

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. IPR2023-00171

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

PETITIONER'S REPLY

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EXHIBIT LIST

Ex.	Description
1001	U.S. Patent No. 10,617,958 (“’958 patent”)
1002	File History for U.S. Patent No. 10,617,958
1003	Declaration of Dr. José Zagal
1004	<i>Curriculum Vitae</i> of Dr. José Zagal
1005	U.S. Patent Pub. No. 2008/0102947 (“Hays”)
1006	Intentionally Left Blank
1007	U.S. Patent No. 7,698,178 (“Chu”)
1008	U.S. Patent Pub. No. 2007/0088801 (“Levkovitz”)
1009	U.S. Patent No. 9,129,301
1010	Steven Kent, <i>The Ultimate History of Video Games</i> (2001)
1011	Frans Mayra, “Mobile Games,” in the <i>International Encyclopedia of Digital Communications and Society</i> , 1st ed. (2015)
1012	N. Leavitt, “Will wireless gaming be a winner?” in <i>Computer</i> , Vol. 36, No. 1, pp. 24-27 (Jan. 2003)
1013	Jason Soh & Bernard Tan, “Mobile Gaming,” in <i>Communications of the ACM</i> , Vol. 51, No. 3, pp. 35-39 (Mar. 2008)
1014	Michael Zyda et al., “Educating the Next Generation of Mobile Game Developers,” in <i>IEEE Computer Graphics and Applications</i> , Vol. 27, No. 2, pp. 92-96 (Mar./Apr. 2007)
1015	Mark Andrejevic, “Productive Play 2.0: The Logic of In-Game Advertising” in <i>Media International Australia</i> , Vol. 130, No. 1, pp. 66-76 (Feb. 2009)

1016	Ilya Vedrashko, Advertising in Computer Games (Doc. No. 123290221) [Master's Thesis, Mass. Inst. of Technology], DSpace@MIT
1017	Exit Games, In-Game Advertising Goes Mobile [Press Release] (Mar. 21, 2006)
1018	Jussi-Pekka Partanen, Mobile Gaming: A Framework for Evaluating the Industry 2000-2005 (2001)
1019	<i>Samsung Electronics Co. v. Lynk Labs, Inc.</i> , IPR2022-00149, Paper 33 (PTAB June 26, 2023)
1020	Transcript of Deposition of Dr. Robert Akl, October 24, 2024
1021	International Pub. No. WO 2005/086969 A2

I. INTRODUCTION

PO's arguments primarily rely on mischaracterizing or ignoring clear and express disclosures found within the prior art or in the '958 patent. For example, PO argues that a "real-time" advertisement selection cannot comprise pre-selected ads, while failing to address the separate disclosures relied upon in the petition relating to advance selection of advertisements. Similarly, PO attempts to argue that the claims do not cover updated content that is merely displayed in a game, without changing the game functionality, but ignores that numerous embodiments in the '958 patent involve nothing more than displaying updated messages or logos. PO's arguments lack credence. PO also repeatedly ignores Dr. Zagal's testimony regarding motivation to combine, instead alleging some disadvantage with combining the references as a whole, which is immaterial to Petitioner's proposed obviousness combinations.

II. DR. ZAGAL'S TESTIMONY SHOULD BE GIVEN DUE WEIGHT

Throughout its Response, PO asserts that Dr. Zagal's testimony "should be afforded no weight" because he "parrot[s] the petition almost word-for-word." See, e.g., POR 14. The Board already rejected an identical argument in its Institution Decision, distinguishing *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 (PTAB Aug. 24, 2022), which PO exclusively relies on. Institution Decision, 16. As the Board already noted, the Petition and Dr. Zagal's declaration "are sufficiently

supported by the teachings of [the prior art], thus distinguishing this situation from the one described in *Xerox*.” *Id.*, 17.

III. GROUND 1: HAYS RENDERS CLAIMS 1-14 OBVIOUS

A. Limitations 1[a]/8[a]: “pre-selected in-game advertising”

As explained in the Petition, Hays discloses “pre-selected in-game advertising” in the form of “media files” corresponding to advertisements are stored in a “database,” enabling “specific [*i.e.*, **pre-selected**] advertisements [to be] presented in the appropriate available ad units at the appropriate time during game play.” Pet. 13-14; EX1005, ¶¶20-21.

