

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

Inter Partes Review No.

IPR2024-00209

Patent No. 9,427,662

PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW

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I. Introduction

Patent Owner Flip Phone Games, Inc. (“FPG”) seeks director review of the portion of the Final Written Decision (Paper 28) (the “Decision”) finding claims 13–19 of U.S. Patent No. 9, 427,662 (“the ’662 Patent”) unpatentable.¹

The Board concluded claims 13–19 would have been obvious over WO 2008/008038 A1 (“Ho”) in view of US 2002/0120589 (“Aoki”). But the Board conceded Ho fails to disclose “contacting a server for hot spot information to download, comprising providing the server with user-identification information,” as required by the claims. And the Board’s conclusion that this limitation was obvious in view of Aoki was based on an erroneous finding that Aoki teaches providing a server with “user information” when contacting the server for game advertisements.

In fact, the game terminal in Aoki provides only a “game ID”—and not any “user information”—to Aoki’s server when contacting the server for game advertisements to download. The only time Aoki’s game terminal ever submits any “user information” to Aoki’s server is “at the time of ending the game”—for use in Aoki’s “advertisement charge process.” The Board’s conclusion otherwise was based on an erroneous reading of both Aoki and the language of claims 13–19. And

¹ FPG does not seek director review of the portion of the Decision finding claims 1–11 of the ’662 Patent unpatentable. FPG also does not seek director review of the portion of the Decision confirming the patentability of claims 12 and 20 of the ’662 Patent. *See, e.g.*, Paper 28 at 47.

the Board compounded its errors by relying on conclusory testimony of Petitioner's expert, Dr. Zagal, which does little more than parrot the Petition and also contradicts the express teachings of Aoki.

For the reasons set forth herein, the Director should correct these errors and confirm the patentability of claims 13–19 of the '662 Patent.

II. Background

A. Claims 13–19 of the '662 Patent

Independent claim 13 of the '662 Patent recites “[a] method for retrieving and displaying a hot spot associated with a video game operable on a mobile communication device, comprising,” among other things, “*contacting a server for hot spot information to download, comprising providing the server with user-identification information,*” wherein the “hot spot information” comprises “hidden promotional content for presenting to the user when the hot spot is activated” and “coordinate information.” '662 Patent, 15:27–16:13 (emphasis added).²

Each of claims 14–19 of the '662 Patent (as well as claim 20) depends from independent claim 13 (whether directly or indirectly). *See* '662 Patent, 16:14–29.

² In contrast, independent claim 1 of the '662 Patent recites a method comprising, *inter alia*, “contacting a server for hot spot information to download, comprising providing the server with at least one of” more than ten different items of information—including, for example, “a version identifier for hot spot information currently on the mobile communication device.” '662 Patent, 14:39–52.

B. The Board's Decision

In its Decision, the Board concluded that Petitioner showed by a preponderance of the evidence that the subject matter of claims 13–19 of the '662 Patent would have been obvious over Ho in view of Aoki. Decision at 36.

In particular, the Board concluded that Ho disclosed the use of “interactive information elements” in a video game, which “can display hidden information, such as an advertisement, when activated by a user.” Decision at 17. The Board equated Ho’s “interactive information elements” with the “hot spots” described in the '662 Patent. Decision at 17. And the Board concluded that Ho taught connecting to a server to download “new interactive information element(s)” from the server to a mobile telephone. Decision at 17–18.

The Board, however, conceded that Ho did not disclose, teach, or otherwise suggest providing the server with “user-identification information” when contacting the server for hot spot information to download, as required by claims 13–19 of the '662 Patent. *See* Decision at 20. Rather, the Board concluded that the information sent to Ho’s server in connection with a request to download new interactive information element(s) would include “user-identification information” only “when combined with Aoki.” Decision at 20.

To that end, the Board concluded that “Aoki teaches sending user-identification information as part of [a] request for additional advertisements” as part

of Aoki’s “system for determining how to charge for advertisements based on various factors.” Decision at 25. And the Board concluded that “[a] person having ordinary skill in the art would have combined Aoki’s teaching of using user-identification information as part of the request for an advertisement with Ho’s system, which also teaches a client device sending information to a server to request hot spot information, such as advertisements.” Decision at 26. The Board specifically concluded that a person having ordinary skill in the art would have appreciated that such modification of Ho, in view of Aoki, “allows for targeted advertisements, which was a known advantage in advertising.” Decision at 27.

