

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

IPR2023-00953

Opposition to Motion to Exclude

I. INTRODUCTION

The Motion to Exclude (Paper 60, “the Motion”) largely repeats erroneous arguments to strike proper reply evidence and fails to address admissibility. 37 C.F.R. § 42.64(c); and Consolidated Trial Practice Guide (CTPG), 79-80 (“A motion to exclude must explain why the evidence is not admissible” and “may not be used to challenge the sufficiency of the evidence to prove a particular fact. ... In most cases, the Board is capable of identifying new issues or belatedly presented evidence”).

The Motion rehashes mistaken arguments from the Sur-Reply that “[s]ubmitting new evidence and theories on Reply is not permitted.” Paper 56, 9. Patent Owner, *i.e.*, RMC, fails to address the routine fact that reply evidence is allowed—and “expected.” *Rembrandt Diagnostics, LP v. Alere, Inc.*, 76 F.4th 1376, 1384 (Fed. Cir. 2023) (citing *Anacor Pharms., Inc. v. Iancu*, 889 F.3d 1372, 1380-82 (Fed. Cir. 2018) and *Genzyme Therapeutic Prods. Ltd. P ’ship v. Biomarin Pharm. Inc.*, 825 F.3d 1360, 1366 (Fed. Cir. 2016)). The Board instructed Patent Owner to make these arguments in the sur-reply when it denied authorization to file a motion to strike. Ex-1058. The Motion is, therefore, largely improper.

The Motion takes an extreme and unsupported position that petitioners must submit all evidence necessary to address all conceivable issues that could arise, including rebutting inchoate arguments, such as secondary indicia and enablement,

where the patent owner bears the burden. The is wrong. CTPG, 73 (“A party also may submit rebuttal evidence in support of its reply. *See Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1077-78 (Fed. Cir. 2015).”).

The *Belden* case controls.

Evidence admitted in rebuttal to respond to the patent owner’s criticisms will commonly confirm the prima facie case. ... No rule requires a Petition to be accompanied by any declaration, let alone one from an expert guiding the Board as to how it should read prior art. What the Board can find without an expert depends on the prior art involved in a particular case. Even in court, we have said, “expert testimony is not required when the references and the invention are easily understandable.” *Wyers v. Master Lock Co.*, 616 F.3d 1231, 1242 (Fed. Cir. 2010).

805 F.3d, 1079. Petitioners routinely submit first and second declarations. Patent Owner cites no on-point authority for a blanket prohibition for submitting new reply evidence. It instead argues that the new evidence somehow changes the grounds of unpatentability. Not so, the new evidence only confirms the Petition’s *prima facie* case and rebuts enablement and secondary indicia arguments where Patent Owner carries the burden.

A. Evidence of Earlier Publication of Krassner and Badros Are Not Currently of Record per the Board's Instructions (Exs-1017-18).¹

Petitioner's Reply addressed Krassner's and Badros' publication dates, but RMC has focused solely on Badros allegedly not teaching a "viewability test." Paper 65, 4. Patent Owner has not and cannot swear-behind either Krassner or Badros because both have § 102(e) priority dates earlier than 2008, when RMC allegedly reduced the invention to practice. RMC has also not produced evidence that "at the time the claimed invention *was made*, [the '329 patent was] owned by the same person or subject to an obligation of assignment to the same person." 35 U.S.C. § 103(c) (pre-AIA); *see also*, Paper 50, 27-28. Therefore, the issue of whether Krassner and Badros are also § 102(b) prior art is largely irrelevant.

B. Petitioner's (and Patent Owners) Routinely Submit New Evidence in Depositions (Exs-1020-22).

First, the Motion provides no basis for denying the admissibility of the evidence. Second, RMC incorrectly argues that parties may not ask witnesses about new enablement evidence. Mot., 5; *see, Ascend Performance Materials Operations LLC v. Samsung SDI Co., Ltd.*, No. IPR2020-00349, Paper 53 (PTAB

¹ These exhibits were part of Dr. Smedley's deposition but were not included with the deposition transcript. Ex-2050, 3:10-12.

July 15, 2021) (even Patent Owners may enter new evidence with depositions).

