

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

Inter Partes Review No.
IPR2024-00200
Patent No. 11,117,056

PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW

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I. Introduction

Patent Owner Flip Phone Games, Inc. (“FPG”) seeks director review of the portion of the Final Written Decision (Paper 30) (“FWD”) finding claims 9-16 of the ’056 Patent unpatentable. The Petition did not separately address the elements of claims 9-16, which materially differ from claims 1-8. The Board overlooked this as merely an “imprecise cross-reference to claim 1” (FWD at 21) and performed its own substantive analysis since none was in the Petition. Petitioner cannot have met its burden to show unpatentability when it did not address multiple claim elements.

In addition to this error, the Board construed claim 9 to ignore requirements that the “pre-selected in-game video game content” be both sent to the device and for use in a video game. The Board’s construction included terms found only in the prior art, which led the Board to a faulty conclusion of obviousness. Finally, the Board improperly credited Petitioner’s expert declaration, which merely parroted the Petition. The Director should reverse and confirm patentability of claims 9-16.

II. Legal Standard for Director Review

“Requests for Director Review of a Board’s final decision under 35 U.S.C. §§ 135, 318, or 328, ... shall be limited to decisions presenting (a) an abuse of discretion, (b) important issues of law or policy, (c) erroneous findings of material

fact, or (d) erroneous conclusions of law.” Director Review Process, § 2(B).¹

“Decisions of the Board under Director Review are reviewed *de novo*.” *Id.* at § 5(A)(ii)(c). The erroneous findings of fact and conclusions of law in the FWD should be reversed.

III. Argument

A. The Board Erred by Ruling that Elements of Claims 9-16, which the Petition Failed to Address Were Nevertheless Found in Hays.

Claims 9-16 recite elements not found in claims 1-8, yet the Petition did not separately address these claims. Petitioner necessarily could not have met its burden of demonstrating unpatentability of these claims since it did not address all of their elements. The Board erred in filling in the Petition’s gaps, which the Board did by addressing claim 9 before claim 1, despite that the Petition’s analysis of claim 9 merely refers back to claim 1. The Board improperly took upon itself Petitioner’s burden of proving invalidity.

i. Claim 9[a] Requires “Storing ... *Pre-Selected In-Game Video Game Content for Use in a Video Game*.”

Claim 1[a] requires only “a storage medium for storing in-game video game content.” But Claim 9[a] further requires that the “in-game video game content” is “pre-selected in-game video game content *for use in a video game*.” The Petition does not address this additional requirement at all, instead simply referring back to

¹ <https://www.uspto.gov/patents/ptab/decisions/director-review-process>

element 1[a], without further analysis. *See* Petition at 30. And while the Petition included some limited analysis of use—which as explained was incorrect—it did not address pre-selected with respect to element 1[a]. *See* Paper 2 at 14-15.

The Board ignored the actual cross-reference in the Petition and instead pointed to an entirely different section, addressing an entirely different claim element and urged that “Petitioner cites Hays’s disclosure of ad targeting in support of its argument that ‘Hays discloses that the advertisements are *pre-selected*.’” FWD at 18 (citing Paper 2 at 20).² But that page of the Petition relates to element 1[e], which does not require “pre-selected in-game video game content for use in a video game,” as is required by claim 9[a]. To the contrary, that element references a pre-selected message. *See* claim 1[e] (“send a message relating to the in-game video game content to the mobile communication device ... wherein *the message is pre-selected by the server*.”). Thus, contrary to the Board’s findings in the FWD, the Petition never addressed the full scope of claim 9[a].

ii. Claim 9[c] Requires “Identifying ... what *Pre-Selected In-Game Video Game Content to Send*.”

Claim 1[d] requires only “identify, in response to receiving the request, what in-game video game content to send.” But Claim 9[c] further requires identifying “what *pre-selected* in-game video game content to send.” As with the element

² All emphasis added unless otherwise noted.

above, the Petition does not address pre-selected at all in discussion of claim 1[d] (see Paper 2 at 16-17), which is the only element to which the Petition refers in its analysis of claim 9[c]. See Paper 2 at 30. Rather, the Petition excludes “pre-selected” from its analysis urging “Hays discloses that the server is configured to identify, in response to receiving the request, what in-game video game content to send.” *Id.* at 17. Thus, contrary to the Board’s findings in the FWD, the Petition never addressed the full scope of claim 9[c].

iii. Claim 9[e] Requires “Sending ... the *Pre-Selected* In-Game Video Game Content to the Mobile Communication Device.”

