

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PLR WORLDWIDE SALES LIMITED,

Petitioner,

v.

FLIP PHONE GAMES INC.,

Patent Owner.

Case No. IPR2023-00200

U.S. Patent No. 11,117,056

PETITIONER'S REPLY

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EXHIBIT LIST

Ex.	Description
1001	U.S. Patent No. 11,117,056 (“’056 patent”)
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1005	U.S. Patent Pub. No. 2008/0102947 (“Hays”)
1006	U.S. Patent Pub. No. 2007/0174490 (“Choi”)
1007	U.S. Patent No. 7,698,178 (“Chu”)
1008	U.S. Patent Pub. No. 2007/0088801 (“Levkovitz”)
1009	Exemplary infringement charts for U.S. Patent No. 11,117,056 served by Patent Owner in <i>Flip Phone Games Inc. v. PLR Worldwide Sales Ltd.</i> , No. 2:23-cv-139 (E.D. Tex.)
1010	Steven Kent, <i>The Ultimate History of Video Games</i> (2001)
1011	Frans Mayra, “Mobile Games,” in the <i>International Encyclopedia of Digital Communications and Society</i> , 1st ed. (2015)
1012	N. Leavitt, “Will wireless gaming be a winner?” in <i>Computer</i> , Vol. 36, No. 1, pp. 24-27 (Jan. 2003)
1013	Jason Soh & Bernard Tan, “Mobile Gaming,” in <i>Communications of the ACM</i> , Vol. 51, No. 3, pp. 35-39 (Mar. 2008)
1014	Michael Zyda et al., “Educating the Next Generation of Mobile Game Developers,” in <i>IEEE Computer Graphics and Applications</i> , Vol. 27, No. 2, pp. 92-96 (Mar./Apr. 2007)
1015	Mark Andrejevic, “Productive Play 2.0: The Logic of In-Game Advertising” in <i>Media International Australia</i> , Vol. 130, No. 1, pp. 66-76 (Feb. 2009)

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

I. INTRODUCTION

PO's arguments primarily rely on unsupported and unduly narrow claim interpretations, and mischaracterizing or ignoring express disclosures within the prior art or in the '056 patent. For example, PO argues that a "real-time" advertisement selection cannot comprise pre-selected ads, while failing to address the separate disclosures relied upon in the Petition relating to advance selection of advertisements. Similarly, PO attempts to argue that the claims do not cover updated content that is merely displayed in a game, without changing the game functionality, but ignores that numerous embodiments in the '056 patent involve nothing more than displaying updated messages or logos. PO's arguments lack credence. PO also repeatedly ignores Dr. Zagal's testimony regarding motivation to combine, instead alleging some disadvantage with combining the references as a whole, which is immaterial to Petitioner's proposed obviousness combinations.

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

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

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

III. GROUND 1: HAYS

A. 1[e]/9[d]:

1. “the message is pre-selected”

Hays discloses pre-selected messages in at least three ways: (1) metadata associated with a pre-selected advertisement; Pet. 18; EX1005, ¶41; (2) the pre-selected advertisement itself, which is sent to the mobile device as a message (*e.g.*, data packets over a network); Pet. 19; EX1003, ¶102; and (3) “lists of advertisements for specific available ad units,” Pet. 19; EX1005, ¶29. The messages (ads, metadata, or lists) may be pre-selected by advertisers based on “sub-channel[s],” such as a game genre or time of day, or based on the “type of game console” (*i.e.*, type of mobile device), or may be “keyed upon [a] unique client identifier.” Pet. 18, 20; EX1005, ¶¶22, 40-41, 43-44.

Interpretation of “pre-selected.” In the related district court proceeding, Petitioner has asserted that “pre-selected” is indefinite. *See* EX2001. PO’s expert could not articulate when or how content must be “pre-selected” in relation to other claim elements. EX1020, 39:6-43:22. Nor does PO offer a construction of the term. However, PO presents several arguments relating to the scope of the term. For example, PO argues that “pre-selection” is distinct from “real-time” selection and sending. POR 11-12. PO also acknowledges that “[a] message identified [*i.e.*, pre-

selected] based on the claimed factors and sent” could also be “‘selected’ and sent.”

