

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.

IPR2024-00200
Patent 11,117,056 B2

Before DAVID C. McKONE, DANIEL J. GALLIGAN, and
SCOTT B. HOWARD, *Administrative Patent Judges*.

GALLIGAN, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

A. Background

PLR Worldwide Sales Limited (“Petitioner”) filed a petition for *inter partes* review (Paper 2 (“Pet.” or “Petition”)) challenging claims 1–16 of U.S. Patent No. 11,117,056 B2 (Ex. 1001 (the “’056 patent”)). Flip Phone Games, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). Petitioner filed an authorized reply to Patent Owner’s Preliminary Response (Paper 7), and Patent Owner filed a sur-reply to Petitioner’s preliminary reply (Paper 8).

Under 37 C.F.R. § 42.4(a), we have authority to determine whether to institute review. The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted unless the information presented in the Petition and the Preliminary Response shows “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”

For the reasons explained below, we institute an *inter partes* review of all challenged claims on all grounds raised in the Petition.

B. Related Matters

As required by 37 C.F.R. § 42.8(b)(2), the parties identify various related matters. Pet. 61; Paper 3 at 1.

C. Real Parties in Interest

Petitioner identifies itself and Playrix Holdings Ltd. as the real parties in interest. Pet. 61. Patent Owner identifies itself as the real party in interest. Paper 3 at 1.

D. The '056 Patent and Illustrative Claim

The '056 patent relates to “providing updated video game content to a mobile communication device.” Ex. 1001, 1:13–15. Claim 1 is reproduced below with Petitioner’s limitation identifiers in brackets. *See* Pet. x.

1. A system for providing updated content associated with a mobile video game to a mobile communication device, the system comprising:

[a] a storage medium for storing in-game video game content;

[b] a server in communication with the storage medium;
and

[c] wherein the server is configured to: receive a request for updated content from the mobile communication device;

[d] identify, in response to receiving the request, what in-game video game content to send;

[e] 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; and

[f] send the in-game video game content to the mobile communication device as the updated content for the mobile video game.

E. Asserted Grounds of Unpatentability

Petitioner presents the following grounds:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1–16	103(a) ¹	Hays ²
1–16	103(a)	Hays, Choi ³
5, 13	103(a)	Hays, Chu ⁴
5, 13	103(a)	Hays, Choi, Chu
1–16	103(a)	Levkovitz ⁵
5, 13	103(a)	Levkovitz, Chu
8, 16	103(a)	Levkovitz, Choi

II. ANALYSIS

A. Discretionary Denial under 35 U.S.C. § 325(d)

Patent Owner argues that we should exercise discretion to deny institution under 35 U.S.C. § 325(d). Prelim. Resp. 15–22; Paper 8 at 1–4. For the reasons stated below, we decline to exercise discretion to deny on this basis.

Section 325(d) provides that the Director may elect not to institute⁶ a proceeding if the challenge to the patent is based on matters previously presented to the Office. 35 U.S.C. § 325(d) states, in pertinent part, “[i]n

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284 (2011), amended 35 U.S.C. §§ 102 and 103, effective March 16, 2013. Petitioner asserts unpatentability under pre-AIA § 103(a). *See* Pet. 8–12 (contending that the asserted references are prior art under pre-AIA § 102 for use in pre-AIA 103(a)).

² US 2008/0102947 A1, published May 1, 2008 (Ex. 1005).

³ US 2007/0174490 A1, published July 26, 2007 (Ex. 1006).

⁴ US 7,698,178 B2, issued Apr. 13, 2010 (Ex. 1007).

⁵ US 2007/0088801 A1, published Apr. 19, 2007 (Ex. 1008).

⁶ The Board institutes trial on behalf of the Director. 37 C.F.R. § 42.4(a) (2019).

determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, 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.” We use the following two-part framework in determining whether to exercise our discretion under § 325(d):

- (1) 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;
- and (2) if either condition of first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.

Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GmbH,
IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential).

