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 SUR-REPLY

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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
2004	Declaration of Dr. Robert Akl
2005	CV of Dr. Robert Akl, D.SC
2006	Complaint for Patent Infringement, *Flip Phone Games Inc. v. PLR Worldwide Sales, Ltd.,* No. 2:23-cv-00139-JRG (E.D. Tex.), Dkt. 1
2007	CV of Steven D. Moore

I. INTRODUCTION

Patent Owner Flip Phone Games, Inc. ("PO") submits this Sur-Reply explaining why Petitioner PLR Worldwide Sales Limited ("Petitioner") failed to establish that any Challenged Claim is obvious. Petitioner fails to give any effect, much less full effect, to multiple claim limitations.

First, with respect to the claims' requirement that the advertising is "pre-selected," the Petition suggests it is met by selection alone. This ignores the requirement for "***pre***-selection." Next the Petition ignores that the claims require "advertising ***for use*** in a video game." Tacitly acknowledging that the cited art does not disclose advertising "for use," Petitioner urges that the '958 Patent provides examples of advertising that are not for use. But that the specification provides unclaimed examples does not modify the claims' requirement, which Petitioner fails to address.

Those issues and other elements recited by dependent claims notwithstanding, Petitioner relies heavily on a purported "expert" whose declaration is little more than a mouthpiece for Petitioner, parroting large swaths of the Petition whole cloth with no or only insignificant modification. Such testimony is not sufficient to shoulder Petitioner's burden of filling the significant gaps between the art and the claimed invention. For these reasons and others explained below, and in the Response, the Petition fails.

II. DR. ZAGAL'S TESTIMONY SHOULD BE GIVEN NO WEIGHT.

Petitioner urges that Dr. Zagal's opinions should be given due weight. Reply, 1. The "due weight" Dr. Zagal's opinions should be afforded is little to no weight. His declaration is little more than a carbon copy of the Petition. *Compare* Ex. 1003, ¶¶83-86 *with* Petition at 12-13; *compare, e.g.*, Ex. 1003, ¶¶87-89 *with* Petition, 13-14; *compare* Ex. 1003, ¶¶96-98 *with* Petition, 18-19; *compare* Ex. 1003, ¶¶112-18 *with* Petition, 25-28; *compare* Ex. 1003, ¶¶128-133 *with* Petition, 32-34; *compare* Ex. 1003, ¶¶140-42 *with* Petition, 36-37; *compare* Ex. 1003, ¶¶152-53 *with* Petition, 40-41; *compare* Ex. 1003, ¶¶175-77 *with* Petition, 49-50.

Petitioner offers no explanation for its failure to present credible testimony versus simply parroting the Petition. As PO has shown previously and shows below, such a declaration is of little use and should be afforded no weight. *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9, at 18 (PTAB Aug. 24, 2022) (precedential).

III. GROUND 1: PETITIONER FAILS TO CARRY ITS BURDEN OF ESTABLISHING THAT HAYS RENDERS CLAIMS 1-14 OBVIOUS.

A. Claims 1[a] and 8[a]: Hays does not teach "pre-selected in-game advertising"

Hays does not disclose "pre-selected in-game advertising." First, Petitioner goes on to suggest that it is adopting PO's interpretation of the term "pre-selected." Even so, Petitioner, again, fails to ascribe proper meaning to the term because it fails

to distinguish between the selection of an advertisement and a "pre-selected" advertisement in its analysis of Hays. Reply, 3-4.

Petitioner also attempts to criticize Dr. Akl for purportedly being unable to describe "when or how content must be 'pre-selected.'" Reply, 2. But throughout the four pages of cited testimony Dr. Akl explained exactly what the claims require. For instance:

> A. There is no preselection step on its own. There is a check what preselected advertising to send and there is a send the preselected in-game advertising. I am saying that the claim language says you need to check and then you need to send. And the sending step happens after the checking step.

Ex. 1020, 41:8-15. Petitioner ignored this testimony and instead asked questions unrelated to the claims such as "does the preselection of -- of content, does that need to have already happened by the time you send the preselected in-game advertising?" *Id*., 41:22-25. But this is irrelevant to the claim, as Dr. Akl testified. *Id*., 42:1-25.

