

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 No.: IPR2023-00953

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

**REQUEST FOR REHEARING OF DECISION ON
MOTION TO SUBMIT SUPPLEMENTAL INFORMATION
UNDER 37 C.F.R. § 42.123(a)**

Petitioner respectfully requests reconsideration¹ of the Decision (Paper 21, the “Dec.” or “Decision”) on the Motion to Submit Supplemental Information (Paper 15, the “Mot.” or “Motion”). The Decision seems to misapprehend or overlook the stated effect of the supplemental information and the reasons for the inadvertent omission. Dec., 3. The limited, 5-page Motion argued these issues, even though none of the statutes, rules, nor the Order (Paper 14), requested such information. Petitioner, therefore, clarifies those same arguments below to address any ambiguity.

The Petitioner explained the purpose of the supplemental information: “the supplemental information is relevant to earlier publications of Krassner and Badros.” Mot., 3; *see also*, 37 C.F.R. § 42.123(a)(2). Petitioner also stated, “The Board need not rule on the publication dates,” to recognize simply that such a motion to submit supplemental information is dispositive of nothing (Mot., 4–5) and the publication-date issue would remain open for trial. Petitioner followed the rule to show that the supplemental information was relevant, not its ultimate effect, which would be premature to decide. Rule 123(a)(2) simply requires relevance; no one disputes that

¹ The Order denying supplemental information issued on October 12. This request is due 14 days later, on October 26, and is therefore timely. 37 C.F.R. § 42.71(d)(1).

the supplemental information is relevant to whether the “invention” was published earlier as a printed publication, a patent in this case. 35 U.S.C. § 102(b).

The Motion acknowledged the importance of discretion and how the Board consistently enters supplemental information concerning publication date. Mot., 3. Petitioner simply requests that its evidence of publication receive the same, consistent treatment.

I. The Decision Misapprehended or Overlooked the Reasons How the Supplemental Information Is Relevant to an Instituted Claim.

The Motion specifically addressed “what the supplemental information ... demonstrates to have been published before the critical date.” Dec., 4.

All the quotes [in the Petition] are the same the same, except for a single quote of a claim in Badros [Pet. at 27, 29, and 39 (citing Ex-1003, 26:2–5)] 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.

Mot., 1 (FN1) (the quotes in the Petition from the earlier Krassner publication are all identical; the Board overlooked or did not address these facts). Obviously, nearly all related applications and patents have identical disclosures, absent correction of typos, unless there is a continuation-in-part. Accordingly, the supplemental information “is relevant to earlier publication” of the invention under § 102(b) (“the invention was patented or described in a printed publication.”). Mot., 3; Pet., 11–12 (identifying the art as § 102(b) art); *see also*, Ex-1009, Smedley Dec., ¶37.

Hulu, LLC v. Sound View Innovations, LLC, had extremely similar facts. IPR2018-01039, Paper 66 (PTAB Oct. 5, 2021) (“*Hulu*”). *Hulu* did find differences between various versions of the same book. *Id.*, 22 (earlier “Cornell” version lacked later “minor corrections”) and 37–40 (missing pages and pictures from two other versions do not demonstrate a material difference) (citing *Valve Corp. v. Ironburg Inventions Ltd.*, 8 F.4th 1364, 1372 (Fed. Cir. 2021) (reversing final written decision because immaterial differences between prior art submitted with a petition and earlier-published version do not make the documents different); *VidStream LLC v. Twitter, Inc.*, 981 F.3d 1060, 1066 (Fed. Cir. 2020) (Board held exhibit submitted with petition was prior art based on different version submitted with reply); and *Suffolk Techs., LLC v. AOL Inc.*, 752 F.3d 1358, 1365–66 (Fed. Cir. 2014) (holding that alterations of a newsgroup post asserted as prior art were insufficient to create a genuine issue of material fact concerning the post)); *see also*, Mot., 2. *Hulu* and its three, cited Federal Circuit decisions are directly on point because each concerns printed publications; patents and pre-grant publications are also printed publications. *See e.g., Becton, Dickinson and Company v. Baxter Corporation Englewood et al.*, IPR2019-00119, Paper 51 (PTAB Apr. 29, 2020).

Like the prior art in *Hulu* and the cases it cited (*Valve*, *VidStream*, and *Suffolk*), pre-grant and WIPO publications are slightly different from issued patents, but this is not “affirmative evidence challenging material facts” because the

substance is the same. *Hulu*, 37–38. Related patent disclosures are and must be substantively identical. Therefore, just like in *Hulu*, the “invention” disclosed in the earlier publications of each of the Krassner and Badros patents is materially identical to the later publications. *Id.*; *see also*, § 102(b).

