

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 RESPONSE

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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	Prosecution History of U.S. Patent No. 9,731,202
2003	U.S. Patent No. 9,731,202 (the '202 Patent)
2004	Declaration of Dr. Robert Akl, D.SC.
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.

I. INTRODUCTION

Patent Owner Flip Phone Games, Inc. (“FPG” or “Patent Owner”) submits this Response to the Petition and Institution Decision. The Board instituted review of claims 1-14 (the “Challenged Claims”) of U.S. Patent No. 10,617,958 (the “’958 Patent”). But Petitioner PLR Worldwide Sales Limited (“Petitioner” or “Playrix”) has not met its burden of proving unpatentability of any of these claims.

None of the prior art teaches the fundamental feature claimed by the ’958 Patent: updating content without updating the entire mobile video game. The ’958 Patent allows for these updates based on claimed steps of checking what updated content to send. Updates of this nature changed the face of mobile gaming as it existed on the June 2007 priority date by allowing game developers to add new features in games, which drive user engagement and avoid problems with fully downloading and updating the game.

This significant feature was absent in mobile video games in June 2007. Petitioner relies on two primary references describing advertisement servers (“ad servers”). But the references fail to disclose multiple elements of the two independent claims, as described below. None of the references discloses “*pre-selected* in-game advertising *for use* in a video game.” The Petition largely ignores both of these requirements, treating pre-selected as the same as “selected,” and

rendering “for use” meaningless by asserting that it covers any content accessed by game code.

The independent claims aside, the Petition fails as to several dependent claims for additional reasons. For instance, none of the references discloses or renders obvious “the server sends information to the mobile communication device regarding the in-game placement location of the content, the information being part of the updated content,” as required by claims 3 and 10. And none of the references discloses that “the server tracks the distribution of updated content,” as required by claims 7 and 14.

As explained further below, Petitioner failed to carry its burden, and the Board should affirm the patentability of the Challenged Claims.

II. LEVEL OF SKILL IN THE ART AND EXPERT TESTIMONY

This Patent Owner Response is supported by the expert testimony of Dr. Robert Akl (Ex. 2004), who has decades of experience in the relevant technology area. As Dr. Akl explains, a person of ordinary skill in the art (“POSITA”) of the ’958 Patent would have a bachelor’s degree in electrical engineering, computer engineering, computer science, or a similar field, along with one to two years of experience developing or programming video games or video game systems, or similar types of computer systems. Ex. 2004, ¶28. Alternatively, a POSITA may have additional education that might substitute for some of the experience, and

additional substantial experience might substitute for some of the educational background. *Id.*

Petitioner proposes a POSITA definition that includes a person with “an undergraduate degree in game design or development, computer science, computer engineering, or a related field, with at least two years of experience working with computer gaming systems or software application development.” Petition at 2; Ex. 2004, ¶29. Thus, Petitioner does not require experience in programming video games, but only “working with computer gaming systems or software application development.” This difference does not materially affect the analysis presented below, however.

III. PRIORITY DATE

As expressly recognized by Petitioner, the relevant time for the Board to consider is the claimed priority date of the '958 Patent: June 26, 2007. *See* Petition at 1. The '958 Patent is a “divisional” of U.S. Application No. 11/768,892 (the “'892 Application”), which was filed on June 26, 2007. '958 Patent, at 1:4–6. The '958 Patent thus shares “substantially the same specification” as the '892 Application (now U.S. Patent No. 9,731,202). *Two-Way Media Ltd. v. Comcast Cable Commc'ns, LLC*, 874 F.3d 1329, 1332 (Fed. Cir. 2017).

Written description support for the Challenged Claims of the '958 Patent, respectively, is found in at least the following non-limiting portions of the '892 Application, as filed on June 26, 2007 (Ex. 2002 at 293-337), respectively:

'958 Patent, Claim Element¹	Example Support in the '892 Application (Filed June 26, 2007)
1[pre]	[0009], [0011], [0031], [0036], [0040], Figs. 3A, 3B, 4B.
1[a]	[0018], [0032], [0039], [0078], [0090] Fig. 1.
1[b]	[0030], [0036], [0038]-[0040], Figs. 1, 3A, 3B.
1[c]	[0038], [0063], [0092], [0094], Figs. 1, 4B.
1[d]	[0036], [0040], [0052], [0058]-[0063], Figs. 3A, 3B, 4B.
1[e]	[0040], [0066], [0069], [0090], Figs. 3A, 3B, 4B.
2	[0047], [0069], [0097], Claim 2.
3	[0016], [0019], [0081], Claim 22, Fig. 3B.
4	[0012], [0019], [0067]-[0070], Claim 23.
5	[0019], [0070], [0094], [0096], Claim 24.
6	[0017], [0020], [0066]-[0067], Claim 17.
7	[0017], [0020], [0066], [0077], [0101], Claim 26.
8[pre]	<i>See</i> Claim 1[pre].
8[a]	<i>See</i> Claim 1[a].
8[b]	<i>See</i> Claim 1[c].
8[c]	<i>See</i> Claim 1[d].
8[d]	<i>See</i> Claim 1[e].
9	<i>See</i> Claim 2.
10	<i>See</i> Claim 3
11	<i>See</i> Claim 4.
12	<i>See</i> Claim 5.
13	<i>See</i> Claim 6.
14	<i>See</i> Claim 7.

¹ *See* Petition at List of Challenged Claims.

IV. BACKGROUND

A. Mobile Gaming Technology Was Entirely Different as of the June 26, 2007, Priority Date of the '958 Patent.

As of the priority date of the '958 Patent, June 26, 2007, as Dr. Akl explains, the claimed invention was both novel and non-obvious. Ex. 2004, ¶¶34-39. The Petition ignores the broader context and history of mobile gaming in 2007, and instead adopts a hindsight-driven viewpoint to suggest that technology that was novel in 2007 was somehow well-known and basic simply because it is used widely today. Ex. 2004, ¶¶40-42.

The '958 Patent describes and claims a novel and unconventional way of using mobile games and mobile devices, involving “updating in-game content on a mobile communication device” based on specified criteria, which “may prolong user interest in a game for a mobile communication device.” Ex. 2003, 2:7-11²; *see also* Ex. 2004, ¶37. The innovative mobile gaming technology claimed in the '958 Patent originates from mobile game developer Mobile Deluxe (“MDX”), which was founded in 2003 and is the precursor of FPG. Ex. 2006, ¶8. At that time, smartphones and modern online stores for smartphone app purchases (“App Stores”) had not been

² The '958 Patent claims priority to U.S. Patent No. 9,731,202 (the '202 Patent), which is challenged in a related proceeding, IPR2024-00132. For convenience citations to the specification of the Challenged Patent are to the '202 Patent (Ex. 2003).

launched, and the mobile gaming landscape was very different than it is today. *Id.* ¶9.

It was not until mid-2008, a full year after the filing of the application to which the '958 Patent claims priority, that modern App Stores became available.³ Ex. 2004, ¶40. Before that time, mobile games had a very short life cycle. Ex. 2004, ¶¶41-42. Wireless carriers each managed their own individual app store or “deck,” with a limited catalog of games (typically several hundred titles). Ex. 2004, ¶42. Once that capacity was reached, the carrier would be forced to remove or “sunset” older game titles to make room for new games. Ex. 2004, ¶42.

As the '958 Patent describes, “all video games tend to have a popularity life span” and after the end of that span, “the user may stop playing that particular game in favor of others.” *Id.* at 1:28-32; *see also* Ex. 2004, ¶36. Because of this short life cycle, carriers, developers, and publishers did not update a game during its lifetime, and there was no expectation a game would evolve. Ex. 2004, ¶41. Rather, mobile games were a one-time purchase, typically \$4.99 to \$9.99 each. Ex. 2004, ¶45. Instead of updating pre-existing mobile games, developers would, for example, launch a sequel to a game, which would be treated by carriers as a new title,

³ *See, e.g.*, <https://www.apple.com/newsroom/2018/07/app-store-turns-10/> (“Apple introduced the App Store on July 10, 2008....”); <https://pickaso.com/en/2020/google-play-store-evolution> (“Android’s store that ... launched in 2008 under the name of Android Market, and then renamed Google Play Store.”).

triggering a new lifecycle for that new title. Ex. 2004, ¶¶43-45. The specification explains that “[a]s game elements become increasingly familiar to players, the game may hold less surprises and/or no longer present a challenge to the user, at which point the user may stop playing that particular game in favor of others.” *Id.* at 1:29-32; *see also* Ex. 2004, ¶36. Thus, as of the priority date of the ’958 Patent, mobile games had a limited life cycle, and game developers addressed loss of user interest by releasing new mobile games rather than updating existing mobile games. *See* Ex. 2004, ¶45.

