

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. IPR2024-00209

Patent No. 9,427,662

PATENT OWNER'S PRELIMINARY RESPONSE

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EXHIBIT LIST

Exhibit	Description
2001	Playrix's Exchange of Proposed Terms and Claim Elements for Construction, served January 30, 2024
2002	U.S. Publication No. 2006/0205510 to Lauper et al. ("Lauper")

I. INTRODUCTION

Patent Owner Flip Phone Games, Inc. (“FPG” or “Patent Owner”) submits this Preliminary Response to Petitioner PLR Worldwide Sales Limited’s (“Playrix” or “Petitioner”) petition for *inter partes* review (“the Petition”) of U.S. Patent No. 9,427,662 (“the ’662 Patent”).

The Petition ignores that the ’662 Patent claims priority to mid-2007—before the release of any modern smartphone—and describes and claims, what was at the time, a novel and unconventional way of updating in-game content for video games on mobile devices. The ’662 Patent provides “hot spots” and updates in-game “hot spot” information. For example, new interactive items and/or hidden features may be placed within a particular scene in a game so that the user has something new to look at or trigger. Features of this type were revolutionary and changed the face of mobile gaming because developers could provide keep game elements fresh to drive user engagement, without forcing users to purchase a new game.

The application underlying the ’662 Patent proceeded through substantial prosecution through which the Examiner confirmed the claims that ultimately issued were novel over the art relied on, cited, or identified during prosecution. The Petition ignores this fact and the similarities between the prior art presented during prosecution and the prior art presented in the Petition—as well as the fundamental differences between the prior art presented in the Petition and the claims of the ’662

Patent. Instead, the Petition attempts to broaden the claims of the '662 Patent in this forum to cover any game information that may be presented to a user in any form.

The Petition includes other abuses and errors as well. Petitioner adopts inconsistent claim construction positions between the Petition and a parallel district court proceeding involving the '662 Patent. And the Petition fails to demonstrate how any asserted prior art reference discloses certain claim terms as construed by the Petitioner in the parallel district court proceeding (*e.g.*, “hot spot”). Additionally, at the district court—and, notably, relying on a different expert than the one it relies on in this proceeding—Petitioner contends that multiple claim terms are indefinite and thus not amenable to construction. Yet, both the Petition and the supporting declaration of Dr. José Zagal (Ex. 1003) appear able to apply prior art to these claim terms in this forum. Moreover, the “expert” declaration Petitioner submits purporting to be from Dr. Zagal is largely just a word-for-word copy of the Petition itself, confirming that no reliable expert testimony supports the Petition’s faulty conclusions as to critical issues. Finally, each ground of the Petition relies on “secret prior art” under 35 U.S.C. § 102(e)—a reference which should not be available in this proceeding under 35 U.S.C. § 311(b).

For these reasons and others discussed herein, the Board should deny institution.

II. BACKGROUND

A. Mobile Gaming Technology was Entirely Different as of the June 26, 2007, Priority Date of the '662 Patent.

The relevant time for the PTAB to consider is the priority date of the '662 Patent, June 26, 2007 (*see* Petition at 7), and at that time, the claimed invention was both novel and non-obvious. The Petition ignores the broader context and history of mobile gaming in 2007, and instead adopts a hindsight-driven viewpoint to suggest that technology that was novel in 2007 was somehow well-known and basic simply because it is used widely today.

The '662 Patent describes and claims a novel and unconventional way of using mobile gaming and mobile gaming devices, involving “providing hot spots of triggered content within the gaming environment of a mobile video game on a mobile communication device,” which “may prolong user interest in a game for a mobile communication device” '662 Patent, at 1:64–2:6. The innovative mobile gaming technology claimed in the '662 Patent originates from mobile game developer Mobile Deluxe (“MDX”), which was founded in 2003 and is the precursor of FPG. At that time, smartphones and modern online stores for smartphone app purchases (“App Stores”) had not been launched, and the mobile gaming landscape was very different than it is today.

It was not until mid-2008, a full year after the priority date of the '662 Patent, that App Stores even became available.¹ Before that time, mobile games had a very short life cycle. Wireless carriers each managed their own individual app store or “deck,” with a limited catalog of games (typically several hundred titles). Once that capacity was reached, the carrier would be forced to remove or “sunset” older game titles to make room for new games.

As the '662 Patent describes, “all video games tend to have a popularity life span” and, after the end of that span, “the user may stop playing that particular game in favor of others.” '662 Patent, at 1:31–35. Because of this short life cycle, carriers, developers, and publishers did not update a game during its lifetime, and there was no expectation a game would evolve. Rather, mobile games were a one-time purchase, typically \$4.99 to \$9.99 each. Instead of updating pre-existing mobile games, developers would, for example, launch a sequel to a game, which would be treated by carriers as a new title, triggering a new lifecycle for that new title. *See* '662 Patent, at 1:31–35. Thus, at the time the '662 Patent was filed, mobile games had a limited life cycle, and game developers addressed loss of user interest by releasing new mobile games rather than updating existing mobile games.

¹ *See, e.g.*, <https://www.apple.com/newsroom/2018/07/app-store-turns-10/> (“Apple introduced the App Store on July 10, 2008”); <https://pickaso.com/en/2020/google-play-store-evolution> (“Android’s store that ... launched in 2008 under the name of Android Market”).

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

A portion of the innovative technology that MDX created is claimed in the '662 Patent. In particular, the '662 Patent's claims provide a unique solution to the problem in the field at the time, providing and controlling access to certain content in a mobile video game via a "hot spot," such that "new interactive items and/or hidden features may be placed within a particular scene in the game so that the user has something new to look at or trigger (sometimes unexpectedly)," for example. '662 Patent, at 4:28–39. The claims improve the utility of computer-implemented games on mobile devices by providing hot spots of triggered content within the gaming environment of the video game, which "allow[s] game companies to keep game elements fresh and prolong user enjoyment of the game." *See, e.g., id.*, 1:64–2:6, 2:27–48, 4:14–23, 4:28–39. This improvement was groundbreaking at the time

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

B. Petitioner’s Faulty Summary of the State of the Art Relies on Materials that Are Not Prior Art, Not Raised in Any Ground, and that Confirm the Patentability of the ’662 Patent’s Claims.

The Petition attempts to provide a summary of the state of the art and, in so doing, suggests that “[g]ame developers embraced the idea of updateable games even before mobile games became popular.” Petition at 5. To support this position, Petitioner relies on unauthenticated hearsay that is not even prior art, and which, in fact, draws the exact opposite conclusion and demonstrates the novelty of the claimed invention of the ’662 Patent in June 2007.

The Petition relies on Exhibit 1015, an article purportedly published in Australia and entitled “Productive Play 2.0: The Logic of In-Game Advertising.” *See, e.g.*, Petition at 5. Putting aside that Petitioner does nothing to authenticate this article, it is not prior art. Indeed, it states on its face that it was published in February 2009, more than a year and half after the claimed priority date of the ’662 Patent. *See* Ex. 1015 at 2. Even then, the first paragraph of the article states that “suggestive events for *the future of online gaming* took place in the spring² of 2007” (Ex. 1015

² Spring in Australia occurs from September to November, *i.e.*, after the June 26, 2007, priority date of the ’662 Patent. <https://www.australia.com/en-us/facts-and-planning/when-to-go/australias-seasons.html>.

at 1 (emphasis and footnote added))—confirming that, as of its June 26, 2007 priority date, the invention provided by the '662 Patent was novel.

The Petition also relies on Exhibit 1016, a thesis entitled “Advertising in Computer Games.” *See, e.g.*, Petition at 5. While this thesis is stamped with the date September 28, 2006, Petitioner tellingly does not submit any evidence corroborating this date of publication or authenticating the Exhibit. Nor does Petitioner rely on Exhibit 1016 as a prior art reference. Further, as with Exhibit 1015, this thesis, in fact, suggests the novelty of the invention claimed in the '662 Patent, stating in its abstract that “[t]his paper suggests advertisers should experiment with in-game advertising to gain skills that could become vital in the *near future*.” Ex. 1016 at 2 (emphasis added).

