

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PLR WORLDWIDE SALES LIMITED,

Petitioner,

v.

FLIP PHONE GAMES, INC.,

Patent Owner.

Case No. IPR2024-00171

U.S. Patent No. 10,617,958

PETITIONER'S PRELIMINARY REPLY

The Preliminary Response is devoted almost entirely to discretionary denial-based arguments. Though they all lack merit, the Board has granted permission to address two.¹ *First*, Section 325(d) does not warrant denial because Hays and Levkovitz are not substantially the same as art cited during prosecution. *Second*, Petitioner’s claim construction positions are not inconsistent.

I. SECTION 325(D) DOES NOT WARRANT DENIAL

PO incorrectly argues that two of the Petition’s references—Hays and Levkovitz, neither of which were cited or considered by the examiner—are “substantially the same” as the Willis and Chatani references.

As an initial matter, PO’s 325(d) arguments apply **only** to Grounds 1 and 3. Grounds 2 and 4 also rely on Chu, which PO does **not** raise any 325(d) arguments; thus, on this basis alone, 325(d)-based denial is inappropriate.

With respect to Grounds 1 and 3, PO’s 325(d) analysis fails to meet the standard for discretionary denial. In determining whether art is “substantially the same prior art,” PO must establish that “Petitioner relies on [the new art] in substantially the same manner as the Examiner cited [the previous art] during

¹ To the extent PO argues it is improper for Petitioner to bring new arguments regarding these two issues, that is clearly foreclosed by the Board’s finding of good cause for this Reply because PO’s arguments were not foreseeable.

prosecution such that [the new art] discloses substantially the same information as [the previous art] in relevant part.” *Advanced Bionics*, IPR2019-01469, Paper 6 at 15 (P.T.A.B. Feb. 13, 2020) (precedential). PO has failed to do this, merely arguing there are irrelevant similarities.

Indeed, Hays and Levkovitz disclose the very limitations that were the basis for allowance. As explained in the Petition (Pet. 4), to overcome Bennett, Gatto, and Chatani, applicant agreed to amend the word “content” to the currently as-claimed “in-game advertising.” Ex. 1002, 84, 37-38; Pet. 4. The Petition clearly distinguished Hays and Levkovitz from such art. Pet. 4, 19-20, 41-42.

Patent Owner ignores this distinction and focuses on irrelevant similarities, arguing that both Hays and Levkovitz “relate to sending content to a video game for display.” POPR 18. Obviously, sending the claimed “in-game advertising” falls under sending content. The relevant difference is that Hays and Levkovitz specifically send “in-game advertising,” not just content generally. For example, Hays discloses that “[t]he selected **advertisements** are then sent back ... to the advertisement recipient client **for display**” “at the appropriate time during game play.” Ex. 1005, ¶¶43, 21; Pet. 19-20. Similarly, Levkovitz discloses the “**ad** server ... serve[s] content items [*i.e.* advertising] directed **for presentation** using a first application 176 (e.g. a chess **game**).” Ex. 1008, ¶127; Pet. 41-42. Thus—unlike

Chatani—Hays and Levkovitz expressly disclose sending in-game advertisements. Had the Examiner been aware of them, the claims would not have been allowed.

Similarly, in the prosecution of the parent '202 patent, the Board held Willis sends advertisements “based on the **physical geographic location of the gamer**,” but “not **based on the console type**” as recited by the claims in the '202 patent. Ex. 2002, 42. Patent Owner thus argues that both Hays and Levkovitz send advertisements “based **in part** on their location.” POPR 18-19. The '958 patent has no such limitation, but in any case, Hays and Levkovitz **also** send advertising based on console/device type. IPR2024-00132, Paper 2 at 4, 17-20, 46-47.

PO also argues that the '202 patent’s “ten-year examination ... weighs heavily against institution,” citing to dicta in non-precedential *Juniper Networks*. POPR 19. *Juniper* only says prosecution length is a factor “where some of the references were at issue.” *Id.* at 10 n.5; CBM2016-0075, Paper 16 at 8 (“[T]hose references were presented to **and extensively considered** by the Office.”). The Office did not consider Hays and Levkovitz and they are materially different from those that were.

II. THERE IS NO INCONSISTENT CLAIM CONSTRUCTION HERE

PO accuses Petitioner of “abuse of process” because Petitioner contended in the District Court that some terms are indefinite. POPR 21-25. But Petitioner’s positions are not inconsistent. *See* Pet. 11 (the Petition takes “no position ... as to whether the claims are indefinite”); Ex. 1003, ¶¶68-69. Moreover, Petitioner does

not currently contend in the litigation that any claims of the '958 patent are indefinite, and never proffered any evidence in furtherance of such a contention.

Regardless, it is axiomatic that one may “ascribe some meaning” to a term that is nevertheless indefinite. *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898 (2014); *Interval Licensing, LLC v. AOL, Inc.*, 766 F.3d 1364, 1371-72 (Fed. Cir. 2014) (terms indefinite for lack of objective boundaries). As a result, the Board “need not necessarily determine the outer boundaries of a claim” to decide “whether the asserted prior art anticipates a claim or renders it obvious.” *Mylan Pharms. Inc. v. Horizon Pharma USA*, IPR2017-01995, Paper 72 at 5-6 (Mar. 28, 2019); *Standard Oil Co. v. American Cyanamid Co.*, 774 F.2d 448, 453 (Fed. Cir. 1985) (affirming indefiniteness and obviousness).

Here, Petitioner had only proposed that one term from the independent claims was indefinite: “pre-selected.” Though the outer boundaries of that term may be indefinite, it clearly includes content selected in advance. The Petition identifies where the prior art discloses such content.

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

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

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

For the foregoing reasons, institution should not be denied.

Date: March 25, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on March 25, 2024, true and correct copies of the foregoing document were served in its entirety on the following parties via Electronic Mail

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