Interpretation of “pre-selected.” In the related district court proceeding, Petitioner has asserted that the term “pre-selected” is indefinite. *See* EX2001. Even PO’s expert could not articulate when or how content must be “pre-selected” in relation to other claim elements. EX1020, 39:6-43:22. Nor does PO offer a construction of the term in the POR. However, PO presents several arguments relating to the scope of the term. For example, PO argues that “pre-selection” of advertisements is distinct from “real-time selection” of advertisements to deliver. POR 11. PO also acknowledges that “pre-selected content identified based on the claimed factors” may later be “‘selected’ and sent.” *Id.* Indeed, this must be true as the claims expressly require “check[ing] what pre-selected in-game advertising to

send.” EX1001, Limitation 1[e]. For the purposes of IPR, Petitioner adopts PO's interpretation of the term “pre-selected” as outlined above.

Hays discloses pre-selected in-game advertising under PO's interpretation. PO argues that Hays's “weighting system” comprises “dynamic real-time selection” of advertisements, rather than pre-selection of advertisements. POR 11. However, the Petition does not rely on Hays's weighting system for the teaching of pre-selected in-game advertising. Rather, Hays's “advertising matching and weighting system” performs the **subsequent** selection of an advertisement. Pet. 18-19. The Petition states that pre-selection is disclosed by Hays's “sub-channel[s]” that enable advertisers to pre-select advertisements for specific game genres, times of day, or dates in advance of a real-time matching and weighting. Pet. 13 (citing EX1005, ¶22). That selection plainly happens **before** the weighting system determines which ads to serve to a particular mobile device—the advertisers are not being polled every time an advertisement is delivered.

PO asserts that Hays's sub-channels do not involve “pre-selected” advertisements, but offers no reasoning to support that argument. POR 12. PO simply repeats that Hays's weighting system performs a real-time selection of ads, but does not explain why the advance selection of criteria (*i.e.*, sub-channels) based on the game genre, time of day, or date does not entail “pre-selecting” ads. The fact that the pre-selected ads are later used as part of the weighting process is of no

moment—as PO acknowledges, and as the claims require, a “pre-selected” advertisement may also later be “selected” and sent to the mobile device. POR 11; EX1001, Limitation 1[e].

PO also argues that Hays’s “‘sub-channels’ have to do with the target for a particular advertisement,” and “is irrelevant to whether a particular advertisement is ‘pre-selected.’” POR 13. PO offers no support for this conclusion. PO does not cite to any evidence to suggest that pre-selection of advertisements cannot be related to targeting advertisements for particular games or game players. Rather, when discussing the scope of the claim term, PO only argues that “pre-selection” must occur separate from “real-time selection” of the advertisement for delivery to a mobile device. POR 11. Hays’s sub-channels allow advertisers to perform such pre-selection in advance of any real-time matching or weighting for delivery of specific advertisements to users. EX1005, ¶22.

Even under PO’s unsupported distinction between “pre-selected” advertising and targeted advertising, Hays discloses that pre-selection can be performed to ensure compatibility between ads and specific game clients. For example, Hays discloses that a database may be used to store “information about the technical media formats accepted by each advertising destination within an advertisement recipient client and about which advertising has been specifically approved for each advertisement recipient client by a game publisher/developer.” EX1005, ¶42. Only

advertisements with “the correct media format” and “that have been specifically approved” may later be selected for delivery. *Id.* Technical compatibility and publisher/developer approval can also thus be used to pre-select advertisements based on the specifications of the mobile device.

To the extent PO contends that “pre-selected” advertisements must identify a single, specific ad to send, rather than a set of ads from which a specific ad may later be selected for delivery, that interpretation lacks any support in the intrinsic evidence. The '958 patent expressly contemplates that updated content may be “part of a **group of pre-selected content** for the mobile communications device.” EX1001, 5:45-48. Updated content may also be “chosen from pre-selected content based on at least one of the factors.” *Id.*, 11:34-40. These disclosures confirm that the pre-selected ads may be a group or set of ads from which a specific ad is later selected.

B. Limitations 1[a]/8[a]: “for use in a video game”

As explained in the Petition, Hays discloses that the delivered advertisements are for use in a video game, because they are displayed “during game play,” such as “a game character [that] may move around a screen holding a can of Pepsi and ask player if they would like a drink.” Pet. 8, 13 (quoting EX1005, ¶¶21, 79).

