

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*.

FITZPATRICK, *Administrative Patent Judge*.

ORDER

Denying Petitioner's Motion to Submit Supplemental Information
37 C.F.R. § 42.123(a)

On August 30, 2023, we entered a Decision Granting Institution of *Inter Partes* Review. Paper 9 (“Dec.”). The prior art references relied-upon in the Petition are: 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). Dec. 10. In our Decision, we noted that “Petitioner asserts that each of these references constitutes prior art under 35 U.S.C. § 102(b),” but that they are not. *Id.* We nonetheless determined that they were prior art under 35 U.S.C. § 102(e). *Id.* at 13.

On September 11, 2023, Petitioner requested a conference call to seek authorization to file a motion to submit supplemental information “consisting of earlier-published versions of Krassner and Badros.” Ex. 3001 (Sept. 11, 2023, email from counsel for Petitioner). On September 13, 2023, the Board conducted a call with both parties’ counsel. During the call, counsel for Petitioner sought authorization to file either the above-described motion under 37 C.F.R. § 42.123(a) or a motion under 37 C.F.R. § 42.104(c). *See* 37 C.F.R. § 42.104(c) (“A motion may be filed that seeks to correct a clerical or typographical mistake in the petition.”). We heard from both parties’ counsel, and ultimately authorized Petitioner to file a single motion under 37 C.F.R. § 42.123(a) and/or 37 C.F.R. § 42.104(c) and a response or opposition by Patent Owner.

On September 20, 2023, Petitioner timely filed a Motion to Submit Supplemental Information Under 37 C.F.R. § 42.123(a). Paper 15 (“Motion” or Mot.”). On September 27, 2023, Patent Owner timely filed its Opposition to Motion to Submit Supplemental Information Under 37 C.F.R. § 42.123(a). Paper 18 (“Opposition” or “Opp.”).

For the reasons explained, we deny the Motion.

Petitioner's Motion seeks to add, as supplemental information, two published patent applications. The first is US 2007/0265923 A1, published November 15, 2007 ("Krassner publication," Ex. 1015¹), which is a publication of the application that later issued as Krassner. The second is WO 2006/138400 A1, published December 28, 2006 ("Badros publication," Ex. 1016), which is a publication of an international application under the Patent Cooperation Treaty claiming priority to the U.S. application that later issued as Badros.

The Motion is replete with ambivalence and ambiguity, leaving one to wonder what the effect of its Motion would be were it to be granted.

On the one hand, the Motion states that "[t]he supplemental information addresses an inadvertent omission of citations to and copies of the earlier publications," and that "[t]he supplemental information is substantially and substantively identical to the documents filed by Petitioner." Mot. 1. These and other statements imply Petitioner intends to substitute the Krassner publication for Krassner and the Badros publication for Badros into its grounds of unpatentability. In fact, the Motion further states that the Board, in instituting the review, "identified the inadvertent clerical error in which Petitioner included § 102(e) prior art rather than the intended earlier-published § 102(b) prior art." Mot. 1. We did not. We

¹ Another Exhibit 1015 already exists in this case, having been filed by Petitioner on May 24, 2023, along with its Petition. Because we are denying the Motion and expunging the supplemental information including the second-filed Exhibit 1015, the Krassner publication need not -- and indeed may not -- be re-filed under a new exhibit number.

identified Petitioner's error in asserting that its references were prior art under § 102(b). Dec. 10. We did not describe that error as "inadvertent" or "clerical."

On the other hand, the Motion includes statements suggesting that Petitioner is *not* seeking to substitute the Krassner publication for Krassner and the Badros publication for Badros into its grounds of unpatentability. For example, the Motion states that "[t]he supplemental information does not change the grounds of unpatentability. Rather, it evinces earlier publication of substantively identical disclosures to those cited in the Petition." Mot. 4. Further, Petitioner argues that the supplemental information "is relevant because it demonstrates publication over one year before the effective filing date of the '329 patent." *Id.* (citing *Hulu, LLC v. Sound View Innovations, LLC*, No. IPR2018-01039 (PTAB Oct. 5, 2021) (Paper 66, 46–47)). Conspicuously absent from Petitioner's argument is *what* the supplemental information allegedly demonstrates to have been published before the critical date.

