

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DURATION MEDIA LLC,
Petitioner,

v.

RICH MEDIA CLUB LLC,
Patent Owner.

IPR2023-00953
Patent 11,443,329 B2

Before KARL D. EASTHOM, MICHAEL J. FITZPATRICK, and
JASON M. REPKO, *Administrative Patent Judges*.

Opinion for the Board filed by *Administrative Patent Judge* FITZPATRICK.

Opinion Including Additional Views filed by *Administrative Patent Judge*
FITZPATRICK.

FITZPATRICK, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

Petitioner, Duration Media LLC, filed a Petition to institute an *inter partes* review of all claims, namely claims 1–10, of U.S. Patent No. 11,443,329 B2 (“the ’329 patent”) pursuant to 35 U.S.C. § 311(a). Paper 1 (“Pet.”). Patent Owner, Rich Media Club LLC, filed a Waiver of Preliminary Response pursuant to 37 C.F.R. § 42.107(b). Paper 6.

Institution of an *inter partes* review requires that “the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). Determining whether a reasonable likelihood has been met has been delegated to the Board. *See* 37 C.F.R. § 42.4(a) (“The Board institutes the trial on behalf of the Director.”).

Upon consideration of the Petition, and for the reasons explained below, we determine that the information presented shows a reasonable likelihood that Petitioner would prevail with respect to at least one claim. Accordingly, we grant the Petition.

A. *Related Matters*

The parties identify the following related matter involving the ’329 patent: *Rich Media Club LLC v. Duration Media LLC*, Case No. 2:22-cv-02086. Pet. 6; Paper 8, 1. In addition, Patent Owner identifies applications related to the ’329 patent. Paper 8, 1–2.

B. *Real Parties In Interest*

Each party identifies itself as the sole real party in interest. Pet. 5; Paper 8, 1.

C. The '329 Patent

The '329 patent is titled “System And Method For Creation, Distribution And Tracking Of Advertising Via Electronic Networks.” Ex. 1001, code (54). The prime exemplary electronic network identified is the Internet. *Id.* at 1:63. The '329 patent explains: “From the advertiser’s perspective, there are two main tasks to accomplish: 1) creation of an effective ad; and 2) effective placement of the ad. From the ad publisher’s perspective there are also two main tasks to accomplish: 1) display of the highest revenue-producing ads; and 2) reducing the amount of work necessary to place, maintain, track and process payments for advertising.” *Id.* at 1:67–2:6.

The '329 patent discloses “creating electronic advertisements using licensed digital content, and distributing such advertisements for display at desired network locations.” *Id.* at 2:45–48. “The digital content is delivered to designated advertising locations on the network and becomes part of an advertising display composed at the time requested by the network user/ad viewer.” *Id.* at 2:55–58. “The [described invention] provides the ability for both publishers and advertisers to optimize the benefits of creating and distributing advertisements electronically, and manage and track every aspect of the advertisement creation and distribution process.” *Id.* at 3:6–10.

The '329 patent states that its underlying application is a

[c]ontinuation of application No. 12/384,403 [“the parent '403 application”], filed on Apr. 4, 2009, now Pat. No. 11,004,090, which is a continuation-in-part [(“CIP”)] of application No. 11/803,779 [“the grandparent '779 application”], filed on May 16, 2007, now Pat. No. 10,380,602, which is a continuation-in-part of application No. 11/643,245, filed on Dec. 21, 2006, now Pat. No. 10,380,597, said application No.

12/384,403 is a continuation-in-part of application No. 12/316,781, filed on Dec. 16, 2008, now abandoned.

Ex. 1001, code (63). Thus, the parent '403 application is a CIP of the grandparent '779 application.

Petitioner argues that certain features of the challenged claims, namely “replacement advertisement” and “predefined period of time,” constitute new matter as of the filing of the parent '403 application that was not present in the grandparent '779 application. As a result, Petitioner argues that the challenged claims' earliest effective filing date is the date on which the parent '403 application was filed. Pet. 14. That date is April 4, 2009.¹ Ex. 1015, code (22).

