

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

PATENT OWNER'S OBJECTIONS TO EVIDENCE

Pursuant to 37 C.F.R. § 42.64(b)(1) and the Federal Rules of Evidence (“FRE”), Patent Owner objects to the admissibility of evidence submitted by Petitioner in connection with Petitioner’s Reply (“PR”). The evidence and grounds for the objections is listed below. Patent also objects to Petitioner’s reliance on or citation to any objected evidence in its reply, declarations, or any other paper. The challenged evidence is list below.

1. Expunged Exhibit 1017

In Paper 21, the Board ordered that Exhibit 1017, U.S. Patent Application No. 20070265923, be expunged. The Board expressly stated that “the Krassner publication need not – and indeed may not – be re-filed under a new exhibit number.” Paper 21 at 3 n.1. Despite the expungement and direction not to re-file the exhibit, Patent Owner re-filed it anyway. See also Paper 21 p. 5 (“Hulu is unlike the situation here.”). For the reasons set forth in Paper 18, and the Board’s express ruling in Paper 21, Patent Owner objects to Petitioner’s use of EX1017.

2. New References (EX1017, EX1025, EX1028, EX1029, EX1030, EX1034, EX1035, EX1037).

The Reply submits eight new references: EX1017 (Krassner Pub.); EX1025, US Patent No. 7,567,916 (“Koeppel”); EX1028, US Patent No. 6,317,782 (“Himmel”); EX1029, US Patent No. US 2008/022503 (“Sandige”); EX1030, US pub. no. 20060155615 (“Loo”); EX1034, US Patent No. 5,778,372 (“Cordell”); EX1035, US Patent No. 6,418,470 (“Blumenau”) EX1037, US Patent No.

8,135,616 (“Callaghan”). Each of these references could have been submitted with the Petition, but Petitioner chose not to do so. The Board should exclude them. *See, e.g., Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016), and related cases cited below.

3. References to the Purported Alenty System (EX1038, EX1039, EX1040)

Patent Owner objects to EX1038, EX1039 and EX1040 under FRE 901 (authenticity), 801(hearsay), and 401/402 (relevancy). Petitioner did not provide any basis to determine the authenticity of the exhibits, and relies on them to purportedly prove that “Alenty was a company that had a prior-art viewability product on the market.” They are inadmissible and therefore also irrelevant. Patent Owner also objects to the extent the references purport to explain how a *system* operates because IPRs are limited to printed publications; systems cannot be used as purportedly invalidating references. 37 CFR § 42.104(b)(2).

4. New Opinions That Could Have Been Filed with the Petition (EX1026, EX1027 and the Exhibits listed above)

On Reply, Petitioner presents a new purported expert for the first time, Madansky (Ex. 1026). Madansky offers new opinions, including that viewability tests were already known in the art. Madansky purports to support these new opinions with six new patent references: EX1034, US Patent No. 5,778,372 (“Cordell”), Madansky ¶12; EX1035, US Patent No. 6,418,470 (“Blumenau”),

Madansky ¶13; EX1037, US Patent No. 8,135,616 (“Callaghan”), Madansky ¶14; EX1025, US Patent No. 7,567,916 (“Koeppel”), Madansky ¶16; EX1030, US pub. no. 20060155615 (“Loo”), Madansky ¶17; and EX1029, US Patent No. US 2008/022503 (“Sandige”), Madansky ¶17. Madansky ¶11 also relies on a new purported system or system(s) reference described in these three documents: EX1038, Blog: “Audience 2.0: Time - Alenty - Web 2.0 Marketing”; EX1039, purported press release: “Alenty analyzes the visibility of advertisements on the Internet”; and EX1040, purported 2014 Press release: “AppNexus Buys Paris-Based Viewability Firm Alenty.”

Petitioner’s Reply also includes a new declaration from its purported expert, Smedley, offering new opinions, including that Badros teaches a viewability test and opining that “viewability tests were well known” (Ex. 1027 ¶26) and briefly discussing EX1025, EX1029, EX1030 and EX1037 (Id. at ¶¶17-18) and another reference: EX1028, US Patent No. 6,317,782 (“Himmel”), Ex. 1027 at ¶17.

Smedley’s and Madansky’s new opinions should be excluded because Petitioner could have presented the opinions earlier to make out a prima facie case of unpatentability. Smedley’s new declaration, EX1027 ¶9, admits again what he admitted during his deposition: that he had not formed an opinion about whether Badros disclosed the viewability test by the time of the Petition (and his first declaration): I stated that I had not yet formed an opinion on whether Badros

disclosed any “make a determination...” limitation. EX2050, 50:22-52:19.

Smedley’s and Petitioner’s decision not to proffer an expert opinion on this issue in the Petition was entirely within their own control. *See also* Reply p.19 (acknowledging “The fact that Dr. Smedley testified that he had not formed an opinion on various questions....”).

