game placement location”

Chu delivers advertisements that include “the *location* within a game at which advertisements are to appear.” Pet. 39 (quoting EX1007, 14:20-15:5).

PO argues that Chu does not describe that such information is sent “from the server to the client as claim 4 requires.” POR 32-33. Chu clearly states that requested metadata sent to the client includes the “location object.” EX1007, 14:47-15:5. Figure 5 further shows that the server “[r]eturn[s] *campaign metadata*,” which includes the location.

PO also argues that “Dr. Zagal fails to explain how Chu’s client-based system would be modified for or implemented into Hays’s server system.” POR 33. But Dr. Zagal explained how to use Chu’s location metadata with Hays’s system. EX1003, ¶¶144-49. It is not necessary to combine the entirety of Chu’s system with Hays’s system. *Belden*, 805 F.3d at 1076.

B. Motivation to Combine Hays (or Hays-Choi) with Chu

PO argues that the “Petition fails to set forth any motivation to combine Choi and Chu or Hays, Choi, and Chu.” But the Petition set forth a motivation to “modify Hays (or *further modify the Hays-Choi combination*) according to Chu’s

teachings,” and PO provides no explanation for why any of the articulated motivations would not also apply to the Hays-Choi combination. Pet. 37-39.

As for the Hays-Chu combination, PO argues that “a POSITA would not have sought to modify Hays’s specific ad units to transmit placement information.” POR 34. But the combination does not modify Hays’s ad units. Hays discloses that ad units are found in certain locations within the game (*e.g.* a t-shirt or billboard (EX1005, ¶18)) and thus, a POSITA would have been motivated to use Chu’s teaching of providing a location to specify the ad unit. EX1003, ¶148.

PO also argues that Hays provides ads “across a variety of games” whereas Chu “is directed to a specific, online gaming system.” POR 34-35. This fails to address the specific combination or motivations. It is also not necessary to combine the entirety of Chu’s system with Hays’s system. *See Belden*, 805 F.3d at 1076.

PO next argues that Hays “teaches against designing gaming applications, as Hays applies only to browser-based systems.” POR 35. Hays is not limited to browser-based systems, and its system works with “game consoles.” EX1005, ¶21. Moreover, PO provides no explanation for why browser-based games would teach-away the combination.

Finally, PO states “Hays’s ad units are not fixed to a specific location and are sent ‘regardless of [their] location.’” POR 35 (quoting EX1005, ¶73). This grossly mischaracterizes Hays, which provides as ***an example*** that a ***type*** of ad unit can be a

“static sign regardless of its location.” EX1005, ¶73. Hays expressly discloses that advertisements are placed at “a specific location.” EX1005, ¶46; *see also id.*, ¶18 (“[A]dvertisements ... on pre-designated ***geometry within the game*** such as billboards, storefront signs, panel trucks ...”).

VI. GROUND 4: HAYS AND VAN DATTA RENDER OBVIOUS CLAIM 6

Petitioner's Hays-Van Datta combination was an alternative ground to claim 6, which recites “displaying the video-game content within the game at a location based on user interaction.” PO's arguments fail as discussed herein.

A. Van Datta teaches displaying an advertisement “at a location based on user interaction”

The Petition explained that van Datta is directed to placing advertisements based on “a user's choice,” such tagging a location or dragging-dropping an advertisement. EX1009, Abstract, 2:59-64; Pet. 43.

PO argues that “the advertisements of van Datta are not ***displayed*** to an end user” because “van Datta discloses only assigning advertisements.” POR 37 (emphasis in original). Van Datta states that “advertisements will ... be ***displayed*** in various ‘tagged’ assets.” EX1009, 8:20-24.

PO also fails to engage with Petitioner's proposed combination, where van Datta's dragging-dropping or tagging assets are incorporated into Hays's displaying advertisements. Pet. 42; EX1003, ¶158.

B. Motivation to Combine Hays (or Hays-Choi) with van Datta

PO does not dispute Dr. Zagal's reasons as to why a POSITA would combine Hays with van Datta. EX1003, ¶¶154-58; POR 38-39. PO argues there are some alleged disadvantages, which is not a basis to deny obviousness. *Allied Erecting*, 825 F.3d at 1381.

PO states "Hays describes placing the ad units on items, objects, or characters, which requires no interaction from a user," but that is immaterial. POR 38. The combination is to make use of van Datta's teachings of a user designating an asset (such as Hays's ad unit) as a place for an advertisement.