As explained in the Response, Hays describes weighting advertisements for selection. It never describes that these advertisements are "pre-selected," as is required by the claims. Rather, Hays weighs advertisements against each other for dynamic real-time selection.

On Reply Petitioner points to "sub-channels" that it asserts pre-select advertisements before they are used in the advertising and weighting system. Reply, 3. Petitioner is wrong. Hays's sub-channels are sub-channels for advertisement

spaces within a game—not sub-channels (or sub-selections or sub-groupings) of the advertising content itself. Ex. 1005, [0021] ("[T]he ***multiple games that comprise the network of available advertisement spaces can be divided by genre*** such as sports titles (and even further by specific sport), children's titles, racing titles, etc. Accordingly, advertisers can target the delivery of their advertisement campaign specifically to a ***sub-channel*** as that sub-channel relates to their campaign."). Alternatively, Hays describes that sub-channels can relate to, e.g., time of day. *See id*. ("Accordingly, advertisers can target the delivery of their advertisement campaign specifically to a sub-channel as that sub-channel relates to their campaign 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…."). Thus, Hays specifically describes dividing the platforms in which advertisements may be displayed—the games and spaces—into sub-channels. This identification of games and corresponding spaces that are divided into subchannels does not disclose "pre-selected in-game advertising," as the claims require.

Hays does not describe how any advertisement or group of advertisements is "pre-selected." Rather, Hays allows advertisements to be targeted to game titles along the channels described above. *See id.* ("advertisers can target the delivery of their advertisement campaign specifically to a sub-channel as that sub-channel relates to their campaign."). But as Dr. Akl explains the actual selection of

advertisements is still according to the weighting system. *See* Ex. 2004, ¶56. Hays never describes that ads are selected, much less preselected. *Id*., ¶57-58. Indeed, the use of sub-channels simply enables targeting of advertisements, but it does not describe that these advertisements are pre-selected. *Id*., ¶59.

Hays's description of accepted "technical media formats," which Petitioner identified for the first time for this element in its Reply, also does not teach "pre-selected in-game advertising." Ex. 1005, [0042]. Instead, Hays describes whether the advertisement "has been specifically approved," which is determining technical compatibility of an advertisement with a client and whether an advertisement can be sent. *Id.* This is not "pre-select[ing]" the advertising content to send. Petitioner's description proves as much. Petitioner's references to "pre-select" or "later be selected for delivery" are merely attorney argument not supported by the description in Hays or by Dr. Zagal. *See, e.g.*, Reply, 5.

Thus, Hays fails to teach "pre-selected in-game advertising."

B. Claims 1[a] and 8[a]: Hays does not teach advertising "for use in a video game"

Hays does not disclose sending in-game advertising ***for use*** in a video game. First, Petitioner attempts to equate unrelated sections of the '958 Patent's specification, citing to a discussion of updating a logo or a poster. *See* Reply, 6. But neither the logo nor poster are actually used in the game. To the contrary, both are simply described as skins that are periodically updated. *See* Ex. 1001, 6:60-61 ("the

shirt may be replaced with a sign that states 'space available.'"). Moreover, the specification describes examples that are ***for use*** in the game, including for "newer mobile communication devices may be able to display elaborate content, so distinguishing among types of mobile communication devices may allow a game provider to maximize the experience on each type of mobile communication device." Ex. 1001, 10:41-45.

Second, none of Petitioner's examples from Hays suggest "updated video-game content being usable in the video game." For instance, Petitioner cites where Hays "send[s] bots or electronic agents into the game as advertising units or real characters in the game, which advertise or promote a product (e.g., a game character may move around a screen holding a can of Pepsi and ask player if they would like a drink)." Ex. 1005, [0079]. According to Petitioner, "the player has the option to drink the advertised product." Reply, 6. Yet nowhere does Hays include any suggestion that the player's character has the option to drink any advertised product ***in the game***, as opposed to suggesting the player do so in real life. Indeed, contrary to Petitioner's suggestion, Hays never describes any interaction by the user with these "bots or electronic agents." Instead, they act as non-interactive mobile advertisements. Finally, these "bots" are not received from a server, but rather are "advertising units," which are already part of the game, as Hays describes. *See* Ex. 1005, [0018].