Petitioner is correct that neither “replacement advertisement” nor “predefined period of time” appears in the grandparent '779 application. At this stage of the proceeding, we are persuaded that the challenged claims are entitled to a filing date no earlier than April 4, 2009.² *See Chiron Corp. v. Genentech, Inc.*, 363 F.3d 1247, 1259 (Fed. Cir. 2004) (“[A] patent cannot claim priority to earlier applications if it includes new matter not present in those earlier disclosures.”).

¹ The Petition repeatedly and erroneously refers to “April 3, 2009.” Pet. 13–14. We presume that is a typographical error.

² During trial, Patent Owner will have the burden of production to argue or produce evidence that the challenged claims are entitled to the benefit of any earlier filing date. *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1380 (Fed. Cir. 2015).

D. The Challenged Claims

Review is sought for all of the claims of the '329 patent, namely claims 1–10. Claims 1 and 6 are independent, with claim 1 being a method claim and claim 6 being a system claim. Claim 1 is illustrative and reproduced below:

1. A method comprising:

(a) determining whether a predefined area of an ad content display page that is used to display an advertisement is in view within a visible area of a browser window of a browser configured to be operated by a remote computing device, wherein the predefined area is a portion of the ad content display page, and wherein the ad content display page includes (i) the predefined area configured to display advertisement content, the predefined area being a portion of the ad content display page, and (ii) page content displayed in other portions of the ad content display page, the page content being separate from the advertisement content; and

(b) in response to a determination that the predefined area that is used to display the advertisement has been in view within the visible area of the browser window for a predefined period of time, causing a communication to be sent to one or more dispatcher servers, wherein the one or more dispatcher servers are configured to:

(i) receive the communication;

(ii) cause a replacement advertisement to be selected for display on the ad content display page; and

(iii) cause the replacement advertisement to be served to the remote computing device;

wherein the browser is further configured to render the replacement advertisement in the predefined area.

Ex. 1001, 68:45–69:4.

C. *The Asserted Grounds of Unpatentability*

Petitioner asserts the following grounds of unpatentability:

Claim(s) Challenged	35 U.S.C. § ³	Reference(s)/Basis
1–10	103(a)	Krassner, Badros, Harkins
1–10	103(a)	Badros, Harkins

II. ANALYSIS

A. *Claim Construction*

The challenged claims should be read in light of the specification, as it would be interpreted by one of ordinary skill in the art. *In re Suitco Surface, Inc.*, 603 F.3d 1255, 1260 (Fed. Cir. 2010). Thus, we generally give claim terms their ordinary and customary meaning. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007) (“The ordinary and customary meaning is the meaning that the term would have to a person of ordinary skill in the art in question.”) (internal quotation marks omitted); *see also* 37 C.F.R. § 42.100(b) (stating that claims are construed in IPRs according to the same standard as used in federal court).

The Petition proposes express constructions for two claim limitations: “render” and “replacement advertisement.” Pet. 10–11.

³ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112–29, which was enacted September 16, 2011, made amendments to 35 U.S.C. §§ 102 and 103. AIA § 3(b)–(c). Those amendments became effective eighteen months later on March 16, 2013. *Id.* at § 3(n). Because the application from which the ’329 patent issued claims priority to an application filed before March 16, 2013, any citations herein to 35 U.S.C. §§ 102 and 103 are to their pre-AIA versions. *Id.* at § 3(n)(1).

“Petitioner proposes the term ‘*render*’ should be construed as expressly defined by the applicant’s lexicography in the ’329 patent claims and specification to mean ‘the process of requesting and loading content so that it may be viewed, heard or otherwise perceived by a viewer communicating electronically using a browser.’” *Id.* (quoting Ex. 1001, 7:15–19). The cited portion of the ’329 patent is accurately quoted but it is not clear on the current record whether the ’329 patent defines “render” as requiring both the requesting and loading of content or merely just the loading of content that has been requested. In multiple other instances, including the claims themselves, “render” is used exclusively in reference to the loading of content and not the requesting of it. *See, e.g.*, Ex. 1001, 7:9–10 (referring to “a pre-defined area of the ad content display page where the content is to be rendered”), 8:19 (referring to “content that was already rendered on the page”), 9:11–15 (“Content is only rendered on an ad content display page to a viewer when and/or to the extent that the pre-defined ad content display page triggering area is within, or within a pre-defined distance outside of, the viewer’s browser screen dimensions and scrolling position.”), 69:3–4 (claim 1 reciting “wherein the browser is further configured to render the replacement advertisement in the predefined area”). For purposes of this Decision, we apply the following construction for render: loading content so that it may be viewed, heard or otherwise perceived by a viewer communicating electronically using a browser.

