

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

Inter Partes Review No.

IPR2024-00132

Patent No. 9,731,202

PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW

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I. Introduction

Patent Owner Flip Phone Games, Inc. (“FPG”) seeks director review of the Final Written Decision (Paper 29) (“FWD”) finding all claims of the ’202 Patent unpatentable. The claims require that updated video-game content be: (1) transmitted to a mobile device, and (2) usable in a game that already exists on the mobile device. But the Board purported to construe the claims by adding negative limitations, finding they “do not require an interactive object or new ad unit that is inserted into an existing game that alters the function of the game.” Aside from being inconsistent with the plain language of the claims, specification, and prosecution history, this negative construction tellingly includes terms from the cited prior art, not the intrinsic record. Further, the Board relies upon an expert declaration that does little more than parrot the Petition. The Director should correct these errors and confirm patentability.

II. Background

Independent Claim 1 requires:

A method for providing updated video-game content to a mobile communication device for *use in a mobile video game*, the method comprising the steps of:

receiving a request for the updated video-game content from the mobile communication device, the updated video-game content *being usable in the video game that already exists on the mobile communication device*;

checking what updated video-game content to send based on one of the factors including a type of the mobile communication device, a telecom service associated with the mobile communication device, and a service provider of the telecom service; and

uploading updated video-game content to the communications device, the video-game content being ***usable when the video game operates on the communications device***.¹

The Board incorrectly characterized FPG’s arguments as “implicat[ing] a claim construction dispute.” FWD at 10. Not so – FPG simply sought to apply the claims as written to the cited prior art, including the language “for use in a mobile video game” and “usable in the video game.” The Board wrongly stated that FPG’s arguments about the prior art sought to construe the claims to require “that the updated video-game content be an interactive object that is inserted into an existing game, or at least a new ad unit not already present in the game, and that the updated content alters the function of the game.” *Id.* at 11. The Board thus construed the “for use” terms as “not requir[ing] an interactive object or new ad unit that is inserted into an existing game that alters the function of the game.” *Id.* at 15.

In adopting its claim construction and analyzing these claim elements, the Board shaped its decision using two examples within Ex. 1005 (“Hays”): (1) an

¹ All emphasis added unless noted.

Energy Bar (Hays, [0019]) and (2) a Pepsi can (Hays, [0079]). *See* FWD at 23. The Board incorrectly found that these examples meet the claims, disregarding the claim language requiring uploading video-game content “for use” and “usable” in the game. *Id.* at 25-29.

III. Legal Standard for Director Review

“Requests for Director Review of a Board’s final decision under 35 U.S.C. §§ 135, 318, or 328, ... shall be limited to decisions presenting (a) an abuse of discretion, (b) important issues of law or policy, (c) erroneous findings of material fact, or (d) erroneous conclusions of law.” Director Review Process, § 2(B).² Further, “Decisions of the Board under Director Review are reviewed *de novo*.” *Id.* at § 5(A)(ii)(c). The erroneous findings of fact and conclusions of law in the FWD should be reversed.

IV. Argument

A. The Board Erred in Holding the Claims “Do Not Require an Interactive Object or New Ad Unit that Is Inserted into an Existing Game that Alters the Function of the Game”

The Board analyzed the various “use” terms (“for use in a mobile video game,” “usable in the video game,” and “the video-game content being usable when the video game operates”) in its claim construction section. *See* FWD at 9-16. The Board made clear that it construed these terms: after reciting the negative

² <https://www.uspto.gov/patents/ptab/decisions/director-review-process>

construction above, it stated “we do not find it necessary to provide express claim constructions for *any other claim terms*.” *Id.* at 15.

The Board’s construction broadened the claims to ignore the “for use” terms and read on the Hays prior art. Indeed, while the plain language of the claims requires receiving updated video-game content that is “for use” or “usable,” the Board’s “construction” excludes these requirements. *Id.* at 15. Further, the Board interprets the claims using terms such as “ad unit” found nowhere in the intrinsic record and only in the cited prior art. Thus, the Board’s construction does not define what the claims cover, but rather what the claims “do not require.” *Id.* (the claims “*do not require* an interactive object or new ad unit that is inserted into an existing game that alters the function of the game.”).

As explained, this flawed construction necessarily conflicts with the plain meaning of the claims and should be rejected.

i. The Board’s Construction Ignores that the Claim Requires that the Updated Video-Game Content Is Transmitted to the Mobile Device and Usable in the Video Game.