Petitioner goes on to cite another example of "a game character eating a brand name energy bar to boost her power in the game." Reply, 7 (citing Ex. 1005, [0019]). But again it is the ad unit, the "pre-designated geometry within the game," that is actually for use in the game. Ex. 1005, [0018]. Hays does not describe that inclusion of an advertisement—i.e., the specific brand of energy bar—as modifying any functionality for use in the game. Ex. 2004, ¶61-74. Rather, the game operates in the same way whether the energy bar is blank, shows the branding of a known brand, or includes a fictional in-game brand. Ex. 2004, ¶71-72.

Even if the Pepsi can and energy bar examples are similar to updating a shirt to provide a logo, as described in the '958 Patent, this is irrelevant to the claims. The updated logos on a shirt in the '958 patent are never described as "for use," as is required by the claim. *See* Ex. 1001, 6:45-47; 6:53-55.

For similar reasons Petitioner's attempt to distinguish the claims from the Examiner's analysis of Gatto during prosecution fails. *See* Reply, 7-8. The applicant argued that "[a] close reading of Gatto reveals that the 'hyperlinks to download promotional items' are, in fact, not usable in the so-called video game," and "it would not make sense for an email to provide hyperlinks for content that is usable in the email itself." Ex. 1002, 188, 189. Indeed, as Petitioner appears to acknowledge, "the problem with Gatto was that the updated content was not itself displayed within the email but instead linked by the email's hyperlinks." Reply, 8.

Thus, the distinction with Gatto is the same as Hays, which as noted, provides "ad units," which are "pre-designated geometry within the game," at which linked advertising may be displayed. *See* Ex. 1005, [0018]. As with the hyperlinks in Gatto, this advertising does not alter the functionality of the individual ad unit.

C. Claims 3 and 10: Hays does not teach 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's arguments ignore that the claim language expressly requires 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***." Nowhere does Hays disclose sending information to the mobile communication device regarding an in-game placement location nor that the information is part of the updated content. Indeed, Petitioner does not address this specific claim language. Instead, Petitioner first urges, without citation, "the device still needs to know which ad unit to display it on." Reply, 9. But Hays does not disclose this. Indeed, Hays suggests the opposite, explaining that its ad server provides general advertisements to standardized locations, enabling them to be sent to "large sets of available ad units from multiple game titles." Ex. 1005, [0022]. Hays describes 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].

Thus, while Hays describes predesignated locations for "ad units," it never discloses "***send[ing] information to the mobile communication device regarding the in-game placement location of the content***," much less "the information ***being part of the updated content***." Ex. 2004, ¶¶75-80. Petitioner's citation to Dr. Zagal offers no help, as to the extent his conclusory parroting of the Petition is even accepted, his testimony never addresses the requirement that the in-game placement location be provided ***as part*** of the updated content. *See* Reply, 10 (citing Ex. 1003, ¶106).

D. Claims 5 and 12: Hays does not teach that "the message is pre-selected by the server based on 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."

Hays does not disclose pre-selecting a message "based on 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."

First, as explained above, Hays does not disclose that the advertisements are pre-selected. Hays likewise does not disclose that the messages are pre-selected. Hays, instead, describes that advertisements and associated messages are selected

based on a weighting scheme relative to the weight of other advertisements—not the recited factors—even within a sub-channel.

Second, Petitioner relies on paragraph 42 of Hays and asserts that messages are pre-selected based on "media format and/or specific approval of recipient client devices" and that this results in a selection of messages "based at least on the model type of the mobile device as required by the claims." Reply, 11. But this is incorrect, entirely unsupported, and merely attorney argument. Even so, Hays does not describe that approval of devices is related to model type or any other recited factor. *See* Response, 21-24.

Hays's disclosure of weighting based on "the specific client type" fails for the same reason. The "specific client type" is not described as the "model type associated with the mobile communication device" or other recited factors. Nor does Dr. Zagal explain how a POSITA would arrive at this conclusion.

Accordingly, Hays does not teach that a "message is pre-selected," nor that any "message" or other content is pre-selected based on the required factors.