Petitioner proposes “[t]he term ‘*replacement advertisement*’ should be construed to mean ‘a new ad/content rendered in place of a previous ad/content’ as used in the context of the ’329 patent claims and specification.” Pet. 10. Petitioner supports its proposed construction with

the following disclosure by the '329 patent: “The billboard module may also cease rendering or send additional requests to the ad dispatcher server to select a new ad/content to render in the billboard module, say if the billboard was in view for a pre-determined period of time, or has been scrolled outside the viewer’s browser window dimensions.” Pet. 10 (quoting Ex. 1001, 12:65–13:3). For purposes of this Decision, we apply Petitioner’s proposed construction for replacement advertisement.

In addition to proposing express constructions for the two above-discussed limitations, Petitioner also proposes that we construe “th[e] ‘*in response to*’ limitation [of claim 1 as] non-limiting because it requires a condition precedent that need not ever occur.” Pet. 34–35 (same). We are not persuaded and reject this proposed construction.

The full limitation at issue recites:

(b) in response to a determination that the predefined area that is used to display the advertisement has been in view within the visible area of the browser window for a predefined period of time, causing a communication to be sent to one or more dispatcher servers.

Ex. 1001, 68:59–63. As properly construed on the present record, the “in response to” language modifies the recited step of “causing a communication to be sent to one or more dispatcher servers” such that the step must be “in response to a determination that the predefined area that is used to display the advertisement has been in view within the visible area of the browser window for a predefined period of time.” In short, “causing a communication” is a required step of the method of claim 1.

B. Obviousness Generally

A claim is unpatentable “if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains.” 35 U.S.C. § 103(a). “Obviousness is a question of law based on underlying facts.” *MobileMedia Ideas LLC v. Apple Inc.*, 780 F.3d 1159, 1167 (Fed. Cir. 2015). The underlying facts include “(i) the scope and content of the prior art, (ii) the differences between the prior art and the claimed invention, (iii) the level of ordinary skill in the field of the invention, and (iv) any relevant objective considerations of nonobviousness.” *Id.* (citing *Graham v. John Deere of Kan. City*, 383 U.S. 1, 17–18 (1966)). An additional underlying fact is whether there was a reason to combine prior art teachings when so asserted. *Id.*

C. Level Of Ordinary Skill In The Art

In determining whether an invention would have been obvious at the time it was made, we consider the level of ordinary skill in the pertinent art at the time of the invention. *Graham*, 383 U.S. at 17. “The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry.” *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718 (Fed. Cir. 1991). The “person having ordinary skill in the art” is a hypothetical construct, from whose vantage point obviousness is assessed. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998).

Petitioner argues a person having ordinary skill in the art “would have had a bachelor’s degree in computer science, computer engineering or electrical (or similar) engineering with about three years of experience in computer science, computer engineering and electrical engineering.” Pet. 9.

Because Petitioner’s formulation of the level of ordinary skill in the art appears consistent with the ’329 patent and the asserted prior art, and because there is no argument to the contrary at this stage of the proceeding, we apply it in our analysis below.

D. The Prior Art

“A petitioner in an inter partes review may request to cancel as unpatentable 1 or more claims of a patent . . . only on the basis of prior art consisting of patents or printed publications.” 35 U.S.C. § 311(b).

Petitioner here asserts the following two patents and one printed publication as prior art: US 10,380,602 B2, issued Aug. 13, 2019 (“Krassner,” Ex. 1002); US 7,725,502 B1, issued May 25, 2010 (“Badros,” Ex. 1003); and US 2008/0221982 A1, published Sept. 11, 2008 (“Harkins,” Ex. 1004). Petitioner asserts that each of these references constitutes prior art under 35 U.S.C. § 102(b). *See* Pet. 11 (“Krassner is prior art under pre-AIA § 102(b)”), 12 (“Badros is prior art under pre-AIA § 102(b). . . . Harkins is prior art under pre-AIA § 102(b).”). Petitioner is mistaken. They are not prior art under § 102(b).

