

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

IPR No. IPR2024-00132

Patent No. 9,731,202

PATENT OWNER'S SUR-REPLY

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EXHIBIT LIST

Exhibit	Description
2001	Playrix's Exchange of Proposed Terms and Claim Elements for Construction, served January 30, 2024
2002	Joint Claim Construction Statement in <i>Flip Phone Games Inc. v. PLR Worldwide Sales Limited</i> , No. 2:23-cv-00139-JRG (E.D. Tex.), Dkt. 71
2003	Declaration of Henry H. Houh, Ph.D., in Support of Playrix's Proposed Claim Constructions
2004	Declaration of Dr. Robert Akl, D.SC. in Support of Patent Owner's Response
2005	CV of Dr. Robert Akl, D.SC
2006	Complaint for Patent Infringement, <i>Flip Phone Games Inc. v. PLR Worldwide Sales, Ltd.</i> , No. 2:23-cv-00139-JRG (E.D. Tex.), Dkt. 1
2007	CV of Steven D. Moore

I. INTRODUCTION

Patent Owner Flip Phone Games, Inc. (“PO”) submits this Sur-Reply explaining why Petitioner PLR Worldwide Sales Limited (“Petitioner”) failed to establish that any Challenged Claim is obvious.

II. DR. ZAGAL’S TESTIMONY SHOULD BE GIVEN NO WEIGHT.

Petitioner urges that “[w]ell-reasoned opinions, however, should be given proper weight.” Reply, 2. Dr. Zagal offers no such opinions. Instead, his declaration is little more than a carbon copy of the Petition. *Compare* Ex. 1003, ¶¶113-15 with Petition, 23-25; *compare* Ex. 1003, ¶¶125-26 with Petition, 29-30; *compare* Ex. 1003, ¶¶132-36 with Petition, 32-34; *compare* Ex. 1003, ¶¶147-49 with Petition, 37-39; *compare* Ex. 1003, ¶¶185-87 with Petition, 52-53; *compare* Ex. 1003, ¶196 with Petition, 56. Petitioner offers no explanation for its failure to present credible testimony versus simply parroting the Petition. As PO has shown previously and shows below, such a declaration is of little use and should be afforded no weight. *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9, at 18 (PTAB Aug. 24, 2022) (precedential).

III. GROUND I: PETITIONER FAILS TO CARRY ITS BURDEN OF ESTABLISHING THAT HAYS RENDERS CLAIMS 1-9 OBVIOUS.

A. Claim 1[b]: “checking what updated video-game content to send based on one of the [claimed] factors....”

Hays does not disclose “checking” using *any* of the factors required by the claim, “a type of the mobile communication device, a telecom service associated with the mobile communication device, and a service provider of the telecom service.” Ex. 2004, ¶¶51-60.

Petitioner misstates the claim language. Petitioner first urges that “Hays teaches factors related to the mobile device.” Reply, 2. But the claim does not recite “factors related to the mobile device.” It instead recites three factors: “a type of the mobile communication device, a telecom service associated with the mobile communication device, and a service provider of the telecom service,” none of which is met by simply “factors related to the mobile device.”

Further, Hays never discloses identifying an advertisement based on “specific client type.” To the contrary, Hays describes weighting advertisements against each other, and its “weighting system 220 may calculate *the weight of each advertisement* based on ... information regarding the specific client type from the advertisement recipient database 120.” Ex. 1005, [0043]. Thus, to the extent a specific client type is used, it is part of a weight assigned to an advertisement. As explained, this assigned weight is “relative to other advertisements in the set,” and

thus the weighting is between individual advertisements. *Id.*, [0043]; Ex. 2004, ¶¶53-55. Thus, in Hays weights are assigned, or advertisements are matched, based on factors associated with other advertisements. Ex. 2004, ¶53.

Finally, the claim does not recite “associated with a service provider,” but rather “a telecom service associated with the mobile communication device, and a service provider of the telecom service,” neither of which is taught by a user’s IP address. *See* Ex. 2004, ¶¶55-56. Hays does not target advertising based on an IP address. Rather, it describes collecting information about the user via an IP address. Ex. 1005, [0044] (“it may contain demographic information about a game player *collected via the use of an IP address....*”). This does not disclose targeting at all, much less the elements required by the claim.

The purpose of the claimed checking step is determining compatibility.

