

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.

IPR2024-00209
Patent 9,427,662 B2

Record of Oral Hearing
Held: February 6, 2025

Before DAVID C. McKONE, DANIEL J. GALLIGAN, and
SCOTT B. HOWARD Administrative Patent Judges.

APPEARANCES:

ON BEHALF OF THE PETITIONER:

RON HAGIZ, ESQ.
Quinn Emanuel Urquhart & Sullivan, LLP
295 5th Avenue
9th Floor
New York, New York 10016
(212) 849-7453
ronhagiz@quinnemanuel.com

ON BEHALF OF THE PATENT OWNER:

JOSHUA LEE, ESQ.
MICHAEL MORLOCK, ESQ.
Kilpatrick Townsend & Stockton LLP
1100 Peachtree Street NE
Suite 2800
Atlanta, Georgia 30309
(404) 815-6582 (Lee)
(404) 815-6003 (Morlock)
jlee@kilpatricktownsend.com
mmorlock@kilpatricktownsend.com

KASEY KOBALLA, ESQ.
Kilpatrick Townsend & Stockton LLP
4208 Six Forks Road
Suite 1400
Raleigh, North Carolina 27609
(919) 420-1712 (Koballa)
kkoballa@kilpatricktownsend.com

The above-entitled matter came on for hearing Thursday,
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P-R-O-C-E-E-D-I-N-G-S

1:00 p.m.

JUDGE HOWARD: Good afternoon, everyone. This is an oral hearing in Case IPR2024-00209 concerning US Patent 9,427,662. I am Judge Howard, and I am joined by Judge McKone and Judge Galligan. Just a few administrative matters before we begin. Per our hearing order, each side will have 60 minutes to present its case. Petitioner, who bears the burden of proving unpatentability, will proceed first. Petitioner may reserve up to half its time for rebuttal. Once Petitioner has finished its initial presentation, Patent Owner may proceed with its case. If Petitioner reserves time for rebuttal, Patent Owner can reserve time for a brief sur-rebuttal. Rebuttal will be limited to addressing issues raised in Patent Owner's opening arguments, and sur-rebuttal will be limited to issues raised by Petitioner in its rebuttal time.

For the sake of the judges, as we're all participating remotely, as well as for clarity of the record, we ask that you please refer to your slide numbers when you're talking about one, even if you're showing it on -- taking control and you're showing it as part of the presentation. It's very helpful for the judges and the record. As for objections, we don't expect there to be any, but if there are, please do not interrupt your opposing counsel. Wait until it's your time and then we will deal with it then. Also, in order to avoid or prevent any feedback or background noises, if you can please keep yourself on mute when you are not speaking. At this time, we'd like to have counsels to introduce themselves and who you have with you. Let's begin with Petitioner.

1 MR. HAGIZ: Good morning, Your Honors. This is Ron Hagiz from
2 Quinn Emanuel. I'll be arguing today on behalf of Petitioner. I think there
3 may be some client representatives listening in on the public line, but I don't
4 believe anyone else on our end is on this line.

5 JUDGE HOWARD: Thank you. And for Patent Owner?

6 MR. LEE: Good afternoon, Your Honors. This is Josh Lee with
7 Kilpatrick Townsend & Stockton. I will be arguing on behalf of Patent
8 Owner today, along with my colleague, Kasey Koballa, also with Kilpatrick
9 Townsend & Stockton. Lead counsel for Patent Owner, Michael Morlock, is
10 also on the line, and client representatives for Patent Owner are online on the
11 public line, I believe.

12 JUDGE HOWARD: Okay, thank you. Petitioner, how much time
13 would you like to reserve for rebuttal?

14 MR. HAGIZ: Yes, Your Honor. Let me tentatively reserve 20 minutes
15 for rebuttal.

16 JUDGE HOWARD: Okay. I will be keeping track here. I will try to
17 give you notice when you're approaching your time for either rebuttal or the
18 end of your time. I suggest it might be helpful for you to keep track of time
19 yourself also, to help pace yourself. With that, Mr. Hagiz, you can begin
20 whenever you're ready.

21 MR. HAGIZ: Thank you. Let me just share my demonstratives, see if
22 we can get that to work. Your Honors, can you see the slides on the screen?

23 JUDGE HOWARD: We can.

24 MR. HAGIZ: Perfect, then let me -- why don't I begin? Your Honors,
25 there are four grounds that are raised in the Petition here, and this is on Slide
26 2. Grounds 1 and 3 are based on Ho as the primary reference. Grounds 2 and

1 4 are based on Jiau as the primary reference. I'm going to focus on Grounds
2 1 and 2 today, which both involve combinations with Aoki as the secondary
3 reference. Grounds 3 and 4 relied on Kim as an alternative disclosure of
4 using coordinates to identify the location of a hotspot. Patent Owner hasn't
5 disputed that Ho and Jiau independently disclose those limitations, so I don't
6 think we need to get into Kim and the combinations with Kim, hence the
7 focus on Grounds 1 and 2.

8 Jumping into those disputes, there are really three real disputes on the
9 independent claims 1 and 13. For Claim 1, in Ground 1 based on Ho, only
10 limitation 1[a] is challenged, and specifically -- and we're on Slide 3 --
11 specifically that claim limitation enumerates 14 categories of information,
12 any one of which may be sent from the client to the server in connection
13 with requesting hotspot information. The Petition shows that seven of these
14 are disclosed either by Ho or by Aoki. Most of Patent Owner's arguments
15 relating to Ho assert that Ho doesn't expressly identify the information that's
16 sent, but Petitioner's expert, Dr. Zagal, goes through specific examples in Ho
17 of how hotspot information is used in describing the exchange of data
18 between the server and the client as part of that process, and explains why a
19 POSITA would understand from those examples and embodiments that
20 certain information is or would be provided as part of the request.

21 With respect to Aoki, Aoki is relied on for the particular category of
22 user identification information. There is no dispute by Patent Owner that
23 Aoki has a disclosure of sending user identification information from a client
24 to an advertising server. Patent Owner's argument is that that information is
25 used for a different purpose in Aoki; for billing or for charging rather than
26 for requesting the advertisements. But in the proposed combination in the

1 Petition, the combination that is suggested is using the user identification
2 information transmission from Aoki, including that in part of Ho's request
3 for hotspot information. Both the Petition and Petitioner's expert explained
4 why a POSITA would combine the references in this way, particularly in
5 order to further and facilitate targeted advertising based on references such
6 as Sturman, Exhibit 1008.

7 With respect to Ground 2, the Jiau/Aoki, no dispute that limitation
8 1[a] is disclosed in that combination. The only dispute there is on the
9 limitation downloading hotspot information. Patent Owner argues that Jiau
10 only teaches caching information rather than downloading information.
11 Now, we have two responses to that. First is that there is express disclosure
12 in Jiau of storing information at the client, and second, we believe that
13 Patent Owner's narrow interpretation of downloading is somehow excluding
14 caches is overly narrow claim construction and not based on any intrinsic
15 evidence. For Claim 13, the other independent claim, most of the disputes
16 are the same with respect to Ground 1.

17 Patent Owner disputes limitation 13[a], which requires sending user
18 identification information. It's the same arguments that are advanced in
19 response to limitation 1[a] for that same category of information. Similar
20 argument raised for 13[b] in Ground 2 on downloading information. The
21 only new issue on Claim 13 is in Ground 2 the Jiau/Aoki combination, and
22 whether there, there is a disclosure of providing user identification
23 information. The arguments largely mirror the response to the Ho/Aoki
24 combination and the fact that Aoki's disclosure of user identification
25 information is not for the same purpose as the claim. I'll address those in
26 more detail shortly. A handful of dependent claims disputed, Claim 7 is

1 addressed in both grounds, requires saving a version identifier corresponding
2 to the hotspot information.

3 For Ground 1, that argument is subsumed in the discussion of
4 limitation 1[a]. That is one of the categories of information that is
5 contemplated in 1[a] and that we argue is disclosed in Ho. For Ground 2,
6 there are two alternative theories that are proposed in the Petition, one based
7 on Jiau's disclosure of an object ID and the other on nVersion information.
8 I'm going to focus on the nVersion information theory today. We think there
9 isn't really a meaningful response to that one. The last dispute is over Claims
10 12 and 20 in Ground 2, which specifically requires hidden content that
11 comprises a second hotspot. Petition relies on essentially Jiau's disclosure of
12 an object that has a hotspot that can explore an interior building, for
13 example. The building itself can have other objects that can also have
14 hotspots.

15 Let me go into details of these arguments. Starting on -- actually,
16 before that, let me tackle a few easy or simpler procedural issues before we
17 go into the substance. On Slide 19, in its Patent Owner response, Patent
18 Owner argued that Ho doesn't qualify as prior art because it was raised as
19 prior art under 102(e), meaning it was filed before the priority date of the
20 '662 patent, but published later. In its Sur-reply, Patent Owner
21 acknowledged that this is an issue that at that point in time was pending
22 before the Federal Circuit in *Lynk Labs v. Samsung Elecs*. That decision has
23 come out. Patent Owner's position has been plainly rejected. Federal Circuit
24 held, and this is 2025 WL 85559: “We conclude that §§ 311(b) and
25 102(e)(1) permit IPR challenges based upon published patent applications,
26 and such published patent applications can be deemed prior art in IPRs as of

1 their filing date.” No dispute that Ho is 102 prior art, and so that's valid
2 based on the Federal Circuit's *Lynk Labs* decisions.

3 On Slide 21, Patent Owner also presents a broad challenge to Dr.
4 Zagal, Petitioner's expert's declaration. This is a similar issue, or essentially
5 the same issue that was raised in the pre-institution response. The Board
6 already addressed that as a general challenge in its institution decision, Paper
7 9, where Your Honors declined to give no weight to Dr. Zagal's testimony
8 and noted that much of his testimony cites to portions of the prior art and
9 explains his reasoning.

10 A particular example from Paragraph 121 of his declaration was
11 pointed out where he points to specific elements in the prior art, in this case,
12 discussing the Ho reference, and provides a technical reasoning explaining
13 how and why a POSITA would understand certain disclosures in the prior
14 art. On Slide 22, in Patent Owner's response, they rely on the *Xerox* case to
15 take another stab at this argument. Essentially the argument is that because
16 there are portions of the Petition that incorporate and reproduce Dr. Zagal's
17 testimony and opinions from his declaration, it should be given no weight.
18 The *Xerox* case doesn't stand for that proposition. *Xerox* says that when an
19 expert's declaration merely repeats verbatim the conclusory assertion for
20 which it is offered to support without additional supporting evidence or
21 technical reasoning to support the statement, that was a basis to give the
22 declaration little weight, not just because there is an overlap between the
23 Petition and the declaration.

24 I'll address the specific portions of Dr. Zagal's testimony that are
25 relevant for the disputes today and point out where he is citing to evidence
26 from the references or from other evidence and applying technical reasoning.

1 So *Xerox* doesn't provide a basis to disregard any of his testimony on the
2 issues in dispute.

3 With that, let me jump into the substance of it. I'm going to start with
4 Ground 1, the issues relating to the Ho and Aoki combination. As I
5 mentioned before, out of really three different disputes here, but they are all
6 essentially covered in the analysis of limitation 1[a], whether Ho in view of
7 Aoki discloses contacting a server for hotspot information to download,
8 comprising providing the server with at least one of 14 different enumerated
9 categories of information.

