

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PLR WORLDWIDE SALES LIMITED,

Petitioner,

v.

FLIP PHONE GAMES, INC.,

Patent Owner.

Case No. IPR2024-00209

U.S. Patent No. 9,427,662

PETITIONER'S PRELIMINARY REPLY

The Preliminary Response is devoted almost entirely to discretionary denial-based arguments. Though they all lack merit, the Board has granted permission to address two.¹ *First*, Section 325(d) does not warrant denial because Ho, Aoki, Jiau, and Kim are not substantially the same as art cited during prosecution. *Second*, Petitioner’s claim construction positions are not inconsistent.

I. SECTION 325(D) DOES NOT WARRANT DENIAL

PO incorrectly argues that the Petition’s prior art references—Ho, Aoki, Jiau, and Kim, none of which were cited or considered by the examiner—are “substantially the same” as the Chu and Lauper references.

PO’s 325(d) analysis fails to meet the standard for discretionary denial. In determining whether art is “substantially the same prior art,” PO must establish that “Petitioner relies on [the new art] in substantially the same manner as the Examiner cited [the previous art] during prosecution such that [the new art] discloses substantially the same information as [the previous art] in relevant part.” *Advanced Bionics*, IPR2019-01469, Paper 6 at 15 (P.T.A.B. Feb. 13, 2020) (precedential). PO fails to do this, merely arguing there are irrelevant similarities.

¹ To the extent PO argues it is improper for Petitioner to bring new arguments regarding these two issues, that is clearly foreclosed by the Board’s finding of good cause for this Reply because PO’s arguments were not foreseeable.

Indeed, Ho, Jiau, Aoki, and Kim disclose the very limitations that were the basis for allowance. As explained in the Petition (Pet. 9-10) and the POPR (POPR 9-13), the examiner rejected PO's claims under the combination of Lauper and Chu, finding that Chu's "pit stop location" is a "non-promotional location" designated using coordinate information that triggers an advertisement. Ex. 1002, 47-48. PO overcame this rejection by adding the limitation "displaying an object in the designated non-promotional location" and arguing that Chu does not disclose any object being displayed at the pit stop. *Id.*, 26, 30, 13.

The Petition clearly distinguished Ho, Jiau, Aoki, and Kim from such art, explaining how they disclose "displaying an object in the designated non-promotional location" "based on coordinate information." Pet. 10, 28-30, 47-50. Ho discloses in-game characters or items at "specific locations" that trigger advertisements when interacted with. Ex. 1004, 2:11-12, 5:1-7, 5:27-38; Pet. 28-30. Jiau similarly discloses, for example, "an object ... having a hot spot link" in Figure 11(e). Ex. 1006, 16:30-32, 11:18-12:12; Pet. 47-50. And as the Petition explained, Ho and Jiau disclosed (or rendered obvious in view of Aoki or Kim) designating these locations based on coordinate information. Pet. 28-30, 47-50, 62, 69.

PO ignores these distinctions. For example, PO argues that, like Chu, Ho "discloses a game component ... at a location in the game"—yet unlike Chu, Ho discloses discrete objects, not just game components like a "pit stop location." Pet.

28-30. PO also argues that, like Lauper, Jiau discloses “promotional signs,” ignoring Jiau’s disclosures of “object[s]” at a specific “hot spot” location as claimed. Pet 47-50. As for Aoki and Kim, whatever similarities they have with Chu and Lauper is not relevant to how Petitioner used those references—in combination with Ho and Jiau to render obvious “coordinate information”—nor the manner in which the Examiner found the claims overcame Chu and Lauper, which was their failure to disclose “displaying an object in the designated non-promotional location.”