Petitioner suggests that “checking what updated video-game content” based on “a service provider of the telecom service” demonstrates that there is no compatibility check performed. Reply, 3. This is simply wrong, in particular during the relevant timeframe, June 2007. As Dr. Akl’s un rebutted testimony confirms, that timeframe predates the first generation iPhone and “the first generation of the Apple Appstore would not be released for another year.” Ex. 2004, ¶39. Thus, “mobile games were generally designed for only specific devices (e.g., specific models of phones) and were made available ... through mobile device carriers.” *Id.*, ¶40. Further, specific

carriers at that time often used platform specific operating systems, e.g., BREW or J2ME. Thus, contrary to Petitioner’s attorney argument, a check for a specific carrier provided necessary information for determining compatibility. *See id.*

Petitioner’s only evidentiary cite is to the specification’s discussion of “an initial message” or a “service provider’s logo,” which Petitioner suggests shows no compatibility determination. Reply, 3-4. Yet in each example, the *very next sentence* makes clear the use for compatibility determinations: “newer mobile communication devices may be able to display a more elaborate initial message, so *distinguishing among types of mobile communication devices* may allow a game provider to maximize the experience on each type of mobile communication device.” Ex. 1001, 10:41-45; 11:40-45 (similar).

Petitioner presents no evidence that software for console games would be applicable to mobile devices at the relevant time period. A POSITA would have known that gaming consoles operated differently than games on mobile devices, and Hays itself draws a distinction between consoles and wireless devices. *See, e.g.*, Ex. 1005, [0023] (identifying “a range of electronic mediums including consoles (such as Sony Play Station and Microsoft Xbox)..., wireless equipment (cellular phones and other wireless gaming devices)”); Ex. 2004, ¶57. Petitioner ignores this and points to a single statement, that “the term ‘computer,’ ‘game console,’ ‘console,’ or the like, as used generally herein, refers to any of the above devices, as well as to

any data processor.” Ex. 1005, [0051]. But the preceding sentence—which recites the above devices—makes no mention whatsoever of mobile devices, and instead discusses “special purpose computer or data processor that is specifically programmed,” neither of which suggests mobile device much less “a *type of the* mobile communication device,” as claimed. *Id.*

Finally, Petitioner makes the unsupported statement that PlayStation Portable and Nintendo DS were available on the market at the time and “could easily render advertisements.” To the extent this is even correct, these systems cannot be raised in this proceeding and are not part of any ground. Further, neither device offered any form of cellular data connection,¹ and thus neither is a mobile *communication* device and necessarily never determines “a telecom service associated with the mobile communication device, and a service provider of the telecom service.” For this reason, Petitioner’s citation to Dr. Akl’s testimony that portable consoles were available is irrelevant to the claims. Reply, 4. Indeed, as Dr. Akl’s testimony confirms, given the technical limitations at the time, including bandwidth, storage, and processing limitations, a POSITA would not have been motivated to apply a method for weighting advertisements to be sent to a game console to mobile devices. Ex. 2004, ¶58.

¹ https://en.wikipedia.org/wiki/PlayStation_Portable;
https://en.wikipedia.org/wiki/Nintendo_DS

B. Claim 1[Pre]/1[a]/1[c]: “updated video-game content being *usable in the video game*”

Hays does not disclose transmitting updated videogame content that is usable in the video game. First, Petitioner attempts to equate unrelated sections of the '202 Patent's specification, citing to a discussion of updating a logo or a poster. *See* Reply, 5. But neither the logo nor poster are used in the game. To the contrary, both are simply described as skins that are periodically updated. *See* Ex. 1001, 6:60-61 (“the shirt may be replaced with a sign that states ‘space available.’”). Dr. Akl's testimony is fully consistent with this explanation: “just having something on a shirt, and if we stop there and we don't give any additional information, that is just content but that doesn't disclose for use yet.” Ex. 1020, 26:14-18. And the specification likewise consistently describes examples that are *for use* in the game, including for “newer mobile communication devices may be able to display elaborate content, so distinguishing among types of mobile communication devices may allow a game provider to maximize the experience on each type of mobile communication device.” Ex. 1001, 10:41-45.