10 Those categories include a version identifier and user identification
11 information, so the argument there and the analysis there encompasses the
12 issues raised for Claim 7 and for Claim 13. Just for a little bit of background
13 and context, the limitation here is limitation 1[a] from the '662 patent. This
14 is Slide 25. We see in Claim 1 there is a recitation of 14 categories of
15 information, at least one of which has to be provided to the server as part of
16 contacting the server for hotspot information. Per the Petition, five of these
17 are disclosed or rendered obvious by Ho, and that includes the scene or
18 element for which hotspot information is desired, the model type of the
19 communication device, current location of the communication device, and a
20 version identifier for the hotspot information.

21 Of those, I'm going to focus today on element -- in my argument
22 today, I'm going to focus on element, current location and version identifier.
23 The rest are addressed in our papers, and I'll provide the pages for those, too.
24 Two other of the categories of information are rendered obvious by Aoki.
25 That is the game for which hotspot information and user-identification
26 information. For the purposes of our argument today, I'm going to focus on

1 the latter of those two, the user-identification information. For some
2 overarching context that is helpful for understanding Ho's disclosures -- this
3 is Slide 26 -- Ho expressly discloses -- let me take a step back. In its papers,
4 Patent Owner repeatedly points out the fact that Ho describes the retrieval of
5 hotspot information as automatic. The suggestion or the implication as I read
6 it is that there's no information from the client that is needed or used for this
7 determination.

8 I think that's clearly wrong when you look at the broader context of
9 Ho. Ho may describe the retrieval as automatic, but it is clear that there is an
10 exchange of information as part of that. In Ho's Exhibit 2004 in Colum 10,
11 Lines 1 to 16, Ho describes the preferred method of client and in server
12 interaction. That process involves the server obtaining data from the client
13 and device, the server checking information on client and device relating to
14 the interactive information elements, and here, the interactive information
15 elements are what are pointed to for the hotspot limitations in the claims.
16 After checking the information on the client and device, the server then
17 determines whether the interactive information elements need to be
18 changed/renewed. If so, then new interactive information elements are sent
19 to the client and device.

20 There is a very clear disclosure here that some information is sent to
21 the server as part of the request, that the server checks that client and
22 information and then uses that to determine whether to change or renew, i.e.,
23 to send new hotspot information. The examples and types of data that are
24 obtained and used for this decision are apparent from a number of the
25 specific examples and embodiments that are disclosed in Ho, so we'll walk
26 through those next. Starting on Slide 27, focusing on the scene or element,

1 Ho, as background teaches that hotspots may be part of a scene or element.
2 If we look at Figure 3 from Ho and the accompanying disclosure in Column
3 5:27-38, there is an example of a scene from a game where a player is
4 encountering a hamburger monster. The hamburger monster is described as
5 one of the interactive information elements. In this case, it's Element 56.

6 Ho explains in that same passage that if the character slays the
7 hamburger monster, then you can generate a sub-screen showing an
8 advertisement of a chain of fast-food restaurants. In this case, the elements
9 in the scene, the hamburger monster, has a hotspot that when it is activated
10 shows hidden content, in this example, the advertisement for the fast-food
11 restaurants. Ho specifically explains on Slide 28 that as part of the updating
12 process, the server obtains information relating to the interactive information
13 element. In this example, it would be the hamburger monster. In a related
14 disclosure, and I think the citation is missing from the slide, but it's at
15 Column 9, Lines 10 to 13 of Ho, Ho describes downloading and replacing
16 relevant sub-modules controlling the interactive information elements in the
17 video game.

18 The interactive information elements can be updated by downloading
19 these sub-modules. In order for the server to know what sub-modules are
20 relevant, which sub-modules need to be replaced, it has to know what
21 interactive information elements are on the client to begin with. On Slide 29,
22 Dr. Zagal, Petitioner's expert, explains that with reference to the hamburger
23 monster example in particular. He says, well, the hamburger monster
24 example would be clear to a POSITA that the client device provides to the
25 server the scene or the element for which hotspot information is desired, and
26 that's so that the server can return the appropriate hotspot information and

1 the associated advertisement. In the context in the example of the hamburger
2 monster, we can see from Ho that the advertisement that is being provided is
3 something that is relevant to that element.

4 If you have a hamburger monster, you are providing a fast-food
5 advertisement. In order to know what hotspot information, what
6 advertisement to provide, there needs to be some understanding of what
7 element is there so that you know to provide an ad for a fast-food restaurant
8 and not an ad for a cosmetics company or for a travel agency. That's one
9 example, it's one of the categories of information in limitation 1[a]. Another
10 one, on Slide 31 is the current location for hotspot information. To provide
11 some context there, Ho discloses -- and this is in Column 9, Lines 7 to 10,
12 and Column 8:19-21 -- two examples that are relevant to location. There's
13 one example in Column 9 on using the interactive information elements for
14 public announcement services, which could be warnings for hurricanes,
15 tsunamis, earthquakes and the like.

16 Another example, the one we were just looking at, at Column 8 with
17 the hamburger monster, you can show an advertisement for a chain of fast-
18 food restaurants.

19 JUDGE HOWARD: This is Judge Howard. I have a question, actually
20 on both of these, but let me start first with the public service announcement.
21 How does that relate to hotspot information? I can see your point that in
22 order to get public service or emergency announcements about a hurricane
23 or tsunami or an earthquake, it's important to know the location of the person
24 so you send the correct warnings. There would be no reason to send a
25 warning about a tsunami that's on the other side of the planet. It would also
26 make sense that this warning about tsunami is not going to be within a

1 hotspot. You're not going to want somebody to have to find out that there's a
2 warning of an important event. My question is how does this location
3 information relate to the hotspot?

4 MR. HAGIZ: Absolutely, Your Honor. It's entirely possible that you
5 might want to show the emergency announcement as some kind of
6 immediate pop-up. I would say two things. Number one, Ho did not limit it
7 to emergency announcements. It talks about propagation of public
8 announcement services generally, and there may be non-emergency
9 announcements that you do want to incorporate as an element of the game.
10 But I would say more importantly, Ho teaches that this use for public
11 announcement services, it is using these same interactive information
12 elements that are undisputably hotspots. There is no dispute that Ho's
13 interactive information elements are hotspots as described in the claim. Ho
14 does not distinguish between interactive information elements that the
15 elements themselves, for the purposes -- whether it's used for this public
16 announcement functionality or for an advertisement functionality.

17 What Ho says on Column 9, Lines 7-10, is that the interactive
18 information elements are not only for advertising. So we are talking about
19 the same interactive information elements. It absolutely may be the case that
20 there are certain instances where if there is a warning you don't want it to be
21 in response to a game element. You want to make it pop up immediately.
22 But there's no question that Ho is clearly disclosing the use of interactive
23 information elements for this purpose, and so there is a clear disclosure here
24 of location-sensitive and location-relevant information that would be part of
25 the content that is provided as part of a hotspot.

1 JUDGE HOWARD: But my problem is that, I'm willing to agree with
2 you that these interactive information elements have hotspots that can then
3 be activated by actions such as slaying the hamburger monster, that that's a
4 hotspot activity, or that's an activity that activates the hotspot and something
5 happens. I guess I'm having the problem of there's nothing in Ho that says
6 these are linked to actions. This is just having the interactive information
7 elements propagating public announcements. There's nothing that says those
8 are hidden announcements that have to be unhidden or activated in order to
9 be seen. That's the problem I'm having is this link. They only communicate
10 by activating a hotspot, and I'm not sure that that's supported by Ho.

11 MR. HAGIZ: Understood. I think there are two things that I can say to
12 help make that link. The first one is that, like I said, there's no specific need
13 for -- I think Ho, at least, undisputedly discloses the interactive information
14 elements can have hotspots that have this link that displays hidden content.
15 Those hotspots, the interactive information elements, including the hotspots,
16 can be used for a number of functionalities, including advertisements or
17 public announcement services. I think between those disclosures I would say
18 there isn't a carve-out saying well, you only use the interactive element for
19 advertisements and you don't use the interactive component for public
20 announcement services.

21 I think the disclosure of Ho is broad enough to capture the use of the
22 interactivity, the hotspot part, whether it is for advertisements or for public
23 announcement services. That's number one. The other thing that I would add
24 is that the claim is actually very, very broad here. If you look -- let me pull
25 up the full claim language on Slide 7. The claim requires contact via server
26 for hotspot information, and as part of that contacting the server, you

1 provide the server with a list of information. After that, you download the
2 hotspot information from the service, and notice, the downloading does not
3 need to be -- nowhere does it say that it is based on the information that is
4 provided to the server. As long as information is provided as part of the
5 contacting to the server, the fact that there may be non-hotspot information
6 that is provided in response to that information, that's still within the scope
7 of the claim.

8 Just as an example, let's say in the Ho example if the client contacts
9 the server to update the interactive information elements, and some of those
10 may have hotspots, some of those may not have hotspots, but the request for
11 updated interactive information elements would include both the ones with
12 hotspots and the ones without hotspots. Part of that, we need to be able to
13 provide updated elements that have this public announcement functionality,
14 you're going to need to know what is relevant, i.e., the location where the
15 user is where the announcements would be relevant. Now it may be the case,
16 as Your Honor has noted, that the interactive information elements that use
17 the location information, maybe they're not the interactive ones. Maybe
18 they're not the ones with the hotspot, and so those end up getting sent back
19 as non-hotspot information.

20 It doesn't matter from the perspective of the claim, because it doesn't
21 matter that the location information was used to identify the hotspot
22 information as long as the location information was sent as part of that
23 request. That, I think, is within the scope of Ho's disclosure, of sending
24 information as part of the request for interactive information elements. Does
25 that help at all?

1 JUDGE HOWARD: I understand your point, thank you. My other
2 question just relates to the evidence that you presented regarding the chain
3 of burger locations. And for example, in your reply, you bring out an
4 example of a regional chain such as In-N-Out, and you'd want to have the
5 location because it wouldn't make sense to have advertisement in locations
6 where In-N-Out Burger is not located. I guess my question is do you actually
7 have any evidence about this, or is this just attorney argument? Did your
8 expert opine upon it?

9 MR. HAGIZ: I think actually in Slide 32, our expert does specifically
10 note in Paragraph 114 that the rationale for providing location information in
11 the advertisement context is so that the advertised fast-food chain is one that
12 is within the geographic location of the client device. So, in the reply, the In-
13 N-Out example is just an example that applies that concept, but our expert
14 does provide that as part of the reasoning why you would include location
15 information.

16 JUDGE HOWARD: Thank you.

17 MR. HAGIZ: That is all for current location. Moving on to Slide 33
18 on version identifier. Now Ho expressly teaches on Column 9, Lines 25-33
19 and Column 10, Lines 9-16, it describes that the interactive information
20 elements may need to be updated or renewed over time. That's in Column
21 10. In Column 9, there's also a particular example that talks about the video
22 game at issue being one that is potentially still undergoing ongoing
23 development. As part of that, there may be information or additional data for
24 the game that is updated by downloading and replacing sub-modules of the
25 interactive information element. On Slide 34, Dr. Zagal explains citing to

1 these examples the POSITA would've understood or would've found obvious
2 to use a version identifier to determine what information needs updating.