In applying the two-part framework, we consider the following non-exclusive factors:

- (a) the similarities and material differences between the asserted art and the prior art involved during examination;
- (b) the cumulative nature of the asserted art and the prior art evaluated during examination;
- (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection;
- (d) the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art;
- (e) whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art; and
- (f) the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments.

Becton, Dickinson & Co. v. B. Braun Melsungen AG, IPR2017-01586, Paper 8 at 17–18 (Dec. 15, 2017) (precedential as to § III.C.5, first paragraph). If, after review of factors (a), (b), and (d), we determine that the same or substantially the same art or arguments previously were presented to the Office, then we consider factors (c), (e), and (f), which relate to whether the petitioner demonstrates that the Office erred in a manner material to the patentability of the challenged claims. *Advanced Bionics*, Paper 6 at 10.

Patent Owner asserts that Hays and Levkovitz are similar to prior art considered during examination of the application for the '056 patent and during examination of a parent application, noting that the references relate to delivering ad content to mobile devices and doing so based on location of the mobile device, similar to previously-considered references. Prelim. Resp. 18–21. We do not find such general allegations of similarity to be sufficient to satisfy the first part of the *Advanced Bionics* framework. Rather, Patent Owner must provide a more substantive analysis comparing the teachings to show that they are substantially the same. It is no surprise that Petitioner would rely on art that discloses delivering ads to mobile devices given the subject matter recited in the claims. Patent Owner's more specific assertion is that Hays and Levkovitz "relate to ad servers that provide advertisements to recipients based in part on their location." Prelim. Resp. 20. But even if that is a similarity with previously-considered prior art, Patent Owner does not explain the relevance of this similarity given that the independent claims recite no such requirement. Although certain dependent claims recite subject matter relating to the location of the mobile device, the claims were allowed based on amendments made to the independent claims, as noted by Patent Owner. *See* Prelim. Resp. 10 (citing Ex. 1002, 76–81).

Patent Owner also argues that the extensive prosecution of a parent application “weighs heavily against institution of a proceeding based on the Petition here.” Prelim. Resp. 17 (citing, *inter alia*, *Kayak Software Corp. v. IBM Corp.*, CBM2016-00075, Paper 16 at 12–13 (PTAB Dec. 15, 2016) (informative)). Patent Owner provides a summary of this prosecution history and notes that the Board reversed a rejection “based on a claim element similar to one recited in the independent claims of the ’056 Patent.” Prelim. Resp. 14 (citing Ex. 2002, 40–43). In that Board decision, the panel found that the asserted prior art sent advertising content based on the location of the device. Ex. 2002, 42–43. As noted above, the independent claims recite no such requirement, and, therefore, this prosecution history does not show that the first part of the *Advanced Bionics* framework is satisfied.

Because we determine that the first part of the *Advanced Bionics* framework is not satisfied, we decline to deny institution under 35 U.S.C. § 325(d).

B. Principles of Law

A patent claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) any secondary

considerations, if in evidence.⁷ *Graham v. John Deere Co. of Kan. City*, 383 U.S. 1, 17–18 (1966).

C. Level of Ordinary Skill in the Art

Petitioner argues that a person of ordinary skill in the art “would have had an undergraduate degree in game design or development, computer science, computer engineering, or a related field, with at least two years of experience working with computer gaming systems or software application development.” Pet. 2 (citing Ex. 1003 ¶¶ 65–69). Petitioner also contends that “[l]ess work experience may be compensated by a higher level of education or vice versa.” Pet. 2–3 (citing Ex. 1003 ¶¶ 65–69).

Patent Owner does not comment on the level of ordinary skill in the Preliminary Response.

To the extent necessary, and for purposes of this Decision, we accept the uncontested assessment offered by Petitioner, which appears consistent with the ’056 patent and the asserted prior art, except that we change qualifier “at least” to “about” to avoid including experience levels that exceed the level of ordinary skill in the art.