III. Legal Standard for Director Review

“Requests for Director Review of a Board’s final decision under 35 U.S.C. §§ 135, 318, or 328, ... shall be limited to decisions presenting (a) an abuse of discretion, (b) important issues of law or policy, (c) erroneous findings of material fact, or (d) erroneous conclusions of law.” Director Review Process, § 2(B).³ Further, “Decisions of the Board under Director Review are reviewed *de novo*.” *Id.* at § 5(A)(ii)(c).

³ <https://www.uspto.gov/patents/ptab/decisions/director-review-process>

IV. Argument

A. The Board Erred in Finding Aoki Teaches Providing “User-Identification Information” In Connection with Contacting a Server for Advertisements to Download.

The Board’s conclusion that “Aoki teaches sending user-identification information as part of [a] request for additional advertisements” to a server (Decision at 25) is based on an erroneous reading of Aoki (Ex. 1005). Aoki does not disclose, teach, or suggest providing a server “user-identification information” as a part of a request for advertisements from Aoki’s server. Rather, as detailed below, Aoki’s teachings with respect to submission of any “user information” are with respect to an “advertisement charge process” that occurs only at the *end of a game—i.e., after* an advertisement has been both downloaded and displayed on a game terminal. Ex. 1005, [0077], [0088], [0089], Fig. 12; *see* Ex. 2006, ¶76. Aoki does not disclose, teach, or suggest proactively targeting advertisements based on “user information.”

Aoki is generally directed to a “game advertisement charge system.” *E.g.*, Ex. 1005, [0002]. Indeed, while other publications “disclose ... distribution or displaying techniques for game advertisements,” Aoki’s teachings are focused on “methods for setting advertisement charges.” Ex. 1005, [0005]. In fact, with respect to distribution of advertisements, Aoki simply discloses that a game terminal receives “new advertisement data” from Aoki’s “advertisement management server” in response to the game terminal sending the server a “game ID identifying a game

to be performed at that game terminal.” Ex. 1005, [0077]. Aoki then teaches that—after display of an advertisement in a game (*i.e.*, at the end of the game)—various information related to the game terminal and displayed advertisement(s) is uploaded to the “advertisement management server” for “use[] in an advertisement charge process applied in the advertisement management server.” Ex. 1005, [0077].

That “advertisement charge process” is illustrated in Figure 12 of Aoki. Ex. 1005, [0088], Fig. 12; *see id.*, [0077]. “[I]n the advertisement charge process, the advertisement management server 50 receives from a game terminal an advertisement ID, an advertisement point, and user information (S501), all of these being uploaded to the advertisement management server 50 from a game terminal ***at the time of ending the game.***” Ex. 1005, [0088] (emphasis added); *see* Ex. 1005, [0077]. “[T]he advertisement management server 50 calculates a charge point based on the information received (S502).” Ex. 1005, [0089]. At a part of that calculation, the advertisement management server determines whether the “user information” received by the server (*e.g.*, “age, sex, profession”) falls within the “user range” for which the advertisement was intended (“advertisement target data”). Ex. 1005, [0089]. If it does, the advertisement management server sets a higher “charge point” for the advertisement as compared to if it does not. Ex. 1005, [0089].

Thus, Aoki does not disclose, teach, or suggest providing a server with any “user-identification information” when contacting the server for advertisements to

download. Indeed, the only information Aoki teaches providing its “advertisement management server” to obtain “new advertisement data” is a “game ID identifying a game to be performed at that game terminal.” Ex. 1005, [0077]. And any “user information” provided to Aoki’s “advertisement management server” from the game terminal is provided only “at the time of ending the game” for use in Aoki’s post-game “advertisement charge process.” Ex. 1005, [0088].