PO attempts to avoid Hays's disclosure by interpreting the term “for use” to require an effect on game play or game functionality. Specifically, PO argues Hays's “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.” POR 15-16. PO provides this contrived definition without considering the ordinary meaning of the claim language and without explaining why the Board should depart from it. The claims use ordinary words and convey their meaning clearly. Indeed, PO’s expert admits that the specification describes content placed on objects within the game without any effect on gameplay. For example, a shirt “might be updated to include a logo associated with third party X” or a poster “might advertise an upcoming movie for third party Y.” EX1001, 6:49-52; EX1020, 26:3-18 (“[J]ust having something on a shirt ... that doesn’t disclose for use yet.”). The specification also states the updated content could “displayed in a pop-up window” which also has no effect on gameplay. EX1001, 8:6-7.

However, even under PO’s incorrect construction that “for use” requires affecting gameplay, that is precisely what Hays teaches. Hays teaches that the advertisement may be uploaded into the game as a “bot[] or electronic agent[] ... or real character[] in the game,” such as “a game character [that] may move around a screen holding a can of Pepsi and ask player if they would like a drink.” EX1005, ¶79. This is a specific example of updated content being delivered to the game in a way that affects gameplay—namely, an advertisement where the player has the option to drink the advertised product.

PO mischaracterizes this teaching in Hays as merely an “in-game can on which the skin of the brand Pepsi may be displayed” which does not otherwise “alter[] the functionality of the game based on whether a Pepsi ad is displayed on this particular unit versus if the can were left blank or displayed a fictional brand.” POR 16. Yet Hays does not state that the character drinking a can is a pre-existing character that is simply skinned to show the Pepsi logo—instead, Hays is explicit that the “advertisement management service system may *send bots or electronic agents*” such as a character “holding a can of Pepsi and ask[ing the] player if they would like a drink.” EX1005, ¶79. Thus, Hays teaches that the character and its player interaction is the delivered advertisement. Another example of an interactive advertisement that Hays teaches is “a game character eating a brand name energy bar to boost her power in the game.” *Id.*, ¶19; *see also* EX1005, ¶21 (“[S]pecific advertisements may be presented in the appropriate available ad units at the appropriate time *during game play*.”).

PO is incorrect that these examples are like the hyperlinked content in Gatto distinguished during prosecution of the parent '202 patent. POR 18-19. In fact, Hays's disclosures are much more like the '958 patent's disclosure of a shirt that “might be updated to include a logo associated with third party X” or a poster that “might advertise an upcoming movie for third party Y.” EX1001, 6:47-52. By contrast, during the prosecution of the '202 patent, the examiner had asserted that

Gatto's "'promotional items' available for download via email hyperlink" were the updated content—contrary to PO's assertion, it was not the hyperlinks themselves that the examiner contended were the updated content. EX2002, 188; POR 18-19. The examiner further contended that the hyperlinked content was usable within the email (which the examiner alleged was a "video game"). EX2002, 188. But the applicant correctly pointed out that the *linked promotional items* were not usable in the video game, since "it would not make sense for an email to provide hyperlinks to *content that is usable in the email itself*." EX2002, 188. In other words, the problem with Gatto was that the updated content was not itself displayed within the email but instead linked by the email's hyperlinks. By contrast, in both the '958 patent and Hays, the content itself (such as an advertisement) is used within the game (such as, in the '958 patent, being displayed on a t-shirt (EX1001, 6:47-49) or, in Hays, as an interactive soda can (EX1005, ¶79)).

C. Claims 3/10: "the server sends information ... regarding the in-game placement location of the content"

As discussed in the Petition, a POSITA would understand or at least consider it obvious that Hays's teaching of delivering advertisements to the mobile device would designate the "ad unit" (*i.e.* a "space") within the game in which the advertisement should appear, and thus provides an "in-game placement location." Pet. 21-23; EX1005, ¶18; EX1003, ¶¶102-106.

PO argues that “the ad units are ‘standardized’ and not related to any specific in-game placement location.” POR 21. PO once again mischaracterizes Hays, which clearly states that “standardized available ad units” refers to standardized **types** of ad units such as “signs,” “structure,” or “logos.” EX1005, ¶73. Thus, Hays teaches that different retailers can select a standardized type that is appropriate to that retailer, such as “McDonald’s” selecting a “branded fast food restaurant” structure. *Id.*, ¶¶73-74 (“The use of standardized available ad units facilitates the sale of advertising that spans across multiple games/titles because one advertisement can fit into many available ad units of a **standard advertisement unit type**.”).