The Motion explained that the supplemental information did not change a ground of unpatentability. Mot., 2. “Rather, it evinces earlier publication of substantively identical disclosures to those cited in the Petition.” *Id.* The prior art quotations in the Petition are identical to the earlier publications but for one quote of a claim from Badros. The § 102(b) grounds would be identical. The Decision overlooked several cases supporting this idea:

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.”).

* * *

See, e.g., South-Tek Sys., [LLC et al v. Engineered Corrosion Solutions, LLC], 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 (PTAB Mar. 15, 2017) (Paper 58).

Mot., 3–4. Indeed, *Palo Alto* concerned supplemental information (Ex-1017) containing a different version of the prior art submitted with the petition (Ex-1006). Furthermore, page 5 of *TCL Corp.* explained, “The trial court’s inherent search for truth is the basic building block by which the judicial process maintains its credibility within the fabric of our society.” (Citing *TechSearch LLC v. Intel Corp.*, 286 F.3d 1360, 1378 (Fed. Cir. 2002)). The inherent truth is indisputably that the “invention” disclosed by Krassner and Badros is § 102(b) prior art, even if the substantively identical versions filed with the Petition were republished earlier.

Petitioner never suggested anything other than it was demonstrating that the “invention” of the Krassner and Badros patents was published earlier in “exactly the” “same application.” MPEP § 901.05(b) code (65); WIPO, “Handbook on Industrial Property Information and Documentation” (<https://shorturl.at/zEYZ9>); and 35 U.S.C. § 102(b).

The Decision also misapprehended that a pre-grant publication obviously cannot identify when a patent will issue. Dec., 4. However, the Krassner patent itself provided evidence of “a previously published patent document concerning *the same application*.” MPEP § 901.05(b); Ex-1002 code (65) (emphasis added). Accordingly, like the copyright date in *Hulu*, Krassner bears an earlier publication

date. *Hulu*, 22. Similarly, the earlier WIPO publication of Badros could not predict when its priority application, the Badros application, would issue or publish. It did, however, cite the priority application. *Id.*, 2, code (30). This is the same as *Hulu*, where an earlier-published version said nothing about an inchoate publication of the same invention. The distinguishing facts are irrelevant.

The Decision also distinguishes *Hulu* because it concerned a textbook, not a patent. Dec., 4–5. This fact also fails to support denial of the Motion. The issue is not when the prior art was “patented,” it is when the “invention” was published. § 102(b). The Petition correctly stated that the disclosed “inventions” were § 102(b) prior art. *See* Pet., 11–12. The only concern is whether the Petition provided sufficient evidence of the earlier publication. Like *Hulu*, the Board properly instituted review, leaving open the publication-date issue.

The Motion cited several cases supporting the idea that supplemental information may be relevant to earlier publication. Indeed, this seems to be the most common usage of supplemental information. The final written decision decides publication dates, not the motion to submit supplemental information.

II. The Decision Misapprehended or Overlooked How the Petitioner Intends to Rely on the Supplemental Information.

The Motion explicitly stated that the earlier publications of Krassner and Badros contain “substantially and substantively identical” disclosure of the Krassner and Badros patents. Mot., 1. Each of the cases Petitioner cited, such as *Palo Alto* and

Hulu, concerned supplemental information, including earlier-published versions and supporting declarations, relevant to proving how an exhibit attached to a petition was prior art, despite not being 100% identical to a different version. The critical fact is whether the “invention” was published more than a year before the critical data, not that the exact version attached to the petition was so published.

Petitioner stated, “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,” which is consistent with the purpose of supplemental information. Mot., 4–5; *see generally Handi Quilter, Inc. v. Bernina Int’l AG*, Case IPR2013-00364, Paper 30, 2-3 (PTAB Jun. 12, 2014) (Supplemental information supports an argument on the merits). The Motion consistently argued that the supplemental information supported an earlier publication date for the invention of the Krassner and Badros patents. The grounds would not change because the disclosure was basically identical. The Patent Owner could argue, for example, that the differences between the pre-grant publications and issued patents were material, *i.e.*, the claim amendments included new matter. Petitioner simply acknowledged the fact that granting the Motion would not be an ultimate finding of fact. Rather, it is a statutory means for submitting relevant information post institution. 35 U.S.C. § 316(a)(3).

III. The Board Misapprehended or Overlooked that, as Here, Hulu's Later-Submitted Evidence Showed that Different Versions of Hulu's Evidence Were Published Earlier.

