

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PLR WORLDWIDE SALES LIMITED,
Petitioner,

v.

FLIP PHONES GAMES INC.,
Patent Owner.

Case No. IPR2024-00209
U.S. Patent No. 9,427,662

PETITIONER'S REPLY

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EXHIBIT LIST

Ex.	Description
1001	U.S. Patent No. 9,427,662 to Hartwell
1002	Prosecution history for U.S. Patent No. 9,427,662
1003	Expert Declaration of Dr. José Zagal
1004	International Patent Publication WO 2008/008038 to Ho
1005	U.S. Patent Publication No. 2002/0120589 to Aoki
1006	International Patent Publication WO 2000/070489 to Jiau et al.
1007	U.S. Patent No. 6,928,414 to Kim et al.
1008	International Patent Publication WO 2006/071246 to Sturman
1009	U.S. Patent No. 8,825,521 to Ellis et al.
1010	Steven Kent, <i>The Ultimate History of Video Games</i> (2001)
1011	Frans Mayra, “Mobile Games,” in <i>the International Encyclopedia of Digital Communications and Society</i> , 1 st ed. (2015)
1012	N. Leavitt, “Will wireless gaming be a winner?” in <i>Computer</i> , Vol. 36, No. 1, pp. 24-27 (Jan. 2003)
1013	Jason Soh & Bernard Tan, “Mobile Gaming,” in <i>Communications of the ACM</i> , Vol. 51, No. 3, pp. 35-39 (Mar. 2008)
1014	Michael Zyda et al., “Educating the Next Generation of Mobile Game Developers,” in <i>IEEE Computer Graphics and Applications</i> , Vol. 27, No. 2, pp. 92-96 (Mar./Apr. 2007)
1015	Mark Andrejevic, “Productive Play 2.0: The Logic of In-Game Advertising” in <i>Media International Australia</i> , Vol. 130, No. 1, pp. 66-76 (Feb. 2009)

1016	Ilya Vedrashko, <i>Advertising in Computer Games</i> (Doc. No. 123290221) [Master's Thesis, Mass. Inst. of Technology], DSpace@MIT
1017	Exit Games, <i>In-Game Advertising Goes Mobile</i> [Press Release] (Mar. 21, 2006)
1018	Jussi-Pekka Partanen, <i>Mobile Gaming: A Framework for Evaluating the Industry 2000-2005</i> (2001)
1019	Exemplary infringement charts for U.S. Patent No. 8,688,662 served by Patent Owner in <i>Flip Phone Games Inc. v. PLR Worldwide Sales Ltd.</i> , No. 2:23-cv-139 (E.D. Tex.)
1020	U.S. Publication No. 2003/0100355 A1 to Hannay
1021	Forest J. Handford, East Coast Games – Game Development Glossary (Feb. 20, 2006), available at https://web.archive.org/web/20060220024505/http://www.eastcoastgames.com/design/glossary.html
1022	U.S. Publication No. 2006/0111979 to Chu
1023	Andre LaMothe, <i>Tricks of the 3D Game Programming Gurus</i> (2003)
1024	Game Hacking Academy, <i>A Beginner's Guide to Understanding Game Hacking Techniques</i>
1025	Tiger Woods PGA Tour 07, March 26, 2007, available at https://www.pocketgamer.com/tiger-woods-pga-tour-07/tiger-woods-pga-tour-07/
1026	“download,” Merriam-Webster Dictionary, available at https://www.merriam-webster.com/dictionary/download
1027	U.S. Pat. No. 6,496,189

Patent Owner Flip Phones Games Inc.'s ("PO") Response ("POR") does not raise any persuasive reason to preserve the validity of the challenged claims, as shown below.

First, PO argues that the prior art does not disclose a mobile device that sends at least one of the following pieces of information to a server: "a game for which hot spot information is desired, a scene for which hot spot information is desired, an element for which hot spot information is desired, the model type of the mobile communication device, the service plan to which the mobile device belongs, the service provider for the mobile communications device, the base location of the mobile communication device, the current location of the mobile communication device, a version identifier for hot spot information currently on the mobile communication device, user-identification information, preset location, amount of game-play time, game score, and level of play." Any one of these pieces of information renders Claim 1 unpatentable. Petitioner showed that the prior art discloses sending not just one, but many of these pieces of information (including "user-identification information" that is recited in Claim 13). PO's response mischaracterizes or ignores clear and express disclosures found within the prior art.

