

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

Granting In Part Patent Owner's Motion for Additional Discovery
37 C.F.R. §§ 42.51(b)(2)(i)

INTRODUCTION AND BACKGROUND

With our authorization (*see* Paper 27), Patent Owner, Rich Media Club LLC, filed a Motion for additional discovery pursuant to 37 C.F.R. § 42.51(b)(2)(i). Paper 29 (“Mot.”). The Motion seeks discovery from Petitioner, Duration Media LLC, in the form of answers to the following two proposed interrogatories:

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.

Mot. 1. Patent Owner bears the burden to “show that such additional discovery is in the interests of justice.” 37 C.F.R. § 42.51(b)(2)(i). For the reasons explained below, we grant the Motion in part.

DISCUSSION

Patent Owner argues that the proposed interrogatories “relat[e] to the objective indicia of non-obviousness of copying and commercial success.”

Mot. 1. Clearly, such information is potentially relevant to this *inter partes* review, in which Petitioner challenges all claims of the ’329 patent as obvious. Paper 1; *see Graham v. John Deere Co. of Kansas City*, 383 U.S.

1, 18 (1966) (“As indicia of obviousness or nonobviousness, these inquiries may have relevancy.”); *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 894 (Fed. Cir. 1984) (“Determining obviousness/nonobviousness under 35 U.S.C. § 103 involves factual inquiries into: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of nonobviousness, e.g., long felt need, *commercial success*, failure of others, *copying*, unexpected results.” (emphasis added; footnote omitted)). However, in order for evidence of objective indicia to be probative of non-obviousness, such evidence “must have a ‘nexus’ to the claims, i.e., there must be ‘a legally and factually sufficient connection’ between the evidence and the patented invention.” *Henny Penny Corp. v. Frymaster LLC*, 938 F.3d 1324, 1332 (Fed. Cir. 2019).

Patent Owner argues that the discovery its Motion seeks is in the interests of justice because there is more than a possibility that something useful will be discovered and the interrogatories are not overly burdensome to answer. Mot. 5 (citing *Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, No. IPR2012-00001, Paper 26 (“*Garmin*”) at 6–7 (Mar. 5, 2013) (informative)). Petitioner argues to the contrary and additionally argues that the Motion fails to address other factors outlined in *Garmin* and that these additional factors support denying the Motion. Paper 31 (“Opp.”), 2–4.

Patent Owner argues, and Petitioner has not disputed, that Petitioner was formed in 2018. Mot. 1–2 (quoting Ex. 2022).¹ Patent Owner further argues, and Petitioner has not disputed, that also in 2018 Petitioner “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.” Mot. 2 (citing Ex. 2025 ¶¶5–7).² Patent Owner argues, and Petitioner has not disputed, that, pursuant to the contract (“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 a[] user’s browser.” Mot. 2 (citing Ex. 2009).³ Patent Owner points out that Petitioner’s own website states 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.” Mot. 4 (citing Ex. 2023⁴ and referring to Petitioner’s U.S. Patent No. 11,195,210 B2, which is Ex. 2005). Patent Owner argues that

¹ Exhibit 2022 appears on its face to be a press release by Petitioner. *See also* Ex. 2025 ¶ 22 (“Exhibit 2022 . . . is a true and correct copy of the webpage at the url: <https://durationmedia.net/press/>.”).

² Exhibit 2025 is a declaration by Igor Tchibirev, the Chief Technology Officer of Patent Owner. Ex. 2025 ¶ 3.

³ Exhibit 2009 was filed provisionally under seal along with a motion to seal, which is pending. Paper 28. Patent Owner’s instant Motion and Petitioner’s Opposition thereto both were filed publicly and discuss certain aspects of Exhibit 2009. Mot. 2; Opp. 4. We discuss Exhibit 2009 only to the extent it has been publicly discussed by either party.

⁴ Exhibit 2023 appears on its face to be a print out of a webpage belonging to Petitioner. *See also* Ex. 2025 ¶ 22 (“Exhibit 2023 . . . is a true and correct copy of the [webpage at the] url: <https://durationmedia.net/patent-information/>.”).

“claim 1 of Duration’s ’210 patent is nearly identical in scope to claims 3 and 8 of RMC’s ’329 Patent.” Mot. 4 (citing Ex. 2023). Thus, Patent Owner concludes “nexus between the ’329 Patent and Duration VaaS system is necessarily present.” Mot. 5.

Petitioner argues that Patent Owner’s attempt to establish nexus “is insufficient” because Patent Owner “did not compare its product to Duration’s product, which is necessary to show copying,” and “instead focused on copying of a patent, which is irrelevant under *Iron Grip*,” *Barbell Co., Inc. v. USA Sports, Inc.*, 392 F.3d 1317, 1325 (Fed. Cir. 2004). Opp. 1. This argument is not persuasive for a couple reasons.

First, as a matter of fact, Patent Owner does provide direct comparison between Petitioner’s product and that of Patent Owner’s affiliate. *See* Mot. 3–4; Ex. 2013; Ex. 2014. Petitioner’s arguments to the contrary are erroneous.

