

Patent Owner's Demonstrative Presentation

IPR2023-00953

U.S. Patent 11,443,329

Patent Owner: Rich Media Club

Petitioner: Duration Media

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May 29, 2024

The '329 Patent

EX1001, '329 Patent, claim 1 (68:45-69:4)

1. A method comprising:

(a) determining whether a predefined area of an ad content display page that is used to display an advertisement is in view within a visible area of a browser window of a browser configured to be operated by a remote computing device, wherein the predefined area is a portion of the ad content display page, and wherein the ad content display page includes (i) the predefined area configured to display advertisement content, the predefined area being a portion of the ad content display page, and (ii) page content displayed in other portions of the ad content display page, the page content being separate from the advertisement content; and

(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:

(i) receive the communication;

(ii) cause a replacement advertisement to be selected for display on the ad content display page; and

(iii) cause the replacement advertisement to be served to the remote computing device;

wherein the browser is further configured to render the replacement advertisement in the predefined area

Ad Viewability Test

2. The method of claim 1 wherein the replacement advertisement is selected at least partially as a result of a replacement auction.

Auction

3. The method of claim 2 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.

Real-Time Auction

Replacement Ad

Petitioner Has **Not** Met Its Burden

Claim(s) Challenged	35 U.S.C. § ³	Reference(s)/Basis
1–10	103(a)	~~Krassner, Badros, Harkins~~
1–10	103(a)	~~Badros, Harkins~~

Badros & Smedley’s Admissions

Krassner, a 102(e) Reference, Is Out

Harkins Is Both Non-Analogous Does Not Teach Real-time Auction

***Volvo Penta* & Petitioner’s Legal Failure**

Petitioner Has **Not** Met Its Burden

Claim(s) Challenged	35 U.S.C. §³	Totality of the Evidence
1-10	103(a)	Long-felt need, Praise, Surprise, Failure by Others, Licensing, Copying, Commercial Success in relation to ~~Krassner, Badros, Harkins~~
1-10	103(a)	Long-felt need, Praise, Surprise, Failure by Others, Licensing, Copying, Commercial Success in relation to ~~Badros, Harkins~~

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Petitioner Has Not Met Its Burden **Badros & Smedley's Admissions**

The patent, petition and Smedley are talking about the same “**determination**” language

EX1001, '329 Patent, 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

EX1009, Smedley, at ¶65

(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:

Paper 1, Petition, at 23

Secondly, even though Krassner doesn't disclose “*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*” Badros does (e.g., “Some embodiments may apply time-multiplexing criteria for a plurality of documents based on the time during which a document is actually viewable on the user's screen.” Ex-1003, 11:22–24; “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.” *Id.* at 12:37–40). *See also*, Ex-1009, ¶¶67–68.

EX2050, Smedley Cross, at 52:10-16

10 Q. The question is, you do not have an opinion
11 about whether Badros teaches to make a
12 determination that the predefined area that
13 is used to display the advertisement has
14 been in view within the visible area of the
15 browser window for a predefined period of
16 time?

Petitioner Has Not Met Its Burden **Badros & Smedley's Admissions**

EX2050, Smedley Cross, at 50:22 – 53:6

22 Q. That's exactly my question. Is it your
23 testimony that you do not know whether Badros
24 teaches to make a determination that the
25 predefined area that is used to display the

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1 advertisement has been in view within the
2 visible area of the browser window for a
3 predefined period of time?
4 A. That's not something that I have given an
5 opinion on.
6 Q. My question is, as you sit here today, is
7 it your opinion that Badros teaches that or
8 not?
9 A. That's not something I've given an opinion
10 on here, and I can't formulate that sort
11 of opinion as we sit here. I'd have to --
12 it's something I haven't done, so I'd have
13 to sit down and analyze what he's proposed
14 carefully and it would take longer than we
15 have to sit here today.
16 Q. I want to know whether Badros teaches, in
17 your opinion, to make a determination that
18 the predefined area that is used to display
19 the advertisement has been in view within the
20 visible area of the browser window for a
21 predefined period of time?
22 A. It's not something I'm able to do as I sit
23 here right now.
24 Q. How long is it going to take you?
25 A. I don't know.

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1 Q. Well, I actually need an answer to that
2 question because I need to know whether
3 Badros teaches that or not because if it
4 doesn't teach it, I don't see how Badros
5 can invalidate, how your opinion can support
6 the petition.
7 MR. GREENLEAF: Objection, asked
8 and answered.
9 A. Is there a question there?
10 Q. The question is, you do not have an opinion
11 about whether Badros teaches to make a
12 determination that the predefined area that
13 is used to display the advertisement has
14 been in view within the visible area of the
15 browser window for a predefined period of
16 time?
17 A. That's not something I've given an opinion
18 on and it's not something I'm able to give an
19 opinion on as we sit here today.
20 Q. So as you sit here today, you are not able
21 to opine that Badros teaches to make a
22 determination that the predefined area that
23 is used to display the advertisement has
24 been in view within a visible area of the
25 browser window for a predefined period of

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1 time?
2 A. I'm not able to form an opinion about Badros
3 teaching, as I sit here today, about Badros
4 teaching, I'd say, pretty much anything
5 that I haven't already analyzed and given an
6 opinion on|

Petitioner Has Not Met Its Burden **Badros & Smedley's Admissions**

EX1009, Smedley, at ¶70 (also ¶¶ 62, 65, 68)

70. It is my opinion that Badros alone also discloses these steps. For example, Badros discloses the following:

70. It is my opinion that Badros alone also discloses these steps.

Declaration of Trevor Smedley

Some embodiments may apply time-multiplexing criteria for a plurality of documents based on the time during which a document is actually viewable on the user's screen.

Ex-1003, 11:22-24.

may determine whether a document (e.g., a document containing a link) is actually visible to a user.

Id. at 12:36-37.

and it may track the time duration during which the document is actually visible to the user.

Id., 12:38-39.

EX2050, Smedley Cross, at 51:4-23; 52:17-19; 53:2-6

4 A. That's not something that I have given an
5 opinion on.

9 A. That's not something I've given an opinion
10 on here, and I can't formulate that sort
11 of opinion as we sit here. I'd have to --

22 A. It's not something I'm able to do as I sit
23 here right now.

17 A. That's not something I've given an opinion
18 on and it's not something I'm able to give an
19 opinion on as we sit here today.

2 A. I'm not able to form an opinion about Badros
3 teaching, as I sit here today, about Badros
4 teaching, I'd say, pretty much anything
5 that I haven't already analyzed and given an
6 opinion on.

