

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. IPR2024-00171

Patent No. 10,617,958

PATENT OWNER'S PRELIMINARY SUR-REPLY

EXHIBIT LIST

Ex.	Description
2001	Playrix's Exchange of Proposed Terms and Claim Elements for Construction, served January 30, 2024
2002	Prosecution History of U.S. Patent No. 9,731,202

Petitioner's Reply ignores the Petition's § 325(d) analysis and introduces new arguments on discretionary denial. The parent of the '958 Patent went through ten years of prosecution, including a decision from the Board, finding the claims patentable over similar art—a highly relevant fact with respect to § 325(d). On the claim construction issue, Petitioner shifts its positions yet again, dropping indefiniteness and raising a new construction of the term “preselected” which it now says is “content selected in advance.” But the Petition fails to show that the cited art meets this new construction and instead addresses, at most, only selecting content. The Board should exercise discretion and deny institution.

I. Discretionary Denial is Warranted Under § 325(d)

The Reply's argument regarding § 325(d) is entirely new and should not be considered. *See* Consolidated Trial Practice Guide (“TPG”) at 73 (“Petitioner may not submit new evidence or argument in reply that it could have presented earlier....”). The Petition included a section addressing § 325(d). *See* Petition at 51. Therein, Petitioner urged against denial because none of the references addressed during prosecution “contain a substantially similar disclosure of a mobile game with dynamically updated hot spots represented in-game as non-promotional background objects, as is disclosed in the combinations described in the Grounds presented herein.” *Id.* Thus, the Petition failed to address the relevant prior art and claim language. The Board should disregard new argument presented in Reply. TPG at 73.

Petitioner newly suggests that FPG's § 325(d) arguments regarding Hays and Levkovitz apply to only Grounds 1 and 3. This is wrong. There is only one additional reference (Chu), and the Petition does not use Chu to address any element of an independent claim; instead raising it only as an alternative ground for dependent Claims 3 and 10. Petition at 34-35 and 49-50. Such use of secondary references does not foreclose discretionary denial. *See Ziegmann v. Stephens*, No. IPR2015-01860, Paper 11 at 9 (P.T.A.B. Feb. 24, 2016) (denying institution where a primary reference "was substantively presented to and considered by the Office," but was presented in the petition "in view of several secondary references."). Indeed, in *Juniper Networks, Inc. v. Finjan, Inc.*, the Petitioner argued that denial was not appropriate because "notwithstanding the use of Hanson, the Petition asserts prior art ... that has never been considered by the Office." No. IPR2019-00060, Paper 7 at 13 (P.T.A.B. Apr. 29, 2019). As the Board explained, "the reliance on Hanson and previously presented arguments [is] a factor that strongly weighs in favor of denial of this Petition"—regardless of the newly added references. *Id.* at 15. The same is true here, where the primary references—Hays and Levkovitz—are used in every ground and every element of the independent claims and are substantially the same as the art previously considered by the Examiner and the Board during prosecution.

As explained, Hays and Levkovitz describe providing advertising to mobile devices based on location, just like the Willis reference considered during

prosecution. *See* POPR at 18-19. Similarly, each of Hays and Levkovitz relates to sending content to a video game for display, just like the Chatani reference considered during prosecution. Petitioner acknowledges these similarities, but nonetheless urges—without authority—that they are somehow “irrelevant.” Reply at 2. These similarities weigh in favor of denial. 35 U.S.C. § 325(d).

Petitioner newly argues that § 325(d) denial is also improper because “[o]bviously, sending the claimed ‘in-game advertising’ falls under sending content.” *First*, this is not the claim element, which requires “utiliz[ing] the request to: check what ***pre-selected*** in-game advertising to send.” *Second*, as explained, the Petition failed to address content that was “pre-selected.” POPR at 34-41.