Claim 1[f] requires only “send the in-game video game content to the mobile communication device as the updated content for the mobile video game.” But Claim 9[e] further requires sending “*pre-selected* in-game video game content.” As with the element above, the Petition does not address pre-selected at all in discussion of claim 1[f] (see Paper 2 at 21-22), which is the only element to which the Petition refers in its analysis of claim 9[e]. See Paper 2 at 30-31. Rather, the Petition excludes “pre-selected” from its analysis urging “Hays discloses that the advertisement is updated content for the mobile video game, because when the advertisements are sent, they are presented on the mobile communications device.” *Id.* at 22. Thus, contrary to the Board’s findings in the FWD, the Petition never addressed the full scope of claim 9[c].

iv. The Board Cannot Cure the Petition’s Deficiencies.

Contrary to the Board’s urging, the shortcomings in the Petition are more than an “imprecise cross-reference to claim 1.” FWD at 21. Claims 1 and 9 recite fundamentally different limitations. Critically, the Petition’s analysis of a “message is preselected by the server” in element 1[e] is irrelevant to the claim’s additional requirement that the *in-game videogame content* is also pre-selected. Claim 9 recites *both* “pre-selected in-game video game content for use in a video game” (claims 9[a], 9[c], and 9[e]) and also a “message is preselected by the server,” (claim 9[d]). These claim elements—the pre-selected message and the pre-selected in-game video game content—presumptively have different meanings. *CAE Screenplates Inc. v. Heinrich Fiedler GMBH & Co.*, 224 F.3d 1308, 1317 (Fed. Cir. 2000) (“In the absence of any evidence to the contrary, we must presume that the use of these different terms in the claims connotes different meanings.”). It was legally improper for the Board to fill the plain gaps in the Petition’s analysis and interpret both of these elements in view of the same argument and disclosure.

B. The Board Erred in Its Analysis of “Pre-Selected.”

The Board further erred in its analysis of claims 9-16 through its improper interpretation of “pre-selected.” The Board applied what it urged was FPG’s definition of the term pre-selected, characterizing that as “some sort of selection

that is more than merely storing data before an eventual selection of data to send in response to receiving a request for updated content.” FWD at 14.³

The Board applies this construction to find that Hays discloses pre-selection through its disclosure of targeting via sub-channels. *See* FWD at 21-22. But Hays’s sub-channels are not “pre-selected in-game video game content,” as claim 9 requires. As discussed above, the Petition did not apply Hays in this way. Indeed, the only discussion of channels or sub-channels in the Petition is with respect to claim 1[e], which as explained relates to a message that is pre-selected, and not “pre-selected in-game video game content.” *See* Paper 2 at 20.

Further, 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 describes dividing the games and available spaces by genre into sub-channels. But this does not select, much less pre-select advertising.

³ The Board further errs in critiquing FPG’s discussion of indexing during oral argument. FWD at 15. But Petitioner too never raised indexing in briefing.

The Petition describes that a sub-channel includes “genre such as sports titles ..., children’s titles, racing titles, etc.,” or “may subtarget by time of day (e.g., deliver advertising to all gaming devices playing at 8 p.m. on Thursday) or by game play date (e.g., once the game has been played for 45 minutes—air the Domino’s ad campaign, or in the fourth inning of the sports title, air the XYZ campaign).” Paper 2 at 20 (citing Hays, [0022]). The Petition’s analysis makes clear that the targeting is not a selection of an advertisement, but rather the selection of a channel (e.g., a time of day, or type of game) in which advertisements are displayed. This does not disclose pre-selection of advertisements, much less in-game video game content.

C. The Board Erred in Finding Claim 9 “Does Not Require an Interactive Object or New Ad Unit that is Inserted into an Existing Game that Alters the Function of the Game”

i. The Board’s Construction Ignores that the Claim Requires Sending the Pre-Selected in-Game Video Game Content for Use in a Video Game.

Claim 9 further requires “storing, on a storage medium, pre-selected in-game video game content *for use* in a video game.” The Board analyzed this phrase in its claim construction section. *See* FWD at 6-13. Therein the Board made clear that it construed this phrase: “[w]e address these claim construction disputes below to the extent necessary and determine that no other terms require express construction.” *Id.* at 7. Despite the Board calling its analysis a construction, the Board simply

broadened the claims to ignore the “for use” term and read on prior art. Indeed, while the plain language of the claims requires receiving pre-selected in-game video game content that is “for use,” the Board’s “construction” excludes these requirements. *Id.* at 13. Further, the Board interprets the claims using terms such as “ad unit” found nowhere in the intrinsic record and only in the cited prior art. The Board’s construction defines not what the claims cover, but rather what the claims “do not require.” *Id.* (the claims “***do not require*** an interactive object or new ad unit that is inserted into an existing game that alters the function of the game.”).

As explained, this flawed construction necessarily conflicts with the plain meaning of the claims and should be rejected.

ii. The Plain Meaning of “For Use in a Video Game.”

