

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 SUR-REPLY

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EXHIBIT LIST

Exhibit	Description
2001	Playrix's Exchange of Proposed Terms and Claim Elements for Construction, served January 30, 2024
2002	U.S. Publication No. 2006/0205510 to Lauper et al. ("Lauper")
2003	Joint Claim Construction Statement in <i>Flip Phone Games Inc. v. PLR Worldwide Sales Limited</i> , No. 2:23-cv-00139-JRG (E.D. Tex.), Dkt. 71
2004	Declaration of Henry H. Houh, Ph.D., in Support of Playrix's Proposed Claim Constructions
2005	Prosecution History for U.S. Application No. 11/768,890 (U.S. Patent No. 8,688,089)
2006	Declaration of Dr. Robert Akl, D.SC.
2007	CV of Dr. Robert Akl, D.SC.
2008	Complaint for Patent Infringement, <i>Flip Phone Games Inc. v. PLR Worldwide Sales, Ltd.</i> , No. 2:23-cv-00139-JRG (E.D. Tex.), Dkt. 1

Patent Owner Flip Phone Games, Inc. (“Patent Owner”) submits this Sur-Reply regarding Petitioner PLR Worldwide Sales Limited’s (“Petitioner”) petition for *inter partes* review of U.S. Patent No. 9,427,662 (“the ’662 Patent”).

I. NONE OF THE HO GROUNDS RENDERS THE CHALLENGED CLAIMS OBVIOUS

A. Ground 1: Ho & Aoki

i. Ho, in View of Aoki, Does Not Disclose or Suggest “Contacting a Server for Hot Spot Information to Download, Comprising Providing the Server With At Least One of ...” (Claim 1[a])

In Ho, an “interactive information element”—the purported “hot spot”—is undisputedly “automatically download[ed]” on a client end device “whenever the player goes online.” Ex. 1004 at 9:29–33; *see* Response at 11–12. Petitioner’s challenge to the claims of the ’662 Patent with respect to Ho is fundamentally based on Petitioner’s assertion that “Ho explains” this “automatically downloading” necessarily “means” the client end device “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.” Reply at 4–5. Ho, in fact, contains no such explanation. *See* Ex. 2006, ¶¶57–72. Petitioner’s argument otherwise is unsubstantiated speculation built on the conclusory testimony of its expert, Dr. Zagal. *See* Response at 13–21.

The Federal Circuit has consistently “rejected obviousness determinations based on conclusory and unsupported expert testimony”—like Petitioner’s challenge here—equating such challenges to “the impermissible *ex post* reasoning and hindsight bias that *KSR* warned against.” *TQ Delta, LLC v. Cisco Sys., Inc.*, 942 F.3d 1352, 1361 (Fed. Cir. 2019). A petitioner must, instead, supply the factual basis for the challenge and “may not resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis.” *In re Warner*, 379 F.2d 1011, 1017 (C.C.P.A. 1967). Petitioner fails to do so here.

Model Type: Ho does not disclose or suggest having the client end device provide Ho’s server with “the model type of the mobile communication device” in connection with contacting the server for an interactive information element(s). *See* Response 13–15. Petitioner’s argument otherwise is simply a hindsight suggestion that a POSITA “would have ... found it obvious to provide the server with the model type of the mobile phone so that [] information that is returned by the server is compatible or optimized for the mobile phone type.” Petition at 23 (citing Ex. 1003, ¶115). But Petitioner’s speculation is based entirely on the testimony of Dr. Zagal, who simply repeats Petitioner’s argument and without any support. Ex. 1003, ¶115. And, as discussed (Response at 14–15), the Board “cannot accept” Petitioner’s and Dr. Zagal’s unsupported general speculation “as a replacement for documentary evidence for core factual findings in a determination of patentability.” *K/S Himpp v.*

Hear-Wear Techs., LLC, 751 F.3d 1362, 1366 (Fed. Cir. 2014); *see Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9, at 15 (P.T.A.B. Aug. 24, 2022).

That Ho generally discloses its game may be run on a device such as “a mobile telephone” (Reply at 5) does nothing to suggest that device supplies its specific “model type” to Ho’s server in connection with requesting an interactive information element. And Petitioner’s new argument that Ho renders this limitation obvious because “[o]ther contemporaneous publications [] explain that mobile games were designed to be played on different devices having different capabilities” (Reply at 5) likewise fails. Moreover, the primary exhibit Petitioner cites in support of this argument, Exhibit 1013 (Reply at 5), was published in “March 2008”—nearly a year *after* the June 26, 2007, priority date of the ’662 Patent. Ex. 1013. And the fact that a single, different game, Tiger Woods PGA Tour 07, may have allegedly been available on both Nokia and Sony Ericsson mobile phones in 2007 (Ex. 1025) fails to demonstrate that a POSITA would have found it obvious that the client end device in Ho’s game provide Ho’s server its “model type” when requesting to download an “interactive information element” of Ho.

