

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. IPR2024-00200

Patent No. 11,117,056

PATENT OWNER'S PRELIMINARY 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

I. INTRODUCTION

Patent Owner Flip Phone Games, Inc. (“FPG” or “Patent Owner”) submits this Preliminary Response to Petitioner PLR Worldwide Sales Limited’s (“Playrix” or “Petitioner”) petition for inter partes review of U.S. Patent No. 11,117,056 (“the ’056 Patent”).

The Petition ignores that the ’056 Patent claims priority to mid-2007—before the release of any modern smartphone—and describes and claims what was at the time a novel and unconventional way of updating in-game content for mobile devices. In particular, the ’056 Patent updates that in-game content without updating the entire game and does so based on a request to a server, which must identify what content to send, along with a message based on specific criteria and related to the content. Updates of this type were revolutionary and changed the face of mobile gaming because developers could provide new features or levels to drive user engagement, without forcing users to fully update a game or to purchase a new game.

The PTAB has already recognized the novelty of the invention claimed by the parent of the ’056 Patent, which proceeded through the full appeal process after which the PTAB confirmed that claims that ultimately issued were novel over the art relied upon by the Examiner. The Petition ignores this fact as well as the fundamental differences between the prior art and the claims of the ’056 Patent, and instead attempts to broaden the claims in this forum to cover any form of content

that may be transmitted to a mobile device solely to manufacture an artificial invalidity challenge to the claims.

The Petition includes other abuses and errors as well. Petitioner adopts inconsistent claim construction positions between the Petition and a parallel district court proceeding involving the '056 Patent. At the district court and relying on a different expert than the one it relies on here, Petitioner contends that multiple claim terms are indefinite and thus not amenable to construction. Yet both the Petition and the supporting declaration of Dr. José Zagal (Ex. 1003) appear able to apply prior art to these claim terms in this forum. More critically, the “expert” declaration Petitioner submits purporting to be from Dr. Zagal is largely just a word-for-word copy of the Petition itself, confirming that no reliable expert testimony supports the Petition’s faulty conclusions as to issues such as limitations missing from the purported prior art being known or obvious, among other things.

These deficiencies are compounded by Playrix presenting similar prior art to that already presented during prosecution, which is similarly lacking as to the claim element the PTAB found missing during an earlier appeal of the parent of the '056 Patent. Finally, the Petition relies extensively on “secret prior art” under 35 U.S.C. § 102(e), which references should not be available in this proceeding under 35 U.S.C. § 311(b). For these reasons and others discussed herein the Board should deny institution.

II. BACKGROUND

A. Mobile Gaming Technology was Entirely Different as of the June 26, 2007, Priority Date of the '056 Patent.

The relevant time for the PTAB to consider is the priority date of the '056 Patent, June 26, 2007, and at that time the claimed invention was both novel and non-obvious. 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.

The '056 Patent describes and claims a novel and unconventional way of using mobile gaming and mobile gaming 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.” '056 Patent, 2:14-17. The innovative mobile gaming technology claimed in the '056 Patent originates from mobile game developer Mobile Deluxe (“MDX”), which was founded in 2003 and is the precursor of FPG. At that time, smartphones and modern online stores for smartphone app purchases (“App Stores”) had not been launched, and the mobile gaming landscape was very different than it is today.

It was not until mid-2008, a full year after the priority date of the '056 Patent, that App Stores even became available.¹ Before that time, mobile games had a very short life cycle. Wireless carriers each managed their own individual app store or “deck,” with a limited catalog of games (typically several hundred titles). Once that capacity was reached, the carrier would be forced to remove or “sunset” older game titles to make room for new games.

As the '056 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 1:35-39. 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. Rather, mobile games were a one-time purchase, typically \$4.99 to \$9.99 each. 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, triggering a new lifecycle for that new title. 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

¹ 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.”).

others.” *Id.* at 1:36-39. Thus, at the time the ’056 Patent was filed, 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.

Rather than utilize the then standard model for mobile gaming, MDX decided to pursue a different approach and invented systems and methods to dramatically change the game a consumer had already downloaded (and paid for). The technology MDX invented allowed carriers to update content and promotions presented to customers through tailored gaming updates. MDX understood that this new approach to mobile gaming would keep players engaged and keep games fresh. And in fact, MDX’s innovative approach to mobile gaming led MDX to succeed in an extremely competitive market.

The ’056 Patent’s claims provide a unique solution to this problem, updating mobile game content based on a request to a server, along with sending a message related to the updated content that is based on specific factors such that “a particular scene within the game may be rearranged so that the user has something new to look at or explore” and that “the updated content may comprise a new level within the game” for example. *Id.*, 4:40-43. The claims thus improve the utility of video games on mobile devices by allowing videogame content to be updated with content based on a request to a server, along with a related message, as recited in the claims. *See, e.g., id.*, 5:15-6:35. This improvement was groundbreaking at the time and was far

from obvious in a pre-App Store and pre-smartphone world that had a static approach to mobile gaming.

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 ’056 Patent’s Claims.

The Petition attempts to provide a summary of the state of the art and in so doing suggests that “[g]ame developers embraced the idea of updateable games even before mobile games became popular.” Petition at 7. To support this position Petitioner relies on unauthenticated hearsay that is not even prior art, and which, in fact, draws the exact opposite conclusion and demonstrates the novelty of the claimed invention of the ’056 Patent in June 2007.

The Petition begins by discussing references that address the same subject as addressed during prosecution—updated advertising—and 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 ’056 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 spring² of 2007” (Ex. 1015 at 1 (emphasis added)) confirming that as of the June 2007 priority date, the invention provided by the ’056 Patent was novel.

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 it is a publication at all, let alone published on this date, or otherwise authenticating the Exhibit. Nor does Petitioner rely on Exhibit 1016 as a prior art reference. Further, this thesis supports the novelty of the invention claimed in the ’056 Patent, stating 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).

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. Further as with the other exhibits, Exhibit 1017 confirms the novelty of the ’056 Patent, stating “[i]n the *near future*,

² Spring in Australia runs 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>

mobile in-game advertising *will become* increasingly attractive for providers of mobile phones.” Ex. 1017 at 1 (emphasis added). Thus, this press release does not describe prior art, but merely describes what may happen in the *future*.

Finally, the Petition relies on Exhibit 1018, purportedly published in 2001. *See, e.g.*, Petition at 7. Petitioner likewise submits no evidence corroborating the date of alleged publication or authenticating this Exhibit. Exhibit 1018 similarly confirms that in-game content updates were not available at the time of the priority date of the ’056 Patent. 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). Further, this article confirms exactly the need to address the problem that the ’056 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.

