

Duration Media v. Rich Media Club

IPR2023-00953

ORAL HEARING

MAY 29, 2024

Outline

- I. Claims 1 and 6, Limitation (b) — So-Called “Viewability Test”
- II. Badros Alone (or in Combination with Krassner or Harkins) Renders Obvious Claims 1–10
- III. Badros Enables Determining Whether an Ad Is “Actually in View”
- IV. The Evidence of Secondary Indicia Deserves Little Weight
 - A. Fails to Overcome the Strong Obviousness Showing
 - B. Lacks Nexus
 - C. Testimony of Dr. Madansky
- V. § 103(c) Safe Harbor Does Not Apply because Patent Owner Has Not Demonstrated Co-Ownership “When the Invention Was Made”
- VI. The POSA Would Have Found It Obvious to Combine Badros, Krassner and Harkins

Claims 1 and 6 “Viewability Test”

Claim 1

(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, causing a communication to be sent to one or more dispatcher servers, wherein the one or more dispatcher servers are configured to:

Claim 6

(ii) in response to a determination that the predefined area has been in view within the visible area of the browser window for a predefined period of time, cause a communication to be sent from the remote computing device; and

Decision on Institution (DI)

However, Petitioner also argues that the prior art, either Badros alone or Badros in combination with Harkins, teaches the above-quoted portion of claim 1. *See* Pet. 35–40 (citing Ex. 1003, 2:9–21, 3:13–17, 5:11–21, 9:67–10:2, 11:22–24, 12:36–39, 12:48–66, 20:7–13, 22:12–15, 26:2–5; Ex. 1004 ¶76). For example, as noted by Petitioner, Badros discloses that “time-multiplexing criteria for a plurality of documents [can be] based on the time during which a document is actually viewable on the user’s screen.” Ex. 1003, 11:22–24; *see also id.* at 12:35–39 (“For instance, impression module 38 may determine whether a document (e.g., a document containing a link) is actually visible to a user, and it may track the time duration during which the document is actually visible to the user.”).

Decision on Institution

We are persuaded, from the Petition's citations and arguments, that there is a reasonable likelihood that Badros, with or without Harkins, teaches the above-quoted portion of claim 1.

Patent Owner Response (POR)

The '329 Patent expressly discloses computer code needed to implement the viewability test (columns 65-66), and the viewability test is expressly claimed in claims 1 and 6 including in “(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.” EX1001, claims 1 and 6.

Badros Distinctions in POR Are Incorrect

1. Badros disclosed viewable impressions, not served impressions
2. Badros enabled viewed impressions
 - Viewable impressions were well-known and preferably omitted from the disclosure. MPEP § 2164.05(a) (Reply, 19)
 - Badros used the fundamental client-server architecture used by all websites then and now.

POR – Served Impressions

74. As I explain below, the discussion of viewability in Badros would be interpreted by a POSA as either referring to a served impression in general or an “above the fold” “good” “high probability” impression with a higher likelihood of falling within the viewable portion of a webpage.

Pet.'s Reply – Served Impressions

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.

Pet.'s Reply – Served Impressions

4. I agree with Dr. Smedley that the person of ordinary skill in the art does not need advertising experience. As discussed in this declaration and Dr. Smedley's two declarations, the prior art clearly distinguished between served and viewed impressions. Even if the POSA did require advertising experience, it is my opinion that Dr. Smedley accurately characterized Badros and other prior art as disclosing viewability tests¹. The concept of viewable impressions was understood before 2005.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

Dr. Madansky (Substitute Ex-1026), ¶14; Pet. Rply. (Paper 50), 17 (emphasis added).

Pet.'s Reply – Served Impressions

5. In the online advertising industry during the time period from 2005-2009, there was a clear understanding of the difference between served impressions and viewable impressions. People understood that not all ads that were served were viewable for several reasons including users not scrolling to the part of the page where the ad was displayed or due to a technical issue which prevented the ad from loading properly.

