

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PLR WORLDWIDE SALES LIMITED,
Petitioner

v.

FLIP PHONE GAMES, INC.,
Patent Owner

IPR No. IPR2024-00200

Patent No. 11,117,056

PATENT OWNER'S PRELIMINARY SUR-REPLY

EXHIBIT LIST

Ex.	Description
2001	Playrix's Exchange of Proposed Terms and Claim Elements for Construction, served January 30, 2024
2002	Prosecution History of U.S. Patent No. 9,731,202

Petitioner’s Reply ignores the Petition’s § 325(d) analysis and introduces new arguments on discretionary denial. The parent of the ’056 Patent went through ten years of prosecution, including a decision from the Board, finding the claims patentable over similar art—a highly relevant fact with respect to § 325(d). On the claim construction issue, Petitioner shifts its positions yet again, dropping indefiniteness and raising a new construction of the term “pre-selected” which it now says is “content selected in advance.” But the Petition fails to show that the cited art meets this new construction and instead addresses, at most, only selecting content. The Board should exercise discretion and deny institution.

I. Discretionary Denial is Warranted Under § 325(d)

The Reply’s argument regarding § 325(d) is entirely new and should not be considered. *See* Consolidated Trial Practice Guide (“TPG”) at 73 (“Petitioner may not submit new evidence or argument in reply that it could have presented earlier....”). The Petition included a section addressing § 325(d). *See* Petition at 61. Therein, Petitioner urged against denial because none of the references addressed during prosecution “contain a substantially similar disclosure of a mobile game with dynamically updated hot spots represented in-game as non-promotional background objects, as is disclosed in the combinations described in the Grounds presented herein.” *Id.* Thus, the Petition failed to address the relevant prior art and claim language. The Board should disregard new argument presented in Reply. TPG at 73.

Petitioner newly suggests that FPG’s § 325(d) arguments regarding Hays and Levkovitz apply to only Grounds 1 and 4. This is wrong. There are only two additional references (Choi and Chu), and the Petition uses these references only as alternative grounds for certain claims. Grounds 1 and 4 address all claims, and Grounds 2, 3, 5, and 6 introduce Choi and Chu as alternative grounds for only certain elements. Such use of secondary references does not foreclose discretionary denial. *See Ziegmann v. Stephens*, No. IPR2015-01860, Paper 11 at 9 (P.T.A.B. Feb. 24, 2016) (denying institution where a primary reference “was substantively presented to and considered by the Office,” but was presented in the petition “in view of several secondary references.”). Indeed, in *Juniper Networks, Inc. v. Finjan, Inc.*, the Petitioner argued that denial was not appropriate because “notwithstanding the use of Hanson, the Petition asserts prior art ... that has never been considered by the Office.” No. IPR2019-00060, Paper 7 at 13 (P.T.A.B. Apr. 29, 2019). As the Board explained, “the reliance on Hanson and previously presented arguments [is] a factor that strongly weighs in favor of denial of this Petition”—regardless of the newly added references. *Id.* at 15. The same is true here, where the primary references—Hays and Levkovitz—are used in every ground and are substantially the same as the art previously considered by the Examiner and the Board.

As explained, Hays and Levkovitz describe providing advertising to mobile devices based on location, just like the Willis reference considered during

prosecution. *See* POPR at 18-19. Petitioner acknowledges these similarities but urges—without authority—that they are somehow “irrelevant.” Reply at 2. These similarities weigh in favor of denial. 35 U.S.C. § 325(d). The Reply goes on to argue that § 325(d) denial is improper because it alleges that “Hays and Levkovitz provide advertisements based “on a model type.” *First*, this is not the claim element, which requires “wherein the message is *pre-selected* by the server based on....” *Second*, as explained, the Petition failed to address “pre-selected” content. POPR at 33-42.

Finally, Petitioner attempts to distinguish the Board’s decision in *Juniper*, suggesting that the length of prosecution is only a factor where the same reference was submitted during prosecution. Reply at 3. This is wrong. *Juniper* stated that the § 325(d) factors are “non-exclusive,” and that “additional circumstances, not fitting within any of the listed factors, may be relevant to our exercise of discretion under § 325(d) in the context of examination.” *Juniper Networks, Inc. v. Mobile Telecoms. Techs., LLC*, IPR2017-00642, Paper 31 at 10 (P.T.A.B. Mar. 14, 2018). *Juniper* further explained that “11 years of prosecution history, which included multiple appeals to the Board,” would be one of those factors. *Id.* at n.5. In an informative decision, the Board has also explained that while “length of prosecution and the numbers of Office Actions and Board Decisions do not, by themselves, definitively mandate for or against institution on a particular ground, on these facts, ... they do weigh heavily against institution of the prior art grounds proffered by Petitioner.”

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