The ’958 Patent’s claims provide a unique solution to the problem of updating content in response to a request by a mobile device to do so, for instance such that “the updated content may comprise a new level within the game” or “the user has something new to look at or explore.” *Id.*, 4:31-45; *see also* Ex. 2004, ¶37. This improvement was groundbreaking at the time and was far from obvious in a 2007, pre-App Store and pre-smartphone world’s static approach to mobile gaming. *See* Ex. 2004, ¶46.

B. Petitioner’s Faulty Summary of the State of the Art Relies on Materials that Are Not Prior Art, Not Raised in Any Ground, and that Confirm the Patentability of the ’958 Patent’s Claims.

The Petition suggests that “[g]ame developers embraced the idea of updateable games even before mobile games became popular.” Petition at 7; *see also* Ex. 2004, ¶233. To support this position, Petitioner relies on unauthenticated

documents that are not prior art, and which, in fact, demonstrate the non-obviousness of the claimed invention of the '958 Patent in June 2007. Indeed, each of these references (and the prior art references) relate to the “provision and display of advertisements in a video game,” as Petitioner admits, on PC and console devices. Petition at 7. The references, in fact, do not explain providing “pre-selected in-game advertising for use in a video game,” as the claim requires. Ex. 2004, ¶¶232-233.

The Petition relies on Exhibit 1015, an article purportedly published in Australia and entitled “Productive Play 2.0: The Logic of In-Game Advertising.” *See, e.g.*, Petition at 7. Putting aside that Petitioner does nothing to authenticate this article, *it is not prior art*. Indeed, it states on its face that it was published in February 2009, more than a year and half *after* the claimed priority date of the '958 Patent. *See* Ex. 1015 at 2. Even then, the first paragraph of the article states that “suggestive events for *the future of online gaming* took place in the spring⁴ of 2007” (Ex. 1015 at 1 (emphasis added)) confirming that as of the June 2007 priority date, the invention provided by the '958 Patent was novel. Ex. 2004, ¶237.

The Petition also relies on Exhibit 1016, a thesis entitled Advertising in Computer Games. *See, e.g.*, Petition at 7. While this thesis is stamped with the date September 28, 2006, Petitioner tellingly does not submit any evidence corroborating

⁴ Spring in Australia occurs from September to November, after the June 2007 priority date. <https://www.australia.com/en-us/facts-and-planning/when-to-go/australias-seasons.html>

it is a publication at all, let alone demonstrating that the thesis actually published on this date, or otherwise authenticating the Exhibit. Nor does Petitioner rely on Exhibit 1016 as a prior art reference. Further, this thesis states in its abstract that “[t]his paper suggests advertisers should experiment with in-game advertising to gain skills that could become vital in the *near future*.” Ex. 1016 at 2 (emphasis added); *see* Ex. 2004, ¶¶235, 237. And indeed, as discussed in further detail below, such in game advertising is not “for use” in the videogame. Ex. 2004, ¶235.

The Petition next relies on Exhibit 1017, a press release purported to be dated March 21, 2006, and entitled In-Game Advertising Goes Mobile. *See, e.g.*, Petition at 7. As with Exhibit 1016, Petitioner submits no evidence corroborating the date of alleged publication or authenticating this Exhibit. Petitioner does not rely on Exhibit 1017 as a prior art reference, nor could it, as the press release is barely over one-page and provides no technical details at all. Ex. 2004, ¶236. Further as with the other exhibits, Exhibit 1017 states “[i]n the *near future*, mobile in-game advertising *will become* increasingly attractive for providers of mobile phones.” Ex. 1017 at 1 (emphasis added); *see* Ex. 2004, ¶237. Thus, this press release does not describe prior art, but merely describes what may happen in the *future*. Ex. 2004, ¶¶236-237.

Finally, the Petition relies on Exhibit 1018, purportedly published in 2001. *See, e.g.*, Petition at 7; *see also* Ex. 2004, ¶234. Petitioner likewise submits no evidence corroborating the date of alleged publication or authenticating this Exhibit.

Exhibit 1018 similarly never shows what was available as of the June 2007 priority date of the '958 Patent. Ex. 2004, ¶¶234, 237. Indeed, Exhibit 1018 expressly describes “[t]he biggest change between the current game technologies *and the future ones* is that in the future it will be possible to offer also games with realtime interactivity.” Ex. 1018 at 50 (emphasis added); *see* Ex. 2004, ¶237. Further, this article confirms exactly the need to address the problem that the '958 Patent in fact solved, describing that “life cycle[s] of [] certain game[s] will [be] quite short, and will be replaced by more trendy games very promptly.” Ex. 1018 at 52; *see* Ex. 2004, ¶237.

V. GROUNDS 1-2: NONE OF THE HAYS GROUNDS RENDERS THE CHALLENGED CLAIMS OBVIOUS.

As explained further below, Hays fails to disclose numerous claim limitations.

A. Ground 1: Hays Does Not Render the Challenged Claims Obvious.

1. Claims 1[a] and 8[a]: Hays does not disclose “*pre-selected in-game advertising*”

Hays describes an advertising matching and weighting system. In particular, Hays explains that “[t]he advertising matching and weighting system 220 may calculate the weight of each advertisement based on several factors” Ex. 1005, [0043]. The Hays factors include “campaign goal and completion data from the advertisement serving database 122 and information regarding the specific client

type from the advertisement recipient database 120.” *Id.*; Ex. 2004, ¶54. Thus, Hays selects advertisements (the alleged updated in-game advertising) from a weighted set, “where the probability of an advertisement being selected is directly derived from the advertisement’s assigned weight, relative to other advertisements in the set.” Ex. 1005, [0043]; Ex. 2004, ¶54. While Hays describes weighting advertisements for selection, Hays never describes that these advertisements are “pre-selected,” as is required by the claims. Rather, Hays weights advertisements against each other for dynamic real-time selection.

The Institution Decision suggests that “the parties may wish to address the interpretation of the phrase ‘pre-selected in-game video game content.’” Paper 9 at 9. Further, the Institution Decision states that claims 1 and 8 may “encompass choosing from among pre-selected content.” *Id.* at 13. While pre-selected content identified based on the claimed factors could be “selected” and sent, extending the claim to content that is merely selected from storage and sent gives no meaning to pre-selected as required by claims 1 and 8, which require “check[ing] what pre-selected in-game advertising to send.”

Further, merely “selecting” advertising from stored data does not give effect to dependent claims 5 or 12 because all data is stored before selection and selecting an advertisement does not show pre-selection of an advertisement, as required. Claims 5 and 12 confirm as much, by making it clear that the message is pre-selected

based upon various factors related to the mobile communications device or its service provider. Thus, content is not shown to be pre-selected by selecting it from storage and sending.

The Petition similarly fails to ascribe the proper meaning to pre-selected and never distinguishes between the selection of an advertisement and a “pre-selected” advertisement. With respect to “pre-selected,” the Petition states merely:

Hays discloses that ‘advertisers can target the delivery of their advertisement campaign specifically to a sub-channel as that sub-channel relates to their campaign,’ where a sub-channel includes ‘genre such as sports titles ..., children’s titles, racing titles, etc.,’ or ‘may subtarget by time of day (e.g., deliver advertising to all gaming devices playing at 8 p.m. on Thursday) or by game play date (e.g., once the game has been played for 45 minutes—air the Domino’s ad campaign, or in the fourth inning of the sports title, air the XYZ campaign). Ex. 1005, ¶22. In other words, Hays teaches that advertisers can *pre-select* which advertisements to deliver to which genre of games or which time of the day or which event within the game.

Petition at 14 (citing Ex. 1003, ¶89). This conclusory statement never addresses whether the advertisements are “pre-selected.” Rather, it points the very ad-targeting system discussed in Hays for selecting advertisements.

The only paragraph of Hays the Petition cites as meeting the “pre-selected” limitation, paragraph [0022], describes “the advertisement server may then (through matching and optimization) distribute and deliver targeted advertisements to players’ gaming devices, where the advertisements may be integrated into the relevant game areas in real time.” Ex. 1005, [0022]. This “real time” ad targeting

system says nothing of “pre-selected” advertisements. Ex. 2004, ¶55. To the contrary, it selects advertisements in “real time,” meaning that these advertisements are necessarily not “pre-selected.” Ex. 2004, ¶57.