As stated above, the ’329 patent is a continuation of the parent ’403 application, filed on April 4, 2009, which issued as U.S. Patent No. 11,004,090. Ex. 1001, code (63).

Section 102(b) states that “A person shall be entitled to a patent unless . . . (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, *more than one year prior to the date of the application for patent in the United States.*” 35 U.S.C. § 102(b) (emphasis added). Krassner was patented on August 13, 2019, and thus not more than one year prior to April 4, 2009. Badros was patented on May 25, 2010, and thus not more than one year prior to April 4, 2009. Harkins was published September 11, 2008, and thus not more than one year prior to April 4, 2009. Thus, none of these references qualifies as prior art under § 102(b).

A different subsection of 35 U.S.C. § 102—subsection (e)—identifies a prior art reference by its application filing date as opposed to a patent issue date or an application publication date. That subsection states, in relevant part, that “A person shall be entitled to a patent unless . . . (e) the invention was described in — (1) an application for patent, published under section 122(b), *by another* filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent *by another* filed in the United States before the invention by the applicant for patent.” 35 U.S.C. § 102(e) (emphasis added). Under this subsection, the prior art patent or published application must be from an application that was filed (1) before Patent Owner’s invention date; and (2) “by another.”

“The statute’s reference to ‘by another’ means that an application issued to the same inventive entity cannot qualify as § 102(e) prior art.” *EmeraChem Holdings, LLC v. Volkswagen Grp. of Am., Inc.*, 859 F.3d 1341, 1345 (Fed. Cir. 2017). The inventive entity is different if not all inventors are the same. *See, e.g., Ex parte DesOrmeaux*, 25 USPQ 2d 2040, 1992 WL

457519, 2–4 (BPAI 1992). It does not matter if some inventors are the same. *Id.* If there is any difference, the reference is “by another.” *Id.*

All three of Krassner, Badros, and Harkins stem from applications that were filed before Patent Owner’s earliest invention date based on the present record, i.e., April 4, 2009. Although Krassner shares some common inventors with the challenged patent, it is “by another” because Igor Tchibirev is listed as an inventor on the ’329 patent but is not listed as an inventor on the Krassner patent. *Compare* Ex. 1001, code (72), *with* Ex. 1006, code (72).

Section 103(c) of Title 35 provides the following:

(1) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

(2) For the purposes of this subsection, subject matter developed by another person and a claimed invention shall be deemed to have been owned by the same person or subject to an obligation of assignment to the same person if—

(A) the claimed invention was made by or on behalf of parties to a joint research agreement that was in effect on or before the date the claimed invention was made;

(B) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

(C) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.

(3) For purposes of paragraph (2), the term “joint research agreement” means a written contract, grant, or cooperative

agreement entered into by two or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention.

35 U.S.C. § 103. Thus, prior art under pre-AIA § 102(e) may not render a claim obvious under § 103 where both patents were commonly owned or assigned at the time the invention was made. *Id.* On this record, we note that Krassner appears to only qualify as prior art under 35 U.S.C. § 102(e).

Petitioner bears the burden of persuasion to prove unpatentability by a preponderance of the evidence, and that burden never shifts to Patent Owner. But, if Patent Owner affirmatively seeks to establish a proposition not relied on by Petitioner and not a necessary predicate for unpatentability, the burden of production shifts. *See, e.g., MaxLinear, Inc. v. Cresta Tech. Corp.*, IPR2015-00594, Paper 90 at 24 (PTAB Aug. 15, 2016) (citing *In re Magnum Oil Tools Int'l, Ltd.*, 829 F.3d 1364, 1376 (Fed. Cir. 2016)) Thus, if Patent Owner were to later contend that the safe haven of § 103(c) applies, for example, Patent Owner would bear the burden of production to show (1) the date on which the claimed invention was made and (2) that as of that date, the '329 patent and Krassner were “owned by the same person or subject to an obligation of assignment to the same person.” *See* 35 U.S.C. § 103(c)(1).

