

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

Case IPR2023-00953

Filing Date: May 11, 2021

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Title: System And Method For Creation, Distribution And tracking Of Advertising
Via Electronic Networks

Petitioner's Reply to the Patent Owner Response

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LIST OF EXHIBITS

Ex. No.	Description
1001	U.S. Patent No. 11,443,329 (“’329 Patent”)
1002	U.S. Patent No. 10,380,602 to Krassner et al. (“Krassner”)
1003	U.S. Patent No. 7,725,502 (“Badros”)
1004	U.S. Patent Application No. 20080221982 (“Harkins”)
1005	– Intentionally Blank –
1006	File History for ’329 Patent
1007	File History of U.S. Patent Application No. 12/384,403 (“’403 App.”)
1008	File History of U.S. Patent Application No. 11/643,245 (“’245 App.”)
1009	Declaration of Trevor Smedley, Ph.D.
1010	C.V. of Trevor Smedley, Ph.D.
1011	Document compare of specification of the ’090 Patent with the specification of Krassner
1012	Docket Navigator Judge John J Tuchi Statistics
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1015	U.S. Patent No. 11,004,090 (“’090 Patent”)
1016	Expunged
1017	U.S. Patent Application No. 20070265923 (“Krassner I”)
1018	Badros WIPO
1019	Screenshot of publicly available Assassin’s Creed Webpage source code
1020	Igor Deposition transcript
1021	Alan Edwards Deposition Transcript
1022	Robert Sherwood Deposition Transcript
1023	EMPTY
1024	<i>Nunc pro tunc</i> assignment
1025	US Patent No. 7,567,916 (“Koeppel”) (titled “System and method for performing Web based in-view monitoring,” priority 2000)
1026	Declaration of Michele Madansky, Ph.D.
1027	Second Declaration of Trevor Smedley, Ph.D.
1028	US Patent No. 6,317,782 (“Himmel”) (titled “Method and apparatus for detecting actual viewing of electronic advertisements,” priority 1998)
1029	US pub. no. 20080222503 (“Sandige”) (titled “Rendering of two-dimensional markup messages,” priority 2007)
1030	US pub. no. 20060155615 (“Loo”) (titled “Object placement within computer generated multidimensional environments,” priority 2005)
1031	DDE-1-11-cv-00235-440 (Sherwood Daubert)

1032	JavaScript - Wikipedia.pdf
1033	Overview of Viewability and Active View - Google Ad Manager Help
1034	US Patent No. 5,778,372 ("Cordell")
1035	US Patent No. 6,418,470 ("Blumenau") (titled "Metering of internet content using a control," priority 1998)
1036	ComScore v. MOAT complaint
1037	US Patent No. 8,135,616 ("Callaghan") (titled "Browsing and quality of service features")
1038	Audience 2.0_ Time - Alenty - Web 2.0 Marketing
1039	Alenty analyzes the visibility of advertisements on the Internet
1040	AppNexus Buys Paris-Based Viewability Firm Alenty
1042	Need the list of Auditors for MRC accreditation. adops
1043	Moat Accreditation
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1047	C.V. of Dr. Michele Madansky
1048	MRC Announces Changes to Accreditation Statuses of Comscore Digital Measurement Products
1049	Ad Formats: from concept to award winning
1050	DoubleVerify Raises \$10 Million in Series B Funding _ DoubleVerify
1051	IAB_Internet_Advertising_Revenue_Report_Full_Year_2021
1052	Programmatic Ad Revenues Totaled \$10.1 Billion in 2014, According to First-Ever IAB Programmatic Revenue Report
1053	Previous Declaration of Robert Sherwood from CBM2014-00094, Ex-1020
1054	3MS Initiative Releases Five-Part Digital Marketing Measurement Solution
1055	A History Of Programmatic And The Era Of Control _ AdExchanger
1056	MRC-Viewable-Ad-Impression-Measurement-Guideline

I. INTRODUCTION

The Patent Owner Response (“POR”) fails to 1) demonstrate that Badros’ disclosure of “actually in view” does not mean what it says, 2) demonstrate that Badros does not enable a so-called “viewability test,” and 3) demonstrate common ownership to overcome the Krassner-based grounds under § 103(c).

Patent Owner argues that the “viewability test” is expressly claimed as “(b) in response to a determination that the predefined area that is used to display the advertisement has been in view within the visible area of the browser window for a predefined period of time.” POR, 3. This is Badros’ main purpose:

[I]f several documents are intended to be actually displayed to a user for five seconds each before switching to the next document, then impression module may keep track of the amount of time that each document is actually output on a user’s computer monitor 10. The impression module 38 may prevent the display of a subsequent document until a first document has received its full “true” impression time.

Ex-1003, 12:50-57. This and the several similar statements in Badros present an extremely strong *prima facie* case of obviousness.

Patent Owner’s nearly 30-page secondary indicia arguments cannot overcome the strong showing of obviousness. *Intercontinental Great Brands LLC v. Kellogg N. Am. Co.*, 869 F.3d 1336, 1351 (Fed. Cir. 2017) (“the showing of obviousness is sufficiently strong that no PTO contrary determination could alter

the conclusion about summary judgment.”) Moreover, many of Patent Owners arguments rely on speculation and innuendo, unsupported by actual evidence.