The face of the Krassner publication demonstrates its own publication date, November 15, 2007. Ex. 1015, code (43). It says nothing about the "publication" of Krassner, which is a United States Patent. Similarly, the face of the Badros publication demonstrates its own publication date, December 28, 2006. Ex. 1016, code (43). It says nothing about the "publication" of Badros, which is a United States Patent.

Petitioner's argument that the instant "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" is not persuasive. In *Hulu*, the reference at issue was a textbook

(“Dougherty”) bearing a copyright date before the critical date. *Hulu*, at 22. Despite the copyright date, the patent owner contested whether it was actually publicly available before the critical date. *Hulu*, at 33. The Board found that reply evidence filed by petitioner regarding other versions of Dougherty from the University of Michigan and Johns Hopkins University were probative of Petitioner’s version of Dougherty having been publicly available before the critical date. *Id.* at 47.

Hulu is unlike the situation here. Here, the references in the Petition, Krassner and Badros, are United States Patents, and there can be no question as to when they were patented.

Petitioner’s Motion is based on Rule 123(a), which provides as follows:

(a) Motion to submit supplemental information. Once a trial has been instituted, a party may file a motion to submit supplemental information in accordance with the following requirements:

- (1) A request for the authorization to file a motion to submit supplemental information is made within one month of the date the trial is instituted.
- (2) The supplemental information must be relevant to a claim for which the trial has been instituted.

37 C.F.R. § 42.123(a). Petitioner argues that its Motion “satisfies the[se] basic requirements of allowing supplemental information.” Mot. 4.

However, § 123(a) does not *require* granting such a motion upon a showing that the basic requirements of timeliness and relevance have been met. *See Redline Detection, LLC v. Star Envirotech, Inc.*, 811 F.3d 435, 446 (Fed. Cir. 2015) (quoting and rejecting as erroneous petitioner’s argument that § 123(a) “permits ‘consideration of two and only two requirements: timeliness and relevance’”). Rather, as the Court of Appeals held:

The PTAB's decision to admit supplemental information is also informed by 37 C.F.R. Part 42, Subpart A. *See* 37 C.F.R. § 42.100(a) ("An [IPR] is a trial subject to the procedures set forth in subpart A of this part."). Subpart A requires USPTO regulations "be construed to secure the just, speedy, and inexpensive resolution of every proceeding." 37 C.F.R. § 42.1(b); *see also* 35 U.S.C. § 316(b).

Redline, 811 F.3d at 443. "Requiring admission of supplemental information so long as it was timely submitted and relevant to the IPR proceeding would cut against this mandate and alter the intended purpose of IPR proceedings." *Id.* at 445.

Section 312 of Title 35 lists the statutory "Requirements of [a] Petition." Among the listed requirements are the identification of "the evidence that supports the grounds for the challenge to each claim" and the inclusion of "copies of the patents and printed publications that the petitioner relies upon in support of the petition." 35 U.S.C. § 312(a)(3). The supplemental information sought to be added by the Motion clearly was available to Petitioner before it filed its Petition. Allowing Petitioner to add it now post-institution would cut against the just, speedy, and inexpensive resolution of the proceeding. In fact, as stated above, it is not clear how Petitioner intends to rely on the supplemental information, as Petitioner explicitly punts the issue to a later date. *See* Mot. 5 ("The parties can argue the impact of the [supplemental] information during the trial.").

ORDER

Accordingly, it is

ORDERED that Petitioner's Motion to Submit Supplemental Information Under 37 C.F.R. § 42.123(a) is DENIED; and

IPR2023-00953
Patent 11,443,329 B2

FURTHER ORDERED that the Supplemental Information be
expunged.

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