The Petition next relies on Exhibit 1017, a press release purported to be dated March 21, 2006, and entitled “In-Game Advertising Goes Mobile.” *See, e.g.*, Petition at 5. As with Exhibit 1016, Petitioner submits no evidence corroborating the date of alleged publication or authenticating this Exhibit. Petitioner does not rely on Exhibit 1017 as a prior art reference—nor could it, as the press release is barely over one-page and provides no technical details at all. Further, as with the other exhibits, Exhibit 1017 confirms the novelty of the '662 Patent, stating: “In the *near future*, mobile in-game advertising *will become* increasingly attractive for providers of

mobile phones.” Ex. 1017 at 1 (emphasis added). Thus, this press release does not describe prior art, but merely describes what may happen in the *future*.

Finally, the Petition relies on Exhibit 1018, purportedly published in 2001. *See, e.g.*, Petition at 5. But again, Petitioner submits no evidence corroborating the date of alleged publication or authenticating this Exhibit. Exhibit 1018 also similarly confirms that in-game content updates, including with respect to “hot spots,” were not available at the time of the claimed invention of the ’662 Patent. Indeed, Exhibit 1018 expressly describes “[t]he biggest change between the current game technologies *and the future ones* is that in the future it will be possible to offer also games with realtime interactivity.” Ex. 1018 at 50 (emphasis added). Further, this article confirms exactly the need to address the problem that the ’662 Patent in fact solved, describing that “life cycle[s] of [] certain game[s] will [be] quite short, and will be replaced by more trendy games very promptly.” Ex. 1018 at 52.

C. The ’662 Patent Has Extensive Prosecution History, Including on Issues Relevant to the Petition.

Before it issued, the ’662 Patent went through a substantial prosecution process, including multiple critical claim amendments. Patent Owner details certain events in the prosecution history below that demonstrate that Petitioner’s arguments should be rejected as insufficient to institute review, including because prior art similar to the art asserted in the Petition was expressly distinguished and overcome during prosecution.

For example, the Challenged Claims of the '662 Patent recite, *inter alia*, “downloading hot spot information from the server to the mobile communication device, the hot spot information comprising: 1) hidden content for presenting to the user when the hot spot is activated; and 2) coordinate information”; “designating a non-promotional location in-game associated with activating the hot spot based on the coordinate information”; “displaying an object at the designated non-promotional location”; and “displaying the hidden content when the user activates the hot spot.” '662 Patent, at 14:53–63, 16:1–11. This claim language is the result of multiple claim amendments during prosecution.

The Examiner rejected the originally proposed claims under § 103 based on Lauper (U.S. Publication No. 2006/0205510) in view of Chu (U.S. Publication No. 2006/0111979). Ex. 1002 at 83–90. The Examiner contended that Lauper “discloses the invention substantially,” but conceded that Lauper “does not disclose that the hot spot information comprises hidden content for presenting to the user when the hot spot is activated; [] designating a non-promotional location in-game associated with activating the hot spot; and [] displaying the hidden content when the user activates the hot spot.” *Id.* at 86. The Examiner contended, however, that Lauper in combination with Chu disclosed “hidden content within nonpromotional game locations, and associate [*sic*] locations with coordinates.” *Id.* at 87.

The Examiner stated that Chu “teaches a virtual racing game with a pit-stop location where engine oil brands are advertised.” Ex. 1002 at 86. According to the Examiner: “Since the player does not know the content of the advertisement prior to making the pit-stop, this advertising information is interpreted as ‘hidden content,’ activated during the pit-stop.” *Id.* The Examiner contended that Chu thus disclosed placing advertising content in “non-promotional locations” in a game “that lack a nexus to advertisement data” and “that locations both for advertisements and non-promotional content are associated with game coordinates.” *Id.* at 86–87.

In response, the applicant amended the claims to require that the downloaded “hot spot information” comprises “coordinate information” and that the “non-promotional location in-game associated with activating the hot spot” is “based on the coordinate information.” Ex. 1002 at 65, 68. Therewith, the Applicant explained that the combination of Lauper and Chu failed to disclose or render obvious the claims as amended. *Id.* at 72. The Applicant explained that, in the amended claims, “[t]he mobile communication device may designate the location represented by the downloaded coordinate information as activating the hot spot.” *Id.* For instance, the Applicant stated that, “[i]n an exemplary embodiment, the coordinates may specify a location along the horizontal axis of the screen and the vertical axis to monitor for user interaction,” and “[i]n [another] embodiment, the coordinates may also include scene, level, or time information for playing the hot spot in-game.” *Id.*

The Applicant distinguished the amended claims from Chu, stating: “[E]ven if Chu teaches that advertisements or non-promotional content are ultimately associated with coordinates when they are displayed at the client device, which Applicant does not concede, Chu does not disclose or teach that these objects are displayed on the screen at those coordinates based on ‘coordinate information’ that was downloaded from a server to the client device.” Ex. 1002 at 73. The Applicant explained that, in the portion of Chu cited by the Examiner, Chu simply discloses that advertisements “may display within a given area or object within a game,” and “[a]reas’ in this context refers to any region mapped to any two or three-dimensional coordinate system bounded by the spatial dimensions of the described space.” *Id.* The Applicant pointed out that “[n]othing in the cited portion of Chu, or any other portion, discloses that coordinate information for a potential advertisement or object is downloaded to a client device” and, as such, Chu fails to teach “designating a non-promotional location in-game associated with activating the hot spot based on the coordinate information,” as recited in the amended claims. *Id.*

The Examiner, however, maintained a § 103 rejection based on Lauper in view of Chu. Ex. 1002 at 42–51. While the Examiner conceded that Lauper does not expressly teach “that the hot spot information comprises hidden content for presenting to the user when the hot spot is activated and coordinate information; [and] designating a non-promotional location in-game associated with activating the

hot spot based on the coordinate information,” the Examiner contended that Chu—and its “pit stop location”—“teaches these elements.” *Id.* at 47. The Examiner maintained the contention that Chu teaches “that locations both for advertisements and non-promotional content are associated with game coordinates.” *Id.* at 48. In particular, the Examiner cited Chu’s disclosure regarding a “method for defining advertisement locations and objects” by “specifying the areas or objects within a game in which advertisements may display,” noting that Chu defines “areas” as “any region mapped to any two or three dimensional coordinate system bounded by the spatial dimensions of the described space.” *Id.*

In response, the Applicant further amended the claims to require “displaying an object at the designated non-promotional location” “associated with activating the hot spot” and “based on the coordinate information” downloaded to the mobile communication device from the server. Ex. 1002 at 23, 26. Therewith, the Applicant explained that Chu did not “disclose or teach this subject matter.” *Id.* at 30. The Applicant explained that, while “the Examiner apparently contends that Chu discloses ‘displaying the hidden content when the user activates the hot spot’ based on its disclosure that advertising information (i.e., the alleged ‘hidden content’) is displayed when a user arrives at a pit stop (i.e., the alleged ‘hot spot’), Chu fails to disclose that any object is displayed at a designated location, which, when activated, results in the display of the advertising information.” *Id.* at 30.

In view of these amendments and remarks, the Examiner issued a Notice of Allowance on May 11, 2016, and the '662 Patent subsequently issued on August 30, 2016. Ex. 1002 at 13; *see* Ex. 1001 at 1.

III. THE BOARD SHOULD DENY INSTITUTION OF THE PETITION

A. Extensive Prosecution History Addressing Substantially Similar Art Weighs in Favor of Denial Under § 325(d)

The Board should exercise its discretion to deny institution under § 325(d) because the Petition presents “the same or substantially the same prior art or arguments previously ... presented to the Office,” 35 U.S.C. § 325(d), and because Petitioner failed to meet its burden to show material error with respect to such art or arguments. *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 (P.T.A.B. Feb. 13, 2020) (precedential) (“*Advanced Bionics*”); *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (P.T.A.B. Dec. 15, 2017) (precedential as to Section III.C.5, first paragraph) (“*Becton*”).

Under *Advanced Bionics*, the Board first considers “whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office.” IPR2019-01469, Paper 6 at 7–8. If “either condition of [the] first part of the framework is satisfied,” the Board then considers “whether the petitioner has

demonstrated that the Office erred in a manner material to the patentability of challenged claims.” *Id.* at 8. “If the petitioner fails to show that the Office erred, the Director may exercise his discretion not to institute *inter partes* review.” *Id.* (citing *Becton*, IPR2017-01586, Paper 8 at 24).

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

1) Part 1 of *Advanced Bionics*: The Prosecution History of the '662 Patent Considered Substantially the Same Prior Art and Arguments Petitioner Presents in the Petition.

The similarities between the art asserted in the Grounds in the Petition (*see* Petition at 3) and the art considered during prosecution of the '662 Patent weigh against institution. *See Juniper Networks, Inc.*, 2018 WL 1358386, at *4; 35 U.S.C. § 325(d) (“In determining whether to institute ... the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.”).