Under the Board’s construction the claim does not require updated video-game content to be “inserted into an existing game.” But this is exactly what the full claim language requires: “[a] method for *providing updated video-game content to a mobile communication device for use* in a mobile video game, comprising ... receiving a request for the updated video-game content from the

mobile communication device ... *uploading updated video-game content to the communications device.*” The Board’s construction ignores these requirements, and in so doing broadens the claim to cover content already found in the game. But content that is already found in the game necessarily cannot be the claimed “updated video-game content” under a plain reading of the elements above.

ii. The Board’s Construction Ignores the Plain Meaning of “For Use” and “Useable.”

In construing the claims not to require updated video-game content that “alters the function of the game,” the Board disregarded the plain meaning of “use” and “usable” as recited by the claim and described in the specification. In effect the Board broadly defined “usable” to include any content at all that is displayed or otherwise associated with the game, whether or not it is uploaded for use in the game. To reach its conclusion, the Board first cited an example from the specification describing different types of updates:

virtually any of these items may be changed by receiving updated content on the mobile communication device. For instance, the shirt 230 might be updated to include a logo associated with third party X (as shown). The poster 225 might advertise an upcoming movie for third party Y, and chalk board 220 may contain a handwritten advertisement for third party Z (as shown).

FWD at 12 (quoting Ex. 1001, col. 6:42-50). The Board urges that “[t]hese are examples of updated video-game content (updated advertisements on posters, T-

shirts, and chalk boards) that are usable (e.g., by the game or mobile communication device executing the game) in a video game that already exists on the mobile communication device.” FWD at 12. But the passage above never describes updated video-game content that is used or usable. Indeed, it does not include any conjugation of the verb “use” at all.

The Board further errs in suggesting that “[t]hese are also examples of ... ‘skins’ that correspond to existing *ad units* and that do not alter any function of the game.” FWD at 12. But the specification includes no description at all of an “ad unit.” Rather, this is a term the Board took from the prior art reference Hays, which the Board improperly conflates with the specification of the ’202 Patent.

Elsewhere the specification highlights content that is both updated and *usable* in the game as the claim requires. In addressing usable content, the specification describes “new weapons, interactive characters, levels, hot spots, and other items may be provided as part of the update. In short, any content element *used* in the mobile video game may be updated, depending on the embodiment.” Ex. 1001, col. 7:10-13. The Board discounted this example, saying that it “makes clear that ‘[o]ther content of the mobile video game, such as the shape, design coloring of dartboard 210 or the texture or coloring of background 215’ falls within ‘any content element used in the mobile video game.’” FWD at 14. The Board reads out the full context of the paragraph suggesting that “used” in the final

sentence encompasses any content throughout the paragraph. But nothing in the cited paragraph provides such a definition of “use,” and the second sentence plainly identifies content used by the player, e.g., “new weapons, interactive characters, levels, hot spots.” This aligns with purpose of the invention: “keep[ing] game elements fresh and prolong user enjoyment of the game.” Ex. 1001, 4:36-37.

iii. The Board’s Construction Ignores the Prosecution History.

The Board also discounted arguments during prosecution that shed further light on the meaning of “use” as recited by the claim. FPG explained that during prosecution it distinguished U.S. Pub. No. 2004/0127279 to Gatto’s (“Gatto”) description of items available for download via a hyperlink as not “usable” in the game. Ex. 1002 at 188 (“There is no indication that these promotional items are ‘usable in the video game.’ Indeed, it would not make sense for an email to provide hyperlinks for content that is usable in the email itself.”); *id.* at 189 (“A close reading of Gatto reveals that the ‘hyperlinks to download promotional items’ are, in fact, not usable in the so-called video game.”).

The Board found “the applicant distinguished Gatto because Gatto’s promotional content did not appear in the email that the Examiner alleged was a video game.” FWD at 15. The Board’s conclusion ignores that the prosecution history makes clear the meaning of usable in the video game, i.e., “[t]he available hyperlink ... causes the download of an entirely separate program or Internet

page.” Ex. 1002, at 142. In other words, content usable in the game is content that provides additional gameplay functionality, such as new weapons, interactive characters, levels and hot spots.

iv. The Board’s Construction Improperly Defines the Scope of the Claims Using Terms Found Only in Hays.