Petitioner Has Not Met Its Burden **Badros & Smedley's Admissions**

Under oath at his deposition, Smedley would **not testify that Badros teaches the “viewability test” claim element**

Petitioner Has Not Met Its Burden **Badros & Smedley's Admissions**

Petitioner Cannot Undo Smedley's Deposition Position in Reply

Paper 56, **Sur-Reply**, at 4-12

35 U.S.C. § 312(a)(3) (petition included “(A)copies of patents and printed publications that the petitioner relies upon in support of the petition; and (B) affidavits or declarations of supporting evidence and opinions, if the petitioner relies on expert opinions”);

37 CFR § 42.104(b) (Petition must “the patents or printed publications relied upon for each ground”)

TPG, 73 (On Reply, “Petitioner may not submit new evidence or argument that it could have presented earlier, e.g., to make out a prima facie case of unpatentability”).

Federal Circuit (*Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016))

“Sham Affidavit” Doctrine

Paper 50, **Reply**, at 7 EX1027, **Smedley II**, ¶ 7-26

Dr. Smedley agrees with the analysis of the Petition that Badros teaches “mak[ing] 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.” Ex-1027, ¶¶7-26. The POR falsely stated that Dr.

Petitioner's Extensive New Evidence in Reply (including 1027) Should Not Be Considered (Sur-Reply pages 4-12)

Petitioner Has Not Met Its Burden **Badros & Smedley's Admissions**

The “**Sham Affidavit**” Doctrine Precludes Smedley’s Retraction of His Retraction *Sinskey v. Pharmacia Ophthalmics, Inc.*, 982 F.2d 494, 498 (Fed. Cir. 1992)

A party cannot create an issue of fact by supplying an affidavit contradicting his prior deposition testimony, without explaining the contradiction or attempting to resolve the disparity. *See, e.g.*,  *Martin v. Merrell Dow Pharmaceuticals, Inc.*, 851 F.2d 703, 706 (3d Cir.1988);

 *Mack v. United States*, 814 F.2d 120, 124 (2d Cir.1987);  *Franks v. Nimmo*, 796 F.2d 1230, 1237 (10th Cir.1986). Where, as here, a party has been examined extensively at deposition and then seeks to create an issue of fact through a later, inconsistent declaration, he has the duty to provide a satisfactory explanation for the discrepancy at the time the declaration is filed. To allow him to preclude summary judgment simply by contradicting his own prior statements would seriously impair the utility of **Federal Rule of Civil Procedure 56**. The trial court properly disregarded the declaration in assessing the existence of a genuine issue of fact.

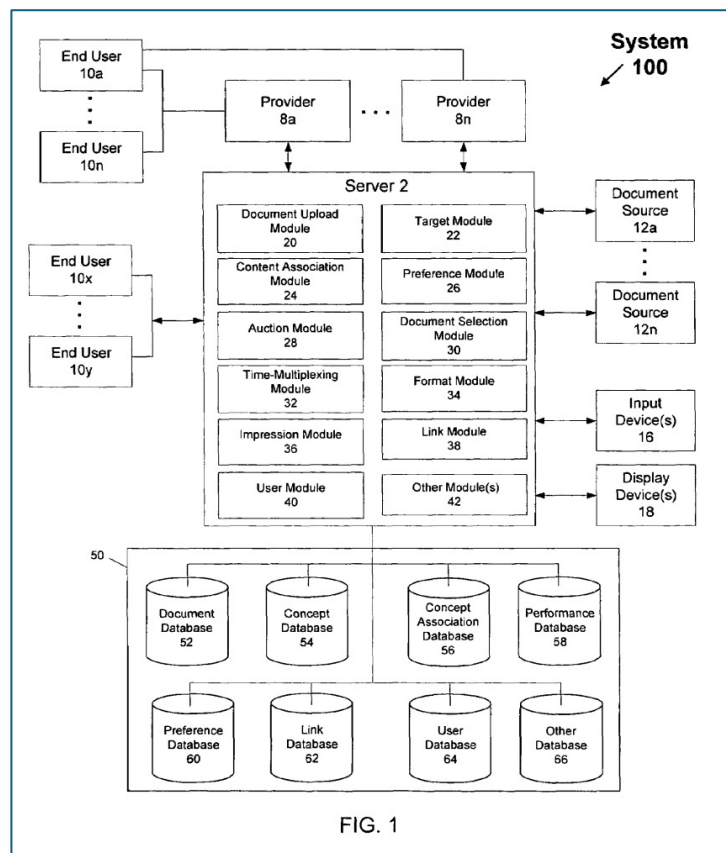
Petitioner Has Not Met Its Burden **Badros & Smedley's Admissions**

- He made the same statement **five times**
- He repeated the position after being **warned** it meant his position did not support the Petition
- The sworn deposition testimony **cannot be changed** in Reply
- ***Conclusion: The admissible evidence is that Duration's paid witness refused to testify that Badros teaches the viewability test claim element.***

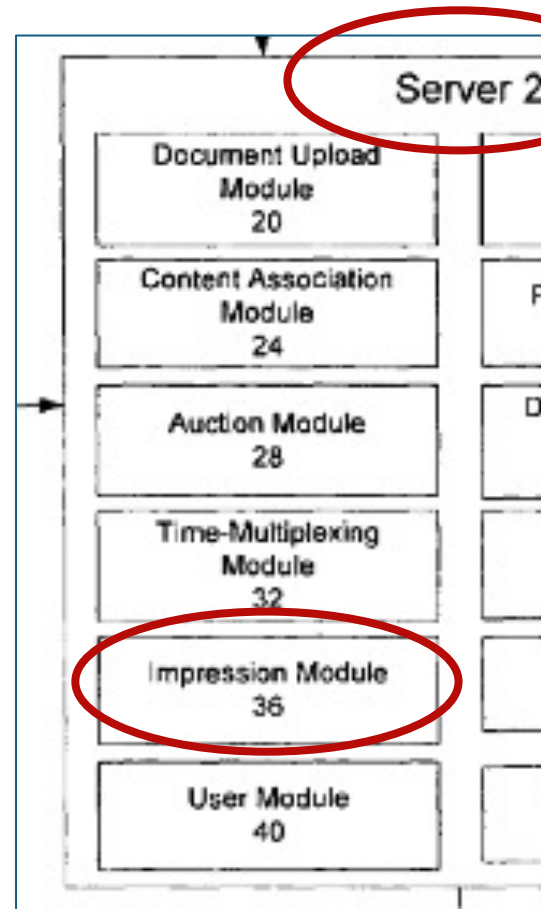
Petitioner Has Not Met Its Burden **Badros & Smedley's Admissions**

Badros' Impression Module Is On the Server

EX1003, **Badros**, at Fig. 1



EX1003, **Badros**, 12:34-47



Impression module 38 may also determine more specific and accurate information about an impression. 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. For instance, impression module 38 may determine whether an ad on a web page of a user's browser is actually visible to the user. For instance, impression module 38 may determine whether the browser is in a minimized status on the user's desktop. It may also determine when and if a particular document is actually visible on the user's desktop (or other display interface). Impression module 38 may accordingly track impressions of a document on a more accurate basis.