Second, PO argues that Ground 2 does not disclose "downloading" hot spot information from a server, but rather "caching it." PO's argument relies upon an erroneous interpretation of downloading that excludes caching, and, in any event,

mischaracterizes the prior art which discloses downloading under any reasonable interpretation of that term.

PO's remaining arguments—that Petitioner's expert declaration should be given no weight and that 102(e) prior art is not available in IPR—are simply unpersuasive and are inconsistent with the Board's prior decisions.

I. GROUND 1: HO-AOKI RENDER OBVIOUS CLAIMS 1-11, 13-19

A. Independent Claim 1

Ground 1 of the Petition established that Claim 1 of the '662 patent was obvious based on Ho in view of Aoki. Paper 1 ("Pet."), 11-36. PO argues in Response that Petitioner has failed to show the Ho-Aoki combination discloses Limitation 1[a]. Paper 12 ("POR"), 10-25. Limitation 1[a] identifies numerous pieces of information that can be provided to a server, any one of which would meet the claims:

contacting a server for hot spot information to download, comprising providing the server with **at least one of:** [1] a game for which hot spot information is desired, [2] a scene for which hot spot information is desired, [3] an element for which hot spot information is desired, [4] the model type of the mobile communication device, [5] the service plan to which the mobile device belongs, [6] the service provider for the mobile communications device, [7] the base location of the mobile communication device, [8] the current location of the mobile communication device, [9] a version identifier for hot spot information currently on the mobile communication device, [10] user-identification information, [11] preset location, [12] amount of game-play time, [13] game score, and [14] level of play.

Ex. 1001, cl. 1 (enumerated). PO does not dispute that the prior art discloses contacting a server for “hot spot information to download.” *Id.* Rather, PO disputes only whether the client device provides the server with “at least one” of the pieces of information that is underlined above. This is the sole challenge that Petitioner raises against the Ho-Aoki combination for Claim 1.

As demonstrated below, Petitioner’s argument mischaracterizes the prior art and ignores its disclosures. Ho *and* Aoki both disclose this limitation.

1. Ho (Ex. 1004)

Petitioner demonstrated that Ho discloses Limitation 1[a] in multiple ways. For instance, Petitioner showed that Ho discloses a client providing the server with (i) “the model type of the mobile communication device”; (ii) “the current location of the mobile communication device”; (iii) the “scene” or “element” “for which hot spot information is desired”; or (iv) “a version identifier” for an interactive information element. Pet., 22–24. PO fails to meaningfully rebut Petitioner’s showing.

The Response and PO’s expert repeatedly rely upon Ho’s disclosure that hot spots may be added or uploaded to the game by “***automatically*** downloading and replacing relevant sub-modules of the interactive information element[] in the video game ***whenever the player goes online.***” POR, 12 (citing 9:29-33) (emphasis added by PO). PO and its expert interpret this disclosure to mean that Ho’s system does

not send any information to the server. *Id.*; *see also* Ex. 2006, ¶¶61 (“Ho makes clear that when a client device goes ‘online,’” the server in Ho ‘automatically’ determines and sends interactive information element to the client device—without any affirmative provision of information by the client device to the server.”), 62 (same), 66 (same), 69 (same), 77-78 (same).

But PO misinterprets Ho; indeed, when read in full context, it is plain that its disclosure supports *Petitioner’s* arguments. Indeed, Ho expressly teaches that, for example, information the server can transmit includes “emergency warnings to players of video games” based on where the user is located, such as “only” sending a notification to a particular “state/country/affected area.” Ex. 1004, 9:7-18, 6:25-36. As Petitioner’s expert explained, it would have been obvious to a POSITA that for the server to send warnings to players only in particular locations, those players’ devices must provide location information to the server. Pet. 22; Ex. 1003, ¶114. PO ignored this analysis in the Response.

Moreover, Ho’s reference to “automatically downloading” a hot spot does not preclude the device from contacting the server and sending information. As Ho explains, “automatically downloading” means that the client “connect[s] to the server to carry out this method,” *i.e.* automatically establishes a connection without affirmative action by the user, and provides any necessary information to carry out the method, such as model type, current location, scene or element, version

identifier. Ex. 1004, 10:21-25. It does not in any way suggest that the client does not send **any** information to the server. Thus, PO's argument should be rejected because it relies upon a mischaracterization of Ho.