Current Location: Ho does not disclose or suggest having the client end device provide Ho’s server with “the current location of the mobile communication device” when contacting the server for an interactive information element(s). *See*

Response 15–18. Petitioner’s argument otherwise once again impermissibly turns to conclusory speculation, as opposed to factual findings.

Petitioner argues that, because Ho discloses that engaging an interactive information element may reveal an advertisement for a “chain of fast food restaurants” (Ex. 1004 at 8:19–21), a POSITA would have understood that the client end device necessarily provides Ho’s server with the “current location of the mobile communication device” when “contacting a server for hot spot information to download.” Petition at 22; Reply at 6–7. But, once again, Petitioner’s hindsight speculation is based entirely on the testimony of Dr. Zagal, who simply repeats Petitioner’s argument verbatim and without any support. Ex. 1003, ¶114; *see* Petition at 22. The Board “cannot accept” Petitioner’s and Dr. Zagal’s unsupported speculation “as a replacement for documentary evidence for core factual findings in a determination of patentability.” *K/S Himpp*, 751 F.3d at 1366.

Petitioner’s argument in Reply—that fast food chains, like In-N-Out, “are specific to locations,” and thus this limitation is obvious in view of Ho (Reply at 7)—suffers from multiple flaws as well. Fundamentally, Petitioner’s argument is entirely unsubstantiated and, relatedly, untethered to the relevant time of invention of the ’662 Patent. Moreover, nothing in Ho—invented by an individual residing in Singapore (Ex. 1004 at 1)—suggests that its “fast food chain” advertisements relate to “the California fast food chain In-N-Out.” Reply at 7. Rather, the types of

advertisements taught by Ho are generalized with respect to “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 limited by location. Ex. 2006, ¶63.

Petitioner’s reliance on Ho’s disclosure regarding the use of Ho’s interactive information elements for “emergency warnings” does not demonstrate otherwise. Ex. 1004 at 9:7–15; *see* Reply at 4, 6. Ho makes clear that this is an *alternative* use of Ho’s interactive information elements—separate and distinct from use “for advertising.” Ex. 1004 at 9:7–8. And critically, Petitioner and Dr. Zagal each contend only that “[a] POSITA would understand this disclosure to teach that the mobile phone provides the server with ‘the current location of the mobile communication device.’” Petition at 22; Ex. 1003, ¶113. The claim, in contrast, requires that the “the current location of the mobile communication device” must be provided when “contacting a server for hot spot information to download.” ’662 Patent, 14:39–52. And the full claim language specifies that the “hot spot information to download” includes “hidden content for presenting to the user when the hot spot is activated.” ’662 Patent, 14:53–57. An emergency warning that is instantly transmitted (Ex. 1004 at 9:7–15) can hardly be characterized as “hidden content” that is only presented upon activation of a hot spot. Ex. 2006, ¶64.

Scene or Element: Petitioner’s argument in Reply that “Ho teaches that its mobile device provides the server with information about the scene or element for

which hot spot information is desired” impermissibly seeks to recast the Petition and, in any event, fails on the factual record. Reply at 7.

In the Petition, Petitioner argues that a POSITA would understand Ho to teach that a client device in Ho provides the server with a “scene” or “element” for which hot spot information is desired based on Ho’s purported submission of a “hamburger monster” to Ho’s server “so that the server may return the appropriate advertisement (*i.e.*, an advertisement for a fast food chain).” Petition at 22. Patent Owner explained in its Response how Petitioner’s contrived argument regarding Ho’s “hamburger monster” ignores the full context of both Ho and claim 1 of the ’662 Patent. Response at 18–19. In short, Petitioner contends that Ho’s “hamburger monster” itself (*i.e.*, an “interactive information element”) is the claimed “hot spot information.” Petition at 21, 25. Thus, the “hamburger monster” cannot also be the claimed “scene” or “element” for which “hot spot information” is desired that is provided to Ho’s server. *See* Response at 18–19.

Tellingly, Petitioner’s Reply fails to acknowledge, let alone explain, this fallacy in Petitioner’s circular argument. *See* Reply at 7–8. Rather, Petitioner attempts to misdirect the Board by newly citing to two different portions of Ho regarding teachings unrelated to Ho’s “hamburger monster.” Reply at 7–8.