E. Claims 7 and 14: Hays does not teach that "the server tracks the distribution of updated content."

Petitioner begins its argument by pointing to "frequency caps." Reply, 12. PO did address this issue in the same discussion of recording advertisements delivered to a session. Response, at 25-26 (citing Ex. 1005, [0045]). As explained, this ignores the claim's requirement to track "what has been uploaded to the mobile

communications device." This is not met by a session, which would at most only represent a portion of any data uploaded. Ex. 1005, [0045]; Ex. 2004, ¶¶93, 102. Petitioner's "active session database 124" example (Reply, 12-13) fails for similar reasons.

Petitioner also argues that Hays meets this limitation based on a misquotation, stating Hays's "active session database 124" is "'used to ***track*** and record ***all communications and data*** sent and received from the' mobile device." Reply, 12-13 (quoting Ex. 1005, [0038]). Petitioner omits that this sentence is explicit that it relates to "a record in the active session database," rather than tracking the data sent to the device outside of a particular session. Ex. 1005, [0038].

Petitioner moves on to examples that track a user's reaction to an advertisement rather than tracking delivery of advertisements. Reply, 13 (citing Ex. 1005, [0025]). The examples of tracked information are "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)." Ex. 1005, [0025]. None of these meets the claim. Rather, they describe tracking user's reactions to particular advertisements, which is irrelevant to the claim language.

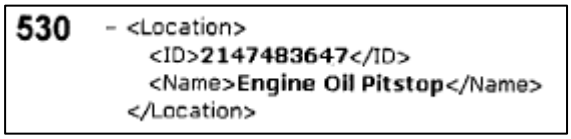
IV. GROUND 2: PETITIONER FAILS TO CARRY ITS BURDEN OF ESTABLISHING THAT HAYS COMBINED WITH CHU RENDERS CLAIMS 3 AND 10 OBVIOUS.

A. Claims 3 and 10: The Hays-Chu combination does 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."

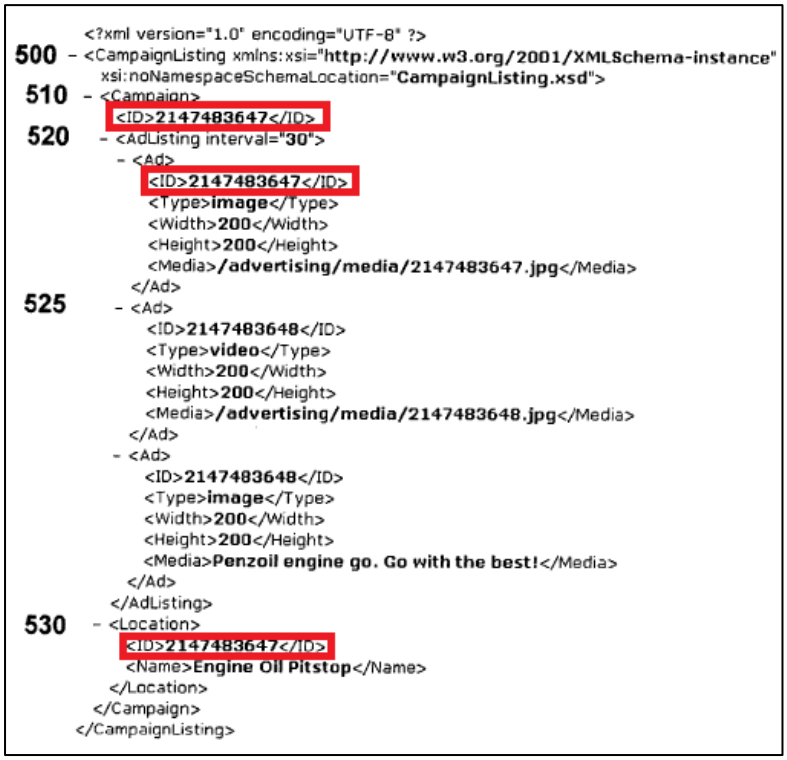
Chu makes clear that its system transmits the location of an advertisement to the server. *See* Ex. 1007,14:31-33 ("***game clients must pass the server information*** such as but not limited to ***the location identifiers*** that uniquely identify an ad within a game…."). Petitioner acknowledges as much in citing a different section of Chu. Reply, 14-15 (citing Ex. 1007, 14:20-15:5).