See also EX2050, **Smedley Cross**, at 130:13-14 (“In Figure 1 it shows the impression module inside a box marked Server 2”)

Petitioner Has Not Met Its Burden **Badros & Smedley's Admissions** **No Opinion that a Server-Side Solution Exists or that Badros Teaches One**

EX2050, **Smedley Cross**, 131-132

13 Q. I'm asking you, as you sit here today, are
14 you aware of any viewability test that is
15 conducted on the server side?
16 A. I'm not aware of that, server or client. I
17 haven't given an opinion on that.

7 Q. Can you explain how the server would
8 conduct -- well, can you explain to me how
9 Badros teaches that a server-side system
10 can conduct a viewability test?
11 A. Is that an opinion I provided?
12 Q. It's a question about Badros.
13 A. The answer is no, I haven't provided an
14 opinion on that and it's not something I can
15 provide an opinion about without careful
16 analysis.
17 Q. So, as you sit here today, you're not aware
18 of any teaching in Badros that explains how a
19 server-side system can conduct a viewability
20 test?
21 A. I would have to do careful analysis to form
22 an opinion on that.

EX2050, **Smedley Cross**, 141:23-142:4

22 in order to do that.
23 Q. As you sit here today, do you know of
24 anybody in the online Internet advertising
25 ecosystem that has ever programmed a server

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1 to conduct a viewability test?
2 A. I'm not familiar with where they have put
3 their viewability tests, so I can't answer
4 that question one way or another.
5 Q. You don't know?
6 A. That's correct.

Petitioner Has Not Met Its Burden

Badros & Smedley's Admissions

Ads Were Counted on Server; Edwards Moved Counting Ads to Client

EX1021, **Edwards Cross**, 11:10-12:10

10 Q What was your contribution to the
11 invention in the '329 patent?
12 A My contribution was the specific idea of
13 using the geometry fired by the browser to actually
14 determine if the ad space was in the viewable window.
15 So that -- yeah, I mean, that basically is what
16 happened.

17 So what happens is -- just so you
18 understand the -- prior to us arriving on the scene,
19 ad impressions or exposures were measured on the
20 server. And the server would interact with the
21 database or the log file and say how many times these
22 ads were called. But when you're living on the

12
1 server, you have no visibility into what the user is
2 doing on the user side, because that's your computer
3 where you are. Right?

4 So we had moved the counting to the
5 computer. And once you get there, the world changes.
6 You can see a lot more things because -- and we
7 started to discover what the browser would fire. And
8 at that point I realized that you could probably tell
9 if this was in the window or not based on geometry,
10 and that's -- that's -- that was my contribution.

Petitioner Has Not Met Its Burden

Badros & Smedley's Admissions

Sherwood Confirms Badros Does **Not** Teach Viewability

EX2045, **Sherwood Dec.**, ¶¶ 61-63

61. In my opinion, understanding that the reference includes the sentence relied upon in the Petition (and other, similar sentences), Badros does not teach the viewability test element.

62. I reach this opinion in part because there is no disclosure in Badros about how to actually run a viewability test. As is apparent from the industry reception when RealVu demonstrated a viewability test that worked (described below), Badros should have explained how its viewability could be programmed if the inventors at Google had actually invented technology that would change the very way internet ads were accounted for.

63. Smedley agrees that the explanation for how to do the viewability test is missing from Badros and Krassner. Ex. 2050, 148:9-16.

Petitioner Has Not Met Its Burden

Badros & Smedley's Admissions

Sherwood Confirms Badros Does **Not** Teach Viewability

EX2045, Sherwood Dec., ¶ 68

68. Badros includes discussion of what it calls an “impression module” on the server used to deliver content to end users. Ex. 1003, Fig 2. And Badros states “impression module 38 may determine whether an ad on a web page of a user’s browser is actually visible to the user.” I disagree. Badros does not teach the critical distinction between serving an ad to a user’s browser and actual viewability or seeing the ad by the user. Ad serving is not ad seeing. According to my experience, at the time Badros was filed, however, the standard for determining whether an ad had been made “visible to the user” was whether the ad had been served from the server. Hence, Badros does not teach or claim a viewable impression and further Badros does not teach how to do a viewability test and, in deference to Smedley’s opinion, it is my opinion that a POSA would not know how to program the test in 2005.

Petitioner Has **Not** Met Its Burden

Claim(s) Challenged	35 U.S.C. § ³	Totality of the Evidence
1-10	103(a)	Long-felt need, Praise, Surprise, Failure by Others, Licensing, Copying, Commercial Success in relation to ~~Krassner, Badros, Harkins~~
1-10	103(a)	Long-felt need, Praise, Surprise, Failure by Others, Licensing, Copying, Commercial Success in relation to ~~Badros, Harkins~~

Badros & Smedley’s Admissions

Krassner, a 102(e) Reference, Is Out

Harkins Is Both Non-Analogous Does Not Teach Real-time Auction

Volvo Penta & Petitioner’s Legal Failure

Petitioner Has **Not** Met Its Burden **Krassner, 102(e), Is Out**

Paper 1, Petition, at 11

A. U.S. Patent No. 10,380,602 (“Krassner”)

Krassner is an ancestor of the '329 patent, which has added matter due to a continuation-in-part between the two patents. As explained below, in § VIII below the '329 patent claims the new matter, and therefore does not have priority to Krassner. Accordingly, Krassner is prior art under pre-AIA § 102(b).

Paper 9, **Board**, at 10

Petitioner asserts that each of these references constitutes prior art under 35 U.S.C. § 102(b). *See* Pet. 11 (“Krassner is prior art under pre-AIA § 102(b)”), 12 (“Badros is prior art under pre-AIA § 102(b). . . . Harkins is prior art under pre-AIA § 102(b).”). Petitioner is mistaken. They are not prior art under § 102(b).

Petitioner Has **Not** Met Its Burden **Krassner, 102(e), Is Out**

Paper 9, **Board**, at 13

35 U.S.C. § 103. Thus, prior art under pre-AIA § 102(e) may not render a claim obvious under § 103 where both patents were commonly owned or assigned at the time the invention was made. *Id.* On this record, we note that Krassner appears to only qualify as prior art under 35 U.S.C. § 102(e).

EX2026, Tchibirev II, at ¶¶ 4-5

4. The respective inventors assigned all divisionals, continuations, and continuations-in-part of Application Nos. 11/643,245 and 60/753,536, including Application Nos. 12/384,403, 12/316,781 and 11/803,779 to Rich Media Club, LLC on December 19, 2006 and November 24, 2008. Exs. 2015, 2016.