The *Hulu* case included a decision from the Precedential Opinion Panel (POP) concerning the standard for instituting review when it is unclear whether a publication constitutes prior art. *Hulu*, Paper 29 (“*Hulu* POP Dec.”). The POP stated there were several means for submitting additional evidence, including supplemental information or in reply to an argument from the Patent Owner. *Id.*, 14. The Petitioner in *Hulu* did not ask to submit supplemental information, but instead filed new evidence of earlier publication in its reply, much later in the proceeding. *Hulu*, Paper 66, 24. The Patent Owner in *Hulu* objected because it could not address the new evidence in its POR, as suggested by the POP. *Id.*; *see also*, *Hulu*, Paper 56, 4. Still, the panel said the evidence submitted in reply was timely. *Id.*, Paper 66, 24–26.

Here, Petitioner attempted to provide the evidence as soon as it realized the clerical error², giving Patent Owner even more time than in *Hulu*, *Valve*, and

² The undersigned clarifies that the clerical error was due to an associate failing to follow instructions to file the earlier-published versions of the same applications, and co-counsel missing that the error had not been fixed. Mot., 1; *see also*, 37 C.F.R. § 42.11. The earlier publications were not intentionally withheld, and

VidStream. The Petitioner in *Hulu* provided rebuttal evidence in its reply to demonstrate earlier publication. *Id.*, 29–33; *see also*, *Valve*, 8 F.4th at 1370 (FN6, different versions “are clearly relevant”); and *VidStream* 981 F.3d at 1064. If the Patent Owner had sufficient time to respond to new evidence in its sur-reply in *Hulu*, it is unclear why submitting supplemental information of earlier publication before the patent owner response is any different. In fact, the Patent Owner would have even more time and two opportunities to address the supplemental evidence/information.

IV. Allowing the Supplemental Information Will Not Interfere with the Mandate to Provide a Just, Speedy, and Inexpensive Proceeding.

The Decision did not dispute that Petitioner met the express requirements of Rule 123(a). Rather, the Board used its discretion to deny the motion. Dec., 5–6 (citing *Redline Detection, LLC v. Star Envirotech, Inc.*, 811 F.3d 435, 446 (Fed. Cir. 2015)). *Redline* is distinguishable because, first, unlike *Redline*, Petitioner never argued that the Board could not rely on discretion. Mot., 2. Also, *Redline* concerned a Petitioner requesting to submit an expert declaration that it intentionally omitted

Patent Owner has had the relevant substantive disclosures since being served with the Petition. Petitioner again apologizes for the inadvertent error and the additional work imposed on the Board.

from its petition. *Redline*, 811 F.3d, 443. There was no intentional delay in this case; it was a clerical error. Furthermore, the Federal Circuit has found that the Board’s discretion is not “unfettered.” *Ultratec, Inc. v. CaptionCall, LLC*, 872 F.3d 1267, 1274 (Fed. Cir. 2017) (reversing Board’s denial of a motion to submit supplemental information).

The Motion also explained that Office policy is that supplemental information does not interfere with the Board’s mandate to provide a just, speedy, and inexpensive proceeding. Mot., 5³. This is especially true, where as here, the Petitioner requests submitting supplemental information instead of submitting rebuttal evidence much later in the trial.

Here, the Petitioner explained (1) how the supplemental information was relevant; (2) how the Petitioner intends to rely on the information, and (3) how *Hulu* (and the cases it relies upon) are consistent with Office policy that supplemental information gives the parties sufficient time to address the issues. Moreover,

³ Citing, “Changes to Implement Inter Partes Review Proceedings, Post-Grant Review Proceedings, and Transitional Program for Covered Business Method Patents,” 77 Fed. Reg. 48680, 48707–08 (Aug. 14, 2012) (explaining how supplemental information within one month of institution allows patent owners sufficient time to address it).

allowing the supplemental information will (i) promote justice, as it will allow the Board to consider all relevant information relating to unpatentability, (ii) not affect the speed of the proceeding, as the published applications are substantially identical to the issued patents, and (iii) not cause greater expense to the Patent Owner who has known of the substantive disclosures of the prior art since being served with the Petition in May. Petitioner respectfully submits that any differences between *Hulu* and this case are immaterial⁴.

V. Conclusion

Accordingly, Petitioner requests reconsideration of the Decision denying entry of the supplemental information relevant to publication.

Respectfully Submitted,

Dated: October 24, 2023

/Kevin Greenleaf/
Kevin Greenleaf
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Reg. No. 36,456
Dated: October 23, 2023

⁴ See e.g., “Patented or Described in a Printed Publication,” Dennis Crouch, <https://patentlyo.com/patent/2012/01/patented-or-described-in-a-printed-publication.html> (January 4, 2012) (discussing how patents and textbooks are both printed publications.)

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing Petitioner's Request for Rehearing on the Decision Denying Supplemental Information Under 37 C.F.R. § 42.123(a) was served on October 24, 2023, via email on the following correspondence address of record for the Patent Owner.

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Respectfully Submitted,

Dated: October 24, 2023

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