II. THERE IS NO INCONSISTENT CLAIM CONSTRUCTION HERE

PO accuses Petitioner of “abuse of process” because Petitioner contended in the District Court that some terms are indefinite or should be construed. POPR 21-26. But Petitioner’s positions are not inconsistent. *See* Pet. 11 (“Petitioner does not believe any terms require construction ***to resolve the patentability disputes*** because the challenged claims are rendered unpatentable by the cited art under any reasonable interpretation of the claims. Petitioner takes no position ... as to whether the claims are indefinite”); Ex. 1003, ¶¶79-80.

It is axiomatic that one may “ascribe some meaning” to a term that is nevertheless indefinite. *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898 (2014); *Interval Licensing, LLC v. AOL, Inc.*, 766 F.3d 1364, 1371-72 (Fed. Cir. 2014) (terms indefinite for lack of objective boundaries). As a result, the Board “need not necessarily determine the outer boundaries of a claim” to decide “whether

the asserted prior art anticipates a claim or renders it obvious.” *Mylan Pharms. Inc. v. Horizon Pharma USA*, IPR2017-01995, Paper 72 at 5-6 (Mar. 28, 2019); *Standard Oil Co. v. American Cyanamid Co.*, 774 F.2d 448, 453 (Fed. Cir. 1985) (affirming indefiniteness and obviousness).

Here, the claims require in-game “non-promotional” objects. Though the outer boundaries of that term may be indefinite (it likely excludes billboards, but does it exclude a Jumbotron screen?), there are clearly in-game objects that no user would expect to be used for promotional advertising. The Petition identifies where the prior art discloses such non-promotional objects. There is nothing inconsistent with arguing in the litigation that the full scope of the claim is undetermined, while arguing here that the limited scope of the claims are found in the prior art.

As for “preset location,” this limitation is merely one of several items in a disjunctive list. Ex. 1001, cl. 1. The Petition explains how Ho and Jiau disclose several of those items—but not “preset location.” Pet. 22 (Ho discloses “current location,” “scene,” “element,” “model type”); Pet. 43-44 (Jiau discloses “scene,” “element,” “user-identification information”). There is nothing inconsistent with arguing that “preset location,” and therefore the full scope of the claims, is indefinite, while arguing here that the other limitations in the disjunctive list are disclosed.

Even if Petitioner’s claim constructions were inconsistent, denial would nevertheless be inappropriate. The Board has consistently found that Petitioner may

rely on a construction it believes is incorrect—such as Patent Owner’s construction that terms are definite. IPR2018-00082, Paper 11 at 12 (Apr. 25, 2018) (“Petitioner [need not] express its subjective agreement regarding correctness of its proffered claim constructions”); IPR2020-00921, Paper 13 at 42-44 (Aug. 5, 2021) (“[A] petitioner [can] rely[] on claim constructions that it believes are incorrect.”).

None of the decisions Patent Owner relies on hold otherwise. In *Resmed* and *Kiosoft*, the Board held that in the context of *Fintiv* Factor 6 regarding the **merits** of the Petition, inconsistent positions favored denial. But as explained by Petitioner, which Patent Owner does not dispute, the *Fintiv* factors overall do not favor denial. Pet. . In *Comcast*, the Board denied CBM review because of a means-plus-function claim construction issue that was not raised in a parallel IPR proceeding and was “central” to both trials. CBM2018-00033, Paper 9, at 7, 11. But the terms at issue here are not means-plus-function terms, nor are they central to this trial. *Facebook* similarly turned on Petitioner’s failure to construe means-plus-function terms pursuant to 37 C.F.R. § 42.104(b)(3). IPR2017-00998, Paper 13, at 16-17. No means-plus-functions terms are at issue here. The Board also faulted Petitioner for failing to disclose its district court claim construction positions. *Id.*, at 17. Here, however, Petitioner’s claim construction positions were not made or disclosed until nearly three months **after** the Petition was filed. Ex. 2001 (dated January 30, 2024).

For the foregoing reasons, institution should not be denied.

Date: March 25, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on March 25, 2024, true and correct copies of the foregoing document were served in its entirety on the following parties via Electronic Mail

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