

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

**OPPOSITION TO MOTION TO SUBMIT SUPPLEMENTAL INFORMATION
UNDER 37 C.F.R. § 42.123(a) (Paper 15)**

I. Petitioner asks to change the grounds of unpatentability by now (1) relying on different references the Petition omitted and (2) by again changing the basis of proceeding, from §102(e) to §102(b).

An IPR Petition must cite “the patents and printed publications which are presented to provide a substantial new question of patentability.” 47 CFR § 1.915(c). Here, the Petition relied on three patents, Krassner (Ex. 1002), Badros (Ex. 1003), and Harkin (Ex. 1004). The Petition presented these references as as prior art under pre-AIA section 102(b). *See, e.g.*, Pet. Page 11 (“Krassner is prior art under pre-AIA § 102(b)”); 12 (“Badros is prior art under pre-AIA § 102(b)”); 12 (“Harkins is prior art under pre-AIA § 102(b)”). The Petition was wrong. None of the references are prior art under pre-AIA § 102(b), a fact so obvious the Patent Owner did file a preliminary response. And the Board readily reached the same conclusion. Paper 9 at 10.

Despite this facial flaw in the Petition, the Board made a preliminary finding that the references the Petitioner wrongly asserted as 102(b) appeared to qualify as prior art under section 102(e), “despite Petitioner failing to argue” that theory. Paper 9 at 13. Now, under the rubric of providing “supplemental information,” Petitioner seeks Board permission to introduce two ***published patent applications*** (Krassner* and Badros*, together the “New References”). As explained below, while seeking to supplement the record, the Petitioner has not addressed the ***effect*** of the supplementation. Are the New References ***replacing*** the references in the Petition or are they offered for a more limited purpose? If the New References replace the references in the Petition, then the Trial proceeds on the un-examined claims in

Krassner* and Badros*. In this scenario, the issued claims in Badros and Krassner could not be relied upon by the Petitioner or Board to invalidate a claim. If the issued claims are in, on what basis? 102(e)? The Motion to Supplement addresses none of these issues and the Board should deny the motion on that basis alone.

A. The Supplemental References Are New References with Different Legal Implications than the References in the Petition

Petitioner downplays the significance of its motion by asserting the New References are being offered to establish “prior publication” of Badros and Krassner. But that is not and legally cannot be the case. The New References are different from Badros and Krassner at least to the extent the published, non-issued, claims in the New References are different than the allowed claims in Badros and Krassner. The Petition and expert report cite to the “wrong” versions of references. And, of course, their dates are different, potentially resulting in different outcomes depending on the purposes the Board allows for use of the New References.

Whether this Petition proceeds using the issued Krassner patent, Ground 1 fails because, as the Board determined, the Krasner issued patent is a 102(e) reference which may not be used as a 103 reference because it was commonly owned with the ’329 patent. Paper 9 at 12-13. If the Board allows substitution of Krassner with Krassner*, however, then the safe haven might not apply. Uncertainty regarding the permissible use of the supplemental information is itself prejudicial to Patent Owner.

What, precisely, are the references and bases on which the Patent Owner is to respond? This apparently will not be revealed until *after* Patent Owner's Reponse.

Similar issues arise if Badros* replaces Badros as the basis for the Petition. As the Board recognized, Badros is not a 102(b) reference, as Badros* appears to be. As a 102(e) reference, Patent Owner can potentially swear behind Badros; if Badros* is a 102(b) reference, it cannot be sworn behind. Thus, Petitioner's proposed substitutions are to cure deficiencies in its Petition that were identified in the Institution decision, and should not be allowed.

B. The Petitioner Withheld at Least Krassner*

Petitioner *actually knew* of Krassner* and withheld it from being submitted. Eleven months before he participated in preparing the Petition, Petitioner and its counsel (Joel Bock at Dentons) filed a post-allowance IDS in the file history of Petitioner's patent 11,195,210 ("Batkin"), citing Krassner* as a reference. Ex. 2004.¹ The Board can and should consider that Petitioner had the opportunity to submit the New References with the petition. *See, e.g. B/E Aerospace, Inc. v. MAG Aerospace Indus., LLC*, Case IPR2014-01510 (PTAB Apr. 28, 2015) (Paper 37) ("Petitioner's opportunity to have submitted the proffered information with the petition rather than

¹ Petitioner's failure to acknowledge its awareness of Krassner* pre-Petition permits an inference that the Petitioner also knew of Badros* pre-Petition. Certainly diligence would have revealed Badros*.

as supplemental information is a permissible consideration in evaluation of a motion under section 123(a)” (citation omitted). *See also Palo Alto Networks, Inc. v. Juniper Networks, Inc.*, Case IPR2013-00369 (PTAB Feb. 5, 2014) (Paper 37 at 4). Here, the Petitioner new of Krassner* and withheld it.

C. Petitioner’s “Clerical Error” Excuse Beggars Belief

The only reason Petitioner gives for withholding the references from the Petition is “clerical error.” But even here the Petitioner is less than candid. Was the purported clerical error that the Petitioner meant to use Krassner* and Badros* instead of Krassner and Badros in the Petition? Or was the purported clerical error that the Petitioner meant to base the petition on Badros and Krassner but forgot to include Krassner* and Badros* as evidence of prior publication? The latter seems nonsensical – why not rely on Badros* and Krassner* directly? And the former seems noncredible – no one cites the “wrong” reference 11 times in the case of Krassner and 41 times in the case of Badros.

D. The Basis of the Petition Is Now an Evidentiary Mess; Responding to It Is the Very Picture of Prejudice

While the Petitioner passes off the situation as mere “clerical error,” the reality it has created has already overly taxed the Board and the Patent Owner, and that taxation will remain throughout the Trial. The Petition and expert report refer to Krassner and Badros, not the New References. Will the Petitioner be permitted to file

a new expert report referring to Krassner* and Badros* with its Reply — effectively depriving Patent Owner of any opportunity to address the new evidence?

Petitioner string cites 8 IPRs for the proposition that supplemental information is permitted to establish prior publication. Many of the cases involve library or other materials used to address publication dates or public availability of the reference in the Petition, not wholesale substitution of one reference for another.

Granting the motion would be highly prejudicial to the Patent Owner. In addition to being required to respond to 102(e) arguments not in the Petition or the expert declaration, Patent Owner would also be required to respond references not cited in the Petition or the expert's declaration and 102(b) arguments that the Petitioner has not made. This is unreasonable and unfair. Patent Owner cannot fairly be required to respond to material and arguments not in the Petition or the expert's declaration. All of this also precludes Patent Owner from making informed judgments about amending its claims in advance of the deadline.

Granting the motion contravenes *In re Magnum Oil Tools Int'l, Ltd.*, 829 F.3d 1364, 1381 (Fed. Cir. 2016) and the APA's notice requirements, as *Apple Inc. v. Corephotonics, Ltd.*, 2023 WL 5838695, at *7 (Fed. Cir. Sept. 11, 2023). Petitioner's proposed change to the fundamental bases for its Petition, post-institution, do not comport with the notice requirements of the APA.

The motion should be denied. If it is granted, Patent Owner requests clarification on the scope of use of New References and an amended schedule.

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 OPPOSITION TO MOTION TO SUBMIT SUPPLEMENTAL INFORMATION UNDER 37 C.F.R. § 42.123(a) was served via electronic mail on the following counsel of record for Petitioner:

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