The Board excluded the plain meaning of “for use” as recited by the claim and described in the specification and instead defined “for use” to include any content at all. The Board first cites to an example from the specification describing different types of updates. FWD at 9-10 (quoting Ex. 1001, col. 6:44-52). The Board urges that “[t]hese are examples of updated video-game content (updated advertisements on posters, T-shirts, and chalk boards) that are usable (e.g., by the game or mobile communication device executing the game) in a video game that already exists on the mobile communication device.” *Id.* But this passage does not

include any conjugation of the verb “use” at all, and never suggests the T-shirt or poster are used or usable in the game.

Elsewhere the specification highlights content that is both updated and *usable* in the game as the claim requires. In addressing usable content, the specification describes “new weapons, interactive characters, levels, hot spots, and other items may be provided as part of the update. In short, any content element *used* in the mobile video game may be updated, depending on the embodiment.” Ex. 1001, col. 7:10-13. The Board discounted this example, saying that it “makes clear that ‘[o]ther content of the mobile video game, such as the shape, design coloring of dartboard 210 or the texture or coloring of background 215’ falls within ‘any content element used in the mobile video game.’” FWD at 14. The Board reads out the full context of the paragraph suggesting that “used” in the final sentence encompasses any content throughout the paragraph. But nothing in the cited paragraph provides such a definition of “use,” and the second sentence plainly identifies content used by the player, e.g., “new weapons, interactive characters, levels, hot spots.” This aligns with purpose of the invention: “keep[ing] game elements fresh and prolong user enjoyment of the game.” Ex. 1001, 4:36-37.

iii. The Board’s Construction Discounts the Prosecution History.

The Board also discounted arguments during prosecution of the parent that shed further light on the meaning of “use.” FPG explained that to overcome a

rejection based on U.S. Pub. No. 2004/0127279 to Gatto (“Gatto”), the applicant distinguished Gatto’s description of items available for download via a hyperlink as not “usable” in the game. Ex. 2002 at 188, 189. The Board reviewed these statements and found “the applicant distinguished Gatto because Gatto’s promotional content did not appear in the email that the Examiner alleged was a video game.” FWD at 15. The Board’s conclusion ignores that the prosecution history makes clear the meaning of usable in the video game, i.e., “[t]he available hyperlink ... causes the download of an entirely separate program or Internet page.” Ex. 2002, at 142. In other words, content usable in the game is content that provides additional gameplay functionality, such as new weapons, interactive characters, levels and hot spots.

iv. The Board’s Construction Improperly Defines the Scope of the Claims Using Terms Found Only in Hays.

The Board’s construction further errs in that it expressly relies upon phrases not found anywhere in the claims or the specification—such as “interactive object or new ad unit.” While not used by the ’056 Patent at all, “ad unit” is a term detailed throughout Hays. As explained below, Hays does not describe the “ad unit,” as something that is transmitted as updated in-game video game content. Thus, even if it were somehow proper to include it in the Board’s construction, this term is not relevant to the claims, which require sending the updated video-game content to the mobile device. The Board’s inclusion of terms from the prior art in

the construction further demonstrates the improper lens through which the Board construed the claims.

D. Hays’s Interactive Ad Units Are Not “Pre-Selected In-Game Video Game Content for Use in a Video Game”

The Board relies heavily on a single description in Hays of ad units that are “interactive.” FWD at 26 (citing Hays, [0019]). In reality, this paragraph of Hays describes “[s]ome available ad units may be interactive within the game (e.g., a game character eating a brand name energy bar to boost her power in the game, a brand-related ‘mini game’ presented between levels, a click-through advertisement, etc.) and may bring aspects of the real world into the game (e.g., a player can enter a code from a product to provide advantages in the game).” Hays, [0019]. None of these meets the requirements of the claim.

First, Hays describes that the ad unit is already in the game. *See* Hays, [0018] (“the advertisement delivery scheme and associated facility present advertisements as texture maps or other graphical displays (e.g., animations, video, etc.) on pre-designated geometry within the game ... [e]ach of these spaces may be termed an ‘available ad unit’”); [0019] (“[w]hen a game is shipped, it may have a fixed set of available ad units”); [0074] (“The use of standardized available ad units facilitates the sale of advertising that spans across multiple games/titles because one advertisement can fit into many available ad units of a standard advertisement unit type.”). Thus, the ad unit necessarily cannot be the “pre-

selected in-game video game content for use in a video game,” because the ad unit is not pre-selected and transmitted to the device.

