

IPR2024-00200

U.S. 11,117,056

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 SUR-REPLY

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EXHIBIT LIST

Exhibit	Description
2001	Playrix's Exchange of Proposed Terms and Claim Elements for Construction, served January 30, 2024
2002	Prosecution History of U.S. Patent No. 9,731,202
2003	U.S. Patent No. 9,731,202
2004	Declaration of Dr. Robert Akl
2005	CV of Dr. Robert Akl, D.SC
2006	Complaint for Patent Infringement, <i>Flip Phone Games Inc. v. PLR Worldwide Sales, Ltd.</i> , No. 2:23-cv-00139-JRG (E.D. Tex.), Dkt. 1
2007	CV of Steven D. Moore

I. INTRODUCTION

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

With respect to the claims’ requirement that the message is “pre-selected,” the Petition suggests it is met by sending information. This ignores the requirement for “*pre*-selection.” The Petition similarly ignores that claim 9 and its dependent claims require “pre-selected in-game video game content *for use* in a video game.” Tacitly acknowledging that the cited art does not disclose video game content for use, Petitioner urges that the ’056 Patent provides examples of content that is not for use. But that the specification provides unclaimed examples does not modify the claims’ requirement, which Petitioner fails to address.

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

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

Petitioner urges that Dr. Zagal’s testimony “should be given due weight.” Reply, 1. Indeed, the due weight here for Dr. Zagal’s opinions is little to none. His declaration is nearly a carbon copy of the Petition. *Compare, e.g.*, Petition, 18-21 (addressing element 1(e)) *with* Ex. 1003, ¶¶101-107; *compare* Ex. 1003, ¶¶88-91 *with* Petition, 13-14; *compare* Ex. 1003, ¶¶98-100 *with* Petition, 16-17; *compare* Ex. 1003, ¶¶112-114 *with* Petition, 22-23; *compare* Ex. 1003, ¶183 *with* Petition, 46-47; *compare* Ex. 1003, ¶198 *with* Petition, 51-52. Petitioner offers no explanation for its failure to present credible testimony, nor does Petitioner attempt to rebut PO’s contentions. Reply, 1-2. As PO has shown previously and shows below, Dr. Zagal’s declaration is of little use and should be afforded no weight. *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9, at 18 (PTAB Aug. 24, 2022) (precedential).

III. GROUND 1: PETITIONER FAILS TO CARRY ITS BURDEN OF ESTABLISHING THAT HAYS RENDERS CLAIMS 1-16 OBVIOUS.

A. Claims 1[e] and 9[d]: Hays does not teach a “message relating to the in-game video game content ... wherein the message is pre-selected by the server”

Hays does not disclose that “the message is *pre-selected* by the server.” Petitioner fails to ascribe proper meaning to the term because it fails to distinguish between the selection of an advertisement and a “message relating to the in-game

video game content ... wherein the message is *pre-selected* by the server.” Reply, 3-4.

Petitioner attempts to criticize Dr. Akl for purportedly being unable to describe “when or how content must be ‘pre-selected.’” Reply at 2. But throughout the four pages of cited testimony Dr. Akl explained exactly what the claims require. Ex. 1020, 41:8-15. Petitioner ignores this testimony and instead asked questions unrelated to the claims such as “does the preselection of -- of content, does that need to have already happened by the time you send the preselected in-game advertising?” *Id.*, 41:22-25. But this is irrelevant to the claims, as Dr. Akl testified. *Id.*, 42:1-25.

Petitioner asserts that retrieval of advertisements or metadata based “upon the unique client identifier” teaches that messages are pre-selected. Reply, 3 (quoting Ex. 1005, [0041]). But a unique client identifier does not indicate that any message or advertisement was preselected. Hays, instead, explains that this is “extract[ing]” “[a] set of advertising for each request,” (*id.*) which is merely selecting an advertisement or message. Petitioner again ignores that the claim requires “pre-select[ing]” a message relating to in-game video game content.

This disclosure is consistent with Hays’s disclosures based on “client type” or “type of game console.” Ex. 1005, [0040], [0043]-[0044]. Hays does not describe how any advertisement is “pre-selected,” rather how advertisements are selected in response to a request. Petitioner and Dr. Zagal do not explain how this could teach

preselecting a message rather than simply selecting an advertisement to send in response to a request. Petitioner, thus, ignores the plain language of this limitation.

