

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Duration Media LLC
Petitioner,

v.

Rich Media Club LLC
Patent Owner.

US Patent No. 11,443,329

Filing Date: May 11, 2021

Issue Date: September 13, 2022

Title: System And Method For Creation, Distribution And tracking Of Advertising
Via Electronic Networks

MOTION TO SUBMIT SUPPLEMENTAL INFORMATION

UNDER 37 C.F.R. § 42.123(a)

I. INTRODUCTION

On September 13, 2023, the Board authorized Petitioner to file this motion to submit Exhibits 1015–1016 as supplemental information under Rule 123(a).

The Board instituted *inter partes* review on August 30, 2023, and identified the inadvertent clerical error in which Petitioner included § 102(e) prior art rather than the intended earlier-published § 102(b) prior art. Petitioner respectfully requests that the Board allow supplemental information consisting of each of the earlier-published versions of Krassner (Ex-1002) and Badros (Ex-1003). Petitioner served the supplemental information to Patent Owner on September 11, 2023.

The supplemental information addresses an inadvertent omission of citations to and copies of the earlier publications.¹ Granting Petitioner’s motion will not prejudice Patent Owner or prohibit the Board from meeting its statutory deadlines. Petitioner has stated repeatedly that it will work with Patent Owner to move deadlines as allowed under the Board’s rules and the scheduling order.

The supplemental information is substantially and substantively identical to the documents filed by Petitioner, and Patent Owner will have two months to

¹ All the quotes are the same, except for a single quote of a claim in Badros that was used in a string cite along with other, similar quotations. The claim was amended during prosecution and was therefore not in the pre-grant publication.

consider the supplemental information before it must file its Response. As a result, granting the motion will neither significantly prejudice Patent Owner nor impact the twelve-month statutory deadline. Petitioner respectfully requests the Board grant this motion.

II. ARGUMENT

A. Legal Standard.

Rule 42.123(a) allows supplemental information if: (1) a “request ... is made within one month of the date the trial is instituted;” and (2) “[t]he supplemental information [is] relevant to a claim for which the trial has been instituted.”

In exercising its discretion to grant the motion, the Board’s “guiding principle for the PTAB in making any determination is to ‘ensure efficient administration of the Office and the ability of the Office to complete IPR proceedings in a timely manner.’” *Redline Detection, LLC v. Star Envirotech, Inc.*, 811 F.3d 435, 445 (Fed. Cir. 2015); *see also*, 37 C.F.R. § 42.1(b) (requiring the Board to construe its rules “to secure the just, speedy, and inexpensive resolution of every proceeding”). Petitioner bears the burden to prove it is entitled to the requested relief.

B. Rule 42.123(a) allows entry of information showing prior publication.

Petitioner’s request to submit Exhibits 1015–1016 as supplemental information meets the requirements of 37 C.F.R. § 42.123(a). First, Petitioner requested authorization to submit its motion on September 11, 2023, less than one

month after the Board instituted *inter partes* review on August 30, 2023. *See*, 37 C.F.R. § 42.123(a)(1). Second, each exhibit supports the prior art status of the art upon which the Board instituted trial and are therefore “relevant to a claim for which the trial has been instituted.” *See*, 37 C.F.R. § 42.123(a)(2); *see*, *Palo Alto Networks, Inc. v. Juniper Networks, Inc.*, IPR2013-00369 (PTAB Feb. 5, 2014) (Paper 37, 3) (“Evidence that allegedly confirms the public accessibility of references that serve as the basis of the grounds of unpatentability authorized in this proceeding is relevant to the claims ... for which the trial was instituted.”). The supplemental evidence detailed below is relevant to earlier publications of Krassner and Badros upon which the Board instituted trial:

1. Exhibit 1015 is an earlier pre-grant publication of Krassner.
2. Exhibit 1016 is an earlier international WIPO publication of Badros.

Accordingly, the supplemental information is relevant to the challenged claims.

