

Case No. IPR2023-00953

U.S. Patent 11,443,329

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 IPR2023-00953
U.S. Patent 11,443,329

**MOTION FOR LIMITED DISCOVERY FROM PETITIONER
PURSUANT TO 37 CFR § 42.51(b)(2)(i)**

Patent Owner seeks limited discovery from the Petitioner in the form of answers to the proposed interrogatories below relating to the objective indicia of non-obviousness of copying and commercial success:

Proposed Interrogatory 1: For each of the years 2018-2023, state your revenue from the sale of services relating to replacing a first ad on a webpage with a second ad upon a determination that the ad space including the first ad is in or near the portion of a webpage that is visible to the user.

Proposed Interrogatory 2: Given that Duration stopped using Rich Media Club's services in 2020, but continued to offer the same services including the same technologies that had been supplied by Rich Media Club/RealVu, describe how you replaced the following features of your services that had been provided by Rich Media Club/RealVu, and how the replacement technology was developed:

(1) a test for whether an ad space was in view; (2) tracking the time in view; and (3) triggering a real-time bidding auction to replace the in-view ad after a predetermined period of time.

Alternatively, similar questions would be asked of Duration's purported inventor of its U.S. Patent 11,195,210 and CEO, Andy Batkin, in a short deposition.

This discovery is in the interests of justice because there is more than a possibility and mere allegation that something useful will be discovered. As shown, these discovery requests that are not overly burdensome to answer.

A. Background Facts Relating to Copying and Commercial Success.

Petitioner Duration's 2021 press release states: "Duration Media was formed in

2018 by three experienced digital media executives whose primary goals were to address some of *the industry's most challenging problems*, namely *poor viewability* of advertising resulting in advertiser dissatisfaction, leading to the loss of ad revenues for publishers.” Ex. 2022 (emphasis added).¹ Unstated is that when Duration was formed in 2018, it had no solution to the “poor viewability” issue. Instead, in 2018, Duration contracted with a company affiliated with the Patent Owner, RealVu, Inc., which was set up to commercialize the technologies that the ’329 Patent taught and disclosed. Ex. 2025, Tchibirev Decl., ¶¶ 5-7. Under their “Cooperation Agreement” RealVu provided technical services to Duration, including “second print” ads, or replacement ads shown only after an ad space had been determined to be in view on an user’s browser. Ex. 2009. For example, Patent Owner had developed an overlay tool to show how its second print system worked and showed it to Duration, which used it during their relationship.

¹ Duration’s press release also evidences long-felt need and failure by others: ““The poor viewability of digital advertising across the entire ecosystem has been seen by advertisers as a serious issue, and one that has plagued the media industry since the beginning of digital advertising. Duration’s innovation [sic] clearly is a giant step forward for both publishers and advertisers alike,’ concluded Batkin.”

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U1

leaderboard desktop 1
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04:34:40: U2 right_rak_1 300x193@1072,1438 view?

04:34:40: U1 leaderboard_md_1 177x60@233,1146 view?

04:34:74: U2 gg-ekfrRequested

04:34:77: U5 gg-ekfrRequested

04:35:30: U1 gg-mend

04:35:51: U1 gg-mend

04:36:35: U2 gg-view

04:37:00: U1 gg-view

04:40:25: U1 gg-mend

04:40:26: U1 leaderboard_md_1 217x61@622,5242 read

04:42:32: U1 gg-view

04:43:34: U1 leaderboard_desktop_1 197x63@225,5 view

04:45:00: U1 gg-ekfrRequested

04:46:30: U1 gg-mend

04:47:32: U1 gg-view

Patent Owner's Solution Tracks	Duration Tracks
(1) each ad space (U1 in the overlay)	(1) each ad space (#1 in the copied overlay)
(2) total time the ad space is tracked;	(2) total time the ad space is tracked (t=02:37 in the copied overlay)

(3) total time the ad space is in view	(3) the total time the ad space is in view (vt=01:38 in the copied overlay)
(4) percent of the area in view	(4) the percent of the area in view (p=100% in the copied overlay)
(5) number of times the ad has rotated	
(6) times when the “second print” for slots were requested	(5) times when the “second print” for slot U1 were requested (e.g., “#1 728x90 Ad Request” in the copied overlay)

The look at feel of the tool also confirm that Duration copied it from Patent Owner.