Second, none of Petitioner's examples from Hays suggests “updated video-game content being usable in the video game.” For instance, Petitioner cites where Hays “send[s] 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).” Ex. 1005, [0079]. According to Petitioner, “the player has the option to drink the advertised product.” Reply, 6. Yet nowhere does Hays include any suggestion that the player’s character has the option to drink any advertised product *in the game*, as opposed to suggesting the player do so in real life. Indeed, contrary to Petitioner’s suggestion, Hays never describes any interaction by the user with these “bots or electronic agents.” Instead, they act as non-interactive mobile advertisements. Finally, these “bots or electronic agents” are not received from a server, but rather are part of the game at the time it is created and include “advertising units,” which can be updated to change skin, as Hays describes. *See* Ex. 1005, [0018].

Petitioner goes on to cite another example of “a game character eating a brand name energy bar to boost her power in the game.” Reply, 6 (citing Ex. 1005, [0019]). But again it is the ad unit, which is “pre-designated geometry within the game,” that is actually usable. Ex. 1005, [0018]. Hays does not describe the inclusion of an advertisement—i.e., the specific brand of energy bar—as modifying any functionality. Ex. 2004, ¶63. Rather, the game operates in the same way whether the energy bar is blank, shows the branding of a known brand, or includes a fictional in-game brand. Ex. 2004, ¶64.

Even if the Pepsi can and energy bar examples are similar to updating a shirt to provide a logo, as described in the '202 Patent, this is irrelevant to the claims. The updated logos on a shirt in the '202 patent are never described as “for use” or “usable.” *See* Ex. 1001, 6:45-47; 6:53-55.

For similar reasons Petitioner’s attempt to distinguish the claims from analysis of Gatto during prosecution fails. *See* Reply, 7. The applicant argued that “[a] close reading of Gatto reveals that the ‘hyperlinks to download promotional items’ are, in fact, not usable in the so-called video game,” and “it would not make sense for an email to provide hyperlinks for content that is usable in the email itself.” Ex. 1002, 188, 189. Indeed, as Petitioner appears to acknowledge, “the problem with Gatto was that the updated content was linked by the hyperlinks.” Reply, 7. Thus, the distinction with Gatto is the same as Hays, which as noted, provides “ad units,” which are “pre-designated geometry within the game,” at which linked advertising may be displayed. *See* Ex. 1005, [0018]. As with the hyperlinks in Gatto, this advertising does not alter the functionality of the individual ad unit.

C. Claim 4: “sending information to the mobile communication device as part of the updated content, the information providing an in-game placement location associated with the updated video-game content.”

Petitioner’s arguments ignore that the claim language expressly requires the “the step of *sending information to the mobile communication device as part of*

the updated content, the information providing an in-game placement location associated with the updated video-game content.” Nowhere does Hays disclose sending an in-game placement location to the mobile communication device as part of the updated content. Indeed, Petitioner does not address this specific claim language. Instead, Petitioner first urges, without citation, “the device still needs to know the in-game location to display the advertisement.” But Hays does not disclose this. Indeed, Hays suggests the opposite, explaining that its ad server provides general advertisements to standardized locations, enabling them to be sent to “large sets of available ad units from multiple game titles.” Ex. 1005, [0022]. Hays describes that “advertisement opportunities may be offered to advertisers based on *standardized available ad units*, which may include, for example signs (e.g., a billboard, poster, or other form of static sign *regardless of its location*)....” Ex. 1005, [0073].

Thus, while Hays describes *predesignated* locations for “ad units,” at the time the game is created, it never discloses “*providing* an in-game placement location associated with the updated video-game content,” much less doing so “*as part of the updated content*.” Ex. 2004, ¶¶75-80. Petitioner’s citation to Dr. Zagal offers no help, as to the extent his conclusory parroting of the Petition is even accepted, his testimony never addresses that the in-game placement location must be part of the updated content. *See* Reply, 9 (citing Ex. 1003, ¶115).

D. Claim 5: “tracking what has been uploaded to the mobile communication device.”

Petitioner begins its argument by pointing to “frequency caps.” Reply, 10. PO did address this issue, in the same discussion of recording advertisements delivered to a session. Response at 22-23 (citing Ex. 1005, [0045]). As explained, this ignores the claim’s requirement to track “what has been uploaded to the mobile communications device.” This is not met by a session, which would represent only a portion of any data uploaded. Ex. 1005, [0045]; Ex. 2004, ¶81. Petitioner’s “active session database 124” example (Reply, 10) fails for similar reasons.