Finally, Petitioner attempts to distinguish the Board’s decision in *Juniper*, suggesting that the length of prosecution is only a factor where the same reference was submitted during prosecution. Reply at 3. This is wrong. *Juniper* stated that the § 325(d) factors are “non-exclusive,” and that “additional circumstances, not fitting within any of the listed factors, may be relevant to our exercise of discretion under § 325(d) in the context of examination.” *Juniper Networks, Inc. v. Mobile Telecoms. Techs., LLC*, IPR2017-00642, Paper 31 at 10 (P.T.A.B. Mar. 14, 2018). *Juniper* further explained that “11 years of prosecution history, which included multiple appeals to the Board,” would be one of those factors. *Id.* at n.5. In an informative decision, the Board has also explained that while “length of prosecution and the

numbers of Office Actions and Board Decisions do not, by themselves, definitively mandate for or against institution on a particular ground, on these facts, ... they do weigh heavily against institution of the prior art grounds proffered by Petitioner.” *Kayak Software Corp. v. IBM Corp.*, No. CBM2016-00075, Paper 16 at 12–13 (P.T.A.B. Dec. 15, 2016) (*informative*). The Board should decline to review this patent, whose parent it has already considered and found patentable over similar art during an appeal and ten years of prosecution. *See* POPR at 17–23.

II. Inconsistent Claim Construction Positions Doom the Petition

The Reply implicitly concedes that Petitioner’s claim construction positions were inconsistent, but brushes that off by saying “Petitioner does not *currently* contend in the litigation that any claims of the ’958 patent are indefinite.” Reply at 4. Petitioner’s litigation position, however, was stated in a pleading (Ex. 2001) signed months *after* Petitioner represented to the Board that it “does not believe any terms require construction.” Petition at 11.

In an attempt to mask this inconsistency, the Reply now urges that “[t]hough the outer boundaries of that term may be indefinite, it clearly includes *content selected in advance*.” Reply at 4 (emphasis added). This argument is new. But more critically, the Petition does not even attempt to establish that Hays and Levkovitz disclose “content selected in advance,” as Petitioner’s new construction requires.

Rather than addressing this new construction, the Petition, at most, addresses selecting content, without explaining how that content is “preselected.” With respect to Hays, the Petition simply states: “the advertisements are stored in a storage medium (such as the storage media of a database or server) and they are pre-selected.” Petition at 20. Similarly, the Petition states that Levkovitz “selects advertisements by utilizing the request to determine the requested conditions for the selected advertisements.” The Petition never addresses how content is “preselected,” much less that it is “content selected in advance,” under Petitioner’s construction.

Petitioner’s cited authority does not support its inconsistent positions. In *Western Digital Corp. v. SPEX Techs., Inc.*, the petition was based on the claim constructions urged by the **patent owner** in related district court litigation. IPR2018-00082, Paper 11 at 12 (Apr. 25, 2018). Similarly, in *Philip Morris Products, S.A. v. Rai Strategic Holdings, Inc.*, the petitioner relied on the **patent owner’s** constructions to argue the claims were unpatentable. IPR2020-00921, Paper 13 at 42 (Aug. 5, 2021). In contrast, here Petitioner first argued the claim was indefinite and then changed to a new construction. But the Petition fails to establish that the cited art meets this new construction. Thus, the Petition must fail.

III. Conclusion

Petitioner fails to carry its burden, and no proceeding should be instituted.

Dated: April 1, 2024

Respectfully submitted,

/Michael T. Morlock/
Michael T. Morlock
Reg. No. 62,245
Lead Counsel for Patent Owner

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **PATENT OWNER'S PRELIMINARY SUR-REPLY** has been served electronically via email upon the following:

jimglass@quinnemanuel.com
quincylu@quinnemanuel.com
ronhagiz@quinnemanuel.com
nimahefazi@quinnemanuel.com

Dated: April 1, 2024

By: /Michael T. Morlock/
Michael T. Morlock
Reg. No. 62,245
Lead Counsel for Patent Owner