The remainder of the paragraph includes no further description of “pre-selected;” instead it discusses the various data points that may be used for the “real time” selection by “target[ing] the delivery of their advertisement campaign specifically to a sub-channel as that sub-channel relates to [the advertising] campaign.” Ex. 1005, [0022], Ex. 2004, ¶¶56-58. These “sub-channels” relate to the location of “available advertisement spaces,” in groups of games, which “can be divided by genre such as sports titles (and even further by specific sport), children’s titles, racing titles, etc.” Ex. 1005, [0022]. Thus, these “sub-channels” have to do with the target for a particular advertisement, e.g., in a particular game or at a particular time of day. This is irrelevant to whether a particular advertisement is “pre-selected;” rather this is simply a further description of how an advertisement is targeted to a particular category of game or game player, such that multiple players may see the same advertisement. Ex. 2004, ¶58. As Hays describes the sub-channel “targeting may include the game devices of game players involved in multiplayer games (who may all see the same advertisement simultaneously).” Ex. 1005, [0022]. But this is irrelevant to whether a particular advertisement was “pre-selected,” versus simply being selected. Ex. 2004, ¶59.

Thus, rather than addressing the claim element, which requires “pre-selected in-game advertising” the Petition instead conflates this element with a weighting process that selects an advertisement. The Petition offers no additional analysis for the other independent claim, claim 8. *See* Petition at 31. Thus, the Petition’s analysis of this claim element does not address these distinctions between Hays and the Challenged Claims of the ’958 Patent and cannot carry its burden of establishing obviousness.

2. Petitioner’s Expert Testimony Should Be Afforded Little Weight

Petitioner relies on Dr. Zagal to attempt to bolster the Petition’s analysis of this claim element, but this too fails. Dr. Zagal adds nothing to the analysis. Rather, his entire “opinion” is nothing more than parroting the Petition almost word-for-word. *Compare* Petition at 13-14 (addressing element 1(a)) *with* Ex. 1003, ¶¶ 87-89. Indeed, Dr. Zagal does not add anything at all to the analysis. Rather, he simply repeats the text of the Petition almost *verbatim*. And the single paragraph addressing “pre-selected” (Ex. 1003, ¶89), is, but for the addition of the three words “In my opinion,” a word-for-word copy of the same paragraph in the Petition. *See* Petition at 14.

Such parroting adds nothing to the Petition—which as discussed is insufficient—and Dr. Zagal’s parroting should be afforded no weight, to the extent

it is accepted at all. *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9, at 18 (P.T.A.B. Aug. 24, 2022) (precedential) (denying institution where Petitioner’s expert “offers only a *verbatim* restatement of the assertion being supported, without any supporting evidence or technical reasoning.”).

3. Claims 1[a] and 8[a]: Hays does not disclose advertising “*for use* in a video game”

Claims 1[a] and 8[a] both further require “pre-selected in-game advertising *for use* in a video game.” The Petition never addresses the claim element requiring that this advertising be “*for use* in a video game.” Indeed, the section of the Petition addressing this claim element uses the word “use” exactly once, in the first sentence which quotes the claim language. *See* Petition at 13-14. The Petition never actually addresses the limitation requiring “use,” and thus cannot carry its burden of establishing obviousness.

Even if the Petition had addressed this element—it did not and Petitioner should not be authorized to bolster this failure on Reply—it could not establish that Hays discloses the limitation requiring “use.” At most, Hays discloses an advertisement delivery scheme that can be deployed in the context of a video game on a mobile device. Ex. 2004, ¶¶62-63. Hays does not disclose that its advertisements are “for use” in the video game. Instead, Hays is limited to displaying advertisements from external providers. Ex. 2004, ¶64. These advertisements are

untethered from game functionality, and instead merely represent “skins” that are displayed within the gaming environment but that do not affect game play. *See, e.g.*, Ex. 1005, [0017]-[0019]; Ex. 2004, ¶64.

Indeed, Hays explains that the ads can be presented as “commercial-like intermissions” or “as texture maps or other graphical displays (e.g., animations, video, etc.) on pre-designated geometry within the game.” *See, e.g.*, 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, such as billboards, storefront signs, panel trucks, Jumbotron screens in a sports stadium, posters on walls, T-shirts on a game character, items used by game characters (e.g., a brand name soft drink or energy bar), and so on.”). These advertisements are not “for use” in a video game as required by claim 1.

In particular, Hays never describes that any of its “ad units” alter the functionality of the game based on whether an advertisement is displayed, much less that the functionality is specific to an advertisement versus the preexisting placement location, i.e., the “ad unit.” Ex. 2004, ¶63. Rather, at most, Hays describes pre-designated ad units that may be “interactive within the game.” Ex. 1005, [0019], [0079]. But these ad units are not updated content “for use” in the game because, to the extent there is any game functionality associated with an “ad unit,” that

functionality is the same regardless of whether an advertisement is displayed on the ad unit. Ex. 2004, ¶64. As Dr. Akl explains, the ad units are graphical “skins” that are displayed on items that are already present in the game. Ex. 2004, ¶64. The ad units display as their skin an advertisement to promote external products, not features or anything else “for use” in the mobile video game. Nor do the ad units relate to any in-game purchases. Ex. 2004, ¶¶64, 71-73. Indeed, Hays’s ad units are presented “across one or multiple game titles played across multiple platforms” and are “not limited to a single specific game title.” Ex. 1005, Abstract, [0017]; Ex. 2004, ¶64. Hays, thus, explains that the ad units are not intended for use in a mobile video game.

As one example “ad unit,” Hays describes an in-game can on which the skin of the brand Pepsi may be displayed. (Ex. 1005, [0058]). But Hays never describes altering the functionality of the game based on whether a Pepsi ad is displayed on this particular ad unit versus if the can were left blank or displayed a fictional brand. To the contrary, Hays makes clear that the ad unit, in this case the can, is nothing more than “pre-designated geometry within the game.” Hays, [0018]. Hays does not describe that inclusion of an advertisement on the ad unit enables additional functionality or modifies functionality that can be used in the video-game. Put another way, the video game described in Hays operates in the same way whether the can is blank or says Pepsi, and similarly the user does not experience any

differences in the game based on the Pepsi skin being applied to the can versus there being no or a different advertisement. Ex. 2004, ¶¶71-72. Hays thus does not disclose “in-game advertising *for use* in a video game.”

Hays’s disclosure is similar to the prior art discussed during prosecution of the ’202 Patent, to which the ’958 Patent claims priority. *See* Ex. 2002. There, the applicant successfully presented arguments to achieve allowability based upon the same claim language requiring that the updated content be for use and usable in the video game. Ex. 2004, ¶¶65-67. To overcome a rejection based on U.S. Pub. No. 2004/0127279 to Gatto (“Gatto”), the applicant distinguished Gatto’s description of items available for download via a hyperlink as not “usable” in the game. Ex. 2002 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 (“the Examiner fails to address the remaining claim language of this element-namely, whether this content is ‘usable in the video game that already exists on the mobile communication device.’ A close reading of Gatto reveals that the ‘hyperlinks to download promotional items’ are, in fact, not usable in the so-called video game.”); *see also* Ex. 2004, ¶66. Elsewhere during prosecution, the applicant explained in detail that the “hyperlink” described in Gatto is not “updated ‘promotional items’ or content that would be ‘usable in’ the email ticket or a ‘video game’ itself, as opposed to a separate application program.”

Ex. 2002 at 166. Later the applicant made clear that Gatto “does not teach or suggest any updated content that is ‘useable in’ a video game.” *Id.* at 142. Rather, “[t]he available hyperlink ... causes the download of an entirely separate program or Internet page.” *Id.* Thus, the applicant expressly distinguished during prosecution the concept of a link to content used in a separate application, which is similar to Hays’s ad unit linked to an ad server that provides a skin, from the claimed “in-game advertising *for use* in a video game.” Ex. 2004, ¶¶68, 72.

Thus, Hays does not teach or suggest “in-game advertising *for use* in a video game,” as required by claims 1 and 8. And, as with the element discussed above, Dr. Zagal’s purported “testimony” with respect to these elements is little more than a word-for-word copy of the Petition and should thus be afforded no weight. *Compare* Petition at 13-14 (addressing element 1(a)) *with* Ex. 1003, ¶¶ 87-89. In contrast, as cited above, Dr. Akl offers detailed testimony outlining Hays’s failure to disclose these claim elements. *See* Ex. 2004, ¶¶61-74.