PO's other arguments are discussed below and are equally unpersuasive.

Model Type: The Petition established that Ho discloses providing the server with a "model type of the mobile communication device." Pet., 23. Petitioner's expert explained that mobile telephones had different capabilities (*e.g.*, screen sizes, resolutions, and operating systems), such that a POSITA would have understood or found it obvious to provide the server with the model type of the mobile phone so that hot spot and advertisement information that is returned by the server is compatible or optimized for the mobile phone type. Ex. 1003, ¶¶115, 44.

PO argues in Response that there is no need to provide the "model type" because at the time of the '662 patent "a mobile game was generally designed for only a specific device." POR at 13. PO and its expert do not provide any supporting evidence for this assertion, and the evidence plainly establishes PO is incorrect. For example, Ho discloses that its video game is designed to run on a variety of mobile devices, including a "mobile telephone," a "personal digital assistant" (PDA), a "notebook or a desktop computer," and others. Ex. 1004, 4:8-10, Claim 6. Other contemporaneous publications likewise explain that mobile games were designed to be played on different devices having different capabilities. Ex. 1013, 3 (Table 2,

showing games were designed for platforms, such as Java, that could run across a variety of devices). As just one example, in 2007, Tiger Woods PGA Tour 07 was available for mobile phones with different capabilities and manufacturers, such as phones from Sony Ericsson and Nokia. Ex. 1025.

Current Location: The Petition likewise established that Ho discloses providing the server with the location of the mobile device so that hot spot information and warnings can be targeted to a geographic area. Pet., 22; Ex. 1003, ¶¶113-114. PO argues in response that Ho’s “functionality ‘facilitates the **instant transmittal** of emergency warning to players of video games.’” POR, 16 (citing Ex. 1004, 9:13–15 (emphasis in original)). It is not clear how the reference to “instant transmittal” support PO’s argument, but the portion of this quote that PO truncates undermines its argument. The full quote in Ho reads as follows that the functionality “facilitates the instant transmittal of emergency warnings to players of video games (**preferably in a particular state/country/affected area only**).” Ex. 1004, 9:13–15 (emphasis added). As discussed above, Ho’s disclosure that warnings can be targeted to the geographic location of the mobile device teaches, or at least renders obvious, providing the server a location of the mobile device.

PO also argues that Ho’s disclosures regarding providing the location of the mobile device relate only to “emergency warning[s],” which PO argues are not hot spots. POR, 16. PO is wrong. Petitioner established that activating a hot spot may

display advertisements specific to geographic locations, such as an advertisement for a “fast food chain.” Pet., 22. PO’s sole response is that “the advertisements taught by Ho are with respect to ubiquitous brands, such as ‘airliner[s]’ and ‘chain[s] of fast food restaurants’ (Ex. 1004 at 5:27–38, 8:11–21), suggesting that Ho envisions its advertisements need not be based on ‘the current location’ of the player.” POR, 17. PO’s argument is easily rejected. Fast food chains are specific to locations. Displaying an advertising for the California fast food chain In-N-Out to users in a state or country where In-N-Out does not exist would not make sense. Airlines may also differ by state or country. PO fails to rebut Petitioner’s argument or show that this limitation was not obvious in view of Ho’s disclosures.

Scene or Element: The Petition established that in order to download an interactive information element and the associated hidden advertising content that is presented to the user when the information element is activated,¹ Ho teaches that its mobile device provides the server with information about the scene or element for which hot spot information is desired. Pet., 22. PO fails to meaningfully rebut this argument. For instance, PO fails to rebut Ho’s disclosure that “the server may obtain data from the client end device [*i.e.*, mobile communication device] and determine whether the interactive information element(s) is legitimate”; if legitimate, the server

¹ For example, a hamburger monster and the hidden advertising content that appears when the hamburger monster is slayed

determines if the element needs to be “changed/renewed” and sends back the appropriate interactive information element and hidden content. Ex. 1004, 10:14-19; Pet., 23 (citing to Ex. 1004, 10:14-19). Similarly, PO fails to rebut Ho’s disclosure that the server obtains information from the mobile communication device to allow it to “download[] and replac[e] relevant submodules” (scenes). Ex. 1004, 9:25-27; Pet., 23 (citing Ex. 1004, 9:25-27). These disclosures make clear that the information provided includes a scene and/or element for which hot spot information is desired.