D. Claim Construction

Neither party proposes any claim terms for construction. On this record, we determine that no terms need express construction to determine whether we should institute. *See Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019) (“The Board is required to construe ‘only those terms . . . that are in controversy, and only to the extent necessary to resolve the controversy.’” (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200

⁷ Patent Owner has not introduced secondary considerations evidence.

F.3d 795, 803 (Fed. Cir. 1999))). Nevertheless, we note two issues of claim interpretation for the parties to consider.

First, the parties may wish to address the interpretation of the phrase “pre-selected in-game video game content” during the trial for the reasons discussed below in § II.E.3.

Second, the parties may wish to address the interpretation of the subject matter of claims 1 and 9 reciting “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” for the reasons discussed below in §§ II.E.2 and II.F.1.

*E. Alleged Obviousness over Hays
(Claims 1–16)*

Petitioner asserts that claims 1–16 are unpatentable as obvious over Hays. Pet. 2, 13–32.

1. Prior Art Status of Hays

In an *inter partes* review, a petitioner “may request to cancel as unpatentable 1 or more claims of a patent only on a ground that could be raised under section 102 or 103 and only on the basis of prior art consisting of patents or printed publications.” 35 U.S.C. § 311(b). Patent Owner argues that “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,” and, therefore, that Hays is “ineligible to be prior art in an IPR.” Prelim. Resp. 42–45.

We disagree with Patent Owner’s statutory interpretation. Hays is a printed publication, having been published on May 1, 2008, as Patent Owner acknowledges. *See* Ex. 1005, code (43); *see also* Prelim. Resp. 42 (acknowledging publication date). On this record, we are persuaded by Petitioner’s contention that Hays is prior art under pre-AIA 35 U.S.C. § 102(e), having been filed “by another . . . in the United States before the invention by the applicant for patent.” *See* Pet. 8. Thus, Petitioner asserts a permissible ground of unpatentability by arguing that claims 1–16 are unpatentable under 35 U.S.C. § 103(a) “on the basis of prior art consisting of patents or printed publications” (35 U.S.C. § 311(b)), specifically based on Hays, which is prior art and a printed publication.

2. *Claim 1*

Claim 1 is directed to a “system for providing updated content associated with a mobile video game to a mobile communication device.” Petitioner argues that Hays discloses the preamble. Pet. 13–14 (citing Ex. 1005 ¶¶ 17, 21, 51; Ex. 1003 ¶¶ 88–91); *see* Ex. 1005 ¶¶ 21 (disclosing that “specific advertisements may be presented in the appropriate available ad units at the appropriate time during game play”), 51 (“Those skilled in the relevant art will appreciate that the invention can be practiced with other system configurations, including Internet appliances, hand-held devices, wearable computers, [or] cellular or mobile phones . . .”).

Claim 1 recites “a storage medium for storing in-game video game content” and “a server in communication with the storage medium.” Petitioner argues that Hays’s advertisement and media servers are in communication with storage devices that store advertisements for use in a video game. Pet. 14–16 (citing Ex. 1005 ¶¶ 20–21, 28, 52, 55, 79, 98, Fig. 1A; Ex. 1003 ¶¶ 92–94).

Claim 1 recites “wherein the server is configured to: receive a request for updated content from the mobile communication device.” Petitioner argues that Hays discloses that the gaming device may request and receive advertisements from the advertisement server. Pet. 16 (citing Ex. 1005 ¶¶ 32, 37, 51, Fig. 1A; Ex. 1003 ¶¶ 95–97); *see* Ex. 1005 ¶ 32 (“The game playing device 126 may request and receive advertisements from the advertisement management service system 108 and may be configured to establish communication via a communication link, such as the Internet 129.”).

Claim 1 recites that the server is configured to “identify, in response to receiving the request, what in-game video game content to send” (limitation 1d) and “send the in-game video game content to the mobile communication device as the updated content for the mobile video game” (limitation 1f). Petitioner argues that Hays discloses selecting advertisements and sending them to the mobile device. Pet. 16–17 (addressing limitation 1d) (citing Ex. 1005 ¶¶ 37, 40, 43, Figs. 1A, 2; Ex. 1003 ¶¶ 98–100), 21–22 (addressing limitation 1f) (citing Ex. 1005 ¶¶ 21, 32, 43, 79; Ex. 1003 ¶¶ 108–110).