Therefore, the Motion is improper and otherwise baseless.

C. The Reply Enablement Exhibits Properly Rebutted Patent Owner's Enablement Arguments (Exs-1025, 1028-30, 1034-40).

Patent Owner mischaracterizes the enablement exhibits as necessary for proving *prima facie* obviousness. Mot., 1. Patent Owner cites *Axonics, Inc. v. Medtronic, Inc.*, arguing that enablement evidence was improper. *Id.*, citing (75 F.4th 1374 (Fed. Cir. 2023)). The Federal Circuit stated the issue in *Axonics* thusly: “where a patent owner offers a new claim construction for the first time in its response after the institution decision, a petitioner may introduce new arguments and evidence in reply under the newly proposed claim construction.” 75 F.4th, 1380. The Federal Circuit reversed the Board's decision to **not** consider that new reply evidence. *Id.*, 1384.

Dicta in *Axonics*, “that a petitioner may not in reply rely on new prior art to teach a claim limitation,” does not apply here. *Id.*, 1383. The reply addressed this:

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.

Paper 50, 10. The Motion ignores this fact.

Axonics does not support RMC for several reasons. First, it directly contradicts patent owner's assertion. RMC proposed a new theory of lack of enablement for the first time in the response. *Axonics* faulted the Board for **not** considering reply evidence in an analogous situation. Second, the law states that prior art is presumed to be enabled, and it is RMC's burden to prove otherwise. Paper 50, 10 (citing *Analog Devices, Inc. v. Xilinx, Inc.*, No. IPR2020-01596, 2022 WL 1157604, at *14 (PTAB April 13, 2022)). Even if RMC met its burden—which it did not—Petitioner rightly gets an opportunity to rebut new issues if the burden shifted. 5 U.S.C. § 554(c). In fact, *Raytheon Techs. Corp. v. Gen. Elec. Co.*, concerning enablement of an advanced material, faulted the petitioner for **not** submitting rebuttal evidence. 993 F.3d 1374, 1377 (Fed. Cir. 2021).

RMC's citation to *Intelligent Bio-Sys. v. Illumina Cambridge* is also inapposite.² Mot., 2, 5, 11 (citing 821 F.3d 1359, 1369 (Fed. Cir. 2016)). *Intelligent* concerned a wholly new ground of unpatentability. 821 F.3d at 1369. *Intelligent* had nothing to do with enablement. Duration's reply stated expressly that the new

² *Wasica Fin. GmbH v. Cont'l Auto. Sys., Inc.*, 853 F.3d 1272, 1286–87 (Fed. Cir. 2017) and *Henny Penny Corp. v. Frymaster LLC*, 938 F.3d 1324, 1330 (Fed. Cir. 2019) are not different than *Intelligent* on these points.

evidence focused on the “state-of-the-art” for enablement arguments, not new grounds of unpatentability. Paper 50, 10-11; *see also*, MPEP § 2164.05(a). The references’ only purpose was to demonstrate that “[v]iewability 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.” Paper 50, 9. RMC’s accusations ignore these facts and instead conjure a nonexistent new ground.

1. Evidence of Earlier Public Use by Alenty Properly Rebutted Patent Owner’s Enablement Arguments (Exs-1038-40).

RMC objected to these exhibits as inauthentic (Fed. R. Evid. 901) and hearsay (Fed. R. Evid. 810), (unlike other exhibits that do not have any admissibility objections). Petitioner’s lead counsel testified that these exhibits are authentic files retrieved from the Internet. Ex-1057, ¶¶5-7. Ex-1038 was downloaded from the WayBack Machine and bears a retrieval time of February 2, 2008. *See* <https://help.archive.org/help/using-the-wayback-machine/>. The other two exhibits are not hearsay under Fed. R. Evid. 803(18) (“Statements in Periodicals”). Ex-1039 is from Le Journal du Net (JDN “The Net Journal”) and Ex-1040 is from AdExchanger.

Moreover, the Board requires that “Affidavits expressing an opinion of an expert must disclose the underlying facts or data upon which the opinion is based.