II. BADROS ALONE OR IN COMBINATION WITH HARKINS RENDERS THE CLAIMS OBVIOUS

A. Patent Owner's Expert Agrees that Badros Discusses “Viewability” and Is Not Limited to “Served Impressions.”

Patent Owner's expert conceded the obvious: Badros' unambiguously discloses using a viewability test: “determin[ing] whether an ad on a web page of a user's browser is actually visible to the user.” Ex-1003, 12:39-41; Ex-2045, ¶113; Ex-1022, 39:18-41:14, 54:25-58:16 (“...Badros discussed Viewability...”), 65:13-67:1, 67:25-68:4. These citations teach the viewability test (Pet., 22-28 and 34-40) as Patent Owner defines it: “(b) in response to a determination that the predefined area that is used to display the advertisement has been in view within the visible area of the browser window for a predefined period of time.” *Id.*, POR, 3.

Badros expressly distinguished its “actually visible” method from served impressions:

The number of “actual” (e.g., verified) impressions **may be distinguished** from the number of times a document was output to client terminal. Also, the actual time during which a document was visible on a monitor may be stored.

Ex-1003, 15:4-8 (emphasis added); *see also*, 1:42-44, 11:24-34, and 14:10-45.

Patent Owner's argument that “One of skill in the art would have understood the

discussion of viewability in Badros as referring to a served impression” is not credible because Badros expressly distinguishes its “actually visible” test from served impressions. *Id.*, POR, 14.

Dr. Smedley agrees with the analysis of the Petition that Badros teaches “mak[ing] a determination that the predefined area that is used to display the advertisement has been in view within the visible area of the browser window for a predefined period of time.” Ex-1027, ¶¶7-26. The POR falsely stated that Dr. Smedley “does **not** believe Badros teaches” the limitation. POR, 4. Rather, Patent Owner quoted testimony that Dr. Smedley’s declaration did not expressly give an opinion on that limitation. *Id.* (citing Ex-2050, 50:22-52:19). To the extent Badros itself is unclear, Patent Owner can depose Dr. Smedley again based on his rebuttal of the false statement.

B. Badros Enables Viewable Impressions by Using Both Client- and Server-Side Components

Badros’ system and method teach running auctions to “time-multiplex” (*i.e.*, replace) advertisements using well-known client-side JavaScript, which should be obvious if not inherent. Ex-1003, 13:8-27, 14:20-31, and 11:22-34. The parties agree that *only* way to accomplish this feature is to have “a timer at the user computer.” *Id.*, 23:61-62; Ex-2026, ¶14; Ex-2045, ¶69; Pet., 27, 38-39.

Accordingly, Badros expressly, inherently, and obviously discloses “client-side timers” to replace ads. Ex-1003, 23:61-62. Badros’ disclosed client-server

architecture works the same way as any web page since they were invented in the early '90's. Ex-1027, ¶19. All HTML websites work by storing code on servers (e.g., a combination of HTML and JavaScript) that they transmit to browsers on client computers to render webpages. *Id.* ¶¶19-20. Therefore, a person of ordinary skill in the art would have understood that any document discussing websites necessarily included server-stored code transmitted to client-side browsers. *Id.*

Petitioner repeatedly cited and explained that Badros uses the ubiquitous client-server web architecture. For example, the “User module may pass information to and receive information from (or about) displays and users, e.g., directly or indirectly through providers. [Ex-1003], 12:48-66; *see also*, Ex-1009, ¶69.” Pet., 35-36; *see also*, pp. 23, 30, 43; and Ex-1003, 11:22-34 (“an ads allotted duration may be tolled according to viewable time instead of absolute time.”)

In some embodiments, user module 40 may cause code to be downloaded and/or executed on a user computer 10 or display device 18. ... user module 40 may cause a time-multiplexing program or system (e.g., similar to that described for server 2) to exist and run on a user computer. ... [U]ser module 40 may pass code to an output terminal Such as JavaScript (or other 25 client-side Support), wherein the JavaScript Switches the document source based on client-side timers.

Ex-1003, 13:8-27.

For instance, one or more advertisements may be rotated according to viewable time instead of absolute time. In these embodiments, time during which the document space is not viewable on the user's computer may not be tolled against the time for a current ad or other document.