First, Petitioner vaguely suggests that Ho’s disclosure regarding determining whether an “interactive information element” is “legitimate” or otherwise needs to

be “changed/renewed” somehow “make[s] clear” that Ho’s client end device provides an “element” for which hot spot information is desired. Reply at 7–8 (citing Ex. 1004, 10:14–19). This new argument suffers from the same flaw as Petitioner’s “hamburger monster” argument, however. Ho’s “interactive information element” cannot be both the claimed “hot spot information” (under the Petition’s theory) and the claimed “scene” or “element” for which “hot spot information” is desired.

Second, Petitioner argues that Ho’s purported disclosure that Ho’s server obtains some *unspecified* information from the client end device to allow it to “download[] and replac[e] relevant submodules” somehow “make[s] clear” that Ho’s client end device provides “scenes” for which hot spot information is desired. Reply at 8 (citing Ex. 1004, 9:25–27). There is no disclosure or suggestion in Ho that Ho’s client end device provide Ho’s server with a specific “scene” for which hot spot information is desired. Rather, Ho makes clear that, when a client end device goes “online,” the server in Ho “automatically” determines and sends the “updated” interactive information element to the client end device. Ex. 1004 at 9:29–33, 10:14–25, Fig. 5; *see* Ex. 2006, ¶61. And tellingly, Petitioner omits the term “automatically” from the language it quotes from Ho in support of its new, vague argument. *Compare* Reply at 8 *with* Ex. 1004 at 9:29–33.

Version Identifier: Petitioner concedes that Ho does not expressly disclose “contacting a server for hot spot information to download, comprising providing the

server with ... a version identifier for hot spot information currently on the mobile communication device.” *See* Reply at 8. “Petitioner is not arguing inherency either.” *Id.* at 9. Petitioner contends only that Ho renders “obvious” this limitation. *Id.* That obviousness challenge, however, is nothing more than “the impermissible *ex post* reasoning and hindsight bias that *KSR* warned against.” *TQ Delta*, 942 F.3d at 1361.

Ho, at most, teaches only that, when a client end device connects to Ho’s server (*i.e.*, goes “online”), the server “automatically” checks some ***unspecified*** “information on the client end device relating to the interactive information elements” and “then determines whether the interactive information element(s)” “needs to be changed/renewed.” Ex. 1004 at 9:29–33, 10:2–25, Fig. 5; *see also* Ex. 2006, ¶70. Petitioner suggests that it would be obvious for the client end device in Ho to “provid[e] a version identifier” for an interactive information element to allow Ho’s server to change or update the interactive information element. Reply at 9. Petitioner’s argument is rooted in Dr. Zagal’s opinion that, “[a]bsent such an identifier, the server may send a client device an interactive information element that the mobile device already possesses.” Ex. 1003, ¶116; *see* Petition at 23.

Contrary to Dr. Zagal’s conclusory testimony, a “version identifier” is not the sole, exclusive mechanism for so updating Ho’s interactive information elements. Patent Owner’s expert, Dr. Akl, explained that a POSITA would have understood there are multiple ways Ho’s server can determine whether an interactive

information element on a client end device in Ho “needs to be changed/renewed” (as opposed to some *undisclosed* “version identifier”), including, for example, “the date and time of the last connection to the server by the client device.” Ex. 2006, ¶71.

Petitioner has failed to articulate a precise basis as to why a POSITA, as of June 26, 2007, would have been motivated to create and employ a versioning system for each and every interactive information element in Ho’s game and utilize a “version identifier” associated with each interactive information element to update those elements via Ho’s server—as opposed to one of the other many, less complicated options for evaluating those elements for updates. *See* Ex. 2006, ¶71.

At most, Petitioner submitted only a single prior art reference (“Hannay”) that teaches, as “new levels and/or versions” of its game are created, some “games content” therein may have “an associated identifier tag that identifies the version that has been used in its construction.” Ex. 1020, [0019]; *see* Reply at 9. But critically, Petitioner fails to rely on Hannay in any Ground in the Petition, and cannot now use this reference to fashion a new prior art combination. *See Wasica Finance GmbH v. Continental Automotive Sys., Inc.*, 853 F.3d 1272, 1286–87 (Fed. Cir. 2017); *Intel Corp. v. PACT XPP Schweiz AG*, No. 2023-1537, 2024 WL 5068112 (Fed. Cir. Dec. 11, 2024). And Petitioner and Dr. Zagal also fail to explain why a POSITA would have been motivated to apply Hannay’s “identifier tag[s]” with respect to a “game” version to the interactive information elements in Ho’s video game—let alone

demonstrate “a reasonable likelihood of success” in such modification of Ho. *See Forest Lab'ys, LLC v. Sigmapharm Lab'ys, LLC*, 918 F.3d 928, 934 (Fed. Cir. 2019).