C. The ’056 Patent and Its Parent Underwent Thorough Prosecution Addressing Similar Prior Art as the Petition.

1) Prosecution of the Application that Led to the ’056 Patent.

FPG filed its Application for the ’056 Patent on April 9, 2020. Ex. 1002 at 135. The Application claimed priority to U.S. Patent No. 9,731,202 (“the ’202 Patent”), filed June 26, 2007, and incorporated the ’202 Patent by reference in its entirety. *Id.* at 200. The Application also noted that it was a continuation of U.S.

Patent No. 10,617,958 (“the ’958 Patent”) and incorporated the ’958 Patent by reference in its entirety. *Id.*

In the first substantive Office Action mailed on September 15, 2020, the Examiner rejected the claims under § 102 based on U.S. 2008/0307412 (“Marr”). *Id.* at 98-99. Marr relates to a “distribution server that determines what advertisement to place in a particular advertising space within the game based on considerations such as the game title and the time of day, month year, etc.” Marr at [0004]. The game in Marr is on a “client device” that “may be any other type of network capable device. Such devices include, but are not limited to cellular telephones, personal computers, laptop computers, television set-top boxes, portable internet access devices, portable email devices, portable video game devices, personal digital assistants, digital music players, and the like.” *Id.* at [0016].

The Examiner also rejected the claims under § 103 as allegedly obvious in view of the combination of Marr and U.S. 2006/0136297 (“Willis”). Willis, which was considered in the prosecution history for the ’202 Patent, relates to providing targeted advertising to mobile video game platforms, where the advertising content is delivered to gaming platforms in dependence upon a location of the mobile platform. *See* Willis at [0015] and [0024]. The Examiner also noted that certain dependent claims were “objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form including all of the

limitations of the base claim and any intervening claims.” Ex. 2002 at 101. Finally, the Examiner issued a double patenting rejection of the Application based on the ’202 and ’958 Patents. *Id.*

In response, FPG amended the Application’s independent claims to include element “send a message relating to the in-game video game content to the mobile communication device in response to receiving the request, wherein 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” from the dependent claims the Examiner had pointed out as allowable if incorporated into the independent claims. *Id.* at 76-80. FPG then argued that the amended independent claims “are therefore allowable at least because of the incorporated subject matter.” *Id.* at 81.

Thereafter, in response to a final Office Action, FPG filed a terminal disclaimer over the ’958 Patent and requested reconsideration of the Application. *Id.* at 56-64. The Application was then allowed on June 3, 2021. *Id.* at 30-35, 48. The application that led to the ’056 Patent issued only after its parent was pending for nearly ten years and received multiple prior art rejections addressing art and argument that is very similarly to what is presented in the Petition.

2) The Prosecution History of the '056 Patent's Parent, the '202 Patent, Included the PTAB's Confirmation of Patentability.

As discussed, the '056 Patent claims priority to the '202 Patent, which went through a lengthy—almost ten-year—prosecution process, including multiple appeals, the first of which led the Examiner to reopen prosecution and issue a new non-final rejection, and the second of which reversed the Examiner's rejections based upon prior art. Petitioner's repetitive arguments addressing similar prior art should be rejected as insufficient to institute review.

FPG filed the application that eventually issued as the '202 Patent on June 26, 2007. Ex. 2002 at 289. The Examiner initially issued multiple rejections based on US 2004/0127279 ("Gatto"). *Id.* at 100-05, 127-29, 176-81, 202-04, 225-28. Gatto concerns email tickets with a promotional layer that is initially shown to an email recipient and a hidden, secret layer that is gradually revealed following a predetermined action by the recipient. *See* Gatto at [0010]-[0011]. The email ticket in Gatto also includes authentication information that enables authentication of the ticket so a recipient can potentially win a prize. *See id.* at [0011].

After a series of arguments, FPG amended the claims that ultimately issued as the '202 Patent to recite "checking what updated video-game content to send based on one of the factors including a type of the mobile communication device, a telecom service associated with the mobile communication device, and a service provider of the telecom service." Ex. 2002 at 185-86. FPG explained that Gatto did

not anticipate the claims because “Gatto is not relevant video-game content at all.” *Id.* at 187. Further, “Gatto does not disclose that this so-called content is ‘updated,’ or that the program ‘check[s] what updated content to send based on one of the factors including a type of the mobile communication device, a telecom service associated with the mobile communication device, and a service provider of the telecom service.’” *Id.* at 188. As FPG went on to explain, the claim requires “‘checking what updated content to send,’ rather than which display program a graphical animation should use.” *Id.* Such an embodiment was not disclosed by the prior art.

After a series of rejections, FPG presented these arguments in a pre-appeal brief (*id.* at 164-68) and in an appeal brief once the pre-appeal panel determined that the application should proceed to the BPAI. *Id.* at 132-51. Thereafter, the Examiner reopened prosecution, relying on the same prior art as used previously. *Id.* at 124-29. However, the Examiner’s rejection was newly based on the Willis reference discussed above as a primary reference for anticipation, and Gatto as a secondary reference in an obviousness rejection of dependent claims. *Id.*

The Examiner added Willis to teach the limitation of “the video-game content is selected based on the location of the mobile communication device” because “Gatto fails to teach the video-game content is selected based on the location of the mobile communication device.” Ex. 2002 at 180. The Examiner went on “Willis

discloses video-game content is selected based on *the location* of the mobile communication device.” *Id.* (emphasis added).

Thus, FPG explained in response to the rejection that “Willis discloses that *advertising content is sent merely based on the geographic location* of the gamer... Regardless of whether the video game devices disclosed in Willis may be associated with a ‘type,’ ‘telecom service,’ and/or ‘service provider,’ nothing in Willis discloses that one of those characteristics, as claimed here, determines the advertising information sent to those devices according to Willis's method.” *Id.* at 113 (emphasis added). Rather, Willis “is directed to techniques for delivering advertising content to a gaming platform based on the location of the gaming platform.” *Id.* at 112. The system described by Willis “communicates with a geolocation server to determine a playing location of a gamer and then provides this location information to an advertising broker.” *Id.* Willis’s “advertising broker determines both the appropriate content and the identities of advertisement service providers for serving the content to the platform.” *Id.*

Thus, as FPG explained to the Examiner, “[n]othing in Willis, however, discloses that ‘updated video-game content’ is sent or uploaded ‘based on one of the factors including a type of the mobile communication device, a telecom service associated with the mobile communication device, and a service provider of the telecom service.’” *Id.* at 113.