POR 11. For the purposes of IPR, Petitioner adopts PO’s interpretation of the term “pre-selected” as outlined above.

Hays discloses a pre-selected message under PO’s interpretation. PO’s argument is directed to Hays’s “matching and weighting system,” which PO argues “selects advertisements in ‘real time’” rather than “pre-selecting” a message. POR 11-13. But the Petition relies on *different* disclosures for the pre-selected message.

First, the Petition relies on Hays’ teaching that advertisements and/or metadata (*i.e.*, messages) may be “retrieved from a[n] advertisement recipient database 120 *keyed upon the unique client identifier.*” Pet. 18 (quoting EX1005, ¶41). Thus, messages may be retrieved from a database where they were previously pre-selected and stored based on identifiers corresponding to client (*i.e.*, a type of mobile device). EX1003, ¶106. That is consistent with Hays’s teaching that requests for advertisements may include an identification of a “client type,” which is a “type of game console”—information that would be needed to retrieve the pre-selected advertisements and/or messages for that client type. Pet. 20 (quoting EX1005, ¶¶ 40, 43-44). PO does not address these disclosures at all.

The Petition also states that pre-selection is disclosed by Hays’s “sub-channel[s]” that enable advertisers to pre-select advertisements, *e.g.*, based on game genre, time of day, or date in advance of any real-time matching and weighting. Pet.

20 (citing EX1005, ¶22). That pre-selection plainly happens **before** the weighting system determines which ads and associated data to serve to a particular mobile device—the advertisers are not being polled every time an advertisement is delivered. And as noted above, Hays teaches that pre-selection can be based on client type.

PO asserts that Hays's sub-channels do not involve "pre-selected" messages and advertisements, but offers no reasoning to support that argument. POR 12-13. PO simply repeats that Hays's weighting system performs a real-time selection of ads, but does not explain why the advance selection of criteria (*i.e.*, sub-channels) does not entail "pre-selecting" ads and messages. The fact that the pre-selected ads and messages may later be further selected based on a real-time weighting process is irrelevant.

PO also argues that Hays's "'sub-channels' have to do with the target for a particular advertisement," and "is irrelevant to whether a particular advertisement is 'pre-selected.'" POR 13. PO offers no support for this conclusion. PO does not cite to any evidence that pre-selection of advertisements and messages cannot be related to targeting advertisements for particular games or game players. Rather, when discussing the scope of the claim term, PO only argues that "pre-selection" must occur separate from "real-time selection" of the advertisement for delivery to a mobile device. POR 11-12. Hays's sub-channels allow advertisers to perform

such pre-selection in advance of real-time selection of specific advertisements for delivery. EX1005, ¶22.

Even under PO's unsupported distinction between "pre-selected" advertising and targeted advertising, Hays discloses that pre-selection can be performed to ensure compatibility between ads and game clients. For example, Hays discloses that a database may be used to store "information about the technical media formats accepted by each advertising destination ... and about which advertising has been specifically approved for each advertisement recipient client by a game publisher/developer." EX1005, ¶42. Only advertisements with "the correct media format" and "that have been specifically approved" may later be selected for delivery. *Id.* Technical compatibility (based on the device type) and publisher/developer approval can also thus be used to pre-select advertisements based on the specifications of the mobile device.

To the extent PO contends that "pre-selected" advertisements must identify one specific ad to send, rather than a set of ads from which a specific ad may later be selected, that interpretation lacks support in the intrinsic evidence. The '056 patent expressly contemplates that updated content may be "part of a **group of pre-selected content** for the mobile communications device." EX1001, 5:45-48. Updated content may also be "chosen from pre-selected content based on at least

one of the factors.” *Id.*, 11:35-40. These disclosures confirm that the pre-selected ads may be a group or set of ads from which a specific ad is later selected.

2. “based on [the claimed factors]”

As discussed above, Hays teaches that a message is pre-selected based at least on a type of client device. EX1005, ¶41 (“keyed upon a unique client identifier), 42 (based on “technical media formats” compatible with a client type). Petitioner incorrectly asserts that the Petition relies on Hays’s advertising matching and weighting system for this element. POR 15. It does not. The remainder of PO’s argument is directed to whether or not Hays’s advertising matching and weighting system selects advertisements based on a type of mobile device or a service provider. POR 15-18. Because Petitioner does not contend that the advertising matching and weighting system pre-selects messages, POs arguments are entirely irrelevant to this limitation.