PO also argues that "Hays is expressly agnostic to location," which is false. As PO expressly admits, Hays's ads are placed on "items, objects, or characters," which each has a location. POR 38; EX1005, ¶46 ("[A]n advertisement for a specific location"), cl. 1 ("advertising locations within ... games").

PO argues that "Hays seeks to avoid customization and instead seeks to serve advertisements broadly," whereas van Datta "seeks to allow users to customize placement of ads in a particular game." POR 39. Nowhere in Hays does it say customization is undesirable. Indeed, Hays is directed to "targeted advertising" and as Dr. Zagal explained (which PO does not address), "van Datta's teachings fulfill ... advertiser needs for advertising the user finds desirable." EX1005, Abstract; EX1003, ¶157. And Hays expressly states its system is suitable for a single, specific

game. EX1005, ¶27 (“[A]t least **one** game publisher system 110 that publishes **a game title**.”).

VII. GROUND 5: LEVKOVITZ RENDERS OBVIOUS CLAIMS 1-3 AND 5-9

A. 1[a]/1[c]: “for use” or “usable”

PO argues that Levkovitz only discloses “placement of content ... within the game, which are not usable in the video game.” POR 40-42. As discussed above in Section III.B, PO’s attempt to construe “usable” to require affecting gameplay has no support in the claim language or specification. EX1001, 6:47-50 (describing a pre-existing shirt updated to display a logo); 8:6-7 (describing content being “displayed in a pop-up window”).

PO tries to compare Levkovitz’s display of advertisements to the hyperlinking described in the Gatto reference considered by the examiner. As discussed in Section III.B, the examiner had asserted that Gatto’s “‘promotional items’ available for download via email hyperlink” were the updated content. EX1002, 188. In other words, the problem with Gatto was that the email did not display the content, but was instead linked to it via hyperlink. Thus, the examiner allowed the claims.

B. 1[c]: “uploading updated video-game content”

As the Petition points out, Levkovitz describes an “ad server” that “serve[s] content items” to a client device. Pet. 47 (quoting EX1008, ¶127). Nevertheless, PO inexplicably argues that Levkovitz does not “upload” any such content to the

device, because Levkovitz uses the WAP protocol and “WAP operates like a web browser that retrieves and caches content but, notably, does not require downloading or uploading content.” POR 43. As an initial matter, PO does not cite to any evidence that the WAP protocol does not upload or download data, beyond their own expert's say-so. Moreover, Levkovitz states that WAP is used only in “some embodiments.” EX1008, ¶339. In fact, paragraphs 121 through 338 of Levkovitz (which encompass all of the portions of Levkovitz that the Petition cited to) do not mention any use of WAP at all. And PO's comparison to a web browser makes little sense when web servers do, in fact, upload content to web browsers.

Regardless, Levkovitz could not be more clear that an “ad server” uploads content to the device. EX1008, ¶6 (“The ad server may selectively *serve content items* to the content client”), ¶128 (“Ad server 110 may *serve, transfer or transmit* one or more selected content items to communicator 150.”), ¶143 (“the *distribution of content items* among multiple ad servers 110”), ¶152 (“Ad server 110 may selectively *provide* to communicator 150 one or more content items”).

C. Claim 5: “tracking what has been uploaded”

Levkovitz discloses “log[ing] information related to presentations” which includes “data indicating the content item(s) presented.” EX1008, ¶132; Pet. 49. PO argues that some content “could be uploaded and not presented” and therefore would not be logged. PO's argument, however, narrowly construes this claim to require

tracking of **everything** that has been uploaded, which is not supported by the language of the claims itself or the specification. The antecedent basis of “what has been uploaded” is simply “uploading updated video-game content,” which does not recite a plurality of video-game content. Thus, this claim is disclosed as long as the prior art teaches tracking of at least one uploaded updated video-game content, which Levkovitz does.

In addition, PO does not cite to anything in Levkovitz that indicates a content item is uploaded but not presented. Indeed, for the embodiment that Petitioner relies on, Levkovitz states that the ad server “may serve content items **directed for presentation** using a first application 176 (e.g., a chess game).” EX1008, ¶127.

D. Claim 6: displaying content “at a location based on user interaction”

The Petition pointed out that Levkovitz discloses “presentation rules” which dictate the size of the uploaded content based on user interaction such as “inactivity elapses” or completion of a level, goal or score. Pet. 49-50; EX1008, ¶¶187, 318.