Moreover, Petitioner’s new argument in Reply that Hannay demonstrates that “version identifiers are used to determine if gaming modules or elements needs to be changed or renewed” (Reply at 9) has no foundation in the record. Hannay simply discloses that, as a designer “create[s]” new versions of a game, the game content therein “has an associated identifier tag that indicates the version that has been used in its construction.” Ex. 1020, [0019]. Hannay is silent regarding any subsequent analysis of or use case for those “identifier tag[s],” let alone with respect to changing or renewing any intra-game element of Hannay’s game. *See generally* Ex. 1020.

User-Identification Information: Petitioner concedes that Ho alone does not disclose or render obvious providing Ho’s server with “user-identification information” or “a game for which hot spot information is desired” when contacting Ho’s server for hot spot information to download. *See* Petition at 24; Reply at 10. Rather, Petitioner contends only that, in a “***combined Ho-Aoki system***,” “the client end device would [] 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’).” Petition at 24 (emphasis added).

Patent Owner demonstrated that this contention by Petitioner was based on a fundamental misunderstanding of Aoki. Response at 21–23. Aoki’s teachings with respect to submission of a player ID and game ID are with respect to an “advertisement charge process” that occurs *after* an advertisement is downloaded and displayed on a game terminal. Ex. 1005, [0077], [0088], [0089], Fig. 12. Thus, in any combined Ho-Aoki system, Ho’s client device would, at most, only provide the server with a player ID *after* the downloading of an interactive information element and display of the content associated therewith—for calculation of a “charge point.” Ex. 1005, [0077], [0088], [0089], Fig. 12; *see* Ex. 2006, ¶76.

In view of these disclosures and teachings of Aoki, Petitioner newly suggests that a POSITA would have been motivated to *modify* the combined Ho-Aoki system “so that the mobile communication device provides the server with this information when downloading hot spot information.” Reply at 10. Petitioner argues that a POSITA would have been motivated to do so because the provision of this information to Ho’s server when downloading Ho’s interactive information elements would “allow Ho’s system to provide hot spot information ... that is targeted to specific users.” Reply at 11; Ex. 1003, ¶117.

But the purported “overwhelming evidence” Petitioner presented in the Petition on this point is only a single sentence by Dr. Zagal that repeats Petitioner’s conclusion and thus is entitled little to no weight. *Xerox*, IPR2022-00624, Paper 9,

at 15; *see* Petition at 24 (citing Ex. 1003, ¶117). In particular, Dr. Zagal states: “A POSITA would be motivated to provide the server a user ID and game ID so that advertisements can be targeted based on this information.” Ex. 1003, ¶117.

At most, Petitioner and Dr. Zagal cite only Ex. 1008 (“Sturman”) in passing support of their conclusion. Petition at 24; Ex. 1003, ¶117. But critically, Petitioner fails to rely on Sturman in any Ground in the Petition, and cannot now use this reference to fashion a new prior art combination. *See Wasica*, 853 F.3d at 1286–87. In any event, Petitioner and Dr. Zagal fail to explain why a POSITA would have been motivated to apply Sturman’s specific advertising delivery schemes to Ho’s interactive information elements—let alone demonstrate “a reasonable likelihood of success” in such modification of Ho. *See Forest Lab'ys*, 918 F.3d at 934.

Petitioner’s argument that Sturman nonetheless “provides an express motivation to combine” Ho and Aoki “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” (Reply at 11) misses the mark. To the extent Sturman’s teachings would have motivated a POSITA to “combine” Ho and Aoki, in that resulting “combined Ho-Aoki system,” Ho’s client device would, at most, only provide the server with the “ID of the player” *after* the downloading of an interactive information element and display of the content associated therewith in accordance with Aoki’s “advertisement charge

process,” as discussed. *See* Response at 21–23. And any newly-suggested modification of Aoki to provide the advertisement server with the “ID of the player” *prior* to downloading the advertising content would render Aoki inoperable for its intended purpose (“advertisement charge process”). *See In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984) (finding no suggestion to modify a prior art device where the modification would render the device inoperable for its intended purpose).

Petitioner’s new argument in Reply that other evidence submitted with the Petition suggests that such a modification of the combined Ho-Aoki system would nonetheless somehow have been “common sense” (Reply at 11–12) also falls flat.