However, when delivering the advertisement to the device, the device still needs to know which ad unit to display it on. Thus, as Dr. Zagal explained, Hays’s ad units are “**spaces ... within the game**” and refer to specific objects located in specific areas, 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.” EX1003, ¶103 (quoting EX1005, ¶18). The ’958 patent discloses a similar system, wherein the locations are not necessarily specific “positions along the axes” but are instead the specific objects where the content is displayed. EX1001, 12:28-32 (“[A] first location may be where the shirt 230 is hanging, a second location may be where poster 225 is positioned, a third location may be where the dart board 210 is placed.”). As PO’s own expert conceded, the claim is met by

providing “a location ... in relation to an object.” EX1020, 31:21-32:1. Thus, the system need only designate which of these locations to display the updated content—precisely the same thing Hays discloses. Thus, by designating which ad unit to display an advertisement, the system provides an ***in-game placement location***.

In addition, Dr. Zagal explained why a POSITA would find it obvious to provide the in-game placement location because “a POSITA would be motivated to provide a mechanism to inform the game ... where to place the advertisement, as that would fulfill the contractual obligations to the advertiser.” EX1003, ¶106. Dr. Akl fails to address the substance of Dr. Zagal’s testimony. He instead argues that “[b]ecause the ad units are predesignated, a POSITA would understand that Hays does not send location information with the ads.” EX2004, ¶80. However, this fails to address the need and desire for the system to “inform the game ... where to place the advertisement,” *i.e.* designate the ad unit to display the advertisement. EX1003, ¶106. That some ad units are predesignated does not solve the problem of telling the device which ad units should display which advertisements.

D. Claims 5/12: “messages ... pre-selected by the server”

Claims 5 and 12 depend from claims 4 and 11, respectively, which require the server to send a message “relating to the content” in response to a request from the mobile device. EX1001, cl. 5. The Petition explains that Hays’s server sends such a message in the form of “lists of advertisements for specific available ad units.”

Pet. 23-24 (citing EX1005, ¶29). Delivery of the content itself also necessarily involves sending a message relating to that content, and may include “data” used to display an advertisement. Pet. 23-24 (citing EX1003, ¶108; EX1005, ¶41). PO does not dispute that Hays discloses this limitation.

For claims 5 and 12, the Petition explains that because the advertisements themselves are pre-selected (as discussed in the Petition and above), the messages associated with the advertisements (e.g., the associated data or the list of pre-selected advertisements) are also pre-selected. Pet 25 (citing EX1003, ¶113). For example, data used for the presentation of a particular advertisement is necessarily associated with (and pre-selected for) that advertisement. Similarly, when advertisements are pre-selected by advertisers based on a sub-channel (EX1005, ¶22), or based on media format and/or specific approval of recipient client devices (*id.*, ¶42), then the corresponding list of advertisements for a particular ad unit will also be pre-selected for those criteria. When the pre-selection is based on, *e.g.*, technical requirements or publisher/developer approval of specific client devices, then the resulting messages will be based at least on the model type of the mobile device as required by the claims.

PO does not address these specific disclosures relied upon in the Petition. PO instead argues that advertising matching and weighting is not pre-selecting based on the claimed factors. POR 22. PO is incorrect.

First, as discussed above (including in Section III.A), Hays's pre-selection of advertisements and messages occurs separate from the matching and weighting process, *e.g.*, based on technical formats or publisher/developer approval determined in advance. PO does not address these disclosures in Hays at all.

Second, Hays expressly teaches that within the weighting process, weights are calculated based on, *inter alia*, "the specific client type [*i.e.*, the model type of the mobile device]." Pet. 26 (citing EX1005, ¶¶40, 43). And as discussed above (and as PO does not dispute), each advertisement has an associated pre-selected message containing information for presenting the advertisement. EX1005, ¶41. Accordingly, thus, when the weighting system selects a particular advertisement based on the type of mobile device, the server will send a pre-selected message associated with that advertisement.