The Examiner maintained the rejection and thus FPG filed a second notice of appeal to the PTAB. *Id.* at 91, 99-106. On appeal, FPG distinguished the claimed invention from the prior art based on the same claim element requiring “checking what updated video-game content to send based on one of the factors including a type of the mobile communication device, a telecom service associated with the mobile communication device, and a service provider of the telecom service.” *Id.* at 73-81.

The PTAB issued a decision reversing the Examiner’s rejection of the application. *Id.* at 40-43. The PTAB explained that “[w]e concur with Appellant’s argument that the Examiner erred in rejecting independent claim 15 under 35 U.S.C. § 102(b) as being anticipated by Willis.” *Id.* In particular, the PTAB explained that “Willis does not disclose, either expressly or inherently, the limitation ‘checking what updated video-game content to send based on one of the factors including a type of the mobile communication device, a telecom service associated with the mobile communication device, and a service provider of the telecom service.’” *Id.* The Board did not include any new ground of rejection.

Thus, the PTAB in addressing the ’202 Patent distinguished the prior art based on a claim element similar to one recited in the independent claims of the ’056 Patent.

'202 Patent Element Found Patentable by PTAB (Ex. 2002 at 40-43.)	'056 Patent, Claim 1	'056 Patent, Claim 9
checking what updated video-game content to send <i>based on one of the factors including a type of the mobile communication device, a telecom service associated with the mobile communication device, and a service provider of the telecom service</i>	the message is pre-selected by the server <i>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</i>	the message is pre-selected by the server <i>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</i>

III. THE BOARD SHOULD DENY INSTITUTION OF THE PETITION.

A. Extensive Prosecution History, Including Very Similar Art, Weighs in Favor of Denial Under § 325(d).

The Board should exercise its discretion to deny institution under § 325(d) because the Petition presents “the same or substantially the same prior art or arguments previously ... presented to the Office,” 35 U.S.C. § 325(d), and because Petitioner failed to meet its burden to show material error with respect to such art or arguments. *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020) (precedential) (“*Advanced Bionics*”); *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586,

Paper 8 (PTAB Dec. 15, 2017) (precedential as to Section III.C.5, first paragraph) (“*Becton*”).

Under *Advanced Bionics*, the Board first considers “whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office.” IPR2019-01469, Paper 6 at 7-8. If “either condition of [the] first part of the framework is satisfied,” the Board then considers “whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.” *Id.* at 8. “If the petitioner fails to show that the Office erred, the Director may exercise his discretion not to institute *inter partes* review.” *Id.* (citing *Becton*, IPR2017-01586, Paper 8 at 24).

Here, institution should be denied because substantially the same prior art and arguments previously were presented to the Office, the Examiner correctly resolved them, and Petitioner makes no allegations to the contrary.

1) Part 1 of *Advanced Bionics*: The Thorough Prosecution History of the ’056 Patent Considered Substantially the Same Prior Art and Arguments Petitioner Presents.

As explained in further detail above, the ’056 Patent also incorporates by the reference the ’202 Patent, prosecution of which began in 2007 and proceeded for nearly ten years. This extended prosecution included multiple Office Actions, a pre-appeal brief, two appeal briefs, and ultimately a decision from the PTAB reversing

the Examiner's rejection. During this time the Examiner and the PTAB addressed two references that are similar to the primary references relied upon by the Petition.

The prosecution history of the '202 Patent is relevant under § 325(d) for determining whether to institute a petition for IPR of its child, the '056 Patent. *Edge Endo, LLC v. Michael Scianamblo*, IPR2018-01321, Paper 15 at 15-16 (PTAB Jan. 14, 2019) (exercising discretion to deny institution under § 325(d), and “find[ing] that the respective prosecutions of related [patents] are pertinent for consideration of whether to exercise our discretion to deny institution under Section 325(d).”); *Microsoft Corp., et al. v. Koninklijke Philips N.V.*, IPR2018-00279, Paper 11 at 9-19 (PTAB June 8, 2018).

The nearly ten-year examination of the parent of the '056 Patent weighs heavily against institution of a proceeding based on the Petition here. *See Juniper Networks, Inc. v. Mobile Telecommunications Techs., LLC*, IPR2017-00642, 2018 WL 1358386, at *4 n. 5 (Mar. 14, 2018) (finding that “additional circumstances,” which may include a long prosecution history and prior appeals to the Board, “may be relevant to our exercise of discretion under § 325(d) in the context of examination.”); *see also Kayak Software Corp., et al. v. IBM Corp.*, No. CBM2016-00075, at *12-13 (P.T.A.B. Dec. 15, 2016) (*designated informative*) (“While length of prosecution and the numbers of Office Actions and Board Decisions do not, by themselves, definitively mandate for or against institution on a particular ground, on

these facts, we are persuaded that they do weigh heavily against institution of the prior art grounds proffered by Petitioner.”).

Further, there are similarities between the art in this Petition and the art in the ’056 Patent’s prosecution. This is another factor that weighs against institution. *See Juniper Networks, Inc.*, 2018 WL 1358386, at *4; 35 U.S.C.A. § 325(d) (“In determining whether to institute ... the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.”).

As explained, during prosecution of the Application that led to the ’202 Patent the Examiner and Board considered Willis. The very same reference was considered during the prosecution of the ’056 Patent as well. Willis is “related to dynamic content delivery,” and more particularly providing new advertising content to mobile video games. *See Willis* at [0002] (“relates to dynamic content delivery, and more particularly to a system and a method of delivering dynamic content that is dependent on the geographic location (geolocation) of the recipient.”). Indeed, Willis explains that it “describe[s] insertion of advertising content into video games during execution thereof, advertising content delivered to mobile platforms and based on geographic location information is generally advantageous.” *Id.* at [0039]. The new advertising content in Willis is selected based on the geographical location of the mobile platform. *Id.* Similarly, the primary reference relied upon by the

Examiner during prosecution of the '056 Patent was U.S. 2008/0307412 to Marr, which describes a distribution server to provide advertising to a video game console based on factors such as the game title and current date or time. *See, e.g.*, Marr, [0004] (“Conventionally, a video game console may connect to a distribution server that determines what advertisement to place in a particular advertising space within the game based on considerations such as the game title and the time of day, month year, etc. Often the actual advertising content is stored on a separate server known as a content server.”).

