

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Duration Media LLC
Petitioner,

v.

Rich Media Club LLC
Patent Owner.

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

**OPPOSITION TO
MOTION FOR ADDITIONAL DISCOVERY**

I. Introduction

Patent Owner's motion for additional discovery (Mot.) fails to demonstrate that the discovery is necessary in the interest of justice under the *Garmin* factors. The Mot. also admits to already having the requested discovery.

II. RMC Did Not Show Nexus for Copying.

RMC made one conclusory statement allegedly showing nexus: "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." Mot. at 5. This is insufficient.

RMC did not compare its product to Duration's product, which is necessary to show copying. *Iron Grip Barbell Co., Inc. v. USA Sports, Inc.*, 392 F.3d 1317, 1325 (Fed. Cir. 2004) ("Not every competing product that arguably falls within the scope of a patent is evidence of copying. . . . Rather, copying requires the replication of a specific product."). RMC instead focused on copying of a patent, which is irrelevant under *Iron Grip*. See, *L'Oréal USA, Inc. v. Liqwd, Inc.*, No. PGR2017-00012, Paper 37 at 5–7 (Sept. 27, 2017). Accordingly, RMC did not meet its burden to demonstrate nexus. See e.g., *Palo Alto Networks, Inc., v. Juniper Networks, Inc.*, No. IPR2013-00369, Paper 36 (Feb. 5, 2014) (denying additional discovery when the Patent Owner failed to compare the relevant products to the challenged claims), and *Ashworth Bros., Inc., v. Laitram, L.L.C.*, No. IPR2020-00594, Paper 15 at 5–6

(Oct. 28, 2020) (rejecting suggestion that copying portions of a patent application constitutes evidence of secondary indicia). Accordingly, RMC's comparison of two patents does not satisfy the nexus requirement.

III. RMC Failed to Address the *Garmin* Factors.

The following is RMC's sole conclusion concerning the *Garmin* factors:

The [*Garmin*] 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.

Mot. at 5. RMC is incorrect that any factor is present here.

First, the Motion presents nothing more than a possibility and mere allegation that the discovery will be useful. RMC's alleges copying based largely on portions the '329 patent appearing in Duration's patent. Such copying is not unusual. Moreover, RMC expressly granted rights "to the facsimile reproduction by anyone of the patent document or the patent disclosure." Ex-1001, 1:37–38. Nevertheless, copying figures or text from a patent does not demonstrate secondary indicia.

Second, the Motion seeks Duration's non-infringement positions, *i.e.*, whether Duration's product is the same, but that is not the issue here. Such information is more consistent with district-court litigation where discovery is more expansive. *Inter partes* review was established to prevent these types of fishing expeditions.

Acco Brands Corp. v. Fellowes, Inc., No. IPR2013-00566, Paper 20 at 5 (Apr. 24, 2014); *see also*, 154 Cong. Rec. S99898 (daily ed. Sept. 27, 2008) (Legislative history showing that IPRs intend to avoid “fishing expeditions.”). RMC made no attempt to demonstrate copying via the source code, thus discovery of the development process is purely speculative as to whether it will yield anything useful.

Third, RMC admits that it already has most of the requested information. *See* Ex-2025, ¶¶ 7–17 (RMC’s CTO, Igor Tchibirev, testifying to his personal knowledge of how Duration’s system allegedly works and how to debug its system). Mr. Tchibirev found the “dm_debug” flag to view the “overlay” presumably because the source code is publicly available. *See e.g.*, Ex-1019 (showing publicly available source code for the Assassin’s Creed webpage), and <https://tag.durationmedia.net/sites/10651/dm.js>. Accordingly, RMC can use Mr. Tchibirev’s personal knowledge and publicly available source code to identify any alleged copying.

Fourth, RMCs proposal is difficult to understand and overly burdensome. RMC requests that Duration 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.” Mot. at 1. Product development occurs over many months of planning, analysis, design, implementation, and maintenance, performed by a team of developers and managers. RMC’s request a difficult-to-understand “fishing expedition.”

Regarding interrogatory 1, RMC already has substantial revenue information. RMC concedes its license to Duration existed during a two-year period from 2018–2020, and determining revenue was a part of that license. Ex-2009 at 3 (discussing fees relating to “Total Gross Revenue”). Accordingly, RMC already has much of the information it requests. Furthermore, RMC failed to demonstrate nexus between its product, the claimed invention, and alleged copying by Duration. Therefore, the revenue information is irrelevant without a showing of nexus, which RMC did not attempt to address.

Finally, any pressure on the Board to decide the motion quickly is due to RMC’s delay. RMC could have requested this discovery much earlier, even pre-institution. The secondary considerations issue has not changed since Duration filed the Petition. It is RMC’s burden to establish secondary considerations in its response due on December 6, 2023. *WMS Gaming v. Int’l Game Tech.*, 184 F.3d 1339 (Fed. Cir. 1999). It is not Duration’s burden to show that there was no copying. Duration reserves the right to address secondary indicia arguments in its reply, due on March 12, 2024, and during any deposition of the Mr. Tchibirev.

IV. Conclusion

Duration requests that the Board deny the motion because RMC failed to meet its burden to provide threshold evidence of nexus. Granting the motion would not be in the interest of justice for the reasons expressed above concerning the *Garmin* factors, and RMC's failure to address them sufficiently.

Respectfully Submitted,

Dated: November 13, 2023

/Kevin Greenleaf/
Kevin Greenleaf
Reg. No. 64,062
Joel Bock
Reg. No. 36,456

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing Opposition to the Motion for Additional Discovery and related exhibits were served on November 13, 2023, via email on the following correspondence addresses for the RMC's counsel of record and otherwise.

rolson@giplg.com
dberten@giplg.com
hsadler@giplg.com
arichards@giplg.com
kmartin@giplg.com

Respectfully Submitted,

Dated: November 13, 2023

/Kevin Greenleaf/
Kevin Greenleaf