PO also repeats the argument that the claim limitation requires a “compatibility determination.” PO does not provide **any** claim construction analysis as required by the Federal Circuit, and does not argue any disavowal or lexicography to support its unreasonably narrow construction. *Thorner v. Sony Computer Entertainment America LLC*, 669 F. 3d 1362, 1366 (Fed. Cir. 2011). The claim plainly does not require performing a check based on device compatibility—it can, for example, perform the check based on a service provider which is not related to

device compatibility. In any event, as discussed above, Hays discloses pre-selected messages and advertisements based on compatibility for a type of device. EX1005, ¶42.

B. 9[a]

1. “pre-selected in-game video game content”

PO erroneously argues the Petition “does not address this [] requirement at all.” POR 18. But the Petition cites back to claim 1, which includes a detailed discussion of why Hays’s advertisements are “pre-selected.” Pet. 20-21.

2. “for use in a video game”

PO again incorrectly asserts the Petition does not address this limitation. POR 19. The Petition expressly explains that Hays’s advertisements are usable in a video game because they are displayed “during game play,” such as “a game character [that] may move around a screen holding a can of Pepsi and ask player if they would like a drink.” Pet. 15 (quoting EX1005, ¶¶21, 79).

PO improperly limits the term “for use” to require an effect on gameplay or functionality. See POR 19 (Hays’s “advertisements are untethered from game functionality” and “are displayed” but “do not affect game play”). PO does not address the ordinary meaning of the claim language or explain why the Board should depart from it. As PO’s expert admits, the ’056 patent discloses embodiments where content is displayed without any effect on gameplay. For example, a shirt “might be updated to include a logo associated with third party X” or a poster “might advertise

an upcoming movie for third party Y.” EX1001, 6:47-49; EX1020, 26:3-18 (“[J]ust having something on a shirt ... that doesn’t disclose for use yet.”). Updated content may also be “displayed in a pop-up window” which has no effect on gameplay. EX1001, 8:6-7.

Even under PO’s incorrect construction, Hays discloses the limitation. Hays teaches that the advertisement may be uploaded into the game as a “bot[] or electronic agent[] ... or real character[] in the game,” such as “a game character [that] may move around a screen holding a can of Pepsi and ask player if they would like a drink.” EX1005, ¶79. This is a specific example of updated content that affects gameplay—*i.e.*, by allowing the player to drink the advertised product.

PO mischaracterizes this teaching example as merely an “in-game can on which the skin of the brand Pepsi may be displayed” which does not otherwise “alter[] the functionality of the game.” POR 21. Yet Hays does not state that the character drinking a can is a pre-existing character that is simply skinned to show the Pepsi logo—instead, Hays is explicit that the “advertisement management service system may **send bots or electronic agents**” such as a character “holding a can of Pepsi and ask[ing the] player if they would like a drink.” EX1005, ¶79. Thus, Hays teaches that the character and its player interaction is the delivered advertisement. Hays similarly discloses “a game character eating a brand name energy bar to boost her power in the game.” *Id.*, ¶19; *see also id.*, ¶21 (“[S]pecific

advertisements may be presented in the appropriate available ad units at the appropriate time *during game play.*").

PO is incorrect that these examples are like the hyperlinked content in Gatto distinguished during prosecution of the parent '202 patent. POR 22. Hays's disclosures are far closer to the '056 patent's disclosure of a shirt that "might be updated to include a logo associated with third party X" or a poster that "might advertise an upcoming movie for third party Y." EX1001, 6:45-59. By contrast, during the prosecution of the '202 patent, the examiner had asserted that Gatto's "‘promotional items’ available for download via email hyperlink" were the updated content—it was not the hyperlinks themselves that the examiner contended were the updated content. EX2002, 188; POR 18-19. The examiner further contended that the hyperlinked content was usable within the email (which the examiner alleged was a "video game"). EX2002, 188. But the applicant argued that the *linked promotional items* were not usable in the video game, since "it would not make sense for an email to provide hyperlinks to *content that is usable in the email itself.*" EX2002, 188. In other words, the problem with Gatto was that the updated content was not itself displayed within the email but instead linked by the email's hyperlinks. By contrast, in both the '056 patent and Hays, the content itself (such as an advertisement) is used within the game (such as, in the '056 patent, being displayed

on a t-shirt (EX1001, 6:47-49) or, in Hays, as an interactive soda can (EX1005, ¶79)).

