

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

IPR2023-00953

Motion to Strike

Petitioner requests that the Board strike or refuse to consider 44 pages of claim charts (Exs. 2046–2049), submitted with the POR, and conclusory statements that improperly incorporate them by reference. 37 C.F.R. § 42.6 (a)(3). The OCR’d claim charts (with headers/footers removed) comprise ~20,000 words—with excessive images of text—more than doubling the 13,744-word POR (Paper 35). It would be prejudicial to require Petitioner to address essentially two PORs in a 5,600-word reply, as would limiting arguments to one per claim.

The POR contains three mere conclusions citing Exs. 2046–2049: The claim charts **“show[] how Duration’s product practice [*sic*] the claimed invention.”** (POR, 37); They show **“how both its own service and the services provided by Duration are covered by the claimed inventions (and indeed, are coextensive with them). [...] RealVu’s content rendering and control technology embodies the claimed invention and is coextensive with it.”** (*Id.*, 52); and **“Duration’s products embody the claimed invention and are coextensive with it.”** *Id.*, 54.

The expert declarations make the same superficial conclusions: **“[T]he claim charts confirm[] that this revenue was generated using the ‘second print’ system that is co-extensive with what is claimed in the ’329 claims, all of this commercial success is attributable to use of a system and method as claimed.”** (Ex-2045, ¶94) **“[T]he claim charts [...] confirm that they accurately describe the operations of both the RealVu Content Rendering and Control**

system and Duration Media’s products relating to second print ads.”

(Ex. 2026, ¶7). The attorney argument exists only in the claim charts.

Incorporating attorney argument from exhibits violates Rule 42.6 (a)(3).

The Federal Circuit consistently upholds the Board’s decisions to strike or refuse to consider arguments that are not made in principle briefs. *See e.g., 3M Co. v. Evergreen Adhesives, Inc.*, 860 F. App’x 724, 727–28 (Fed. Cir. 2021) (affirming denial of rehearing due to arguments in briefs being “skeletal”); *Gen. Access Sols., Ltd. v. Sprint Spectrum L.P.*, 811 F. App’x 654, 658 (Fed. Cir. 2020) (affirming Board’s decision to not consider evidence supporting conclusions in a POR). “Judges are not like pigs, hunting for truffles buried in briefs.” *Parus Holdings, Inc. v. Google LLC*, 70 F.4th 1365, 1371–72 (Fed. Cir. 2023) (internal citation omitted). The Board may “strike or not consider submissions that exceed the page limits” because petitioners also do not root for truffles. *Id.*

Board policy and precedent support striking arguments now. *See e.g.*, Patent Trial and Appeal Board Consolidated Trial Practice Guide, 80–81 (“A motion to strike may be appropriate when a party believes the Board should disregard arguments.”); and *Apple v. Parus Holdings*, IPR2020-00686 Paper 37, 31 (PTAB April 7, 2017) (motion to strike is the proper vehicle for addressing incorporation by reference). The Board may alternatively refuse to consider the improperly incorporated exhibits. *See e.g., IBG LLC v. Trading Techs. Int’l, Inc.*, CBM2016-

00054, Paper 38 (PTAB April 7, 2017) (citing *Cisco Systems, Inc. v. C-Cation Technologies, LLC*, IPR2014-00454, Paper 12 (PTAB Aug. 29, 2014) (informative)). *IBG* concerned a similar situation: a motion to strike a claim chart concerning secondary indicia. *Id.*, 1–3. The Board held that it wouldn’t consider conclusory references to claim charts like those here. *Id.*

The Board only denies motions to strike when the arguments are briefed sufficiently. *3M Co.*, 860 F. App’x, 726. Here, in contrast, the incorporation-by-reference is beyond dispute. All the “analysis” is only in the claim charts. The few sentences in the POR are inadequate and require the extra ~20,000 words. *Id.*

Delay until the FWD would compel the 5,600-word reply to address over 30,000 words of analysis in the POR and claim charts; plus three declarations, two of which also improperly incorporate arguments by reference. Patent Owner’s counsel stated that they reviewed the Board’s rules and should have known that the POR did not comply. Exs. 2001–2003 (*pro hac vice* decls.), ¶9. Petitioner respectfully requests that the Board strike or refuse to consider the prejudicial claim charts, improperly incorporated by reference. 37 C.F.R. § 42.6 (a)(3).

Dated: January 10, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing Petitioner's Motion to Strike has been served on all parties via email on January 10, 2024.

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