3 That's based more generally on the common knowledge that software
4 developers use version identifiers and version numbers to identify the state
5 of software and different software versions and updated versions of
6 software. Among other things, he cites to Exhibit 1020, which is the Hannay
7 reference that specifically provides an example of a video game where a
8 version or an identifier tag identifies the version that has been used in
9 constructing different levels of the games and thus associates a version
10 number with each update and new content for the game. Slide 35, Patent
11 Owner's argument in the Sur-reply is essentially well, there are other
12 techniques that you could use to determine which interactive information
13 elements need to be updated. I'd say two things. Number one, the way that
14 there may be ways to do it without a version identifier does not render the
15 use of a version identifier any less obvious.

16 It is still a well-known method and technique to use version numbers
17 and version identifiers to track software, especially in the context of Ho's
18 example, where there is a software, a video game that is still in a state of
19 development so you need to update it over time as new versions are released.
20 That is an obvious way based on the prior art. I'd say the alternative option
21 that Patent Owner provides using a last modified date, that's still a version
22 identifier. Just saying that you used the date as the version number doesn't
23 change the fact that that is literally an identifier that is used to track the
24 version of the data or of the software or of the interactive information
25 element. Simply calling it by something other than a version identifier does
26 not change the fact that even per Patent Owner's example in the Sur-reply,

1 the use of an identifier to track the version for updating software is definitely
2 something that would've been obvious.

3 Then finally focusing on the Ho/Aoki combination. Ho, as mentioned
4 before, Ho already discloses that the server obtains data from the client and
5 device in order to determine what hotspot information, in this case
6 interactive information elements to send. We've looked at examples where
7 the interactive information elements are used to display ads, like the
8 hamburger example. On Slide 37, in light of those disclosures in Ho, based
9 on Aoki, as the Petition provides, it would've been obvious to also send user
10 identification information as part of that request for interactive information
11 elements. That's based on Aoki's disclosure, and this is Exhibit 1005,
12 Paragraph 77 of sending "the ID of the player who uses the game terminal"
13 to an advertisement management server.

14 In the proposed combination -- this is Slide 38 -- Aoki's user
15 identification information and game identifier, those are part of the
16 information that are sent when the server updates the hotspot information
17 rather as part of the request to the server for updated hotspot information.
18 Dr. Zagal addresses that in Paragraph 117 of his declaration. Now Patent
19 Owner's main response to this is well, Aoki uses the user identification
20 information in a different way. Aoki uses it in order to determine which user,
21 kind of a charging criteria for the ad and not for the purposes of determining
22 which ad to send. Our response is, it's irrelevant when we're looking at
23 obviousness here. It doesn't matter whether Aoki is using that information in
24 the same way as the claim.

25 The question is whether a POSITA would be motivated to combine
26 the references in a way that renders the claims obvious. Dr. Zagal on Slide

1 40 provides a number of reasons why a POSITA would, in fact, be
2 motivated to combine the references in the way that he proposes and to use
3 Aoki's user identification information specifically in the context of the
4 request for interactive information elements. Among other things in
5 Paragraph 106, he explains that both Ho and Aoki are directed to
6 improvements in game design and monetization, and are trying to overcome
7 problems with current forms of advertising and video games that do not
8 engage the player during the course of game play. So part of the problem is
9 providing ads that are more engaging and more relevant to the player. Then
10 in Paragraph 117, he said well, a POSITA based on these teachings would be
11 motivated to use Aoki's user identification information as part of the request
12 for hotspot information so that advertisements can be targeted based on this
13 information.

14 Then he cites to Exhibit 1008, which is the Sturman reference.
15 *Sturman* is, specifically on Slide 41, a prior art reference that talks about
16 using player-specific information for advertising targeting, and it's
17 specifically in the context of dynamic advertisements for video games. He
18 points to a contemporaneous reference that shows that it is well known and
19 advantageous to use player-specific information in order to better target and
20 deliver ads in an online video game advertisement concept. That provides
21 the motivation to use Aoki's user identification information, specifically as
22 part of the request for hotspot information.

23 JUDGE HOWARD: What's your response to Patent Owner's
24 argument that this is an improper use of Sturman, it's not one of the two
25 references that are identified as part of the grounds, and you can't go to this
26 unidentified reference to supply a missing limitation.

1 MR. HAGIZ: That's because, Your Honor, we're not relying on
2 Sturman for the missing limitation. The limitations are all either in Ho or in
3 Aoki. The limitation requiring sending/contacting the server for hotspot
4 information to download, that is in Ho. The part of the limitation of sending
5 information from the client to the server as part of that request is part of Ho.
6 The specific sending of user identification information from the client to the
7 server, that is part of Aoki. The elements individually are in the references
8 that are identified as part of the grounds. Sturman is not relied for to supply
9 the elements. Sturman is relied on for supplying the motivation to combine.

10 There are none of Patent Owner's cases, and I would say to the
11 contrary, I'd say the caselaw is clear that the opposite is true, you can 100%
12 rely on evidence outside of the specific prior art that is the grounds in order
13 to supply the motivation to combine. That's all we're doing here. We're
14 relying on Sturman to establish that targeted advertising is known and
15 advantageous, and so the end and the goal of targeted advertising is the
16 motivation to use Aoki's user identification information in a different way,
17 specifically as part of the request for hotspot information that Ho expressly
18 discloses, and that gets you to the claim limitation. Does that answer your
19 question, Your Honor?

20 JUDGE HOWARD: It does, thank you.

21 MR. HAGIZ: Okay.

22 JUDGE HOWARD: Just so you know, you've used about 34 minutes,
23 so you have six minutes before you hit your rebuttal time.

24 MR. HAGIZ: Yes, understood, Your Honor. I'll just briefly note again
25 Claims 7 and 13 relate to the version identifier and to the user identification
26 information. Same arguments raised by Patent Owner as we already

1 discussed for Claim 1[a], and so the same responses apply. Now let's move
2 on to Jiau and Aoki for Ground 2. There are three disputes here, one relating
3 to the downloading of hotspot information in Claims 1[b] and 13[b] -- sorry,
4 four disputes. That one, one relating to the user identification information in
5 Claim 13[a], which is similar to the arguments we just went through on Ho
6 and Aoki, and then two relating to the dependent claims.

7 Focusing on the first dispute that's at Slide 46, Jiau expressly
8 discloses downloading hotspot information. Jiau is a virtual world reference,
9 and there is a client that loads lots and objects from a server system. Jiau
10 makes clear that the lot file is sent to the client and stored in the client. This
11 is all coming from Jiau, Exhibit 1006, Columns 6:31-7:2 and 19:27-20:3.
12 That shows that the lot file is sent to the client and stored in the client, and
13 there's a reference to Figure 17, which is an example of the lot file that
14 includes hotspot information, such as objects with links and coordinates.
15 Nowhere does Jiau say well, this information is only stored in a cache. To
16 the contrary, on Slide 47, Jiau expressly discloses that the client has memory
17 for storage and that includes local memory and also long-term memory, such
18 as mass storage devices.

19 In its Sur-reply, Patent Owner argues that Jiau only ever discloses
20 storing the lot file information in the cache. The only two citations that
21 Patent Owner offers for this limiting view of Jiau's disclosure are both
22 instances where Jiau expressly notes that it is talking about an example or a
23 possibility. In Columns, I believe, 7:7-8, there is -- sorry, in Columns 10:3-5
24 it notes that it is possible that the lots are stored in the cache or a similar
25 local memory. Again, the cache is a possibility, local memory is also a
26 possibility. Another example, I think this is 13:12-14, Jiau says in the

1 described embodiment, the lots are cached by the client system. None of that
2 defeats the broader disclosure in Jiau of storing lot file information and
3 indicate that Jiau only ever discloses caching.

4 Even if we accept Patent Owner's overly narrow construction, Jiau
5 does not limit it to caching. It discloses storing to memory, which Patent
6 Owner admits is downloading. But if we focus on downloading itself, there
7 is absolutely no support for Patent Owner's view that downloading
8 somehow excludes caching. Slide 48, plain meaning of downloading is not
9 limited to storing in a longer-term sense. Plain meaning is any transfer from
10 a computer to the memory of another device, whether that memory is mass
11 storage, local memory or cached memory. That's based on the Miriam
12 Webster definition, Exhibit 1026. Consistent usage in other
13 contemporaneous references, so Exhibit 1027, is US Patent 6,496,189 from
14 December 2002, describes a cache manager that downloads information
15 from a server into a cached memory. Patent Owner doesn't point to anything
16 in the intrinsic evidence or the '662 patent that warrants a narrower
17 construction.

18 Patent Owner's only real argument on Slide 49 is that there are some
19 cases, and primarily focusing on the *Finisar* case from the Federal Circuit,
20 523 F.3d 1323, that Patent Owner says stands for the proposition that
21 downloading cannot be transient storage in a cache. If you look at the actual
22 opinion from *Finisar*, the Federal Circuit was very clear that it was focusing
23 on the specific claims at issue in that case. The Federal Circuit said well,
24 fleeting or transient retention does not qualify as the kind of downloading
25 defined by these claims, and then concluded downloading as used in the
26 patent requires something more than just transient retention of data. There is

1 a very long discussion of the intrinsic evidence of the patent at issue in that
2 case, from which the Federal Circuit concluded that downloading was being
3 used in a narrower sense that did not include transient storage.

4 No such discussion provided by Patent Owner, absolutely nothing in
5 the '662 patent to suggest that downloading somehow excludes caching,
6 even if Jiau were somehow limited to using caches to storing the lot file,
7 which it's not.

8 Moving on briefly, on Dependent Claim 7, in the Petition described
9 two alternative ways. I'm going to focus on the nVersion theory. Dr. Zagal
10 explains, Paragraph 197 of his declaration, that a POSITA would've
11 understood that this field, which literally has version in the name and is part
12 of the lot file that defines the lot and objects that are sent, Dr. Zagal explains
13 this field corresponds to a version of the lot and points to the specific
14 disclosure in Jiau that describes the nVersion field or describes the header
15 file that contains the nVersion field as sent to the client and stored in the
16 client and describing the lot and the objects associated with it. That's
17 Column 19:27–23 and Figure 17.

18 Patent Owner's response largely focused on the object ID theory that
19 we'll rest on the papers for that one. The only real argument I saw in
20 response to the nVersion field is that Petitioner relies on Dr. Zagal's
21 testimony, which should be disregarded. I've addressed that argument
22 before, we've addressed it generally. Again, Dr. Zagal here is relying on
23 specifying disclosures in Jiau and specifically, a field that has version
24 literally in the name to say that that is a version identifier.

25 JUDGE HOWARD: Mr. Hagiz, just so you know, you're into your
26 rebuttal time.

1 MR. HAGIZ: Okay, sure, I'll wrap up briefly. On Claims 12 and 20,
2 the requirement there is hidden content of the first hotspot includes a second
3 hotspot. The relevance context here on Slide 51, Jiau discloses an example
4 where an object like a house can have a hotspot link like a door. When it's
5 activated, it displays a hidden interior which is another scene. That's in
6 Column 15:17–31 and Figures 11(e)–(f) of Jiau. In addition to that, as we
7 see in Figure 11(f), this is on Slide 52, there can be additional objects within
8 that hidden content like furniture. Jiau more broadly discloses that any
9 object can have a hotspot associated with it. Even non-objects can have a
10 hotspot. Jiau calls those a hot space that are associated with it. Jiau also
11 teaches more broadly that an object can have multiple hotspots.

12 So taking all of these disclosures into account, on Slide 53 Dr. Zagal
13 explains well, based on the fact that an object can have a plurality of
14 hotspots, based on the fact that Jiau broadly describes that objects can have
15 hotspots associated with it, and based on Figure 11(f), which is showing
16 additional objects such as furniture within the hidden content of a first
17 hotspot, it's apparent to a POSITA that you can have a hotspot within a
18 hotspot, essentially. For example, a hotspot associated with the furniture in
19 Figure 11(f), which is itself part of hidden content that is triggered by the
20 hotspot in Figure 11(e).