C. Claims 4/12

These claims require *identifying advertisements* to send (rather than *pre-selecting messages*) based on factors such as a model type, service provider, or location. The Petition explains that Hays teaches selecting advertisements based on “weights” that are computed based on, *inter alia*, the “client type” and a player’s “IP address,” which is associated with a service provider, or the GPS location of the mobile device. Pet. 24; EX1005, ¶¶30, 40, 43-44; EX1003, ¶116.

PO generally argues that Hays’s “advertising matching and weighting system” cannot meet the requirements of claims 1 and 9. POR 23. But PO does not challenge limitations 1[d]/9[c], which recite the corresponding “identifying” step. And PO’s arguments that Hays’s weighting is not based on the device type and service provider (POR 15-17) ignore the clear disclosures of Hays. EX1005, ¶¶40, 51 (advertisements chosen based on “the client type,” which may be a “cellular or mobile phone[]”); *id.*, ¶44 (advertisements selected based on “demographic characteristics” determined from IP address or “Internet service providers”). PO also does not dispute that Hays selects advertisements based on GPS location, which is in itself sufficient to satisfy the claim.

D. Claims 5/13

Hays teaches designating the “ad unit” (*i.e.* a “space”) within the game in which an advertisement should appear, providing an “in-game placement location.” Pet. 24-26; EX1005, ¶18; EX1003, ¶¶119-123.

PO argues “the ad units are ‘standardized’ and not related to any specific in-game placement location.” POR 25. But “standardized available ad units” refers to standardized **types** of ad units such as “signs,” “structure,” or “logos.” EX1005, ¶73. Different retailers can select a standardized **type** that is appropriate to that retailer, such as “McDonald’s” selecting a “branded fast food restaurant” structure. *Id.*, ¶¶73-74.

However, the device still needs to know the in-game location to display the advertisement. Hays’s ad units are “**spaces ... within the game**” and refer to specific objects located in specific areas, such as “Jumbotron screens, in a sports stadium, posters on walls, T-shirts on a game character, items used by game characters.” EX1003, ¶120 (quoting EX1005, ¶18). The ’056 patent similarly discloses the locations are not necessarily “positions along the axes” but may be specific objects. EX1001, 12:28-32 (“[A] first location may be where the shirt 230 is hanging”). PO’s own expert conceded the claim is met by providing “a location ... in relation to an object.” EX1020, 31:21-32:1. Thus, by designating the ad unit, *i.e.*, a location in relation to an object, the system provides an ***in-game placement location***.

Dr. Zagal also explains why it is obvious to provide in-game location because “a POSITA would be motivated to provide a mechanism to inform the game ... where to place the advertisement, as that would fulfill the contractual obligations to the advertiser.” EX1003, ¶123. PO does not address this opinion. PO instead argues that ad units are “pre-designated” and thus no location information is sent. POR 24-25. But pre-designated ad units do not solve the problem of “inform[ing] the game ... where to place the advertisement,” *i.e.* designating the ad unit to display the advertisement. EX1003, ¶123.

E. Claims 7/15

The Petition provides several examples from Hays of tracking. Neither PO or its expert address Hays’s “frequency caps,” which require tracking uploaded advertisements and their frequency. Pet. 28; EX1005, ¶45.

PO’s arguments likewise fail with respect to Hays’s remaining teachings. The Petition explained that Hays’s “active session database 124” is “used to **track** and record **all communications and data** sent and received from the” mobile device. Pet. 30 (quoting EX1005, ¶38). Although Hays tracks “**all** communications,” PO argues that Hays’s tracked data is only for “session[s],” and therefore fails to track all uploaded data and does not “show what has been uploaded.” POR 26.