Version identifier: It is undisputed that Ho discloses that its mobile device provides the server with information that permits the server to determine whether a “module” of the game (which may be “added to the video game” after it is published) needs to be “updated” or “replaced” and/or whether interactive information elements “need[] to be changed/renewed.” Pet., 23. PO argues that Ho does not explicitly state that it provides the server with a “version identifier. But merely because the term “version identifier” is not explicitly mentioned does not negate the fact that the act of determining whether a change or renewal is needed requires a mechanism for tracking versions or updates and acting upon the version information to initiate updates or renewals. Indeed, Petitioner and its expert established that a POSITA would have understood Ho’s disclosure to teach, or at least render obvious, “providing the server with ‘a version identifier’ for the interactive information

element so that the mobile phone can keep track of whether the version on the mobile phone is the latest version.” Pet., 23.

PO also argues, without support, that Ho’s server could instead determine whether an update is necessary by tracking when the module or interactive information element was “last modified” for the client. To the extent PO is suggesting that Ho’s client device would provide the server with “last modified” information, that would be a type of version identifier. To the extent the PO is suggesting that the server would somehow maintain that information, PO fails to provide any support for its assertion. For instance, PO does not explain how the server would track last modified information for every client device that communicates with the server, how long that information would be maintained, and what happens if a client device connects after the server has rewritten or replaced the last modified information. In any event, PO’s argument is a strawman. Petitioner is not arguing inherency. Rather, Petitioner argued that a POSITA would understand the disclosure to teach providing a version identifier as one way for the server to change or update the modules and elements, or that it would at least be obvious. Petitioner also included corroborating evidence that confirmed version identifiers are used to determine if gaming modules or elements need to be changed or renewed. Ex. 1020 (U.S. Pub. No. 2003/0100355), [0019] (“When new levels and/or versions are applied to the game the content provider modifies the games content. Modified

games content has an associated identifier tag that identifies the version that has been used in its construction.”). PO fails to rebut Petitioner’s showing.

2. Aoki (Ex. 1005)

Petitioner also demonstrated that Aoki renders obvious Limitation 1[a] by providing the server with [1] “user-identification information” and [2] “a game for which hot spot information is desired.” Pet., 24. PO does not dispute that Aoki discloses a mobile device providing a server with “user information, such as the ID of the player who uses the game terminal” and the user’s “age, sex, profession, and so forth.” Ex. 1005, [0077], [0088]. Nor does PO dispute that Aoki discloses that the mobile device also provides a server with a “game ID identifying a game.” *Id.* PO argues only that Aoki fails to render this limitation obvious because the user-identification information and game ID in Aoki are utilized to determine advertisement charges after an advertisement is provided. POR, 22-23.

PO’s argument is a strawman, because it ignores that Petitioner’s argument is based on **obviousness**. Petitioner established that Aoki provides user-identification information and a game ID to a server, and that a POSITA would have been motivated to modify Ho so that the mobile communication device provides the server with this information when downloading hot spot information. Pet., 24. PO’s expert claims that Petitioner failed to articulate a valid motivation to combine (Ex. 2006, ¶¶77-78), but simply ignores the overwhelming evidence Petitioner presented

on this issue. For instance, Petitioner’s expert Dr. Zagal explained that a POSITA would have been motivated to make the proposed modification because the user-identification and game ID would allow Ho’s system to provide hotspot information—which includes advertisements that are displayed upon engagement of the hot spot (*e.g.*, slaying the hamburger monster)—that is targeted to specific users. Pet., 24; Ex. 1003, ¶¶104-07. PO failed to rebut any of this evidence.