Petitioner moves on to examples that track a user’s reaction to an advertisement rather than tracking delivery of advertisements. Reply, 10 (citing Ex. 1005, [0025]). The examples of tracked information are “advertisement impressions (which quantify the presentation qualities—e.g., viewing angle, percent screen size, time on screen, etc.—of an advertisement as presented in any given instance).” Ex. 1005, [0025]. None meets the claim. Rather, they describe tracking user’s reactions to particular advertisements, which is irrelevant to the claim language.

Petitioner goes on to state, “tracking ‘advertisement impressions’ includes when and how often an advertisement is uploaded.” Reply, 11 (citing Ex. 1003, ¶118). Notably, the cited section of Dr. Zagal’s declaration says nothing of “when”

or “how often” advertisements are uploaded, and Hays never suggests that such information is tracked or would even need to be tracked.

Finally, Petitioner ends its argument with yet another misquotation, stating “Hays ‘track[s] ... *all communications*’ uploaded to the device...” Reply, 11 (citing Ex. 1005, [0038]). Petitioner omits that this sentence is explicit that it relates to “a record in the active session database,” rather than tracking the data sent to the device outside of a particular session. Ex. 1005, [0038].

E. Claim 6: “displaying the videogame content within the game at a location based on user interaction.”

Petitioner’s arguments all fundamentally misstate the claim language and ignore the requirement that the content be displayed “at a location based on user interaction.” Rather than addressing the claim, Petitioner attempts to end-run around the placement location requirement by citing to display “based on user interaction.”

Petitioner begins its argument by pointing to advertisements that are “Zone Static.” See Reply, 11. Contrary to Petitioner’s suggestion, PO did address these as the Petition presents them as an example of ads presented at the end of a level. *Compare* Petition, 27 *with* Response, 24-25.

Regardless, the cited description states: “Zone Static: Advertisement stays static as long as the user is in the Zone, per session,” and provides the example: “Advertisement creative will remain static during length of single game session (e.g.,

a McDonald’s store front does not switch to a Citibank in the middle of game play).”

Ex. 1005, [0061].

TABLE A-continued	
Campaign and Targeting options:	Example:
Rotation options e.g.,: Static: Advertisement stays static as long as the user is playing the game, per session. Zone Static: Advertisement stays static as long as the user is in the zone, per session.	Advertisement creative will remain static during length of single game session (e.g., a McDonald’s store front does not switch to a Citibank in the middle of game play).

Id. This does not explain anything about the placement location of a particular advertisement. Rather, it describes that the advertisement “stays static” e.g., does not change from McDonald’s to Citibank, “in the middle of gameplay.” *Id.* This merely addresses rotating advertisements and is irrelevant to placing the advertisement at a particular location. This is confirmed by the fact that the table calls this a “Rotation Option.”

Petitioner’s example of a mini-game similarly fails. Relying solely on its conclusory expert testimony, Petitioner urges that mini-games are displayed “at a specific location.” Petitioner offers no support from Hays, which merely describes these as mini-games played between levels. *See* Ex. 1005, ¶78. This is not an in-game location but rather a timing, i.e., upon completion of a level. Again, this is irrelevant to displaying the minigame “**at a location** based on user interaction.”

Finally, Petitioner discusses again the example of a Pepsi and bots or agents that promote a product. But Hays never describes the location of these bots or agents.

Rather, it describes “a game character may move around a screen holding a can of Pepsi and ask player if they would like a drink.” Ex. 1005, [0079]. There is no indication that this game character is even displayed, much less positioned, based on user interaction. *Id.* And Dr. Zagal’s testimony cannot fill the gap in what the reference does not disclose. *Arendi S.A.R.L. v. Apple Inc.*, 832 F.3d 1355, 1363 (Fed. Cir. 2016).

IV. GROUND II: PETITIONER FAILS TO CARRY ITS BURDEN OF ESTABLISHING THAT HAYS COMBINED WITH CHOI RENDERS CLAIMS 1-9 OBVIOUS.

A. Claim 1[b]: “checking what updated video-game content to send based on one of the [claimed] factors....”

Hays does not meet this claim element, and Choi also does not disclose or suggest “checking what updated video-game content to send based on ... a type of the mobile communication device, a telecom service associated with the mobile communication device, and a service provider of the telecom service.” Rather, Choi describes the importance of ad targeting and demographic information. Choi, [0083]. This is irrelevant to the claimed factors. Petitioner urges that if a user’s carrier is determined, this can be used to determine demographic information. Reply, 13. At most this suggests targeting advertisements based on demographic information, which is irrelevant to the claim.