Because Hays does not render claim either claims 1 or 8 obvious (*see* Ex. 2004, ¶¶98-99), claims 2-7 are also not rendered obvious and 9-14 are similarly not rendered obvious. And, as addressed further below, claims 3, 5, 7, 10, 12, and 14 are not obvious for independent additional reasons.

4. Claims 3 and 10: Hays does not disclose that “the server sends information to the mobile communication device

regarding the in-game placement location of the content, the information being part of the updated content.”

Claims 3 and 10 both require that “the server sends information to the mobile communication device regarding the in-game placement location of the content, the information being part of the updated content.” Petitioner contends that this claim is met by Hays’s disclosure of “ad units,” or spaces that include “pre-designated geometry within the game” that “are in-game placement locations associated with advertising.” Petition at 21. While Hays describes pre-designated locations for “ad units,” Hays never discloses “send[ing] information to the mobile communication device regarding the in-game placement location of the content, the information being part of the updated content.” Ex. 2004, ¶¶75-76, 100. And, as Dr. Akl explains, a POSITA could implement Hays’s ad unit system without sending coordinate information with ad data. Ex. 2004, ¶¶77-78.

More specifically, the advertisements in Hays are placed in “specific ad units” or “*pre-designated* geometry within the game.” Ex. 1005, [0018] (“the advertisement delivery scheme and associated facility present advertisements ... on pre-designated geometry within the game, such as billboards, storefront signs, panel trucks, Jumbotron screens in a sports stadium, posters on walls, T-shirts on a game character, items used by game characters”); *see also id.* at [0029]; [0040]. While Hays discloses transmitting advertisements it never discloses transmitting any

information regarding the placement location of an advertisement. Ex. 2004, ¶¶77, 80. Indeed, Hays explains 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]. Hays is, thus, clear that the ad units are “standardized” and not related to any specific in-game placement location. *See, e.g., id.* at [0073]-[0074]; *see also* Ex. 2004, ¶¶77, 80.

Petitioner relies on Dr. Zagal to attempt to cure this deficiency, but Dr. Zagal, again, only parrots the Petition and, thus, his testimony should be afforded little weight. *Compare* Petition at 21-23 (addressing claim 3) *with* Ex. 1003, ¶¶102-106; *see Xerox Corp.*, IPR2022-00624, Paper 9, at 18. In contrast, Dr. Akl explains how a POSITA would have understood the art at the time of invention and explains how a POSITA would not have found the claimed invention obvious. Ex. 2004, ¶¶78-80. As Dr. Akl provides, a POSITA would understand that Hays does not send location information with advertising. Ex. 1005, [0073]; Ex. 2004, ¶80. Thus, Hays fails to teach or suggest either of claims 3 or 10.

5. **Claims 5 and 12: Hays does not disclose that “the message is pre-selected by the server based on a model type associated with the mobile communication device, a service subscription associated with the mobile communication**

device, or a service provider for the service subscription associated with the mobile communication device.”

Claims 5 and 12 both require that “the message is pre-selected by the server based on a model type associated with the mobile communication device, a service subscription associated with the mobile communication device, or a service provider for the service subscription associated with the mobile communication device.”

Petitioner contends that the user device of Hays sends “a request for advertisements” to the server. *See* Petition at 26 (citing Ex. 1005, [0040]). But this is irrelevant to the claim, which requires “the message is pre-selected by the server,” which necessarily does not cover a message sent to the server from the device that will display the advertisement. Ex. 2004, ¶¶83, 101.

Petitioner also points to Hays’s advertising matching and weighting system, which also does not meet this claim element. *See* Petition at 26. Hays does not disclose selecting an advertisement, much less ***pre-selecting*** “message relating to the content,” based on any of the factors required by claims 5 and 12. Ex. 2004, ¶¶86-87. Rather, Hays explains that “[t]he advertising matching and weighting system 220 may calculate the weight of ***each advertisement*** based on several factors” Ex. 1005, [0043]. The Hays factors include “campaign goal and completion data from the advertisement serving database 122 and information regarding the specific client type from the advertisement recipient database 120.” *Id.*; Ex. 2004,

¶86. Thus, Hays is clear that weights are assigned, or advertisements are matched, based on factors associated with *the advertisements*. Ex. 2004, ¶86. Indeed, Hays selects advertisements from a weighted set, “where the probability of an advertisement being selected is directly derived from the advertisement’s assigned weight, relative to other advertisements in the set.” Ex. 1005, [0043]; Ex. 2004, ¶86.

A POSITA would understand that the weighting and matching system of Hays selects what advertisement to send based on factors related to the advertisement, *i.e.*, “the advertisement’s assigned weight.” Ex. 2004, ¶87; Ex. 1005, [0043]. Further, this assigned weight is “relative to other advertisements in the set,” and thus the weighting is between individual advertisements. Ex. 1005, [0043]. In contrast, claims 5 and 12 require the use of the explicitly recited factors related to the mobile communication device, *i.e.*, “a model type associated with the mobile communication device, a service subscription associated with the mobile communication device, or a service provider for the service subscription associated with the mobile communication device.” These factors are related to the mobile device receiving the data, not the data itself. Ex. 2004, ¶87. In contrast, Hays weights the data (*i.e.*, the advertisements) against other advertisements for targeting purposes. Ex. 1005, [0043]; Ex. 2004, ¶¶86-87. And Hays targets advertising based on “campaign goal and completion data” (Ex. 1005, [0043]) or “specific demographic characteristics of a game player,” (*id.*, [0044]), but neither of these

discloses checking the specific factors required by claims 5 and 12. Ex. 2004, ¶¶86-87.

A POSITA would also understand that Hays’s matching and weighting system selects advertising. This is distinct from the step recited by claims 5 and 12, because these claims require pre-selection of a “message relating to the content,” based on a compatibility determination with the user’s mobile device. Ex. 2004, ¶87. This step requires that “the message is pre-selected by the server based on,” the factors required by the claim. Ex. 2004, ¶87. A POSITA would have understood that, at the time of the invention, this would have required checking for compatibility of the updated content with the mobile device and service provider, which operated on different platforms. Ex. 2004, ¶¶87-91. In contrast, Hays is simply comparing and weighting or ranking advertisements, not the recited factors. *Id.*

As with the other claims above, Petitioner relies on Dr. Zagal to attempt to cure this deficiency, but Dr. Zagal, again, only parrots the Petition and, thus, his testimony should be afforded little weight. *Compare* Petition at 25-28 (addressing claim 5) *with* Ex. 1003, ¶¶112-118; *see Xerox Corp.*, IPR2022-00624, Paper 9, at 18. Thus, the Petition fails with respect to claims 5 and 12 for this additional reason.

6. Claims 7 and 14: Hays does not disclose that “the server tracks the distribution of updated content.”

Claims 7 and 14 each require that “the server tracks the distribution of updated content.” Petitioner contends that Hays discloses “tracking” and “recording” what advertisements have been sent. But this “tracking” is not related to “the distribution of updated content,” and instead, is only based on “sessions,” which would at most only represent a portion of any data uploaded to a mobile communications device. Ex. 1005, [0045]; Ex. 2004, ¶¶93, 102. This fails for two reasons: first, “session” data would not represent all of the uploaded content that has was uploaded to a mobile communications a device in its entirety; and second, “session” data would not show what has been “uploaded” to the mobile communications device. Ex. 2004, ¶¶93-96.

Each of the three paragraphs of Hays Petitioner relies on makes clear that the tracking in Hays is related to a “session,” not the updated content uploaded to the mobile device. Petition at 29-30 (citing Ex. 1005, [0038], [0045], [0025]); Ex. 2004, ¶¶93-95. Petitioner first relies on Paragraph [0038] in which Hays discloses “a record in the *active session database* 124, which registers the game player as the first member of the new session and is used to track and record all communications and data sent to and received from the advertisement recipient client 104,” which is only data recorded for an “active session,” or a period a user is playing a game, not

uploaded content. Ex. 1005, [0038]; Ex. 2004, ¶93. Paragraph [0045] is similarly limited to an “active session.” *Id.*, [0045]; Ex. 2004, ¶93.