Hays's "sub-channel[s]" also do not perform a step of "pre-select[ing]" a message relating to the in-game video game content. *See* PO Response at 10-14 (addressing Hays's "advertising matching and weighting system" and "sub-channels"). Hays's sub-channels are sub-channels for advertisement *spaces* within a game—not sub-channels (or sub-selections or sub-groupings) of the advertising content itself. Ex. 1005, [0021] ("[T]he ***multiple games that comprise the network of available advertisement spaces can be divided by genre*** such as sports titles (and even further by specific sport), children's titles, racing titles, etc. Accordingly, advertisers can target the delivery of their advertisement campaign specifically to a ***sub-channel*** as that sub-channel relates to their campaign."). Hays specifically describes dividing the games and available spaces by genre into sub-channels, not the advertisements. Thus, Hays specifically describes dividing the platforms in which advertisements may be displayed—the games and corresponding spaces—into sub-channels. This identification of games that are divided into subchannels does not disclose "a message relating to the in-game video game content," that is "pre-selected by the server" based on factors, as the claims require.

Hays's description of accepted "technical media formats," (Ex. 1005, [0042]) which Petitioner identified for the first time in its Reply, also does not teach a pre-

selected “message relating to the in-game video game content.” Instead, Hays describes whether the advertisement “has been specifically approved,” which is determining technical compatibility of an advertisement with a client and whether an advertisement can be sent. *Id.* This not “pre-select[ing]” a “message relating to the in-game video game content,” as the claim requires. Petitioner’s description proves as much. Petitioner’s reference to “pre-select” or “later be selected for delivery” are merely attorney argument not supported by the description in Hays or by Dr. Zagal.

Thus, Hays fails to teach a pre-selected “message relating to the in-game video game content.”

B. Claims 1[e] and 9[d]: Hays does not teach that “the message is pre-selected by the server based on” the claimed factors.

As explained above, Hays does not disclose pre-selected messages. Hays, instead, discloses that advertisements and associated messages are selected based on a weighting scheme relative to the weight of other advertisements—not the recited factors—even within a sub-channel.

Petitioner relies on paragraph [0042], which Petitioner identified for the first time in its Reply, and asserts that messages are pre-selected “based on ‘technical media formats’ compatible with a client type.” Reply, 6. But this is incorrect and entirely unsupported. Even so, approval of devices is not related to model type or any other recited factor. Accordingly, Hays does not teach that a “message is pre-

selected,” nor that any “message” or other content is selected based on the required factors.

C. Claims 9-16: Hays does not teach “pre-selected in-game video game content.”

Contrary to Petitioner’s assertion, the Petition does not address the requirement that the “in-game video game content” is preselected as recited in claim 9. Instead, and as Petitioner admits, it only refers back to claim 1 for its analysis. Reply at 7. But claim 1 does not recite this element. To the contrary, claim 1 recites “wherein *the message* is pre-selected by the server.” Thus, the Petition fails to carry its burden with respect to this claim element, and claim 9 and all of its dependent claims are patentable over Hays.

D. Claims 9-16: Hays does not teach “in-game video game content for use in a video game.”

Hays does not disclose sending in-game video game content for use in a video game. First, Petitioner attempts to equate unrelated sections of the ’056 Patent’s specification, citing to a discussion of updating a logo or a poster. *See* Reply, 7-8. But the neither the logo nor poster are actually used in the game. To the contrary, both are simply described as skins that are periodically updated. *See* Ex. 1001, 6:60-61. Dr. Akl’s testimony, is fully consistent with this explanation, “just having something on a shirt, and if we stop there and we don’t give any additional information, that is just content but that doesn't disclose for use yet.” Ex. 1020,

26:14-18. And the specification likewise consistently describes examples that are *for use* in the game, including for “newer mobile communication devices may be able to display elaborate content, so distinguishing among types of mobile communication devices may allow a game provider to maximize the experience on each type of mobile communication device.” Ex. 1001, 10:41-45.