As discussed above, the Examiner considered Chu (U.S. Patent Application Publication No. 2006/0111979) during prosecution. *See, e.g.*, Ex. 1002 at 85–88. Chu is directed to “a virtual racing game.” Ex. 1002 at 86. For example, the system of Chu allows users to enter “a pit-stop location where engine oil brands are advertised.” *Id.* at 86 (citing Chu, [0063]). In particular, when a player arrives at the

“pit-stop location,” “advertising information” is activated and displayed to the player. *Id.* In another embodiment, Chu describes that when a game object, such as a “treasure chest,” is activated (*e.g.*, “opening of the chest”), previously hidden advertising content is displayed to the player. *Id.* at 86–87 (citing Chu, [0065]–[0066]). Chu also discloses that “advertisements” “may display within a given area or object within a game,” wherein “area” refers to “any region mapped to any two or three-dimensional coordinate system bounded by the spatial dimensions of the described space.” *Id.* at 45, 73 (quoting Chu, [0069]). As summarized above, the Applicant distinguished these disclosures of Chu from the Challenged Claims of the ’662 Patent. Ex. 1002 at 29–31, 72–74.

Ho (Ex. 1004) is similar to Chu in this regard. Ho discloses a “video game with at least one interactive information element incorporated within the game,” wherein “engagement of the at least one interactive element [] activates an action, such as, for example, an on-screen presentation,” such as an “advertisement.” Ex. 1004 at 2:1–2, 2:8–9, 2:22–25. Ho describes that the “interactive information element” is “an icon in the game, a character in the game or an item in the game”—such as “character 52,” “wings button 54,” “hamburger monster 56,” or “car 58,” as illustrated in Figure 3 of Ho. Ex. 1004 at 4:28–29, 5:1–5, Fig. 3. Ho describes that, “[i]n the course of gameplay,” a player is presented “an option to engage” these “interactive information elements.” Ex. 1004 at 4:22–23, 5:8–10.

As to any specific “coordinate information” associated with Ho’s “interactive information elements,” Ho simply generally describes that the “interactive information elements” may be “located at a juncture in the game such as ... a specific location in the game.” Ex. 1004 at 7:17–23. Thus, just as with the Chu reference considered in detail during prosecution of the ’662 Patent, Ho, at most, discloses a game component (*e.g.*, “pit-stop”; “treasure chest”) located at a location in the game that may display an advertisement when engaged by a player. *See* Ex. 1002 at 73. And just like Chu, Ho fails to disclose that its “interactive information elements” “are displayed on the screen at [] coordinates based on ‘coordinate information’ that was downloaded from a server to the client device.” Ex. 1002 at 73.

Kim (Ex. 1007) is also analogous to Chu for similar reasons. Kim “relates to a method of advertisement which is applied to a game on the internet.” Petition at 58 (quoting Ex. 1007 at 1:14–17). For instance, Kim discloses that a “character featured at the server,” such as a “monster,” may appear at a “certain place and certain time” in a game, and, if a user encounters and fights the monster, an “advertisement relevant to the monster can be shown at the spot where [the] monster [] dies.” Ex. 1007 at 8:44–63. But “[a]ll movement of monsters is controlled by [the] server” of Kim—as opposed to the client device. Ex. 1007 at 9:7–10. Thus, just as with Chu, Kim simply discloses a game component (*e.g.*, “monster”) that may display an advertisement at an unspecified location in the game. *See* Ex. 1002 at 73.

And just like Chu, Kim fails to disclose that its “character featured at the server” “[is] displayed on the screen at [] coordinates based on ‘coordinate information’ that was downloaded from a server to the client device.” Ex. 1002 at 73.

Additionally, the Examiner considered Lauper (U.S. Publication No. 2006/0205510) during prosecution. *See, e.g.*, Ex. 1002 at 47–50, 86–88. Lauper is directed to a gaming system including a server for “broadcasting advertising contents” over a network to a game terminal. Ex. 2002, Abstract. In particular, Lauper discloses a game wherein a virtual car controlled by a player may drive on a street between visible advertising placards, on which advertisements are immediately visible once the placard is available to be presented on the screen. Ex. 2002, [0019]. When a player selects one of the advertisements, the player is shown a screen that allows the player to purchase components relevant to the game. Ex. 2002, [0024]–[0025]. As summarized above, the Examiner readily conceded that Lauper did not disclose or suggest all the elements of the Challenged Claims of the ’662 Patent, including, but not limited to, the “***non-promotional*** location in game associated with activating the hot spot.” Ex. 1002 at 47, 86 (emphasis added).

Jiau (Ex. 1006) is similar to Lauper in this regard. Jiau discloses a method for providing “hotspots” (“areas of an object [] that have an associated link”) in a virtual world, wherein activation of a “hotspot” by a user displays an “advertisement.” Ex. 1006 at Abstract, 15:31–32. In particular, Jiau discloses a virtual world that includes

“sign[s]” containing “advertisement[s],” as illustrated in Figure 11(d). Ex. 1006 at 15:3–17, Fig. 11(d). Jiau discloses advertisements may appear on the signs “when the user’s location becomes within a predetermined virtual distance in the virtual world.” Ex. 1006 at 15:3–17. Jiau discloses that the user may engage with a “hotspot link” within the sign by clicking on it. *Id.* Thus, just as with the Lauper reference considered in detail during prosecution of the ’662 Patent, Jiau discloses promotional signs (*i.e.*, placards) by which a user can act on an advertisement displayed to the user in the game. *See* Ex. 1002 at 47, 86.

Aoki (Ex. 1005) is also similar to Lauper in this regard. Aoki discloses an “game advertisement charge[]” system that calculates a charge amount for outputting a game advertisement. Ex. 1005 at Abstract. Aoki discloses an “advertisement management database” containing “advertisement placement location data” that is used to embed the advertisement image into a position in the game. Petition at 16 (citing Ex. 1005, Fig. 7, [0074]). In particular, Aoki discloses a 3D driving game that includes “placard objects” installed on the “road,” wherein each of the placard objects has “an advertisement thereon.” Petition at 14–15 (citing Ex. 1005, Fig. 3, [0068]). Thus, just as with the Lauper reference considered in detail during prosecution of the ’662 Patent, Aoki simply discloses promotional placards on which an advertisement is displayed in the game. *See* Ex. 1002 at 47, 86.

The Petition does not meaningfully dispute the similarity between the references on which it relies (*e.g.*, Ho, Jiau, Aoki, Kim) and the art considered by the Office during prosecution (*e.g.*, Chu, Lauper). Rather, at most, the Petition states only that “[n]one of the cited references contain a substantially similar disclosure of a mobile game with dynamically updated hot spots represented in-game as non-promotional background objects, as is disclosed in the combinations described in the Grounds presented herein.” Petition at 73. This boilerplate assertion by Petitioner is nonsensical, as none of the Challenged Claims of the ’662 Patent recites “hot spots” represented by “non-promotional background objects.” And, in any event, the Petition fails to set forth any specific evidence or other facts to demonstrate that the prior art asserted in the Petition (*e.g.*, Ho, Jiau, Aoki, Kim) is materially different from the art cited during prosecution of the ’662 Patent (*e.g.*, Chu, Lauper).

Overall, the similarity in the art presented in the Petition and addressed in detail by the Examiner during prosecution counsels against institution. *See Fox Factory, Inc. v. SRAM, LLC*, IPR2016-01876, Paper 8, at 7 (P.T.A.B. Apr. 3, 2017) (“[T]here are the interests in conserving the resources of the Office and granting patent owners repose on issues and prior art that have been considered previously.”); *Kayak Software Corp. v. IBM Corp.*, CBM2016-00075, Paper 16, at 12–13 (P.T.A.B. Dec. 15, 2016).

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

The second prong of the *Advanced Bionics* test is met because Petitioner completely failed to set forth any evidence of material error committed by the Office. Petitioner does not even allege “material error” by the Office. Petition at 73. Instead, the Petition states simply “the Examiner committed error in evaluating the prior art of record.” *Id.* This cursory contention does not articulate “material error.”