Paragraph [0025] of Hays is similarly distinguishable. Petitioner alleges that Hays “discloses that ‘services that track and audit the quality of presentation of the in-game advertisements,’ including ‘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).” Petition at 30; Ex. 2004, ¶95. But this is related to the advertisement itself, not “the distribution of updated content,” and it in no way addresses what content was distributed. Ex. 2004, ¶95. At most it describes information regarding the presentation of an advertisement, rather than when an advertisement has been uploaded. Ex. 2004, ¶¶95-96.

As with the other claims above, Petitioner relies on Dr. Zagal to attempt to cure this deficiency, but Dr. Zagal, again, only parrots the Petition and, thus, his testimony should be afforded little weight. *Compare* Petition at 29-30 (addressing claim 5) *with* Ex. 1003, ¶¶122-125; *see Xerox Corp.*, IPR2022-00624, Paper 9, at 18. Hays thus fails to disclose “track[ing] the distribution of updated content,” as claims 7 and 14 require.

B. Ground 2: Hays In View of Chu Does Not Render Claims 3 and 10 Obvious.

Petitioner alleges that claims 3 and 10 are obvious in view of Hays in combination with Chu, but the proposed combination fails to teach or suggest the claimed “server sends information to the mobile communication device regarding the in-game placement location of the content, the information being part of the updated content.” Further, Petitioner fails to carry its burden of establishing that there is a motivation to combine Hays with Chu.

1. Claims 3 and 10: Hays in view of Chu does not teach or suggest a “server sends information to the mobile communication device regarding the in-game placement location of the content, the information being part of the updated content.”

As explained above, Hays describes only that advertisements are transmitted to the client and placed in ad units. Hays fails to disclose, teach, or suggest “send[ing] information to the mobile communication device regarding the in-game placement location of the content, the information being part of the updated content.” Chu does not cure this deficiency. Ex. 2004, ¶¶103-106.

The Petition asserts that Chu “specifies locations” for advertisements and provides “[a] location object (530, 630) [that] represents the location within a game at which advertisements are to appear.” Petition at 35 (quoting Ex. 1007, 14:20-15:5). The Petition also asserts that Chu discloses sending the location information

from the server to the client as claim 3 requires, but this disclosure is entirely absent from Chu. Petition at 35. Instead, Chu explains the opposite – how information is provided from the client to the server. 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....”), 14:20-15:5; Ex. 2004, ¶106. Chu does not describe providing information from the server to the client, as the claim requires.

Indeed, as Dr. Akl explains, Chu explicitly states that “***game clients must pass the server information*** such as but not limited to ***the location identifiers*** that uniquely identify an ad within a game....” Ex. 1007, 14:31-33; *see also id.*, 14:50-54 (“After an online game running on a game console or 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.”). Each of these criteria described in Chu is sent from the client to the server, not from the server to the client as the claim requires. Ex. 2004, ¶106.

The Petition also relies on testimony from Dr. Zagal, which again adds nothing to the analysis. Dr. Zagal’s opinion consists of three paragraphs nearly identical to the Petition that should not be given any weight. *Compare* Petition at 34-35 *with* Ex. 1003, at ¶¶134-136; *see Xerox Corp.*, IPR2022-00624, Paper 9, at 18. Notably, Dr. Zagal fails to explain how Chu’s client-based system would be

modified for or implemented into Hays's server system. Ex. 2004, ¶¶105-106, 108-114. Thus, the Petition fails to establish that Hays in view of Chu renders claims 3 and 10 obvious.

2. There Is No Motivation to Combine Hays and Chu.

A POSITA would not have found it obvious to modify Hays's system in light of the teachings of Chu. The Petition asserts that a POSITA would have been motivated to modify Hays to include "Chu's teaching of a video game requesting 'advertising metadata and schedules that determine what advertisements are to display in *specified locations* within the game,' and in turn receiving advertisements that include '[a] location object (530, 630) [that] represents *the location within a game* at which advertisements are to appear.'" Petition at 32-33 (quoting Ex. 1007, 14:20-15:5). While Hays discloses specific ad units on items regardless of their location, Ex. 1005, at [0073], [0074]-[0080], a POSITA would not have sought to modify Hays's specific ad units to transmit placement information. Ex. 2004, ¶111.

Indeed, as Dr. Akl explains, and as explained above, Hays is directed to an ad server which can provide advertisements across a variety of games, regardless of the specific gaming environment, while Chu is directed to a specific, online gaming system. Ex. 2004, ¶¶110-111. Hays teaches against designing a game (or advertisement therein) in such a narrow nature. Ex. 2004, ¶¶110-111. Modifying Hays to include specific location information, as allegedly provided in Chu, would

have been counterproductive to Hays's purpose and broad applicability. In fact, Hays's ad units are not fixed to a specific location and advertisements are sent to ad units "regardless of [their] location." Ex. 1005, [0073]; Ex. 2004, ¶111.

Dr. Zagal asserts that "[a] POSITA would have been motivated to use Chu's teachings of the server providing to the client the specific in-game locations of advertisements because of the well-known benefits of being able to display advertisements at in-game locations." Ex. 1003, ¶131; *see* Ex. 2004, ¶112. But, in doing so, he ignores the purpose of Hays. Ex. 2004, ¶112. As Dr. Akl explains, Hays provides advertisements regardless of the location and attaches them to one or more ad units in games. Ex. 2004, ¶112. Based on Hays's disclosure, a POSITA would not have sought to modify Hays's system to display advertisements at in-game locations, let alone "control the location and viewing of advertisements," as Dr. Zagal erroneously asserts. Ex. 2004, ¶112. A POSITA would not have been motivated to control the location of advertisements in Hays's system which expressly provides that advertisements are sent to the ad units "regardless of [their] location." Ex. 1005, [0073], Ex. 2004, ¶112.

Further, Hays teaches the server sending advertisements to be displayed at ad units. Ex. 2004, ¶113. In contrast, Chu describes requests from the client, not from the server. Ex. 2004, ¶113. A POSITA would have understood that these systems operate in different manners based on how the content is sent, *i.e.*, whether the

content is pulled or pushed. Ex. 2004, ¶113. Thus, contrary to Dr. Zagal’s assertion that “[a] POSITA would have reasonably expected the proposed Hays and Chu combination to succeed,” (Ex. 1003, ¶133), a POSITA would not have reasonably expected a combination of Hays’s push system with Chu’s pull system to succeed. Ex. 2004, ¶¶113-114.

VI. GROUNDS 3-4: NONE OF THE LEVKOVITZ GROUNDS RENDERS THE CHALLENGED CLAIMS OBVIOUS.

As explained further below, Levkovitz fails to disclose numerous claim limitations.

A. Ground 3: Levkovitz Does Not Render Claims 1-2, 4-9, and 11-14 Obvious.

1. Claims 1[a] and 8[a]: Levkovitz does not disclose “*pre-selected in-game advertising*”

Levkovitz discloses a system for “delivering targeted advertisements” (*i.e.*, an advertisement server). More specifically, Levkovitz describes including “advertisements or banners, within an application executed by a cellular phone,” which may include “a game.” Ex. 1008, [0005], [0123]. But nothing in Levkovitz provides or suggests that the updated content (or advertisements) are “pre-selected,” as is required by the claims.

With respect to “pre-selected,”—just as with the Hays Grounds discussed above—the Petition never distinguishes between the selection of an advertisement

and a “pre-selected” advertisement. With respect to “pre-selected,” the Petition states merely:

A “content item” is, for example, a pre-selected in-game advertisement. Ex. 1003, ¶142. Content items include “advertisements.” Ex. 1008, ¶152. These “content items” are “directed for presentation using a first application 176 (e.g., a chess game),” and are therefore *for use in a video game*. *Id.*, ¶127. The content items are “previously stored in the content items repository 118” and are therefore *pre-selected*. *Id.*, ¶126; *see also* ¶147 (“Data transferor 124 may distribute content items to ad server(s) 110 periodically and/or in advance.”).

Petition at 37 (citing Ex. 1003, ¶142). This conclusory statement never addresses whether the advertisements are “pre-selected.” Rather, it suggests that any advertisement at all that is stored in the server of Levkovitz is necessarily pre-selected. But this renders the term “pre-selected” meaningless as compared with “selected.” Ex. 2004, ¶¶116-117.