Id., 14:20-31. Mr. Tchibirev agrees that Badros discloses client-side code. Ex-1020, 59:18-60:1; Ex-1027, ¶21. Petitioner's theory has consistently been that Badros teaches using auctions to replacing ads on web browsers that are inherently, or at least obviously, on client computers. Pet., 35-36

Viewability tests were well known for well over a decade prior to the '329 patent's priority date. Koeppel, for example, demonstrates that the "viewability" problem was known as early as 2000: "A disadvantage to this conventional process is that advertisement servers may be billed for banners that are never seen by a user browsing a rendered Web page." Ex-1025, 3:67-4:2. Koeppel, titled "system and method for performing web based in-view monitoring," provides a detailed algorithm for "in-view monitoring." *Id.*, 14:7-18:25, and FIGS. 9A-C; *see also*, Ex-1028 (titled "Method and apparatus for detecting actual viewing of electronic advertisements"); Ex-1025, (titled "System and method for performing Web based in-view monitoring"); Ex-1029, ¶62 ("To provide greater accuracy in advertising metrics, may supplement the existing server-based web-page advertisement metrics and tracking with detailed accurate client viewability information."); Ex-1035,

6:20-24 (“as the metered content is scrolled into or out of view, the control 106 maintains, for example, a counter of the on-screen exposure time of the metered content.”); *see also*, Ex-1036, ¶¶33-38 (complaint alleging “Ad Viewability” product infringed Ex-1035). One prior art publication describes “time visible” as a “common metric” for advertising in 2005. Ex-1030, ¶4. These references are unnecessary for demonstrating obviousness; instead, they demonstrate that the state-of-the-art enabled the POSA to develop viewability tests. Indeed, both inventors testified that they did not invent viewability *per se*; they instead invented what they called “geometric viewability.” Ex-1020, 49:12-50:12; Ex-1021, 13:13-14:10. Accordingly, both inventors and Mr. Sherwood admit that viewability was known prior to the priority date of the ’329 patent. *Id.*

Determining whether a window was in view was well known when Badros was filed. Accordingly, Patent Owner has not satisfied its burden to prove nonenablement. *Analog Devices, Inc. v. Xilinx, Inc.*, No. IPR2020-01596, 2022 WL 1157604, at *14 (PTAB April 13, 2022) (“[R]egardless of the forum, prior art patents and publications enjoy a presumption of enablement, and the patentee/applicant has the burden to prove nonenablement.”) (Internal citation omitted). RMC relies on *Raytheon Techs. Corp. v. Gen. Elec. Co.*, 993 F.3d 1374, 1382 (Fed. Cir. 2021), to argue that Badros is non-enabled. Here, however, computer programming is a predictable art, unlike *Raytheon* where the prior art did

not enable an “advanced material.” *Id.* (finding patent owner had presented un rebutted evidence the “advanced material” disclosed in the prior art was unavailable and its exceptional properties “had not been achieved through other means as of the priority date” of the challenged patent, and patent challenger “did not dispute that [the prior art’s] contemplated revolutionary materials were unavailable at the time the [challenged] patent was filed”). There is nothing unpredictable about writing code to determine whether a rectangle is in view on a screen. Ex-1027, ¶¶22-26.

A basic tenet of patent law is, “[A disclosure] need not disclose what is well-known to those skilled in the art and preferably omits that which is well-known to those skilled and already available to the public.” MPEP § 2164.05(a) (internal citations omitted). An “artisan’s knowledge of the prior art and routine experimentation can often fill gaps, interpolate between embodiments, and perhaps even extrapolate beyond the disclosed embodiments, depending upon the predictability of the art.” *AK Steel Corp. v. Sollac*, 344 F.3d 1234, 1244 (Fed. Cir. 2003). A “patent need not teach, and preferably omits, what is well known in the art,” *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1534 (Fed. Cir. 1987). Badros and the ’329 patent relate to computer-implemented technology having a “high level of predictability.” MPEP 2161.III. Dr. Smedley testified that Badros

did not explain how to do a viewability test because it was “not a difficult thing to do.” See POR, 15 (citing Ex-2050, 148:9-16).

C. Patent Owner's Expert's Testimony Is Unreliable and Should Be Given Little Weight

Patent Owner's Expert, Mr. Sherwood, lacks basic knowledge of computer science principles. He did not testify credibly about the skill of the ordinary person and whether the '329 patent or the prior art was enabled. Mr. Sherwood has a reputation for providing unreliable testimony. For example, a district court struck his testimony as unreliable because he could not explain the basis for his opinions. Ex-1031. Here, too, Mr. Sherwood provided unreliable testimony for several reasons.

First, Mr. Sherwood could not answer a basic question about the alleged source code in the '329 patent. Ex-1022, 15:13-16:25, 18:10-19:8, and 101:15-102:4. For example, he did not know whether the javascript object “viz_var_check{...}” was an integer, which it obviously was not. *Id.*, 16:3-25, Ex-1027, ¶23. Rather, it is an object, *i.e.*, a basic data structure in all object-oriented programming languages, such as C++, Java, and JavaScript. Ex-1027, ¶23 Mr. Sherwood's argument that source “code” is required to enable Badros is meritless. Ex-2045, ¶106. Even a competent programmer, which Mr. Sherwood is not, cannot make much sense out of the “code” in columns 65-68 of the '329 patent. Ex-1027, ¶ 23 (describing the code as “gobbledygook”). It's unclear what most of the

variables and functions are because they are undefined and undescribed. *Id.* Mr. Sherwood, therefore, does not have ordinary skill to effect the claimed embodiments.