21 JUDGE HOWARD: In looking at that Figure 11(f) that you have
22 annotated on there the second hotspot link and pointing to one of the
23 benches, is there anything in Jiau that says that's a hotspot, or is this just
24 your expert saying it is?

25 MR. HAGIZ: Jiau does not point to this specific example and say this
26 particular table is a hotspot. What Jiau more generally says is essentially that

1 every object can have a hotspot associated with it, and that hotspot can be
2 something that triggers a link, like the door of the house. It can also be
3 something that just prevents the player, essentially bounces the player off the
4 object. So if you walk into a physical object, you don't pass through it, you
5 bounce off. Based on that discussion that everything can have a hotspot
6 associated with it, there's absolutely no reason, and I think a POSITA would
7 understand that the thrust of Dr. Zagal's testimony is that these objects in
8 Figure 11(f) can also be hotspots, especially since there's nothing that would
9 preclude -- nothing in Jiau prevents the objects within one hotspot from also
10 having hotspots. That's the significance of an object being able to have a
11 plurality of hotspots.

12 JUDGE HOWARD: And where in Jiau does it say that any object can
13 be a hotspot?

14 MR. HAGIZ: Let me pull that up for you, Your Honor, one moment.

15 JUDGE HOWARD: And then also where did Dr. Zagal testify about
16 that in regard to the second hotspot link inside the house?

17 MR. HAGIZ: Sorry, I missed that second question, Your Honor.

18 JUDGE HOWARD: Sure, so I want to know where in Jiau does it say
19 it. I also want to know where does Dr. Zagal go and use that to go and say
20 that it can be anywhere, such as inside the house.

21 MR. HAGIZ: Dr. Zagal, so Paragraph 206, which is on Slide 53, is
22 where Dr. Zagal addresses this. In particular, he focuses on Jiau's disclosure
23 on Column 15, Lines 17–31, which describes the specific case in Figure
24 11(e) and 11(f). But there is also a reference to the different categories of
25 hotspots and various examples of objects and types of hotspots, which are,
26 among other places, in Column 11, Line 16 through Column 12, Line 12,

1 which all describe examples of different types of objects and different types
2 of hotspots that can be associated with them. I think the takeaway from that
3 is these can be assigned to any object in the game role. Any object that's
4 defined as part of a lot has its corresponding definition, which we see in
5 Figure 17 on Slide 46. The object has a hotspot associated with it. There is a
6 link event there and so that is kind of the structure for generally applying a
7 hotspot to any object.

8 JUDGE HOWARD: Thank you.

9 MR. HAGIZ: Then finally, just briefly on Slide 54, on the Jiau/Aoki
10 combination, again the reliance here is similar to the Ho/Aoki combination.
11 It's relying on Aoki's disclosure of user identification information and Jiau's
12 more general disclosure of sending information for retrieving hotspot
13 information. Similar rationale for combining provided by Dr. Zagal, which is
14 discussed in the Petition and in his declaration, again based on the need for
15 targeted advertising. One thing I will note on this one, Patent Owner
16 suggested the combination is contrary to the intended purpose of Jiau
17 because Jiau's lots are stored on a remote server for common access. That's
18 Patent Owner's Response 51–52 and on Slide 61. The fact that all users can
19 access a lot does not teach away from customizing the lot so that you can
20 provide a better experience to individual users based on targeted advertising.

21 There is a specific disclosure in Jiau of lots that correspond to a
22 corporate user, such as a company like Forever 21, and so that could include
23 advertisements that cater to a particular demographic. Nothing about the fact
24 that Jiau's lots are accessible to other users somehow teaches away or is
25 contrary to the use of user identification information to provide a better

1 experience through targeted advertising. With that, I will reserve the rest of
2 my time for rebuttal. Thank you, Your Honors.

3 JUDGE HOWARD: Thank you. You'll have a little bit over 13
4 minutes left. Mr. Lee, are you going to be starting?

5 MR. LEE: Yes, Your Honor.

6 JUDGE HOWARD: Okay, and how much time would you like to
7 reserve for your surrebuttal?

8 MR. LEE: Ten minutes, please, Your Honor.

9 JUDGE HOWARD: Okay, whenever you're ready, you can begin.

10 MR. LEE: Great. I'll go ahead and pull up some slides and
11 demonstratives to help us with that. Can everyone see the slides that I'm
12 sharing?

13 JUDGE HOWARD: We can.

14 MR. LEE: Great, thank you. I want to dive right back into where
15 Counselor was just speaking on the Jiau grounds, including due to the
16 recency, but also because the Jiau grounds, Grounds 2 and 4, are the only
17 grounds in the Petition that challenge all 20 claims in the '662 patent. We've
18 got that summarized here on Slide 27, Petitioner relies on Aoki and Kim in
19 combination with Jiau in each of these grounds. As we've seen in the
20 demonstration today, the vast majority of the parties' disputes are with
21 respect to Jiau itself, because the reliance with respect to Aoki and Kim was
22 primarily with respect to coordinate information limitations that aren't in
23 dispute in this proceeding. Really the parties' disputes on these grounds
24 concern Jiau's disclosures.

25 I want to turn first to Claim 13 of Jiau, where Counselor left off, but
26 before I do that, I want to take a moment to make sure that we all understand

1 what Jiau is disclosing. What I mean by that is this virtual world that Jiau
2 describes has three very distinct aspects to it, a virtual lot, objects within that
3 lot, and then hotspots that may be associated with objects. There are three
4 very distinct aspects of this virtual world, and I fear at times Petitioner
5 conflates the disparate teachings in Jiau with respect to these three discrete
6 items. Just for illustration, we can see on Slide 28, Figure 11(d) from Jiau, a
7 view of a virtual lot generally that has objects, such as 1182, the Buy Brand
8 X billboard, that's an object, as well as object 1184, Buy Brand Y, that's an
9 object, and then a hotspot, 1186, the push button.

10 Let's keep this in mind. It's going to be very relevant to our
11 conversation today. Notwithstanding that Jiau does disclose a hotspot, Jiau
12 fails to disclose or suggest numerous limitations of the challenged claims,
13 including in Independent Claim 13, which we have on the screen as Slide 29.
14 Now notably, the first, step A, the first step in this method claim is for a
15 mobile communication device to retrieve hotspot information by contacting
16 a server for hotspot information to download, comprising providing the
17 server with user identification information. Now in the Petition, Petitioner
18 asserts that Jiau discloses this limitation based on contacting the server for a
19 virtual lot, the inference being that the lot is going to have objects that may
20 have hotspots. So the request is contact the server for the virtual lot. Well,
21 Jiau never discloses providing the server with any user identification
22 information in that step.

23 We see Jiau's relevant disclosure of this on Slide 30, which is a
24 reproduction of Figure 8 from Jiau. As clearly shown, when a client system
25 of Jiau is requesting a lot, it is following this procedure of submitting lot IDs
26 and object IDs. In particular, what Jiau describes to us is that in a virtual

1 world, the user will start in a first lot and it will request, and the server will
2 provide, the surrounding eight lots to that user. In my mind, I think of this as
3 a tic-tac-toe board. The user is standing in the center square, if you will, of
4 the tic-tac-toe board, and as requested, the eight lots surrounding that center
5 square. Now as the user moves in the virtual world, the client system will
6 appreciate that movement and will make new requests to Jiau's server in
7 view of that movement. So as the user moves from the center square of the
8 tic-tac-toe board to an adjacent square, the adjacent square effectively
9 becomes the new center square and new lots are requested.

10 Again, we see that process here in Figure 8, and in that process the
11 only information that is being sent to the server by the client are these lot
12 IDs and these object IDs because these requests are based on the movement
13 of the user in the virtual world. There is no disclosure in Jiau that in making
14 these requests based on the user's movements that the Jiau client system is
15 submitting providing to Jiau's server any user identification information.
16 Now faced with this fact and this clear disclosure in Jiau, Petitioner resorts
17 to suggesting that well, Jiau somehow does this because each lot was created
18 by a user and has an associated user ID. Because that user ID is associated
19 with a lot ID, it somehow must be sent to the server. That's just not at all
20 what's disclosed in Jiau. I think what's notable here, if we turn to the '662
21 patent, excuse me, the Jiau reference, and the particular evidence that
22 Petitioner relies on here, it's Figure 13(a) and Figure 13(b) that disclose
23 examples of data structure for these lots.

24 That includes the user ID. Well, Jiau makes clear that that property,
25 the user ID and other properties, are stored in the server system, not on the
26 client system. The client system does not have the user IDs of these adjacent

1 lots that it is requesting, and there is no disclosure in Jiau that the client
2 system is submitting any such user IDs when the user moves in the virtual
3 world of Jiau. Moreover, this disclosure follows immediate disclosure in
4 Jiau about submission of the lot IDs and the object IDs. That's what the
5 client server is sending. Only when the client system sends these lot IDs and
6 object IDs, then does the server respond with the full lot information sent to
7 the client system, including the user ID. This all makes sense. Jiau's
8 disclosure is trying to mimic the real world. When we are walking in the
9 virtual world and we turn a corner in Downtown DC or in Downtown
10 Atlanta where I am, my eyes adjust to my location and I see the new lot, the
11 new parcel, the new buildings adjacent to me.

12 I am not telling my eyes that I only want to see buildings that are
13 owned by John Doe or I only want to see buildings that are owned by Jane
14 Doe. Rather, as I'm navigating this world, just as the user is navigating the
15 virtual world in Jiau, as they move a request for the adjacent lot IDs is made
16 by those lot IDs, no user information. So we know that Jiau doesn't disclose
17 this user identification information because Petitioner resorts to Aoki to fill
18 this void in Jiau. In particular, we see on Slide 31 the testimony of Dr. Zagal.
19 Now respectfully, this is a verbatim copy of the Petitioner's arguments in the
20 Petition. So instead of two slides, I've collapsed it into one here. There are
21 two very important aspects of this, and I've neglected our highlighting here. I
22 wish I would've highlighted more in light of Counsel's arguments this
23 morning.

24 There are two underlying principles with respect to Petitioner's
25 argument based on the Jiau and Aoki system with respect to Claim 13. The
26 first is that Aoki discloses a game terminal that runs a video game that

1 provides the ID of the player in order to obtain advertisements. Dr. Zagal
2 and Petitioner, their read of Aoki is that that system submits the player ID in
3 order to obtain advertisements. Based on that interpretation, Dr. Zagal and
4 Petitioner say in the combined Jiau/Aoki combination, the Jiau client device
5 would submit a player ID when requesting these virtual lots. As we
6 explained in the brief, this is a misread of Aoki, a very material misread of
7 Aoki. Counselor says that we're focused on a different use case of Aoki, and
8 that's false. Patent Owner's arguments with respect to Aoki are with respect
9 to the time at which the Aoki system submits the player ID. The Aoki
10 system does not disclose, does not teach submission of a player ID in order
11 to obtain advertisements.

