

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

**PETITIONER'S MOTION TO STRIKE OR DISREGARD
UNTIMELY EVIDENCE
IN PATENT OWNER'S SUR-REPLY
UNDER 37 CFR § 42.23(b)**

Rule 42.23(b) forbids submitting “new evidence other than deposition transcripts” in sur-replies. Petitioner, therefore, moves to strike (*e.g.*, disregard) Exs-2063-69 and parts of the Sur-Reply (pp. 1, 8-11, and 15), precluding Patent Owner from using them for evidentiary support. The rule has three exceptions. None apply.

First, Patent Owner waived cross-examining Dr. Smedley with new evidence.

Second, Patent Owner waived submitting supplemental information under rule 42.123 and instead filed the evidence “*sub silentio*.” *Resi Media LLC v. BoxCast Inc.*, IPR2022-00066, Paper 64, 65-66 (PTAB April 12, 2023).

Third, Petitioners may optionally file a sur-sur-reply. This is impracticable because five exhibits (Exs-2064-2068), a new declaration and supporting documents, require taking Mr. Tchibirev’s deposition. 37 C.F.R. § 42.51(b)(1)(ii). Patent Owner’s request for a one-month extension to file the sur-reply created this timing impracticality. The timing of oral argument provides no meaningful opportunity to respond to the new exhibits, including Exs-2063-2069, because it is in less than a month and strictly prohibits new arguments. Paper 55, 3; *see also*, *Infineon Technologies AG v. AmaTech Group Limited*, IPR2022-00650, Paper 31, 13 (PTAB September 1, 2023).

The Sur-Reply provided Patent Owner a fair opportunity to respond. For example, the Sur-Reply (p. 9) argued that the Reply evidence was untimely. However, the Reply (p. 10) explained that the new evidence responded to

enablement and secondary indicia issues, which are Patent Owner's burden. *Rembrandt Diagnostics, LP v. Alere, Inc.*, 76 F.4th 1376, 1384 (Fed. Cir. 2023) (reply evidence is expected). Patent Owner also argued repeatedly that Dr. Smedley's testimony was a "sham." Sur-Reply, 1 and 4-6. But, Dr. Smedley simply testified in rebuttal that the code in the '329 patent was incomplete. Ex-1027, ¶23.

Patent Owner had options to submit new evidence, as discussed above, but instead violated the rules a second time (Paper No. 49). Patent Owner's untimely evidence confirms that the code in the '329 patent was incomplete and provides no opportunity for Petitioner to address it. This justifies expunging at least Exs-2063-2069 and disregarding arguments relying on that evidence.

Receiving a fast decision on this motion, ideally by May 20 (deadline for demonstratives service), would focus the parties' arguments and simplify the hearing for the Board. Consolidated Trial Practice Guide, 81. However, Petitioner appreciates that the Board is busy.

Dated: May 6, 2024

Respectfully submitted,

/Kevin Greenleaf/
Kevin Greenleaf
Reg. No. 64,062
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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing motion to strike was served on May 6, 2024, via email on the following correspondence address of record for the Patent Owner.

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Dated: May 6, 2024

Respectfully submitted,

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