Second, Mr. Sherwood testified that his opinion on “viewability tests” was based entirely on his experience. Ex-1022, 35:24-36:4. He did not investigate how well known such viewability tests were. *Id.*, 62:14-22. Badros did not need to disclose any source code for performing what was already well known. *Keynetik, Inc. v. Samsung Elecs. Co.*, No. 2022-1127, 2023 WL 2003932, at *2 (Fed. Cir. Feb. 15, 2023) (affirming Board’s finding of a reasonable expectation of success (citing *Fonar Corp. v. Gen. Elec. Co.*, 107 F.3d 1543, 1549 (Fed. Cir. 1997))). Mr. Sherwood would have found plenty of prior-art viewability tests had he investigated. Ex-1026, ¶¶10-19; Ex-1027, ¶¶24-25.

Third, he did not understand basic client-server architecture concerning basic questions about the ’329 patent and how websites work. *Id.*, 72:14-15 (“I don’t know that anything is downloaded to the local computer.”)

Q. Which computer in [FIG. 3 of the ’329 patent] would perform the viewability test?

A. I don’t know looking at this schematic which one -- which one does it, but if the viewability test is on a web page, right, and the viewability test is invoked, then it’s actually being invoked by whatever processor is in that particular computer.

76:4-22. Accordingly, Mr. Sherwood could not explain whether the client or the server performed the “viewability test.”

Fourth, he did not know that JavaScript was the “de facto standard for client-side scripting on the Web” in the early 2000’s. *Id.* 63:8-13; Ex-1032, 2.

Fifth, he did not know that Google’s ActiveView product provides a viewability test today. Ex-1022, 99:6-6; Ex-1033.

Sixth, he also did not presume that Badros was enabled as required by law. Ex-1022, 58:8-16; *Analog Devices*, 2022 WL 1157604, at *14.

Seventh, he contradicted his testimony about long-felt need when he testified that Google had no motivation to switch to viewable impressions. Ex-1022, 98:10-99:5.

Eighth, he incorrectly relied on the inventors’ skill in determining the level of the POSA. *Id.*, 110:12-17; *Standard Oil Co. v. American Cyanamid Co.*, 774 F.2d 448, 227 USPQ 293, 297-98 (Fed. Cir. 1985).

Ninth, Mr. Sherwood simply assumed that viewability tests were unknown, and failed to investigate references, such as Badros and one reference filed in 1996, to determine whether they taught viewability tests. *See e.g.*, US pat. no. 5,778,372, 3:46-48 (“the browser prioritizes the retrieval of the images depending on their location in the visible or non-visible portions of the [HTML] document.”); and US pat. no. 8,135,616, 7:61-64. (“[A]s part of an impression ad campaign, an

advertiser is not charged for an advertisement if all or a designated portion of the advertisement is not within a current viewable space of a browser display.”).

Finally and importantly, Mr. Sherwood contradicted both inventors when he testified that RMC was the first to invent viewability tests *per se*. Ex-1022, 7:7-20. Two inventors testified that viewability was known; they invented what they called “geometric viewability.” Ex-1020, 49:7-50:22, 58:12-14; Ex-1021, 13:16-14:10 (“non-geometric viewability ... was done before....”).

D. Even the So-Called “Geometric Viewability” Was Known.

Both Messrs. Tchibirev and Edwards admitted that they invented “geometric viewability,” not viewability *per se*. *Id.* Mr. Tchibirev described this as determining X and Y coordinates that are in viewable spaces (Ex-1020, 49:18-50:12), as in FIG. 51 of the '329 patent illustrating unseen spaces and seen portions of content page 21:

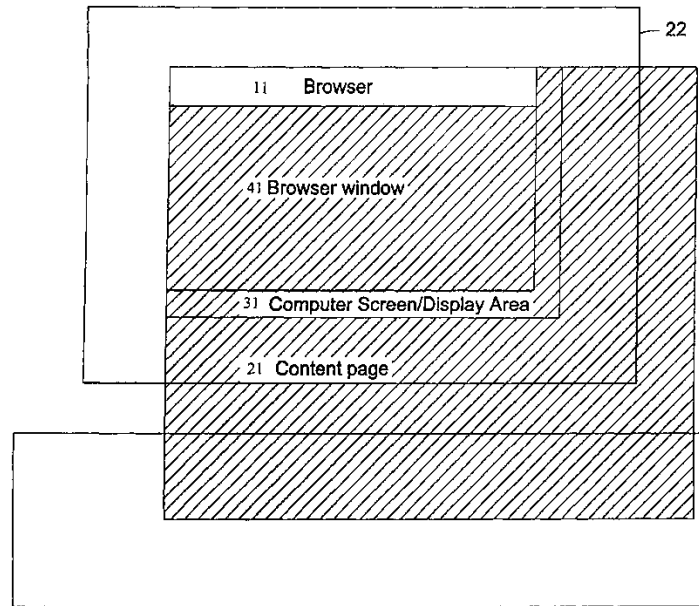


FIG. 51

This, too, was well-known because, for example, Koeppel (Ex-1025, FIG. 9B) describes the same idea, seen and unseen portions of a content page (976), nearly a decade earlier:

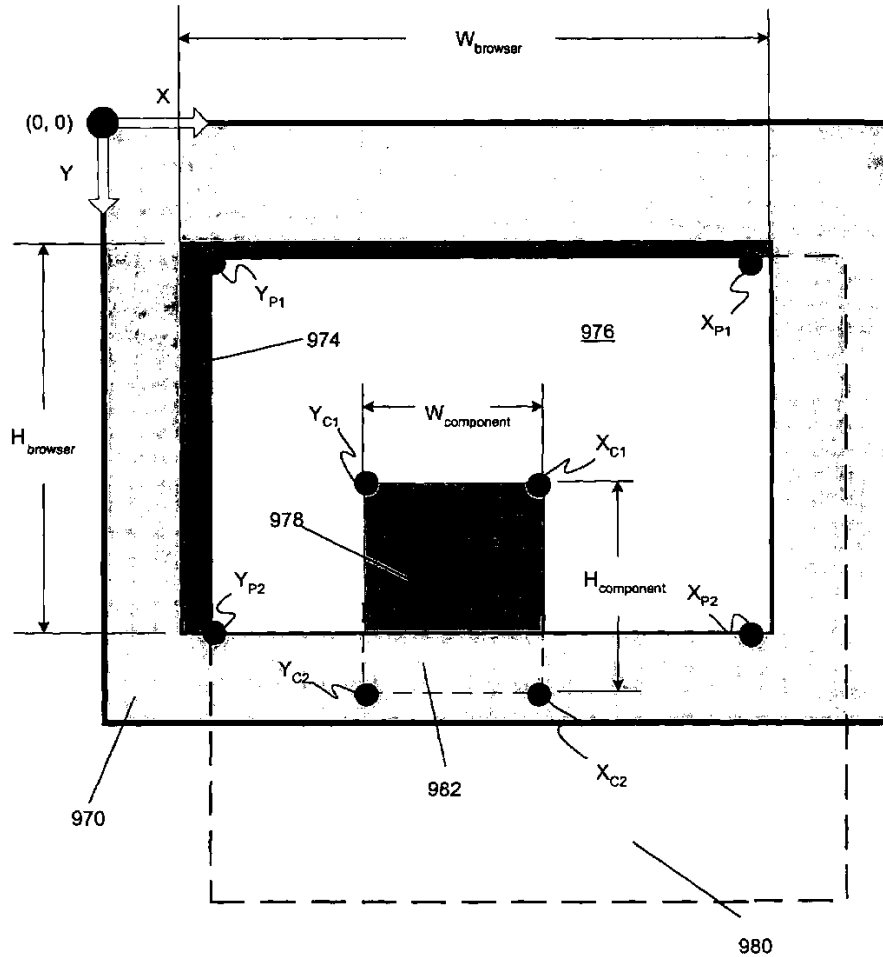


FIGURE 9B

The advertising industry was well aware of viewability tests well before 2009. Ex-1026, ¶¶2-21; Ex-1027, ¶¶24-25. Furthermore, Mr. Sherwood did not have an understanding of what geometric viewability—the inventor’s core technology—even was. Ex-1022, 6:20-24.

E. Harkins Is Analogous Art

The Petition and Dr. Smedley explained that Krassner, Badros, and Harkins were all related to digital advertising. Pet., 18-19 and 32; Ex-1009, ¶¶48-61. Patent

Owner attempts to distinguish Harkins because it teaches digital ads being printed on receipts rather than being displayed on a screen. Petitioner relies on Badros for displaying on a screen. Harkins only teaches the obvious ability to repeat Badros' process more than once. Pet., 25-28 and 37-40. Furthermore, Harkins teaches that its invention can be used in web pages. Ex-1004, ¶30. Therefore, Harkins is combinable with Krassner and Badros.

III. DR. SMEDLEY TESTIFIED CREDIBLY ON LIMITED ISSUES

Dr. Smedley is overly qualified to testify on the level of ordinary skill required for determining whether content is in view in a web browser, and websites in general. His lack of experience with a particular type of content—advertisements—is irrelevant. Badros explicitly addresses viewability. Patent Owner's witnesses agreed. Their sole argument was enablement. The fact that Dr. Smedley did not work with advertisements *per se* is unnecessary for his testimony to be admissible. FRE 702. The Federal Circuit has upheld testimony when a witness lacked experience in the design of the patented invention, but had experience with materials selected for use in the invention. *See SEB S.A. v. Montgomery Ward & Co., Inc.*, 594 F.3d 1360, 1372-73 (Fed. Cir. 2010); *see also* Patent Trial and Appeal Board Consolidated Trial Practice Guide November 2019 at 34 (“There is . . . no requirement of a perfect match between the expert's

experience and the relevant field.”). Accordingly, Dr. Smedley’s testimony is credible and relevant.