Second, none of Petitioner’s examples from Hays suggests “in-game video game content for use in a video game.” For instance, Petitioner cites where Hays “send[s] bots or electronic agents into the game as advertising units or real characters in the game, which advertise or promote a product (e.g., a game character may move around a screen holding a can of Pepsi and ask player if they would like a drink).” Ex. 1005, [0079]. According to Petitioner, this includes the feature of “allowing the player to drink the advertised product.” Reply, 8. Yet nowhere does Hays include any suggestion that the player’s character has the option to drink any advertised product *in the game*, as opposed to suggesting the player do so in real life. Indeed, contrary to Petitioner’s suggestion, Hays never describes any interaction by the user with these “bots or electronic agents.” Instead, they act as non-interactive mobile advertisements. Finally, these “bots” are not received from a server, but rather are “advertising units,” which are already part of the game, as Hays describes. *See* Ex. 1005, [0018].

Petitioner goes on to cite another example of “a game character eating a brand name energy bar to boost her power in the game.” Reply, 8 (citing Ex. 1005, [0019]). But again it is the ad unit, the “pre-designated geometry within the game,” that is for use. Ex. 1005, [0018]. Hays does not describe that inclusion of an advertisement—i.e., the specific brand of energy bar—as modifying any functionality for use in the game. Ex. 2004, ¶63. Rather, the game operates in the same way whether the energy bar is blank, shows the branding of a known brand, or includes a fictional in-game brand. Ex. 2004, ¶176-78, 61-74.

For similar reasons Petitioner’s attempt to distinguish the claims from the Examiner’s analysis of Gatto during prosecution fails. *See* Reply, 9. The applicant argued that “[a] close reading of Gatto reveals that the ‘hyperlinks to download promotional items’ are, in fact, not usable in the so-called video game,” and “it would not make sense for an email to provide hyperlinks for content that is usable in the email itself.” Ex. 1002, 188, 189. Indeed, as Petitioner appears to acknowledge, “the problem with Gatto was that the updated content was not itself displayed within the email but instead linked by the email’s hyperlinks.” Reply, 9. Thus, the distinction with Gatto is the same as Hays, which as noted, provides “ad units,” which are “pre-designated geometry within the game,” at which linked advertising may be displayed. *See* Ex. 1005, [0018]. As with the hyperlinks in Gatto,

this advertising does not alter the functionality of the individual ad unit and, thus, is not “for use in a video game.”

E. Claims 4 and 12: Hays does not teach “identifying what in-game video game content to send” based on the claimed factors.

As explained in the Response, the Petition fails to establish that Hays meets this claim element. Response, 23-24. Apparently recognizing this deficiency, Petitioner reverts to entirely new disclosure in Hays, now citing to “GPS location.” See Reply, 10. But none of the Petition’s analysis addresses any disclosure of GPS location within Hays. See Petition at 24. The Board should reject this new argument.

F. Claims 5 and 13: Hays does not teach “send[ing] information [from the server] to the mobile communication device regarding the in-game placement location of the in-game video game content.”

Petitioner’s arguments ignore that the claim language expressly requires “*send[ing] information* [from the server] to the mobile communication device regarding *the in-game placement location of the in-game video game content.*” Nowhere does Hays disclose sending an in-game placement location of the in-game video game content to the mobile communication device.

Petitioner first urges, without citation, “the device still needs to know the in-game location to display the advertisement.” Reply, 11. But Hays does not disclose this. Indeed, Hays suggests the opposite, explaining that its ad server provides general advertisements to standardized locations, enabling them to be sent to “large

sets of available ad units from multiple game titles.” Ex. 1005, [0022]. Hays describes that “advertisement opportunities may be offered to advertisers based on *standardized available ad units*, which may include, for example signs (e.g., a billboard, poster, or other form of static sign *regardless of its location*).” Ex. 1005, [0073].

Thus, while Hays describes predesignated locations for “ad units,” it never discloses “*send[ing] information* [from the server] to the mobile communication device regarding *the in-game placement location of the in-game video game content*.” Ex. 2004, ¶¶165, 75-80. Petitioner’s citation to Dr. Zagal offers no help, as to the extent his conclusory parroting of the Petition is even accepted, his testimony never addresses the requirement that the in-game placement location be provided for the specific in-game video content. *See* Reply, 12 (citing Ex. 1003, ¶123).

G. Claims 7 and 15: Hays does not teach that “the server is further configured to track the distribution of updated content.”

