

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*.

ORDER

Granting In Part Petitioner's Motion To Strike Exhibits 2046–2049 Or, In
the Alternative, To Have Exhibits 2046–2049 Not Considered
37 C.F.R. § 42.5

With our authorization (*see* Paper 41), Petitioner filed a Motion to have us “strike or refuse to consider” Exhibits 2046 through 2049. Paper 44 (“Mot.”). Patent Owner filed an Opposition to the Motion. Paper 45 (“Opp.”). We grant the Motion in part.

Exhibits 2046 through 2049 are claim charts submitted by Patent Owner. The Patent Owner Response cites to the exhibits as “demonstrating how both [Patent Owner’s] own service and the services provided by [Petitioner] Duration are covered by the claimed inventions (and indeed, are coextensive with them).” Paper 42 (“PO Resp.”), 53.¹

Petitioner argues that the Patent Owner Response “contains three mere conclusions” citing to the exhibits, which, in turn, contain argument, and thus the citation to the exhibits violates our prohibition on incorporation by reference. Mot. 1–2; *see* 37 C.F.R. § 42.6(a)(3) (“Arguments must not be incorporated by reference from one document into another document.”).

Petitioner argues the claim charts collectively “comprise ~20,000 words—with excessive images of text.” Mot. 1. We agree with Petitioner that the exhibits contain *some* argument. However, we disagree with the magnitude with which Petitioner has characterized the problem, and we tailor the relief accordingly.

In its Opposition, Patent Owner disputes that the claim charts are entirely, or even substantially, comprised of argument and asks us to consider the actual content of the claim charts. *See, e.g.*, Opp. 2 (“The

¹ There are two versions of the Patent Owner Response on file. One version is Paper 35 and is provisionally sealed pending a motion to seal. The other is Paper 42 and is partially redacted but publicly available. We cite to the publicly available copy.

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.''). Patent Owner's characterization of the claim charts is fair.

Each claim chart contains three columns, labeled from left to right: "Claim [no.]," "Analysis," and "Select Evidence." *See, e.g.,* Ex. 2046. The "Claim [no.]" column reproduces claim language and lacks argument. The "Select Evidence" contains evidence largely in the form of screenshots. *See, e.g.,* Ex. 2046, 1 ("Source: <https://www.realvu.com/realvu-technology-patented-crc/>"). The "Analysis" column characterizes how the evidence purportedly meets the claims language and thus contains argument. *See, e.g.,* Ex. 2046, 2 (arguing "RealVu determines whether a predefined area of an ad content display page that is used to display an advertisement is in view within a visible area of a browser window of a browser configured to be operated by a remote computing device").² Patent Owner argues that each analysis column "largely parrots the claim language and the screenshots' content" but does not dispute that it contains argument. Opp. 2. It does. In fact, Patent Owner offers that, "[i]f concerned the 'analysis' adds argument, the Board can strike just that column." *Id.* n.2. We appreciate this reasonable concession. However, we will not strike the "Analysis" columns of the claim charts; instead, we will not consider them.

Petitioner cites *IBG LLC v. Trading Techs. International, Inc.*, No. CBM2016-00054, Paper 38 (PTAB April 7, 2017) ("*IBG*"), as having

² According to Patent Owner, RealVu, Inc., is "a related company" that was "established" by Patent Owner. PO Resp. 21.

“concerned a similar situation: a motion to strike a claim chart concerning secondary indicia.” Mot. 3. Notably, the Board did not strike the claim charts at issue in *IBG*. See *IBG* at 4. (“We . . . are not persuaded by Petitioner that the proper remedy is to strike or expunge [the claim charts.]”) Instead, the Board in *IBG* held that it would not consider any arguments contained in the claims charts that are not also in the patent owner’s briefs. See *id.* (“The appropriate remedy is for us not to consider such arguments. Petitioner will not be prejudiced by arguments that are not considered. We, thus, will not consider any arguments that are not adequately explained in the PORs, themselves.” (citation omitted)).

Here, we determine the appropriate remedy is the same as in *IBG*. We will not consider the “Analysis” column of any of the claim charts filed as Exhibits 2046 through 2049.

ORDER

In consideration of the foregoing, it is
ORDERED that Petitioner’s Motion is granted in part;
FURTHER ORDERED that the Board will not consider the
“Analysis” column of any of Exhibits 2046 through 2049.

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