Dr. Smedley’s 26-page declaration (Ex-1009) focused primarily on priority, rationale to combine Krassner, Badros, and Harkins, and discrete issues in claim limitations. That is how the petition relied on his testimony. Unpatentability does not require expert testimony concerning every limitation. *Perfect Web Techs., Inc. v. InfoUSA, Inc.*, 587 F.3d 1324, 1329 (Fed. Cir. 2009). Patent Owner, however, repeatedly attacked Dr. Smedley concerning opinions beyond the issues addressed in his declaration, asserting the lack of an opinion was “fatal.” POR, 4-5. In one example, the POR argues that Dr. Smedley admitted that Badros did not teach a viewability test, but overlooks testimony stating, “[T]hat’s not a difficult thing to do.” POR, 15; *see also*, MPEP § 2164.05(a) (description preferably omits what’s well-known). The fact that Dr. Smedley testified that he had not formed an opinion on various questions is irrelevant. Indeed, Mr. Sherwood similarly testified “I don’t know” about several basic issues concerning the ’329 patent. Ex-1022, 16:3-17, 22:2-19, 55:6-13, 58:24-59:6. Still, Dr. Smedley did testify that he agreed that all claims were unpatentable. Ex-1009, ¶62; Ex-2050, 54:21-46:5.

Mr. Sherwood also testified in similar cases that no advertising experience was necessary. *See e.g.*, Ex-1053 (CBM2014-00094, Ex-1020), ¶60 (testifying that the POSA requires a degree and web experience to understand a display-

advertising-related patent). Dr. Madansky (Ex-1026), an expert in digital advertising, agrees that advertising experience is unnecessary. Ex-1026, ¶4. Her declaration is unnecessary for a *prima facie* showing of obviousness but rebuts advertising-industry-specific arguments in the POR.

IV. THE SECONDARY INDICA DOES NOT OVERCOME THE STRONG SHOWING OF OBVIOUSNESS

Patent Owner's evidence is insufficient to overcome the strong showing of obviousness. *See, Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) and *Pfizer, Inc. v. Apotex, Inc.*, 480 F.3d 1348, 1372 (Fed. Cir. 2007).

A. Long-Felt Need, Failure by Others, Skepticism, and Commercial Praise

The Petition and arguments above demonstrate that RMC was not the first to meet any so-called "long-felt need." *Newell Cos. v. Kenney Mfg. Co.*, 864 F.2d 757, 768 (Fed. Cir. 1988) ("once another supplied the key element, there was no long-felt need or, indeed, a problem to be solved."). Furthermore, "A nexus may not exist where, for example, the merits of the claimed invention were 'readily available in the prior art.'" *ClassCo, Inc. v. Apple, Inc.*, 838 F.3d 1214, 1220 (Fed. Cir. 2016). "[T]he identified objective indicia must be directed to what was not known in the prior art." *Henny Penny Corp. v. Frymaster LLC*, 938 F.3d 1324, 1333 (Fed. Cir. 2019). "If commercial success is due to an element in the prior art,

no nexus exists.” *Tokai Corp. v. Easton Enters., Inc.*, 632 F.3d 1358, 1369 (Fed. Cir. 2011). The ’329 patent discloses nothing new.

Patent Owner’s so-called “viewability test” was well known for at least a decade prior to the 2009 priority date. *See e.g.*, Ex-1028 (“Himmel,” titled “Method and apparatus for detecting actual viewing of electronic advertisements,” priority 1998); Ex-1025 (“Koeppel,” titled “System and method for performing Web based in-view monitoring,” priority 2000); Ex-1029, ¶63 (“Sandige,” “To provide greater accuracy in advertising metrics, may supplement the existing server-based web-page advertisement metrics and tracking with detailed accurate client viewability information.” priority 2007); Ex-1037, Abstract (“Callaghan,” “Embodiments are configured to provide browsing and other functionality that can be used to provide viewable data based in part on a current viewable space of a browser interface”). Indeed, one prior art publication describes “time visible” as “common metric” for advertising in 2005. US pub. no. 20060155615 (“Loo” Ex-1030), ¶4.

Alenty was a company that had a prior-art viewability product on the market. Ex-1038 (distinguishing page views from determining whether “content is visible”); Ex-1039 (“Alenty offers a technology to measure the actual visibility of online banner ads”); Ex-1040 (Alenty was “the first company to measure in-view impressions.”). Ex-1026, ¶11.

Patent Owner presented no evidence of failure of others. There are other explanations for why the online advertising industry had not completely shifted from a served or pay-per-click standard to a viewed standard, such as other standards were extremely lucrative. Ad sellers had incentive for maintaining the status quo. There was also no motivation to switch to a viewability standard until programmatic advertising became more prevalent. Ex-1026, ¶¶ 29-35.

As explained above in § II and in the Petition, Badros and many other prior art references taught and enabled viewability tests. Ex-1026, ¶¶10-21. There was no long-felt need; indeed, there was no need because most advertising at that time went to specific entities, *i.e.*, the large publishers, and was not distributed programmatically around the Internet like it is today. Moreover, viewability was not important until the industry shifted from more traditional media outlets, such as the New York Times, to programmatic ad serving on smaller websites, known as the long tail. Ex-1026, ¶¶ 29-35.

RMC has not demonstrated a nexus between any alleged “commercial praise” and the claimed invention. The self-serving statements promoted MRC’s expensive accreditation process and RealVu’s ad service. The prior art demonstrates that ad sellers knew that viewability tests were possible, but they had no motivation to change. The alleged praise does not have a nexus to the claims of

the '482 patent because 1) they were in the prior art; and 2) the praise could have been the result of RealVu's early request for certification, not that it wasn't known.