Petitioner begins its argument by pointing to “frequency caps.” Reply, 12. PO did address this issue in the same discussion of recording advertisements delivered to a session. Response, 26-27 (citing Ex. 1005, [0045]). As explained, this ignores the claim’s requirement that the tracking is of what data has been “distribut[ed]” to the mobile communications device. This is not met by a session, which would at most only represent a portion of any data sent to a mobile communications device.

Ex. 1005, [0045]; Ex. 2004, ¶¶166, 93-97. Petitioner’s “active session database 124” example (Reply, 12) fails for similar reasons.

Petitioner moves on to examples that track a user’s reaction to an advertisement rather than tracking delivery and distribution of advertisements. Reply, 13 (citing Ex. 1005, [0025]). The examples of tracked information are “advertisement impressions (which quantify the presentation qualities—e.g., viewing angle, percent screen size, time on screen, etc.—of an advertisement as presented in any given instance).” Ex. 1005, [0025]. None of these meets the claim. Rather, they describe tracking user’s reactions to particular advertisements, which is irrelevant to distribution.

Finally, Petitioner goes on to state, “tracking ‘advertisement impressions’ includes when and how often an advertisement is uploaded.” Reply, 13 (citing Ex. 1003, ¶131). Notably, the cited section of Dr. Zagal’s declaration says nothing of “when” or “how often” advertisements are distributed, and Hays never suggests that such information is tracked or would even need to be tracked.

H. Claims 8 and 16: Hays does not teach that “the server is further configured to check for availability of bandwidth before sending the updated content to the mobile communication device.”

Hays does not disclose that “the server is further configured to check for availability of bandwidth before sending the updated content to the mobile communication device.” As with the Petition, the Reply ignores that this claim

requires expressly “check[ing] for availability of bandwidth” and instead tries to equate this to sending or downloading content “when bandwidth is available.” Reply, 13-14. The two are not the same. The claim requires checking for availability of bandwidth and *subsequently* sending the updated content. Hays only describes downloading data when the client or console is connected to a server (*see* Ex. 1005, [0021], [0034]) but does not teach “checking for availability of bandwidth.”

Petitioner also urges that this could be accounted for with “the relevant knowledge and ordinary creativity of a POSITA,” (Reply, 14) but Petitioner fails to cite *any* evidence reflecting the knowledge of a POSITA..

IV. GROUND 2: PETITIONER FAILS TO CARRY ITS BURDEN OF ESTABLISHING THAT HAYS COMBINED WITH CHOI RENDERS CLAIMS 1-16 OBVIOUS.

A. Claims 1[e] and 9[d]: The Hays-Choi combination does not teach or suggest that “the message is pre-selected by the server based on” the claimed factors.

For the reasons explained above, Hays fails to teach that “the message is pre-selected by the server based on” the claimed factors, and Choi does not cure this deficiency.

Petitioner asserts that Choi “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.” Reply, 14. Choi, like Hays, however, only describes ad targeting or ad selection, which Petitioner admits. Petitioner

explains that “Choi expressly teaches *targeting ads* based on ‘user demographics,’ which may be inferred from ‘a users’ carrier.’” Reply, 15 (quoting Ex. 1006, [0083]). Choi does not explain how a user’s carrier could be used to select a message. More importantly, Choi does not describe how that information could be used to pre-select a message. Indeed, Choi does not describe how any advertisement or message is *pre-selected*.

Thus, the combination of Hays and Choi fails to render claim 1 or 9 obvious.

B. Claims 9-16: The Hays-Choi combination does not cure the deficiencies in Hays.

Just as in Ground 1, the Reply does not bolster any of the analysis of claim 9, nor address the elements claim 9’s requirement of “pre-selected in-game video game content for use in a video game.” The Hays-Choi combination fails for this additional reason. *See* Ex. 2004, ¶187.

C. Claims 4 and 12: The Hays-Choi combination does not teach or suggest that “identifying what in-game video game content to send is based on” the claimed factors.

As discussed above, Hays does not meet this element. Choi describes the importance of ad targeting and demographic information. Ex. 1006, [0083]. This is irrelevant to the claimed factors. Petitioner urges that if a user’s carrier is determined, this can be used to determine demographic information. Reply, 16. At most this suggests targeting advertisements based on demographic information, which is irrelevant to the claim. Similarly, as explained above, Petitioner’s new reliance on

GPS location is found nowhere in its analysis of this limitation in the Petition. *See* Petition at 39. Such new arguments should be rejected.