More critically, this unsupported statement offers no description of what the Examiner’s error may have been. And the Board has declined “to guess or develop its own theory on what error may have been committed in prior proceedings.” *Atrium Med. Corp. v. Bard Peripheral Vascular, Inc.*, IPR2021-01197, Paper 11, at 23 (P.T.A.B. Jan. 10, 2022). In fact, Petitioner identifies no material error by the Office because there was none. Accordingly, Petitioner has not, and cannot, meet its burden of establishing that “the Office erred in a manner material to the patentability of challenged claims.” *Advanced Bionics*, IPR2019-01469, Paper 6, at 7-11.

For all these reasons, the Board should exercise its discretion under § 325(d) and deny institution. *See, e.g., ABS Glob., Inc. v. Cytonome/ST LLC*, IPR2021-00306, Paper 13, at 13–14, 16 (P.T.A.B. June 7, 2021).

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

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

As one example of the Petitioner’s abuse of process, Petitioner has taken inconsistent positions regarding the scope of the Challenged Claims of the ’662 Patent in different forums. *Cf. ResMed Corp. v. Cleveland Medical Devices Inc.*, IPR2023-00565, Paper 13, at 17 (P.T.A.B. Sep. 25, 2023) (“We agree with Patent Owner that on the facts of this case, by providing inconsistent positions regarding the proper construction of the claims, Petitioner is not being transparent. ... The potential for conflicting decisions favors denial.”); *Kiosoft Techs., LLC v. PayRange, Inc.*, IPR2021-00086, Paper 12, at 16 (P.T.A.B. Mar. 22, 2021) (“Thus, regardless of the Petition’s merits, the potential problems inherent in the inconsistent claim constructions set forth by Petitioner between the Petition and its proposals at the district court warrant us to find that factor 6 weighs in favor of denying institution.”); *Comcast Cable Communs, LLC v. Promptu Sys. Corp.*, CBM2018-00033, Paper 9,

at 10–11 (P.T.A.B. Oct. 10, 2019) (Petitioners’ reliance on “competing claim construction arguments that impact central aspects of both trials” weighs against institution because the Board would risk a decision contradicting the claim construction adopted in the other case or having to abandon its own case to be consistent with the claim construction advocated in the other trial); *Facebook, Inc. v. Sound View Innovations, LLC*, IPR2017-00998, Paper 13, at 8, 17 (P.T.A.B. Sep. 5, 2017) (denying institution where the Petitioner “did not inform the panel that Petitioner had taken a very different claim construction position before the district court, it did not inform the panel that the different position was then under consideration by the district court, nor did it explain the reason for Petitioner’s change of heart”); *id.* at 17–18 (“At the very least, Petitioner’s failure to inform us of its differing claim construction arguments before the district court raises the specter of lack of candor.”).

Indeed, Petitioner’s proposed constructions in the parallel district court proceeding (Ex. 2001) conflict with its positions in the Petition regarding the scope of the Challenged Claims of the ’662 Patent (*see, e.g.*, Petition at 11). In short, Petitioner seeks to have the terms of the ’662 Patent applied as broadly as possible in attempting to invalidate the claims of the ’662 Patent before the Board, while simultaneously arguing that several terms are indefinite under 35 U.S.C. § 112 and proposing formal constructions for other terms in district court.

In particular, in the Petition, Petitioner represents that no terms in the Challenged Claims of the '662 Patent require construction. Petition at 11. And, in setting forth its grounds in the Petition, Petitioner necessarily readily understands the definite meaning of those claims and contends that the asserted prior art references disclose the various elements and limitations of the Challenged Claims based solely on the plain language of the claims, as opposed to any specific construction of any term therein. *See* Petition at 11–73. Likewise, Petitioner’s expert in this proceeding, Dr. Zagal, has declared that the Challenged Claims of the '662 Patent “do not use any specialized terms that would require additional explanation or express definitions”; rather, “[t]he ordinary and customary meaning of the claims and the terms used therein, read in the context of the specification, would have been understood by a POSITA.” Ex. 1003, ¶ 80. As such, Dr. Zagal has also “applied the ordinary and customary meaning of the claim terms” in rendering his opinions presented to the Board. Ex. 1003, ¶ 79.

In the district court, however, Petitioner contends that multiple claim elements/terms in the Challenged Claims are “Indefinite”—including, but not limited to, “non-promotional” (which appears in every Challenged Claim) and “preset location” (which appears in claims 1–12). Ex. 2001 at 6–10. Petitioner has not yet put forth its full bases for the alleged indefiniteness. For each term, however, Petitioner has made clear that it is represented by an additional expert witness, Mr.

Garry Kitchen, who will take the *opposite* position from Dr. Zagal and explain to the district court why, in that venue, the Petitioner believes the meaning and/or scope of the claim terms is not reasonably certain. Ex. 2001 at 6–10.

Additionally, in the district court, Petitioner contends that multiple claim terms require construction—including the term “hot spot” / “hot spot information” (which appear in every Challenged Claim). Ex. 2001 at 6–10. And Petitioner has also reserved the right to construe other, additional phrases/terms as well—including “designating a ... location in-game associated with activating the hot spot based on the coordinate information”; “coordinate information”; “the coordinate information comprises one or more predefined in-game locations”; “a version identifier for the downloaded hot spot information”; “user-identification information”; and “the hidden content is displayed in a pop-up window.” *Id.* Petitioner’s positions at the district court thus directly contradict both Petitioner’s and its expert’s position in this proceeding that no claim phrases/terms “require additional explanation or express definitions.” Ex. 1003, ¶ 80; *see* Petition at 11.

Petitioner’s inconsistency between the two forums “calls to mind the well quoted phrase: ‘When I use a word,’ Humpty Dumpty said, in a rather scornful tone, ‘it means just what I choose it to mean-neither more nor less.’” *Honeywell Intern., Inc. v. ITT Indus., Inc.*, No. 02-73948, 2005 WL 5416765, at *7–8 (E.D. Mich. May 17, 2005) (quoting Lewis Carroll, *Through the Looking Glass* from Alice’s

Adventures in Wonderland, Chapter VI, Humpty Dumpty (1865)). Such an inconsistency amounts to an “abuse of process.” *See* June 21, 2022 PTAB Interim Procedure for Discretionary Denials, at 4, 9; *see also Facebook*, IPR2017-00998, Paper 13, at 17–18 (noting Petitioner’s “differing claim construction arguments before the district court raises the specter of lack of candor.”). Just as “claims are construed the same way for both invalidity and infringement,” *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1330 (Fed. Cir. 2003), a Petitioner must take consistent positions regarding claim construction before the Board and in any parallel proceeding, including district court litigation.

Petitioner’s abuse of process is further highlighted by its selective use of different experts to take different positions on the scope and meaning of the Challenged Claims of the ’662 Patent in different forums. *Compare* Ex. 1003, ¶¶ 79–80 *with* Ex. 2001 at 6–10. This abuse of process also necessarily calls into question the accuracy and reliability of Dr. Zagal’s opinions as a whole in this proceeding, given that at least a number of his opinions directly conflict with the reported “expert testimony” of another in the field, Mr. Garry Kitchen, Petitioner’s expert in the district court. *See* Ex. 2001 at 6–10.

Petitioner’s gamesmanship regarding the proper construction of the Challenged Claims of the ’662 Patent is reason alone to deny its Petition. *See* June 21, 2022 PTAB Interim Procedure for Discretionary Denials, at 4, 9; *see also*

ResMed Corp., IPR2023-00565, Paper 13, at 17; *Kiosoft Techs.*, IPR2021-00086, Paper 12, at 16; *Comcast*, CBM2018-00033, Paper 9, at 10–11; *Facebook*, IPR2017-00998, Paper 13, at 8, 16–18.

C. Petitioner Has Not Shown a Reasonable Likelihood of Prevailing on Any Ground.

1) Petitioner Fails to Shoulder Its Burden with Respect to Multiple Claim Terms.

“Hot Spot”/“Hot Spot Information”: Petitioner cannot shoulder its burden of establishing that the references it cites disclose or suggest the claimed “hot spot” and “hot spot information,” including as recited in what Petitioner identifies as elements 1(a), 1(b), 1(c), and 1(e) (and corresponding elements in claim 13) in the Petition. *See, e.g.*, Petition at 25–30, 42–50.

In support of the Petition, both Petitioner and Dr. Zagal represent that no terms in the Challenged Claims of the ’662 Patent require construction, as noted above. Petition at 11; Ex. 1003, ¶¶ 79–80. And relatedly, neither Petitioner nor Dr. Zagal set forth any construction of any term in any Challenged Claim of the ’662 Patent—let alone analyze any cited prior art relative to such a construction. But, as discussed above, Petitioner takes a different, inconsistent position in the parallel district court proceeding. In particular, Petitioner contends that the terms “hot spot” and “hot spot information” necessarily do not have any plain meaning and, rather, must be construed to mean “an in-game feature that includes an activation element and a

content element that is triggered by the activation element.” Ex. 2001 at 7. As discussed, this inconsistency alone justifies denial of institution.