Second, that the “ad unit” includes an energy bar does not alter this conclusion. Hays makes clear that the “items used by game characters (e.g., a brand name soft drink or energy bar) ... may be termed an “available ad unit.” Hays, [0018]. Thus, the energy bar itself is already in the game at the time of installation. The only thing that may change is the branding of the energy bar, as Hays describes “advertisement opportunities may be offered to advertisers based on standardized available ad units, which may include, ... packaging (e.g., packaging for products within the game such as cans, wrappers, bags, etc.” Hays, [0073]. This is further confirmed by Hays, Figure 6, which shows “a sample insertion order for selling advertisements space in association with the advertisement delivery scheme and associated facility.” *Id.*, [0010]. That the label on this packaging is updated does not alter anything in the game. Put another way, the “energy bar” provides the same benefits to the player regardless of whether it is blank, displays a real brand, or displays a fictional in-game brand. And the specification of the ’056 Patent provides a similar example, which it does not describe as usable. Ex. 1001 at col. 5:10-12 (“in a previously-released game, a bar scene might be filled with updated bottles that show a company logo not present at the time of the game’s launch.”)

The other two examples, “a brand-related ‘mini game’ presented between levels” and “a click-through advertisement,” similarly fail to meet the claims. The mini game is never described as sent to the game. *See* Hays, [0078]. Thus, it is not “updated video-game content being usable in the video game,” as the claims require. And this is exactly the embodiment in Gatto that the Applicant distinguished during prosecution, as discussed above. *See* Ex. 1002 at 188-189. Similarly, “a click-through advertisement,” is simply an advertisement, not “updated video-game content being usable in the video game.”

E. The Pepsi Can Example in Hays Is Not “Pre-Selected In-Game Video Game Content for Use in a Video Game”

The FWD also relies extensively on Hays’s description of an in-game character with a Pepsi can. FWD at 27-28. The full example is in Hays, [0079]. But the Pepsi graphic itself is, like the energy bar example above, just a skin placed on the ad unit associated with the can. The ad unit itself is the only element that may be functional, and there is no relevant difference between whether the can is blank, says Pepsi, or has an entirely different branding.

The Board claimed instead that “the service system inserts more than a skin; it inserts a bot or agent that was not part of the game before its insertion.” FWD at 27. But Hays never describes that “the bot or agent ... was not part of the game before its insertion.” *Id.* It merely says that the “system” (which includes the ad units in the game from the start) sends the bots or agents. Even if the Board were

correct, Hays never once describes that the bot or agent is itself transmitted from a remote device. At most the bot or agent is controlled by “the advertisement management service system 108,” but that is not sufficient because the claim requires “sending, from the server, the pre-selected in-game video game content to the mobile communication device.”⁴

Hays elsewhere makes clear that the Pepsi can is just like the energy bar example discussed above. Hays paragraph [0058] describes the Pepsi can as part of the insertion order described in Figure 6. *See* Hays, [0058]. This insertion order references the “Logo” or “Packaging” of the particular “Ad Unit” (624), and in this example Hays plainly contemplates the logo being either “Coke” or “Pepsi,” but never contemplates a different outcome based on that label. Hays, FIG. 6. And, as explained, Hays makes clear the “ad unit” is already placed within the game, and thus regardless of whether it is interactive, the ad unit itself cannot be the claimed “updated video-game content.”

Thus, like the energy bar example, Hays’s Pepsi can meets the claims only under the Board’s improper construction (*see* FWD at 25) which, as discussed, the Board tailored not based on the intrinsic record, but to capture Hays.

⁴ Contrary to its criticism, the Board’s reliance on these bots as “ad units” makes clear that they were already in the game. *See* Hays, [0018].

F. The Board Erred in Crediting Dr. Zagal's Testimony Where Dr. Zagal Parroted the Petition.

Dr. Zagal's testimony should be afforded no weight. *See, e.g.*, Paper 12 at 14-15, 18, 25. Dr. Zagal's declaration is largely, and in some sections entirely, a word-for-word copy of the original Petition. This is particularly so with the elements above. *Compare* Petition at 18-21 (addressing element 1(e)) *with* Ex. 1003, ¶¶101-107. Thus, the declaration should be afforded no weight, and the FWD improperly relied upon Dr. Zagal. *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9, at 18 (PTAB Aug. 24, 2022) (precedential); *TQ Delta, LLC v. Cisco Sys., Inc.*, 942 F.3d 1352, 1361 (Fed. Cir. 2019).

The Board did not address this at all in the FWD and only addressed FPG's arguments regarding the appropriate weight to afford Dr. Zagal at institution by saying "we find that the assertions in the Petition are sufficiently supported by the teachings of Hays." Paper 9 at 18. Even if this is correct, it does not excuse reliance on a declaration that adds no further analysis. The Board erred in considering Dr. Zagal's declaration and affording it weight. *Xerox*, IPR2022-00624, Paper 9, at 18

IV. Conclusion

In view of the foregoing, FPG respectfully requests that the Director reverse the Decision and confirm the patentability of the claims 9-16 of the '056 Patent.

Dated: May 23, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW** has been served via email on the following:

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