Choi does not cure Hays's deficiency and thus this combination necessarily fails to disclose claim 1[b]. Nor does Choi cure any deficiency discussed above.

B. Petitioner Does Not Establish that a POSITA Would Combine Hays and Choi.

Petitioner never establishes a motivation to combine Hays based on Choi. First, Dr. Zagal's testimony cannot provide such a motivation as his purported testimony on this score is a word-for-word copy of the Petition, which should carry little weight. *Compare* Ex. 1003, ¶¶132-36 with Petition, 32-34; *see Xerox Corp.*, IPR2022-00624, Paper 9, at 18. Second, the Reply attempts to cite to cases regarding disadvantages, without applying them to any particular reasoning given by PO. The Response provided a detailed explanation of why references would not be combined including that there is no basis to apply Hays's method for sending advertisements to multiple games with Choi's system for specific demographic targeting. Further, Petitioner again misreads the claim language suggesting that a POSITA would modify Hays to use predicted demographic information. *See* Reply, 15 ("Hays 'does not expressly describe how to obtain such predicted demographic information.'"). But as explained, this is irrelevant to the claim language, which does not recite demographic information.

V. GROUND III: PETITIONER FAILS TO CARRY ITS BURDEN OF ESTABLISHING THAT HAYS COMBINED WITH CHU RENDERS CLAIM 4 OBVIOUS.

- A. Claim 4: “sending information to the mobile communication device as part of the updated content, the information providing an in-game placement location associated with the updated video-game content.”**

Chu makes clear that its system transmits the location of an advertisement to the server. *See* Ex. 1007, 14:31-33 (“*game clients must pass the server information* such as but not limited to *the location identifiers* that uniquely identify an ad within a game....”). Petitioner acknowledges as much, and now cites to a new section of Chu. Reply, 16 (citing Ex. 1007, 14:47-15:5).

The cited passage explains first “[a]fter an online game running on ... a user computer (client) requests advertising metadata and determines an ad campaign’s display rules, schedule, and *locations*, it requests *the advertising assets that represent the advertisement*.” Ex. 1007, 14:50-54. Thus, Chu explains that the client device itself determines the location, rather than the server sending it with the updated content. The remainder of the description describes data transmission and advertising campaigns, but never states that location information is sent from the server to the client. Figure 7 shows an example “illustrat[ing] an XML format structure that may be utilized to *send metadata* and which corresponds to the example structure 800 for the metadata.” *Id.*, 14:57-59. Figure 7’s reference to

location (*see* 530) does not indicate that it is transmitted from the server, rather than to the server. Indeed, this “location” is not an X/Y coordinate structure, which is necessarily not “an in-game *placement location*,” because it contains no information for placement.

```

530 - <Location>
      <ID>2147483647</ID>
      <Name>Engine Oil Pitstop</Name>
    </Location>

```

Id., Fig. 7. To the extent Petitioner suggests the “ID” 2147483647 is a placement location, this is simply wrong, as the same ID appears for information plainly unrelated to location:

```

<?xml version="1.0" encoding="UTF-8" ?>
500 - <CampaignListing xmlns:xsi="http://www.w3.org/2001/XMLSchema-instance"
      xsi:noNamespaceSchemaLocation="CampaignListing.xsd">
510 -   <Campaign>
520 -     <ID>2147483647</ID>
520 -     <AdListing interval="30">
520 -       <Ad>
520 -         <ID>2147483647</ID>
520 -         <Type>image</Type>
520 -         <Width>200</Width>
520 -         <Height>200</Height>
520 -         <Media>/advertising/media/2147483647.jpg</Media>
525 -       </Ad>
525 -       <Ad>
525 -         <ID>2147483648</ID>
525 -         <Type>video</Type>
525 -         <Width>200</Width>
525 -         <Height>200</Height>
525 -         <Media>/advertising/media/2147483648.jpg</Media>
525 -       </Ad>
525 -       <Ad>
525 -         <ID>2147483648</ID>
525 -         <Type>image</Type>
525 -         <Width>200</Width>
525 -         <Height>200</Height>
525 -         <Media>Penzoil engine go. Go with the best!</Media>
525 -       </Ad>
525 -     </AdListing>
530 -   </Location>
530 -   <ID>2147483647</ID>
530 -   <Name>Engine Oil Pitstop</Name>
530 - </Location>
530 - </Campaign>
530 - </CampaignListing>

```

Id., Fig. 7. Thus, the “ID” may merely refer to an ID number used for the ad.