POR – Badros Enablement (*How*)

Here, *both* experts agree that Badros does not teach *how* to implement a viewability test. Smedley goes farther, three times admitting that he has no opinion on whether Badros teaches the element at all, let alone enables it. Sherwood opines that Badros does not enable a viewability test. EX2045, ¶ 68-69. And the great weight of the objective indicia of non-obviousness (discussed below) confirm that it was RealVu, not Badros/Google that invented the first viewability test.

POR – Badros Enablement (*How*)

Q. So do you agree with me that Krassner does not teach how to do the viewability test?

A. Yeah.

Q. Just like Badros doesn't teach how to do its viewability test?

MR. GREENLEAF: Objection, vague.

A. Yeah, that's not a difficult thing to do, so...

EX2050, 148:9-16.

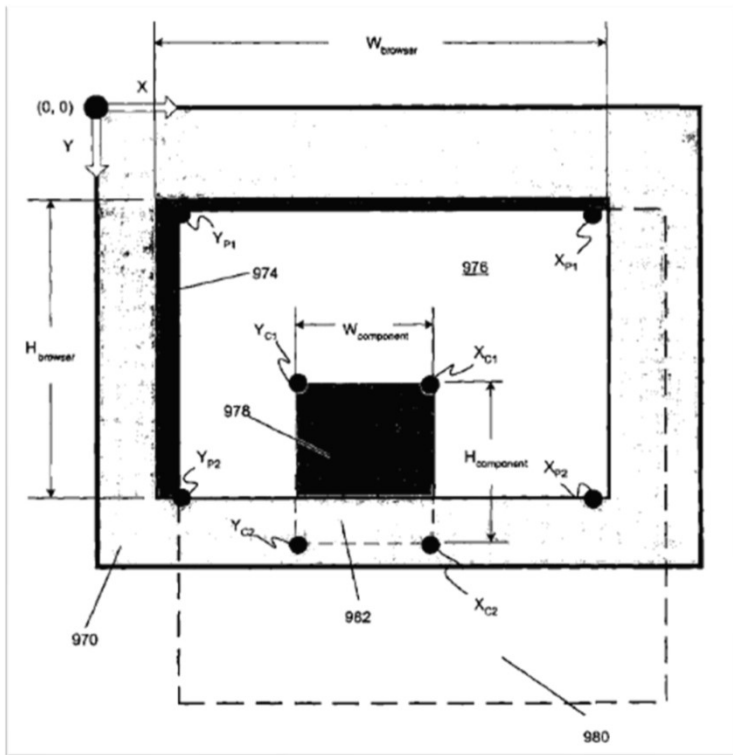
Pet.'s Reply – Badros Enablement (*How*)

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.

Pet.'s Reply – Badros Enablement (*How*)

24. Koepfel, for example, discloses a detailed algorithm from 2000 to “determine whether the target component is entirely positioned in the browser window [by] checking X and Y coordinates of both the Web page and component.”
See e.g., Ex-1025, 16:15-17 and 14:7-18:25.

Pet.'s Reply – Badros Enablement (*How*)



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.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

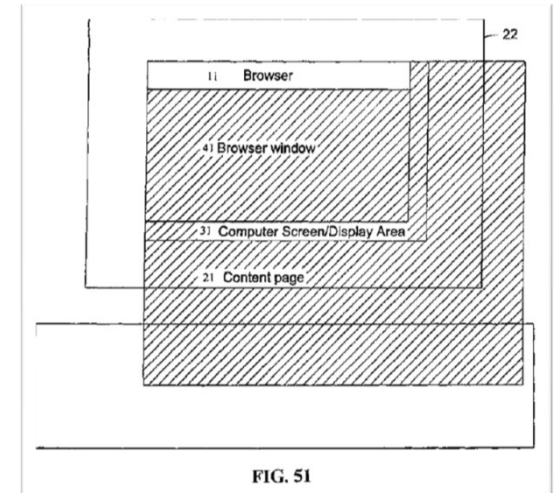
Pet. Rply. (Paper 50), 17; Koeppel (Ex-1025), FIG. 9B (Priority to September 12, 2000).