Choi does not cure Hays's deficiency and thus this combination necessarily fails to disclose claims 4 and 12. Petitioner does not attempt to show that Choi cures any other deficiency discussed above.

D. Petitioner Does Not Establish that a POSITA Would Combine Hays and Choi.

Petitioner never establishes a motivation to combine Hays and Choi. First, Dr. Zagal's testimony cannot provide such a motivation as his purported testimony on this score is a word-for-word copy of the Petition. *Compare* Ex. 1003, ¶¶137-47 with Petition, 32-36; *see Xerox Corp.*, IPR2022-00624, Paper 9, at 18. Second, the Reply attempts to cite to cases regarding disadvantages, without applying them to any particular reasoning given by PO. The Response provided a detailed explanation of why references would not be combined including that there is no basis to apply Hays's method for sending advertisements to multiple games with Choi's system for specific demographic targeting. Further, Petitioner again misreads the claim language suggesting that a POSITA would modify Hays to use predicted demographic information. *See* Reply, 16. But as explained, this is irrelevant to the claim language, which does not recite demographic information.

V. GROUND 3: PETITIONER FAILS TO CARRY ITS BURDEN OF ESTABLISHING THAT HAYS COMBINED WITH CHU RENDERS CLAIMS 5 AND 13 OBVIOUS.

A. Claims 5 and 13: The Hays-Chu combination does not teach or suggest that “the server is further configured to send information to the mobile communication device regarding the in-game placement location of the in-game video game content.”

Chu makes clear that its system transmits the location of an advertisement to the server. *See* Ex. 1007,14:31-33 (“*game clients must pass the server information* such as but not limited to *the location identifiers* that uniquely identify an ad within a game....”). Petitioner acknowledges as much in citing a different section of Chu. Reply, 17 (citing Ex. 1007, 14:47-15:5).

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

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

```
530 - <Location>
      <ID>2147483647</ID>
      <Name>Engine Oil Pitstop</Name>
    </Location>
```

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

```

500 - <?xml version="1.0" encoding="UTF-8" ?>
500 - <CampaignListing xmlns:xsi="http://www.w3.org/2001/XMLSchema-instance"
500 -   xsi:noNamespaceSchemaLocation="CampaignListing.xsd">
510 -   <Campaign>
510 -     <ID>2147483647</ID>
520 -     <AdListing interval="30">
520 -       <Ad>
520 -         <ID>2147483647</ID>
520 -         <Type>image</Type>
520 -         <Width>200</Width>
520 -         <Height>200</Height>
520 -         <Media>/advertising/media/2147483647.jpg</Media>
525 -       </Ad>
525 -       <Ad>
525 -         <ID>2147483648</ID>
525 -         <Type>video</Type>
525 -         <Width>200</Width>
525 -         <Height>200</Height>
525 -         <Media>/advertising/media/2147483648.jpg</Media>
525 -       </Ad>
525 -       <Ad>
525 -         <ID>2147483648</ID>
525 -         <Type>image</Type>
525 -         <Width>200</Width>
525 -         <Height>200</Height>
525 -         <Media>Penzoil engine go. Go with the best!</Media>
525 -       </Ad>
525 -     </AdListing>
530 -   </Campaign>
530 -   <Location>
530 -     <ID>2147483647</ID>
530 -     <Name>Engine Oil Pitstop</Name>
530 -   </Location>
530 - </Campaign>
530 - </CampaignListing>
```

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

Petitioner also asserts that “Figure 5 further shows that the server “[r]eturn[s] *campaign metadata*,” which includes the location.” Reply, 17 (no cite). To the

contrary, Figure 5 is never described in Chu, but on its face shows that the client identifies and specifies the location the advertisements. Ex. 1007, Fig. 5.