In sum, despite Petitioner failing to argue that Krassner, Badros and Harkins are prior art under 35 U.S.C. § 102(e), the present record supports that they are.⁴

⁴ During trial, Patent Owner will have the burden of production to argue or produce evidence that the challenged claims have an invention date earlier than the April 4, 2009 filing date of the '779 parent application. *Cf. Dynamic Drinkware*, 800 F.3d at 1380.

E. Ground II

Ground II relies on “**Badros Alone or Optionally in Combination with Harkins.**” Pet. 31. Badros discloses “a system and method for providing documents such as advertisements on a time-multiplexed basis.” Ex. 1003, 2:41–43. Harkins discloses “a system for placing advertisements provided by advertisers on at least a portion of receipts generated by at least one advertising agent.” Ex. 1004 ¶9.

As discussed below, there is a reasonable likelihood that Petitioner would prevail in proving that claim 1 is unpatentable on this ground.

1. Claim 1

In mapping the prior art to claim 1, the Petition breaks the claim into four portions and organizes its arguments accordingly. *See* Pet. 32–40 (§ IV.B.2.a.–d.). Our discussion tracks the Petition’s arguments as so organized.

a) “A method comprising: (a) determining whether a predefined area of an ad content display page that is used to display an advertisement is in view within a visible area of a browser window of a browser configured to be operated by a remote computing device, wherein the predefined area is a portion of the ad content display page”

Petitioner relies on Badros alone for teaching the above-quoted portion of claim 1. Pet. 32–33 (citing Ex. 1003, 2:49–51, 2:61–63, 3:15–17, 11:61–62, 12:38–41). As noted by Petitioner, Badros discloses that, “[i]n embodiments related to webpage advertisements, more than one advertisement may be displayed in a single ad space of a single webpage” (Ex. 1003, 3:15–17) and the advertisements may be “time-multiplexed” (*id.* at 2:61). In addition, as Petitioner further notes, an “impression module . . .

may determine whether an ad on a web page of a user's browser is actually visible to the user." Ex. 1003, 12:38–41.

We are persuaded, from the Petition's citations and arguments, that there is a reasonable likelihood that Badros teaches the above-quoted portion of claim 1.

b) "wherein the ad content display page includes (i) the predefined area configured to display advertisement content, the predefined area being a portion of the ad content display page, and (ii) page content displayed in other portions of the ad content display page, the page content being separate from the advertisement content"

Petitioner relies on Badros alone for teaching the above-quoted portion of claim 1. Pet. 33–34 (citing Ex. 1003, 2:48–51, 4:34–37). As noted by Petitioner, Badros discloses "a display source such as a monitor or electronic billboard" on which "documents may be displayed in connection with the display of another document such as a webpage." Ex. 1003, 2:48–51. In addition, as Petitioner further notes, Badros discloses that "Website-based advertisements are often presented to their advertising audience in the form of 'banner ads'—i.e., a rectangular box across the top of a web page that includes a graphic." Ex. 1003, 4:34–37.

We are persuaded, from the Petition's citations and arguments, that there is a reasonable likelihood that Badros teaches the above-quoted portion of claim 1.

c) “(b) in response to a determination that the predefined area that is used to display the advertisement has been in view within the visible area of the browser window for a predefined period of time, causing a communication to be sent to one or more dispatcher servers, wherein the one or more dispatcher servers are configured to:

(i) receive the communication;

(ii) cause a replacement advertisement to be selected for display on the ad content display page; and

(iii) cause the replacement advertisement to be served to the remote computing device”

As discussed above, we do not agree with Petitioner’s initial argument that the above-quoted portion of claim 1 is not a limitation of the claimed invention by virtue of the phrase “in response to.” *See* Pet. 34–35.