The Board’s construction further errs in that it expressly relies upon phrases not found anywhere in the claim or the specification—such as “new ad unit.” While not used by the ’202 Patent at all, “ad unit” is a term detailed throughout Hays. As explained below, Hays does not describe the “ad unit,” as something that is transmitted as updated video-game content. Thus, even if it were somehow proper to include it in the Board’s construction, this term is not relevant to the claims, which require sending the updated video-game content to the mobile device. The Board’s inclusion of terms from the prior art in the construction further demonstrates the improper lens through which the Board construed the claims.

B. Hays’s Interactive Ad Units Are Not “Updated Video-Game Content Being Usable in the Video Game that Already Exists”

The Board relies heavily on a single description in Hays of ad units that are “interactive.” FWD at 26 (citing Hays, [0019]). In reality, this paragraph of Hays describes “[s]ome available ad units may be interactive within the game (e.g., a game character eating a brand name energy bar to boost her power in the game, a brand-related ‘mini game’ presented between levels, a click-through

advertisement, etc.) and may bring aspects of the real world into the game (e.g., a player can enter a code from a product to provide advantages in the game).” None of these meets the requirements of the claim.

First, as described in Hays the ad unit is itself already in the game, not something that is “upload[ed]” as the claim requires. *See* Hays, [0018] (“the advertisement delivery scheme and associated facility present advertisements as texture maps or other graphical displays (e.g., animations, video, etc.) on pre-designated geometry within the game ... [e]ach of these spaces may be termed an ‘available ad unit’”); [0019] (“[w]hen a game is shipped, it may have a fixed set of available ad units”); [0074] (“The use of standardized available ad units facilitates the sale of advertising that spans across multiple games/titles because one advertisement can fit into many available ad units of a standard advertisement unit type.”). Thus, the ad unit itself necessarily cannot be the updated video-game content, because the ad unit is never itself selected and uploaded to the mobile device. Rather, it is already in the game.

Second, that the “ad unit” includes an energy bar does not alter this conclusion. Hays makes clear that the “items used by game characters (e.g., a brand name soft drink or energy bar) ... may be termed an ‘available ad unit.’” Hays, [0018]. The energy bar is already in the game at the time of installation. The only thing that may change is the branding of the energy bar, as Hays describes

“advertisement opportunities may be offered to advertisers based on standardized available ad units, which may include, ... packaging (e.g., packaging for products within the game such as cans, wrappers, bags, etc.” Hays, [0073]. This is further confirmed by Hays, Figure 6, which shows “a sample insertion order for selling advertisements space in association with the advertisement delivery scheme and associated facility.” *Id.*, [0010]. As shown in Figure 6, the “insertion order” expressly includes the specific “ad unit” in the game in which branding is to be placed. *See id.*, FIG. 6 (including as an example “packaging”). That the label on this packaging is updated does not alter anything in the game. Put another way, the “energy bar” provides the same benefits to the player regardless of whether it is blank, displays a real brand, or displays a fictional in-game brand. Thus, the label is not usable or interactive.

Rather, the ad unit is the only thing that may be usable—however, it is built into the game and not updated and thus cannot be the updated video-game content, as required by the claims. And the specification of the '202 Patent provides a similar example, which it does not describe as usable. Ex. 1001 at col. 5:7-10 (“in a previously-released game, a bar scene might be filled with updated bottles that show a company logo not present at the time of the game’s launch.”).

The other two examples, “a brand-related ‘mini game’ presented between levels” and “a click-through advertisement,” similarly fail to meet the claims. The

minigame is never described as sent to the game. *See* Hays, [0078]. Thus, it is not “updated video-game content being usable in the video game,” as the claims require. And this is exactly the embodiment in Gatto that the Applicant distinguished during prosecution, as discussed above. *See* Ex. 1002 at 188-189. Similarly, “a click-through advertisement,” is simply an advertisement, not “updated video-game content being *usable in the video game*.”

None of these examples meets the plain meaning of the claim elements.

C. The Pepsi Can Example in Hays Is Not “Updated Video-Game Content Being Usable in the Video Game that Already Exists”

The FWD also relies extensively on Hays’s description of an in-game character with a Pepsi can. FWD at 26-27. The full example from Hays is below.

In some embodiments, the 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).

Hays, [0079]. But the Pepsi graphic itself is, like the energy bar example above, just a skin placed on the ad unit associated with the can. The ad unit is the only element that may be functional, and there is no relevant difference between whether the can is blank, says Pepsi, or has an entirely different branding.