Petitioner also supported its argument with corroborating evidence. For instance, Petitioner’s expert explained that prior to the ’662 patent, advertisers, such as Massive Incorporated, began partnering with game developers to provide targeted advertisements in video games. Ex. 1003, ¶18. Petitioner also relied on a prior art patent assigned to Massive (Ex. 1008, Sturman) that provides an express motivation to combine by explaining that it is desirable for a mobile device to provide a server with user-identification information and the game ID so that the advertisements in the video game can be targeted to the user: “Player-specific information may also be used for targeting, and may include player geographic information (*e.g.*, country, region/state, city, and Direct Marketing Associate (DMA) areas), and player demographics (*e.g.*, gender, age, purchase history, etc.), and game play behavior (*e.g.*, play 80% of time on weekends, play sports titles and racing only, play for average of 4 hours per game session, etc.).” Pet., 24 (citing Ex. 1008, [0054]-[0055]). It is well-settled that the motivation to combine may be set forth in

contemporaneous prior art references. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (“Often, it will be necessary for a court to look to interrelated teachings of multiple patents ... in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.”).

The desirability of applying this known technique—providing user-identification information to a server—to permit and enhance targeted advertisements was well-known and common sense (*e.g.*, to avoid providing certain commercials to children) by the time of the ’662 patent. Ex. 1022, [0042]-[0043] (explaining that user-identification information, such as age, can be used to target advertisements displayed in-game, for instance “a player must [be] 21 years or older to be allowed to view the advertisement that contains a free coupon for a six pack of beer.”); Ex. 1009 (Ellis) at 17:47-63 (“game client system [may] specify certain genres, or classes of ads that are not acceptable to that game client... An example genre of ads may be beer or other alcohol type ads, which should not be targeted to those too young to purchase such products.”).

Thus, Petitioner has established that a POSITA would have been motivated to modify Ho so that “the client end device would continue to download from the server interactive information elements and hidden content, and would do so after providing the server the ID of the player (‘user-identification information’) and a game ID (‘a game for which hot spot information is desired’).” Pet, 24.

In addition, PO's argument also ignores the claim language, which recites "contact[ing] a server for hot spot information to download, comprising providing the server with ... a game for which hot spot information is desired ... [or] user-identification information." *See, e.g.*, Claims 1 and 13. The claim language does not specify a purpose for the claimed information or require that it be used to download the hot spot information. It merely requires that the information be provided to the server when requesting hot spot information. The proposed combination of Ho-Aoki clearly discloses this limitation.

B. Independent Claim 13

Limitation 13[a] recites "contacting a server for hot spot information to download, comprising providing the server with user-identification information." For this limitation, PO merely refers back to its arguments for Limitation 1[a]. POR, 27 ("For the same reasons as discussed above with respect to claim 1(a), Petitioner has failed to carry its burden of demonstrating that Ho, in view of Aoki, discloses or renders obvious "contacting a server for hot spot information to download, comprising providing the server with user-identification information," as required by claim 13."). This argument lacks merit for the reasons discussed above. *See* Section I.A. The Ho-Aoki combination satisfies Limitation 1[a] by providing the server "user-identification information" (*i.e.*, the ID of the Player). Section I.A.2.

C. Dependent Claims 2-11 and 14-19

Claims 2-11 and 14-19 depend (directly or indirectly) on Claims 1 and 13. PO does not raise any additional arguments for these limitations. POR, 25-26, 28-29. These claims are invalid for the same reasons discussed above. Section I.A-B.

D. Ho is Prior Art because it is a “Printed Publication”

The Petition established that Ho is prior art under at least pre-AIA 35 U.S.C. §102(e) because its filing date is before the priority date of the ’662 patent. Pet., 11. PO argues that §102(e) art is not available in an *Inter Partes Reviews*. POR, 30-32.

PO’s argument has been expressly rejected in recent decisions from the Director and the Board. For instance, in connection with a related patent the Director rejected PO’s argument that Ho is not prior art. *See PLR Worldwide Sales Ltd. v. Flip Phone Games, Inc.*, Case No. IPR2024-00133, Paper 12 at 8, n.6 (Aug. 22, 2024) (“I reject Patent Owner’s argument that the Ho reference (Ex. 1004) is not ‘prior art consisting of patents or printed publications’ under 35 U.S.C. § 311(b).”). The Board also rejected this same argument in other recent decisions. *Samsung Electronics Co., Ltd. v. Lynk Labs, Inc.*, IPR2022-00149, Paper 33, 10-12 (June 26, 2023); *Patent Quality Assurance, LLC v. VLSI Tech. LLC*, IPR2021-01229, Paper 129, 27–29 (June 13, 2023); *Purdue Pharma L.P. v. Iancu*, 767 F. App’x 918, 925 (Fed. Cir. 2019).