In a similar way, Petitioner’s primary references US. Pub. No 2008/0102947 (Ex. 1005, “Hays”) and U.S. Pub. No. 2007/0088801 (Ex. 1008, “Levkovitz”) both relate to providing targeted advertising for mobile video games. *See* Ex. 1005 at Abstract (“An advertisement delivery scheme and associated facility provide targeted advertisements for multiple video games”); Ex. 1008 at Abstract (“Devices, systems and methods of presentation of delivering targeted advertisements using Wireless Application Protocol.”). Both also similarly provide this targeted advertising in part based on geographical location. *See, e.g.*, Ex. 1005 (“In general, the advertisement server 114 may select advertisements based upon a variety of factors, including location....”); Ex. 1008 at [0006] (“The ad server may selectively serve content items to the content client ... based on parameters related to a user of the mobile phone, e.g., ... geographical location, proximity to geographical places,

or the like.”). Thus, as with the Willis reference considered in detail by the PTAB during prosecution of the parent of the ’202 Patent, and the Marr reference considered during prosecution of the ’056 Patent, both of the primary references addressed in the Petition relate to ad servers that provide advertisements to recipients based in part on their location.

The Petition does not attempt to dispute the similarity between the references on which it relies and the art considered by the Examiner during prosecution. Instead, the Petition states only that “[n]one of the cited references contain a substantially similar disclosure of a mobile game with dynamically updated hot spots represented in-game as non-promotional background objects, as is disclosed in the combinations described in the Grounds presented herein.” Petition at 61. This statement is irrelevant as “dynamically updated hot spots” and “non-promotional background objects” are not recited in the Challenged Claims nor otherwise addressed in the Petition.

Thus, the Petition wholly fails to establish that the prior art cited therein is different than the art cited during prosecution. The Petition instead presents similar art addressing sending content to a video game for display, without explaining how these references do anything to address the deficiency found during prosecution.

The similarity in the art presented in the petition and addressed in detail by the Examiner further counsels against institution. *See Fox Factory, Inc. v. SRAM*,

LLC, IPR2016-01876, Paper 8 at 7 (Apr. 3, 2017) (“there are the interests in conserving the resources of the Office and granting patent owners repose on issues and prior art that have been considered previously.”); *Kayak*, No. CBM2016-00075, at *12-13.

2) Part 2 of *Advanced Bionics*: Petitioner Failed to Demonstrate that the Office Erred in a Manner Material to the Patentability of the Challenged Claims.

The second prong of the *Advanced Bionics* test is met because Petitioner completely failed to set forth any evidence of material error committed by the Office. Petitioner does not even allege “material error” by the Office. Petition at 61. Instead, the Petition states simply “the Examiner committed error in evaluating the prior art of record.” *Id.* This does not articulate “material error,” nor does it address that the PTAB previously addressed this application during prosecution.

More critically, this unsupported statement offers no description of what the Examiner’s error may have been. Petitioner identifies no prior material error by the PTAB because there was none. In any event, the Board has declined “to guess or develop its own theory on what error may have been committed in prior proceedings over the [challenged] patent where the now-asserted prior art was at issue.” *Atrium Med. Corp. v. Bard Peripheral Vascular, Inc.*, IPR2021-01197, Paper 11 at 23 (P.T.A.B. Jan. 10, 2022). Accordingly, Petitioner has not, and cannot, meet its

burden of establishing that “the Office erred in a manner material to the patentability of challenged claims.” *Advanced Bionics*, IPR2019-01469, Paper 6 at 7-11.

Because Petitioner identifies no material error, the Board should exercise its discretion under § 325(d) and deny institution. *See, e.g., ABS Glob., Inc. v. Cytonome/ST LLC*, IPR2021-00306, Paper 13 at 13-14, 16 (P.T.A.B. June 7, 2021).

B. Petitioner’s Inconsistent Claim Construction Positions Before the Board and District Court Amount to Abuse of Process

The Board “retains discretion to deny institution for proceedings where abuse has been demonstrated.” June 21, 2022 PTAB Interim Procedure for Discretionary Denials, at 4; *see id.* at 9 (“[E]ven if the PTAB does not deny institution under *Fintiv*, it retains the right to deny institution for other reasons under 35 U.S.C. §§ 314(a), 324(a), and 325(d). For example, the PTAB may deny institution if other pertinent circumstances are present, such as abuse of process by a petitioner.”). The Board should so exercise its discretion to deny institution here.

As one example, Petitioner has taken inconsistent positions regarding the scope of the Challenged Claims of the ’056 Patent in different forums. *Cf. ResMed Corp. v. Cleveland Medical Devices Inc.*, IPR2023-00565, Paper 13, at 17 (P.T.A.B. Sept. 25, 2023) (“We agree with Patent Owner that on the facts of this case, by providing inconsistent positions regarding the proper construction of the claims, Petitioner is not being transparent. . . . The potential for conflicting decisions favors denial.”); *Kiosoft Techs., LLC v. PayRange, Inc.*, IPR2021-00086, Paper 12, at 16

(P.T.A.B. Mar. 22, 2021) (“Thus, regardless of the Petition’s merits, the potential problems inherent in the inconsistent claim constructions set forth by Petitioner between the Petition and its proposals at the district court warrant us to find that factor 6 weighs in favor of denying institution.”); *Comcast Cable Communs, LLC v. Promptu Sys. Corp.*, CBM2018-00033, Paper 9, at 10-11 (P.T.A.B. Oct. 10, 2019) (Petitioner’s reliance on “competing claim construction arguments that impact central aspects of both trials” weighs against institution because the Board would risk a decision contradicting the claim construction adopted in the other case or having to abandon its own case to be consistent with the claim construction advocated in the other trial); *Facebook, Inc. v. Sound View Innovations, LLC*, IPR2017-00998, Paper 13, at 8, 17 (P.T.A.B. Sept. 5, 2017) (denying institution where the Petitioner “did not inform the panel that Petitioner had taken a very different claim construction position before the district court, it did not inform the panel that the different position was then under consideration by the district court, nor did it explain the reason for Petitioner’s change of heart”); *id.* at 17-18 (“At the very least, Petitioner’s failure to inform us of its differing claim construction arguments before the district court raises the specter of lack of candor.”)

Indeed, Petitioner’s proposed constructions in the parallel District Court proceeding (Ex. 2001) conflict with its positions in the Petition regarding the scope of the Challenged Claims of the ’056 Patent (*see, e.g.*, Petition at 12). Petitioner

seeks to have the terms of the '056 Patent applied as broadly as possible in attempting to invalidate the claims of the '056 Patent before the Board, while simultaneously arguing that several terms are indefinite under 35 U.S.C. § 112 in the District Court.