Attempting to fill the evidence admittedly missing from the Petition, Smedley’s new declaration now offers the new opinion that a “person of ordinary skill in the art would have understood this plain language in Badros as disclosing viewable impressions.” EX1027 ¶11. To fill the same hole, Smedley’s new declaration also now offers the new opinion that: “viewability tests were well known.” EX1027 ¶¶15, 18, 26. Petitioner’s new expert, Madansky, offers similar new opinions. EX1026 ¶¶5, 9, 11-19, 21.

Petitioner could have presented these opinions earlier to make out a *prima facie* case of unpatentability. The claim element was always part of the ’329 patent and Petitioner always knew it had to meet its burden to address it. There is no reason why Petitioner could not have presented these opinions earlier. According to Trial Practice Guide, a petitioner “may not submit new evidence or argument in reply that it could have presented earlier, e.g. to make out a *prima facie* case of unpatentability.”

37 CFR § 42.104(b) required that the Petition identify:

(2) The specific statutory grounds under [35 U.S.C. 102](#) or [103](#) on which the challenge to the claim is based and the patents or printed publications relied upon for each ground;.....

(5) The exhibit number of the supporting evidence relied upon to support the challenge and the relevance of the evidence to the challenge raised, including identifying specific portions of the evidence that support the challenge.

The Federal Circuit has rejected similar attempts to introduce new theories and evidence. For example in *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016), Petitioner argued on appeal that the PTAB was required to “consider whether it is within the skill of the ordinary artisan to modify the cleavage conditions to satisfy the alleged cleavage requirements.” “The Board did not consider this argument, however, because it was raised for the first time in IBS's reply brief and expert declaration.” The Petitioner had “supported its new theory of invalidity by reference to new evidence, citing a number of non-patent literature references which were not relied upon to support unpatentability in the Petition.” The Federal Circuit explained:

IBS chose which grounds of invalidity to assert in its petition and it chose not to assert this new one. Unlike district court litigation—where parties have greater freedom to revise and develop their arguments over time and in response to newly discovered material—the expedited nature of IPRs bring with it an obligation for petitioners to make their case in their petition to institute. While the Board's

requirements are strict ones, they are requirements of which petitioners are aware when they seek to institute an IPR.

See also, e.g., Wasica Fin. GmbH v. Cont'l Auto. Sys., Inc., 853 F.3d 1272, 1286–87 (Fed. Cir. 2017) (“Rather than explaining how its original petition was correct, Continental’s subsequent arguments amount to an entirely new theory of *prima facie* obviousness absent from the petition. Shifting arguments in this fashion is foreclosed by statute, our precedent, and Board guidelines. We therefore see no error in the Board declining to engage such an argument here.”); *Henny Penny Corp. v. Frymaster LLC*, 938 F.3d 1324, 1330 (Fed. Cir. 2019) (“We agree with Frymaster that the Board did not abuse its discretion by holding HPC to the obviousness theory in its petition.”)

5. Unauthentic and Hearsay Exhibits (EX1032, 1033)

Patent Owner objects to EX1032, EX1033 under FRE 901 (authenticity), 801(hearsay), and 401/402 (relevancy). Petitioner did not provide any basis to determine the authenticity of the exhibits, and relies on them to prove “facts.” They are inadmissible and therefore also irrelevant.

6. The Uncited Exhibits (EX1041, EX1042, EX1043, EX1044, EX1045, EX1046, EX1048, EX1049, EX1050, EX1051, EX1052, EX1054, EX1055, EX1056)

Petitioner submitted 15 exhibits that are nowhere cited or discussed in the Reply. Most of the uncited exhibits appear in the second Smedley declaration (EX1026), but only in the table of materials he allegedly considered. Patent Owner

objects to EX1041, EX1042, EX1043, EX1044, EX1045, EX1046, EX1048, EX1049, EX1050, EX1051, EX1052, EX1054, EX1055, EX1056 under FRE 901 (authenticity), 801(hearsay), and 401/402 (relevancy).

The exhibits uncited in the Reply also appear in the list of materials Madansky allegedly considered, and are referenced in single-line entries in her declaration. See EX1026 ¶8 (EX1049); ¶9 (EX1041); ¶31 (EX1055); ¶32 (EX1051, EX1052); ¶33 (EX1044, EX1045, EX1050); ¶35 (EX1054, EX1056); ¶37 (EX1048); ¶38 (EX1042); and ¶41 (EX1046). The Reply then cites to the indicated paragraphs, thus attempting, it appears, to incorporate the underlying uncited references by incorporation by reference.

Dated: March 19, 2024

Respectfully Submitted,

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CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e)(1))

The undersigned hereby certifies that on March 19, 2024, a complete and correct copy of the foregoing PATENT OWNER'S OBJECTIONS TO EVIDENCE was served via electronic mail on the following counsel of record for Petitioner:

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