Second, Petitioner’s argument conflates nexus, which applies to objective indicia generally, with a further requirement specific to copying.

Nexus is required for objective indicia evidence generally in order for it “[t]o be accorded substantial weight in the obviousness analysis.” *Henny Penny*, 938 F.3d at 1332.

As objective indicia, copying requires a showing (or presumption) of nexus. In addition, “[c]opying requires duplication of features of the patentee’s work based on access to that work, lest all infringement be mistakenly treated as copying.” *Liqwd, Inc. v. L’Oreal USA, Inc.*, 941 F.3d 1133, 1137 (Fed. Cir. 2019); *see also Iron Grip Barbell*, 392 F.3d at 1325 (“Not every competing product that arguably falls within the scope of a patent is evidence of copying. Otherwise every infringement suit would

automatically confirm the nonobviousness of the patent. Rather, copying requires the replication of a specific product.”).

“Evidence of copying may include internal documents, direct evidence such as photos of patented features or disassembly of products, or access and similarity to a patented product.” *Liqwd*, 941 F.3d at 1137 (citing *Iron Grip Barbell*, 392 F.3d at 1325). Patent Owner has put forth evidence showing that Petitioner had access to Patent Owner’s patented technology from 2018 through 2020 pursuant to the Cooperation Agreement and further that Petitioner’s software is similar to that of Patent Owner’s affiliate. *See* Mot. 3–4; Ex. 2013; Ex. 2014.

Garmin identifies five factors that are relevant to a motion for additional discovery under 37 C.F.R. § 42.51(b)(2)(i). *Garmin* at 6–7.

With respect to *Garmin* factor 1, and for reasons already discussed, Patent Owner has demonstrated “possession of evidence tending to show beyond speculation that in fact something useful will be uncovered” by its discovery requests. *Garmin* at 6.

With respect to *Garmin* factor 2, Petitioner argues that “the Motion seeks Duration’s non-infringement positions, i.e., whether Duration’s product is the same, but that is not the issue here.” Opp. 2. We discern this argument as relating only to Proposed Interrogatory 2. In any event, it is not persuasive. Although Petitioner’s product is relevant to infringement, which is not at issue here, Petitioner’s product is also relevant to Patent Owner’s argument that Petitioner’s alleged copying is probative of obviousness. Indeed, Petitioner concedes as much, in arguing that Patent Owner allegedly “did not compare its product to Duration’s product, which is necessary to show copying.” Opp. 1.

With respect to *Garmin* factor 3, Petitioner argues that Patent Owner “admits that it already has most of the requested information.” Opp. 3.

As for Proposed Interrogatory 1, Petitioner argues that Patent Owner “already has substantial revenue information . . . from 2018–2020.” Opp. 4. What Patent Owner has requested, however, is a statement of annual revenue generated by the specified services *through 2023*. Further, it is unclear what Patent Owner allegedly already has from 2018–2020. Petitioner characterizes it as “substantial revenue information” but does not identify any actual information; it simply cites to page 3 of Exhibit 2009 with no explanation. Opp. 4.

As for Proposed Interrogatory 2, Petitioner argues that Patent Owner’s Chief Technology Officer, Igor Tchibirev, has “personal knowledge of how Duration’s system *allegedly* works and how to debug its system.” Opp. 3 (emphasis added). It is true that Mr. Tchibirev testifies to having significant personal knowledge of Duration’s “copied technology.” *See, e.g.*, Ex. 2025 ¶14. However, Petitioner hedges on whether Mr. Tchibirev’s testimony regarding how Duration’s system works is accurate. *See* Opp. 3 (“allegedly”). As discussed below in the context of *Garmin* factors 4 and 5, we modify Proposed Interrogatory 2 to narrow the information being sought.

With respect to *Garmin* factors 4 and 5, Petitioner argues Proposed Interrogatory 2 “is difficult to understand and overly burdensome” because it asks for a description of “*how* [Petitioner] replaced . . . features of [its] services that had been provided by Rich Media Club/RealVu, and how the replacement technology was developed.” Opp. 3 (emphasis added). Petitioner explains that “[p]roduct development occurs over many months of planning, analysis, design, implementation, and maintenance, performed by

a team of developers and managers.” *Id.* We agree that Patent Owner’s Proposed Interrogatory 2 is too broad, given the stated justification therefor, which is alleged copying. We modify it as follows:

Modified Interrogatory 2: State whether Duration, after it stopped using Rich Media Club’s services in 2020, continued to offer the same services including the same technologies that had been supplied by Rich Media Club/RealVu; and identify any and all changes that were made to the following features of Duration’s services after Duration stopped using Rich Media Club’s services in 2020: (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.

CONCLUSION

Patent Owner has shown that the discovery it seeks, as narrowed by us, is in the interests of justice.

ORDER

Accordingly, it is

ORDERED that Patent Owner’s Motion for additional discovery (Paper 29) is granted in part, as described above; and

FURTHER ORDERED that the parties shall and meet and confer to agree on a reasonable deadline for Petitioner to answer Proposed Interrogatory 1 and Modified Interrogatory 2.

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