In particular, Petitioner represents that no terms in the Challenged Claims of the '056 Patent require construction. Petition at 12. And, in setting forth its grounds in the Petition, Petitioner necessarily understands the definite meaning of those claims and contends that the asserted prior art references disclose the various claim elements based solely on their plain language, as opposed to any specific construction. *See* Petition at 12–59. Likewise, Petitioner’s expert, Dr. Zagal, parrots the Petition and declares that the Challenged Claims of the '056 Patent “do not use any specialized terms that would require additional explanation or express definitions”; rather, “[t]he ordinary and customary meaning of the claims and the terms used therein would have been understood by a POSITA.” Ex. 1003, ¶ 72. As such, Dr. Zagal has also “applied the ordinary and customary meaning of the claim terms” in rendering his opinions presented to the Board. Ex. 1003, ¶ 71.

In the District Court, however, Petitioner contends that multiple claim elements/terms in the Challenged Claims are “Indefinite”—including “pre-selected” and “the distribution.” Ex. 2001, at 6–10. Petitioner has not yet put forth its full bases for the alleged indefiniteness. For each of these terms, however, Petitioner has made

clear that it relies on a different expert witness, Mr. Garry Kitchen, who will take the *opposite* position from Dr. Zagal and explain to the District Court why, in that venue, the Petitioner believes the claim terms are not reasonably certain. Ex. 2001, at 6–10.

Petitioner’s inconsistency between the two forums “calls to mind the well quoted phrase: ‘When I use a word,’ Humpty Dumpty said, in a rather scornful tone, ‘it means just what I choose it to mean-neither more nor less.’” *Honeywell Intern., Inc. v. ITT Indus., Inc.*, No. 02-73948, 2005 WL 5416765, at *7-8 (E.D. Mich. May 17, 2005) (quoting Lewis Carroll, *Through the Looking Glass* from Alice’s Adventures in Wonderland, Chapter VI, Humpty Dumpty (1865)). Such an inconsistency amounts to an “abuse of process.” See June 21, 2022 PTAB Interim Procedure for Discretionary Denials, at 4, 9; see also *Facebook*, IPR2017-00998, Paper 13, at 17-18 (noting Petitioner’s “differing claim construction arguments before the district court raises the specter of lack of candor.”). Just as “claims are construed the same way for both invalidity and infringement,” *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1330 (Fed. Cir. 2003), a Petitioner must take consistent positions regarding claim construction before the Board and in any parallel proceeding, including district court litigation.

Petitioner’s abuse of process is further highlighted by its selective use of different experts to take different positions on the scope and meaning of the Challenged Claims of the ’056 Patent in different forums. Compare Ex. 1003, ¶¶

71–72 *with* Ex. 2001, at 6–10. This abuse of process also necessarily calls into question the accuracy and reliability of Dr. Zagal’s opinions as a whole in this proceeding, given that at least a number of his opinions directly conflict with the reported “expert testimony” of another in the field, Mr. Garry Kitchen, Petitioner’s expert in the District Court. *See* Ex. 2001, at 6–10.

Thus, regardless of the Petition’s merits, Petitioner’s gamesmanship regarding the proper construction of the Challenged Claims is reason alone to deny its Petition. *See* June 21, 2022 PTAB Interim Procedure for Discretionary Denials, at 4, 9; *see also ResMed Corp.*, IPR2023-00565, Paper 13, at 17; *Kiosoft Techs.*, IPR2021-00086, Paper 12, at 16; *Comcast*, CBM2018-00033, Paper 9, at 10-11; *Facebook*, IPR2017-00998, Paper 13, at 8, 16–18.

C. Petitioner’s Expert’s Declaration Parrots the Petition and Thus the Testimony Provided Therein Should Be Given No Weight.

As noted above, in support of its Petition, Petitioner submits a declaration from its expert, Dr. Zagal. *See* Ex. 1003, (the “Zagal Declaration”). As discussed above, the Zagal Declaration is necessarily suspect given that portions of it regarding claim construction of the Challenged Claims are directly contradicted by both Petitioner and Petitioner’s different expert in the District Court, Mr. Garry Kitchen. *See* Ex. 2001, at 6–10. Moreover, the Zagal Declaration simply parrots the Petition, as opposed to providing any insightful expert opinions and analysis. For all these

reasons, the Zagal Declaration should not be entitled to any weight—and, as such, Petitioner has necessarily failed to carry its burden with respect to institution.

As the Board has consistently recognized, a declaration that repeats the petition verbatim “is conclusory and unsupported, adds little to the conclusory assertion for which it is offered to support, and is entitled to little weight.” *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9, 2022 WL 3648989, at *6 (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.”). Simply put, an expert declaration that “merely parrots the Petition” is entitled to “little to no weight.” *E.g.*, *MarkForged Inc. v. Continuous Composites, Inc.*, IPR2022-01431, Paper 7, at 14 (Jan. 18, 2023) (“[Expert’s] declaration testimony on this point is entitled to little to no weight as it merely parrots the Petition.”); *LG Elecs. Inc. v. Jawbone Innovations, LLC*, IPR2023-01111, Paper 10, at 15 (Jan. 9, 2024) (“Petitioner’s expert merely parrots the Petition...Thus, Petitioner’s conclusory assertion is unpersuasive.”); *see Content Square SAS v. Medallia Inc.*, IPR2022-00316, Paper, at 38 (July 14, 2022) (“Merely repeating an argument from the Petition in the declaration of a proposed expert, does not give that argument enhanced probative value.”); *Man Wah Holdings Ltd. v. Rafeel Sys., LLC*, IPR2019-00616, Paper 7, at 15-16 (Aug. 21, 2019) (“Merely

repeating an argument from the Petition in the declaration of a proposed expert does not give that argument enhanced probative value.”).

Such is the case here with respect to the Zagal Declaration. Indeed, with respect to issues such as the alleged disclosures of the prior art and the purported motivation(s) to combine the disparate prior art references asserted by Petitioner—areas on which expert testimony may be critical—the Zagal Declaration simply restates the attorney argument set forth in the Petition itself, without any meaningful discussion or elaboration, let alone expertise. *Compare* Ex. 1003, ¶¶ 137-47 with Petition at 32-36.