Compare Ex. 2013 with 2014.

Consistent with its effort to copy technology that Duration was no longer buying from RMC, Duration also copied RMC’s *patent*. Remarkably, after learning the technology from RMC, Duration filed a patent application two years *after* starting work with RMC (and a decade after RMC’s patent was filed). Ex. 2005 (Patent No. 11,195,210). A CopyLeaks Plagiarism Report, showing that when the text of Rich Media’s patent is compared to the text of Duration’s patent, there is a 7.5% match, with 4.5% of the text plagiarized verbatim from Patent Owner’s patent. Ex. 2025; 2007; 2008.

Duration states on its website that “Duration Media’s software and VaaS™ (Viewability as a Service™) is protected by patents” and lists only the ’210 patent as covering those products. Ex. 2023. Not surprisingly given Duration’s copying of RMC’s patent, claim 1 of Duration’s ’210 patent is nearly identical in scope to claims 3 and 8 of RMC’s ’329 Patent. The Board can readily conclude that if

Duration's VaaS software is covered by Duration's '210 patent, it is also covered by claims 3 and 8 of RMC's '329 Patent, meaning that the nexus between the '329 Patent and Duration VaaS system is necessarily present.

Argument. As set forth in *Palo Alto Networks v. Juniper Networks*, 2013-00369 (Paper 36 p. 3): The Board considers various factors in determining whether additional discovery in an IPR is in the interests of justice. The factors include, but are not limited to, the following: (1) more than a possibility and mere allegation that something useful will be discovered; and (2) discovery requests that are not overly burdensome to answer.” *Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, IPR 2012-00001, Paper 26 at 6-7 (Mar. 5, 2013). Both factors are present here. Additional discovery will explain the extent and manner of the copying and is not overly burdensome to answer.

Similarly, a single interrogatory directed to learning how much money Duration generated both using RMC's technology and Duration's copy of that technology is both not unduly burdensome and the only way to discover the extent of Duration's commercial success with the patented technology. As Duration states, with its own emphasis, “we are focused on ONLY delivering HIGHLY viewable ad impressions to the market.” Ex. 2022. Two of its three revenue streams – “Viewability as a Service” and “The Duration Highly Viewable Ad Exchange” – are relevant. Duration should be able to identify its revenues from them.

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Respectfully submitted,

Dated: November 6, 2023

/Ragnar Olson/

Ragnar Olson

Reg. No. 58,684

Global IP Law Group, LLC

55 W. Monroe Street, Suite 3400

Chicago, IL 60603

Ph.: (312) 241-1503

Lead Counsel for Patent Owner

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on November 6, 2023, a complete and correct copy of the foregoing MOTION FOR LIMITED DISCOVERY FROM PETITIONER PURSUANT TO 37 CFR § 42.51(b)(2)(i) was served via electronic mail on the following counsel of record for Petitioner:

Kevin Greenleaf (Reg. No. 64,062)
Dentons US LLP
233 South Wacker Drive, Suite 5800
Chicago, IL 60606
Telephone: 650-798-0381
Email: kevin.greenleaf@dentons.com; ipt.docketchi@dentons.com

Joel Bock (Reg. No. 36,456)
Dentons US LLP
233 South Wacker Drive, Suite 5800
Chicago, IL 60606
Telephone: 212-398-8484
Email: joel.bock@dentons.com

/Ragnar Olson/
Ragnar Olson, Reg. No. 58,684
rolson@giplg.com
Global IP Law Group, LLC
55 W. Monroe Street
Suite 3400
Chicago, IL 60603