Petitioner’s argument is premised on its representation that “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.” Reply at 11 (emphasis added) (citing Ex. 1003, ¶18). Petitioner’s expert did no such thing. In ¶18 of his Declaration, Dr. Zagal simply states his understanding of anticipation. Ex. 1003, ¶18. The only reference to Massive Incorporated is in ¶50 of Dr. Zagal’s Declaration, wherein he simply notes that, “by 2006,” companies such as Massive Incorporated had only first launched basic in-game advertising networks. Ex. 1003, ¶50. Dr. Zagal fails to offer any evidence or testimony as to whether any of those networks utilized advertisements targeted to users based on specific user information. *Id.*

Petitioner’s new reliance on Exhibits 1009 (“Ellis”) and 1022 (“Chu”) fares no better. Reply at 12. Neither reference forms any part of any Ground in the Petition. *See Wasica*, 853 F.3d at 1286–87; *Intel*, 2024 WL 5068112. Rather, the Petition cites each reference only a single time unrelated to this limitation: Ellis, with respect to the existence of “in-game advertising networks,” generally, by 2006 (Petition at 5); and Chu, with respect to a “coordinate system” for locating elements in-game (Petition at 7). Moreover, Ellis does not teach or suggest providing “user-identification information” to a server to “permit and enhance targeted advertisements,” contrary to Petitioner’s suggestion. Reply at 12. Rather, Ellis teaches that a “game client system” can instruct an “ad server” that a “genre of advertisements” (*e.g.*, “alcohol type ads”) is “not acceptable to that game client” and that “such ads would not be inserted into the game” *altogether*. Ex. 1009, 7:48–61.

ii. Ho, in View of Aoki, Does Not Render Obvious Dependent Claims 2–12

Because Ho, in view of Aoki, does not render independent claim 1 obvious, Ho, in view of Aoki, does not render obvious dependent claims 2–12. Additionally, claim 7—which requires “saving on the mobile communication device a version identifier for the downloaded hot spot information”—is not rendered obvious for the reasons discussed above with respect to claim 1[a].

**iii. Ho, in View of Aoki, Does Not Disclose or Suggest
“Contacting a Server for Hot Spot Information to
Download, Comprising Providing the Server With User-
Identification Information” (Claim 13[a])**

For the reasons discussed with respect to claim 1[a], Petitioner has failed to demonstrate that the combined teachings of Ho and Aoki render obvious “contacting a server for hot spot information to download, comprising providing the server with user-identification information,” as required by claim 13.

**iv. Ho, in View of Aoki, Does Not Render Obvious Dependent
Claims 14–20**

Because Ho, in view of Aoki, does not render independent claim 13 obvious, Ho, in view of Aoki, does not render obvious dependent claims 14–20.

B. Ground 3: Ho & Kim

For the reasons discussed with respect to Ground 1, Ho, in view of Kim, fails to disclose or render obvious claims 1–12 or 13–20. Indeed, Petitioner does not contend that Kim cures any of the deficiencies in Ho with respect to claim 1[a], dependent claim 7, and claim 13[a]. *See* Petition at 61, 64, 65.

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

Ho is not “prior art consisting of patents or printed publications” under § 311(b) and is therefore ineligible to be prior art in this proceeding. Response at 30–33. Patent Owner’s Response demonstrated this conclusion is supported by both statutory interpretation and controlling Federal Circuit precedents. *Id.* Petitioner’s

Reply fails to rebut either of those points. Reply at 14. Rather, Petitioner suggests only that Patent Owner’s argument—“that §102(e) art is not available in an *Inter Partes Review*”—has been rejected in previous decisions from the Board and Director. Reply at 14. Those agency decisions, however, are not afforded any deference on this question of statutory interpretation. *See Loper Bright Enters. v. Raimondo*, No. 22-451, 603 U.S. ____ (June 28, 2024). In contrast, the Federal Circuit recently heard argument on this question of statutory interpretation in *Lynk Labs, Inc. v. Samsung Electronics Co.*, Appeal No. 23-2346, with an opinion yet to issue.

II. NONE OF THE JIAU GROUNDS RENDERS THE CHALLENGED CLAIMS OBVIOUS

A. Ground 2: Jiau & Aoki

i. Jiau, in View of Aoki, Does Not Disclose or Suggest “Downloading Hot Spot Information From the Server ...” (Claim 1[b])

As discussed, Jiau at most discloses that a limited number of lots—stored on a server—may be temporarily “cached” in a client system of Jiau. Response at 34–36. Petitioner’s argument that the “plain meaning” of “downloading” encompasses such caching (Reply at 16) is rebutted by controlling precedent. Such “fleeting or transient retention” of those lots “does not qualify as ... downloading.” *Finisar Corp. v. DirecTV Group, Inc.*, 523 F. 3d 1323, 1332 (Fed. Cir. 2008).