E. Claim 7/14: "the server tracks the distribution of updated content"

The Petition provides several teachings from Hays that discloses tracking. Notably, neither PO or its expert Dr. Akl address Hays's disclosures of tracking "frequency caps," which as the Petition explained, would require tracking the distribution of advertisements by tracking how often they are provided to a particular mobile device. EX1005, ¶45; Pet. 30 (citing EX1003, ¶124).

PO's arguments likewise fail with respect to Hays's remaining teachings. The Petition explained that Hays discloses this limitation because it teaches an "active

session database 124” which is “used to **track** and record **all communications and data** sent and received from the” mobile device. Pet. 30 (quoting EX1005, ¶38). Despite Hays’s clear disclosure that it “track[s] ... **all** communications,” PO argues that Hays’s tracked data does not include “the updated content uploaded to the mobile device,” because the tracked data is only for “session[s],” and therefore fails to track all uploaded data and does not “show what has been ‘uploaded’.” POR 25.

PO’s argument again misreads Hays. Hays is clear that the session for tracking all data corresponds with what PO describes as the “period a user is playing a game.” POR 25 (citing EX1005, ¶38). Indeed, Hays makes clear that the session begins when the player logs into the game and ends when the player logs out. EX1005, ¶¶38-39 (“[T]he advertisement recipient client 104 **begins by establishing or joining a session** with the advertisement server 114. ... When a game player specifically and actively leaves a session, the advertisement recipient client sends a message indicating **the game player left** ...”). As a result, all “updated content” would necessarily be distributed to the player’s device during a “session,” and would thus be tracked. Claims 7 and 14 require nothing more.

Hays also describes “services that **track** and audit the quality of presentation of the in-game advertisements,” including “advertisement impressions.” EX1005, ¶25; Pet. 26. PO argues “this [data] is related to the advertisement itself, not the ‘mobile communications device.’” POR 26. This argument makes little sense, since

Hays describes that the advertisements are provided to the mobile communications device, and the qualities being tracked all relate to the presentation of the advertisement *at a user's device*—such as time on screen. Pet. 30 (quoting EX1005, ¶25); *see also* Pet. 19-20; EX1005, ¶43 (“The selected advertisements are then ... transmitted back to the advertisement recipient client for display.”). PO also argues that “[a]t most [Hays] describes information regarding the presentation of an advertisement, rather than when an advertisement has been uploaded.” POR 26. But the claims only require tracking **distribution** of updated content, which includes presentation—they do not specifically require tracking “when an advertisement has been uploaded.” POR 26. In any event, Hays describes tracking “advertisement impressions,” which would include when and how often an advertisement is uploaded. EX1003, ¶125.

IV. GROUND 2: HAYS AND CHU RENDER CLAIMS 1-14 OBVIOUS

The Petition provided the Hays-Chu combination as an alternative ground of obviousness for claims 3 and 10. Pet. 34-35. As discussed herein, PO's arguments against this combination fail.

A. Claims 3/10

The Petition explains that Chu discloses that its server delivers advertisements to a client that include “[a] location object (530, 630) [that] represents the **location**

within a game at which advertisements are to appear.” Pet. 35 (quoting EX1007, 14:20-15:5).

PO argues that Chu does not describe that such information is sent “from the server to the client as the claim requires.” POR 28. Not so. Chu clearly states that the client “requests advertising metadata” and that the requested metadata sent to the client includes the “location object.” EX1007, 14:47-15:5. Figure 5 further shows that the client makes a request to the “Transplay Advertising Server,” which “[r]eturn[s] **campaign metadata** and ad assets.” Thus, Chu expressly discloses that the server sends metadata to the client, and that the metadata includes the in-game location. Although Chu also states that the client sends location data to the server (*i.e.*, to identify locations within a game where ads may be displayed) (*see* POR 28), that does not change the fact that the server separately sends the location data to the client to indicate the particular location to display a particular ad.

PO also argues that “Dr. Zagal fails to explain how Chu’s client-based system would be modified for or implemented into Hays’s server system.” POR 28-29. But Dr. Zagal did explain how to use Chu’s location metadata with Hays’s system. EX1003, ¶¶128-136. It is not necessary to combine the entirety of Chu’s system with Hays’s system. *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1076 (Fed. Cir. 2015) (“[A] reference must be considered for **everything it teaches** by way of

technology and is not limited to the particular invention it is describing and attempting to protect.”).