Claim 1 recites that the server is configured to
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 (limitation 1e). Petitioner argues that Hays discloses several examples of messages, including the advertisement itself, metadata about the advertisement, and data accompanying the advertisement. Pet. 18–20 (citing

Ex. 1005 ¶¶ 29, 40, 41, 43, 79; Ex. 1003 ¶¶ 101–106). Petitioner argues that Hays’s disclosure of retrieving advertisements in response to a request based on a client identifier teaches pre-selecting messages based on a model type of the mobile communication device. Pet. 18 (citing Ex. 1005 ¶ 41; Ex. 1003 ¶¶ 102, 106).

With respect to limitation 1e, Patent Owner argues that Hays does not disclose selecting advertisements based on any of the factors recited in the claim. Pet. 35–37 (citing Ex. 1005 ¶ 43; Pet. 17–20). On this record, we disagree. As an initial matter, we interpret limitation 1e to require consideration of at least one of the recited factors, and we focus on “a model type associated with the mobile communication device” for this Decision. If the parties disagree with this interpretation, they may address the issue during the trial.

Hays discloses that the advertising matching and weighting system assigns weights to the advertisements “based on several factors including . . . information regarding the specific client type from the advertisement recipient database 120.” Ex. 1005 ¶ 43. Hays further discloses that the client request for an advertisement “contains a data structure that includes a unique identifier to indicate the client type,” which may be “a type of game console.” Ex. 1005 ¶ 40. Petitioner contends that the type of game console is “a model type associated with the mobile communication device,” as recited in the claim. Pet. 20 (citing Ex. 1005 ¶¶ 40, 43–44; Ex. 1003 ¶ 106). Patent Owner’s argument acknowledges Hays’s paragraph 43 disclosure that weights are assigned based on the specific client type. Prelim. Resp. 36–37 (quoting Ex. 1005 ¶ 43). Hays discloses selecting “advertisements from the weighted advertisement set, where the probability of an advertisement being selected is directly derived from the advertisement’s assigned weight.”

Ex. 1005 ¶ 43. Thus, on this record we find Petitioner’s contentions sufficiently persuasive that Hays teaches advertisement selection “based on a model type associated with the mobile communication device.” *See* Pet. 18–20. We, therefore, disagree with Patent Owner’s assertion that Hays does not use “any of the factors recited in element 1(e)” to select advertisements. Prelim. Resp. 36.

Patent Owner also argues that “the Petition provides no real analysis of how the purported message within Hays is ‘pre-selected.’” Prelim. Resp. 37. We disagree because Petitioner addresses this, for example, at page 18 of the Petition, citing Hays’s disclosure that a “set of advertising for each request may be extracted from the advertisement serving database 122 based on data retrieved from a[n] advertisement recipient database 120 *keyed upon the unique client identifier.*” Ex. 1005 ¶ 41 (emphasis added). As noted above, Hays discloses that client identifier indicates the client type, such as “a type of game console.” Ex. 1005 ¶ 40. Petitioner asserts that this disclosure teaches that the data are “pre-selected.” Pet. 18. Patent Owner does not address this disclosure of Hays. We find Petitioner’s contention sufficiently persuasive on this record. *See also* Pet. 20 (separate argument as to how Hays discloses pre-selection of advertisements).

During the trial, the parties may wish to address the scope of the language in limitation 1e reciting “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.” In particular, the parties may wish to address what it means to be “pre-selected” in the context of the claim. The prefix “pre” suggests that the selection happens before something else.

Thus, it appears that a message that is selected any time before sending would be a “pre-selected” message.