Nor would it make sense for the server to send location information in a system like Chu, in which the client requests specific advertisements and identifies the location in advance. *See* Ex. 2004, ¶118. Petitioner seems to acknowledge as much, stating as a motivation to combine that “Hays discloses that ad units are found in certain locations within the game,” and Chu would “provid[e] a location to specify the ad unit.” Reply, 17. To the extent this is correct, it proves the PO’s argument—Chu is providing advertising at a location specified by the mobile device, i.e., the ad unit. There is no need for the server to specify a location.

Finally, even if the metadata Petitioner identifies were sent from the server to the client device, there is still no indication or disclosure in Chu that location information is included within the advertising assets. Thus, Chu does not disclose or suggest sending “information providing an in-game placement location” “as part of the updated content.”

B. Petitioner Does Not Establish that a POSITA Would Combine Hays and Chu.

Petitioner’s motivation to combine relies almost entirely on the misreading of Chu explained above and fails for this reason. Further, Petitioner urges that PO “grossly mischaracterizes Hays,” in explaining that advertisements in Hays are not fixed to a specific location. Reply, 17. Putting aside the unnecessary rhetoric, Hays is agnostic to location to achieve its goal of enabling “advertisers to deliver their

campaign messages to specific audiences they wish to target across one or multiple game titles played across multiple platforms (e.g., PC, console, mobile, etc.) without being limited to delivering their campaign to only a single specific game title.” Ex. 1005, [0017]. To achieve this goal, a POSITA necessarily would not modify Hays based on a system that identifies specific advertising locations to the server, as Chu teaches. *See* Ex. 2004, ¶128.

VI. GROUND IV: PETITIONER FAILS TO CARRY ITS BURDEN OF ESTABLISHING THAT HAYS COMBINED WITH VAN DATTA RENDERS CLAIM 6 OBVIOUS.

A. Claim 6: “displaying the video-game content within the game at a location based on user interaction.”

Petitioner fails to address the fundamental deficiency that Van Datta does not describe displaying usable video-game content to an end user at a location based on that end user’s interaction. Petitioner urges that “Van Datta states that ‘*advertisements* will ... be *displayed* in various “tagged” assets.’” Reply, 18 (quoting Ex. 1008, 8:20-24). This never explains that the advertisements are displayed to the end user at a location based on user interaction. And in full context, the quoted section explains that “a user may simply point-and-click or highlight and select a particular identifier 410 or group 420 and the appropriate collection of advertisements will randomly be displayed in various ‘tagged’ assets.” Ex. 1008, 8:20-24. At most this discloses displaying an advertisement based on user

interaction, but not: (1) the location at which the advertisement will be displayed, and (2) that this location is determined based on user interaction. This does not meet the claim element.

B. Petitioner Does Not Establish that a POSITA Would Combine Hays and Van Datta.

Petitioner’s motivation to combine ignores its own interpretation—“van Datta is directed to placing advertisements based on ‘a user’s choice,’ such [*sic*] tagging a location or dragging-dropping an advertisement.” Reply, 18. To the extent Petitioner is correct, such a system would never be combined with Hays. As explained, Hays is expressly agnostic to location, which is necessary to achieve its goal of enabling advertisers to target a multitude of platforms and game titles with the same advertisement. Ex. 1005, [0017].

Petitioner never provides a reason that a system for broadcasting advertisements across platforms and games would be combined with a system that allows a user to select specific placement locations for advertisements. There is none, and as Dr. Akl explains “[a] POSITA would have not been motivated to narrow the audience of its advertising campaign through customized advertisements.” Ex. 2004, ¶128. “A POSITA could have only designed drag-and-drop functionality based on a specific game title, which would have required an entirely different architecture than the system of Hays.” *Id.*, ¶130.

VII. GROUND V: PETITIONER FAILS TO CARRY ITS BURDEN OF ESTABLISHING THAT LEVKOVITZ RENDERS CLAIM 1-3 AND 5-9 OBVIOUS.

A. Claim 1: Claim 1[Pre]/1[a]/1[c]: “updated video-game content being *usable in the video game*”

Levkovitz provides nothing more than a banner ad within a game, which is necessarily not usable in that game. Petitioner instead suggests that PO has proposed some alternative meaning of “use.” Reply, 20. But Petitioner bears the burden here and never proposed any meaning of “usable in the video game” *at all*, much less a meaning that would somehow encompass the display of a banner ad. As explained, a banner ad is not even a part of the game, much less usable in the game. Response, 40-41; Ex. 2004, ¶¶131-140.