12 There is no disclosure or suggestion of targeting advertisements to any
13 user in Aoki. Aoki actually discloses the exact opposite. In the Aoki system,
14 there are agnostic ads that are going to be displayed in these games, and the
15 Aoki invention is trying to figure out on the back end at the end of the game
16 who viewed these ads and was it the people that the ad publishers wanted to
17 view these ads. You can see reduced here on Slide 32, this is a clear
18 disclosure in Paragraph 88 and 89 of Aoki talking about this inventive
19 advertisement charge process, noting that the user information in Aoki, the
20 only time, the only time the game terminal sends any user information to the
21 advertisement server in Aoki is "at the time of ending the game." That is
22 when the Aoki system intakes that player ID, intakes other information
23 about how many times an ad was viewed and other attributes to determine
24 what should be charged to the advertising publisher.

25 There is, again, no disclosure in Aoki about any player information
26 being sent at the outset of the game or when requesting any advertisement

1 information. There's none. That's not in there. Likewise, in the combined
2 Jiau/Aoki system, the only player ID, user ID information that would be sent
3 would be sent at the end of Jiau's virtual world experience to then ascertain
4 what player may have viewed what advertisement. There is no suggestion in
5 Aoki that any of that would be done on the front end for any type of
6 targeting advertisement. Notwithstanding Counselor's arguments, but we see
7 what Petitioner tries to do here. Patent Owner pointed out this
8 misinterpretation of Aoki in our response, and it's then in Petitioner's reply
9 we see a major pivot, a major pivot. Now they try to bring in the Sturman
10 reference and argue that Sturman discloses targeting advertising.

11 Well, frankly, Sturman forms no part of these grounds, either Ground
12 2 or Ground 3, so that just cannot be. There's been no showing here and
13 Counselor has admitted that Petitioner is not relying on these disclosures of
14 Sturman, that they believe all these limitations are disclosed in Aoki and Jiau
15 and that's plainly not the case. Now additionally with respect to Independent
16 Claim 13, certainly we feel this lack of showing with respect to limitation
17 1[a] is dispositive and each of these grounds necessarily fail. Additionally,
18 they also fail in light of the downloading limitation in Claim 13(b) on Slide
19 34. Counsel represented that Jiau expressly discloses downloading. The
20 word downloading never appears in Jiau. What Jiau discloses is caching,
21 caching these virtual lots in its system.

22 Patent Owner's expert, Dr. Akl, testified that a POSITA would
23 understand that this fleeting caching of these virtual lots, you fetch, you
24 discard, you fetch, you discard, that's not downloading. That's not a reliable
25 means for latter access of the data. This is unrebutted.

1 JUDGE MCKONE: This is Judge McKone. This sounds an awful lot
2 like the claim construction argument, so I'll ask are you proposing a claim
3 construction for downloading?

4 MR. LEE: Respectfully, Your Honor, we believe this is the plain
5 meaning of downloading, and I believe that's confirmed by other district
6 court and federal circuit cases that have loosely articulated the same.

7 JUDGE MCKONE: So your evidence of the ordinary meaning then is
8 other federal lawsuit cases? That's what we have to go on? That's what we're
9 going to point to if we decide that that's the ordinary meaning?

10 MR. LEE: We think that supports our position. In terms of, if you're
11 looking for intrinsic evidence, I believe there's multiple disclosures in the
12 '662 patent itself establishing that the downloading described by the patent
13 will not be satisfied by caching. I note that at Column 4, Lines 56-67, there's
14 express discussion in the '662 patent that this information, the hotspot
15 information, must be downloaded so that it can be accessed even when
16 there's not a continuous link with the server. In Column 7, Lines 59-62, as
17 well as Column 10, Line 16, Column 10, Lines 61-67, the '662 patent
18 expressly discusses the time and the bandwidth required to download this
19 hotspot information knowing that it's going to be a lengthy process and that
20 the user may want to delay that because it's going to take up a lot of
21 memory, it's going to take up a lot of bandwidth and it's going to take up a
22 lot of time. I think that illustrates that downloading is contemplated --

23 JUDGE MCKONE: Does any of this discuss caching?

24 MR. LEE: No. Caching is not disclosed nor contemplated in the '662.

25 JUDGE MCKONE: And you're saying it's excluded by downloading,
26 so I'm wondering if you have any -- since we're going to the intrinsic

1 evidence, do you have any lexicography, any words of disavowal or
2 exclusion that we would point to if we were to agree with you and have to
3 write this up so that the Federal Circuit didn't reverse us?

4 MR. LEE: No, Your Honor. Again, we aren't taking the position of
5 any lexicography or express disavowal with respect to caching. Rather just
6 that the ordinary and customary meaning of downloading just does not
7 contemplate caching.

8 JUDGE MCKONE: If we write this up in your favor, our support is
9 the Federal Circuit has given its construction of downloading in a different
10 case on different facts, but we should still accept that as evidence of the
11 ordinary meaning?

12 MR. LEE: Including a lot of intrinsic evidence here that stresses the
13 time, the bandwidth associated with downloading hotspot information
14 making clear that caching would not fit that bill.

15 JUDGE MCKONE: Okay.

16 JUDGE HOWARD: This is Judge Howard. Don't you have a problem
17 because one of the cases that you cited to us explicitly said there's no plain
18 and ordinary meaning? In fact, rejected the plaintiff's argument in that case
19 that it had a plain and ordinary meaning, saying that the dictionary
20 definitions it found can have either a broad or a narrow ordinary and plain
21 meaning and therefore turned to the specification to determine what the
22 claim meant. That seems to be very inconsistent with what you're saying
23 here.

24 MR. LEE: That's a valid point, Your Honor. Again, I --

25 JUDGE HOWARD: Also then just to add, the *Finisar*, the Federal
26 Circuit decision doesn't discuss a plain and ordinary meaning. It relies on the

1 specific language in the claim where it talks about downloads "into a
2 memory storage device," which is different than the language you have here.
3 It goes into a very detailed discussion of the specification and relies on claim
4 differentiation, none of which you have here. So I'm concerned about your
5 saying there's this plain and ordinary meaning based on cases where the
6 cases seem to say there's no plain and ordinary meaning.

7 MR. LEE: Understood, Your Honor. That's a very valid point. We
8 certainly think those cases are illustrative, though certainly there are some
9 different facts at issue. Again, we think with comparing the Jiau disclosure
10 of caching, this is a continuous connection with a worldwide network web,
11 and that's just not at all what's contemplated by the '662 patent as both
12 claimed and described in those portions of the specification that I cited. In
13 light of time, I'd like to turn to some of the dependent claims to the '662
14 patent.

15 JUDGE HOWARD: Before we get to this, I have a question about
16 Claim 1 in the Jiau and Aoki combination. I see where you do your
17 arguments about Claim 13, how it doesn't teach limitation 13[a]. I don't
18 know why you didn't argue it doesn't teach also limitation 1[a], which
19 Petitioner relies on the same arguments. Let's just say hypothetically I found
20 that I agreed with you that the references don't teach 13[a]. What am I
21 supposed to do about limitation 1[a]? Am I then supposed to do an argument
22 that you didn't do, or am I just supposed to say Patent Owner doesn't dispute
23 it, so we're going to go on to the rest of the claim?

24 MR. LEE: You are correct, Patent Owner has not disputed that in
25 briefing. I think it's clear on the face of those claims. Claim 1 contemplates
26 provision of a number of different items of information in addition to this

1 user identification information. In view of those other options that are
2 presented in Claim 1, in light of Jiau's disclosures, Patent Owner has not
3 disputed that aspect of Claim 1, though again, certainly disputes the user
4 identification aspect in Claim 13.

5 JUDGE HOWARD: Okay, thank you.

6 MR. LEE: Mindful of my time, I want to focus on Dependent Claim
7 20 that I know Your Honor had some questions about earlier. I'll try to get
8 through this quickly, because my colleague is going to address the Ho
9 grounds, as well. Dependent Claim 20 requires that the hidden content of
10 that first hotspot itself can provide the second hotspot. I think Your Honor
11 asked some very pointed questions of Petitioner's counsel. We see on Slide
12 37, this is the extent of Petitioner's and Dr. Zagal's argument on this. In
13 essence, that this Figure 11(f) of Jiau may disclose this furniture and it may
14 have a hotspot because of all these other things. I think, Judge Howard, to
15 your question, I'm not sure you got a straight response from Petitioner's
16 counsel about some of the support for this. This is the extent of Dr. Zagal's
17 testimony. Now if we go to Slide 38, I think this is key. Petitioner showed
18 you a heavily-annotated version of these figures. I think it's more important
19 to look at these as Jiau presents them.

20 Figure 11(e) discloses a hotspot, the door, 1104. When that's
21 activated, we see, Jiau tells us, Figure 11(f). Now notably, Jiau describes this
22 as an interior view. This is an interior view. Jiau never describes an object in
23 Figure 11(f). It never describes a hotspot in Figure 11(f). Jiau uses the term
24 hotspot 100 times. It never uses it in reference to Figure 11(f). So, there is no
25 disclosure in Jiau of any object in Figure 11(f), let alone an object having a
26 second hotspot. We respectfully submit that Petitioner's and Dr. Zagal's

1 arguments here, this is pure hindsight speculation. There is no evidentiary
2 support for their contention that Dependent Claim is rendered obvious in
3 view of Jiau.

4 JUDGE HOWARD: Looking at the Figure 11(f) that you have there,
5 it does show objects that are in there. There's two benches. If, as Petitioner
6 argues, Aoki, or sorry, Jiau teaches that any object can be a hotspot, why
7 wouldn't those benches also be hotspots? I don't think there's a requirement
8 for Jiau to identify every single object as having a hotspot in the
9 specification if elsewhere it says every object can be a hotspot.

10 MR. LEE: I think a key distinction there is, again, unlike other figures
11 and other disclosures in Jiau, Jiau never identifies any object in Figure 11(f).
12 So we're presuming, we're speculating that these items are one, objects. Then
13 there's going to be a further level of speculation that those objects would
14 have hotspots themselves. I certainly appreciate Your Honor's read of Jiau
15 generally, but I think we have to look at how Jiau has chosen to describe,
16 and frankly, not describe, Figure 11(f), what it has and what it doesn't have.

17 JUDGE HOWARD: But why wouldn't those -- if I'm not going to use
18 the word objects, if I can't use the word objects, I'm not even sure how I
19 would -- those things inside Figure 11(f), they look like objects. Why
20 couldn't a POSITA go and say these things that look like objects are objects?

21 MR. LEE: Even if a POSITA does that, there's no disclosure that
22 those items would have another hotspot. So again, we're dealing with
23 multiple levels of inferences that have to be drawn, and frankly, we just
24 don't feel like Petitioner has carried their burden to show that. Again, this is
25 the entirety of Dr. Zagal's testimony on this. It's just a conclusion that this
26 presumed furniture may have a hotspot. There's just a lot of levels of

1 inference here that would need to have been shown, and respectfully, we just
2 don't believe Petitioner has carried that burden.

3 JUDGE HOWARD: Petitioner has taken the point that Jiau teaches
4 that all objects can be hotspots. Is that something that you agree with or
5 disagree with? If you disagree with it, where's your support for disagreeing
6 with it?

7 MR. LEE: I think I would disagree with that. I would direct you to,
8 for example, we could go to Figure 11(d) on Slide 28. We see two objects
9 here, the Buy Brand Y object, 1184, that has a hotspot, 1186. 1182, Buy
10 Brand X, is not shown as having a hotspot. There's certainly disclosure in
11 Jiau of objects that do not have hotspots, so if Petitioner is newly suggesting
12 that every object in Jiau is going to have a hotspot, I don't think that's
13 accurate, although again I'm not sure where on that spectrum Petitioner's
14 arguments or inferences may fall.