5. At the time of the invention of the '329 Patent, the '329 Patent and the Krassner reference were commonly owned.

Petitioner Has **Not** Met Its Burden **Krassner, 102(e), Is Out**

Patent Owner established “common ownership” two ways:

- Prima facie with assignments of patents [EX2015, EX2016]
- Unrebutted testimony of Igor Tchibirev [EX2026]

***The Safe Harbor of 103(c) Applies
Krassner is not a permissible reference***

Petitioner Has **Not** Met Its Burden

Claim(s) Challenged	35 U.S.C. § ³	Totality of the Evidence
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Badros & Smedley’s Admissions

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***Volvo Penta* & Petitioner’s Legal Failure**

Petitioner Has Not Met Its Burden **Harkins' Printed Receipts Are Non-Analogous**

EX1004, **Harkins**, Fig. 7

FIG. 7

CUSTOMER COPY

Town Restaurant 702
123 Main Street
Any Town, NJ 12345
555-555-5555 704

Date: 12/17/06 706
Time: 7:19 PM 708
Server: 76. Katie T. 710
Order: 19879 712
Description: Table 9 714

Card Type: AMEX 716
Card No: XXXXXXXXXXXX5006

Purchases: \$ 129.20 718
\$ 129.20 720
Tip: \$ 21.72 722
Subtotal: \$ 150.92 724
Add'l Tip: \$ 726
Total: \$ 728

SMITH/JOHN
I agree to pay the above total amount
according to the card issuer agreement.
X 730

MANUFACTURER'S COUPON EXPIRES: 6/30/10
SAVE \$1.00
On any sun block product 732
RETAILER: 734
000000 000000 000000 000000 000000 000000

EX2045, **Sherwood**, ¶ ¶ 76-77

76. As a part of my examination, I reviewed U.S. Patent Application 2008/0221982 (Harkins). This is a patent application relating to printing ads on a paper receipt when a user pays with a credit card. It has nothing to do with internet advertising, so it obviously does not address whether an advertisement is viewable on the internet.

77. Ground 2 of the Petition relies on Harkins for an element in dependent claims 3 and 8: the running of a real-time auction to replace an ad. Paper 1 at 42. But Harkins does not do this. It does not contain the word or concept of a “real time” auction and the use of Harkins for the supposed disclosure necessarily fails.

Harkins Does not Teach a Real Time Auction

Petitioner Has **Not** Met Its Burden

Claim(s) Challenged	35 U.S.C. §³	Totality of the Evidence
1-10	103(a)	Long-felt need, Praise, Surprise, Failure by Others, Licensing, Copying, Commercial Success in relation to ~~Krassner, Badros, Harkins~~
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Badros & Smedley’s Admissions

Krassner, a 102(e) Reference, Is Out

Harkins Is Both Non-Analogous Does Not Teach Real-time Auction

Volvo Penta & Petitioner’s Legal Failure

Petitioner Has Not Met Its Burden *Volvo Penta* & Petitioner's Legal Failure

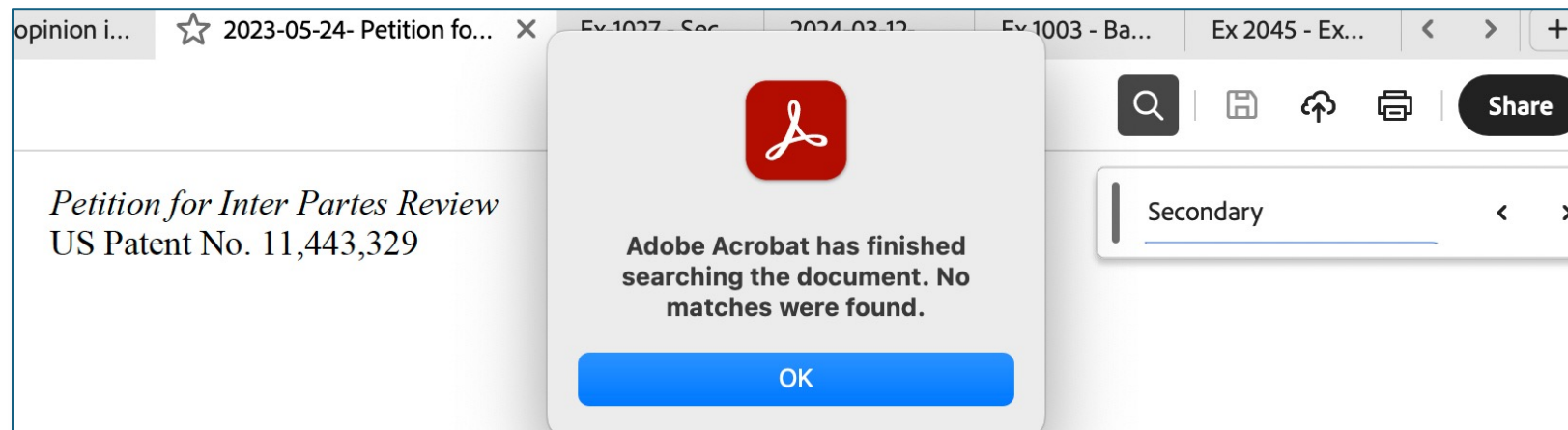
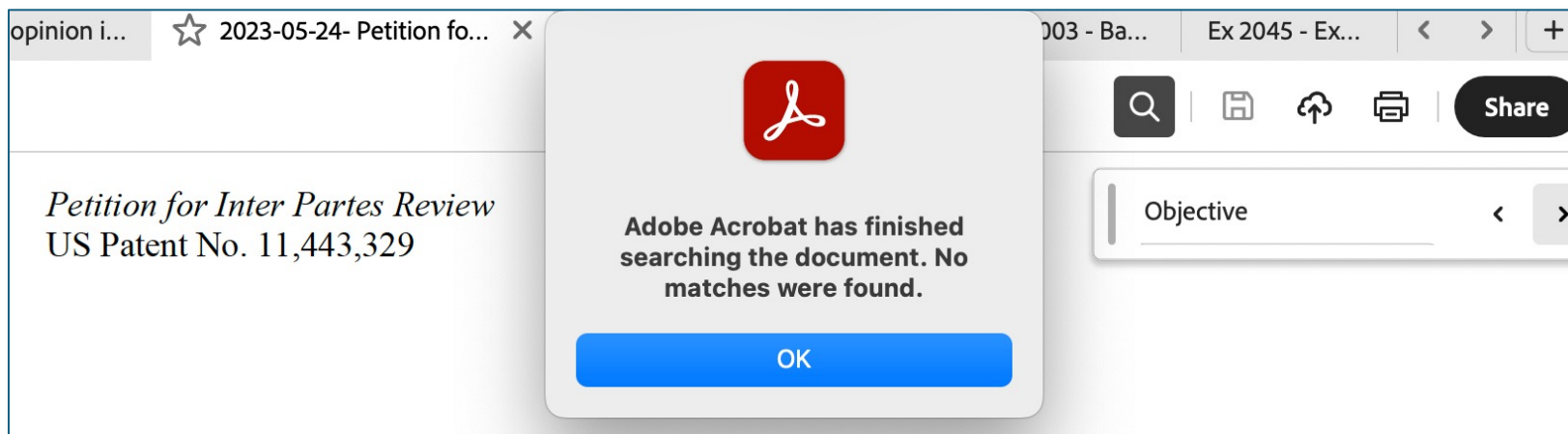
Volvo Penta, at *20

For the aforementioned reasons, we conclude that the Board failed to properly consider the evidence of objective indicia of nonobviousness. We therefore vacate and remand for further consideration consistent with this opinion. The Board should make additional findings as needed, considering the totality of the evidence of obviousness, including the teachings of the combined references in relation to secondary considerations. *Brown & Williamson*, 229 F.3d at 1124 ("The ultimate determination of whether an invention would have been obvious is a legal conclusion based on the totality of the evidence.").