In any event, at a minimum, Petitioner must be held to its own stated standard—albeit in the district court—regarding the scope of the Challenged Claims of the ’662 Patent. In the Petition, however, Petitioner fails to demonstrate that any cited prior art reference discloses such a “hot spot”—“an in-game feature that includes an *activation element* and a *content element* that is triggered by the activation element.” Ex. 2001 at 7 (emphasis added).

Grounds 1 and 3 each rely on Ho (Ex. 1004) as the primary reference, with both grounds relying on secondary references, Aoki and Kim, in an attempt to cure Ho’s deficiencies. *See* Petition at 3. Therein, Petitioner asserts only, in conclusory fashion, that the “interactive information element” of Ho is the claimed “hot spot.” Petition at 21, 25. Petitioner never specifically identifies any “activation element” or “content element” (“that is triggered by the activation element”) within Ho’s “interactive information element.” *See id.* At most, Petitioner simply notes that, in Ho, “activating these interactive elements reveals hidden content for presenting to the user, such as advertisements,” such as “an on-screen presentation.” Petition at 25–26. Such vague, passing remarks by Petitioner, however, fail to shoulder its burden with respect to demonstrating that Ho’s “interactive information element” includes an *activation element* and a *content element* that is triggered by the

activation element,” as required by the Challenged Claims according to Petitioner (albeit at the district court). Ex. 2001 at 7 (emphasis added).

Petitioner’s alternative reliance on the secondary references Aoki and Kim in Grounds 1 and 3 does not cure this deficiency. *See* Petition at 25–26, 61–63. Indeed, Petitioner does not contend that either of Aoki or Kim disclose the claimed “hot spot” or “hot spot information.” *See* Petition at 25–26, 61–63. So, once again, Petitioner never specifically identifies any “activation element” or “content element” (“triggered by the activation element”) within either Aoki or Kim *See id.*

Grounds 2 and 4 each rely on Jiau (Ex. 1006) as the primary reference, with both grounds relying on the same secondary references, Aoki and Kim, in an attempt to cure Jiau’s deficiencies. *See* Petition at 3. Petitioner asserts that Jiau discloses the “hot spot” and “hot spot information” of the Challenged Claims simply because Jiau discloses similar words: “hotspot” and “hot space.” Petition at 42–50, 68–69. But once again, Petitioner never specifically identifies any “activation element” or “content element” (“that is triggered by the activation element”) within Jiau’s “hotspot” or “hot space.” *See id.* And, as with Grounds 1 and 3, Petitioner’s reliance on the secondary references Aoki and Kim fails. *See* Petition at 42–50, 68–69. Indeed, Petitioner does not contend that either of Aoki or Kim disclose the claimed “hot spot” or “hot spot information.” *See* Petition at 25–26, 61–63.

“Designating a Non-promotional Location In-game Associated with Activating the Hot Spot Based on the Coordinate Information”: Petitioner also cannot shoulder its burden of establishing that the references it cites disclose or suggest “downloading hot spot information from the server to the mobile communication device, the hot spot information comprising: ... coordinate information” and “designating a non-promotional location in-game associated with activating the hot spot based on the coordinate information,” which Petitioner identifies as elements 1(b) and 1(c), respectively (and corresponding elements in claim 13), in the Petition. *See, e.g.*, Petition at 25–29.

As a fundamental matter, these elements recite a claim term—“non-promotional”—that Petitioner contends, in the parallel district court proceeding, is indefinite. Ex. 2001 at 6. Thus, in that forum, Petitioner is unable to provide a sufficient meaning to the term in order to determine whether the element is met by either an accused product or an asserted prior art reference. Nevertheless, in this forum, Petitioner claims it is fully able to interpret this claim term, without any construction. Petition at 11; *see* Ex. 1003, ¶¶ 79–80. But in doing so, Petitioner provides no cognizable construction or interpretation of the claim term in view of the cited art. *See id.* Thus, Petitioner cannot argue here that this element is met by prior art, while simultaneously urging in the district court that it has no idea what this term within this element means. *See* Ex. 2001 at 6.

Petitioner has failed to shoulder its burden of establishing that the references it cites disclose or suggest these elements, in any event. Indeed, the prior art asserted by Petitioner with respect to these elements is akin to the prior art distinguished by the Applicant during prosecution (*e.g.*, Chu, Lauper). *See supra* Sections II.C, III.A.

As noted above, Grounds 1 and 3 rely on Ho as a primary reference, with both grounds relying on secondary references in an attempt to cure Ho’s deficiencies. *See* Petition at 11. The Petition points to Ho’s “interactive information element(s)” as allegedly meeting the claimed “hot spot.” *See, e.g.*, Petition at 28. The Petition further suggests that the “interactive information elements” of Ho “are represented by non-promotional objects because they correspond to in-game characters or items, and do not display promotional content until a user has performed a predetermined action.” Petition at 28 (citing Ex. 1004 at 2:11–12, 5:1–7, 5:27–38).

But as to location of Ho’s “interactive information element(s),” the Petition asserts only that the elements may be “located at a juncture in the game such as ... a specific location in the game.” Petition at 26 (citing Ex. 1004 at 7:17–23). Notably, the Petition never asserts that Ho discloses “**downloading** hot spot information from the server to the mobile communication device, the hot spot information comprising: ... coordinate information,” as recited by each Challenged Claim of the ’662 Patent. Rather, at most, the Petition contends only that “[a] POSITA would have understood Ho’s disclosures to teach that the server provides coordinate information for the

interactive information elements.” Petition at 26. Petitioner relies on the Declaration of Dr. Zagal as support for its contention. *Id.* (citing Ex. 1003, ¶ 124). But as discussed further below (*infra* Section III.C.2), Dr. Zagal’s declaration testimony to this end provides nothing more than conclusory statements parroting Petitioner’s argument—and is thus entitled no weight. Ex. 1003, ¶ 121 (“In my opinion, a POSITA would have understood Ho’s disclosures to teach providing coordinate information for the in-game location of the interactive information element.”).

Moreover, Petitioner’s characterization of Ho in this regard is no different than the Examiner’s consideration of Chu during prosecution. As discussed above, Chu disclosed that its game objects (*i.e.*, purported “hot spots”), such as “pit-stop” and “treasure chest,” were “mapped” to a “coordinate system” in Chu’s game. Ex. 1002 at 29–31, 47–48, 72–74, 85–88. The Applicant distinguished these disclosures of Chu from the Challenged Claims of the ’662 Patent, including because nothing in Chu “discloses that coordinate information” for Chu’s game objects “is **downloaded** to a client device,” let alone that any location of Chu’s game objects is designated based on such **downloaded** coordinate information. *Id.* at 29–31, 72–74 (emphasis added). Similarly, as noted above, nothing in Ho discloses that any “coordinate information” for Ho’s interactive information elements “is **downloaded** to a client device,” let alone that any location of Ho’s interactive information elements is designated based on such **downloaded** coordinate information. *See id.*

The Petition fails to cure these deficiencies in Ho with Aoki or Kim. *See* Petition at 27–29, 61–62. Neither Aoki nor Kim discloses “designating a non-promotional location in-game associated with activating the hot spot based on [] coordinate information” downloaded from the server to the mobile communication device, as recited by the Challenged Claims.

As the Petition provides, Aoki discloses only “advertisement placement location data ... that specifies the in-game location for the *advertisement* using ‘X and Y coordinates.’” Petition at 27 (emphasis added). Aoki thus fails to disclose the downloading of any “coordinate information” for a “non-promotional” location or object in-game associated with activating the “hot spot,” as recited by the Challenged Claims. And Petitioner’s argument that, in the “combined Ho-Aoki system,” the client device “would [] receive location data specifying, using coordinate information, an in-game location where the interactive information elements [] should be displayed” is unavailing, because, as discussed further below (*infra* Section III.C.2), it is supported only by Dr. Zagal’s conclusory statement parroting Petitioner’s argument—which is entitled no weight. Petition at 27 (citing Ex. 1003, ¶¶ 122–123 (“In my opinion, ... in the combined Ho-Aoki system, the client end device would ... receive location data specifying, using coordinate information, an in-game location where the interactive information elements [] should be displayed.”)).