15 JUDGE HOWARD: I don't think anybody has argued that all objects
16 have hotspots, it's any object could have a hotspot. It's a big difference.
17 Could you respond to that second? Do you agree that any object in Jiau
18 could have a hotspot?

19 MR. LEE: I believe Jiau --

20 JUDGE HOWARD: If not, then what's the support for your position?

21 MR. LEE: I believe Jiau has a very general disclosure that objects
22 may have hotspots. I certainly want to answer any other questions you have,
23 but I also want to give my colleague, Ms. Koballa, a chance to respond on
24 the Ho grounds within our time.

25 JUDGE HOWARD: That's all the questions I have on this ground.

1 MS. KOBALLA: Good afternoon, Your Honors. This is Kasey
2 Koballa for Patent Owner. I'd like to start at Slide 10, and I'm going to
3 address Grounds 1 and 3, in which Petitioner relies on Ho as a primary
4 reference. In each of these grounds, Petitioner relies on secondary references
5 Aoki and Kim, but as Petitioner acknowledged, Kim is largely not in dispute
6 in this present proceeding. As you can see on Slide 10, there is no challenge
7 to Dependent Claims 12 or 20 in either of these grounds. Skipping ahead to
8 Slide 12, I'd also like to start with Claim 13[a], but to Your Honor's
9 question, I will also address Claim 1[a]. I'll just start with Claim 13[a]
10 because it's a little bit narrower, and Claim 13 is also materially different
11 from Claim 1. It recites contacting a server for hotspot information to
12 download, and when you contact the server to download the hotspot
13 information, you're providing the server with user identification information.
14 All that happens in one step in Claim 13[a].

15 Turning to Slide 13, as Petitioner concedes, Ho doesn't teach this step
16 of providing user identification information. Ho only teaches that interactive
17 information elements may be used to display ads. In doing that, you're
18 checking some undisclosed information to update those interactive
19 information elements, which Petitioner contends is the hotspot information.
20 But Ho doesn't specify any information that's used to trigger that update or
21 what information may be provided. In light of that deficiency, Petitioner
22 doesn't even contend that Ho discloses this limitation of Claim 13[a].
23 Petitioner looks beyond Ho. Turning to Slide 14, that's really why Petitioner
24 points to either Aoki or Kim in Grounds 1 and 3. But at least with respect to
25 Claim 13[a], Petitioner doesn't challenge that element with its proposed

1 Ho/Kim combination. Ground 3 fails as a matter of law with respect to
2 Claim 13[a].

3 Really the only issue with this element is that Petitioner alleges that
4 it's met by its proposed Ho/Aoki system. More specifically, Petitioner
5 contends that the client device in that Ho/Aoki system first provides the
6 server with the player ID, and then subsequently downloads the hotspot
7 information. As I just explained, that's not taught by Ho, and it's also not
8 taught by Aoki. Turning to Slide 16, or sorry, 15, Mr. Lee discussed the
9 Aoki system. It's really directed to a game advertisement charge system. In
10 this system, Aoki never provides the server with that user identification
11 information when it's contacting the server for that hotspot information to
12 download. At most, Aoki is really only providing the server with the ID of
13 the player or the user identification information at the conclusion or at the
14 end of the game. That's the same for the claims in the '662 patent, but in the
15 proposed Ho/Aoki system, that's only going to occur after that interactive
16 information element of Ho had been downloaded.

17 That's because Aoki really only teaches a post-advertisement display
18 analysis and sending of that information in its charge system. There's
19 nothing in Aoki that suggests that those advertisements should be targeted
20 on the front end based on any user information. It's really the opposite. Aoki
21 acknowledges that those ads aren't targeted to users Aoki sends generic
22 advertisements, and then at the end of the game Aoki calculates the charges
23 based on what ads were viewed or displayed. There's nothing in Aoki that
24 suggests that it sends this information in the first instance when it's
25 requesting what ad to send or requesting hotspot information.

1 JUDGE GALLIGAN: Counsel, this is Judge Galligan. I have a
2 question on that, and I appreciate the disclosure there at Paragraphs 88 and
3 89. I know Petitioner relied on Paragraph 77. At least it looks like there's an
4 uploading at Step S102. I think I'm looking at the right reference, Aoki,
5 Exhibit 1005. It says that also included in the record is user information such
6 as the ID of the player. If that's what Petitioner is relying on, I appreciate
7 there may be a disclosure of a later user ID, but can you please address that?

8 MS. KOBALLA: I'm sorry? Paragraph 77? Is that what you're looking
9 at?

10 JUDGE GALLIGAN: Yes. I thought that's what Petitioner relied on
11 for an earlier disclosure on the process of uploading of a user ID. I
12 appreciate that there's a later disclosure of that, too, in the process, but is this
13 not a disclosure of uploading the user ID or identification of the user?

14 MS. KOBALLA: Yeah, I agree that Aoki does disclose providing the
15 user ID, but what's important in Aoki is that this ID is provided at the end of
16 the game after that ad's been displayed. That's distinct from the order of the
17 claims in the '662 patent that require contacting the server and then
18 providing that user information, and then later downloading that hotspot
19 information. That's really the distinction that we're making from these
20 disclosures in Aoki.

21 JUDGE GALLIGAN: Okay, and just to follow up on that, I
22 understand that Figure 12 shows it later, but maybe I'm missing something,
23 but isn't Step S102 there upload advertising point, and then it says receive
24 new advertising data at 104. Is that not a disclosure of uploading the ID of
25 the player, or is that something different? Am I looking at a different
26 process? That's what Petitioner points to, and that's what I was trying to

1 reconcile. Feel free to address this in your surrebuttal, as well. I just didn't
2 say anything about it. I was curious about it when Mr. Lee was talking about
3 it. Maybe he can address it then, thank you.

4 MS. KOBALLA: I believe this is the same process and that the user
5 ID is provided after, but we can also address this in our rebuttal.

6 JUDGE GALLIGAN: Yeah, thank you.

7 MS. KOBALLA: Turning next to our Slide 16, if you can go back to
8 our demonstratives, Mr. Lee? Likely realizing that there is this hole in its
9 proposed Ho/Aoki combination, Petitioner cites to three new references,
10 Sturman, Chu and Ellis, although primarily focus on Sturman in their
11 argument, but Petitioner failed to rely on any of these references in any
12 ground in their Petition. The *Intel* decision proves that this is improper. It's
13 improper to rely on art that wasn't included in any asserted grounds to
14 supply a missing limitation. If Petitioner is trying to couch this as the state of
15 the art, but what they're really doing with Sturman is filling this gap that's
16 not met by Ho or Aoki, and that's improper.

17 But even setting those procedural aspects aside, given that Petitioner
18 didn't rely on any of these in any grounds, neither Petitioner nor its expert
19 have explained why a POSITA would've applied the teachings in Sturman or
20 any of the other references to Ho or Aoki. They also haven't explained why
21 the Ho/Aoki system would've been modified or how a POSITA would've
22 been successful in making any modifications. There's really a complete lack
23 of evidence to support any reliance on Sturman or any of the other
24 references. Unless Your Honors have any other questions on Claim 13, I'd
25 like to move on to some of the dependent claims. Just to hit these really
26 quickly on Slide 12, obviously Petitioner doesn't challenge 20 under either

1 of these Ho grounds, and because Petitioner hasn't met its burden with
2 respect to Claim 13, they also haven't met their burden with respect to 14
3 through 19 either.

4 Next I'd like to turn to Claim 1 on Slide 18, and specifically I'd like to
5 focus on Claim 1[a]. Claim 1[a] recites a number of factors, and providing a
6 server with those factors. That includes model type of the mobile
7 communication device or the user identification that we already talked
8 about. As you heard from Petitioner, they contend that seven of these 14
9 recited elements are disclosed by either Ho alone or the combination of Ho
10 and Aoki. One of those, we obviously discussed the user identification
11 information. The combination of Ho/Aoki doesn't disclose that, but the
12 remaining factors also aren't disclosed. I'd like to start with just talking about
13 Ho alone, if you could turn to Slide 19, please. As you've heard today, Ho
14 doesn't teach providing the server with any specific information. Ho only
15 discloses that these interactive information elements may be automatically
16 updated or that those elements may be changed or renewed.

17 In viewing that, all Ho discloses is that some unidentified information
18 may be provided to trigger that change, but it doesn't specify what that
19 information is. With this lack of disclosure, and really lack of support in Ho,
20 Petitioner's arguments are really only premised on its and Dr. Zagal's
21 speculations on what information may be checked. That's really just based
22 on hindsight speculation, which is improper, and Petitioner hasn't carried
23 their burden to show that this is disclosed in any of the references. Turning
24 to Slide 20, I'd really like to exemplify one of those arguments. Now as you
25 can see on Slide 20, this is really the entirety of Petitioner and Dr. Zagal's
26 argument that Ho renders a model type of a mobile communication device.

1 But as you can see in the slide, this is not based on any support in Ho. It's
2 really devoid of any evidence, devoid of support, doesn't have any analysis.
3 That's because Ho doesn't disclose anything that relates to a model type.

4 Instead, this is really only conclusory hindsight testimony that is
5 unsupported by the record. This exemplifies each of Petitioner's arguments
6 with respect to the elements in Claim 1[a]. It's unsupported by the factual
7 record and only based on hindsight. I'd like to go through another example
8 on Slide 21. Petitioner also asserts that Ho necessarily provides the server
9 with the current location of the mobile communication device, but again, this
10 is really based on a hindsight view of two disclosures in Ho. The first is
11 because Ho discloses that it may reveal advertisements for chains of fast
12 food restaurants, but there is nothing in Ho that correlates any fast food
13 chain to any location. Instead, those ads in Ho are generalized, they're
14 agnostic of the location. They don't relate to any specific fast food chain or
15 airliners, I think are also disclosed. Dr. Zagal cites to nothing to support
16 Petitioner's conclusion that any of these fast food chains are tied to a
17 location.

18 Second, Petitioner alleges that this is not based on Ho's disclosure of
19 sending emergency warnings or public announcements. Petitioner really
20 ignores that this is an alternative embodiment. This is distinct from the
21 disclosure in Ho of sending those advertisements. It's a different use case
22 when you're sending these emergency warnings or public announcements.
23 These warnings are instantly transmitted, and as Your Honor indicated
24 earlier in a question to Petitioner, these emergency warnings aren't hidden
25 hotspots in the game. Claim 1 expressly requires that the hotspot information
26 comprise hidden content.

1 JUDGE HOWARD: Counsel, what about Petitioner's claim
2 construction, or I guess claim construction argument, that if you look at
3 Claim 1, you need to be contacting a server for hotspot information to
4 download, which includes providing some information. But there is nothing
5 in the claim that goes and ties that information that you've provided to the
6 hotspots that you later get. Why wouldn't the claim be met by Ho, which
7 teaches sending the location information in order to have these types of
8 warnings, and then it gets hotspots, which may have nothing to do with that
9 location information, but satisfy the rest of the claim. Why doesn't that just
10 meet the limitations?

11 MS. KOBALLA: Well, Petitioner hasn't met their burden with that or
12 explained how any POSITA would've made that modification. I think it's
13 also important just looking at these two distinct embodiments in Ho. These
14 are two different use cases. On one hand you have that --

15 JUDGE HOWARD: Why can't they be both? I sort of looked at this. It
16 sort of seemed to me that you have these hotspots that you get that can have
17 ads, and the game also provides in case there's a tsunami coming near you,
18 it's going to give you warning of that tsunami. Petitioner goes and says in
19 order to give these warnings, you need to know the person's location
20 because, I guess, why would you need to know about a tsunami on the other
21 side of the country. That all seems to make sense to me, so it seems to make
22 sense that Ho is teaching in order to get that information, they must be
23 sending location information. Is there anything in the claim that ties that
24 need for that location information that's being sent as part of the request to
25 actually the hotspot advertisement that you get?