B. Commercial Success, Licensing, and Copying

1. Copying

Duration could not copy RMC's confidential back-end source code because it never had access to it. Ex-1020, 15:14-21; Ex-2056, 2. RMC provided a public tag that Duration could insert into webpages. Ex-1020, 11:12-12:14; Ex-2056, 2. The tag would access RMC's confidential backend source code and return machine-generated code for providing advertisements. Ex-1001, 7:53-9:28. Patent Owner presented no evidence of Duration having tried and failed or otherwise needing to copy RMC's code implementing well-known functionality. Indeed, any similarities between RMC's and Duration's products is because viewability tests were well known for more than 20 years prior to Duration releasing its product.

Duration intentionally avoided copying RMC's product. Ex-2056, 3. Duration maintained separate engineers who never interacted with RMC to design a new system for which Duration received its own patents. *Id.* Even if Duration did copy, which it did not, "more than the mere fact of copying by an accused infringer is needed to make that action significant to a determination of the obviousness issue." *Cable Elec. Prods., Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1028 (Fed. Cir. 1985). "[C]opying is only equivocal evidence of non-obviousness in the absence of

more compelling objective indicia of other secondary considerations.” *Ecolchem, Inc. v. S. Cal. Edison Co.*, 227 F.3d 1361, 1380 (Fed. Cir. 2000); *see also*, *Vandenberg v. Dairy Equip. Co.*, 740 F.2d 1560, 1567 (Fed. Cir. 1984).

Patent Owner’s mere conclusions failed to explain adequately how either its own or Duration’s software embodies the claimed features. *See IBG LLC v. Trading Techs. International, Inc.*, CBM2016-00054, Paper 61, 65 (PTAB October 17, 2017) (*aff’d*) (*cert. denied*). On page 4 of Paper 49 of this proceeding, the Board stated that it would follow the decision in *IBG* (Paper 38) and held that it would only disregard the analysis column; however, *IBG*, Paper 38, went further: “We, thus, will not consider any arguments that are not adequately explained in the PORs, themselves.” The POR and expert reports make basic conclusions about consonance and copying. The Board struck the only analysis or argument. Therefore, Patent Owner has failed to meet its burden to demonstrate coextensiveness for nexus and that there was copying.

The evidence of copying is equivocal at best, even if the Board considers it. *In re GPAC*, 57 F.3d 1573, 1580, 35 USPQ2d 1116, 1122 (Fed. Cir. 1995) (“[M]ore than the mere fact of copying by an accused infringer is needed to make that action significant to a determination of the obviousness issue.”) This is especially true here, where the alleged copier never had access to nonpublic information to copy. *See, L’Oréal USA, Inc. v. Liqwd, Inc.*, PGR2017-00012,

Paper 120, 9-11 (PTAB December 9, 2020). Also, the allegedly copied features were prevalent in the prior art. Ex-1026, ¶¶10-28.

2. Licensing and Commercial Success

Patent Owner also failed to demonstrate a nexus between any commercial success and the claimed invention because the claimed invention was well known, but had not yet fully replaced the served-impression standard. Badros alone or in combination with Krassner or Hawkins teaches all claim limitations; thus, the licensed technology was known.

Objective evidence, like that submitted with the POR, is entitled little weight, and generally has no bearing on the legal issue of obviousness. *See, In re Vamco Machine & Tool, Inc.*, 752 F.2d 1564, 1577 (Fed. Cir. 1985). Patent Owner's mere citation to revenue is insufficient to demonstrate commercial success. *See In re Baxter Travenol Labs*, 952 F.2d 388, 392 (Fed. Cir. 1991) (“[I]nformation solely on numbers of units sold is insufficient to establish commercial success.”). Patent owners must show that the claimed invention captured a substantial share of the marketplace. *In re Huang*, 100 F.3d 135, 140 (Fed. Cir. 1996) (“[E]vidence related solely to the number of units sold provides a very weak showing of commercial success, if any.”). Ex-1026, ¶¶29-35.

C. Industry Praise

The evidence of “industry praise” is nothing more than a set of self-serving statements from organizations promoting their services and standards. First, RealVu self-published a statement quoting George Ivie, CEO of MRC, stating that RealVu was the first to seek accreditation, implying that others should also seek accreditation. Ex-2057. The exhibit does not demonstrate that viewability was unknown, only that no one saw a need to pursue the burdensome and expensive accreditation process. Ex-1026, ¶¶29-34, 36-39, and 40-42. Second, Ex-2035 is a second instance of Mr. Ivie, CEO of MRC, promoting the fact that RealVu purchased its accreditation services, so Mr. Ivie was self-interested in promoting his accreditation services.

V. KRASSNER IS PRIOR ART UNDER § 102(b) AND (e)

Petitioner thanks the Board for analyzing Krassner under § 102(e). The invention of Krassner also published more than a year before Krassner’s priority date. Ex-1017. Dr. Smedley testified that he confirmed that the Krassner patent and earlier publication contain the same disclosure. Ex-2050, 127:8-15. The Board denied a motion to submit supplemental information relevant to whether the claims are unpatentable due to § 102(b) art.