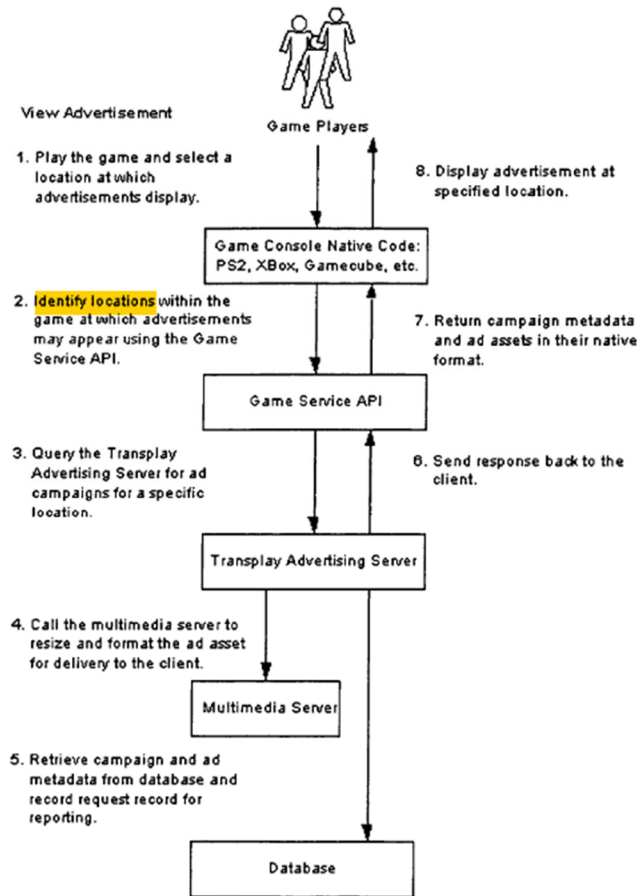


Fig. 5

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

Nor would it make sense for the server to send location information in a system like Chu, in which the client requests specific advertisements and identifies the location in advance. *See* Ex. 2004, ¶¶111-13. Petitioner seems to acknowledge as much, stating as a motivation to combine that “Hays discloses that ad units are found

in certain locations within the game,” and Chu would “provid[e] a location to specify the ad unit.” Reply, 18. To the extent this is correct, it proves the PO’s argument—Chu is providing advertising at a location specified by the mobile device, i.e., the ad unit. There is no need for the server to specify a location.

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

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

Petitioner’s motivation to combine relies almost entirely on the misreading of Chu explained above and fails for this reason. Further, Petitioner urges that PO “grossly mischaracterizes Hays,” in explaining that advertisements in Hays are not fixed to a specific location. Reply, 19. Putting aside the unnecessary rhetoric, Hays is agnostic to location to achieve its goal of enabling “advertisers to deliver their campaign messages to specific audiences they wish to target across one or multiple game titles played across multiple platforms (e.g., PC, console, mobile, etc.) without being limited to delivering their campaign to only a single specific game title.” Ex. 1005, [0017]. To achieve this goal, a POSITA necessarily would not modify Hays

based on a system that identifies specific advertising locations to the server, as Chu teaches. *See* Ex. 2004, ¶202, 108-14.

VI. GROUND 4: PETITIONER FAILS TO CARRY ITS BURDEN OF ESTABLISHING THAT LEVKOVITZ RENDERS CLAIMS 1-16 OBVIOUS.

A. Claims 1[e] and 9[d]: Levkovitz does not teach “wherein the message is pre-selected by the server....”

Levkovitz does not teach that “the message is *pre-selected* by the server.” Petitioner alleges that Levkovitz’s “presentation rules” are pre-selected. Reply, 19. But Levkovitz describes that these are rules for presenting advertisements. This is irrelevant to the claim element.

Petitioner asserts that Levkovitz’s association of a presentation rule with a particular content item indicates that the content item is preselected. Petitioner cites no evidence for this argument. Nor could it. Levkovitz, separately, describes parameters related to a mobile phone (Ex. 1008, [0006]), different versions of content items (*id.*, [0030]), and searching for advertisements in a repository in response to a request. Levkovitz explains that the selection may be based on properties of the device, but again, there is no disclosure that the advertisements are pre-selected. Petitioner merges each of these disclosures together in an attempt to allege that Levkovitz describes “pre-select[ion],” but this is not taught by Levkovitz and Dr. Zagal does not cure this deficiency.

Without any support, Petitioner further alleges that “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.” Reply, 20. This is false. PO explained in the Response how nothing in Levkovitz teaches “pre-select[ing]” a message or advertisement.