1 MS. KOBALLA: Well, I don't think there's anything in the claims, but
2 I think it's important that in the record, Petitioner hasn't made that showing
3 that there would be any reason that a POSITA at the time would've
4 connected those two distinct disclosures in Ho to make that connection and
5 then meet the claim.

6 JUDGE HOWARD: Thank you. I understand your point.

7 MS. KOBALLA: Next, I'd like to quickly address Petitioner's
8 argument that Ho discloses a scene or an element for which hotspot
9 information is desired. Flipping quickly to Petitioner's demonstratives, I'd
10 like to go to their Slide 28. Petitioner alleges that this is disclosed in Ho,
11 based on Ho's disclosure of these interactive information elements and that
12 these relevant sub-modules are downloaded and replaced. But I think
13 Petitioner really leaves out an important highlight of this first, but this
14 happens automatically. So, Ho automatically downloads and replaces these
15 relevant sub-modules, and automatically sends these interactive information
16 elements. But it doesn't send this information in any response to any request
17 for any particular element or specified scene. Next, I'd just like to flip back
18 to our demonstratives and I'd like to go to Slide 22. As I mentioned before,
19 Petitioner doesn't challenge Claim 12 under either of these grounds.
20 Petitioner also hasn't met its burden with respect to Claim 7. Claim 7 recites
21 a version identifier for the downloaded hotspot information, and this version
22 identifier is also cited in Claim 1[a].

23 Turning to Slide 23, I'd like to address the version identifier with
24 respect to Ho.

25 JUDGE HOWARD: Counsel, just so you know, you have five
26 minutes until you hit your rebuttal time.

1 MS. KOBALLA: Thank you, Your Honor. At most, Ho really checks
2 unspecified information to see if that interactive information element needs
3 to be changed or renewed. Ho doesn't talk about any versions or different
4 hotspots. Ho is primarily concerned about the legitimacy of those elements
5 and making sure that they haven't been modified or tampered. That's
6 explained in Ho, Page 10, Lines 6-15. Because there is no versioning in Ho,
7 there is likewise no disclosure in Ho about any version identifiers. Turning
8 to Slide 24, as you can see without this disclosure, Petitioner again has to
9 resort to Dr. Zagal. Again, they only speculate why this is disclosed because
10 allegedly there would be no other way to determine if the information would
11 need to be updated. Petitioner and Dr. Zagal don't share that this is disclosed
12 in Ho, and it's really merely hindsight and not sufficient under this Board's
13 standard.

14 In fact, Dr. Akl explained what a version identifier is. Paragraph 93 of
15 his declaration, he explained that this would be a unique number or other
16 designation for distinguishing one hotspot information from another. With
17 today's technology, you think about document management systems. You're
18 going to have a number for a document, different versions. It could be 1.1,
19 2.1. It's going to be a pretty complex system that would be difficult to
20 implement. There are many other feasible ways to tell if a document would
21 need to be updated, and that's exactly what Dr. Akl explained. He explained
22 that there are a number of other ways that a device could determine whether
23 that element needs to be changed or renewed. That could be based on the
24 date and the time of last connection, the date and the time that the interactive
25 information element was last modified, or the date and the time that the

1 interactive information element was created, exactly the same way that you
2 would be able to tell if a document were out of date.

3 So Petitioner's explanation that a POSITA would've relied on that
4 version identifier is not sufficient, both because there's not any disclosure in
5 Ho of version identifiers or any versioning, and Dr. Zagal's conclusory
6 testimony doesn't fill this gap. Again, in likely realizing this, Petitioner cites
7 to a new reference, Hannay, but again, Petitioner fails to rely on Hannay in
8 any ground, which is improper under the federal circuit precedent identified
9 on Slide 25. Not only was it not presented in the ground, but Petitioner and
10 Dr. Zagal have not explained why a POSITA would've applied the teachings
11 in Hannay to Ho. In fact, a POSITA wouldn't have been because these
12 versions described in Hannay are for an entire game or a level. They are not
13 specific to any content that could be replaced like the interactive information
14 elements in Ho.

15 Unless Your Honors have any other questions, I'd like to save the rest
16 of our time for rebuttal.

17 JUDGE HOWARD: Thank you. You have a little bit more than 11
18 minutes left.

19 MS. KOBALLA: Thank you.

20 JUDGE HOWARD: Okay, Mr. Hagiz, you have 13 minutes and 15
21 seconds left for your rebuttal. You can begin whenever you're ready.

22 MR. HAGIZ: Absolutely, Your Honors. Is there anything in particular
23 that you would like me to touch on? Otherwise, I'll go in the order that I
24 have my notes.

25 JUDGE HOWARD: There is. So, I am particularly interested, and we
26 can look at it in terms of Dr. Zagal's testimony at Paragraph 117 where he

1 cites Aoki Paragraph 77 for Aoki teaches sending the user identification in
2 order to obtain advertisements and how that paragraph relates to what Patent
3 Owner relied on when they were looking at Paragraph 88 -- I believe it was
4 88 -- which implied that this was done after the advertisements were shown.

5 MR. HAGIZ: Absolutely, let me see if I can share that. Can you see
6 my screen?

7 JUDGE HOWARD: I can.

8 MR. HAGIZ: Sorry, it was acting up and I wasn't sure if it would go
9 through. So, a few points on Aoki, I think it applies both to the combination
10 with Jiau and the combination with Ho. I think the problem -- two things. It
11 seems like when Mr. Lee was presenting on Aoki, he seemed to be focused
12 on what is admittedly an imprecise description of Aoki insofar as, I think in
13 the paragraph he was referring to it described Aoki's user ID information
14 being used to retrieve an ad. But I think I addressed this in my argument
15 previously. We're not relying on Aoki for the sending information to get the
16 hotspot information. Ho already describes contacting the server for hotspot
17 information. Ho already describes providing that information as part of that
18 request. All that's missing is a specific disclosure of sending user ID
19 information to the server, and that is in Aoki, whether it is used for the same
20 purpose or for something else.

21 The way I see it, Patent Owner's argument that because Aoki sends it
22 as part of the charging request after the hotspot information is retrieved, then
23 that's the only way it can be used in the combination, that's the essence of
24 the bodily incorporation argument that the federal circuit has rejected time
25 and time again. We don't have to rely on --

1 JUDGE HOWARD: Mr. Hagiz, my question maybe could be more
2 focused, especially given your time. In the second sentence that you have
3 there from Dr. Zagal's testimony, it begins "for instance." Is that statement
4 factually correct, that Aoki requires you to go and send the user ID
5 information in order to obtain advertisements? If that's not true, doesn't that
6 create a logical flaw in Dr. Zagal's testimony?

7 MR. HAGIZ: Sure, it's imprecise. The statement is imprecise because
8 that sentence talks about the ID of the player and the game ID being sent. It
9 is true in Aoki that the game ID is actually sent to obtain advertisements.
10 The ID of the player is used for the ad charging system, and that's why Dr.
11 Zagal explains that in the combined system, in the Ho/Aoki combination,
12 you use it specifically in a different context, which is part of the request for
13 the information. He provides motivation to combine it. I heard both Mr. Lee
14 and Ms. Koballa say that we pivot to pointing to Sturman, but Sturman is in
15 the Petition and it's in Dr. Zagal's declaration. That's the basis, that is the
16 evidence of the motivation to combine. We acknowledge that in Aoki the
17 user identification information is used in a different context for a different
18 purpose. It's still something that is sent from the client to the server. I think
19 one of the items that came up earlier when Patent Owner was arguing, if the
20 question is a temporal limitation, I don't see a specific temporal limitation in
21 the claims and it wasn't an argument that was raised before.

22 I think, Judge Galligan, I think you pointed this out in Paragraph 77,
23 which we rely on, there's a reference to a figure where the sending of the
24 user identification information is Step S102, I think, which happens before
25 the receipt of the hotspot information. Now it is true that in Aoki the user
26 identification information isn't being used to select the hotspot information,

1 but as we talked about, claims don't require you to do that. They just require
2 you to send the user identification information, and the hotspot information
3 is later sent. If we're purely looking at a temporal perspective, Aoki still
4 teaches that you send the user information, at least in the figure that's
5 discussed in Paragraph 77, you send the user identification information first.
6 In the proposed combination, you rely on Sturman as motivation to also
7 include that as part of the request so that you can facilitate targeted
8 advertising. But either way, I think it still supports the combination proposed
9 by Petitioner.

10 I think the single imprecise statement in Dr. Zagal's Paragraph 117
11 that may have suggested that the ID is used to obtain advertisements doesn't
12 change the fact that the argument at its essence that we've been offering
13 since the Petition is that in the combined system you would be motivated to
14 use the data in that way based on teachings such as Sturman, which provides
15 the motivation to combine.

16 JUDGE HOWARD: Thank you.

17 MR. HAGIZ: The only other point I'd add, I heard Ms. Koballa say
18 that Aoki does not talk about targeted advertising at all, not an argument that
19 I've heard before, but if it's helpful I can direct Your Honors to Paragraph
20 26 in Aoki, which specifically talks about storing information on a player
21 targeted by the advertisement. That's also within the context of Aoki further
22 supporting the motivation to combine. I do want to touch on Claim 12 and
23 the Jiau combination. I think, Judge Howard, you mentioned this. Looking at
24 Figure 11(f), we can clearly see that there are objects there, and that is the
25 basis for Dr. Zagal's testimony. You can look at the figure and Jiau doesn't
26 need to tell you there are objects in Figure 11. You can see that there is a

1 room and there are objects that are in the room. The point is, which I didn't
2 hear Mr. Lee at the end of the day disagree with, that Aoki generally teaches
3 that objects can have hotspots. Just some additional -- I don't think I
4 included an exhaustive list of citations when I spoke earlier, but some
5 additional support in this, if you look at Column 12, Lines 1-10 gives two
6 generic examples of hotspots with objects, no limitation to how they would
7 be applied, both can clearly apply to the furniture in 11(f). One is just
8 generally an object with an associated action, something that when you
9 activate it, it does something.

10 There is a second teleportation object, something that when you
11 interact with it, it moves you to a different location. Column 16, Line 29 to
12 Column 17, Line 6 generally talk about objects being able to have
13 predetermined hotspots that cause actions to occur when the user touches or
14 selects the object. When we looked at Figure 17 on Slide 46, we could see
15 that the lot file that defines what the objects are, there is a very simple and
16 straightforward way for identifying an object, a hotspot in an object. All you
17 need is to include this link event field that creates the link which operates as
18 a hotspot. All of these disclosures in Jiau generally stand for the proposition
19 that objects in general can be defined to have a hotspot. Absolutely no
20 reason why the objects in Figure 11(f) also can be hotspots, and that's the
21 logical conclusion of Jiau's teaching. You don't need Jiau to specifically tell
22 you hey, the objects in this particular example have a hotspot or can have a
23 hotspot. A POSITA would understand that from Jiau's broader teachings
24 that objects generally in that system can have hotspots associated with them.