The cited passage explains "[a]fter an online game running on … a 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***." Ex. 1007, 14:50-54. Thus, Chu explains that the client device itself determines the location, rather than the server sending it with the updated content. The remainder of the description describes data transmission and advertising campaigns, but never states that location information is sent from the server to the client. Figure 7 shows an example "illustrat[ing] an XML format structure that may be utilized to ***send metadata*** and which corresponds to the example structure 800 for the metadata." *Id*., 14:57-59. Figure 7's reference to location (*see* 530) does not indicate that it is transmitted from the server, rather than

to the server. Further, this "location" is not an X/Y coordinate structure, which is necessarily not "an in-game ***placement location***," because it contains no information for placement.



Id., Fig. 7. To the extent Petitioner suggests the "ID" 2147483647 is a placement location, this is simply wrong, as the same ID appears for information plainly unrelated to location:



Id., Fig. 7. Thus, the "ID" may merely refer to an ID number used for the ad.

Petitioner also asserts that Figure 5 "shows that the client makes a request to the 'Transplay Advertising Server,' which '[r]eturn[s] campaign metadata and ad

assets.'" Reply, 15 (no cite). This is false. Fig. 5 is never described in Chu, but Fig. 5 on its face shows that the client identifies and specifies the location the advertisements. Ex. 1007, Fig. 5.

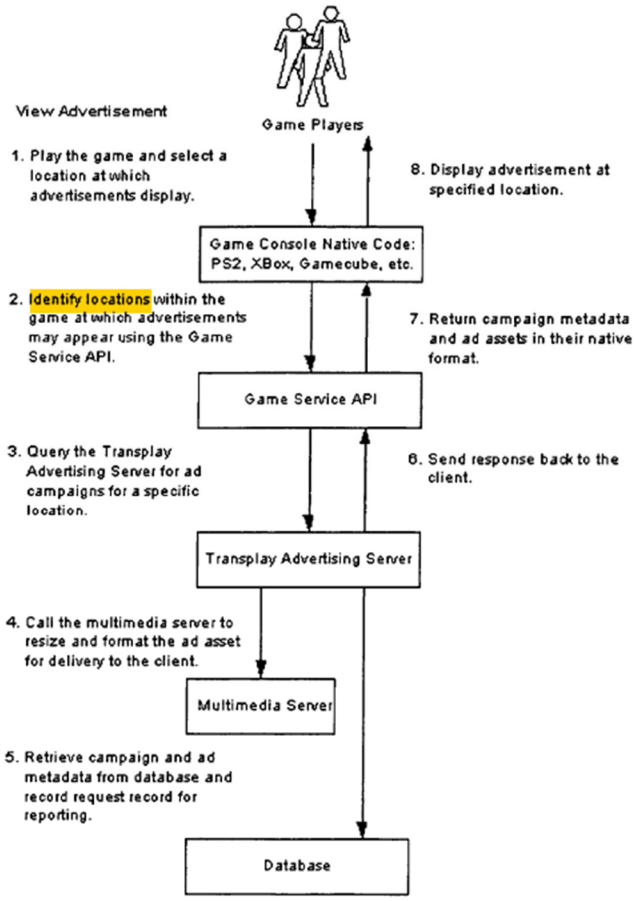


Fig. 5

Id. The Transplay Advertising Server returns campaign metadata and ad assets, but the game players identify the location. *See id.*

Nor would it make sense for the server to send location information in a system like Chu, in which the client requests specific advertisements and identifies the location in advance. *See* Ex. 2004, ¶112. Petitioner seems to acknowledge as

much, stating as a motivation to combine that "Hays discloses that ad units are found in certain locations within the game," and Chu would "provid[e] a location to specify the ad unit." Reply, 16. To the extent this is correct, it proves PO's argument—Chu is providing advertising at a location specified by the mobile device, i.e., the ad unit. There is no need for the server to specify a location.

Finally, even if the metadata Petitioner identifies were sent from the server to the client device, there is still no indication or disclosure in Chu that location information is included within the advertising assets. Thus, Chu does not disclose or suggest sending "information providing an in-game placement location" "as part of the updated content," as the claim requires.