The Petition first points to Levkovitz, [0152], but this paragraph is clear that “Ad server 110 may selectively provide to communicator 150 one or more content items, e.g., advertisements, *in response to a content request* from communicator 150.” Ex. 1008, [0152]. This does not disclose that any content is “pre-selected.” Instead, it expressly describes supplying an advertisement “in response to a content request.” Ex. 2004, ¶117. This is nothing more than selecting content in response to a request and does not disclose that the content is “pre-selected.” Ex. 2004, ¶¶117-118.

The Petition next cites to Levkovitz, [0127], which simply describes that “ad servers 150 may include multiple servers which may be shared among multiple campaigns or may be dedicated for a specific campaign or type of operation.” Ex. 1008, [0127]. The paragraph goes on to explain that multiple ad servers may address different types of content, e.g., “a first ad server 150 may serve content items directed for presentation using a first application 176 (e.g., a chess game), whereas a second ad server 150 may serve content items directed for presentation using a second application 176 (e.g., a racing game).” *Id.* Again, this is irrelevant to whether content is “pre-selected.” Ex. 2004, ¶¶118-119. Rather, this describes that content may be sourced from different servers depending on the type of content. Ex. 2004, ¶¶118-119. But this is irrelevant to whether that content is “pre-selected.” Ex. 2004, ¶119.

Likewise, paragraph [0126] describes that “ad server 150 may obtain a content request from the queue 150, and may search a content items repository 118 within ad server 110 for one or more content items which match the requirements of the content request.” Ex. 1008, [0126]. This describes nothing more than searching a repository for content matching a content request. Ex. 2004, ¶118. At most this describes selection of stored content in response to a request. Ex. 2004, ¶118. But this does not disclose or suggest that the content is “pre-selected,” because content

is not “pre-selected” simply because it is stored and then later selected. Ex. 2004, ¶118.

Levkovitz [0147] describes that certain content may be intended for release at a specific time. But again this does not disclose that this content was “pre-selected;” rather it simply discloses delaying access to particular content until it is made available for selection. *See* Ex. 1008, [0147] (“This may allow ad server(s) 110 to serve content items at their intended serving time, even if temporarily the ad server(s) 110 may not be able to access the control server 120 at that time or closely prior to that time.”); Ex. 2004, ¶120. Yet content that is time-restricted, e.g., withheld until the launch of a “‘live’ campaign period” is simply content that is not yet made available. Ex. 2004, ¶120. This does not disclose that the content is pre-selected, as the claim requires. Ex. 2004, ¶120.

Thus, Levkovitz does not disclose “pre-selected in-game advertising,” as is required by claims 1 and 8.

2. Petitioner’s Expert Testimony Should Be Afforded Little Weight

As with the grounds discussed above, Petitioner relies on Dr. Zagal to attempt to bolster the Petition’s analysis of this claim element. And as he did with the other elements, Dr. Zagal simply parrots the Petition, offering nothing to its flawed analysis. *Compare* Petition at 36-37 (addressing element 1(a)) *with* Ex. 1003, ¶¶140-

142. Dr. Zagal simply repeats the text of the Petition almost *verbatim*. And in the single paragraph addressing “pre-selected” (Ex. 1003, ¶142), Dr. Zagal repeats word-for-word the conclusory sentence that “The content items are ‘previously stored in the content items repository 118’ and are therefore pre-selected.” Petition at 37, Ex. 1003, ¶142. Such parroting adds nothing to the Petition. *Xerox*, IPR2022-00624, Paper 9, at 18 (P.T.A.B. Aug. 24, 2022).

3. Claims 1[a] and 8[a]: Levkovitz does not disclose advertising “*for use in a video game*”

Claims 1[a] and 8[a] both further require “pre-selected in-game advertising *for use* in a video game.” Levkovitz discloses a system for “delivering targeted advertisements” (*i.e.*, an advertisement server). More specifically, Levkovitz describes including “advertisements or banners, within an application executed by a cellular phone,” which may include “a game.” Ex. 1008, [0005], [0123]. But nothing in Levkovitz provides or suggests that the updated content (or advertisements) are “for use in a video game.” Ex. 2004, ¶¶122-131.

Instead, as the Petition concedes, Levkovitz merely discloses “serv[ing] content items directed for presentation....” Petition at 11 (quoting Ex. 1008, [0127]); *see also* Ex. 1008 at [0363] (“In some embodiments, advertisements delivered using WAP to device 1501 may include, for example, textual content, audio content, graphic content, video content, informational items, coupons, promotion items,

banner, banner ads, or the like.”). This is nothing more than the placement of content such as banner ads within the game, which are not usable in the video game as the claim requires. Ex. 2004, ¶¶123-124. Petitioner contends that content is “‘directed for presentation using a first application 176 (e.g., a chess game),’ and [is] therefore *for use in a video game.*” Petition at 37 (quoting Ex. 1008, [0127]). This does not describe that the content is actually “for use” in the video game. Ex. 2004, ¶124. Rather, at most it describes that the content is displayed within the video game. Ex. 2004, ¶124. Display in a video game does not disclose that content is used, i.e., part of the functionality of that video game. Ex. 2004, ¶124.

Further, Levkovitz’s disclosure is fully consistent with the prior art discussed during prosecution, which the applicant overcame. Ex. 2004, ¶¶125-128. As discussed above, during prosecution, to overcome a rejection based on Gatto, the applicant distinguished Gatto’s description of items available for download via a hyperlink as not “usable” in the game. Ex. 2002 at 188 and 189. The applicant explained in detail that the “hyperlink” described in Gatto is not “updated ‘promotional items’ or content that would be ‘usable in’ the email ticket or a ‘video game’ itself, as opposed to a separate application program.” *Id.* at 166. Later the applicant made clear that Gatto “does not teach or suggest any updated content that is ‘useable in’ a video game.” *Id.* at 142. Rather, “[t]he available hyperlink ... causes the download of an entirely separate program or Internet page.” *Id.* Thus, the

applicant expressly distinguished during prosecution the concept of a link to content used in a separate application, like a portal to data provided by an ad server, from the claimed “usable” content.

Again, this is consistent with the understanding of a POSITA at the time of invention. Ex. 2004, ¶¶128-129. As Dr. Akl explains, a POSITA would have found the hyperlinks analogous to ads served via WAP protocol. Ex. 2004, ¶¶128-129. Ads served by browser-based or WAP-based methods are distinct from a gaming application already downloaded on the mobile device. Ex. 2004, ¶¶128-129.

Petitioner attempts to cure this deficiency by relying on Dr. Zagal, but as he does throughout his declaration, Dr. Zagal simply parrots the Petition. *Compare* Petition at 36-37 *with* Ex. 1003, at ¶¶140-142. This should be afforded little weight. *See Xerox Corp.*, IPR2022-00624, Paper 9, at 18. In contrast, Dr. Akl explains how a POSITA would have understood Levkovitz at the time of the invention of the ’958 Patent, and why it does not disclose these aspects of claims 1 and 8. Ex. 2004, ¶¶122-131.

The advertisements displayed by Levkovitz are not “*for use* in a video game.” Thus, Levkovitz fails to render claim 1 obvious.

4. Claims 1[e] and 8[d]: Levkovitz does not disclose “send[ing] the pre-selected in-game advertising stored on the storage

medium to the mobile communication device as the updated content for the mobile video game.”

Claims 1[e] and 8[d] both require the step of “send[ing] the pre-selected in-game advertising stored on the storage medium to the mobile communication device as the updated content for the mobile video game.” Petitioner contends Levkovitz’s ad server completes this step. But this WAP-based ad-server does not disclose uploading any content to the to the mobile communication device.

Levkovitz’s ad server uses “Wireless Application Protocol” (WAP) (*i.e.*, a browser on a mobile device). As shown in Figure 7 of Levkovitz, for example, data is not uploaded to a mobile device (or any user device) in WAP Protocols. *See, e.g.*, Ex. 1008, Fig. 7; Ex. 2004, ¶133. WAP operates like a web browser that retrieves and caches content but, notably, does not require downloading or uploading content. Ex. 2004, ¶133. Indeed, Levkovitz teaches away from uploading content, as it explains that “[prior art] operations, in which content is downloaded to or uploaded from the wireless device, may consume system resources and bandwidth resources, and may require a user to pay a fee to cover the cost of using such resources.” Ex. 1008, [0003]; *see* Ex. 2004, ¶133. Levkovitz attempts to solve this problem, and consume less resources, by **not** uploading (or downloading) content. Ex. 1008, [0003]; *see* Ex. 2004, ¶133. Thus, Levkovitz does not teach or suggest “send[ing] the pre-selected in-game advertising ... to the mobile communication device as the

updated content for the mobile video game” as required by claims 1 and 8 of the ’958 Patent.