Kim likewise never discloses “designating a non-promotional location in-game associated with activating the hot spot based on [] coordinate information” downloaded from the server to the mobile communication device, as recited by the Challenged Claims. Rather, “[a]ll movement” of a “character featured at the server,” such as a “monster,” in the game system described by Kim is “controlled by [the] server” of Kim—as opposed to the client device. Ex. 1007 at 8:44–63, 9:7–10. Moreover, Kim states that its “[s]erver system and client system [] do not necessarily transfer all data.” Ex. 1007 at 8:1–2. And, in fact, Kim states that the server system only “needs to transfer co-ordinates to each client system when items to be *advertised* are manifested at the virtual space of the server system.” Ex. 1007 at 8:5–7 (emphasis added). As such, Kim fails to disclose—and, in fact, teaches away from—downloading any “coordinate information” for a game character, such as “monster” to a client device (as opposed to the *advertisement* to be displayed when “the monster dies”). See Ex. 1007 at 8:49–52.

Petitioner’s argument that, “[a]pplying Kim’s teaching to Ho, a POSITA would have found it obvious for the server to provide coordinate information that specifies the location of interactive information elements” is, once again, unavailing, because, as discussed further below (*infra* Section III.C.2), Petitioner’s argument is supported only by Dr. Zagal’s conclusory statement parroting Petitioner’s argument—which is entitled no weight. Petition at 62 (citing Ex. 1003, ¶ 219 (“In

my opinion, a POSITA, applying Kim’s teaching to Ho, would have found it obvious for the server to provide coordinate information that specifies the location where non-promotional objects associated with activating the hot spot (interactive information elements) should be displayed.”)).

Grounds 2 and 4 of the Petition suffer the same flaws. Petitioner contends that Jiau’s “hotspots” and “hotspaces” are both “examples” of the “hot spots” claimed by the ’662 Patent. Petition at 40. And as to the claims’ requirement that “hot spot information”—comprising “coordinate information” for “designating a non-promotional location in-game associated with activating the hot spot”—be downloaded to the mobile communication device, the Petition contends that Jiau generally discloses a “sub-coordinate system” as well as a “file” containing certain “position” data that “may be provided to a client device by a server.” Petition at 45–46 (citing Ex. 1006 at 19:27–20:3, Fig. 17). But that “file” is a “file storing information for a lot”—not a “hotspot” or “hotspace.” Ex. 1006 at 19:29, Fig. 17. Indeed, Jiau is directed to a “virtual world” that is “divided into a plurality of ‘lots,’ similar to ‘lots’ of real estate in the real world.” Ex. 1006 at 1:31–2:3. Any alleged “coordinate information” included in the “lot file” sent to the client device in Jiau’s system is thus simply the overall metes and bounds of the virtual lot in the virtual world, akin to a property deed in the real world—not specific “coordinate information” for an individual “hotspot” or “hotspace.” *See* Ex. 1006 at 1:31–2:3.

The Petition fails to cure these deficiencies in Jiau with Aoki or Kim. *See* Petition at 46–49, 68–69. As discussed above, neither Aoki nor Kim discloses “designating a non-promotional location in-game associated with activating the hot spot based on [] coordinate information” downloaded from the server to the mobile communication device, as recited by the Challenged Claims. Rather, Aoki, at most, discloses only “advertisement placement location data ... that specifies the in-game location for the *advertisement* using ‘X and Y coordinates.’” Petition at 27 (emphasis added). And Kim’s teachings regarding “co-ordinates” are likewise directed to “when items to be *advertised* are manifested at the virtual space of the server system. Ex. 1007 at 8:5–7 (emphasis added); *see* Ex. 1007 at 8:49–52.

Petitioner’s arguments that the combination of Jiau with Aoki and/or Kim nonetheless somehow discloses these elements are unavailing, because, as discussed further below (*infra* Section III.C.2), Petitioner’s arguments are, once again, supported only by Dr. Zagal’s conclusory statements parroting Petitioner’s arguments—which are entitled no weight. Petition at 46–49 (citing Ex. 1003, ¶¶ 177, 182); Petition at 68–69 (citing Ex. 1003, ¶¶ 247, 249).

2) Petitioner’s Expert’s Declaration Should Be Given No Weight.

As noted above, in support of its Petition, Petitioner submits a declaration from its expert, Dr. Zagal. *See* Ex. 1003 (the “Zagal Declaration”). As discussed above, the Zagal Declaration is fundamentally suspect given the portions of it

regarding claim construction of the Challenged Claims are directly contradicted by both Petitioner and Petitioner's different expert, Mr. Garry Kitchen, in the parallel district court proceeding. *See* Ex. 2001 at 6–10. More troubling, the Zagal Declaration simply parrots the Petition and the Petitioner, as opposed to providing any insightful expert opinions and analysis. For all these reasons, the Zagal Declaration should not be entitled any weight—and, as such, Petitioner has necessarily failed to carry its burden with respect to institution, given that each Ground is an obviousness challenge that relies heavily on the Zagal Declaration.

As the Board has consistently recognized, a declaration that repeats the petition *verbatim* is “is conclusory and unsupported, adds little to the conclusory assertion for which it is offered to support, and is entitled to little weight.” *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9, at 15 (P.T.A.B. Aug. 24, 2022) (precedential) (denying institution where Petitioner's expert “offers only a *verbatim* restatement of the assertion being supported, without any supporting evidence or technical reasoning.”) (listing cases).

Simply put, an expert declaration that “merely parrots the Petition” is entitled to “little to no weight.” *E.g., MarkForged Inc. v. Continuous Composites, Inc.*, IPR2022-01431, Paper 7, at 14 (P.T.A.B. Jan. 18, 2023) (“[Expert's] declaration testimony on this point is entitled to little to no weight as it merely parrots the Petition.”); *LG Elecs. Inc. v. Jawbone Innovations, LLC*, IPR2023-01111, Paper 10,

at 15 (P.T.A.B. Jan. 9, 2024) (“Petitioner’s expert merely parrots the Petition. ... Thus, Petitioner’s conclusory assertion is unpersuasive.”); *see Content Square SAS v. Medallia Inc.*, IPR2022-00316, Paper 13, at 38 (P.T.A.B. July 14, 2022) (“Merely repeating an argument from the Petition in the declaration of a proposed expert, does not give that argument enhanced probative value.”); *Man Wah Holdings Ltd. v. Rafeel Sys., LLC*, IPR2019-00616, Paper 7, at 15–16 (P.T.A.B. Aug. 21, 2019) (“Merely repeating an argument from the Petition in the declaration of a proposed expert does not give that argument enhanced probative value.”).

Such is the case here with respect to the Zagal Declaration. For example, as discussed above, Petitioner’s argument regarding Ho fails to shoulder its burden of demonstrating Ho discloses element 1(b) of the Challenged Claims of the ’662 Patent. *See supra* Section III.C.1. The Petition’s reliance on the Zagal Declaration (Petition at 26–27 (citing Ex. 1003, ¶ 121)) in an attempt to fill this gap in Ho does not change this conclusion. As demonstrated below, the Zagal Declaration simply repeats Petitioner’s attorney argument regarding how a POSITA allegedly would have somehow understood Ho to disclose element 1(b) of the Challenged Claims (despite any lack of disclosure in Ho to that end), nearly *verbatim*:

Petition at 26–27	Ex. 1003, ¶ 121
A POSITA would have understood Ho’s disclosures to teach that the server provides coordinate information for the interactive information elements. Ex. 1003 ¶121.	[A] POSITA would have understood Ho’s disclosures to teach providing coordinate information for the in-game location of the interactive information element and advertisement.