Petitioner’s attempt to distinguish the prosecution history and the Examiner’s analysis of Gatto similarly fails. Petitioner tacitly acknowledges that Levkovitz simply displays advertisements. Reply, 20; *see also* Ex. 1008, [0005] (discussing Levkovitz’s “placement of content, e.g., *advertisements or banners*, within an application executed by a cellular phone, a mobile phone, or other wireless communication device.”). This does not meet the claim, and all grounds based on Levkovitz fail.

B. Claim 1[Pre]/1[a]/1[c]: “uploading updated videogame content to the communications device....”

Petitioner does not address the crux of PO’s argument regarding WAP—that content presented via WAP is never stored on the communications device and thus there is no uploading updated videogame content. None of Petitioner’s arguments or citations to Levkovitz shows that content is actually updated on the communications device. *See* Reply, 21. Rather, each quote presented by Petitioner states only that content is served, transferred, or transmitted, where it can be displayed via WAP. As Dr. Akl explains this does not meet the claim element. Ex. 2004, ¶143.

Rather than grappling with PO’s argument Petitioner attempts to require PO to demonstrate the operation of WAP. First, the burden is on Petitioner not PO in this proceeding. Second, PO did show how WAP works through the testimony of Dr. Akl, and to the extent Petitioner believes Dr. Akl’s testimony is incorrect, it could have challenged that testimony at deposition but did not do so. *See* Ex. 1020 (neither “WAP” nor “Wireless Application Protocol” appear in the transcript). Third, critically, Petitioner’s expert never addresses WAP at all. Thus, Dr. Akl’s testimony stands un rebutted.

The system described in Levkovitz does not download or upload content to the mobile device, and thus does not meet the claim.

C. Claim 5: “tracking what has been uploaded to the mobile communication device.”

Petitioner again fails to grapple with the distinction PO drew in the Response—Levkovitz does not track content that has been uploaded but rather presentations to a user. Ex. 1008, [0132]. Petitioner does not address the distinction between tracking presentations versus tracking “what has been uploaded.” As explained, tracking presentations does not meet the claim.

Petitioner attempts to present a faulty argument based on claim construction to suggest that the “claim is disclosed as long as the prior art teaches tracking of at least one uploaded updated video-game content.” Reply, 22. But Petitioner ignores that the claim language does not read “tracking whether videogame content has been uploaded.” Instead, the claim requires “tracking *what* has been uploaded to the mobile communication device,” which is not shown by Levkovitz.

Finally, Petitioner again attempts to flip the burden to PO to cite something in Levkovitz “that indicates a content item is uploaded but not presented.” First, this is improper burden shifting. Second, as explained above, Levkovitz does not upload anything, rather it presents advertisements via WAP. This is confirmed by the cite Petitioner provides which describes an advertisement “directed for presentation,” which is irrelevant to “tracking *what* has been uploaded to the mobile communication device,” as the claim requires. Reply, 22 (citing Ex. 1008, ¶127).

D. Claim 6: “displaying the video-game content within the game at a location based on user interaction.”

Levkovitz does not disclose or suggest “displaying the video-game content within the game at a location based on user interaction.” Petitioner suggests that “the size of an advertisement does affect which pixels on the screen will display the advertisement, *i.e.* the location of the advertisement.” Reply, 22. But Levkovitz never suggests that the size of an advertisement is related to its placement location, and even if it did, this ignores the requirement that placement is “at a location based on user interaction.” Petitioner never explains a relationship between size and user interaction, much less placement location and user interaction.

Petitioner next suggests that presenting an advertisement based on inactivity is “a change from some interaction to no interaction.” Reply, 22. But the claim does not recite “a change from interaction to no interaction.” Rather, it recites “displaying the video-game content within the game at a location based on user interaction.” Inactivity is not user interaction. And even if it were, Levkovitz does not describe selecting a particular placement location for an advertisement based on inactivity. Ex. 2004, ¶150.