B. A POSITA would be motivated to combine Hays and Chu

The Petition sets forth express motivation to “modify Hays’s system ... by incorporating Chu’s teachings of requesting and receiving advertisements for specific in-game locations.” Pet. 32-34. PO does not specifically address any of the motivations to combine articulated in the Petition.

Instead, PO argues that “a POSITA would not have sought to modify Hays’s specific ad units to transmit placement information.” POR 29. But the combination would not require any modification to Hays’s ad units. Hays discloses that ad units are found in certain locations within the game (*e.g.* a t-shirt or billboard (EX1005, ¶18)) and thus, a POSITA would have been motivated to use Chu’s teaching of providing a location to specify which ad unit to use for a particular advertisement. EX1003, ¶¶130-132.

PO also argues that Hays provides ads “across a variety of games” whereas Chu “is directed to a specific, online gaming system.” POR 29-30. PO similarly argues that Hays discloses that advertising content is “push[ed]” from the server, while Chu discloses that advertising content is “request[ed] from the client.” POR 30-31. This fails to address the combination or motivations regarding the inclusion

of Chu's location metadata with Hays's system. It is also not necessary to combine the entirety of Chu's system with Hays's system. *See Belden*, 805 F.3d at 1076.

PO next argues that Hays proposes an ad server and thus teaches away from specific gaming systems or applications. POR 35. Tellingly, PO does not cite to any disclosure in Hays to support this proposition. Nothing in Hays suggests that the ad server cannot deliver advertisements to specific gaming systems. For example, Hays describes that its system works with "game consoles." EX1005, ¶21. Moreover, PO provides no explanation for why Chu's teachings regarding specifying an ***in-game location*** for an advertisement could not be applied to Hays's ad server.

Finally, PO states "Hays's ad units are not fixed to a specific location and are sent 'regardless of [their] location.'" POR 30-31 (quoting Ex. 1005, ¶73). This grossly mischaracterizes Hays, which only provides as ***an example*** that a ***type*** of ad unit can be a "static sign regardless of its location." EX1005, ¶73. Hays expressly discloses that advertisements are placed at "a specific location." EX1005, ¶46; see *also id.*, ¶18 ("[A]dvertisements ... on pre-designated ***geometry within the game*** such as billboards, storefront signs, panel trucks ...").

V. GROUND 3: LEVKOVITZ RENDERS OBVIOUS CLAIMS 1-2, 3-9, AND 11-14

A. Limitations 1[a]/8[a]: “pre-selected in-game advertising”

As explained in the Petition, Levkovitz discloses a memory unit that stores “a plurality of content items.” Pet. 36-37; EX1008, ¶12. An ad server may later select ads from the content items “previously stored [*i.e.*, pre-selected] in the content items repository 118.” *Id.*, ¶126; *see also id.*, ¶147 (describing distribution of content to ad servers “in advance”). Accordingly, Levkovitz’s ad server checks which of a set of pre-selected in-game advertisements to deliver to a mobile device. EX1003, ¶¶58-59.

PO argues that the petition does not distinguish between pre-selection and selection. POR 31-32. Not so. The Petition expressly notes that the plurality of content items stored in advance are the claimed “***pre-selected*** in-game advertising,” and that ***selection*** only happens later when a particular ad is selected from the pre-selected content items. *See* Pet. 40-41.

PO also argues that the plurality of content items stored in Levkovitz’s memory unit cannot be pre-selected because that “renders the term ‘pre-selected’ meaningless as compared with ‘selected.’” POR 32. PO does not explain why that would be the case when the ***pre-selected*** advertisements stored in memory are distinct from the particular advertisement later ***selected*** from among that set for delivery to a mobile device. At most, PO argues, without explanation or support,

that “content is not ‘pre-selected’ simply because it is stored and then later selected.” POR 32-33. But Levkovitz expressly teaches that the content stored at the ad server was selected “in advance” (*i.e.*, pre-selected) by a “Data transferor.” Pet. 37; EX. 1008, ¶147. Nothing in the ’958 patent suggests more is needed to “pre-select” content.

B. Limitations 1[a]/8[a]: “for use in a video game”

PO argues that Levkovitz only discloses “placement of content ... within the game, which are not usable in the video game.” POR 35-37. As discussed above in Section III.B, PO is attempting to construe “for use” to require some effect on game functionality or gameplay. However, nothing in the claims or the specification justifies such a construction—especially since the ’958 patent specification provides numerous examples of merely displaying updated content without any affect on gameplay. EX1001, 6:47-49 (describing a pre-existing shirt updated to display a logo); 8:6-7 (describing content being “displayed in a pop-up window”).