The Board rejected FPG’s arguments and instead urged that in this example, “the service system inserts more than a skin; it inserts a bot or agent that was not

part of the game before its insertion.” FWD at 28. But Hays never describes that “the bot or agent ... was not part of the game before its insertion.” *Id.* It merely says that the “system” (which includes the ad units in the game from the start) sends the bots or agents. And even if the Board were correct, Hays never once describes that the bot or agent is itself transmitted from a remote device. At most the bot or agent is controlled by “the advertisement management service system 108,” but that does not meet the claim’s requirement of “uploading updated video-game content to the communications device.” For similar reasons, the Board’s criticism of FPG’s argument that Hays never describes interaction with the bots is misplaced. *See* FWD at 28. The Board’s reliance on these bots as “ad units” makes clear that the bots were already in the game, and thus they necessarily cannot be the updated video-game content, as required by the claims. *See* Hays, [0018], [0019], [0074].

Hays elsewhere makes clear that the Pepsi can is just like the energy bar example discussed above, simply another ad unit that was already in the game. Indeed, Hays paragraph [0058] expressly describes the Pepsi can as part of the insertion order described in Figure 6. *See* Hays, [0058] (“The insertion order is then entered onto the advertisement serving database Pepsi may pay a premium to be the exclusive soft drink advertiser for a period of time. This would mean that a Coke advertisement could never run in the same game session as a Pepsi

advertisement.”). This insertion order expressly references the “Logo” or “Packaging” of the particular “Ad Unit” (624), and in this example Hays plainly contemplates the logo being either “Coke” or “Pepsi,” but never contemplates a different outcome based on that label. Hays, FIG. 6. And, as explained, Hays makes clear the “ad unit” is already placed within the game, and thus regardless of whether it is interactive, the ad unit itself cannot be the claimed “updated video-game content.”

Thus, like the energy bar example, Hays’s Pepsi can meets the claims only under the Board’s improper construction (*see* FWD at 25) which, as discussed, the Board tailored not based on the intrinsic record, but to capture Hays.

D. The Board Erred in Crediting Dr. Zagal’s Testimony Where Dr. Zagal Parroted the Petition.

The Board relies on Dr. Zagal throughout the FWD. But as FPG explained, Dr. Zagal’s testimony should be afforded no weight. *See, e.g.*, Paper 12 at 11-13 and 19-20. Dr. Zagal’s declaration is largely, and in some sections entirely, a word-for-word copy of the original Petition. This is particularly so with the elements above. *Compare* Petition at 14-16 (addressing element 1[pre]) *with* Ex. 1003, ¶¶92-95; *compare* Petition at 16-17 (addressing element 1[a]) *with* Ex. 1003, ¶¶96-98. Thus, the declaration should be afforded no weight, and the FWD improperly relied upon Dr. Zagal. *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9, at 18 (PTAB Aug. 24, 2022) (precedential) (an expert declaration is entitled to little

weight when it contains an exact restatement of the petition’s arguments without any additional supporting evidence or reasoning). Indeed, the Federal Circuit has consistently “rejected obviousness determinations based on conclusory expert testimony”—like Petitioner’s challenge here—noting that “crediting such testimony risks allowing the challenger to use the challenged patent as a roadmap to reconstruct the claimed invention using disparate elements from the prior art—i.e., the impermissible *ex post* reasoning and hindsight bias that *KSR* warned against.” *TQ Delta, LLC v. Cisco Sys., Inc.*, 942 F.3d 1352, 1361 (Fed. Cir. 2019).

The Board did not address this at all in the FWD and only addressed FPG’s arguments regarding the appropriate weight to afford Dr. Zagal in a footnote in the Institution Decision. *See* Paper 9 at n.1. It was improper for the Board to ignore this argument and to afford Dr. Zagal weight in view of his declaration being little more than a copy of the Petition. This is particularly so in view of new guidance confirming that Dr. Zagal’s faulty declaration, and the Petition’s extensive reliance on that declaration—properly counseled against institution.³

Dr. Zagal’s testimony is nothing more than a parrot of the Petition, and such testimony is unhelpful and should have been afforded no weight. *Xerox*, IPR2022-00624, Paper 9, at 18.

³ <https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management>

V. Conclusion

In view of the foregoing, FPG respectfully requests that the Director reverse the Decision and confirm the patentability of the claims of the '202 Patent.

Dated: May 23, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW** has been served via email on the following:

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