Pet.'s Reply – Badros Enablement (*How*)

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:



Pet.'s Reply – Badros Enablement (*How*)

25. Badros also describes measuring page and ad size to determine viewability:

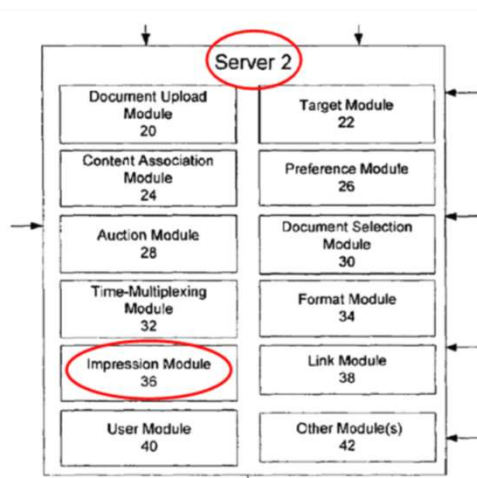
The user module 40 may also determine which of several multiplexed documents were displayed to and/or selected by a user 10. If a user selects one of the plurality of documents that is currently occupying the time-multiplexed space, the program (such as a toolbar) may determine which of the plurality of documents was displayed at the time the user made the selection and thereby determine the identify of the document (e.g., and also the identity of any link or linked document). The toolbar (or server 2) may also detect the size of the user's screen and display ads accordingly.

Ex-1003, 14:10-45.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

Dr. Smedley Dec. (Ex-1027), ¶25 (emphasis added); Pet. Rply. (Paper 50), 17.

POR – Badros Enablement (*Client-Side*)



Badros described each module as operating on the server-side of a web-based server-client architecture. *E.g.*, EX1003, 6:25-24:

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

POR (Paper 35), 20 (emphasis original); Badros (Ex-1003), FIG. 1.

Pet.'s Reply – Badros Enablement (*Client-Side*)

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.”)

Pet.'s Reply – Badros Enablement (*Client-Side*)

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.

Secondary Indicia of Nonobviousness

Volvo Penta

The Reply nowhere mentions the key Federal Circuit case: *Volvo Penta of the Americas, LLC v. Brunswick Corp.*, 81 F.4th 1202 (Fed. Cir. 2023).

Petitioner's Reply ignores the case and nowhere follows its mandate that any obviousness finding can only be after "considering the totality of the evidence of obviousness, including the teachings of the combined references in relation to secondary considerations." *Id.* at *20.

PO Sur-Reply (Paper 56), 1 (emphasis added).

Secondary Indicia of Nonobviousness

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).

Pet. Rply. (Paper 50), 20.

Secondary Indicia of Nonobviousness

Patent Owner Failed to Demonstrate
Nexus

There is no dispute that Petitioner's and
Patent Owner's products are co-extensive with the patent, establishing nexus.

PO Sur-Reply (Paper 56), 20.

Patent Owner Failed to Meet Its Burden to Establish Nexus

Here, we determine the appropriate remedy is the same as in *IBG*. We will not consider the “Analysis” column of any of the claim charts filed as Exhibits 2046 through 2049.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

Decision on Motion to Strike (Paper 49), 4; *see also*, Motion to Strike (Paper 44), 2-3; Pet. Rply, (Paper 50), 24; and CTPG, 40.

Patent Owner Failed to Meet Its Burden to Establish Nexus

The POR contains three mere conclusions citing Exs. 2046–2049: The claim charts “**show[] how Duration’s product practice [sic] the claimed invention.**” (POR, 37); They show “**how both its own service and the services provided by Duration are covered by the claimed inventions (and indeed, are coextensive with them). [...] RealVu’s content rendering and control technology embodies the claimed invention and is coextensive with it.**” (*Id.*, 52); and “**Duration’s products embody the claimed invention and are coextensive with it.**” *Id.*, 54.