PO again tries to compare Levkovitz’s display of advertisements to the hyperlinking described in the Gatto reference considered by the examiner during prosecution of the related ’202 patent. POR 36-37. As discussed in Section III.B, the examiner had asserted that Gatto’s “‘promotional items’ available for download via email hyperlink” were the updated content. EX2002, 188. In other words, the

problem with Gatto was that the email did not display the content, but was instead linked to it via hyperlink.

C. Limitations 1[e]/8[d]: “send[ing] the pre-selected in-game advertising ... to the mobile communication device”

As the Petition points out, Levkovitz describes an “ad server” that “serve[s] content items” to a client device. Pet. 41 (quoting EX1008, ¶127). Nevertheless, PO inexplicably argues that Levkovitz does not “upload” any such content to the device, because Levkovitz uses the WAP protocol and “WAP operates like a web browser that retrieves and caches content but, notably, does not require downloading or uploading content.” POR 38. As an initial matter, even if PO is correct, the claims do not require “uploading” in-game advertising—they merely require “send[ing]” in-game advertising to the mobile device. Regardless of how Levkovitz’s ad server “serves” advertising content, the advertisements plainly must be sent by the ad server and received by the client device in order for the client device to “present” the advertisements. See EX1008, ¶131. In addition, PO does not cite to any evidence that the WAP protocol does not upload or download data, beyond their own expert’s say-so. Levkovitz also states that WAP is used only in “some embodiments.” EX1008, ¶339. In fact, paragraphs 121 through 338 of Levkovitz (which encompass all of the portions of Levkovitz that the Petition cited to) do not mention any use of WAP at all. And PO’s comparison to a web browser makes little sense when web servers do, in fact, upload content to web browsers.

Regardless, Levkovitz could not be more clear that an “ad server” sends content to the device. EX1008, ¶6 (“The ad server may selectively *serve content items* to the content client”), ¶128 (“Ad server 110 may *serve, transfer or transmit* one or more selected content items to communicator 150.”), ¶143 (“the *distribution of content items* among multiple ad servers 110”), ¶152 (“Ad server 110 may selectively *provide* to communicator 150 one or more content items”).

D. Claim 7/14

Levkovitz discloses “log[ging] information related to presentations” which includes “data indicating the content item(s) presented.” EX1008, ¶132; Pet. 45. PO acknowledges that, at a minimum, Levkovitz tracks “what content has been presented.” POR 39. That is all that is required by the claims, which broadly require tracking *distribution* of updated content—which may include *presentation* of that content. PO offers no support for its narrow interpretation of “distribution” as being limited to “what has been uploaded.” POR 39. Indeed, the patentee understood the distinction between “distribution” of content and uploading content. For example, in the related '202 patent, one claim recites “tracking *what has been uploaded* to the mobile communication device.” EX2003, cl. 5. Here, however, the claims only require tracking *distribution*.

Regardless, even under PO's narrow interpretation of distribution as limited to uploading, PO's arguments regarding Levkovitz are incorrect. PO presumes the

claims require tracking **all** uploaded content, and argues that some content “could be uploaded and not presented.” POR 40. But this narrow interpretation is not supported by the language of the claims itself or the specification. The claims merely require tracking distribution of “updated content,” not “**all** updated content.” Thus, the claims are disclosed as long as the prior art teaches tracking of at least one uploaded updated video-game content, which Levkovitz does.

In addition, PO does not cite to anything in Levkovitz that indicates a content item is uploaded but not presented. Indeed, for the embodiment that Petitioner relies on, Levkovitz states that the ad server “may serve content items **directed for presentation** using a first application 176 (e.g., a chess game).” EX1008, ¶127.

VI. GROUND 4: LEVKOVITZ AND CHU RENDER OBVIOUS CLAIMS 3/10

PO relies on the same arguments raised in connection with Ground 2, contending that Chu's server does not send in-game placement location to the client. POR 41-42. As discussed above for Ground 3, that is incorrect—Chu expressly teaches that location metadata is sent from the server to the client. EX1007, 14:20-15:5, Fig. 5.

