

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PLR WORLDWIDE SALES LIMITED,

Petitioner,

v.

FLIP PHONE GAMES INC.,

Patent Owner.

Case No. IPR2024-00209

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

**PETITIONER'S RESPONSE TO PATENT OWNER'S REQUEST FOR
DIRECTOR REVIEW**

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	HO IN VIEW OF AOKI RENDERS OBVIOUS PROVIDING A SERVER WITH USER-IDENTIFICATION INFORMATION	2
III.	DR. ZAGAL’S TESTIMONY WAS GIVEN DUE WEIGHT	4
IV.	PO’S ARGUMENT ALSO FAILS BECAUSE IT IGNORES THE ALTERNATIVE GROUND BASED ON JIAU	5
V.	CONCLUSION	5

EXHIBIT LIST

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

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

I. INTRODUCTION

Ground 1 of the Petition showed that Claims 13-19 were unpatentable based on the combination of Ho (Ex. 1004) and Aoki (Ex. 1005). Paper 2 (Petition) at 11-36. In its Request for Director Review, Patent Owner (“PO”) disputes the Board’s finding as to a single limitation of Claim 13¹ that broadly recites “contacting a server for hot spot information to download, comprising providing the server with user-identification information.” Outside of this limitation, Claim 13 does not refer to user-identification information or recite how it is used. Paper 28 (FWD) at 27. Nevertheless, PO contends that the Board erred and merely rehashes the same arguments the Board considered and rejected. Paper 29 (PO’s Request for Director Review, “Request”) at 5. The Board’s decision on Claims 13-19 was well supported by both the references and law; it did not err.

Moreover, the Petition provided an alternative Ground 2 in which it showed Claims 13-19 were obvious that PO failed to address. In Ground 2 Petitioner showed that Jiau (EX1006) discloses providing the server with user-identification information (a “user id”), Pet. at 43 (citing Ex. 1006, 17:27-32). Thus, PO’s request that the Director “confirm the patentability of claims 13-19” should be denied for this additional reason as well.

¹ Claims 14-19 depend from Claim 13. PO does not present any independent argument for these claims; relying solely on its argument for Claim 13.

II. HO IN VIEW OF AOKI RENDERS OBVIOUS PROVIDING A SERVER WITH USER-IDENTIFICATION INFORMATION

PO includes a smattering of arguments in its Request, but they are all based on the same faulty premise: that Aoki does not render obvious “providing the server with user-identification information” because it purportedly discloses sending user-identification information to the server “only at the end of the game” for use in an “advertisement charge process.” Request at 1, 5. Not so.

First, the Board correctly found that PO's argument is factually inaccurate. The Board walked through Figure 8 of Aoki which discloses a “flowchart explaining an advertising process executed at the time of activating a game terminal.” *Id.* at 25 (citing Ex. 1005 ¶77, Fig. 8). The Board explained that “step S102” discloses that *upon activation of the game terminal*, if “an advertisement record is found” the terminal provides the server an “advertisement point” that includes “user information, such as the ID of the player who uses the game terminal”:

When any such [advertisement] record is found, on the other hand, the “advertisement point” included in that record is uploaded to the advertisement management server 50 (S102) along with the “advertisement ID”, also included in the record, and user information, **such as the ID of the player who uses the game terminal.**

Id. (citing Ex. 1005, ¶77). After receiving the user information, the server returns a new advertisement at Step S104. *Id.* Thus, Aoki teaches that user-identification information may be sent as part of a request for new advertisements when the game is activated—not just at game end. FWD at 25-26. The Board's finding is not error.

Faced with this clear disclosure in Aoki, PO argues that the Board's reliance on Figure 8 is misplaced because Aoki does not disclose that the user-identification information is used to download new advertisement data because it is used for post-display analysis. Request at 7-8. The Board correctly rejected this argument too:

Because claim 1 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, it is inapposite that Aoki uses the user identification information for post-display analysis. All that matters is that in some circumstances, the client sends user-identification information to the server as part of contacting the server for additional advertisements.

FWD at 27-28. While PO repeats the argument in its Request, it fails to dispute the Board's underlying finding: that Claim 13 includes no requirement that the user-identification information be used for returning an advertisement of hot spot. In fact, Claim 13 says nothing about how the information is used and PO does not point to any claim language that contradicts the Board's interpretation. PO simply attempts to inject a new requirement into the claims. This does not warrant Director Review.