- **The Petition did not address objective indicia**
- **Smedley did not address objective indicia (but insisted he considered them)**
- **The Reply did not cite or discuss *Volvo Penta* and nowhere applies the totality of the evidence test**
- **Patent Owner's objective indicia evidence is**
 - ***Admitted (no motion to exclude)***
 - ***Unrebutted***
 - ***One-sided***
 - ***Persuasive***

Petitioner Has **Not** Met Its Burden ***Volvo Penta*** & Petitioner's Legal Failure

The Petition Did Not Consider Objective Indicia



Petitioner Has Not Met Its Burden *Volvo Penta* & Petitioner's Legal Failure

Smedley Says He Did – But He Did Not – Consider Objective Indicia

EX2050, **Smedley Cross**, at 20:2-23

2 Q. All right. My question is referring only
3 to this case. You did not consider any of
4 the secondary considerations of
5 non-obviousness in forming your opinions?
6 A. I wouldn't agree with that, no.
7 Q. Which of the -- why don't you show me your
8 report in this case, Exhibit 1009, where you
9 describe consideration of any of the
10 secondary considerations of non-obviousness
11 A. I don't recall specifically if I have, if I
12 did, where that would be. I'd have to search
13 through to see whether it was there or not.
14 Q. Well, take your time. Let me know where it
15 is in your report.
16 A. (Witness examines document) I don't see
17 anywhere where I have given an opinion on
18 secondary considerations.
19 Q. Is it your testimony that while you didn't
20 give any opinion on objective evidence of
21 non-obviousness, you did, however, consider
22 it?
23 A. Yes.

EX2050, **Smedley Cross**, at 22:2-25

2 A. So I wouldn't be able to answer that sort
3 of question really about anything, like what
4 specific things I did for some very specific
5 fine-grained aspect of my analysis. It was,
6 part of my analysis was considering the
7 secondary considerations.
8 Q. And my question is how could you consider
9 them if you didn't investigate them?
10 A. Well, I didn't say I didn't investigate them.
11 Q. Let's talk about what investigation you did
12 do. Did you investigate whether there was
13 a long-felt but unmet need in the prior art
14 that was satisfied by the claimed invention?
15 A. As I said, I'm not going to be able to answer
16 that type of question because I don't commit
17 to memory every aspect of my analysis
18 connected with each sort of fine-grained
19 investigation that I do.
20 Q. As you sit here today, can you identify a
21 single thing you did to investigate whether
22 there was a long-felt but unmet need in the
23 prior art that was satisfied by the claimed
24 invention?
25 A. As I sit here today, I cannot identify that,

EX2050, **Smedley Cross**, at 23:1-24

Page 23
1 no.
2 Q. As you sit here today, can you identify a
3 single thing you did to determine whether
4 there was commercial success of the processes
5 covered by the patent?
6 A. As I sit here today, I can't recall them.
7 Q. As you sit here today, can you identify
8 anything you did to determine whether there
9 were unexpected results achieved by the
10 invention?
11 A. As I sit here today, I cannot identify that,
12 no.
13 Q. As you sit here today, can you identify any
14 effort you did to determine if there was
15 praise of the invention by others skilled in
16 the art?
17 A. As I sit here today, I can't specifically
18 identify anything like that, no.
19 Q. You would have the same answer, as you sit
20 here today, that you can't identify anything
21 you did regarding determining whether there
22 was taking of licenses under the patents by
23 others?

Petitioner Has Not Met Its Burden ***Volvo Penta*** & Petitioner's Legal Failure

Timeline 1: The Invention & Its Reception

David Cohen Meeting and Blog Post [EX2024]
Nov 10, 2009

Industry Surprise & Praise

"Rocked your world"

"We certainly don't need any more Wall Street Journal articles on 'invisible ads' or trade publications exposing the dangers of ad networks, click frauds, below the fold ad placements, etc. So, you can understand my dilemma after I met with ReaVu last week. Part of me wanted to forget the meeting ever happened. The other part of me thought this little known Salt Lake City startup could change everything."

"ReaVu has developed a technology that allows them to identify when an online ad is within the viewable area" of a user's screen, and for what duration."

"giant step forward for the industry"

HBR: The Dark underbelly of Online Advertising" [EX2062]
Nov 17, 2009

Felt Need

The Dark Underbelly of Online Advertising
By Benjamin Edelman
November 17, 2009

RealVu MRC Viewable Impression Accreditation [EX2017]
Apr 13, 2010

First Company Accredited for Viewable Impression [EX2039]

Independent confirmation that ReaVu solution worked.

Signed by George Ivie
MRC Exec. Dir. & CEO

Press Release re Viewability Accreditation [EX2042]
June 7, 2010

Industry Surprise & Praise

Cohen: "It also changes many of the fundamental tenets of our industry. It really could change everything."

Kim: "MSNBC believes that premium publishers can now use this technology to bring accountability and value to advertisers by running their brand messages in trusted environments where they know they will be actually seen."

Stuart: "we missed a major factor by not accounting for whether an ad has the potential to be viewed on the screen."

Ivie: "ReaVu 'essentially invented viewability'" [EX2035]
Dec 14, 2011

Industry Praise

"The 3MS committee isn't exactly starting from scratch. The MRC's rigorous accreditation process, through which it can take metrics providers to task, has a number of products both within and at the forefront end of its expertise that are addressing some of these elements. I've pointed to a product accredited over two years ago by Salt Lake City-based RealVu, for instance, which the panel 'essentially invented viewability,' along with other products currently under review by committee. Nathan and Christine

Making Measurement Make Sense Initiative Starts
June 30, 2011

Felt Need

Precise date unclear, but sometime in 2011

ANA iab. 3MS

Viewability Panel -IAB Ad Ops Summit [EX2054]
November 2011

Felt Need; Industry Surprise & Praise

George Ivie: "Viewability is on the map." "3MS Initiative coming out"

David Cohen: "I met with ReaVu just about the same time George did and I was equally kind of astounded"

Julian Zilberbrand: "I met with ReaVu about the same time as [Cohen] did. Also very impressive"

3MS Initiative Website [EX2029]
Jul 7, 2012

Felt Need

MRC Viewable Impression Advisory [2018]
Nov 14, 2012

Felt Need & Failure by Others

"Aligned with the Making Measurement Make Sense (3MS) initiative's recommendation, the MRC believes that online advertising impressions, particularly for brand advertising campaigns, should be viewable"

"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."

Google Active View Accredited [EX2039]
April 2013

Google Active View
Accredited (April 2013)

Page Geometry
Google Display Network (GDN):
Dependent on publisher placing ad code directly on page.
DFA: No independent capability to measure viewability within cross domain iframes; offers publishers pub-side file, the use of which allows for measurement within iframes.
No use of protection for viewability. Reports viewability only for those impressions it measures.