The Board’s finding otherwise—that “Aoki teaches sending user-identification information as part of [a] request for additional advertisements” to a server—was based on an erroneous interpretation of Figure 8 of Aoki. Decision at 25–26. As discussed above, in the process illustrated in Figure 8, “the game terminal downloads new advertisement data ... from the advertisement management server 50” by “send[ing] to the advertisement management server 50 a game ID identifying a game to be performed at that game terminal” (Ex. 1005, [0077])—not any “user-identification information,” as required by claim 13–19 of the ’662 Patent.

The Board’s erroneous finding otherwise was based on a different disclosure in Aoki with respect to Aoki’s post-game “advertisement charge process.” Ex. 1005, [0077]. In particular, in Figure 8, Aoki describes that, “at the time of activating a game terminal”—and prior to a game terminal requesting any “new advertisement data”—the game terminal must first “check” whether all information with respect to the last instance of the game prior to this activation has been “uploaded” to Aoki’s

“advertisement management server” for the “advertisement charge process” (described in “FIG. 12”) with respect to that “past advertisement period.” Ex. 1005, [0077]. If such information has not been uploaded to Aoki’s “advertisement management server,” the game terminal does so. Ex. 1005, [0077]. Any “record relating to” that “past advertisement period” is then “deleted” from the game terminal. Ex. 1005, [0077]. And the game terminal then may send to Aoki’s “advertisement management server” a new “game ID identifying a game to be performed at that game terminal, and in turn receives corresponding new, that is, undownloaded, advertisement data,” as noted above. Ex. 1005, [0077].

Thus, any “user information” provided to Aoki’s “advertisement management server” at “the time of activating a game terminal” is in connection with Aoki’s “advertisement charge process applied in the advertisement management server 50 (FIG. 12).” Ex. 1005, [0077]. That “user information” is then “deleted” from the game terminal. Ex. 1005, [0077]. And when the game terminal thereafter newly contacts Aoki’s advertisement management server to download “new advertisement data,” the game terminal provides only a “game ID identifying a game to be performed at that game terminal, and in turn receives corresponding new, that is, undownloaded, advertisement data.” Ex. 1005, [0077]. For all these reasons, the Board’s conclusion that “Aoki teaches sending user-identification information” as “part of [a] request” for advertisements in Aoki (Decision at 25) is erroneous.

The Board’s finding that claim 13 “does not have any limitation requiring that hot spot information (the advertisement) be based on the information sent from the client to the server as part of the request” (Decision at 27) does not excuse the Board’s error. Claim 13 expressly requires “contacting a server for hot spot information to download, comprising providing the server with user-identification information. ’662 Patent, 15:27–16:13. As discussed, when the game terminal in Aoki contacts Aoki’s server for advertisements to download, it provides the server only with a “game ID identifying a game to be performed at that game terminal” (“and in turn receives corresponding new, that is, undownloaded, advertisement data”). Ex. 1005, [0077]. And when the game terminal provides Aoki’s server with “user information,” it is doing so at a different time and only in connection with Aoki’s “advertisement charge process.” Ex. 1005, [0077], [0088], [0089], Fig. 12.

B. The Board Erred in Finding It Obvious to Modify Ho to Provide “Targeted Advertisements” in View of Aoki.

For all the reasons discussed above, Aoki does not disclose, teach, or suggest providing any advertisements in a game based on any user information. And relatedly, the Board’s conclusion that “[a] person having ordinary skill in the art would have taken Aoki’s teaching of sending user-identification information and combined it with the information Ho’s client sends to the remote server for information on the interactive information elements (hot spots) to provide targeted advertisements” (Decision at 30) is erroneous.

Aoki’s “advertisement charge process” is fundamentally premised on the fact that the advertisements displayed in Aoki’s game terminals are *not* targeted advertisements. Indeed, Aoki’s “advertisement charge process”—occurring only post-game—determines whether information associated with a user that viewed an advertisement on the game terminal (*e.g.*, “age, sex”) falls within the “user range” for which the advertisement was intended (“advertisement target data”), as discussed above. Ex. 1005, [0089]. And Aoki expressly recognizes that there are instances where the “user information” “does not” fall within the “user range” for which the advertisement was intended (Ex. 1005, [0089])—necessarily demonstrating that the advertisements in Aoki are not “targeted.” Indeed, the advertisements downloaded to a game terminal from Aoki’s server are based exclusively on the “game ID” of the game to be played on the game terminal—not any “user information” (*e.g.*, “age, sex”). Ex. 1005, [0077]. As such, nothing in Aoki would have motivated a skilled artisan to modify Ho to provide “targeted advertisements.”