Because Levkovitz does not render claims 1 and 8 obvious (*see* Ex. 2004, ¶139), claims 2, 4-7, 9, and 11-14 are also not rendered obvious. And, as addressed further below, claims 7 and 14 are not obvious for independent reasons.

5. Claims 7 and 14: Levkovitz does not disclose that “the server tracks the distribution of updated content.”

Claims 7 and 14 each require that “the server tracks the distribution of updated content.” Petitioner asserts that Levkovitz teaches this limitation because first due to the operations of control server 120. Petition at 45 (citing Ex. 1008, [0143]). But Levkovitz is explicit that control server 120 “monitor[s] and track[s] the distribution of content items *among multiple ad servers 110*,” and thus does not track distribution of the updated content to the recipient mobile devices. Ex. 1008, [0143]; Ex. 2004, ¶¶135-136, 141.

The Petition next cites to Levkovitz paragraph [0154], but again this paragraph does not describe tracking “distribution,” i.e., what has been uploaded. Rather, this describes “a log tracking the activity or servings done by ad server 110,” which at most discusses tracking what content has been presented or what presentations have been performed. Ex. 2004, ¶135. The Petition goes on to cite to Levkovitz, [0171], which describes exactly the same thing, i.e., a log that tracks the

“number of servings of content items (e.g., every 100 impressions, every 500 impressions, etc.).” Ex. 1008, [0171]. As before, this does not track what has been uploaded, but rather what has been viewed. Ex. 2004, ¶135.

Further, content (or advertisements) could be uploaded and not presented, and *vice versa*, content could be presented but not uploaded. Ex. 2004, ¶¶136-138. This is particularly true because Levkovitz uses WAP protocols, as shown in its figures. *See, e.g.*, Ex. 1008, Fig. 7; Ex. 2004, ¶136. With WAP protocols, a POSITA would know that data is not uploaded to the mobile device. Ex. 2004, ¶136. Instead, WAP operates like a web browser that retrieves and caches content but does not require downloading or uploading. Ex. 2004, ¶136. As Dr. Akl explains, a POSITA would understand that Levkovitz teaches presenting advertisements, but not uploading, through the WAP-based protocol described. Ex. 2004, ¶136.

Instead, a POSITA would understand that Levkovitz teaches away from uploading content. Ex. 2004, ¶137. Levkovitz explains that “[prior art] operations, in which content is downloaded to or uploaded from the wireless device, may consume system resources and bandwidth resources, and may require a user to pay a fee to cover the cost of using such resources.” Ex. 1008, [0003]; *see* Ex. 2004, ¶137. A POSITA would understand that Levkovitz consumes less resources by not uploading (or downloading) content. *See* Ex. 2004, ¶137. Thus, because Levkovitz’s WAP-based ad server does not disclose uploading content, it similarly does not

disclose “the server tracks the distribution of updated content,” as required by claims 7 and 14.

B. Ground 4: The Combination of Levkovitz and Chu Does Not Render Claims 3 and 10 Obvious.

Petitioner asserts claims 3 and 10 are rendered obvious by Levkovitz in view of Chu. Chu, however, fails to disclose that “the server sends information to the mobile communication device regarding the in-game placement location of the content, the information being part of the updated content.” Thus, the combination of Levkovitz and Chu does not render obvious this limitation. Further, Petitioner failed to show a motivation to combine Levkovitz and Chu.

1. Claims 3 and 10: Levkovitz and Chu do not teach or suggest that “the server sends information to the mobile communication device regarding the in-game placement location of the content, the information being part of the updated content.”

The Petition solely relies on disclosures in Chu to allege that this limitation is met. Specifically, the Petition asserts that “Chu discloses that a video game requests ‘advertising metadata and schedules that determine what advertisements are to display in *specified locations* within the game,’ and in turn receiving advertisements that include ‘[a] location object (530, 630) [that] represents *the location within a game* at which advertisements are to appear.’” Petition at 49 (quoting Ex. 1007,

14:20-15:5 and citing Ex. 1003, ¶176). As explained with the Hays combination, Chu, instead, describes the opposite of the claimed invention.

Specifically, claims 3 and 10 both require that the *server* send information providing an in-game placement location with the updated content, but Chu describes that information is provided from the client 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...”); *see also id.*, 14:50-54. The Petition does not cite testimony from Dr. Zagal (or any other evidence) to show that it would have been obvious to modify the Levkovitz-Chu combination to “send[] information from the server to the mobile communication device regarding the in-game placement location of the content, the information being part of the updated content,” rather than to send placement location from the device to the server. Ex. 2004, ¶¶143-145. In fact, it would not have been obvious to do so as described further below. Ex. 2004, ¶¶143-145.

Thus, the combination of Levkovitz and Chu fails to render claim 4 obvious.

2. There Is No Motivation to Combine Levkovitz and Chu.

Petitioner asserts that a POSITA would have been motivated to modify the ad server of Levkovitz to “include Chu’s teaching of a video game requesting ‘advertising metadata and schedules that determine what advertisements are to display in specified locations within the game.’” Petition at 47. Petitioner further

asserts that this would result in “receiving advertisements that include ‘[a] location object (530, 630) [that] represents the location within a game at which advertisements are to appear.’” Petition at 47 (quoting Ex. 1007, 14:20-15:5) (alternation in original).

Levkovitz describes a method for presenting advertisements from a server to a client device. Ex. 2004, ¶150. Chu, however, describes a method in which information is provided from the client to the server. 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....”); see Ex. 2004, ¶¶146-149.

Chu’s teaching is opposite from Levkovitz’s teaching of delivering targeted advertisements. Ex. 2004, ¶149. Levkovitz relates to the server sending specified ads while Chu only relates to information sent from the client, not communications from the server. Ex. 2004, ¶149. A POSITA would, thus, have not been motivated to combine these two systems as they operate in opposite manners. Ex. 2004, ¶149.

Moreover, Petitioner did not show that this teaching could be modified with testimony from Dr. Zagal. Dr. Zagal’s testimony is conclusory and merely parrots the Petition, which should carry little, if any, weight. *Compare* Petition at 47-49 with Ex. 1003, at ¶¶169-174; see *Xerox Corp.*, IPR2022-00624, Paper 9, at 18. In stark contrast, Dr. Akl thoroughly explains why a POSITA would not have been motivated to modify these teachings or combine them. Ex. 2004, ¶¶146-151. Indeed, as Dr. Akl

explains, Levkovitz seeks to serve advertisements broadly, like an ad banner. Ex. 2004, ¶¶150-151. A POSITA would not seek to modify Levkovitz's broad system with Chu's narrow disclosure of placing ads at a particular location. Ex. 2004, ¶¶150-151. Even so, such a modification would not arrive at the claimed invention, as described above.

Thus, Petitioner has not shown that a POSITA would have been motivated to combine Levkovitz and Chu.

VII. OBJECTIVE INDICIA SHOW THE NON-OBVIOUSNESS OF THE CHALLENGED CLAIMS

"The objective indicia analysis is ... a fundamental part of the overall § 103 inquiry." *Liqwd, Inc.*, 941 F.3d at 1137 (Fed. Cir. 2019) (citation omitted). It is an essential safeguard that protects against hindsight bias. *In re Cyclobenzaprine Hydrochloride Extended-Release Capsule Pat. Litig.*, 676 F.3d at 1079.

Petitioner asserts that the challenged claims would have been obvious in 2007, but the real-world evidence, including evidence cited by Petitioner, shows that mobile phone developers experienced difficulty with creating new features or levels in game that would not require significant space associated with downloading an entire new game. Ex. 2004, ¶¶231-238. There thus was a long-felt need for the invention of the '958 Patent before June 2007. There is a specific nexus between this long-felt need and the claimed invention, because the claim itself provides the

solution for “send[ing] the pre-selected in-game advertising stored on the storage medium to the mobile communication device as the updated content for the mobile video game,” wherein that “pre-selected in-game advertising [is] for use in a video game.”

Indeed, at the time of the invention of the '958 Patent, the mobile game landscape was very different. Ex. 2004, ¶233. Modern App stores were not available, and each wireless carrier had to manage their own offering of mobile games. Ex. 2004, ¶¶232-233. Further, game engines, or the software architecture necessary to develop games (like the invention of the '958 Patent) was not yet developed, which led to a short lifecycle for games. Ex. 2004, ¶¶232-233.

