

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Duration Media LLC
Petitioner,

v.

Rich Media Club LLC
Patent Owner.

Case IPR2023-00953
U.S. Patent 11,443,329

**PATENT OWNER'S AMENDED MANDATORY NOTICES
PURSUANT TO 37 C.F.R. § 42.8**

Pursuant to 37 C.F.R. § 42.8(a)(2), Patent Owner, Rich Media Club LLC, hereby files its Amended Mandatory Notices in connection with the above-captioned Petition.

I. REAL PARTY-IN-INTEREST

The patent owner is Rich Media Club LLC.

II. RELATED JUDICIAL OR ADMINISTRATIVE MATTERS

As of the filing date of this notice, related matters are:

A. Litigations Involving the Patent-at-Issue

U.S. Patent No. 11,443,329 is at issue in the following lawsuit filed in the United States District Court for the District of Arizona: *Rich Media Club LLC v. Duration Media LLC*, Case No. 2:22-cv-02086.

B. Proceedings Before the USPTO Involving Related Patents

There are two patent applications pending that share an identical disclosure to the '329 Patent: No. 17/961,952 filed October 7, 2022 and no. 18/135,363 filed April 17, 2023. Patent Owner filed an IDS disclosing the Petition and references in the Petition in the '952 Application on June 9, 2023, along with a Request for Continued Examination. A Notice of Allowance issued for the '952 application on June 30, 2023.

As stated on the face of the '329 patent, it is related to the Continuation of application No. 12/384,403, filed on Apr. 4, 2009, now Pat. No. 11,004,090, which

is a continuation - in - part of application No. 11/803,779, 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. The face of the '329 Patent also indicates it is related to provisional application No. 60/753,536, filed on Dec. 24, 2005.

The body of the specification for the '329 patent states: "This application is a continuation in part of co-pending U.S. Nonprovisional patent application Ser. No. 11/643,245 filed on Dec. 21, 2006, which is based upon and claims priority back to U.S. Provisional Patent Application Ser. No. 60/753,536 filed on Dec. 24, 2005, the entirety of each of which is incorporated herein by reference. The benefit of the earlier filing date of co-pending Nonprovisional patent application Ser. No. 11/643,245 filed on Dec. 21, 2006, is claimed pursuant to 35 U.S.C. Section 120."

III. LEAD AND BACK-UP COUNSEL AND SERVICE INFORMATION

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Patent Owner consents to electronic service and requests that all correspondence to the lead counsel be sent to the e-mail addresses rolson@giplg.com, arichards@giplg.com, dberten@giplg.com, and hsadler@giplg.com.

Dated: September 27, 2023

Respectfully submitted,

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CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e)(1))

The undersigned hereby certifies that on September 27, 2023, a complete and correct copy of the foregoing PATENT OWNER'S AMENDED MANDATORY NOTICES PURSUANT TO 37 C.F.R. § 42.8 was served via electronic mail on the following counsel of record for Petitioner:

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