One example highlighting the similarity is Dr. Zagal’s purported testimony addressing element 1(c). As shown below, Dr. Zagal does not even attempt to conceal that his opinion is nothing more than a copy-paste of the same analysis in the Petition. Such expert “testimony” does nothing to help the Board address the prior art or the purported motivations to make the modifications that Petitioner proposes:

Ex. 1003, ¶ 96	Petition at 16
For example, Hays discloses that “[t]he advertisement recipient client 104 may include a game playing device 126 (e.g., a console, computer, portable game device, ...)” and that it “may request and receive advertisements [i.e. the claimed ‘updated content’] from the advertisement management service	For example, Hays discloses that “[t]he advertisement recipient client 104 may include a game playing device 126 (e.g., a console, computer, portable game device, ...)” which “may request and receive advertisements [i.e. updated content] from the advertisement management service system [i.e.

system 108 and may be configured to establish communication via a communication link, such as the Internet 129 [i.e. the claimed ‘network’].” Ex. 1005, ¶32; Fig. 1A. Specifically, “the advertisement server 114 [i.e. the claimed ‘server’] may fulfill requests received from the advertisement recipient client 104.” Id., ¶29. And as I mentioned in 1[pre], the game playing device also includes “cellular or mobile phones.” Id., ¶51.	server].” Ex. 1005, ¶32. As mentioned in 1[pre], the game playing device also includes “cellular or mobile phones.” Id., ¶51; Ex. 1003, ¶96. Hays also discloses that a mobile communication device “may communicate with an advertising request handler 210 associated with the advertisement server 114,” which enables “the matching of advertisement campaigns to appropriate various video game titles.” Ex. 1005, ¶37; see FIG. 1A.
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Put another way, the Zagal Declaration is almost identical to the Petition. But a purported expert merely parroting the Petition cannot give any insight into what a POSITA may or may not be motivated to do. *See LG Elecs.*, IPR2023-01111, Paper 10, at 15; *Content Square*, IPR2022-00316, Paper, at 38.

There are numerous other instances where the Zagal Declaration is a near exact copy of the Petition, and the Petition purports to rely on those conclusory arguments. As one of many examples, compare Dr. Zagal’s purported testimony at paragraphs 171-172 claiming to analyze the preamble of claim 1 by comparison to Levkovitz, with the analysis of that claim element at pages 43-44 of the Petition:

Ex. 1003, ¶¶171-172	Petition at 43-44
To the extent the preamble is limiting, in my opinion, Levkovitz discloses this limitation. For example, Levkovitz discloses providing “contextual and/or	To the extent the preamble is limiting, Levkovitz discloses a <i>system for providing updated content associated with a mobile video game to a mobile communication device</i> . Ex. 1003, ¶¶171-172. For example, Levkovitz

noncontextual placement of content, e.g., advertisements or banners [i.e. the claimed ‘updated content’], within an application executed by a cellular phone, a mobile phone, or other wireless communication device [i.e. the claimed ‘mobile communication device’].” Ex. 1008, ¶5. The application could be “games for mobile phones,” i.e. a mobile video game. Id., ¶6; see also ¶123 (“The application 176 may be ... a game”), ¶127 (“a first application 176 (e.g., a chess game)”, “a second application 176 (e.g. a racing game).”).	discloses providing “contextual and/or noncontextual placement of content, e.g., advertisements or banners [<i>i.e. updated content associated with a mobile video game</i>], within an application executed by a cellular phone, a mobile phone, or other wireless communication device [<i>i.e. mobile communication device</i>].” Ex. 1008, ¶5. The application could be “games for mobile phones.” Id., ¶6; see also ¶123 (“The application 176 may be ... a game”), ¶127 (“a first application 176 (e.g., a chess game)”, “a second application 176 (e.g. a racing game).”); Ex. 1003, ¶172.
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Other than the Petition quoting the preamble and including emphasis as shown in original above, the two statements are almost entirely the same. Another example of parroting is below, addressing whether Levkovitz discloses claim element 1(b):

Ex. 1003, ¶177	Petition at 45
For example, Levkovitz discloses that “the server may include a memory unit [i.e. the claimed ‘storage medium’] to store a plurality of content items” and that “the server... cop[ies] the content of the volatile memory into a non-volatile memory” of the memory unit, thereby indicating that the server communicates with the memory unit, including its storage medium, in order to store advertisements in said medium. Ex. 1008, ¶¶12-14. Levkovitz further discloses that “ad server 150 ... may search a content items repository 118 [i.e. the claimed ‘storage medium’]	Levkovitz discloses that “the server may include a memory unit [i.e. storage medium] to store a plurality of content items” and that “the server... cop[ies] the content of the volatile memory into a non-volatile memory” of the memory unit, thereby indicating that the server communicates with the storage medium. Ex. 1008, ¶¶12-14. Levkovitz further discloses that “ad server 150 ... may search a content items repository 118 [i.e. storage medium] within ad server 110 for one or more content items,” which

within ad server 110 for one or more content items,” which indicates that the server communicates with the item repository, including its storage medium. <i>Id.</i> , ¶126.	indicates that the server communicates with the storage medium. <i>Id.</i> , ¶126.
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This issue is not isolated to independent claims and continues throughout the claim set, including for example, the passage below addressing claim 5:

Ex. 1003, ¶123	Petition at 26
In any case, it is my opinion that a POSITA would have also found it obvious to send the specific ad unit (i.e. the claimed “in-game placement location”) with the advertisement sent to the mobile communication device, because a POSITA would be motivated to provide a mechanism to inform the game running on the device where to place the advertisement, as that would fulfill the contractual obligations to the advertiser. A POSITA would have reasonably expected such a combination to succeed because the modification would simply include the specific ad unit when sending an advertisement, which is information already stored by the server (such as when advertisers use “insertion orders” as described above).	A POSITA would have also found it obvious to send the specific ad unit (i.e. in-game placement location) with the advertisement sent to the mobile communication device because it would enable fulfillment of contractual obligations to the advertiser, e.g., to display ads at specific in-game locations. <i>Id.</i> , ¶123. A POSITA would have reasonably expected such a combination to succeed because the modification would simply include the straightforward step of sending information already stored by the server as part of the response to a request from the mobile communication device. <i>Id.</i>

Indeed, parroting such as this is “particularly problematic in cases where, like here, expert testimony is offered not simply to provide a motivation to combine prior-art teachings, but rather to supply a limitation missing from the prior art.”

Xerox, 2022 WL 3648989, at *6. In the chart above, Dr. Zagal does exactly that – attempt to supply a limitation missing from the prior art by merely parroting the Petition.

The Petition and Dr. Zagal’s purported expert testimony are replete with other similar examples of Dr. Zagal’s parroting the Petition. *Compare* Ex. 1003, ¶¶ 88-91 with Petition at 13-14; *Compare* Ex. 1003, ¶¶ 98-100 with Petition at 16-17; *Compare* Ex. 1003, ¶¶ 112-114 with Petition at 22-23; *Compare* Ex. 1003, ¶ 183 with Petition at 46-47; Ex. 1003, ¶ 198 with Petition at 51-52.