2013 IAB Annual Report [EX2028]
Jan 2014

Felt Need

2009

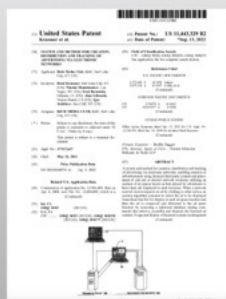
2010

2011

2012

2013

'329 Application Date [EX1001]
April 4, 2009



David Cohen Meeting and Blog Post [EX2024]
Nov 10, 2009



Industry Surprise & Praise

"Rocked your world"

"We certainly don't need any more Wall Street Journal articles on 'invisible ads' or trade publications exposing the dangers of ad networks, click frauds, below the fold ad placements, etc. So, you can understand my dilemma after I met with RealVu last week. Part of me wanted to forget the meeting ever happened. The other part of me thought this little known Salt Lake City startup could change

everything."

"RealVu has developed a technology that allows them to identify when an online ad is 'within the viewable area' of a user's screen, and for what duration."

"giant step forward for the industry"

HBR: The Dark underbelly of Online Advertising [EX2024]
Nov 17, 2009



Felt Need

RealVu MRC Viewable Impression Accreditation [EX2017]
Apr 13, 2010
First Company Accredited for Viewable Impression [EX2038]
Independent confirmation that RealVu solution worked.

Nov 10, 2009
Cohen Meeting and Blog Post [EX2024]
Industry Surprise & Praise
"Rocked your world"
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"RealVu has developed a technology that allows them to identify when an online ad is 'within the viewable area' of a user's screen, and for what duration."
"giant step forward for the industry"

HBR: The Dark underbelly of Online Advertsing" [EX2062]
Nov 17, 2009



Felt Need

RealVu MRC Viewable Impression Accreditation [EX2037]
Apr 13, 2010
First Company Accredited for Viewable Impression [EX2039]
Independent confirmation that RealVu solution worked.
Signed by George Ivie
MRC Exec. Dir. & CEO

Press Release re Viewability Accreditation [EX2042]
June 7, 2010
Industry Surprise & Praise
Cohen: "It also changes many of the fundamental tenets of our industry. It really could change everything."

Kim: "RealVu believes that premium publishers can now use this technology to bring transparency and value to advertisers by running viewable ad campaigns in premium environments where they know they will be seen."

Viewability Panel - Ad Ops Summit [EX2054]
November 2011
Felt Need, Industry Surprise & Praise
George Ivie: "Viewability is on the map." "MRC initiative going full"

David Cohen: "I met with RealVu just about the same time George did and I was equally kind of astounded"

Julian Zlotnik: "I met with RealVu about the same time as [Cohen] did. Also very impressive"

MRC Viewable Impression Accredits [EX2055]
Nov 14, 2011
Felt Need & Industry Surprise
Signed with the MRC, RealVu has been the first company to be accredited for viewable impressions, a critical metric for advertising campaigns. It's a big deal."

Google AdWords Viewability [EX2056]
Nov 14, 2011
Felt Need
AdWords Viewability: Google has announced that it will be introducing a new metric for measuring the effectiveness of AdWords campaigns. This metric, called Viewability, will measure the percentage of AdWords ads that are actually seen by users. This is a significant change from the previous metric, which measured the percentage of ads that were served to users. This change is a result of the growing importance of viewability in the advertising industry. Google is the first major search engine to introduce this metric, and it is expected that other search engines will follow suit.

...a technology that allows them to identify when an online ad is
...Lake City startup could change
...happened. The other part
...viewable area' of a user's screen, and for what duration."
"giant step forward for the industry"

HBR: The Dark underbelly of Online Advertsing* [EX2062]
Nov 17, 2009

Harvard
Business
Review

**The Dark Underbelly of Online
Advertising**
by Benjamin Edelman

November 17, 2009

Felt Need

RealVu MRC Viewable Impression Accreditation [EX2017]
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Press Release re Viewability Accreditation [EX2042]
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Industry Surprise & Praise

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RealVu MRC Viewable Impression Accreditation [EX2017]
Apr 13, 2010



First Company Accredited for Viewable Impression [EX2039]
Independent confirmation that RealVu solution worked.
Signed by George Ivie
MRC Exec. Dir. & CEO

Making Measurement Make Sense Initiative Starts
June 30, 2011



Viewability Panel - IAB Ad Ops Summit [EX2054]
November 2011

Felt Need
Precise data unclear, but sometimes

MRC Viewable Impression Accreditation [EX2017]
Apr 13, 2010

"Signed with the Making Measurement Make Sense (MMS) initiative, we've recommended the MRC, which is the only advertising measurement, particularly for advertising campaigns, should be avoided."

Press Release re Viewability Accreditation [EX2042]
June 7, 2010



Industry Surprise & Praise

Cohen: "It also changes many of the fundamental tenets of our industry. It really could change everything."

Kim: "MSNBC believes that premium publishers can now use this technology to bring accountability and value to advertisers by running their brand messages in trusted environments where they know they will be actually seen."

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Ivie: "RealVu 'essentially invented viewability'" [EX2035]
Dec 14, 2011

The 3MS committee isn't exactly starting from scratch. The MRC's rigorous accreditation process, through which it can take metrics products years to pass, has a number of products both within and at the frontier end of its pipeline that are addressing some of these standards. I've pointed to a product accredited over two years ago by Salt Lake City-based RealVu, for instance, which he said "essentially invented viewability," along with other products currently under review by comScore, Nielsen and Omniture.

Industry Praise

Making Measurement Make Sense Initiative Starts
June 30, 2011

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Accredited by Media Rating Council

Felt Need

Precise date unclear, but sometime in 2011

Viewability Panel - IAB Ad Ops Summit [EX2054]
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Google Active View Accredited [EX2036]
April 2013

Google Active View
Accredited April 2013

Page Summary
Google Display Network (GDN)
Dependent on publisher placing ads directly on page.
GDN has independent capability to measure viewability within cross domain frames, after publishers publish the code of which allows for measurement within frames.
No use of projection for viewability.
Requires viewability only for those impressions & requests.

2013 AG Annual Report [EX2038]
July 2014

EX2039]

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Making Measurement Make Sense Initiative Starts
June 30, 2011



Felt Need

in 2011

Precise date unclear, but sometime

Industry Praise

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Lake City-based ReaVu, for instance, which he said
"essentially invented viewability," along with other
products currently under review by comScore, Nielsen
and Omniture.