Yet the session where data is tracked corresponds to what PO admits is the “period a user is playing a game.” POR 27 (citing EX1005, ¶38). The session begins

when the player logs in and ends when they log-out. EX1005, ¶¶38-39. As a result, all “updated content” would necessarily be distributed to the player’s device during a “session,” and would thus be tracked. Claims 7 and 15 require nothing more.

Hays also describes “services that **track** and audit the quality of presentation of the in-game advertisements,” including “advertisement impressions.” EX1005, ¶25; Pet. 28. PO argues “this [data] is related to the advertisement itself, not the ‘mobile communications device.’” POR 26. But the qualities being tracked all relate to the presentation of the advertisement *at a user’s device*—such as time on screen—and not properties of the advertisement itself. Pet. 28 (quoting EX1005, ¶25). PO argues that “[Hays] describes information regarding the presentation of an advertisement, rather than when an advertisement has been uploaded.” POR 26. But the claims do not require tracking “when an advertisement has been uploaded”—they only require tracking **distribution** of updated content, which includes presentation. In any event, Hays describes tracking “advertisement impressions,” which would include when and how often an advertisement is uploaded. EX1003, ¶131.

F. Claims 8/16

Hays discloses that updated content may be sent only when bandwidth is available, such as “in the background” when the mobile device is connected to the ad server, or “sporadically [or] periodically” when bandwidth is available. Pet. 28-

29; EX1005, ¶¶21, 34; EX1003, ¶133. PO's argument that Hays does not expressly disclose checking for available bandwidth ignores the fact that Ground 4 is an obviousness ground, and fails to account for the relevant knowledge and ordinary creativity of a POSITA.

IV. GROUND 2: HAYS AND CHOI

The Petition provided the Hays-Choi combination as an alternative ground to limitations 1[e]/9[d] and claims 3/11, 4/12, and 8/16. Pet. 32.

A. 1[e]/9[d]

As discussed above for Ground 1, Hays discloses pre-selected messages, including metadata and lists of advertisements, as well as the advertisement itself as a message. Choi similarly discloses sending both ads and associated meta-data to the mobile device. Pet. 37; EX1006, ¶78. Choi further teaches that ads (and, by extension, their associated meta-data) can be pre-selected for certain carriers in order to target demographics associated with that carrier. Pet. 37-38; EX1006, ¶¶86, 96. In the proposed combination, Hays uses carrier information to pre-select advertisements and associated metadata (*i.e.*, messages), as taught by Choi. Pet. 38.

PO argues the Petition “never addresses pre-selected” for Choi. POR 29. That is incorrect. The Petition explains that Choi pre-selects ads and metadata for specific carriers, as described above.

PO also argues that “ad targeting” is “not based on one of the claimed factors.”¹ POR 30. But Choi expressly teaches targeting ads based on “user demographics,” which may be inferred from “a users’ carrier.” EX1006, ¶¶83 (noting that “techniques” for “collection of user demographic ... information” are “outlined below”), 86 (describing technique using carrier information).

PO also repeats the argument that the limitation requires a “compatibility” determination. POR 31. As discussed above, the intrinsic evidence does not support PO’s narrow construction.

B. Claims 4/12

Choi’s server may target ads based on demographic information associated with the service provider for the mobile device or based on the device’s GPS location. Pet. 37-39; EX1006, ¶¶83, 86, 96. PO incorrectly argues that GPS information is only used by the mobile device to “request location-specific advertising from the network server.” POR 33. In order to fill the request, however, the server clearly must *use* the GPS information to select an appropriate ad.

¹ PO also refers to a “checking” step, but no such limitation exists in the ’056 claims.

C. Motivation to Combine

Dr. Zagal provided several reasons why a POSITA would combine Hays and Choi. EX1003, ¶¶137-146; Pet. 32-36. PO does not address any of them. Instead, PO argues that there is no motivation to combine because Hays and Choi disclose “different system[s].” POR 33. For example, PO argues that Hays sends advertisements “regardless of the specific game” whereas Choi has a “focus on a specific game.” POR 34. This distinction has no bearing on whether a POSITA would be motivated to use GPS, carrier, or bandwidth information for targeted advertising—which Choi clearly teaches. *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1076 (Fed. Cir. 2015) (“[A] reference must be considered for **everything it teaches** by way of technology and is not limited to the particular invention it is describing and attempting to protect.”). Hays also expressly states its system works for a specific game. EX1005, ¶27 (“[A]t least **one** game publisher system 110 that publishes **a game title**.”).