Dr. Zagal’s declaration is thus nothing more than a copy of the Petition itself, with almost the exact same words in the exact same order. And “merely repeating conclusory arguments does not help the Board, the trier of fact in this proceeding, understand the evidence or to determine a fact in issue.” *Man Wah Holdings Ltd. v. Rafeel Sys., LLC*, IPR2019-00616, Paper 7, at 15-16 (P.T.A.B. Aug. 21, 2019). Dr. Zagal’s unhelpful declaration should therefore be given no weight. *See, e.g., MarkForged*, IPR2022-01431, Paper 7, at 14 (“[Expert’s] declaration testimony on this point is entitled to little to no weight as it merely parrots the Petition.”); *Xerox*, 2022 WL 3648989, at *6. And without expert testimony, Petitioner cannot satisfy its burden of demonstrating a reasonable likelihood that its purported prior art discloses the elements of the challenged claims or that a person of ordinary skill in the art would be motivated to combine the prior art at issue.

D. Petitioner Failed to Shoulder Its Burden with Respect to Multiple Elements of the Independent Claims.

Petitioner cannot shoulder its burden of establishing that the references it cites disclose or suggest: “send a message relating to the in-game video game content to the mobile communication device in response to receiving the request, wherein 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” which the Petition charts as element 1[e].

First, this element recites a claim term that Petitioner contends in the District Court is indefinite, and thus, in that forum Petitioner, is unable to provide a sufficient meaning in order to determine whether the claim is met. In particular, Petitioner contends that the following emphasized term is indefinite: “send a message relating to the in-game video game content to the mobile communication device in response to receiving the request, wherein the message is *pre-selected* (Ex. 2001, term 3) 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.” Nevertheless, in this forum, Petitioner claims it is fully able to understand this claim term, but in doing so Petitioner provides no cognizable construction or interpretation of the claim in view of the cited art. Thus, Petitioner cannot argue here

that this element is met by prior art, while simultaneously urging in the district court that it has no idea what a key term within this element means.

Second, this is almost exactly the same claim element that the PTAB previously found was not disclosed by the prior art relied upon during prosecution of the '202 Patent. Ex. 2002 at 41 (holding the prior art cited by the Examiner “does not disclose, either expressly or inherently, the limitation ‘checking what updated video-game content to send based on one of the factors including a type of the mobile communication device, a telecom service associated with the mobile communication device, and a service provider of the telecom service.’”). Moreover, the PTAB did not choose to issue a new rejection *sua sponte*, which is well within the Board’s authority. *See, e.g.*, 37 C.F.R. 41.50(b) (“New ground of rejection. Should the Board have knowledge of any grounds not involved in the appeal for rejecting any pending claim, it may include in its opinion a statement to that effect with its reasons for so holding, and designate such a statement as a new ground of rejection of the claim.”); MPEP § 1214.01. Nor did the Examiner reopen prosecution in order to issue a new non-final rejection after the Board reversed. 37 C.F.R. 1.198. The Petition establishes no basis that the Board should reevaluate a claim it has already once considered and affirmed to be valid.

Moreover, as shown below, Petitioner fails to carry its burden with respect to each of the grounds in the Petition with respect to this claim term, in any event.

1) Grounds 1-3 Do Not Carry Petitioner's Burden.

Grounds 1-3 all rely on Hays as a primary reference, with Grounds 2 and 3 relying on secondary references in an attempt to cure Hays's deficiencies with respect to certain dependent claims. *See* Petition at 2. Assuming Hays were proper prior art for this proceeding—it is not as shown below—the Petition fails to carry its burden with respect to Hays. The Petition points to an advertising matching and weighting system as identifying what in-game video content to send, and then contends that either the advertisement that is selected itself, metadata for the advertisement, a list of advertisements, or “characters in the game, which advertise or promote a product” are “a message relating to the content” that 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” as in claim element 1(e). Petition at 17-20. However, the Petition provides no analysis whatsoever on how the “list of advertisements” or the “characters in the game, which advertise or promote a product” are “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.” *Id.*

With respect to the advertisements, and thus the metadata for the advertisements as well, the Petition suggests that “requests for advertisements (i.e., in-game video game content) from the mobile communication device to the server include an identification of the ‘client type,’ which may be a ‘type of game console’” and refers to the Petition’s analysis of element 1(d), where the Petition states that “[t]he ‘advertising request handler 210’ forward[s] the request “to an advertising matching and weighting system,” which ‘calculate[s] [a] weight of each advertisement based on several factors including ... information regarding the specific client type.’” *Id.*

But contrary to Petitioner’s conclusory assertion, Hays is clear that any selection of a “message relating to the in-game video game content” that its “advertising matching and weighting system 220” allegedly performs uses weights assigned to advertisements based on factors associated with the advertisements themselves, and not any of the factors recited in element 1(e), *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.” *See* Ex. 1005, [0043] (“The advertising matching and weighting system 220 may calculate the weight of each advertisement based on several factors including campaign goal and completion data from the advertisement serving database 122 and information

regarding the specific client type from the advertisement recipient database 120.’”).

In fact, Hays selects advertisements, and thus the advertisements’ metadata (both allegedly messages relating to the in-game video game content), 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.” *Id.* Thus, regardless of what data a client device sends to the advertising matching system 220, Hays simply describes creating a weighted set of advertisements and metadata based on “several factors,” and then selects updated advertisements and their associated metadata based on an assigned weight, rather than any of the factors required to be used in element 1(e). *Id.*

This deficiency notwithstanding, the Petition provides no real analysis of how the purported message within Hays is “pre-selected.” To the contrary, the Petition simply identifies the factors used by the matching and weighing system for selection of a weighted advertisement, stating that “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,’...or ‘may subtarget by time of day...or by game play date’” and states that this somehow means an advertisement (the purported message) is “pre-selected.” Petition at 20. These factors are all examples of the “several factors including campaign goal” used by the matching and weighing

system in Hays upon receiving a request for an advertisement. Ex. 1005, [0043]. This does not address, much less explain how the advertisement is pre-selected.

The Petition offers no additional analysis for the other independent claim, claim 9. *See* Petition at 29-30. Thus, the Petition’s analysis of this claim element does not address these distinctions between Hays and the Challenged Claims of the ’056 Patent and thus cannot carry its burden of establishing obviousness. Dr. Zagal adds nothing to the analysis, again simply parroting the Petition almost word-for-word. *Compare* Petition at 18-21 (addressing element 1(e)) *With* Ex. 1003, ¶¶ 101-107; *Xerox*, 2022 WL 3648989, at *6 (denying institution where Petitioner’s expert “offers only a verbatim restatement of the assertion being supported, without any supporting evidence or technical reasoning.”).