MRC Viewable Impression Advisory [2018]
Nov 14, 2012

Felt Need & Failure by Others

*Aligned with the Making Measurement Make Sense Initiative

Viewability Panel -IAB Ad Ops Summit [EX2054]
November 2011



Felt Need; Industry Surprise & Praise

George Ivie: "Viewability is on the map." "3MS Initiative coming out"

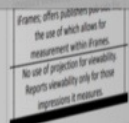
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3MS Initiative Website [EX2038]
Jul 7, 2012



Felt Need



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Dec 14, 2011

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Industry Praise

MRC Viewable Impression Advisory [2016]
Nov 14, 2012

Felt Need & Failure by Others

"Aligned with the Making Measurement Make Sense (3MS) initiative's recommendation, the MRC believes that online advertising impressions, particularly for brand advertising campaigns, should be viewable"

"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."

Making Measurement Make Sense Initiative Starts
June 30, 2011



Felt Need

Precise date unclear, but sometime

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Viewability Panel - IAB Ad Ops Summit [EX2054]
November 2011

Felt Need; Industry Surprise & Praise

George Ivie: "Viewability is on the map." "3MS Initiative coming out"

David Cohen: "Now with RealVu, it's about the same time as [Cohen] did of astounded"

Case No. IPR2023-00953 U.S. Patent 11,329 Patent

Owner's Demonstrative Exhibit-Not Evidence

Google Active View Accredited [EX2038]
April 2013

Google Active View
Accredited (April 2013)

Page Geometry
Accredited (April 2013)





...ps Summit [EX2054]

Felt Need; Industry Surprise & Praise

George Ivie: "Viewability is on the map." "3MS Initiative coming out"

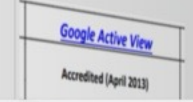
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Google Active View Accredited [EX2039]
April 2013



3MS Initiative Website [EX2029]
Jul 7, 2012

Felt Need

2013 IAB Annual Report [EX2028]
Jan 2014



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3MS Initiative Website [EX2029]
Jul 7, 2012

Felt Need

MRC Viewable Impression Advisory [2018] Nov 14, 2012



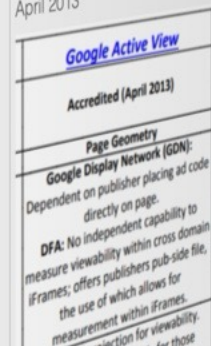
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must be overcome by most of the vendors before finalizing a new online advertising currency definition."

Google Active View Accredited [EX2033]
April 2013



2013 IAB Annual Report [EX2028]
Jan 2014



Case No. 1:11-cv-00953 U.S. Patent 11,443,329 Patent
Owners' Demonstrative Exhibit-Not Evidence

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3MS Initiative Website [EX2029]
Jul 7, 2012



Felt Need

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Google Active View Accredited [EX2039]
April 2013

<u>Google Active View</u>
Accredited (April 2013)
Page Geometry
Google Display Network (GDN): Dependent on publisher placing ad code directly on page.
DFA: No independent capability to measure viewability within cross domain iFrames; offers publishers pub-side file, the use of which allows for measurement within iFrames.
No use of projection for viewability. Reports viewability only for those impressions it measures.

2013-14 Annual Report [EX2028]
Jan 2014



2012

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Google Active View Accredited [EX2039]
April 2013

<u>Google Active View</u>
Accredited (April 2013)
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2013 IAB Annual Report [EX2028]
Jan 2014



Felt Need

2013

Petitioner Has Not Met Its Burden ***Volvo Penta*** & Petitioner's Legal Failure

**Timeline 2: Duration Licenses & Succeeds, and then
Duration Copies & Succeeds**

RealVu Generates \$XX Million in Sales [EX2026]
Jan 2015 – Dec 2023
Commercial Success
[Confidential]

RealVu-Duration NDA [EX2019]
Aug 4, 2018



RealVu-Duration Cooperation Agreement [EX2009]
Sep 24, 2018



Licensing
"COOPERATION and LICENSE: Duration and RMC shall cooperate to screen all Ad spaces for viewability"
"RVC shall work with Duration to integrate the Rich Media Club LLC IP with the Duration Media platform to allow Duration to screen ad spaces purchased in real time for viewability leading to a high conversion rate into viewable impressions"

Explained in Tchibrev II [EX2026]

2019: Duration earns \$xx Million Using RMC Tech [EX2055]
Jan 1 – Dec 31, 2019
Licensing and Commercial Success
[Confidential]

2020: Duration earns \$xx Million using RMC Tech [EX2055]
Jan 1 – Dec 31, 2020
Licensing and Commercial Success
[Confidential]

Duration sends RealVu 'intent to renew' Email [EX2051]
Jun 2, 2020



Explained in Tchibrev II [EX2026]

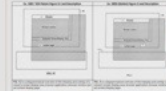
Secret: Duration Copies RealVu's Technology [EX2014]
Jun 2 – Sep 2, 2020



Copying
Compare EX2013
Tchibrev I [EX2025]

"8. Duration Media copied virtually every aspect of the technology it had been purchasing from RealVu, including: (1) determining whether an ad space was in or near the viewable area of user's browser; (2) in the event viewable ad space was confirmed, invoking a real-time bidding auction to sell the viewable ad space; and (3) replacing the original ad with the ad that was sold using the auction." See also 9, 13

Secret: '210 Patent Plagiarizes '329 Specification [EX2005, EX2007, EX2008]
Aug 6, 2020



Copying
Tchibrev I [EX2025]
"All of the figures depict preferred embodiments"

Paragraph 21: Figures and descriptions copied; other extensive copying documented.

Secret: Duration files '210 Patent App [EX2005]
Aug 6, 2020



Copying
The copied patent explains how Duration's technology works, and it works the same way RealVu's does.

Duration Earns Another \$xx Million Using Copied Tech [EX2055]
Jan 1, 2021 – Dec 4, 2023
Copying and Commercial Success
[Confidential]

'210 Patent Describes Duration's Product [EX2023]
Dec 22, 2021



Copying and Commercial Success

Duration Terminates Agreement [EX2026]
Sep 2, 2020

RealVu Generates \$XX Million in Sales [EX2026]

Jan 2015 – Dec 2023

Commercial Success

[Confidential]

2016

2017

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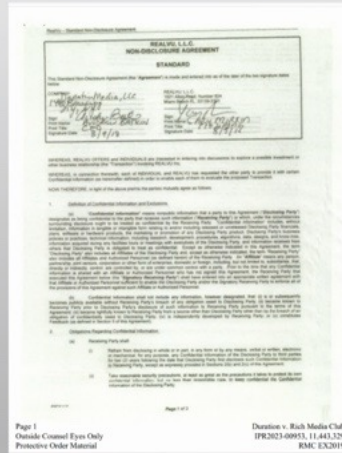
2020

2021

2022

2023

RealVu-Duration NDA [EX2019] Aug 4, 2018



RealVu-Duration Cooperation Agreement [EX2009] Sep 24, 2018



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Using RMC Tech [EX2055]



Secret: Duration Copies RealVu's Technology [EX2014] Jun 2 - Sep 2, 2020



Copying

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Secret: 210 Patent Plagiarizes 338 Specification [EX2005, EX2007, EX2008] Aug 6, 2020



Copying

Tchibrev I [EX2025]

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Secret: Duration files 210 Patent App [EX2005] Aug 6, 2020



Copying

The copied patent explains how Duration's technology works, and it works the same way RealVu's does.