Petitioner’s suggestion that the patent in *Finisar* disclosed “downloading ... requests into a ‘smart cache’” (Reply at 17) is incorrect, as it is based on misleading

quote-cropping. The patent described “download[ing] of data corresponding to anticipated information requests into a ‘smart cache,’ which is used as a temporary buffer, and which is overwritten upon receipt of new information in a later request.” *Finisar*, 523 F. 3d at 1332. The data was not “download[ed]” into the cache, but only when it was “moved to other areas of the user’s hard disk” (“retained” for “future information requests”)—“while unused data from the smart cache are overwritten with new data.” *Id.* As such, the Federal Circuit held that “downloading ... requires something more than just transient retention of data” (*id.*) and thus shows that Jiau’s caching likewise is not downloading. Response at 35.

Petitioner’s new reliance on generalized, passing statements in Jiau that some limited information from Jiau’s server may be “stored” in a client device (Reply at 15–16) does not demonstrate otherwise. As discussed, the only type of storage of lots described in a client device of Jiau is in “cache” or “similar” transient, fleeting memory. *E.g.*, Ex. 1006 at 10:3–5, 13:12–14; *see* Response at 33–36.

Petitioner’s argument that “the Petition demonstrated that this limitation was [] obvious in further view of Aoki” (Reply at 17) is incorrect. The Petition never identified Aoki as rendering obvious “downloading hot spot information from the server to the mobile communication device.” Petition at 44–45. And the Petition’s discussion of Aoki relative to the “coordinate information” aspect of the overall

limitation is devoid of any suggestion that Aoki renders obvious “downloading” any hot spot information (*id.* at 46–47), contrary to Petitioner’s suggestion. Reply at 17.

ii. Jiau, in View of Aoki, Does Not Render Obvious Dependent Claims 2–12

Because Jiau, in view of Aoki, does not render independent claim 1 obvious, Jiau, in view of Aoki, does not render obvious dependent claims 2–12. Additionally, each of claim 7 and claim 12 is not obvious for independent reasons.

Dependent claim 7 recites “saving on the mobile communication device a version identifier for the downloaded hot spot information.” Patent Owner demonstrated that Jiau, even in view of Aoki, fails to disclose or render obvious this limitation. Response at 37–42. Petitioner fails to rebut Patent Owner’s demonstration. Rather, Petitioner wholly ignores Patent Owner’s Response regarding dependent claim 7, incorrectly stating that Patent Owner did not raise any arguments with respect to this claim. Reply at 21. Patent Owner, in fact, presented more than five pages of argument (Response at 37–42)—which is now un rebutted.

Dependent claim 12 recites that the “hidden content” downloaded to the mobile communication device as part of the claimed “hot spot information” comprises “a second hot spot.” Petitioner argues that Jiau discloses or renders obvious this limitation because “Figure 11(e) of Jiau shows an object 1192 [] that has a first hotspot link 1194 [] that when activated reveals a hidden second hot spot (*e.g.*, furniture within object 1192) shown in Figure 11(f).” Reply at 20. Petitioner’s

argument, however, is nothing but impermissible speculation provided only in hindsight in light of the '662 Patent.

Jiau describes that Figure 11(f) illustrates only the “interior view” of object 1192, the exterior of which is illustrated in Figure 11(e). Ex 1006 at 15:19–24, Figs. 11(e), 11(f):

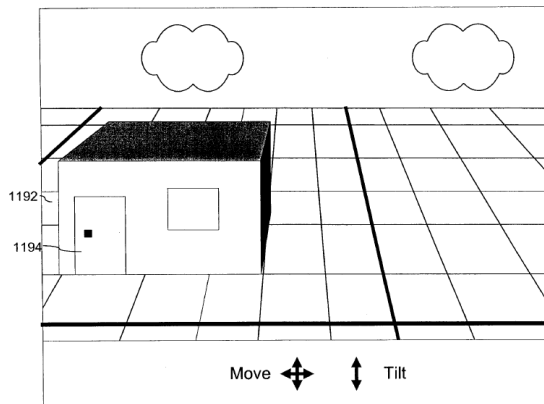


Fig. 11(e)

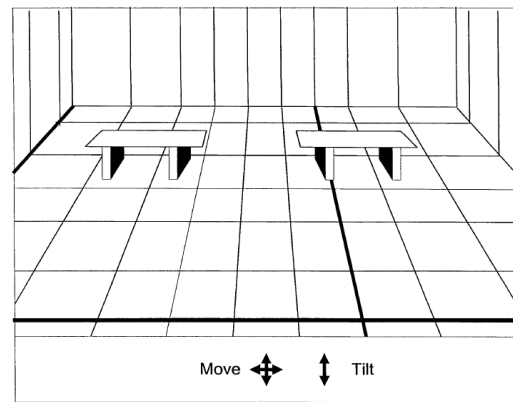


Fig. 11(f)

Critically, Jiau—which uses the term “hotspot” nearly 100 times throughout its disclosure, including in discussion of Figure 11(e)—does not identify any “hotspot” in this “interior view” of object 1192 in Figure 11(f). *See* Ex. 1006 at 15:18–16:2; Fig. 11(e). Indeed, no object is called out in Jiau by reference numeral or otherwise in this “interior view” of object 1192 in Figure 11(f). *See id.* Petitioner’s contention that “furniture” in this “interior view” of object 1192 in Figure 11(f) nonetheless may include a “second hotspot” is thus nothing but pure speculation (*see* Response at 45–46) and thus fails. *See TQ Delta*, 942 F.3d at 1361.