PO also argues that Choi “provides no explanation of how to use the collected information.” POR 33-34. This is incorrect. Choi explains that the information is used for targeted advertising. EX1006, Abstract, ¶3. And the proposed combination is to use the information with Hays’s targeted advertising.

V. GROUND 3: HAYS (OR HAYS AND CHOI) AND CHU

The Petition provided the Hays-Chu or Hays-Choi-Chu combination as an alternative ground to claims 5/13. Pet. 40.

A. Claims 5/13

Chu delivers advertisements that include “the **location** within a game at which advertisements are to appear.” Pet. 43 (quoting EX1007, 14:20-15:5).

PO argues that Chu does not describe that such information is sent “from the server to the client.” POR 35. Chu clearly states that requested metadata sent to the client includes the “location object.” EX1007, 14:47-15:5. Figure 5 further shows that the server “[r]eturn[s] **campaign metadata**,” which includes the location.

PO also argues that “Dr. Zagal fails to explain how Chu’s client-based system would be modified for or implemented into Hays’s server system.” POR 33. But Dr. Zagal explained how to use Chu’s location metadata with Hays’s system. EX1003, ¶¶160-169. It is not necessary to combine the entirety of Chu’s system with Hays’s system. *Belden*, 805 F.3d at 1076.

B. Motivation to Combine

PO argues that the “Petition fails to set forth any motivation to combine Choi and Chu or Hays, Choi, and Chu.” POR 37. But the Petition set forth a motivation to “modify Hays (or **further modify the Hays-Choi combination**) according to Chu’s teachings,” and PO provides no reason why the articulated motivations would not apply to the Hays-Choi combination. Pet. 40-42.

As for the Hays-Chu combination, PO argues that “a POSITA would not have sought to modify Hays’s specific ad units to transmit placement information.” POR 37. But the combination does not modify Hays’s ad units. Hays discloses that ad units are found in certain locations within the game (*e.g.* a t-shirt or billboard (EX1005, ¶18)) and thus, a POSITA would have been motivated to use Chu’s teaching of providing a location to specify the ad unit. EX1003, ¶163.

PO also argues that Hays provides ads “across a variety of games” whereas Chu “is directed to a specific, online gaming system.” POR 37-38. PO similarly argues that Hays discloses that advertising content is “push[ed]” from the server, while Chu discloses that advertising content is “request[ed] from the client.” POR 39. This fails to address the combination or motivations regarding the inclusion of Chu’s location metadata with Hays’s system. It is also not necessary to combine the entirety of Chu’s system with Hays’s system. *See Belden*, 805 F.3d at 1076.

PO next argues that Hays proposes an ad server and thus teaches away from specific gaming systems or applications. POR 38. Tellingly, PO does not cite to any disclosure in Hays to support this proposition. Nothing in Hays suggests that the ad server cannot deliver advertisements to specific gaming systems. For example, Hays describes that its system works with “game consoles.” EX1005, ¶21. Moreover, PO provides no explanation for why Chu’s teachings regarding

specifying an *in-game location* for an advertisement could not be applied to Hays's ad server.

Finally, PO states "Hays's ad units are not fixed to a specific location and are sent 'regardless of [their] location.'" POR 38 (quoting EX1005, ¶73). This grossly mischaracterizes Hays, which provides as *an example* that a *type* of ad unit can be a "static sign regardless of its location." EX1005, ¶73. Hays expressly discloses that advertisements are placed at "a specific location." EX1005, ¶46; *see also id.*, ¶18 ("[A]dvertisements ... on pre-designated *geometry within the game* such as billboards, storefront signs, panel trucks ...").

VI. GROUND 4: LEVKOVITZ

A. 1[e]/9[d]

Levkovitz discloses messages such as "presentation rules" that, *e.g.*, instruct the device when to display updated content or otherwise "control the presentation of the content items." Pet. 47-48; EX1008, ¶129.