Indeed, a POSITA would understand that by the time of Ho many video games used coordinates extensively to manage and represent the position of objects, characters and elements within the game world. <i>Id.</i>; <i>see also</i> §VI.E. For instance, in games with 2D graphics, coordinates may use a system like (x,y) to define positions on a two-dimensional plane. Ex. 1003 ¶121. Similarly, 3D games also use coordinates to define positions on a three-dimensional plane. <i>Id.</i> Thus, a POSITA would have understood that Ho’s server would provide coordinate information so that the interactive information element and hidden content can be displayed in the appropriate location on the screen. <i>Id.</i>	Indeed, a POSITA would understand that by the time of Ho many video games used coordinates extensively to manage and represent the position of objects, characters, and elements within the game world. For example, in games with 2D graphics, the well known cartesian coordinate system (x, y) is used to define positions on a two-dimensional plane. Similarly, 3D games also use coordinates to define positions in a three-dimensional space. Thus, a POSITA would have understood that Ho’s server would provide coordinate information so that the interactive information element and hidden content can be displayed in the appropriate location in the game and/or on the screen in my opinion.
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As demonstrated above, the cited portion of the Zagal Declaration is almost identical to the Petition. *Compare* Petition at 26–27 *with* Ex. 1003, ¶ 121. Put another way, it merely “repeats ... the conclusory assertion for which it is offered to support,” and thus “adds little to the conclusory assertion for which it is offered to support, and is entitled to little weight.” *Xerox*, IPR2022-00624, Paper 9, at 15. Indeed, a purported expert merely parroting the Petition cannot give any insight into what a POSITA may understand and/or be motivated to do. *See LG Elecs.*, IPR2023-01111, Paper 10, at 15; *Content Square*, IPR2022-00316, Paper 13, at 38.

There are numerous other, additional instances where the Zagal Declaration is a near exact copy of the Petition, and the Petition purports to rely on those conclusory arguments (presented in the guise of expert opinion) to give the mindset of a POSITA. As one of many examples, compare Dr. Zagal’s purported testimony at Paragraphs 122, claiming to analyze element 1(b) of the Challenged Claims of the ’662 Patent by comparison to Ho—now in view of Aoki—with the Petitioner’s argument regarding the same at page 27 of the Petition:

Petition at 27	Ex. 1003, ¶ 122
To the extent Ho does not disclose or render obvious this limitation, the limitation was obvious in view of Aoki. Ex. 1003 ¶122. Aoki discloses that a server may provide a mobile communication device (e.g., a “PDA” or “telephone”) with advertisements to be displayed in a video game. Ex. 1005, [0061]-[0062], Fig. 1. For instance, the server may provide an “advertisement image” along with “advertisement placement location data.” <i>Id.</i> The advertisement placement location data includes a “replacing position” that specifies the in-game location for the advertisement using “X and Y coordinates.” <i>Id.</i> Thus, when the time arrives to display an advertisement image, the game can place the advertisement image “into the	Further, to the extent Ho does not disclose or render obvious this limitation, the limitation was obvious in view of Aoki in my opinion. For example, Aoki discloses that a server may provide a video game operable on a mobile communication device (e.g., a “PDA” or “telephone”) with advertisements to be displayed in a video game. Ex. 1005, [0061]-[0062], Fig. 1. In another instance, the server may provide an “advertisement image” along with “advertisement placement location data.” <i>Id.</i> The advertisement placement location data includes a “replacing position” that specifies the in-game location for the advertisement using “X and Y coordinates.” <i>Id.</i> Thus, when the time arrives to display an advertisement image, the game can place the advertisement image “into the

point designated by the ‘replacing position’” using the X and Y coordinates. <i>Id.</i> , [0072], [0074], Fig. 7.	point designated by the ‘replacing position’” using the X and Y coordinates. <i>Id.</i> , [0072], [0074], Fig. 7.
In the combined Ho-Aoki system, the client end device would continue to download from the server interactive information elements and hidden content, and would also receive location data specifying, using coordinate information, an in-game location where the interactive information elements and advertisements should be displayed. Ex. 1003 ¶¶122-123.	In my opinion, this shows that, in the combined Ho-Aoki system, the client end device would continue to download from the server interactive information elements and hidden content, and would also receive location data specifying, using coordinate information, an in-game location where the interactive information elements and advertisements should be displayed.

Each of the above examples is “particularly problematic,” because the purported “expert testimony is offered not simply to provide a motivation to combine prior-art teachings, but rather to supply a limitation missing from the prior art.” *Xerox*, IPR2022-00624, Paper 9, at 16. Indeed, the Petition inherently concedes that Ho does not disclose element 1(b) of the Challenged Claim of the ’662 Patent: “downloading hot spot information from the server to the mobile communication device, the hot spot information comprising: ... coordinate information.”

As discussed above, the Petition at most contends only that “[a] POSITA would have understood Ho’s disclosures to teach that the server provides coordinate information for the interactive information elements.” Petition at 26. But the Petition cites only the Zagal Declaration as support for this assertion. *Id.* (citing Ex. 1003, ¶ 121). And, as demonstrated above, Dr. Zagal’s purported testimony at both

Paragraphs 121 and 122, claiming to analyze this element relative to Ho (including in view of Aoki), effectively just repeats Petitioner’s argument regarding the same on pages 26 and 27 of the Petition, as demonstrated above. Such conclusory, unsupported testimony “adds little to the conclusory assertion for which it is offered to support, and is entitled to little weight.” *Xerox*, IPR2022-00624, Paper 9, at 15.

The Petition and Dr. Zagal’s purported expert testimony are replete with other similar examples of Dr. Zagal’s parroting the Petition. *Compare* Ex. 1003, ¶¶ 118–123 *with* Petition at 25–27; *Compare* Ex. 1003, ¶¶ 124–127 *with* Petition at 28–29; *Compare* Ex. 1003, ¶¶ 172–177 *with* Petition at 44–47; *Compare* Ex. 1003, ¶¶ 178–182 *with* Petition at 47–49; *Compare* Ex. 1003, ¶¶ 183–184 *with* Petition at 49–50.

Petition at 28–29	Ex. 1003, ¶ 124–127
Ho discloses and renders obvious limitation 1(c). Ex. 1003 ¶¶124-128. “designating a non-promotional location in-game associated with activating the hot spot” : Ho discloses that the interactive information elements (<i>i.e.</i> , hot spots) that are activated to display hidden content are “located at a juncture in the game such as... a specific location in the game.” Ex. 1004, 7:17-23; <i>see also id.</i> , 9:33-36 (server may provide the client with a “module” that “enable[s] the at least one interactive information element” and that “may also enable the location of the least one interactive information element at a juncture in the video game.”). Ho’s interactive information	124. In my opinion, Ho discloses or renders obvious this limitation. 125. “designating a non-promotional location in-game associated with activating the hot spot” : Ho discloses that the interactive information elements (<i>i.e.</i> , hot spots) that are activated to display hidden content are “located at a juncture in the game such as... a specific location in the game.” Ex. 1004, 7:17-23; <i>see also id.</i> , 9:33-36 (server may provide the client with a “module” that “enable[s] the at least one interactive information element” and that “may also enable the location of the least one interactive information element at a juncture in the video game.”). Ho’s interactive information

elements are represented by non-promotional objects because they correspond to in-game characters or items, and do not display promotional content until a user has performed a predetermined action. Ex. 1004, 2:11-12, 5:1-7, 5:27-38 (describing how an “on-screen presentation” such as an advertisement is displayed only “[i]f the player chooses to engage any of the interactive information elements”). Thus, the designated location of the interactive information element is a “non-promotion location in-game associated with activating the hot spot.” Ex. 1003 ¶125. “based on the coordinate information”: Ho also discloses that the location of the interactive information elements and hidden content is based on coordinate information provided by the server. Ex. 1003 ¶126. For example, Ho teaches that a server provides the interactive information elements and hidden content, along with the location in-game where they should be displayed. Ex. 1004, 7:17-23; <i>see also id.</i>, 9:33-36 (server may provide the client with a “module” that “enable[s] the at least one interactive information element” and that “may also enable the location of the least one interactive information element at a juncture in the video game.”). By the time of Ho, video games used coordinates extensively to manage and represent the position of objects, characters and elements within	elements are represented by non-promotional objects because they correspond to in-game characters or items, and do not display promotional content until a user has perform a predetermined action. Ex. 1004, 2:11-12 (. . .), 5:1-7 (. . .), 5:27-38 (describing how an “on-screen presentation” such as an advertisement is displayed only “[i]f the player chooses to engage any of the interactive information elements”). Thus, in my opinion, the designated location of the interactive information element is a “non-promotion location in-game associated with activating the hot spot.” 126. “based on the coordinate information”: In my opinion, Ho also discloses that the location of the interactive information elements and hidden content is based on coordinate information provided by the server. For instance, Ho teaches that a server provides the interactive information elements and hidden content, along with the location in-game where they should be displayed. Ex. 1004, 7:17-23; <i>see also id.</i>, 9:33-36 (server may provide the client with a “module” that “enable[s] the at least one interactive information element” and that “may also enable the location of the least one interactive information element at a juncture in the video game.”). By the time of Ho, video games used coordinates extensively to manage and represent the position of objects, characters and elements within the
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the game world. <i>Id.</i>; see §VI.E. A POSITA would thus have understood Ho’s disclosures to teach coordinate information is provided by the server to locate the interactive information elements and hidden content at the appropriate locations in-game. Ex. 1003 ¶126. To the extent Ho does not disclose or render obvious this limitation, the limitation was obvious in view of Aoki. Ex. 1003 ¶127. As explained in connection with limitation 1(b), Aoki discloses that a server may provide an “advertisement image” along with “advertisement placement location data” that specifies the in-game location for the advertisement using “X and Y coordinates.” Applying Aoki’s teaching to Ho, a POSITA would have found it obvious for the server to provide coordinate information that specifies the location where interactive information elements and advertisements should be displayed. Ex. 1003 ¶¶127-128.	game world. <i>Id.</i> In my opinion, a POSITA would thus have understand Ho’s disclosures to teach coordinate information is provided by the server to locate the interactive information elements and hidden content at the appropriate locations in-game. 127. In my opinion, to the extent Ho does not disclose or render obvious this limitation, the limitation was obvious in view of Aoki. As I explained in connection with limitation 1[b], Aoki discloses that a server may provide an “advertisement image” along with “advertisement placement location data” that specifies the in-game location for the advertisement using “X and Y coordinates.” In my opinion, applying Aoki’s teaching to Ho, a POSITA would have found it obvious for the server to provide coordinate information that specifies the location where nonpromotional objects associated with activating the hot spot (interactive information elements) should be displayed, as well as coordinate information for the location of any hidden content that is displayed upon activation.
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Moreover, with respect to the purported motivation(s) to combine the disparate prior art references asserted by Petitioner in the Petitioner—an area on which expert testimony may be critical—the Zagal Declaration again simply restates the attorney argument set forth by Petitioner in the Petition itself, without any