That a claim of Jiau broadly recites that a single “object” may have “a plurality of hotspots” (Ex. 1006, claim 8) does not demonstrate otherwise. Reply at 21. As explained by Patent Owner’s expert, Dr. Akl—and unrebutted by Dr. Zagal—a POSITA would understand Jiau’s disclosure that an “object” may be associated with “a plurality of hot spots” to mean that an object may be sized such that it may contain—and thereby present to the user in the first instance—two or more hotspots (*e.g.*, multiple “push” buttons 1186 in Figure 11(d)). Ex. 2006, ¶103.

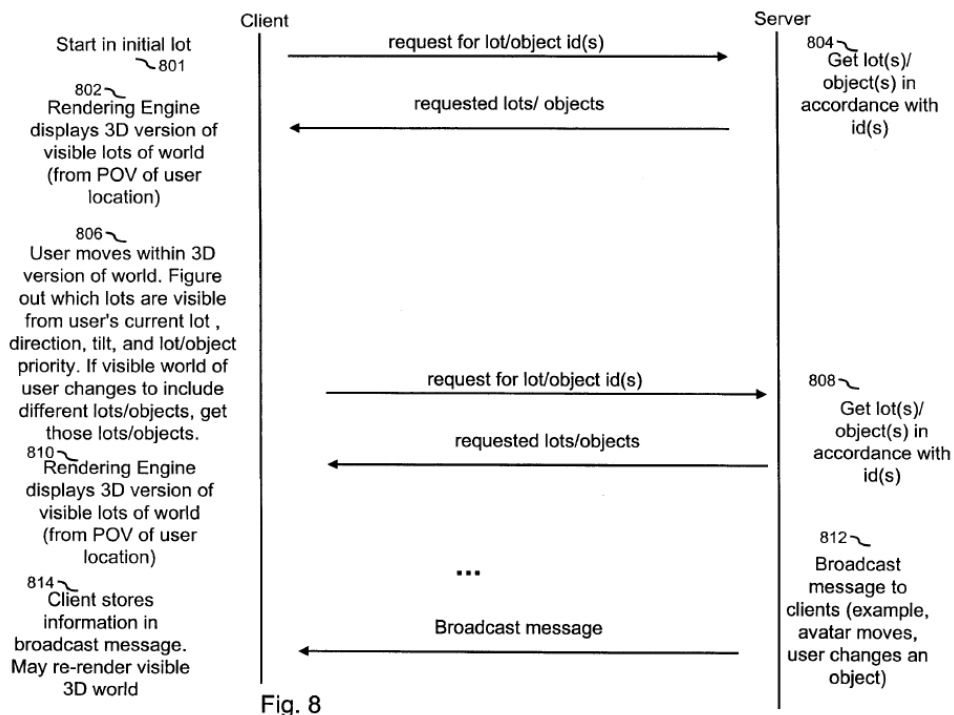
Jiau, in contrast, never discloses or suggests an object with a hotspot that includes within it a second, different object with a hotspot, which is accessed only by activating the hotspot associated with the first object. Ex. 2006, ¶103. The absence of any teaching in Jiau is demonstrated by Figure 11(f), which, as discussed, is silent as to any “object” within the interior of object 1192, let alone any “hotspot” associated with a precise area of any (undisclosed) “object” in Figure 11(f).

**iii. Jiau, in View of Aoki, Does Not Disclose or Suggest
“Contacting a Server for Hot Spot Information to
Download, Comprising Providing the Server With User-
Identification Information” (Claim 13[a])**

Jiau fails to disclose or suggest providing a server with “user-identification information” in connection with downloading “hot spot information” from the server. *See* Response at 46–48. Rather, lots (and the objects and hotspots therein) are fetched in Jiau based on a user’s movements in the virtual world via submission of “lot id(s)” (or “object id(s)”) by the client system to the server system. *See* Response

at 47. In light of these facts presented in Patent Owner’s Response, Petitioner now points to new, previously uncited portions of Jiau (as compared to the Petition) in support of its contention that Jiau discloses this limitation. Reply at 18–19.