However, Petitioner also argues that the prior art, either Badros alone or Badros in combination with Harkins, teaches the above-quoted portion of claim 1. *See* Pet. 35–40 (citing Ex. 1003, 2:9–21, 3:13–17, 5:11–21, 9:67–10:2, 11:22–24, 12:36–39, 12:48–66, 20:7–13, 22:12–15, 26:2–5; Ex. 1004 ¶76). For example, as noted by Petitioner, Badros discloses that “time-multiplexing criteria for a plurality of documents [can be] based on the time during which a document is actually viewable on the user’s screen.” Ex. 1003, 11:22–24; *see also id.* at 12:35–39 (“For instance, impression module 38 may determine whether a document (e.g., a document containing a link) is actually visible to a user, and it may track the time duration during which the document is actually visible to the user.”).

For the recited “communication,” Petitioner cites disclosures from both Badros and Harkins. Pet. 35–36. As for Badros, Petitioner cites its disclosure that the “[u]ser module may pass information to and receive

information from (or about) displays and users, e.g., directly or indirectly through providers” and:

In some embodiments, server 2 may receive a request from user 10 or provider 8 (or other requestor) for a document such as an advertisement associated with a concept (e.g., keywords, subject matter, etc.). In response to the request, the server 2 may cause a plurality of documents to be displayed on a time-multiplexed basis. The timing and format of the time-multiplexing may be based on criteria such a relevance to documents to the concept and preferences of document sources 12 associated with each document.

Pet. 35–36 (quoting Ex. 1003, 12:64–66, 5:13–21, respectively). As for Harkins, Petitioner cites its teaching of initiating “a new auction for advertising in the run period subsequent to the run period of the previously-ended auction” and that “virtually any form of new auction may be initiated without departing from the scope of the present invention.” Pet. 36 (quoting Ex. 1004 ¶76).

In addition, Petitioner argues that “Patent Owner might argue that neither Badros nor Harkins disclose[s] repeating the process of requesting another ‘*advertisement*’ ‘*in response to a determination*,’ but repeating steps is just common sense.” Pet. 37 (quoting portions of claim 1 and citing *Google LLC v. Koninklijke Philips N.V.*, 795 F. App’x 840, 846 (Fed. Cir. 2020); *Perfect Web Techs., Inc. v. InfoUSA, Inc.*, 587 F.3d 1324, 1331 (Fed. Cir. 2009)).

At this stage of the proceeding, Patent Owner has not made such an argument. Moreover, such an argument would implicitly construe the three limitations denoted with “(i),” “(ii),” and “(iii)” as steps that must be performed “in response to a determination that the predefined area that is

used to display the advertisement has been in view within the visible area of the browser window for a predefined period of time.” Ex. 1001, 68:59–69:2 (claim 1). However, on the record before us, we understand claim 1 to specify only one step “in response to” the determination, namely “causing a communication.” The three limitations denoted with “(i),” “(ii),” and “(iii)” recite functions that the “one or more dispatcher servers are configured to” perform, but claim 1 does not specify that these functions be performed “in response to” the determination.

We are persuaded, from the Petition’s citations and arguments, that there is a reasonable likelihood that Badros, with or without Harkins, teaches the above-quoted portion of claim 1.

d) *“wherein the browser is further configured to render the replacement advertisement in the predefined area”*

For this limitation, Petitioner relies on the following disclosure of Badros: “Format module 34 may also scale the document to fit a predetermined size or shape (*e.g.*, fill a rectangle of uniform size with the document). Ads may be scaled to different sizes.” Pet. 40 (quoting Ex. 1003, 11:60–62).

We are persuaded, from the Petition’s citations and arguments, that there is a reasonable likelihood that Badros teaches the above-quoted portion of claim 1.

e) *Conclusion as to Claim 1*

There is a reasonable likelihood that Petitioner would prevail in proving that claim 1 is unpatentable on this ground.

2. Claims 2–10

In *SAS Institute, Inc. v. Iancu*, 138 S. Ct. 1348 (2018), the Supreme Court held the following:

Section 314(a) [of Title 35] does not require the Director to evaluate every claim individually. Instead, it simply requires him to decide whether the petitioner is likely to succeed on “at least 1” claim. Once that single claim threshold is satisfied, it doesn’t matter whether the petitioner is likely to prevail on any *additional* claims; the Director need not even consider any other claim before instituting review. Rather than contemplate claim-by-claim institution, then, the language anticipates a regime where a reasonable prospect of success on a single claim justifies review of all.