B. Petitioner Does Not Establish that a POSITA Would Combine Hays and Chu.

Petitioner's motivation to combine relies almost entirely on the misreading of Chu explained above and fails for this reason. Further, Petitioner urges that PO "grossly mischaracterizes Hays," in explaining that advertisements in Hays are not fixed to a specific location. Reply, 17. Putting aside the unnecessary rhetoric, Hays is agnostic to location to achieve its goal of enabling "advertisers to deliver their campaign messages to specific audiences they wish to target across one or multiple game titles played across multiple platforms (e.g., PC, console, mobile, etc.) without being limited to delivering their campaign to only a single specific game title." Ex. 1005, [0017]. To achieve this goal, a POSITA necessarily would not modify Hays

based on a system that identifies specific advertising locations to the server, as Chu teaches. *See* Ex. 2004, ¶112-113.

V. GROUND 3: PETITIONER FAILS TO CARRY ITS BURDEN OF ESTABLISHING THAT LEVKOVITZ RENDERS CLAIMS 1-2, 4-9, AND 11-14 OBVIOUS.[1]

A. Claims 1[a] and 8[a]: Levkovitz does not teach "pre-selected in-game advertising."

Levkovitz does not disclose "pre-selected in-game advertising." Levkovitz, instead, describes selecting and sending stored content in response to a content request. Ex. 1008, [0126], [0147]. And, contrary to Petitioner's assertion, neither Levkovitz, nor the Petition, describe content items stored in advance. Reply, 18.

At most, Levkovitz describes sending content items "in advance," at the time they are selected, which is not "pre-selected." Ex. 1008, [0147]. Petitioner attempts to conflate this description in [0147] with [0126], but in each instance, the content is sent at the time it is selected. Paragraph [0126] describes selecting and sending stored content items in response to a content request. In contrast, paragraph [0147] describes sending advertisements before the campaign period. Each of these is distinct from the step of storing "pre-selected in-game advertising" which is sent to the mobile communication device in a later step in the claim. The plain language of

[1] The reply incorrectly states that claim 3 was part of ground 3. It was not. *See* Petition at 35.

the claims requires that more is needed to "pre-select" than simply selecting and sending an advertisement in response to a request.

B. Claims 1[a] and 8[a]: Levkovitz does not teach advertising "for use in a video game."

Petitioner does not address that Levkovitz provides nothing more than a banner ad within a game. Such a banner ad is not necessarily for use in the video game. Petitioner instead suggests that PO has proposed some alternative meaning of "use." Reply, 19. But Petitioner bears the burden here and never proposed any meaning of "for use," ***at all***, much less a meaning that would somehow encompass the display of a banner ad. As explained, a banner ad is not even a part of the game, much less for use in the game. Response, 35-37; Ex. 2004, ¶¶122-131.

Petitioner's attempt to distinguish the prosecution history and the Examiner's analysis of Gatto similarly fails. Petitioner tacitly acknowledges that Levkovitz simply displays advertisements. Reply, 19-20; *see also* Ex. 1008, [0005] (discussing Levkovitz's "placement of content, e.g., ***advertisements or banners***, within an application executed by a cellular phone, a mobile phone, or other wireless communication device."). This does not meet the claim, and all grounds based on Levkovitz fail.

C. Claims 1[e] and 8[e]: Levkovitz does not teach "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."

Levkovitz fails to disclose "send[ing] the pre-selected in-game advertising … as the updated content for the mobile video game." As described above, Levkovitz describes selecting and sending stored content in response to a content request, which is not "pre-selected." Ex. 1008, [0126], [0147]. Petitioner argues that Levkovitz "could not be more clear than an 'ad server' sends content to the device." Reply, 21 (citing Ex. 1008, [0006], [0128], [0143], [0152]). But none of these disclosures in Levkovitz describes sending "pre-selected" content or how the content is "pre-selected" as described in Section V.A. *supra.*

D. Claims 7 and 14: Levkovitz does not teach that "the server tracks the distribution of updated content."

Petitioner again fails to grapple with the distinction PO drew in the Response—Levkovitz does not track content that has been uploaded but rather presentations to a user. Ex. 1008, [0132]. Petitioner does not address the distinction between tracking presentations versus tracking "what has been uploaded." *See* Reply, 21-22. As explained, tracking presentations does not meet the claim.

Petitioner attempts to present a faulty argument based on claim construction to suggest that "claims are disclosed as long as the prior art teaches tracking of at least one uploaded updated video-game content." Reply, 22. But Petitioner ignores

that the claim language does not read "tracking of at least one uploaded updated video-game content." Instead, the claim requires "track[ing] the distribution of updated content," which is not shown by Levkovitz.