See Fed. R. Evid. 705; 37 C.F.R. § 42.65.” CTPG, 40. The underlying facts and data may include hearsay. Fed. R. Evid. 703. Therefore, Dr. Madansky may rely on the exhibits, even if the Board still believes they are hearsay.

Finally, the probative value of the exhibits outweighs any possible prejudice to the Patent Owner. *Id.* Patent Owner questioned Dr. Madansky about these exhibits and had an opportunity to present argument about them in its sur-reply. Ex-2062, 31:6-16. Therefore, the prejudice to patent owner in admitting these references is minimal at most.

D. The Reply Declarations Only Confirmed the Same *Prima Facie* Case from the Petition (Exs-1026-27).

Patent Owner identified no admissibility objections for these exhibits. Therefore, the motion to exclude should be denied.

1. Opinions and Arguments about the So-Called “Viewability Test” Were Not New.

Drs. Smedley³ and Madansky addressed Patent Owner’s argument that Badros’ disclosure of an ad that is “actually visible” does not mean what it says. POR, 1. The Petition (pp. 23, 33, 35) argued that “actually visible” meant what it

³ Petitioner protests Patent Owner impugning Dr. Smedley’s character, four times calling him “paid witness Smedley” (Mot., 1, 4, 9), after seven times calling his declaration a “sham” in the sur-reply. 37 C.F.R. § 42.1(c).

said, and the two rebuttal declarations only confirmed that statement. *Belden*, 805 F.3d, 1079.

Petitioner rightly presumed the prior art was enabled. Paper 50, 10 (citing *Analog Devices, Inc. v. Xilinx, Inc.*, No. IPR2020-01596, 2022 WL 1157604, at *14 (PTAB April 13, 2022)). Petitioner assumed that the case would focus on “*replacement advertisement*” limitations, not the clearly erroneous argument that RMC invented the “viewability test” or that Badros did not mean what it said. The rebuttal declarations—routinely entered in IPRs—responded to Patent Owner’s surprising arguments that it invented the well-known “viewability test” and related issues. The rules allow Patent Owner to argue that Badros, which is directed to a predictable art, was not enabled. Petitioner, too, properly responded to this faulty enablement argument in case the Board desired additional evidence that Badros truly meant “actually visible to the user.” Nothing about this process is unusual, other than Patent Owner objecting to nearly all evidence submitted in petitioner’s reply.

2. Dr. Smedley’s Opinions about the ’329 Patent’s Code Addressed Mr. Sherwood’s Testimony.

The Motion again failed to identify an objection in the record to these exhibits.

E. The Experts Relied Properly on the So-Called “Uncited Exhibits.”

The experts cited most of these “uncited exhibits” in their declarations as underlying facts supporting their opinions. CTPG, 40. For example, Dr. Madansky cited the following exhibits in her declaration ((substitute) Ex-1026): ¶31 (Ex-1023), ¶9 (Ex-1041), ¶38 (Ex-1042), ¶33 (Ex-1043-45), ¶41 (Ex-1046), ¶37 (Ex-1048), ¶8 (Ex-1049), ¶11 (Ex-1050), ¶32 (Ex-1051), ¶32 (Ex-1052), ¶35 (Ex-1054), ¶32 (Ex-1055), ¶35 (Ex-1056). Dr. Smedley cited Ex-1032. Ex-1027, ¶¶19-20. The reply cited Ex-1033 on page 14. Therefore, one or more of the reply and the expert declarations cited each of the so-called “uncited exhibits.”

Also, incorporation-by-reference is an invalid ground for a motion to exclude. *Apple, Inc. v. Parus Holdings, Inc.*, No. IPR2020-00686, Paper 37, 42 (PTAB Sept. 9, 2021). The Board rejected Patent Owner’s request for authorization to file a motion to strike. Ex-1058. Petitioner requests that the Board also deny this motion to exclude for the reasons above and because it is almost entirely an improper motion to strike.

Dated: May 15, 2024

Respectfully submitted,

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

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing Petitioner's
Opposition to the Motion to Exclude has been served on all parties via email on
May 15, 2024.

dberten@giplg.com
rolson@giplg.com
arichards@giplg.com
hsadler@giplg.com

Dated: May 15, 2024

Respectfully submitted,

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