SAS, 138 S. Ct. at 1356. Thus, because we have decided to grant review of claim 1, we do the same for claims 2–10 and the ground based on Krassner (Ground I). *Id.*; *see also* 37 C.F.R. § 42.108(a) (“When instituting *inter partes* review, the Board will authorize the review to proceed on all of the challenged claims and on all grounds of unpatentability asserted for each claim.”).

III. CONCLUSION

For the reasons discussed above, we are persuaded that Petitioner has demonstrated a reasonable likelihood of prevailing in establishing that at least one of claims 1–10 of the ’329 patent is unpatentable.

IV. ORDER

In consideration of the foregoing, it is hereby

ORDERED that the Petition is granted and *inter partes* review is hereby instituted as to claims 1–10 of the '329 patent on the grounds presented; and

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial on the grounds of unpatentability authorized above; the trial commences on the entry date of this decision.

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FITZPATRICK, *Administrative Patent Judge*, opinion including additional views.

I write separately and additionally to address Petitioner’s failure to articulate correctly the statutory basis on which each of the asserted references qualifies as prior art to the challenged claims of the ’329 patent. As noted in the Board’s Opinion, Petitioner erroneously asserts that each of Krassner, Badros, and Harkins “is prior art under pre-AIA § 102(b).” *See* Pet. 11–12. Nonetheless, based on the information presented, the Board determines there is a reasonable likelihood that Krassner, Badros, and Harkins are prior art under pre-AIA § 102(e), despite that Petitioner did not assert them to be prior art under that sub-section.

By statute, “a petition [for an inter partes review] may be considered only if,” among other things, it “identifies, in writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim, including—(A) copies of patents and printed publications that the petitioner relies upon in support of the petition.” 35 U.S.C. § 312(a)(3)(A). Although this statute requires that a petition identify any “patents and printed publications that the petitioner relies upon,” it does not explicitly require that a petition identify the subsection(s) of 35 U.S.C. § 102 under which the relied-upon patents and printed publications constitute prior art. I am unaware of any precedential decision interpreting this statutory language as including such a requirement.

A related Rule arguably does include such a requirement. That Rule states that a petition must identify “[t]he *specific statutory grounds* under 35

U.S.C. 102 or 103 on which the challenge to the claim is based and the patents or printed publications relied upon for each ground.” 37 C.F.R. § 42.104(b)(2) (emphasis added). But this language does not definitively set forth such a requirement, and, again, I am unaware of any precedential decision interpreting this regulatory language as including such a requirement.¹

However, the Petition’s failure to identify correctly the proper subsection of 102 unnecessarily increased the workload of the Board and may have prejudicially affected the Patent Owner’s decision whether to file a preliminary response and, had it chosen to do so, the arguments Patent Owner would have advanced therein. It is my view that the Board and parties appearing before the Board would benefit from a clear requirement that petitions identify the specific subsection(s) of § 102 under which each relied-upon patent or printed publication constitutes prior art.

¹ At least one non-precedential Board decision has held that § 42.104(b)(2) does not include such a requirement. *See TCL Corp. v. Telefonaktiebolaget LM Ericsson*, No. IPR2015-01584 (PTAB Mar. 7, 2016) (Paper 18), 5 (“No express requirement exists that the petition must identify the section of 35 U.S.C. § 102 by which a patent or printed publication is prior art to the challenged patent.”); *but see Securus Techs., Inc. v. Glob. Tel*link Corp.*, No. IPR2016-00996, 2017 WL 4899298, at *6 (PTAB Oct. 30, 2017) (“The second page of the Petition makes clear that Petitioner asserts that Hodge is ‘prior art under at least pre-AIA 35 U.S.C. § 102(a) and (e).’ At no point does Petitioner contest the priority date of the ’609 Patent, nor suggest that the patent’s claimed priority date was not clear or was uncertain. We are persuaded that the Petition does not demonstrate an intent to apply Hodge under 35 U.S.C. § 102(b), nor does it otherwise suggest any dispute regarding the priority claim of the ’609 Patent.” (internal citations omitted)).