

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
Conduct of the Proceeding
37 C.F.R. § 42.5

A conference call in the above proceeding was held yesterday, November 2, 2023, between respective counsel for the parties and the presiding panel. Patent Owner, Rich Media Club LLC, sought the conference call “to authorize the following discovery”:

- Deposition of Andy Batkin, Duration Media’s CEO, relating to the objective indicia of non-obviousness including copying and commercial success.
- Deposition of Joel Bock relating to the objective indicia of non-obviousness relating to copying matter from RMC’s patent (or patent application) in the submission of a later patent application for Duration Media.
- To address Duration Media’s objections regarding exhibits used at the deposition of Dr. Smedley, depositions of third parties to authenticate documents and demonstrate that they are not hearsay. These third parties include the Interactive Advertising Bureau (the IAB), the Media Rating Council (MRC), and Google.
- Discovery to address Petitioner’s objection to documents obtained from the Internet Archive/Wayback Machine[.]

Ex. 3002 (October 30, 2023, email from Patent Owner to Trials@uspto.gov and copying Petitioner). Petitioner, Duration Media LLC, opposes the discovery.

We did not authorize any discovery during the call, but we did authorize a motion to seek additional discovery. After discussion by both parties, the focus of additional discovery that would be the subject of the motion was limited to the first bullet point set forth in Patent Owner’s email and reproduced above.

Patent Owner’s motion must show “that such additional discovery is in the interests of justice.” 37 C.F.R. § 42.51(b)(2); *see also Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, No. IPR 2012-00001, Paper 26 at 6–7

(PTAB Mar. 5, 2013) (identifying factors indicative of this standard being met); *Palo Alto Networks, Inc., v. Juniper Networks, Inc.*, No. IPR2013-00369, Paper 36 (Feb. 5, 2014 PTAB) (applying the *Garmin* factors in deciding a motion seeking additional discovery of copying).

ORDER

In consideration of the foregoing, it is

ORDERED that Patent Owner may file a motion under 37 C.F.R. § 42.51(b)(2) for additional discovery; the motion shall not exceed five pages and shall be filed no later than November 6, 2023;

FURTHER ORDERED that Petitioner may file an opposition; the opposition likewise shall not exceed five pages and shall be filed no later than November 13, 2023; and

FURTHER ORDERED that a reply brief is not authorized.

FOR PETITIONER:

Kevin Greenleaf
Joel Bock
DENTONS US LLP
kevin.greenleaf@dentons.com
joel.block@dentons.com

FOR PATENT OWNER:

Ragnar Olson
David P. Berten
GLOBAL IP LAW GROUP, LLC
rolson@giplg.com
dberten@giplg.com