PO's arguments against motivation to combine repeat this same error, assuming that Chu “only relates to information sent from the client.” POR 43. PO fails to address Chu's disclosures relating to the **server** sending location metadata back to the client in response to a request. Thus, Chu and Levkovitz do not “operate

in opposite manners”—both contemplate ad servers that deliver advertisements to a client device.

PO also argues that “Levkovitz seeks to serve advertisements broadly” whereas Chu has a “narrow disclosure of placing ads at a particular location.” POR 43-44. However, this does not rebut any of the known benefits for modifying Levkovitz to place ads at a particular location, as explained by Dr. Zagal, and thus does not establish no motivation to combine. EX1003, ¶¶169-174.

VII. PATENT OWNER PROVIDES NO EVIDENCE OF SECONDARY CONSIDERATIONS

PO argues there was a long-felt need for the '958 Patent, yet admits consoles games “did not face the same issues.” POR 44-45. Yet the claims of the '958 patent recite a “mobile communication device” and as PO's expert readily admits, mobile game consoles existed prior to the patent. EX1020, 7:24-9:3. Further, the only purported evidence PO offers of any long-felt or unmet need with respect to mobile handsets, specifically, is the unsupported say-so of its expert. PO submits no evidence that mobile phone developers or mobile phone users experienced a long-felt need for updated game content. Accordingly, PO has failed to establish a nexus between the claims and any alleged long-felt need.

The evidence cited in the Petition that PO seeks to rely merely describes the industry's desire for more in-game advertising, and any claimed mechanism for delivering updated content. POR 54-56. As shown in the Petition, and as undisputed

by PO, in-game advertising on mobile devices was well known well before the '958 patent, including as described in Hays, Chu, and Levkovitz. Thus, PO has failed to show any nexus. *Yita LLC v. MacNeil IP LLC*, 69 F. 4th 1356, 1364 (Fed. Cir. 2023) (“[O]bjective evidence of nonobviousness lacks a nexus if it exclusively relates to a feature that was known in the prior art.”).

PO does not cite to any commercial praise directed to its patent (or any embodying product) and does not cite to any commercial success from commercializing its patent. PO does not cite to any copying by competitors of any product embodying its patent.

In sum, PO's purported secondary considerations should be given very little weight and do not overcome the strength of the obviousness arguments.

VIII. §311(B)

PO's §311(b) argument has been repeatedly rejected by the Board as well as the Federal Circuit. EX1019, 10-12; *Purdue Pharma L.P. v. Iancu*, 767 F. App'x 918, 925 (Fed. Cir. 2019).

Regardless, Hays claims priority to a PCT application published years before the '958 patent. EX1021. If Hays is not a “printed publication,” Petitioner will seek leave to replace Hays with Exhibit 1021. There should be no prejudice given that the disclosures are identical.

IX. CONCLUSION

For these reasons, all challenged claims are unpatentable.

Date: November 1, 2024

Respectfully submitted,

By: /s/ James M. Glass
James M. Glass

Counsel for Petitioner

**CERTIFICATE OF COMPLIANCE WITH
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AND TYPE STYLE REQUIREMENTS**

1. This Petition complies with the type-volume limitation of 5,600 words, comprising 5,528 words, as counted using the Microsoft Word software that was used to prepare this paper, excluding the parts exempted by 37 C.F.R. § 42.24(a).

2. This Petition complies with the general format requirements of 37 C.F.R. § 42.6(a) and has been prepared using Microsoft® Word 2016 in 14-point Times New Roman.

Date: November 1, 2024

By: /s/ James M. Glass
James M. Glass
QUINN EMANUEL URQUHART
& SULLIVAN, LLP
51 Madison Avenue, 22nd Floor
New York, NY 10010
Tel: (212) 849-7000
Fax: (212) 849-7100

Counsel for Petitioner

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on November 1, 2024, true and correct copies of the foregoing document and supporting materials were served in its entirety on the Patent Owner at the following email addresses:

mmorlock@kilpatricktownsend.com
jlee@kilpatricktownsend.com
arinehart@kilpatricktownsend.com
kkoballa@kilpatricktownsend.com
FPG1367020@kilpatricktownsend.com

Date: November 1, 2024

By: /s/ James M. Glass
James Glass
QUINN EMANUEL URQUHART
& SULLIVAN, LLP
51 Madison Avenue, 22nd Floor
New York, NY 10010
Tel: (212) 849-7000
Fax: (212) 849-7100

Counsel for Petitioner