For the reasons discussed above and based on Petitioner’s contentions and evidence, summarized above, we are persuaded, on this record, that Petitioner shows a reasonable likelihood of prevailing in demonstrating that claim 1 is unpatentable as obvious over the teachings of Hays.⁸

3. *Claim 9*

Petitioner asserts that claim 9 would have been obvious over Hays for the same reasons as claim 1. Pet. 29–31. Claim 9 is a method claim that recites steps that generally correspond to limitations in claim 1, but we highlight one difference. Claim 1 recites “a storage medium for storing in-game video game content” whereas claim 9 recites “storing, on a storage medium, *pre-selected* in-game video game content for use in a video game” (emphasis added). Claim 9 refers back to the pre-selected content in the limitation reciting “identifying, by the server in response to receiving the request, what *pre-selected* in-game video game content to send” (emphasis added). See claim 1 (reciting “identify, in response to receiving the request, what in-game video game content to send”). In its contentions for claim 1, Petitioner asserts that Hays teaches pre-selected advertisements by its disclosure of targeting advertisements. Pet. 20 (citing Ex. 1005 ¶ 22). On this record, we are sufficiently persuaded by Petitioner’s contentions that Hays teaches storing pre-selected in-game video game content.

During the trial, the parties may wish to address the scope of the phrase “pre-selected in-game video game content.” As noted above, claim 9

⁸ We find Petitioner’s contentions sufficiently persuasive for the preamble and, therefore, need not determine whether the preamble is limiting.

recites “identifying, by the server in response to receiving the request, what pre selected in-game video game content to send,” which suggests that the claim encompasses choosing from among pre-selected content. The ’056 patent’s written description is in accord:

The pre-selected content may be stored on a storage medium accessible by the server. Updated content may be chosen from pre-selected content based on at least one of the factors including a type of the mobile communication device, a telecommunication service, a subscription associated with the mobile communication device, and a service provider of the telecommunication service.

Ex. 1001, 11:34–40.

F. Patent Owner’s Other Arguments

Having determined that the Petition meets the threshold for institution (reasonable likelihood of prevailing as to at least one of the challenged claims) based on the Hays obviousness ground, we focus in the remainder of this Decision on Patent Owner’s remaining arguments.

1. Alleged Obviousness over Levkovitz

Petitioner asserts that claims 1–16 would have been obvious over Levkovitz. Pet. 43–54. Levkovitz discloses delivering content, including advertisements, to wireless devices such as mobile phones for presentation during a game. Ex. 1008 ¶¶ 5, 6, 123, 127; *see* Pet. 35–37 (addressing the preamble of claim 1 and limitation 1a). Levkovitz discloses that wireless communication “device 170 may include an application 176 having a content client 174,” which “may be able to send a wireless signal indicating a request (‘content request’) to receive one or more content items, e.g., . . . advertisement The content request may include, for example, data indicating properties of device 170, e.g., . . . handset model” Ex. 1008 ¶ 123. Levkovitz further discloses that “ad server 110 may select one or

more content items, which may be adequately presented by device 170 based on properties of device 170” and “may serve content items directed for presentation using a first application 176 (e.g., a chess game).” Ex. 1008 ¶ 126.

For limitation 1e, Petitioner argues that Levkovitz’s “presentation rules” are messages that are related to the video content. Pet. 48 (citing Ex. 1008 ¶ 129; Ex. 1003 ¶ 186). Levkovitz discloses sending “one or more presentation rules associated with the transmitted content items,” and it gives examples of such rules, including “a capping rule to cap the number of times that a certain content item may be presented” and “other suitable rules or data to control the presentation of the content items.” Ex. 1008 ¶ 129. Petitioner contends 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.” Pet. 48 (citing Ex. 1003 ¶ 187).