II. GROUND 2: JIAU-AOKI RENDER OBVIOUS CLAIMS 1-20

A. Independent Claim 1

Ground 2 of the Petition showed that Claim 1 of the '662 patent was obvious based on Jiau in view of Aoki. Paper 1 (“Pet.”), 36-57. In response, PO argues that Petitioner has failed to show the Jiau-Aoki combination discloses Limitation 1[b]:

downloading hot spot information from the server to the mobile communication device, the hot spot information compromising...

Paper 12 (“POR”), 33-37. Notably, PO does not dispute that the prior art discloses “hot spot information.” *Id.* Rather, PO’s dispute is limited to whether the prior art discloses or renders obvious that the client device “download[s]” the hot spot information. More specifically, PO argues that Jiau discloses “real-time fetching” of the hot spot information, and not “saving it for later access.” *Id.* For this reason, PO claims that the “downloading” language of Limitation 1[b] is not satisfied. This is the sole argument PO raises for Claim 1. As explained below, PO’s argument misrepresents Jiau rests on an erroneous, unsupported interpretation of “downloading.”

First, Jiau discloses saving hot spot information for “later access.” For instance, the Petition established that Jiau discloses that a “lot file” is “stored” by the client system, such as the lot file shown in Figure 17, containing object information, coordinate information, and links, that when activated displays an advertisement or information that may be fetched from a website. Pet., 44-46; Ex.

1006, 19:27-20:3 (“Fig. 17 shows an example of a file format describing a lot and the objects therein.... The lot file is preferably sent to the client and stored in the client in the format shown.”). Jiau also discloses that a client system can request lots and objects stored on a server, and further states that “it is also understood that certain portions of the server database for objects and lots are stored in the client side.” Ex. 1006, 7:4-6, 13:8-18 (“[i]t is possible that these lots (or any lots shown as fetched from the server) are stored in cache or a similar local memory in the user’s system 106.”), (“all information about a user’s own lots and objects are assumed to be located in his client system.”). Jiau also states that the client systems have “appropriate data storage, such as memory or mass-storage devices.” *Id.*, 7:7-9. Thus, Jiau discloses, or alternatively renders obvious, “downloading.”

Second, PO admits that hot spot information in Jiau is “cached by the client system.” POR, 35. However, PO argues that caching does not disclose “downloading.” POR, 35. The plain meaning of the term “downloading” broadly encompasses copying data from a server into memory, including a cache memory. Ex. 1026 (Meriam-Webster) (“downloading” is “an act or instance of transferring something (such as data or files) from a usually large computer to the memory of another device (such as a smaller computer).”); Ex 1027 at 11:63-67 (“Cache manager 74 downloads from server 26 the blocks 42 and/or sub-blocks 43 required by renderer 72, if they are not already stored in cache memory 32, and meanwhile

provides replacement blocks from the cache memory.”). PO’s own cases support this definition. For instance, *Finisar Corp. v. DirectTV Group, Inc.* involved a patent that recited “downloading into a memory storage device those of said received data packets which match said specified set of requested data packets.” 523 F.3d 1323, 1329 (Fed. Cir. 2008). The Federal Circuit found that “fleeting or transient retention does not qualify as the kind of downloading defined by these claims,” but expressly noted that “storage need not be permanent” and that the specification disclosed “downloading... requests into a ‘smart cache.’” *Id.* at 1332 (emphasis added). PO’s reliance upon a more than decade old case from the Western District of Wisconsin—*MOAEC, Inc. v. Pandora Media, Inc.*, 2008 WL 4500704, (W.D. Wis. Sept. 30, 2008)—is also misplaced. Relying upon *Finisar*, the district court simply concluded that downloading in that context required “something more than just transient retention of data.” *Id.* at *7.

Third, the Petition demonstrated that this limitation was also obvious in further view of Aoki. Pet., 46-47. Aoki renders obvious “downloading” hotspot information that includes “advertisements to be displayed in a video game” when a hot spot is activated and “coordinate information.” *Id.* The information downloaded by Aoki is hot spot information. See ‘662 patent at Claim 1 (“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”). And PO does not address this argument. POR at 37. Thus, the combination of Ho and Aoki provides a further reason to find Claim 1 unpatentable.