The precedential *Hulu* decision allows for submitting different versions of publications in reply to a POR. IPR2018-01039 (“*Hulu*”), Paper 29, 4-6 (PTAB Oct. 5, 2021); *see also*, Paper 66, 29-34 (PTAB Oct. 5, 2021). *Hulu* stated that

Petitioners have several opportunities to submit additional evidence. *Hulu*, Paper 19, 14. Indeed, the Petitioner in *Hulu* waived its opportunity to submit supplemental information of publication. *Hulu*, Paper 66, 29-34. Here, Petitioner was much more proactive, requesting authorization to submit supplemental information. Mistakenly using a later publication does not change the fact that the inventions of Krassner (or Badros, *see* Ex-1018) are § 102(b) prior art. *Purdue Pharma L.P. v. DepoMed, Inc.*, IPR2014-00377, Paper at 14 (PTAB Jul. 8, 2015) (misidentification of § 102 subsection does not prejudice the Patent Owner). Therefore, consistent with *Hulu*, Petitioner respectfully requests that the Board recognize that Krassner is prior art under § 102(b) because “the invention was ... described in a printed publication ... more than one year prior to the date of the application for patent.”

VI. PATENT OWNER HAS NOT MET ITS BURDEN OF PRODUCTION TO QUALIFY FOR 35 U.S.C. § 103(c) SAFE HARBOR

Patent Owner failed to meet its burden to prove that the '329 patent, or its priority application no. 12/384,403 (issued patent no. 11,004,090 (“’090 patent”)), “the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.” § 103(c). *Arista Networks, Inc. v. Cisco Technology, Inc.*, IPR2016-00309, Paper 52at 42 (PTAB Jun. 1, 2017) (Patent Owner failed to meet its burden of production to prove that § 103(c) applied)

(*aff'd*). RMC relies on two assignments: (Ex-2016) the original nonprovisional assignment, and (Ex-2015) the assignment of the parent application that matured into the '090 patent signed in November 2008.

Section 103(c), however, requires common ownership when the invention “was made,” not filed. The inventors consistently testified that the invention “was made,” *i.e.*, conceived and/or actually reduced to practice, in early 2008—much earlier than November. MPEP § 2146.02 (“An invention is ‘made’ when conception is complete”); Ex-1020, 54:14-55:13; Ex-1021, 8:2-9:16. Krassner and the '329 patent lacked common ownership at least because there was no assignment until *after* the invention was made. *See e.g., Indus. Tech. Research Institute v. Pacific Biosciences of California, Inc.*, 640 Fed.Appx. 871, 883 (Fed. Cir. 2016) (holding that evidence of later assignment or common ownership does not establish the necessary common ownership at the time of the invention). Furthermore, inventor Fred Bernstein never signed Ex-2015, so his rights remained with him until 2022 when the *nunc pro tunc* assignment was executed. Ex-1024.

VII. KRASSNER IN VIEW OF BADROS RENDERS OBVIOUS THE CLAIMS OF THE '329 PATENT UNDER 35 U.S.C. § 103(a) AND 37 C.F.R. § 1.321, IRRESPECTIVE OF § 103(c)

Patent Owner has failed to file a terminal disclaimer to overcome the Krassner-based ground, even if it is disqualified as prior art. MPEP § 2146.03.II. Neither the Board nor Patent Owner have argued that the '329 patent is patentably

distinct from Krassner. At minimum, the Petition's Krassner-based grounds stand because no terminal disclaimer has been filed and because the § 103(c) safe harbor does not protect double patenting; only § 121 does that. The parent of the '329 patent, US patent no. 11,004,090, has a terminal disclaimer for Krassner (Ex-1007, 384). The '329 patent contains no such terminal disclaimer and is therefore also unpatentable as obvious over Krassner irrespective of § 103(c).

VIII. CONCLUSION

For the reasons given in the petition and above, claims 1-6 are unpatentable by a preponderance of the evidence.

Respectfully submitted,

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

CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24(d), the undersigned hereby certifies that the word count for the foregoing Petitioner's Reply totals 5,016 as counted by Word Count feature of Microsoft Word, which is less than 5,600 allowed under 37 C.F.R. § 42.24(a)(1)(i), excluding the parts of the paper exempted by 37 C.F.R. §42.24(a), and complies with typeface requirements of 37 C.F.R. §42.6(a)(ii) and the style requirements of 37 C.F.R. §§42.6(a)(iii) and (iv.)

Dated: March 12, 2024

By: /Kevin Greenleaf/
Reg. No. 64,062

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing Petitioner's Reply and related exhibits were served on March 12, 2024, via email on the following correspondence address of record for the Patent Owner.

ARICHARDS@GIPLG.COM
DBERTEN@GIPLG.COM
HSADLER@GIPLG.COM
ROLSON@GIPLG.COM

Dated: March 12, 2024

By: /Kevin Greenleaf/
Reg. No. 64,062