PO argues that Levkovitz does not describe how "any capping rule is 'pre-selected.'" POR 40. But Levkovitz's presentation rules are not limited to capping rules. In any event, the Petition explains how presentation rules are pre-selected. For example, presentation rules are associated with specific content items. Pet. 48; EX1008, ¶129. Those content items are pre-selected based on "parameters related to the mobile phone," such as a "model identifier" (*i.e.*, type of mobile device). Pet.

47; EX1008, ¶¶6, 126; *see also* EX1008, ¶30 (describing content items adapted for different types of devices). PO does not dispute that the initial association of content items with specific device types constitutes a pre-selection of content items based on the type of mobile device. Because the presentation rules are associated with those content items, they are also necessarily pre-selected when the corresponding content item is pre-selected. Pet. 47-48. Levkovitz also confirms that presentation rules may specifically be based on “information about device 170,” such that the rules are directly pre-selected based on the device type. EX1008, ¶188.

PO also argues that presentation rules are not transmitted to or applied by a mobile device. POR 41. But Levkovitz expressly teaches that “presentation rules” are “transmit[ted] to device 170.” EX1008, ¶129; *see also id.*, ¶¶184-188 (describing how presentation rules are used by the device).

B. 9[a]:

1. “pre-selected in-game video game content”

PO erroneously argues the Petition “does not address this [] requirement at all.” POR 41. But the Petition cites back to claim 1, which explains that Levkovitz’s content is pre-selected “based on parameters related to the mobile phone.” Pet. 47.

2. “for use in a video game”

PO again incorrectly asserts the Petition does not address this limitation. POR 42. The Petition expressly explains that Levkovitz’s content items are for use in a

video game because they are “directed for presentation using a first application” such as “a chess game.” Pet. 44 (quoting EX1008, ¶127).

PO argues that Levkovitz only discloses “placement of content ... within the game, which are not usable in the video game.” POR 40-42. As discussed above in Section III.B.2, PO’s attempt to construe “for use” to require affecting gameplay has no support in the intrinsic evidence. EX1001, 6:47-50 (describing a pre-existing shirt updated to display a logo); 8:6-7 (describing content being “displayed in a pop-up window”).

PO tries to compare Levkovitz’s display of advertisements to the hyperlinking described in the Gatto reference considered by the examiner during prosecution of the related ’202 patent. POR 36-37. As discussed in Section III.B.2, the examiner had asserted that Gatto’s “‘promotional items’ available for download via email hyperlink” were the updated content. EX2002, 188. In other words, the problem with Gatto was that the email did not display the content, but was instead linked to it via hyperlink.

C. Claims 5/13

Levkovitz discloses serving content items that “may have multiple versions” corresponding to multiple sizes (e.g., “the entire screen,” “half of the screen,” or “a square-shaped or rectangular content item which may occupy approximately one quarter of the screen”). Pet. 51-52; EX1008, ¶¶127, 133.

PO argues that the size of the advertisement does not “disclose[] a placement location.” POR 45. But the size of an advertisement does affect which pixels on the screen will display the advertisement, *i.e.* the location of the advertisement.

D. Claims 7/15

Levkovitz discloses “log[ging] information related to presentations” which includes “data indicating the content item(s) presented.” EX1008, ¶132; Pet. 43. PO acknowledges that, at a minimum, Levkovitz tracks “what content has been presented.” POR 46. That is all that is required by the claims, which broadly require tracking ***distribution*** of updated content, such as ***presentation*** of content. PO offers no support for its argument that “distribution” is limited to “what has been uploaded.” POR 46. Indeed, the patentee understood the distinction between “distribution” of content and uploading content. For example, in the related '202 patent, claim 5 recites “tracking ***what has been uploaded*** to the mobile communication device.” EX2003. Here, the claims only require tracking ***distribution***.

Even under PO's improperly narrow construction, PO's arguments regarding Levkovitz are incorrect. PO presumes the claims require tracking ***all*** uploaded content, and argues that some content “could be uploaded and not presented.” POR 46. But the intrinsic evidence does not support PO's argument. The claims merely require tracking distribution of “updated content,” not “***all*** updated content.” Thus,

the claims are disclosed as long as the prior art teaches tracking of at least one uploaded updated video game content, which Levkovitz does.