The Board also recognized that PO's argument—even if credited—is legally irrelevant because it is based on bodily incorporation. The Federal Circuit has made clear that the test for obviousness is not whether a POSITA would bodily incorporate Aoki's advertisement charging system that provides user-identification information into Ho with any modifications. FWD at 29 (citing cases); *see also In re Etter*, 756 F.2d 852, 859 (Fed. Cir. 1985) (*en banc*) (explaining that whether one reference can

be incorporated in another is “basically irrelevant”). Indeed, the Supreme Court has explained that a POSITA is “a person of ordinary creativity, not an automaton.” *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007). Thus, the Board correctly refused to engage in legal error and instead focused on Petitioner's actual theory:

PO's argument is based on attempting to bodily incorporate the two references. That is improper... Instead, **we focus on Petitioner's theory on how a person having ordinary skill in the art would have combined the teaching of Aoki with Ho's method.** In that regard, Petitioner's argument is not, as PO focuses on, adding Aoki's charging system to Ho. Instead, **Petitioner and Dr. Zagal argue 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 clientsends to the remote server for information on the interactive information elements (hot spots) to provide targetedadvertisements.** See Ex. 1003 ¶ 117; Pet. 24. And, as discussed above, based on the evidence in the record, including the testimony of Dr. Zagal, **that argument is persuasive.**

FWD at 30. While PO may disagree with the Board's conclusion that Petitioner's theory is “persuasive,” simply disagreeing is not enough.

III. DR. ZAGAL'S TESTIMONY WAS GIVEN DUE WEIGHT

PO also argues that the Board erred by relying upon the testimony of Petitioner's expert, Dr. Zagal. Request at 10-13. PO claims that Dr. Zagal “merely parrots the Petition” and that his testimony should “thus be afforded no weight.” *Id.* at 10-11. But the Board has rejected this *exact* argument *twice*. FWD at 23-25, Paper 9 (Insitution Decision) at 17-20. As the Board found, Dr. Zagal's testimony was well-supported by citations to the prior art. *Id.* For instance, Dr. Zagal showed

that Aoki discloses providing a server with “the ID of the player who uses the game terminal” and that “in the combined Ho-Aoki system the client end device would continue to download from the server interactive information elements and hidden content, and would do so after providing the server the ID of the player (‘user-identification information’).” Ex. 1003, ¶52. He also articulated clear motivations to combine, including that the combination would permit the server to provide targeted advertisements using the user-information. *Id.* He also cited corroborating evidence describing “characteristics that may be used for targeting advertisements, including user information.” *Id.* (citing Ex. 1008, ¶¶54-55). There is no error.

IV. PO’S ARGUMENT ALSO FAILS BECAUSE IT IGNORES THE ALTERNATIVE GROUND BASED ON JIAU

Because the Board found Claims 13-19 were obvious based on Ground 1 (Ho-Aoki), it did not “address the parties’ arguments regarding those claims based on [] additional grounds.” FWD at 36-37. For instance, Ground 2 of the Petition also demonstrated that Claims 13-19 were obvious based on Jiau alone, or in further view of Aoki. Pet. at 36-58. With regard to the limitation PO challenges here – “providing the server with user-identification information”—Jiau expressly discloses that the client device provides the server with a “user id.” Pet. at 43 (citing Ex. 1006, 17:27-32). PO does not address Jiau in its Request, another reason its request lacks merit.

V. CONCLUSION

For these reasons, the Director should deny PO’s Request.

Date: June 3, 2025

Respectfully submitted,

By: /s/ James M. Glass
James M. Glass

Counsel for Petitioner

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on June 3, 2025, true and correct copies of the foregoing document and supporting materials were served in its entirety on the PO at the following email addresses:

mmorlock@kilpatricktownsend.com
jlee@kilpatricktownsend.com
arinehart@kilpatricktownsend.com
kkoballa@kilpatricktownsend.com
FPG1367020@kilpatricktownsend.com

Date: June 3, 2025

By: /s/ James M. Glass
James Glass
QUINN EMANUEL URQUHART
& SULLIVAN, LLP
51 Madison Avenue, 22nd Floor
New York, NY 10010
Tel: (212) 849-7000
Fax: (212) 849-7100

Counsel for Petitioner