

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*.

DECISION

Denying Petitioner's Request on Rehearing of
Decision Denying Petitioner's Motion to Submit Supplemental Information
37 C.F.R. § 42.71(d)

On September 20, 2023, Petitioner filed a Motion to Submit Supplemental Information Under 37 C.F.R. § 42.123(a). Paper 15 (“Motion” or Mot.”). On October 12, 2023, we entered a Decision denying Petitioner’s Motion. Paper 21 (“Dec.”). On October 24, 2023, Petitioner, filed a Request for Rehearing of our Decision. Paper 25 (“Request” or “Req.”). For the reasons explained below, Petitioner’s Request is denied.

I. BACKGROUND

On August 30, 2023, we entered a Decision Granting Institution of *Inter Partes* Review. Paper 9 (“Dec. on Pet.”). 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. on Pet. 10. In our Decision Granting Institution, 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 sought 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, after conducting a call with both parties’ counsel, we authorized briefing. Paper 14. On September 20, 2023, Petitioner filed its Motion seeking to add 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,”), 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”), 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.

II. REHEARING STANDARD

“A party dissatisfied with a decision may file a single request for rehearing without prior authorization from the Board.” 37 C.F.R.

§ 42.71(d). The burden of showing a decision should be modified lies with the party making the request and said party “must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.” *Id.* The Request does not identify anything misapprehended or overlooked by the Board.

The Request asserts that “the Decision seems to misapprehend or overlook the stated effect of the supplemental information.” Req. 2. Yet, far from establishing that assertion, the Request concedes that the Motion failed to state what the effect of the supplemental information would be. *See id.* (“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.” (emphasis added)); *see also* Dec. 6 (“[I]t 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.’).”).

The Request asserts that our Decision misapprehended or overlooked that the Krassner publication is identical to Krassner and the Badros publication is nearly identical to Badros. Req. 3. We did not. Those facts did not inform our Decision one way or another. Nonetheless, the Request argues that we misapprehended or overlooked that the supplemental information demonstrates that the inventions disclosed in Krassner and Badros were published earlier than the dates on which they issued. Req. 3. We did not. *See* Dec. 4 (“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.”).¹

The scope of prior art that can be asserted in *inter partes* reviews is limited to “prior art consisting of patents or printed publications.” 35 U.S.C. § 111(b). The Petition asserted two patents, Krassner and Badros. The Petition did not assert the Krassner publication or the Badros publication. The Krassner publication is a different document with a different publication date than Krassner. Likewise, the Badros publication is a different document with a different publication date than Badros.

¹ Exhibits 1015 and 1016 were expunged pursuant to our Decision.

III. CONCLUSION

For the forgoing reasons, Petitioner has not shown that we abused our discretion, or misapprehended or overlooked any persuasive arguments previously presented to the Office. Accordingly, the Request is denied.

IV. ORDER

In consideration of the foregoing, it is hereby
ORDERED that Petitioner's Request for Rehearing is denied.

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