

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

**PATENT OWNER'S OPPOSITION
TO PETITIONER'S MOTION TO STRIKE**

Concerns over “incorporation by reference” typically arise when Petitioners improperly rely on invalidity charts that include arguments not set forth in the Petition. *E.g.*, *Cisco Systems v. C-Cation Tech.*, IPR2014-00454 (Aug. 29, 2014). But the Board has repeatedly allowed claim chart evidence used, as here, to establish nexus. *E.g.*, *Weatherford v. Packers Plus Energy Servs.*, IPR2016-01509, *6 (Apr. 3, 2018) (“with respect to nexus and secondary considerations, we credit Mr. McGowen's testimony *and claim charts* at Exhibit A”); *Tekni-Plex, Inc. v. Converter Mfg.*, IPR2021-00916, *26 (Oct. 20, 2022) (“Patent Owner purports to show nexus by providing a table prepared by Mr. Clements that lists in one column a Roll Over-Wrap Tray Product and in a second column the claims of the ’281 patent corresponding to that product. *Id.* (citing Ex. 2007 ¶¶ 228–232, Appendix, A1–175). Mr. Clements provides claim charts showing how various products embody various claims of the ’281 patent. Ex. 2007, A1–A175.”).

In *Polygroup Limited v Willis Electric*, IPR2016–01610 and -01612, (Feb. 26, 2018) (FWD) Patent Owner submitted EX2247, a **522**-page infringement claim chart. In EX2090 pp.101-102 Patent Owner’s expert Brown compared Petitioner’s, and others’ products, to the patent claims, relying on EX2247 and other chart exhibits. That POR, at pages 93-94 argued: “Dr. Brown provides claim charts identifying each and every element of the inventions as claimed in representative Polygroup products. (*Id.*; Ex. 2247.)” and “Willis’s products also

practice the independent claims of the '186, and have been charted to show a nexus between their sales and the claims.” The PTAB denied the motion to exclude the claim charts. The actual claim chart 2247 from that case was deemed admissible.¹

Here, Patent Owner was following Board precedent by providing claim chart evidence to demonstrate nexus, having witnesses verify the content of the charts, and the POR cited the testimony. Granting the motion to strike would essentially create a “catch 22” situation: the Patent Owner is required to demonstrate nexus, but is preventing from using claim charts to do so. The Board has avoided this in the past by repeatedly allowing the use of claim chart evidence to show nexus.

Petitioner’s concern that it needs to respond to many additional words in the charts is misplaced. The charts contain (1) the claim language (2,352 words); (2) screen shots of Petitioner’s and Patent Owner’s systems; and (3) an “analysis” column that largely parrots the claim language and the screenshots’ content. They are largely repetitive and focus on systems well known to the Petitioner; they certainly do not add “~20,000 words” of *argument*.² The Petitioner need only explain how its system and Patent Owner’s does not meet a claim element. While

¹ This sentence from the POR ending with: “as demonstrated in claim charts showing how Duration’s product practice the claimed invention. EX2047-EX2049” can be stricken without effect.

² If concerned the “analysis” adds argument, the Board can strike just that column.

it takes repetitive evidence to show infringement of each claim element of multiple claims by multiple systems; trying to show non-infringement is far less wordy.

Here, Patent Owner has followed the PTAB's guidance. EX2026 is the declaration from Patent Owner's employee Tchibirev in which he states ¶ 7 that the claim charts at exhibits 2046-49 accurately describes the operations of both the RealVu Content Rendering and Control system and Duration Media's products relating to second print ads. In Exhibit 2015 ¶¶ 93-94 expert Sherwood opines that the claim charts confirm that certain revenue was generated using the "second print" system that is co-extensive with the '329 claims, citing EX2047-2049. That the claim charts were not pasted into the declarations does not matter given no size limitations on the declarations. The POR p. 53, in: "Nexus and Commercial Success of RMC's products," argues: "Realvu's content rendering and control technology embodies the claimed invention and is coextensive with it. EX2026 [Tchibirev], EX2045, ¶ 94 [Sherwood], EX2046 [claim chart]." The POR p. 53, "Nexus and Commercial Success of Duration's products," argues: "Whether it was using RealVu's content rendering and control product or its own copy of that product, Duration's products embody the claimed invention and are coextensive with it. EX2026, EX2045, ¶ 93-94, EX2047-EX2049."

Opposition
IPR2023-00953 (U.S. Patent 11,443,329)

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Respectfully submitted,

/Ragnar Olson/

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on January 17, 2024, a complete and correct copy of the foregoing PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION TO STRIKE was served via electronic mail on the following counsel of record for Petitioner:

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