Patent Owner argues that Petitioner’s contentions fail to show how the advertisements in Levkovitz are “pre-selected” or how the presentation rules are selected based on a model type or other factors recited in limitation 1e. Prelim. Resp. 38–41 (citing Pet. 47–49). On this record, we find Petitioner’s contentions sufficiently persuasive. As discussed above, Levkovitz discloses selecting content items based on properties of the device, such as handset model. Ex. 1008 ¶¶ 123, 126. Levkovitz discloses “communicator 150 may further transmit to device 170, e.g., together with the content item(s) or in a separate transmission, one or more presentation rules associated with the transmitted content items.” Ex. 1008 ¶ 129. Thus, because the presentation rules are associated with the selected content items, we find sufficiently persuasive Petitioner’s contention that the presentation

rules are selected along with the content, which is selected based on model type. *See* Ex. 1003 ¶ 187 (“[W]hen a server selects a particular advertisement (based parameters including the model type of the mobile communication device), the pre-defined presentation rules associated with the particular advertising campaign that includes that advertisement will also be selected (based on the same parameters) . . .”).

Furthermore, Levkovitz discloses that “ad server 110 may selectively determine which content items, which may be previously stored in the content items repository 118, match the content request being processed.” Ex. 1008 ¶ 126. Choosing from pre-stored content based on the handset model appears consistent with the ’056 patent’s disclosure that “[u]pdated content may be chosen from pre-selected content based on at least one of the factors including a type of the mobile communication device.” Ex. 1001, 11:35–40.

As noted above in § II.E.2, the parties may wish to address the scope of the phrase “pre-selected in-game video game content” during the trial.

2. *Alleged Abuse of Process*

Patent Owner argues that Petitioner’s conduct amounts to an “abuse of process” because Petitioner is arguing that certain claim terms are indefinite in district court while asserting in this proceeding that no claim terms require construction. Prelim. Resp. 22–26. We disagree because indefiniteness “does not necessarily preclude the Board from addressing the patentability of the claims on section 102 and 103 grounds.” *Samsung Elecs. Am. Inc. v. Priusa Eng’g Corp.*, 948 F.3d 1342, 1355 (Fed. Cir. 2020); *see also Intel Corp. v. Qualcomm Inc.*, 21 F.4th 801, 813 (Fed. Cir. 2021) (“The indefiniteness of a limitation . . . precludes a patentability determination only

when the indefiniteness renders it logically impossible for the Board to reach such a decision.”).

3. *Weight of Petitioner’s Declarant’s Testimony*

Patent Owner argues that we should give no weight to the testimony of Dr. José Zagal, Petitioner’s technical declarant, because it largely parrots the Petition. Prelim. Resp. 26–32 (citing *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 at 15 (PTAB Aug. 24, 2022) (precedential)). We disagree. *Xerox* stands for the proposition that a declaration is entitled to little weight when it restates a petition’s unsupported, conclusory assertions without any additional supporting evidence or reasoning. IPR2022-00624, Paper 9 at 15 (“Dr. Jones does not cite to any additional supporting evidence or provide any technical reasoning to support his statement. Thus, the cited declaration testimony is conclusory and unsupported, adds little to the conclusory assertion for which it is offered to support, and is entitled to little weight.”). For the reasons discussed above in the Hays ground, we find that the assertions in the Petition are sufficiently supported by the teachings of Hays, thus distinguishing this situation from the one described in *Xerox*.

III. CONCLUSION

For the foregoing reasons, we determine that the information presented in the Petition establishes that there is a reasonable likelihood that Petitioner would prevail in challenging at least one claim of the ’056 patent, and we institute *inter partes* review of all challenged claims on all grounds raised in the Petition. See 37 C.F.R. 42.108(a) (“When instituting *inter partes* review, the Board will authorize the review to proceed on all of the challenged claims and on all grounds of unpatentability asserted for each claim.”). At this stage of the proceeding, we have not made a final

determination with respect to the patentability of any of the challenged claims or the construction of any claim term.

IV. ORDER

Accordingly, it is

ORDERED that, pursuant to 35 U.S.C. § 314(a) and 37 C.F.R. § 42.4, an *inter partes* review is hereby instituted as to claims 1–16 of the '056 patent on all challenges raised in the Petition; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial, which will commence on the entry date of this decision.

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