B. Independent Claim 13

Limitation 13[a] recites “contacting a server for hot spot information to download, comprising providing the server with user-identification information.” For this limitation, PO repeats its “downloading” argument, which was discussed in connection with Claim 1. POR, 53. PO also argues that Jiau-Aoki does not disclose providing the server with “user-identification information.” PO is wrong.

Jiau discloses providing user-identification information: PO argues that Jiau does not expressly teach that the user id is sent from the client device to the server. POR, 48. PO’s argument ignores Jiau’s disclosures. The Petition showed that Jiau’s client devices provides a “user id” (user-identification information”) to the server “in order to access and download the lots and objects” (hotspot information). Pet., 43. Indeed, Jiau states that “each lot in the virtual world has an ownership attribute identifying the user who registered it and owns it” (Ex. 1006, 2:4-11) and that “[a] user can set permissions indicating who else can alter, visit, or otherwise view or copy his lot.” (*id.*). Thus, Jiau discloses that a mobile device and a server exchange information, including user-id information that is used to determine whether the user can access a lot. Jiau also discloses that “[t]he data structure of Figure 13(a) [lot

properties] is an example of the information sent between the server system and the client system.” Ex. 1006, 17:14-24, Fig. 13(a). PO admits that the lot ID in this structure is provided by the mobile device to server (POR, 47) but overlooks that Jiau discloses that the structure also includes a user ID that is sent. *Id.*

Aoki. Petitioner also demonstrated that Aoki renders obvious Limitation 13[a] by providing the server with user-identification information. Pet., 43-44. PO repeats the same rebuttal to Aoki that it presented for Ho in connection with Ground 1. *See* POR, 49-50. Thus, PO’s argument fails for the reasons discussed above.

PO further argues that there is no motivation to modify Jiau in view of Aoki, POR, 51-52. In particular, PO argues that presenting targeted advertising to Jiau’s user based on user-identification information is “contrary to [the] intended purpose of Jiau” because, according to PO, Jiau discloses that “each virtual lot—including the objects therein and their associated hotspots—are stored on a remote server for common access by all ‘client systems’ of Jiau.” *Id.* PO’s argument is easily dismissed. Jiau discloses that each lot (and its objects) are registered and owned by a particular user. Ex. 1006, 2:4-11 (“each lot in the virtual world has an ownership attribute identifying the user who registered it and owns it.”) The fact that other users may browse certain of the registered user’s lots does not mean that it is not desirable to target the advertisement to the user of the lot or other users who have permission to access the lot. For instance, Jiau provides an example in which a lot

includes advertisements for “Forever21,” such as an associated “Forever21Link.” Ex. 1006, Fig. 17. Forever21 is a fashion retailer whose target audience is young people, and it would have therefore been obvious to utilize user-identification information provided by the mobile device to target this advertisement to those lots which are registered to users who fit the target profile.

C. Dependent Claims 12 and 20.

Claim 12 and 20 recites that “the hidden content comprises a second hot spot.” Petitioner showed that Jiau discloses and renders obvious this limitation. Pet., 55-56. For instance, Figure 11(e) of Jiau shows an object 1192 (*e.g.*, a building) that has a first hotspot link 1194 (*e.g.*, a door) that when activated reveals a hidden second hot spot (*e.g.*, furniture within object 1192) shown in Figure 11(f):

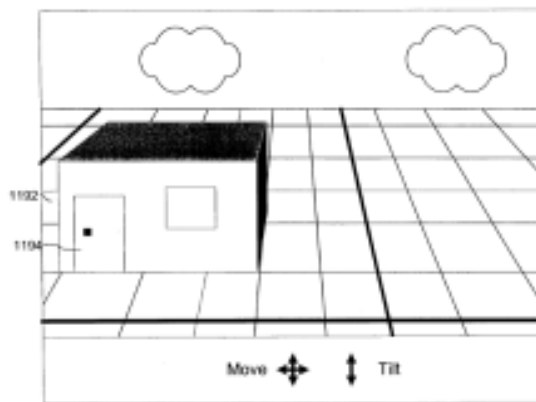


Fig. 11(e)