Moreover, the only evidence Petitioner presented in support of this “targeted advertisement” theory is the conclusory testimony of its expert, Dr. Zagal—which merely parrots the Petition, contradicts Aoki’s express disclosures, and should thus be afforded no weight. Ex. 1003, ¶117; *see* Petition at 24; *see also Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9, at 15 (PTAB Aug. 24, 2022) (precedential). In particular, Dr. Zagal states: “Aoki discloses that a game terminal

... provides an advertisement management server ‘the ID of the player who uses the game terminal’ and a ‘game ID identifying a game’ in order to obtain advertisements” and, “in the combined Ho-Aoki system, ... [a] POSITA would have be[en] motivated to provide the server a user ID and a game ID so that advertisements can be targeted based on this information.” Ex. 1003, ¶117.

Fundamentally, Dr. Zagal’s opinion—repeated near verbatim from the Petition—that Aoki’s game terminal must provide Aoki’s advertisement management server “the ID of the player who uses the game terminal” “*in order to obtain advertisements*” is incorrect. Ex. 1003, ¶117 (emphasis added); *see* Petition at 24. As discussed, according to Aoki, the only information required to be submitted to Aoki’s server by a game terminal “in order to obtain advertisements” is the “game ID” for the game to be played on the game terminal. Ex. 1005, [0077]. And “user information” is only submitted to Aoki’s server in connection with Aoki’s post-game “advertisement charge process,” as discussed. Ex. 1005, [0077], [0088], [0089].

As such, Dr. Zagal’s opinion that a POSITA would have been motivated to provide Ho’s server with “a user ID” in view of Aoki so that “advertisements can be targeted based on this information” (Ex. 1003, ¶117) necessarily fails given the faulty premise on which it is based. Moreover, Dr. Zagal’s opinion is conclusory, and only a single sentence. Ex. 1003, ¶117. And the only evidence cited in support of Dr. Zagal’s (faulty) conclusion is a different prior art reference, Sturman (Ex.

1008)—which the Petitioner does not rely on for this limitation, an undisputed point made clear by the Board. Ex. 1003, ¶117; *see* Decision at 31.

Thus, at bottom, the Board’s conclusion that it would have been obvious to modify Ho in view of Aoki to provide “user-identification information” to Ho’s server when contacting the server to download “hot spot information” is based entirely on two references that each fails to disclose provision of any such “user-identification information” and a single-sentence, conclusory opinion from Dr. Zagal regarding purported utility of “targeted” advertisements—which attempts to fill the material void in Ho and Aoki by, at most, pointing to another reference not relied on by Petitioner. This is insufficient and the Board thereby erred in finding this purported evidence sufficient for Petitioner to carry its burden.

The Federal Circuit has consistently “rejected obviousness determinations based on conclusory expert testimony”—like Petitioner’s challenge here—noting that “crediting such testimony risks allowing the challenger to use the challenged patent as a roadmap to reconstruct the claimed invention using disparate elements from the prior art—i.e., the impermissible *ex post* reasoning and hindsight bias that *KSR* warned against.” *TQ Delta, LLC v. Cisco Sys., Inc.*, 942 F.3d 1352, 1361 (Fed. Cir. 2019). A petitioner must, instead, supply the factual basis for the challenge and “may not resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis.” *In re Warner*, 379 F.2d 1011, 1017

(C.C.P.A. 1967). Petitioner failed to do so here. And Petitioner’s and Dr. Zagal’s general, conclusory speculation regarding “targeted” advertisements “cannot” be accepted “as a replacement for documentary evidence for core factual findings in a determination of patentability.” *K/S Himpp v. Hear-Wear Techs., LLC*, 751 F.3d 1362, 1366 (Fed. Cir. 2014).

V. Conclusion

For all these reasons, FPG respectfully requests that the Director reverse the Decision, in part, and confirm the patentability of claims 13–19 of the ’662 Patent.

Dated: May 23, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW** has been served via email on the following:

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