Thus, Levkovitz fails to teach “wherein the message is pre-selected by the server....”

B. Claims 9-16: Levkovitz does not teach “pre-selected in-game video game content.”

Contrary to Petitioner’s assertion, Petition does not address the requirement that the “in-game video game content” is preselected as recited in claim 9. Instead, and as Petitioner admits, it only refers back to claim 1 for its analysis. Reply, 20. But claim 1 does not recite this element. To the contrary, claim 1 recites “wherein *the message is pre-selected* by the server.” Thus, the Petition fails to carry its burden with respect to this claim element, and claim 9 and all of its dependent claims are patentable over Levkovitz.

C. Claims 9-16: Levkovitz does not teach “in-game video game content *for use in a video game.*”

Petitioner does not address that Levkovitz provides nothing more than a banner ad within a game. Such a banner ad is necessarily not for use in a video game. Petitioner instead suggests that PO has proposed some alternative meaning of “use.”

Reply, 21. But Petitioner bears the burden here and never proposed any meaning of “for use in a video game” *at all*, much less a meaning that would somehow encompass the display of a banner ad. As explained, a banner ad is not even a part of the game, much less usable in the game. Response, 42-45; Ex. 2004, ¶¶221-223.

Petitioner’s attempt to distinguish the prosecution history and the Examiner’s analysis of Gatto similarly fails. Reply, 21. Petitioner tacitly acknowledges that Levkovitz simply displays advertisements. Reply, 21; *see also* Ex. 1008, [0005] (discussing Levkovitz’s “placement of content, e.g., *advertisements or banners*, within an application executed by a cellular phone, a mobile phone, or other wireless communication device.”). This does not meet the claim, thus all grounds based on Levkovitz fail.

D. Claims 5 and 13: Levkovitz does not teach “send[ing] information [from the server] to the mobile communication device regarding the in-game placement location of the in-game video game content.”

Levkovitz does not disclose or suggest “send[ing] information to the mobile communication device regarding the in-game placement location of the in-game video game content.” Petitioner suggests that “the size of an advertisement does affect which pixels on the screen will display the advertisement, *i.e.* the location of the advertisement.” Reply, 22. But Levkovitz never suggests that the size of an advertisement is related to its placement location. Nor does Petitioner explain a relationship between size and placement location.

E. Claims 7 and 15: Levkovitz does not teach “the server is further configured to track the distribution of updated content.”

Petitioner again fails to grapple with the distinction PO drew in the Response—Levkovitz does not track content that has been distributed. Ex. 1008, [0132]. Petitioner does not address the distinction between tracking presentations versus tracking “distribution.” As explained, tracking presentations does not meet the claim. Content may be distributed or uploaded to a device but never presented. *See* Ex. 2004, ¶¶210, 135.

Petitioner attempts to present a faulty argument based on claim construction to suggest that “the claims are disclosed as long as the prior art teaches tracking of at least one uploaded updated video-game content.” Reply, 23. But Petitioner ignores that the claim language does not read “tracking whether videogame content has been uploaded.” Instead, the claim requires “track[ing] the distribution of updated content,” which is not shown by Levkovitz.

Finally, Petitioner again attempts to flip the burden to PO to cite something in Levkovitz “that indicates a content item is uploaded but not presented.” First, this is improper burden shifting. Second, as explained above, Levkovitz does not distribute anything, rather it presents advertisements via WAP. This is confirmed by the cite Petitioner provides which describes an advertisement “directed for presentation,” which is irrelevant to “tracking *the distribution* of updated content,” as the claim requires. Reply, 23 (citing Ex. 1008, ¶127).

F. Claims 8 and 16: Levkovitz does not teach “the server is further configured to check for availability of bandwidth before sending the updated content to the mobile communication device.”

Levkovitz does not disclose that “the server is further configured to check for availability of bandwidth before sending the updated content to the mobile communication device.” Petitioner urges that Levkovitz teaches this step by “correlat[ing]” “functional capabilities” “about the device,” but this does not relate to “check[ing] for availability of bandwidth.” Reply, 23. And, contrary to Petitioner’s assertion, Dr. Zagal does not explain how “‘functional capabilities’ of the device include available bandwidth.” Reply, 23 (citing Ex. 1003, ¶204).

