

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 (Paper 59)
37 C.F.R. § 42.23(b)

In response to an email to the Board, we authorized Petitioner to file a motion to strike what Petitioner's email referred to as "[1] improper new evidence and [2] related arguments in Patent Owner's Sur-Reply." Paper 58; Ex. 3003.

Petitioner timely filed its Motion, requesting to have stricken "Exs-2063-69 and parts of the Sur-Reply (pp. 1, 8-11, and 15), precluding Patent Owner from using them for evidentiary support." Paper 59 ("Mot."), 1 (citing 37 C.F.R. 42.23(b)).

A. Striking of the Exhibits

Petitioner argues that "Rule 42.23(b) forbids submitting 'new evidence other than deposition transcripts' in sur-replies." Mot. 1. This is correct. *See* 37 C.F.R. 42.23(b) ("A sur-reply may only respond to arguments raised in the corresponding reply and may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness.").

Exhibits 2063 through 2069 clearly are not deposition transcripts of the cross-examination of a reply witness. Although Patent Owner filed an Opposition to the Motion, the Opposition does not contest this fact. Paper 61 ("Opp."). Further, Patent Owner filed an Updated Exhibit List (Paper 57) concurrently with its Sur-Reply (Paper 56), which indicates that none of Exhibits 2063 through 2069 is a deposition transcript. *See* Paper 57, 4.

Patent Owner's Opposition fails to rebut Petitioner's argument that Exhibits 2063 through 2069 were filed in contravention of 37 C.F.R. § 42.23(b). Paper 61 ("Opp."). The Opposition, rather, takes a different tact. The Opposition essentially argues that Patent Owner should be allowed

to violate our rules because Petitioner allegedly violated our rules. In Patent Owner's own words:

Raising the issue of Petitioner's rules violation, and asking to have the issue of whether this new Reply evidence was going to be allowed decided before its Surreply, Patent Owner asked to file a motion to strike. The Board responded (EX2070): "Patent Owner's request to file a motion to strike is denied. Patent Owner should use its sur-reply to respond to Petitioner's reply, including stating and explaining any objections to the evidence Petitioner relies on in its reply."

As Patent Owner then explained in Surreply and Motion to Exclude, the new Reply opinions must be excluded. *Alternatively, if they are permitted, Patent Owner submitted evidence demonstrating they are false . . .*

Opp. 1.¹

Patent Owner is not entitled to make up the rules. Patent Owner's filing of Exhibits 2063 through 2069 is a flagrant violation of a rule that could not be clearer.

B. Striking Parts of the Sur-Reply

Petitioner asks us to strike (or disregard) "parts of the Sur-Reply (pp. 1, 8-11, and 15)." Mot. 1. Petitioner does not identify the specific parts it wants excluded (unless it seeks the entirety of each of the identified pages). Moreover, Petitioner does not identify the legal basis for striking any portion of the Sur-Reply. Accordingly, Petitioner has not met its burden in that respect. *See* 37 C.F.R. § 42.20(c) ("The moving party has the burden of proof to establish that it is entitled to the requested relief.").

¹ Patent Owner's Motion to Exclude was filed May 8, 2024. Paper 60. The Board has yet to rule on Patent Owner's Motion to Exclude.

ORDER

In consideration of the foregoing, it is
ORDERED that the Motion (Paper 59) is granted in part;
FURTHER ORDERED that Exhibits 2063 through 2069 are
expunged; and
FURTHER ORDERED that all other relief sought by Petitioner's
Motion is denied.

PETITIONER:

Kevin Greenleaf
Joel Bock
Kevin.greenleaf@dentons.com
Joel.bock@dentons.com

PATENT OWNER:

Ragnar Olson
David Berten
rolson@giplg.com
dberten@giplg.com