Finally, Petitioner again attempts to flip the burden to PO to cite something in Levkovitz "that indicates a content item is uploaded but not presented." Reply, at 22. First, this is improper burden shifting. Second, as explained above, Levkovitz does not upload anything, rather it presents advertisements via WAP. This is confirmed by the cite Petitioner provides which describes an advertisement "directed for presentation," which is irrelevant to "track[ing] the distribution of updated content," as the claim requires. Reply, 22 (citing Ex. 1008, ¶127).

VI. GROUND 4: PETITIONER FAILS TO CARRY ITS BURDEN OF ESTABLISHING THAT LEVKOVITZ COMBINED WITH CHU RENDERS CLAIMS 3 AND 10 OBVIOUS.

As explained in Section IV *supra*, Chu does not teach sending information to the mobile communication device regarding the in-game placement location of the content, the information being part of the updated content. At most it discloses the opposite—sending a placement location from the mobile device to the server. Petitioner presents no evidence, in the form of testimony or otherwise, to establish that this is incorrect. Petitioner similarly fails to shoulder its burden of establishing a motivation to combine Levkovitz and Chu. *See* Response, 41-44. Dr. Zagal's

testimony is of no help as he simply parrots the Petition. *Compare* Petition at 49 *with* Ex. 1003, ¶¶176.

VII. HAYS IS NOT A PRINTED PUBLICATION UNDER 35 U.S.C. § 311(b)

As discussed in the Response, Hays is not "prior art consisting of patents or printed publications" under § 311(b) and is therefore ineligible to be prior art in this proceeding. Response, 48-50. Petitioner suggests only that PO's "argument has been repeatedly rejected by the Board as well as the Federal Circuit." Reply, 24. Prior agency decisions, however, are not afforded any deference on this question of statutory interpretation. *See Loper Bright Enters. v. Raimondo*, No. 22-451, 603 U.S. ___ (June 28, 2024). And the Federal Circuit recently heard oral argument on this question of statutory interpretation in *Lynk Labs, Inc. v. Samsung Electronics Co*., Appeal No. 23-2346, with an opinion yet to issue.

Finally, Petitioner offers a last-ditch effort suggesting that "Hays claims priority to a PCT application." To the extent this is correct, Petitioner did not rely on that priority application in the Petition or cite to it as disclosing any claim element. Petitioner's attempt to rely upon the PCT Application on Reply is improper. And even if this argument were properly presented, Petitioner does nothing to establish that this PCT Application meets any claim element or supports any disclosure within the actually relied upon Hays reference, which as discussed, is not itself prior art. *See* Reply, 24.

VIII. PO'S SECONDARY CONSIDERATIONS STAND UNREBUTTED.

Petitioner offers no evidence in response to the Secondary Considerations of Non-Obviousness, including long-felt need for the invention (Response, 45-46) and teaching away (*id*., 46-47). To the contrary, Petitioner attempts to conflate console games and mobile games, suggesting that the existence of console updates suggests that there was no long felt need. First, this ignores the claim language. Second, as Dr. Akl explains, in 2007 consoles already had extensive processing and memory capabilities (Ex. 2004, ¶43) "in contrast, due to the much more limited processing, storage, and data bandwidth capabilities of mobile devices, the only option available for mobile games, at that time, was to download an entire new game." *Id*. ¶44. This testimony stands unrebutted by any credible evidence.

Petitioner does not address teaching away at all. Thus, this stands unrebutted. Further, Petitioner offered no evidence or argument in response to PO's explanation of the state of the art, which necessarily informs the obviousness analysis. Response 5-10. This unrebutted evidence further confirms non-obviousness.

IX. CONCLUSION

Petitioner fails to shoulder its burden of establishing that Claims 1-14 are unpatentable.

Dated: December 13, 2024 Respectfully submitted,

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CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24(d), the undersigned certifies that this Sur-Reply contains 4,573 words according to the word-processing program used to prepare this paper. The foregoing word count complies with the 5,600 word type-volume limit specified by 37 C.F.R. § 42.24(b)(1).

Dated: December 13, 2024

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The undersigned hereby certifies that a copy of the foregoing Patent Owner's Sur-Reply has been served electronically via email upon the following:

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