Patent Owner Failed to Meet Its Burden to Establish Nexus

The expert declarations make the same superficial conclusions: “[T]he claim charts confirm[] that this revenue was generated using the ‘second print’ system that is co-extensive with what is claimed in the ’329 claims, all of this commercial success is attributable to use of a system and method as claimed.” (Ex-2045, ¶94) “[T]he claim charts [...] confirm that they accurately describe the operations of both the RealVu Content Rendering and Control system and Duration Media’s products relating to second print ads.” (Ex. 2026, ¶7). The attorney argument exists only in the claim charts. Incorporating attorney argument from exhibits violates Rule 42.6 (a)(3).

Patent Owner Failed to Meet Its Burden to Establish Nexus

As Petitioner notes, however, “the [Patent Owner Response] fails to explain how MD Trader embodies the claims.” Pet. Reply 20. The only discussion provided in Patent Owner’s Response as to how MD Trader includes the features recited in the challenged claims is a general allegation noted above that “MD Trader [is] the commercial embodiment of the invention . . . Ex. 2173, ¶¶ 20–23; Ex. 2169, ¶¶ 97, Ex. 2170, ¶¶ 24–31 Ex. 2169; Ex. 2233 (explaining how each claim element is present in MD Trader).” PO Resp. 56. Such an incorporation by reference is inappropriate, as Patent Owner’s Response fails to explain how MD Trader includes the features of the claims. See 37 C.F.R. § 42.6(a)(3) (“Arguments must not be incorporated by reference from one document into another document.”); Paper 38, 3–4 (explaining that we will not consider any arguments that are not adequately explained in the Patent Owner’s Response).

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

See Pet. Rply. (Paper 50), 24 (citing *IBG LLC v. Trading Techs. International, Inc.*, No. CBM2016-00054, Paper 61, 65 (PTAB October 17, 2017) (emphasis added)).

Secondary Considerations

No Long-Felt Need

30. The rise of programmatic advertising was the biggest factor that impacted the interest in viewability. Programmatic ads are purchased through demand side platforms (DSPs) where advertisers or their agencies can specify where they want ads to run (e.g., beauty sites, news sites, characteristics of users they want to reach and desired CPM or Cost Per Click). This differs from direct purchasing of online ad inventory from a yahoo sales rep and New York Time sales rep. When purchasing directly, advertisers knew where their ads were being placed (including where on the page they would run). With programmatic advertising, advertisers could have their ads served on 1,000s of 'long tail' sites and they could not guarantee where they were placed.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

Dr. Madansky (Substitute Ex-1036), ¶30; Pet. Rply. (Paper 50), 22 (emphasis added).

Secondary Considerations No Long-Felt Need

40. Being able to measure whether an online ad was viewable to a web user, as well as being able to measure the time that an ad was viewed was well established by the early 2000s. The industry was not focused on ‘viewability’ because there were other ways of optimizing campaigns based on performance metrics, branding metrics or return on investment. In 2004, 11 websites/organizations represented two-thirds of total industry revenue (source: Ex 2053).

Secondary Considerations

No Long-Felt Need or Commercial Success

32. In 2014 programmatic advertising represented “approximately 52 percent of display-related advertising in 2014 (\$19.6 billion)” (Ex-1052). By 2021 programmatic advertising grew to 89% of non-search placements (Ex-1051). It was this growth from 2011 to 2014 in programmatic advertising buys (where advertisers did not have as much control over their ad placements) that drove the industry to talk about viewability. This puts into context RMC’s reported revenue over an approximately 10-year period and how it was a miniscule fraction of total advertising revenue. Ex-2045, ¶93.

Secondary Considerations

No Long-Felt Need or Commercial Success

34. This is consistent with Mr. Sherwood's testimony, which only reported revenue for RealVu after 2015. Ex-2045, ¶ 93. Accordingly, there was no long-felt need for a viewability test until programmatic advertising became more prevalent.

Secondary Considerations

Failure of Others and Skepticism

The same documents demonstrate *failure by others*. Against the backdrop of an industry pressing for a viewable impression standard – and engaging the MRC to oversee its adoption – the MRC had to issue an advisory against adopting the standard because of failure by others:

Based on large-scale tests of real advertiser campaigns as detailed within, while capabilities vary, the ability to consistently measure whether impressions are viewable is a challenge that must be overcome by most of the vendors before finalizing a new online advertising currency definition.