PO argues that the size of the advertisement is “not related to a location of the content.” POR 46. But the size of an advertisement does affect which pixels on the screen will display the advertisement, *i.e.* the location of the advertisement.

PO also argues that “inactivity” is not “based on user interaction” but a lack thereof. Pet. 46. However, “inactivity” is not merely a lack of interaction, but rather a **change** from some interaction to no interaction. Therefore, inactivity refers to a

change in how the user interacts with the video game. and presenting an advertisement because of “inactivity” is “based on user interaction.”

VIII. GROUND 6: LEVKOVITZ AND CHU RENDER OBVIOUS CLAIM 4

PO argues Chu's server does not send in-game placement location to the client. POR 47-50. As discussed above for Ground 3, that is incorrect.

PO argues that “Levkovitz seeks to serve advertisements broadly” whereas Chu has a “narrow disclosure of placing ads at a particular location.” POR 50. However, this does not address the known benefits for modifying Levkovitz to place ads at a particular location, as explained by Dr. Zagal. EX1003, ¶¶183-88.

IX. GROUND 7: LEVKOVITZ AND VAN DATTA RENDER OBVIOUS CLAIM 6

PO argues van Datta doesn't teach displaying advertisements at tagged locations. POR 51-52. As discussed above for Ground 4, that is incorrect.

PO argues that “select[ing] the placement location of advertisements” is “inherently distinct” from Levkovitz. POR 52. PO provides no explanation for how the references are inherently distinct, nor does PO assert they are not analogous art. As explained by Dr. Zagal, a POSITA would have known of the benefits to advertisement targeting in allowing a user to designate ad placement. EX1003, ¶¶193-97.

X. PO PROVIDES NO EVIDENCE OF SECONDARY CONSIDERATIONS

PO argues there was a long-felt need for the '202 Patent, yet admits consoles games “did not face the same issues.” POR 53. Yet the claims of the '202 patent recite a “mobile communication device” and as PO’s expert readily admits, mobile game consoles existed prior to the patent. EX1020, 7:24-9:3. Thus, there is no nexus between the claims and any alleged long-felt need.

All of the evidence PO cites to merely describes the industry’s desire for more in-game advertising. POR 54-56. Yet as shown in the Petition, and as undisputed by PO, in-game advertising on mobile devices was well-known, including as described in Hays, Chu, Choi, van Datta, and Levkovitz. Thus, PO has failed to show any nexus. *Yita LLC v. MacNeil IP LLC*, 69 F. 4th 1356, 1364 (Fed. Cir. 2023) (“[O]bjective evidence of nonobviousness lacks a nexus if it exclusively relates to a feature that was known in the prior art.”).

PO does not cite to any commercial praise directed to its patent (or any embodying product) and does not cite to any commercial success from commercializing its patent. PO does not cite to any copying by competitors of any product embodying its patent.

In sum, PO’s secondary considerations should be given very little weight and does not overcome the strength of the obviousness arguments.

XI. §311(B)

PO's §311(b) argument has been repeatedly rejected by the Board as well as the Federal Circuit. EX1019; *Purdue Pharma L.P. v. Iancu*, 767 F. App'x 918, 925 (Fed. Cir. 2019).

Regardless, Hays claims priority to a PCT application published years before the '202 patent. EX1021. If Hays is not a "printed publication," Petitioner will seek leave to replace Hays with Exhibit 1021. There should be no prejudice given that the disclosures are identical.

XII. CONCLUSION

For these reasons, all challenged claims are unpatentable.

Date: November 1, 2024

Respectfully submitted,

By: /s/ James M. Glass

James M. Glass

Counsel for Petitioner

**CERTIFICATE OF COMPLIANCE WITH
TYPE-VOLUME LIMITATION, TYPEFACE REQUIREMENTS,
AND TYPE STYLE REQUIREMENTS**

1. This Petition complies with the type-volume limitation of 5,600 words, comprising 5,577 words, as counted using the Microsoft Word software that was used to prepare this paper, excluding the parts exempted by 37 C.F.R. § 42.24(a).

2. This Petition complies with the general format requirements of 37 C.F.R. § 42.6(a) and has been prepared using Microsoft® Word 2016 in 14-point Times New Roman.

Date: November 1, 2024

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on November 1, 2024, true and correct copies of the foregoing document and supporting materials were served in its entirety on the Patent Owner at the following email addresses:

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