VIII. GROUND VI: PETITIONER FAILS TO CARRY ITS BURDEN OF ESTABLISHING THAT THE LEVKOVITZ-CHU COMBINATION RENDERS CLAIM 4 OBVIOUS.

As explained in Section V *supra*, Chu does not teach sending an in-game placement location to the mobile communication device as part of the updated content. At most it discloses the opposite—sending a placement location from the mobile device to the server. Petitioner presents no evidence, in the form of testimony or otherwise, to establish that this is incorrect. Petitioner similarly fails to shoulder its burden of establishing a motivation to combine Levkovitz and Chu. *See* Response, 49-50. Dr. Zagal’s testimony is of no help as he simply parrots the Petition. *Compare* Petition, 54 *with* Ex. 1003, ¶¶189-91.

IX. GROUND VII: PETITIONER FAILS TO CARRY ITS BURDEN OF ESTABLISHING THAT THE LEVKOVITZ-VAN DATTA COMBINATION RENDERS CLAIM 6 OBVIOUS.

As explained in Section VI *supra*, Van Datta does not disclose or suggest “displaying the video-game content within the game at a location based on user interaction.” Rather, at most Van Datta describes displaying an advertisement based on user interaction. But this does not disclose a location that is determined based on the user’s interaction, as the claim requires. Petitioner similarly fails to shoulder its burden of establishing a motivation to combine Levkovitz and Van Datta. *See* Ex. 2004, ¶152. This testimony is functionally un rebutted because Dr. Zagal simply

parrots the Petition. *Compare* Petition, 55-57 with Ex. 1003 ¶¶193-97. This cannot carry Petitioner's burden.

X. HAYS AND CHOI ARE NOT PRINTED PUBLICATIONS UNDER 35 U.S.C. § 311(b)

As discussed in the Response, Hays and Choi are not “prior art consisting of patents or printed publications” under § 311(b) and are therefore ineligible to be prior art in this proceeding. Response, 56-59. Petitioner suggests only that PO's “argument has been repeatedly rejected by the Board as well as the Federal Circuit.” Reply, 25. Prior agency decisions, however, are not afforded any deference on this question of statutory interpretation. *See Loper Bright Enters. v. Raimondo*, No. 22-451, 603 U.S. ____ (June 28, 2024). And the Federal Circuit recently heard oral argument on this question of statutory interpretation in *Lynk Labs, Inc. v. Samsung Electronics Co.*, Appeal No. 23-2346, with an opinion yet to issue.

Finally, Petitioner offers a last-ditch effort suggesting that “Hays claims priority to a PCT application.” To the extent this is correct, Petitioner did not rely on that priority application in the Petition or cite to it as disclosing any claim element. Petitioner's attempt to rely upon the PCT Application on Reply is improper. And even if this argument were properly presented, Petitioner does nothing to establish that this PCT Application meets any claim element or supports any disclosure within

the actually relied upon Hays reference, which as discussed, is not itself prior art. *See Reply, 25.*

XI. PO’S SECONDARY CONSIDERATIONS STAND UNREBUTTED.

Petitioner offers no evidence or argument in response to the Secondary Considerations of Non-Obviousness, including long-felt need for the invention (Response, 52-53) and teaching away (*id.* 55-56). To the contrary, Petitioner attempts to conflate console games and mobile games, suggesting that the existence of console updates suggests that there was no long felt need. Reply, 24. First, this ignores the claim language. Second, as Dr. Akl explains, in 2007 consoles already had extensive processing and memory capabilities (Ex. 2004, ¶42) and that “in contrast, due to the much more limited processing, storage, and data bandwidth capabilities of mobile devices, the only option available for mobile games, at that time, was to download an entire new game.” *Id.* ¶43. This testimony stands un rebutted by any credible evidence.

Petitioner does not address teaching away at all. Thus, this stands un rebutted. Further, Petitioner offered no evidence or argument in response to PO’s explanation of the state of the art, which necessarily informs the obviousness analysis. Response 3-8. This un rebutted evidence further confirms non-obviousness.

XII. CONCLUSION

Petitioner fails to shoulder its burden of establishing that Claims 1-9 are unpatentable.

Dated: December 13, 2024

Respectfully submitted,

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CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24(d), the undersigned certifies that this Sur-Reply contains 5,574 words according to the word-processing program used to prepare this paper. The foregoing word count complies with the 5,600 word type-volume limit specified by 37 C.F.R. § 42.24(b)(1).

Dated: December 13, 2024

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