Game development in other contexts (e.g., console games) did not face the same issues. Ex. 2004, ¶233. And the issues and constraints were even tighter in the context of mobile gaming, with the added restriction of size limitations on mobile devices. Ex. 2004, ¶233. At the time, the only way in which games could be “updated” was to download a new version of the game in its entirety. Ex. 2004, ¶233. This was not practical to do on a mobile device with great size and storage limitations. Ex. 2004, ¶233. The '958 Patent was revolutionary in its time and solved this problem by sending updated content without requiring that the game be downloaded anew and in its entirety. Ex. 2004, ¶¶39-51.

The documents cited as background in the Petition also show that there was a long-felt need for the invention of the '958 Patent. Ex. 2004, ¶¶231-238. For example, documents identified by Playrix include an article that states that “suggestive events for the future of online gaming took place in the [Australian] spring of 2007” (Ex. 1015 at 1)—confirming that, as of its June 26, 2007 priority date, the invention was novel and absent from the current art. *Id.*; *see* Ex. 2004, ¶237. Additional documents identified by Playrix suggest the novelty and long-felt need of the inventions because they explain that “advertisers should experiment with in-game advertising to gain skills that could become vital *in the near future*.” Ex. 1016 at 2; *see* Ex. 2004, ¶235; *see also* Ex. 1017 at 1 (“In the near future, mobile in-game advertising will become increasingly attractive for providers of mobile phones.”).

Likewise, a 2001 article also similarly confirms that in-game content updates, were needed before the claimed invention. Ex. 1018; *see* Ex. 2004, ¶234. The article expressly describes “[t]he biggest change between the current game technologies and the future ones is that in the future it will be possible to offer also games with real-time interactivity.” Ex. 1018 at 50 (emphasis added); *see* Ex. 2004, ¶237. Further, this article confirms exactly the need to address the problem that the '958 Patent in fact solved, describing that “life cycle[s] of [] certain game[s] will [be] quite short, and will be replaced by more trendy games very promptly.” Ex. 1018 at

52; *see* Ex. 2004, ¶237. This evidence of long-felt need also confirms that the claims of the '958 Patent are not obvious.

The prior art also taught away from the claimed invention of the '958 Patent. In particular, the prior art taught away from providing “updated content associated with a mobile video game to a mobile communication device.” At the time of the invention of the '958 Patent, programmers could not update content in a game on a mobile device without re-downloading an entire application. Ex. 2004, ¶233. To overcome this problem, prior art references, like Levkovitz, sought to serve video games and associated advertisements via browsers, which operated in a distinct manner from the claims of the '958 Patent. Ex. 2004, ¶¶47-51, 232-233.

The prior methods, which were not downloaded and instead accessed via the web, allowed developers to serve ads more easily. Ex. 2004, ¶48. The developers could issue new games without requiring users to download or pay for an entire new version. Ex. 2004, ¶49. A developer seeking to update game content or publish a new ad campaign on a mobile device would have sought to do so via a browser or WAP-based game as these features were not available in gaming applications at that time. Ex. 2004, ¶¶48-50. These prior art methods taught away from using the application-based invention of the '958 Patent (*see* Ex. 2004, ¶233), and this evidence also confirms that the inventions are not obvious.

VIII. HAYS IS NOT A “PRINTED PUBLICATION” WITHIN 35 U.S.C. § 311(b)

A patent can be challenged in an IPR “only on the basis of prior art consisting of *patents* or *printed publications*,” 35 U.S.C. § 311(b) (emphasis added)—which limits available prior art, as a matter of law, to only references that are themselves a “publication” as of the ’958 Patent’s priority date of June 26, 2007. *see supra* Section III.

Hays was filed on March 8, 2005, but did not publish until May 1, 2008 (*i.e.*, after the June 26, 2007, priority date of the ’958 Patent). Ex. 1005, at 1. And Hays never issued as a patent. Hays is only a “printed publication” under § 311(b) as of the date it became available to the public—*i.e.*, after the June 26, 2007, priority date of the ’958 Patent. Indeed, the Federal Circuit has repeatedly held that “[t]he statutory phrase “printed publication” ... mean[s] that *before the critical date* [of the challenged patent] the reference must have been *sufficiently accessible to the public* interested in the art.” *In re Cronyn*, 890 F.2d 1158, 1160 (Fed. Cir. 1989) (emphasis added); *accord Acceleration Bay, LLC v. Activision Blizzard Inc.*, 908 F.3d 765, 772-74 (Fed. Cir. 2018) (affirming finding in IPR that reference was not “printed publication” because it “was not publicly accessible before the critical date”). Hays was not accessible to the public before June 26, 2007.

Thus, Hays is not available as prior art, as the effective date of “printed publication” prior art is the date it is “published, i.e., accessible to the public.” *Samsung Elecs. Co. v. Infobridge Pte. Ltd.*, 929 F.3d 1363, 1368, 1370 (Fed. Cir. 2019). Indeed, ““public accessibility”” is “the touchstone in determining whether a reference constitutes a ‘printed publication.’” *Acceleration Bay*, 908 F.3d at 772 (additional quotation marks omitted). And an IPR “petitioner ... ha[s] the burden to prove [a reference] is a printed publication.” *Id.*

Petitioner failed to carry that burden here. For example, Petitioner fails to contend that Hays was publicly accessible prior to the '958 Patent's priority date of June 26, 2007. Nor can it. Hays was not published until May 1, 2008. Hays was thus not “accessible to the public” until after the '958 Patent's priority date and thus cannot be “printed publication” prior art within the meaning of § 311(b). *See Samsung*, 929 F.3d at 1368.

Petitioner's suggestion that Hays is “prior art under pre-AIA § 102(e)” does not demonstrate otherwise. In doing so, Petitioner expressly relies on the *filing date* of each of Hays as the effective prior art date. Petitioner, however, cites no authority for the proposition that a patent application that is prior art under only pre-AIA § 102(e) constitutes a “printed publication” under § 311(b) as of its *filing date*—irrespective of the date the application is ultimately published (if at all).

And there is no legal support for interpreting § 311(b) to permit such “secret prior art” (*OddzOn Prod., Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1402 (Fed. Cir. 1997)) to be available prior art in an IPR. Indeed, applications filed with the Patent Office “shall be kept in confidence by the Patent and Trademark Office” prior to publication in accordance with controlling protocols. 35 U.S.C. §§ 122(a)–(b). Relatedly, courts have long recognized that a “mere application for a patent” is neither a “printed publication” nor a “patent.” *Brown v. Guild*, 90 U.S. 181, 224 (1874); *In re Wertheim*, 646 F.2d 527, 532 (CCPA 1981) (application “was not ... a patent or printed publication”). And when Congress limited IPRs to “only prior art consisting of *patents* or *printed publications*,” 35 U.S.C. § 311(b) (emphasis added), it necessarily excluded other categories of prior art from the permissible bases for an IPR. Pre-publication “application[s] for patent” under pre-AIA § 102(e) (*i.e.*, “secret prior art”) are among those excluded—in contrast to the “printed publication[s]” under pre-AIA §§ 102(a) and (b). *See* 35 U.S.C. § 311(b).

For all these reasons, Hays (Ex. 1005) is not “prior art consisting of patents or printed publications” under § 311(b) and are therefore ineligible to be prior art in an IPR.⁵ Accordingly, each of Grounds 1–2 fails because it relies on the ineligible Hays.

⁵ In *Samsung Electronics Co., Ltd. v. Lynk Labs, Inc.*, IPR2022-00149, Paper 33, at 10–12 (P.T.A.B. June 26, 2023)—a non-precedential decision—another panel held to the contrary. That decision is incorrect for all the reasons set forth above and should not control in any event in view of recent Supreme Court precedent. *See Loper Bright Enters. v. Raimondo*, No. 22-451, 603 U.S.

IX. CONCLUSION

For at least the reasons set forth above, the Petition fails to shoulder its burden of establishing that any of Claims 1-14 of the '958 Patent are unpatentable.

Dated: August 2, 2024

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____ (June 28, 2024) (overruling *Chevron* and holding that the APA requires no deference to agency's statutory interpretation).

CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24(d), the undersigned certifies that this Preliminary Response contains 11,856 words according to the word-processing program used to prepare this paper. The foregoing word count complies with the 14,000 word type-volume limit specified by 37 C.F.R. § 42.24(b)(1).

Dated: August 2, 2024

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CERTIFICATE OF SERVICE

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