Petitioner’s new reliance on Figure 13(a) of Jiau fails. *Id.* The fact that Jiau discloses that a “user id” (*i.e.*, the id of the user that “own[s]” the lot/object) may be associated with a lot—in a data structure “stored in server system 108”—is irrelevant. Ex. 1006 at 17:14–20, 17:25–18:4, Figure 13(a). There is no disclosure or suggestion in Jiau that a client system provides server system 108 with any such “user id” to fetch new lots or objects therein as a (different) user moves about Jiau’s virtual world. *See* Ex. 2006, ¶110. Rather, Jiau teaches only that a “lot id” or “object id” is provided by the client system. Ex. 2006, ¶110; *e.g.*, Ex. 1006 at Fig. 8:



Likewise, the fact that Jiau discloses that the user that owns a lot can set permissions regarding who else may “alter,” “copy,” etc. the user’s lot (Ex. 1006 at 2:4–11)—*i.e.*, make the lot private or public—is immaterial. As discussed above, Jiau teaches only that a “lot id” or “object id” is provided by the client system to request new lots (and the objects therein)—not any information identifying the user requesting the new lots based on the user’s movements in the virtual world. Moreover, Jiau expressly notes that “[a]ll users ... can browse the lots of the virtual world, visiting in turn the lots that others have designed” (Ex. 1006 at 2:22–23; *see* Ex. 2006, ¶109), further demonstrating that any information identifying the user requesting a new lot is not needed nor used for the server to fetch the new lot.

Petitioner’s suggestion that Aoki renders this limitation obvious (Reply at 19) is incorrect. As discussed above with respect to Ground 1 (Ho in view of Aoki), Aoki’s teachings with respect to submission of a player ID are with respect to an “advertisement charge process” that occurs *after* an advertisement is downloaded to and displayed on a game terminal. Ex. 1005, [0077], [0088], [0089], Fig. 12. Thus, in any “combined Jiau-Aoki system” (Petition at 43), Jiau’s client device would, at most, only provide the server with a player ID *after* the downloading of a hotspot and display of the content associated therewith—for calculation of a “charge point.” Ex. 1005, [0077], [0088], [0089], Fig. 12; Ex. 2006, ¶114; *see* Response at 49–52.

The example lot illustrated in Figure 17 of Jiau does not demonstrate otherwise. *See* Reply at 19–20. As a fundamental matter, there is no evidence that the “FOREVER21” lot illustrated in Figure 17 is associated with the fashion retailer Forever21, includes any “advertisements” for Forever 21, or that Forever21’s “target audience” is exclusively “young people”—contrary to Petitioner’s multi-level speculation. Reply at 20; *see* Ex. 1006, 1928–20:3, Fig. 17. Petitioner’s further suggestion that it would have been obvious for a client device in Jiau to provide “user-identification information” to Jiau’s server “to target this [Forever21] advertisement to those lots which are registered to users who fit the target profile” (Reply at 20) is thus impermissibly based on nothing but Petitioner’s unsupported speculation, as opposed to record facts. *See K/S Himpp*, 751 F.3d at 1366.

**iv. Jiau, in View of Aoki, Does Not Disclose or Suggest
“Downloading Hot Spot Information From the Server ...”
(Claim 13[b])**

For the same reasons as discussed respect to claim 1[b], Petitioner has failed to carry its burden of demonstrating that Jiau, in view of Aoki, discloses or renders obvious “downloading” the claimed “hot spot information,” as required by claim 13.

**v. Jiau, in View of Aoki, Does Not Render Obvious Dependent
Claims 14–20**

Because Jiau, in view of Aoki, does not render independent claim 13 obvious, Jiau, in view of Aoki, does not render obvious dependent claims 14–20. Dependent claim 20 is also not obvious for the reasons discussed with respect to claim 12.

B. Ground 4: Jiau & Kim

For the reasons discussed above with respect to Ground 2, Jiau, in view of Kim, fails to disclose or render obvious claims 1–12 or 13–20. Indeed, Petitioner does not contend that Kim cures any of the deficiencies in Jiau with respect to claim 1[b], dependent claim 7, dependent claim 12, claim 13[a], claim 13[b], and dependent claim 20. *See* Petition at 68, 71, 72.

III. CONCLUSION

For at least these reasons, the Petition fails to shoulder its burden of establishing that the Challenged Claims are unpatentable.

Dated: December 13, 2024

Respectfully submitted,

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CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24(d), the undersigned certifies that this Patent Owner Response contains 5,597 words according to the word-processing program used to prepare this paper. The foregoing word count complies with the 5,600 word type-volume limit specified by 37 C.F.R. § 42.24(c)(4).

Dated: December 13, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

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