The Petition does not incorporate any other references or analysis in an attempt to cure these deficiencies. Thus, the Petition fails to carry its burden with respect to Grounds 1-3.

2) Grounds 4-6 Do Not Carry Petitioner’s Burden.

Grounds 4-6 all rely on U.S. Patent Pub. No. 2007/0088801 (“Levkovitz”) (Ex. 1008) as a primary reference, with grounds 5 and 6 incorporating secondary references to address dependent claims.

With respect to element 1(e), discussed above, Petitioner only cites to Levkovitz, and focuses its analysis on three paragraphs within that reference, one of

which is separated from the other paragraphs by over one hundred and twenty intervening paragraphs. *See* Petition at 47-49 (citing Levkovitz, [0006], [0126], [0129], [0142]). Petitioner does nothing to explain the yawning gap between these citations or explain why the embodiments discussed in the disparate paragraphs could or would be combined.

This analysis does not carry Petitioner's burden of establishing that Levkovitz discloses this claim element. Rather, the cited paragraphs of Levkovitz describe "presentation rules associated with the transmitted content items" and state that "[b]ecause the advertisements are selected based on a type of mobile communication device, the presentation rules (i.e. messages related to content) are also pre-selected based on a type of mobile communication device." *Id.* at 48. This analysis fails to address how the presentation rule is selected 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." Rather, it only addresses how a content item itself is allegedly selected.

The only other analysis the Petition provides on the selection of the presentation rules states that "capping rules, which is an example of a presentation rule, are 'pre-defined rules, e.g. specific campaign-related rules' that 'cap the number of times that a certain content item may be presented.'" *Id.* at 48-49 (quoting

Ex. 1008, [0129], [0142]). But capping the number of times a content item may be presented has nothing to do with “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” as in element 1(e).

Further, as with the Hays ground discussed above, the Petition never addresses at all how the advertisement within Levkovitz is “pre-selected,” as is required by the claim. Rather, the petition simply ignores this requirement element and states that “[b]ecause the advertisements are selected based on a type of mobile communication device, the presentation rules (i.e. messages related to content) are also pre-selected based on a type of mobile communication device.” Petition at 48. The only explanation provided for this statement is that “capping rules, which is an example of a presentation rule, are ‘pre-defined rules, e.g. specific campaign-related rule’ that ‘cap the number of times that a certain content item may be presented.’” *Id.* (quoting Ex. 1008, [0129], [0142]). But this statement provides no analysis whatsoever on the presentation rules being pre-selected based on a type of mobile communication device.

Further, as with the Hays Grounds, the Petition includes no further analysis of independent claim 9. *Id.* at 54. Thus, the Petition’s analysis of this claim element

does not address these distinctions between Levkovitz and the Challenged Claims of the '056 Patent and thus cannot carry its burden of establishing obviousness.

Further, as with the elements above, Dr. Zagal offers the Petition no further support. Instead, his purported analysis, found in paragraphs 184-187 of his declaration, is almost identical to the analysis on pages 47-49 of the Petition addressing this claim element. *Xerox*, 2022 WL 3648989, at *6 (denying institution where Petitioner's expert "offers only a verbatim restatement of the assertion being supported, without any supporting evidence or technical reasoning.").

Ex. 1003, ¶ 185	Petition at 47-48
For example, Levkovitz discloses that after the device requests content from an "ad server," the "ad server may selectively serve content items to the content client, based on parameters related to the mobile phone, e.g., manufacturer identifier, model identifier, available memory, presentation capabilities, or the like." Ex. 1008, ¶6. Levkovitz similarly teaches that the "ad server 110 may select one or more content items which may be adequately presented by device 170 based on properties of device 170, e.g., handset model..." Id., ¶126. These parameters, especially the manufacturer and model identifiers or the handset model, correspond to and identify "a model type associated with the mobile communication device."	Levkovitz discloses that after the device requests content from an "ad server," the "ad server may selectively serve content items to the content client, based on parameters related to the mobile phone, e.g., manufacturer identifier, model identifier, available memory, presentation capabilities, or the like." Ex. 1008, ¶6. Such parameters, especially the manufacturer and model identifiers, are factors of a type of mobile communication device. <i>See also id.</i> , ¶126 ("[A]d server 110 may select one or more content items which may be adequately presented by device 170 based on properties of device 170, e.g., handset model ..."); Ex. 1003, ¶171.

The Petition does not incorporate any other references or analysis in an attempt to cure these deficiencies. Thus, the Petition fails to carry its burden with respect to Grounds 4-6.

E. Petitioner’s References Are Not All “Printed Publication” Prior Art Within the Meaning of 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 prior art patent or prior art printed publication.” *Qualcomm Inc. v. Apple Inc.*, 24 F.4th 1367, 1375 (Fed. Cir. 2022). Petitioner’s Grounds 1-3 thus fail, as they rely on at least one reference that are not available as prior art under § 311(b). In particular, Hays (Ex. 1005) is not a prior art “patent” or “printed publication” as of the ’056 Patent’s priority date of June 26, 2007. *See* Petition at 1.

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 ’202 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.*, its publication date, which notably, is after the June 26, 2007 priority date of the ’056 Patent. *See* Petition at 1. 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 ’056 Patent’s priority date of June 26, 2007. Nor can it. Hays was not published until May 1, 2008 (Ex. 1005, at 1)—after the ’056 Patent’s priority date of June 26, 2007. Hays was thus not “accessible to the public” until after the ’056 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. Petition at 8. In doing so, Petitioner expressly relies on the **filing date** 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 PTO “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 patent” is neither a “printed publication” nor a “patent.” *Brown v. Guild*, 90 U.S. 181, 224 (1874) see; *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 is therefore ineligible to be prior art in an IPR. Accordingly, Grounds 1-3 fail because they each rely on the ineligible Hays reference. *See* Petition at 2.³

IV. CONCLUSION

For all the foregoing reasons, the Petitioner fails to carry its burden, and no proceeding should be instituted.

Dated: February 27, 2024

Respectfully submitted,

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³ In *Samsung Electronics Co., Ltd. v. Lynk Labs, Inc.*, IPR2022-00149, Paper 33, at 10–12 (P.T.A.B. June 26, 2023), a nonprecedential decision, another panel held to the contrary regarding Section 102(e) prior art. However, that decision is incorrect for the reasons stated above.

CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24(d), the undersigned certifies that this Preliminary Response contains 11,054 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: February 27, 2024

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CERTIFICATE OF SERVICE

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

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