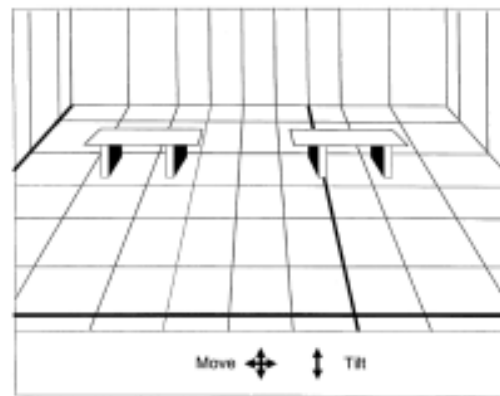


Fig. 11(f)

POR, 56. In response, PO argues that Jiau does not expressly state that the furniture within object 1192 is a “hotspot” that may be activated to reveal hidden content. POR, 45. PO’s argument ignores Jiau’s disclosures. Jiau states that “an object may

be associated with ‘a plurality of hotspots’ and that each hotspot may be ‘activated separately’ with ‘different hotspot activities associated therewith.’” Pet., 55-56 (Ex. 1006, claim 8-10). In the above example, it is undisputed that the door to the building is a first hot spot link that is activated to enter the interior of the room. Jiau’s disclosures that there is a “plurality of hotspots” and that each may be “activated separately” with different “activities associated therewith” discloses and renders obvious that the interior of the object (*e.g.*, the furniture) includes a second hotspot that can be “associated” with a separate activity (*e.g.*, walking into the furniture can display a hidden advertisement). Ex. 1006, 12:1-2 (“object with associated action - walking into this type of object will cause the user to view an action, such as a pop-up ad or an animation.”). Thus, Jiau satisfies this limitation.

D. Dependent Claims 2-11 and 14-19

Claims 2-11 and 14-19 depend (directly or indirectly) on Claims 1 and 13. PO does not raise any additional arguments for these limitations. POR, 25-26, 28-29. These claims are invalid for the same reasons discussed above. Section II.A-B.

III. GROUNDS 3 AND 4

Ground 3 combines Ho with an additional reference—Kim—for limitations related to downloading “coordinate information” for the hot spot information. Pet., 59. Ground 4 combines Jiau with Kim for the same limitations. Pet., 66. PO does not challenge the “coordinate information” limitations in Grounds 1 and 2, and

merely refers to its arguments for Ground 1 and 2 in connection with Grounds 3 and

4. Thus, PO's arguments for Grounds 3 and 4 fail for the reasons already discussed.

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

Throughout its Response, PO asserts that Dr. Zagal's testimony "should be afforded no weight" because he "parrot[s] the petition almost word-for-word." *See, e.g.,* POR 14. The Board rejected this argument: "We decline to give no weight to Dr. Zagal's testimony. Patent Owner has not shown that the entirety of Dr. Zagal's testimony is conclusory. To the contrary, much of Dr. Zagal's testimony cites to portions of the prior art and explains Dr. Zagal's reasoning." ID at 19.

This is a correct holding under *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 (PTAB Aug. 24, 2022) (precedential). There, the Board held that because "the cited declaration testimony is conclusory and unsupported" and "adds little to the conclusory assertion for which it is offered to support," it was "entitled to little weight." *Id.* at 15. In other words, the Board gave little credit to conclusory opinions used to support conclusory arguments in the Petition.

Thus, Patent Owner improperly attempts to extend the holding of *Xerox Corp.* to the unreasonable position that *any* expert testimony that is similarly worded as the argument in the Petition is entitled to little weight. Dr. Zagal's testimony should be given due weight based on the substance of his testimony—that the Petition uses similar wording is not a reasonable basis to write-off his testimony. Dr. Zagal's

opinions are substantive and well-reasoned, citing to the prior art where appropriate and explaining how they meet the limitations of the claims. Dr. Zagal also provides substantive, non-conclusory opinions about why a POSITA would combine the prior art. Thus, his opinions should be given appropriate weight.

CONCLUSION

For the reasons set forth herein, Petitioner respectfully requests that the Board cancel claims 1-20.

Respectfully submitted,

Dated: November 1, 2024

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