Secondary Considerations

Industry Praise Was Self-Serving

38. In speaking to many research vendors who have considered or gone through the MRC accreditation, they have mentioned how time consuming and costly the auditing and accreditation process is. A discussion on reddit related to the MRC under the title “Need the list of auditors for MRC accreditation” (Ex-1042)

“If you can prove your tech works - do not pay the mafia.”

find cost effective auditors, because it would kill one of their cash cows. What you should do is opt out of MRC accreditation in the first place.”

- “Couldn't agree more with this statement. We are going through the process now (and have been for more than 1.5 years) and I cannot express my disdain towards the audit team working on our accreditation. The entire engagement has been lethargic, unorganized (on their end), and overall a huge money pit.”
- “On top of this, you are required to get audited every year after you obtain accreditation and that annual cost is quite expensive as well.”
- **“If you can prove your tech works - do not pay the mafia.”**

IFixTheMacros · 5 yr. ago

If you can prove your tech works - do not pay the mafia.

↑ 3 ↓ Reply Share ...

Ex-1024, 3.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

Dr. Madansky (Substitute Ex-1036), ¶38; Pet. Rply. (Paper 50), 226 (emphasis added).

Secondary Considerations

Copying – “Viewability” Was Well-Known

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.

Secondary Considerations

Copying – Independent Development

Second, Duration hired its own engineers to develop its own confidential backend software conforming to industry viewability standards, other prior art technologies, and its own innovations. Duration took great care to ensure that its software did not practice the disclosure of the patents and applications in the '329 patent family.

Secondary Indicia of Nonobviousness

The Totality of the Evidence Supports a
Finding of Unpatentability

1031	DDE-1-11-cv-00235-440 (Sherwood Daubert)
1032	JavaScript - Wikipedia.pdf
1036	ComScore v. MOAT complaint
1042	Need the list of Auditors for MRC accreditation. adops
1043	Moat Accreditation
1044	DoubleVerify Accreditation
1045	Integral Ad Science Accreditation
1046	Viewability Has Arrived_ What You Need To Know To See Through This Sea Change
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

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

Pre-AIA 35 U.S.C. 103 Conditions of patentability; non-obvious subject matter.

(c)

(1) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of [section 102](#), shall not preclude patentability under this section where 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.**

Pet. Rply. (Paper 50), 27 (citing *Arista Networks, Inc. v. Cisco Technology, Inc.*, IPR2016-00309, Paper 52 at 42 (PTAB Jun. 1, 2017)
(Patent Owner failed to meet its burden of production to prove that § 103(c) applied) (*a'ff'd*)).

§ 103(c)(1) Safe Harbor Does Not Apply

§ 103(c)(1) Safe Harbor Does Not Apply

One of the inventors, Igor Tchibirev, testified “at the time of the invention of the ’329 patent, the ’329 patent and the Krassner reference were commonly owned.” EX2026, ¶5. There is no evidence—zero—that this testimony is inaccurate.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

PO Sur-Reply (Paper 56), 24.

§ 103(c)(1) Safe Harbor Does Not Apply

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.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

Pet. Rply. (Paper 50), 28 (emphasis added).

Two Inventors Testified the Invention Was Made before Assignment

14 Q When did you start to work on the
15 viewability test?

16 A To recollect the story, I find out my
17 very first prototype pages on my old laptop, which I
18 did not use currently. And I could say that it's
19 somewhere February, March 2008.

20 I mean, viewability as geometrical
21 approach. Because we already play this viewability
22 before, have that idea in mind. But to implement it

1 as a technology, my recollection is it's somewhere,
2 say, beginning of 2008.

3 Q Okay. And so you're familiar with the
4 claimed invention in the '329 patent, correct?

5 A Yes.

6 Q So when -- when did you conceive of the
7 claimed invention in the '329 patent?

8 A I believe '329 patent was like part of
9 the family related to viewability. So. And, in
10 patent, you see long history of previous documents.
11 So we start working 2008, like, practically working,
12 and had necessity to -- to submit certain ideas as a
13 patent.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

Pet. Rply. (Paper 50), 28 (citing Igor Tchibirev (Ex-1020), 54:14-55:13) (emphasis added).