The Board consistently grants motions to submit supplemental information where, as here, the supplemental information supports the prior art status of references upon which the Board instituted trial. *See, e.g., South-Tek Sys.*, IPR2016-01351 (PTAB June 15, 2017) (Paper 17); *Apple v. Cal. Inst. of Tech.*, IPR2017-00210 (PTAB Oct. 27, 2017) (Paper 32); *Smart Microwave Sensor GmbH v. Wavetronix LLC*, IPR2016-00488 (PTAB Aug. 26, 2016) (Paper 22); *Creston Elecs. Inc. v. Intuitive Building Controls, Inc.*, IPR2015-01379 (PTAB Feb. 2, 2016) (Paper

27); *Valeo N. Am., Inc. v. Magna Elecs., Inc.*, IPR2014-01204 (PTAB Apr. 10, 2015) (Paper 26); *TCL Corp. v. Telefonaktiebolaget LM Ericsson*, IPR2015-01584 (PTAB Aug. 11, 2016) (Paper 50); *Symantec Corp. v. Finjan, Inc.*, IPR2015-01892 at 31 (PTAB Mar. 15, 2017) (Paper 58).

The supplemental information does not change the grounds of unpatentability. Rather, it evinces earlier publication of substantively identical disclosures to those cited in the Petition. *See, Palo Alto Networks, Inc. v. Juniper Networks, Inc.*, Case IPR2013-00369 (PTAB Feb. 5, 2014) (Paper 37, 3); and *Hayward Industries, Inc. v. Pentair Ltd. et al.*, IPR2013-00287 (PTAB Jan. 27, 2014) (Paper 24). Rule 42.123(a) simply requires that the information is “relevant” to a ground. Here, it is relevant because it demonstrates publication over one year before the effective filing date of the ’329 patent. This situation is like *Hulu, LLC v. Sound View Innovations, LLC*, in which the Petitioner submitted several similar but slightly different versions of a prior art reference to prove publication. Case IPR2018-01039 (PTAB Dec. 20, 2019) (Paper 66, 46–47) (copies submitted with Pet. Rply. used to prove publication); *see also, id.* (Paper 29, 7–8 (“[a]fter institution, there is also an opportunity for the petitioner to move to submit supplemental information under 37 C.F.R. § 42.123”)) (Precedential Opinion Panel) (citing CTPG, 73–74). This motion satisfies the basic requirements of allowing supplemental information when it is relevant. The Board

need not rule on the publication dates of Krassner and Badros when deciding the motion. The parties can argue the impact of the relevant information during the trial.

C. Entering Exhibits 1015–1016 will not prejudice Patent Owner or impact the Board’s ability to complete the trial in twelve months.

Granting this motion will promote “‘the just, speedy, and inexpensive resolution’ [of the] proceedings.” *Crestoin Elecs.*, IPR2015-0179, at 3 (quoting 37 C.F.R. § 42.1(b)). Due process arguments do not withstand scrutiny and presuppose any supplemental information in a trial about earlier publication would result in an undue burden because it could not be addressed in the POPR.

Patent Owner here [has] a full and fair opportunity to address these arguments ...: first in the Patent Owner Response, next in the Sur-reply, and again at the oral hearing. *Cf. Magnum Oil Tools*, 829 F.3d at 1381 (“[T]he Board must base its decision on arguments that were advanced by a party, and to which the opposing party was given a chance to respond.”).

Cisco Sys., Inc. v. Centripetal Networks, Inc., Case IPR2018-01513 (PTAB Mar. 31, 2020) (Paper 26, 17). “[T]he patent owner will have sufficient time to address any new information submitted by the petitioner” 77 Fed. Reg. 48,680, 48,707–08 (Aug. 14, 2012). Petitioner has stated repeatedly that it is willing to move deadlines as allowed under the Board’s rules and the scheduling order.

III. CONCLUSION

Petitioner respectfully requests that the Board grant its Motion to Submit Supplemental Information for at least the reasons above.

IPR2023-00953

Patent 11,443,329 B2

Respectfully Submitted,

Dated: September 20, 2023

/Kevin Greenleaf/

Kevin Greenleaf

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing Motion to Submit Supplemental Information Under 37 C.F.R. § 42.123(a) and related exhibits were served on September 20, 2023, via email on the following correspondence addresses for the Patent Owner's counsel of record and otherwise.

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Respectfully Submitted,

Dated: September 20, 2023

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