meaningful discussion or elaboration, let alone expertise. *Compare* Ex. 1003, ¶¶ 103–107 *with* Petition at 17–19; *Compare* Ex. 1003, ¶¶ 159–163 *with* Petition at 38–40; *Compare* Ex. 1003, ¶¶ 209–213 *with* Petition at 59–61; *Compare* Ex. 1003, ¶¶ 239–243 *with* Petition at 66–68.

Overall, Dr. Zagal’s declaration is effectively thus nothing more than a copy of the Petition itself, with almost the exact same words in the exact same order. “[M]erely repeating conclusory arguments does not help the Board, the trier of fact in this proceeding, understand the evidence or to determine a fact in issue.” *Man Wah*, IPR2019-00616, Paper 7, at 15–16. Dr. Zagal’s unhelpful declaration should thus be given no weight. *See, e.g., MarkForged*, IPR2022-01431, Paper 7, at 14 (“[Expert’s] declaration testimony on this point is entitled to little to no weight as it merely parrots the Petition.”); *see also Xerox*, IPR2022-00624, Paper 9, at 15 (finding “conclusory” expert declaration that “repeats” assertions from Petition “entitled to little weight”). And without expert testimony, Petitioner cannot satisfy its burden of, at least, supplying limitations missing from the cited prior art and demonstrating a reasonable likelihood of establishing a motivation to combine the cited references.

3) Ho is Not “Printed Publication” Prior Art Within the Meaning of 35 U.S.C. § 311(b)

A patent can be challenged in an IPR “only on the basis of prior art consisting of *patents* or *printed publications*,” 35 U.S.C. § 311(b) (emphasis added)—which

limits available prior art, as a matter of law, to only references that are themselves “a prior art patent or prior art printed publication.” *Qualcomm Inc. v. Apple Inc.*, 24 F.4th 1367, 1375 (Fed. Cir. 2022). Each of Petitioner’s Grounds 1 and 3 thus fails, as each relies on one or more references that is not available as prior art under § 311(b). In particular, Ho (Ex. 1004), an integral reference included in these Grounds (*see, e.g.* Petition at 3), is not a prior art “patent” or “printed publication” as of the ’662 Patent’s priority date of June 26, 2007.

Ho was filed on July 12, 2006, but did not publish until January 17, 2008—*i.e.*, after the June 26, 2007, priority date of the ’662 Patent. Ex. 1004 at 1. And Ho never issued as a patent. Accordingly, Ho is only a “printed publication” under § 311(b) as of the date it became available to the public—*i.e.*, Ho’s publication date, which notably is after the June 26, 2007, priority date of the ’662 Patent. Indeed, the Federal Circuit has repeatedly held that “[t]he statutory phrase “printed publication” . . . mean[s] that ***before the critical date*** [of the challenged patent] the reference must have been ***sufficiently accessible to the public*** interested in the art.” *In re Cronyn*, 890 F.2d 1158, 1160 (Fed. Cir. 1989) (emphasis added); *accord Acceleration Bay, LLC v. Activision Blizzard Inc.*, 908 F.3d 765, 772–74 (Fed. Cir. 2018) (affirming finding in IPR that reference was not “printed publication” because it “was not publicly accessible before the critical date”).

Thus, Ho is not available as prior art, because the effective date of “printed publication” prior art is the date it is “published, *i.e.*, accessible to the public.” *Samsung Elecs. Co. v. Infobridge Pte. Ltd.*, 929 F.3d 1363, 1368, 1370 (Fed. Cir. 2019). Indeed, ““public accessibility”” is “the touchstone in determining whether a reference constitutes a ‘printed publication.’” *Acceleration Bay*, 908 F.3d at 772 (additional quotation marks omitted). And an IPR “petitioner . . . ha[s] the burden to prove [a reference] is a printed publication.” *Id.* Petitioner failed to carry that burden here. Petitioner fails to contend that Ho was publicly accessible prior to the ’662 Patent’s priority date of June 26, 2007. Nor can it. Ho was not published until January 17, 2008. Ex. 1004 at 1. Ho was thus not “accessible to the public” until after the ’662 Patent’s priority date and thus cannot be “printed publication” prior art within the meaning of § 311(b). *See Samsung*, 929 F.3d at 1368.

Petitioner’s suggestion that Ho is “prior art under [] pre-AIA § 102(e)” does not demonstrate otherwise. Petition at 11. Petitioner expressly relies on the ***filing date*** of Ho as the effective prior art date. *See id.* Petitioner, however, cites no authority for the proposition that a patent application that is prior art under only pre-AIA § 102(e) constitutes a “printed publication” under § 311(b) as of its ***filing date***—irrespective of the date the application is ultimately published (if at all).

And there is no legal support for interpreting § 311(b) to permit such “secret prior art” (*OddzOn Prod., Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1402 (Fed. Cir.

1997)) to be available prior art in an IPR. Indeed, applications filed with the PTO “shall be kept in confidence by the Patent and Trademark Office” prior to publication in accordance with controlling protocols. 35 U.S.C. §§ 122(a)–(b). Relatedly, courts have long recognized that a “mere application for patent” is neither a “printed publication” nor a “patent.” *Brown v. Guild*, 90 U.S. 181, 224 (1874); *see In re Wertheim*, 646 F.2d 527, 532 (CCPA 1981) (application “was not ... a patent or printed publication”). And when Congress limited IPRs to “only prior art consisting of *patents* or *printed publications*,” 35 U.S.C. § 311(b) (emphasis added), it necessarily excluded other categories of prior art from the permissible bases for an IPR. Pre-publication “application[s] for patent” under pre-AIA § 102(e) (*i.e.*, “secret prior art”) are among those excluded—in contrast to the “printed publication[s]” under pre-AIA §§ 102(a) and (b). *See* 35 U.S.C. § 311(b).

For all these reasons, Ho (Ex. 1004) is not “prior art consisting of patents or printed publications” under § 311(b) and is therefore ineligible to be prior art in an IPR.³ Accordingly, each of Grounds 1 and 3 fails because it relies on the ineligible Ho reference. *See* Petition at 3.

³ In *Samsung Electronics Co., Ltd. v. Lynk Labs, Inc.*, IPR2022-00149, Paper 33, at 10–12 (P.T.A.B. June 26, 2023)—a non-precedential decision—another panel held to the contrary. But that decision is incorrect for all the reasons set forth above.

IV. CONCLUSION

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

Dated: February 26, 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 Preliminary Response contains 12,108 words according to the word-processing program used to prepare this paper. The foregoing word count complies with the 14,000 word type-volume limit specified by 37 C.F.R. § 42.24(b)(1).

Dated: February 26, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

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

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