25 JUDGE MCKONE: You will agree, though, that Jiau does not
26 describe the tables in Figure 11(f) as objects, correct?

1 MR. HAGIZ: Correct. Jiau doesn't specifically call them -- it doesn't
2 say one way or the other. So Jiau doesn't really describe the scene in 11(f)
3 beyond the fact that it's the interior, but I think again, the POSITA is not
4 going to limit his understanding to just the expressed words in Jiau. There
5 are understandings that you can take from the figures, which is why they're
6 there, and there are understandings consistent with KSR. The POSITA is not
7 an automaton, so there are things that they can understand from context and
8 from the other disclosures. I think between what is actually shown in the
9 figure that clearly shows objects that are more than just the background and
10 the broader teachings about objects and hotspots within Jiau, that is
11 sufficient disclosure of a hotspot within that interior space in Figure 11(f). I
12 guess the other minor point I want to hit, I think Ms. Koballa mentioned this
13 in the context of Claim 7 and a versioning system. I heard her say there's no
14 motivation to add a versioning system or to include a versioning system in
15 Ho because it would be difficult to implement.

16 I'll just say that the claims of the '662 patent don't require any
17 specific versioning system. All they require is that there is a version
18 identifier. I went through this earlier, Dr. Zagal explained both the fact that
19 you would need some kind of identifier in order to track different versions,
20 especially since Ho specifically talks about updating the interactive
21 information elements, and specifically contemplates software that is still in a
22 stage of development that will be updated over time. Dr. Zagal points
23 specifically to Hannay as just demonstrating that it is well known to use
24 version identifiers to track different versions of software. Again, multiple
25 times I heard Mr. Lee and Ms. Koballa talk about both Sturman and Hannay
26 as being something that was pivoted to or raised for the first time in reply.

1 Both of those are in Dr. Zagal's declaration. Both of those are in the Petition.
2 Those were part of the argument that we raised from the beginning.

3 They're not part of the grounds and they don't need to be, because
4 they're relied on, in the case of Sturman, as supplying the motivation to
5 combine, which does not need to be part of the ground. It can be external
6 evidence. In the case of Hannay, as corroborating evidence of what is well
7 known, specifically the use of a version identifier to track different versions.
8 The concept of having different versions of the software, that is plainly and
9 expressly in Ho by virtue of its discussion of software that is still in
10 development and of renewing or updating the interactive information
11 elements over time. I think I have a couple of minutes left. Is there anything
12 else that would be helpful for me to address before my time is up, Your
13 Honors?

14 JUDGE HOWARD: I have nothing specific that I need to hear more
15 on. Judges McKone and Galligan, do you have anything?

16 MR. HAGIZ: Okay, I didn't have anything else in my notes that I
17 wanted to address, so I guess I will return the balance of my, I think, two
18 minutes.

19 JUDGE HOWARD: Okay, thank you very much. Patent Owner, I'm
20 not sure who wants to start, but you have 11 minutes and 44 seconds from
21 whenever you begin talking.

22 MR. LEE: Thank you, Your Honor. I want to first address Your
23 Honor's question, as well as, Judge Galligan, your question regarding
24 Paragraph 77 of the Aoki reference, if you give me a moment to navigate
25 there. I think the view that Petitioner takes of this paragraph is way too high-
26 level. If we look at the details, we see that it is describing the advertisement

1 charge process in Figure 12, which is what we discussed in Paragraphs 88
2 and 89. But proceeding from the beginning, Paragraph 77 explains a process
3 that happens upon activation of a game terminal. The first thing that a game
4 terminal is going to do on activation is read its database to see if there's a
5 record of an advertisement period no longer including the present date, i.e.,
6 whether there is an old existing advertisement database record. If there is,
7 then it describes that when such a record is found, that we've got to get paid
8 on this.

9 We've got to send this to the server, so we're going to send it to the
10 server along with this other information, including the player ID. At that
11 time, that's when the server's going to do the advertisement charge process
12 that we walk through. It says I want to get paid, I want to make sure I've
13 submitted all this in-game data from the last time I was on. That's when I'm
14 submitting the player ID. It's still end of that prior game and I'm submitting
15 the player ID to be used at that post-game advertisement charge period.
16 Thereafter, at the game terminal, all of that's going to be deleted. That player
17 ID, deleted. All of that's gone. Now I'm starting a new game, and what am I
18 going to do to start a new game? Then the game terminal downloads new
19 advertisement data. From the rest of this paragraph, there is no disclosure
20 about Aoki, that game terminal, submitting any player ID to obtain that new
21 advertisement data.

22 Again, no player ID is ever going to be submitted by that game
23 terminal until the game ends, as a part of that post-game advertisement
24 display period. So even though this paragraph put together makes it seem
25 like a player ID is first submitted and then some advertisement data is
26 delivered, these are very different processes. Of course, the Claim 13(a)

1 requires that when the device contacts the server for the hotspot information,
2 in that same limitation the device has to provide the server with the user
3 identification information. That's not what's being done in Aoki. That's not
4 what's being described in Paragraph 77 of Aoki. This is where we have the
5 major hole. There is no submission of user identification information in Jiau
6 when requesting its virtual lots. Petitioner never contends that Ho discloses
7 any submission of user identification information whenever any check is
8 done.

9 They only rely on Aoki for this. Judge Howard, as you pointed out, if
10 I can navigate to it, Dr. Zagal's testimony, Paragraph 171, reproduced on
11 Patent's Owner's slides at 31, is premised on his belief and Petitioner's belief
12 that Aoki discloses a game terminal that provides a player ID "in order to
13 obtain advertisements. That's just incorrect. That's not what Aoki does.
14 There's no disclosure in Aoki that teaches that. Petitioner has a massive,
15 massive hole in its grounds as to Claim 13, all grounds, both Ho and Jiau.
16 That's why it's clear to us Petitioner is now trying to pivot to Sturman to fill
17 this. Petitioner says that it doesn't matter that Sturman wasn't included in the
18 grounds. I cannot wrap my head around that. There's no disclosure in Ho,
19 Jiau or Aoki that teaches providing user identification information at the
20 time you're contacting a server for hotspot information.

21 Petitioner newly tried to bring in Sturman or even Ellis and Chu, other
22 references to do this, and that's just improper. It's not in any of the grounds
23 and they haven't set forth any motivation to combine those particular non-
24 ground references, let alone show why a POSITA would've been successful
25 in modifying these systems. They definitely would not have been successful,
26 because that goes against everything Aoki describes. Aoki's whole invention

1 is doing this at the end to determine if an advertisement that was displayed
2 was displayed to an appropriate player ID such that it needs to be monetized.
3 Targeting advertisements in Sturman or Chu or Ellis may suggest -- again,
4 it's very unclear, that's not in any of the grounds and it's opposite to what
5 Aoki, part of the grounds, actually discloses. So we think Petitioner's --

6 JUDGE GALLIGAN: Counsel.

7 MR. LEE: Go ahead, Your Honor.

8 JUDGE GALLIGAN: Counsel, this is Judge Galligan. Didn't want to
9 interrupt you, but that's a helpful explanation. The problem is that it
10 technically is true that in order to get advertising in this process, you would
11 have to upload your user ID because even if you're closing out the previous
12 session, a claim that's met some of the time is met all the time or is enough
13 for infringement, presumably the same for obviousness. So, I see your point,
14 but it seems to be that, for instance, this Figure 8 disclosure will not happen
15 if the game, for instance, if the game terminal realizes oh, I never sent the
16 last step. It has to send it in order to get a new advertisement. Maybe by
17 dumb luck it actually teaches it. I understand that maybe the '662 patent has
18 a different purpose in mind, but it actually does teach that, the literal
19 disclosure of it.

20 MR. LEE: I appreciate your point, Your Honor. I think dumb luck
21 would be the correct way to characterize that disclosure, but again, I still
22 don't think that meets the bill with respect to Claim 13(a). That requires in
23 the single limitation contacting a server for hotspot information to download,
24 comprising providing the server with user identification information. In
25 Aoki when the game terminal is activated and they say oh no, I may still
26 have a record here from a prior game, and when they send that information

1 and they send that player ID at that time, the game terminal is not requesting
2 any hotspot information to download or any advertisement information to
3 download. It's sending it at that time for a completely different purpose.
4 Thereafter, when the game terminal decides to contact anew the ad server to
5 request advertisements to download, it never provides a player ID. So, I
6 think when we look at the claim language, the claim requires that these
7 things have to happen together, that you have to contact a server for hotspot
8 information and therewith provide the server with user identification
9 information.

10 That combined step is not being disclosed in Aoki, respectfully, in the
11 way that we read Aoki. I think maybe to Your Honor's point about dumb
12 luck, we certainly haven't seen any explanation from Dr. Zagal tying this all
13 together to conclude otherwise. His single sentence understanding of Aoki
14 has been proven to be demonstrably false, inaccurate might be a better way
15 to describe it.

16 JUDGE GALLIGAN: Counsel, this is Judge Galligan again. So, in
17 Claim 13, for example, we're talking about that, the claim recites that you
18 have to provide the server with user identification information. The claim
19 nowhere then requires that to be used in any particular way, right?

20 MR. LEE: I will agree with you, the claim does not expressly require
21 that user identification to be used in any particular way, but we believe,
22 Patent Owner believes it's very clear that the claim, claim limitation 1[a]
23 requires that that user identification information must be provided when
24 contacting the server for hotspot information to download.

25 JUDGE GALLIGAN: Okay, thank you very much.

26 MR. LEE: Recognizing --

1 JUDGE HOWARD: You have a minute and a half left.

2 MR. LEE: Recognizing I'm probably running short on time, the last
3 thing that I'll visit very quickly just because I know there's been a lot of
4 questions about it, and I just want to make sure our position is very clear on
5 this, returning to Claim 20 and Claim 12, the second hotspot limitation of
6 the dependent claims, I think the dispute boils down to 11(e) and 11(f) of
7 Jiau. Again, our position -- a lot of assumptions and inferences being drawn
8 about potential objects, let alone potential hotspots in 11(f). I think it's very
9 important, we talked about how Jiau distinguishes various aspects of
10 inventions. There's lots, there's objects, there's hotspots and there's views.
11 Jiau specifically describes that 11(f) is a view. It's an interior view of another
12 object. It's the interior view of an object. Jiau never describes that 11(f) is an
13 object or as a hotspot. It's an interior view, so we have to give meaning to
14 this hierarchy of game items or virtual world items that Jiau discloses.

15 Again, Patent Owner would suggest there's just a complete lack of
16 evidence, and certainly Petitioner has not carried their burden to demonstrate
17 that 11(f) of Jiau discloses not only an object, but a hotspot associated with
18 that non-existent object.

19 JUDGE HOWARD: Thank you, Mr. Lee. With that, your time is up.
20 I'd like to thank both the parties for their presentation. This hearing is
21 adjourned, and we will take the matter under advisement and issue an order
22 in due course. With that, we are done.

23 (Whereupon, the above-entitled matter went off the record at 3:03
24 p.m.)

PETITIONER:

James Glass
Nima Hefazi
QUINN EMANUEL URQUHART & SULLIVAN LLP
jimglass@quinnemanuel.com
nimahefazi@quinnemanuel.com

PATENT OWNER:

Michael Morlock
Joshua Lee
Andrew Rinehart
Kasey Koballa
KILPATRICK TOWNSEND & STOCKTON LLP
mmorlock@kilpatricktownsend.com
jlee@kilpatricktownsend.com
arinehart@kilpatricktownsend.com
kkoballa@kilpatricktownsend.com