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

E. Claims 8/16

Levokvitz teaches that sending updated content may be “correlate[d]” to “information about the device,” including its “functional capabilities.” Pet. 53; EX1008, ¶¶160, 172. As Dr. Zagal notes, a POSITA would have understood that the “functional capabilities” of the device include available bandwidth, which would be used to determine when to send updated content. EX1003, ¶204. PO’s argument ignores the fact that Ground 4 is a single-reference obviousness ground and may rely on material outside of the four corners of the reference, including the relevant knowledge of a POSITA.

VII. GROUND 5: LEVKOVITZ AND CHU

PO relies on the same arguments as in Ground 3, contending that Chu’s server does not send in-game placement location to the client. POR 49-50. As discussed above, that is incorrect—Chu expressly teaches that location metadata is sent from the server to the client. EX1007, 14:20-15:5, Fig. 5.

PO's arguments against motivation to combine repeat this same error, assuming that Chu "only relates to information sent from the client." POR 51. PO fails to address Chu's disclosures relating to the **server** sending location metadata back to the client. Thus, Chu and Levkovitz do not "operate in opposite manners"—both contemplate ad servers that deliver advertisements to a client device.

PO also argues that "Levkovitz seeks to serve advertisements broadly" whereas Chu has a "narrow disclosure of placing ads at a particular location." POR 51. This does not rebut any of the known benefits for modifying Levkovitz to place ads at a particular location, as explained by Dr. Zagal, and thus does not establish no motivation to combine. EX1003, ¶¶206-211.

VIII. GROUND 6: LEVKOVITZ AND CHOI

The Petition provided the Levkovitz-Choi combination as an alternative ground to claims 8/16. Pet. 57-59. PO does not address any arguments presented in this Ground. Instead PO merely repeats its assertion that Levkovitz fails to disclose independent claims 1 and 9. POR 52. These arguments are already addressed above.

IX. PATENT OWNER PROVIDES NO EVIDENCE OF SECONDARY CONSIDERATIONS

PO argues there was a long-felt need for the '056 Patent, yet admits consoles games "did not face the same issues." POR 52-53. Yet the claims of the '056 patent recite a "mobile communication device" and as PO's expert readily admits, mobile game consoles existed prior to the patent. EX1020, 7:24-9:3. Further, the only

purported evidence PO offers of any long-felt or unmet need with respect to mobile handsets, specifically, is the unsupported say-so of its expert. PO submits no evidence that mobile phone developers or mobile phone users experienced a long-felt need for updated game content. Accordingly, PO has failed to establish a nexus between the claims and any alleged long-felt need.

The remaining evidence cited by PO merely describes the industry's desire for more in-game advertising and mechanisms for delivering updated content. POR 54-56. As shown in the Petition, and as undisputed by PO, in-game advertising on mobile devices was well known well before the '056 patent, including as described in Hays, Choi, Chu, and Levkovitz. Thus, PO has failed to show any nexus. *Yita LLC v. MacNeil IP LLC*, 69 F. 4th 1356, 1364 (Fed. Cir. 2023) (“[O]bjective evidence of nonobviousness lacks a nexus if it exclusively relates to a feature that was known in the prior art.”).

PO does not identify evidence of commercial praise, commercial success, or copying by competitors.

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

X. §311(B)

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

Regardless, Hays claims priority to a PCT application published years before the '056 patent. EX1021. If Hays is not a "printed publication," Petitioner will seek leave to replace Hays with Exhibit 1021. There should be no prejudice given that the disclosures are identical.

XI. CONCLUSION

For these reasons, all challenged claims are unpatentable.

Date: November 1, 2024

Respectfully submitted,

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

Counsel for Petitioner

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

1. This Petition complies with the type-volume limitation of 5,600 words, comprising 5,589 words, as counted using the Microsoft Word software that was used to prepare this paper, excluding the parts exempted by 37 C.F.R. § 42.24(a).

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

Date: November 1, 2024

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

Counsel for Petitioner

CERTIFICATE OF SERVICE

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

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

Date: November 1, 2024

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

Counsel for Petitioner