Two Inventors Testified the Invention Was Made before Assignment

11 Q When you conceived of the invention.
 12 A **Conceived of the invention?**
 13 Q Yes.
 14 A I don't remember exactly. I remember
 15 there was -- and it also depends on what you think
 16 the invention is. I remember there was a phone call
 17 between me and Nikolai and I said, can we also
 18 determine if this ad is in view -- in the window,
 19 with geometry. But I don't recall exactly when that
 20 happened. **Sometime in early 2008, I assume.**
 21 Q Okay. Yeah, I believe --
 22 A I mean, it can be --

1 Q Sorry. Go ahead.
 2 A **Yeah, that's my recollection. It's a**
 3 **long time ago. So --**
 4 Q Yes. Igor testified that it was, I
 5 think, around February. Is that -- is that
 6 consistent with your recollection, as well?
 7 A As far as like that first concept phone
 8 call? Like, when the first thing started to be
 9 talked about and worked on.
 10 Q Okay.
 11 A **Yeah, that's about right. I mean, it**
 12 **took a little while to develop, but --**
 13 Q I think Igor also said he had some
 14 prototypes in early 2008; is that your recollection
 15 as well?
 16 A **Yeah, that sounds about right.**

DEMONSTRATIVE EXHIBIT -- NOT EVIDENCE

Pet. Rply. (Paper 50), 28 (citing Edwards Testimony (Ex-1021), 8:2-9:16) (emphasis added).

All Inventors Did Not Assign until after the Invention “Was Made”

Name	Execution Date
Brad Krassner	11/24/2008
Nikolai Mentchoukov	11/24/2008
Alan Edwards	11/24/2008
Igor Tchibirev	11/20/2008

Ex-2015, 1.

Fourth/Joint Assignor:

Date: 02.26.22

Signature:



Typed Legal Name:

Fred Bernstein

Ex-1024, 14.

DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

Pet. Rply. (Paper 50), 28 (citing Edwards Testimony (Ex-1021), 8:2-9:16) (emphasis added).

Claims 3 and 8 Would Have Been Obvious

Patent Owner might argue that neither Krassner nor Badros disclose repeating the process of requesting another “*advertisement*” “*in response to a determination,*” but repeating steps is just common sense. *Google LLC v. Koninklijke Philips N.V.*, 795 F. App’x 840, 846 (Fed. Cir. 2020) (“we determined that even without experimentation, simple logic suggested that repeating the previous steps [was] obvious to try” (internal quotes omitted) (citing *Perfect Web Techs., Inc. v. InfoUSA, Inc.*, 587 F.3d 1324, 1331 (Fed. Cir. 2009))). While Krassner in combination with Badros discloses all the steps, including sending a request to a server for an advertisement, to the extent the combination is missing

The POSA Would Have Found It Obvious to Combine Badros and Harkins to Render Obvious Claims 3 and 8

Moreover, Harkins teaches *wherein the replacement auction is conducted in real time between the time the second communication is sent from the remote computing device and the time that the replacement advertisement is selected* (e.g., “a new auction for advertising in the run period Subsequent to the run period of the previously-ended auction may be initiated. However, virtually any form of new auction may be initiated without departing from the scope of the present invention.” Ex-1004, ¶76).

The POSA Would
Have Found It
Obvious to
Combine Badros
(or Krassner) and
Harkins to Render
Obvious Claims 3
and 8

However, it should be noted that although the systems and methods of the present invention will be primarily described herein using an exemplary embodiment of advertising agents and/or advertising agent locations available to print advertising including logos and the like via sales receipts (“the sales receipt advertising embodiment”), the methods and systems of the present invention are not so limited. The present invention may be implemented for provision of virtually any type of advertising (e.g., print, radio, television, Internet, billboard, etc.) via any type of advertising medium (e.g., newspaper, magazine, radio broadcast, Web pages, billboards, etc.) without departing from the scope of the present invention. Process 100 then proceeds to 104.