VII. GROUND 5: PETITIONER FAILS TO CARRY ITS BURDEN OF ESTABLISHING THAT LEVKOVITZ COMBINED WITH CHU RENDERS CLAIMS 5 AND 13 OBVIOUS.

As explained in Section V *supra*, Chu does not teach sending an in-game placement location to the mobile communication device as part of the updated content. At most it discloses the opposite—sending a placement location from the mobile device to the server. Petitioner presents no evidence, in the form of testimony or otherwise, to establish that this is incorrect. Petitioner similarly fails to shoulder its burden of establishing a motivation to combine Levkovitz and Chu. *See* Response, 48-51. Dr. Zagal’s testimony is of no help as he simply parrots the Petition. *Compare* Petition at 54-56 *with* Ex. 1003, ¶¶206-11.

VIII. GROUND 6: PETITIONER FAILS TO CARRY ITS BURDEN OF ESTABLISHING THAT LEVKOVITZ COMBINED WITH CHOI RENDERS CLAIMS 8 AND 16 OBVIOUS.

As discussed in the Response, and as discussed above, Levkovitz fails to disclose many elements of claims 1 and 9. The Petition focuses on Choi's discussion of checking bandwidth, but never establishes that Choi would cure any other deficiency. Choi does not and cannot cure any other deficiency of claims 1 and 9, and thus claims 8 and 16, which depend from and further limit claims 1 and 9 are patentable for at least the same reasons.

IX. HAYS AND CHOI ARE NOT PRINTED PUBLICATIONS UNDER 35 U.S.C. § 311(b)

As discussed in the Response, Hays and Choi are not "prior art consisting of patents or printed publications" under § 311(b) and are therefore ineligible to be prior art in this proceeding. Response at 56-58. Petitioner suggests only that PO's "argument has been repeatedly rejected by the Board as well as the Federal Circuit." Reply, 26. Prior agency decisions, however, are not afforded any deference on this question of statutory interpretation. *See Loper Bright Enters. v. Raimondo*, No. 22-451, 603 U.S. ____ (June 28, 2024). And the Federal Circuit recently heard oral argument on this question of statutory interpretation in *Lynk Labs, Inc. v. Samsung Electronics Co.*, Appeal No. 23-2346, with an opinion yet to issue.

Finally, Petitioner offers a last-ditch suggestion that "Hays claims priority to a PCT application." To the extent this is correct, Petitioner did not rely on that

priority application in the Petition or cite to it as disclosing any claim element. Petitioner's attempt to rely upon the PCT Application on Reply is improper. And even if this argument were properly presented, Petitioner does nothing to establish that this PCT Application meets any claim element or supports any disclosure within the actually relied upon Hays reference, which as discussed, is not itself prior art. *See Reply*, 26.

X. PO'S SECONDARY CONSIDERATIONS STAND UNREBUTTED.

Petitioner offers no evidence or argument in response to the Secondary Considerations of Non-Obviousness, including long-felt need for the invention (Response, 53-55) and teaching away (*id.* 54-55). To the contrary, Petitioner attempts to conflate console games and mobile games, suggesting that the existence of console updates suggests that there was no long felt need. First, this ignores the claim language. Second, as Dr. Akl explains, in 2007 consoles already had extensive processing and memory capabilities (Ex. 2004, ¶43) “in contrast, due to the much more limited processing, storage, and data bandwidth capabilities of mobile devices, the only option available for mobile games, at that time, was to download an entire new game.” *Id.* ¶44. This testimony stands unrebutted by any credible evidence.

Petitioner does not address teaching away at all. Thus, this stands unrebutted. Further, Petitioner offered no evidence or argument in response to PO's explanation

of the state of the art, which necessarily informs the obviousness analysis. Response 5-10. This un rebutted evidence further confirms non-obviousness.

XI. CONCLUSION

Petitioner fails to shoulder its burden of establishing that Claims 1-16 are unpatentable.

Dated: December 13, 2024

Respectfully submitted,

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CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24(d), the undersigned certifies that this Sur-Reply contains 5,575 words according to the word-processing program used to prepare this paper. The foregoing word count complies with the 5,600 word type-volume limit specified by 37 C.F.R. § 42.24(b)(1).

Dated: December 13, 2024

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CERTIFICATE OF SERVICE

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