Duration Earns Another \$60 Million Using Copied Tech [EX2005] Jan 1, 2021 - Dec 4, 2023

Copying and Commercial Success

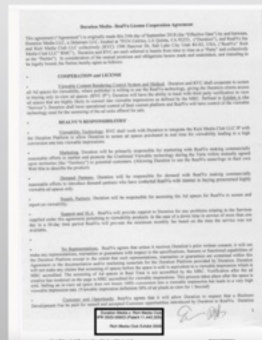
[Confidential]



210 Patent Describes Duration's Product [EX2005]
Dec 30, 2021

Copying and Commercial Success

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Explained in Tchibirev II [EX2026]

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Jan 1 – Dec 31, 2019

Licensing and Commercial Success

[Confidential]

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Jan 1 – Dec 31, 2020

Licensing and Commercial Success

[Confidential]

Duration Terminates Agreement [EX2028]
Sep 2, 2020

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Jan 1 – Dec 31, 2021

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Licensing and Commercial Success

[Confidential]

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Licensing and Commercial Success

[Confidential]

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Sep 2, 2020

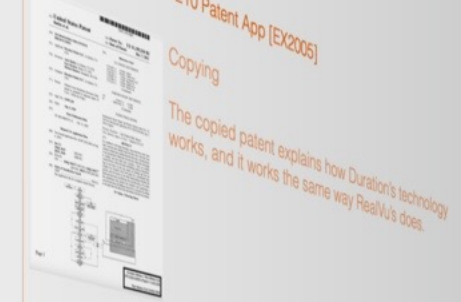
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Copying and Commercial Success

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[EX2026]

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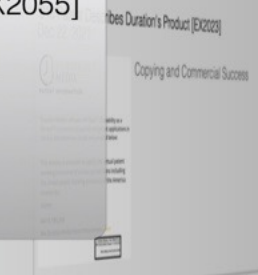
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[Confidential]



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[Confidential]

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Licensing and Commercial Success
[Confidential]

Duration Terminates Agreement [EX2026]
Sep 2, 2020



Duration sends RealVu "intent to renew" Email [EX2051] Jun 2, 2020

Duration Media LLC
1209 Orange Street
Wilmington DE 19801

June 11, 2020

Attn: Gary Minkin
President
RealVu Inc.

Dear Gary,

As per the agreed upon terms stated in the "Extension Term and Renewal" section of the "Extension 2019 RealVu Inc Duration Media LLC Agreement" dated September 1, 2019 please accept this letter as our notice of intent to renew the agreement beyond the "Extension Term" which ends on September 24, 2020.

Please confirm receipt of this notice and also please let me know some dates/times that would work for you to begin discussions on next steps.

Thank you,

Andrew

Andrew Pancer
CEO
Duration Media
6/11/2020

Explained in Tchibirev II [EX2026]

Secret: Duration Copies RealVu's Technology [EX2014] Jun 2 – Sep 2, 2020



Copying

Compare EX2013

Tchibirev I [EX2025]

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Patent Plagiarizes '329 Specification [EX2005, EX2007,

[illegible]

Secret: Duration Copies RealVu's Technology [EX2014]
Jun 2 – Sep 2, 2020

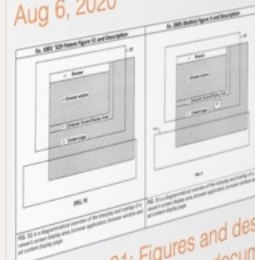


Copying

Compare EX2013

Tchibrirev I [EX2025]

Secret: '210 Patent Plagiarizes 329 Spec
EX2008]
Aug 6, 2020



Copying

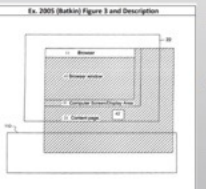
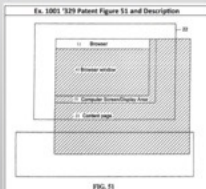
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at: Duration files '210 Patent App [EX2005]

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Tchibrerev I [EX2025]

"8. Duration Media copied virtually every aspect of the technology it had been purchasing from RealVu, including: (1) determining whether an ad space was in or near the viewable area of user's browser; (2) in the event viewable ad space was confirmed, invoking a real-time bidding auction to sell the viewable ad space; and (3) replacing the original ad with the ad that was sold using the auction."

Secret: '210 Patent Plagiarizes '329 Specification [EX2005, EX2007, EX2008]
Aug 6, 2020



Copying
Tchibrerev I [EX2025]
"All of the figures depict preferred embodiments"

Paragraph 21: Figures and descriptions copied; other extensive copying documented.

Secret: Duration files '210 Patent App [EX2005]
Aug 6, 2020

Copying
The copied patent explains how Duration's technology works, and it works the same way RealVu's does.

Duration and RMC
spaces for viewabili-

to integrate the Rich
ation Media platform
urchased in

Duration Earns Another \$xx Million Using Copied Tech [EX2055]
Jan 1, 2021 - Dec 4, 2023
and Commercial Success

'210 Patent Describes Duration's Product [EX2023]
2021
Copying and Commercial Success

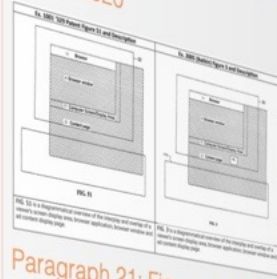
Duration and RMC
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to a high conversion

ng RMC Tech [EX2055]

2020: Duration earns \$xx Million using RMC Tech [EX2055]
Jan 1 – Dec 31, 2020
Commercial Success

Secret: '210 Patent Plagiarizes '329 Specification [EX2005, EX2007,
EX2008]
Aug 6, 2020



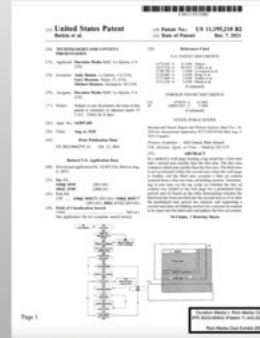
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Duration Earns Another \$xx Million Using Copied Tech [EX2055]
Jan 1, 2021 – Dec 4, 2023

Copying and Commercial Success

[Confidential]

'210 Patent Describes Duration's Product [EX2028]
Dec 22, 2021



Copying and Commercial Success

2020

2020: Duration earns \$xx Million using RMC Tech [EX2055]
Jan 1 – Dec 31, 2020
Licensing and Commercial Success
[Confidential]

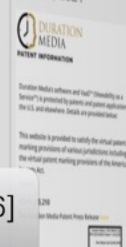
2021

Duration Earns Another \$xx Million Using Copied Tech [EX2055]
Jan 1, 2021 – Dec 4, 2023
Copying and Commercial Success
[Confidential]

Duration Terminates Agreement [EX2026]
Sep 2, 2020

2022

'210 Patent Describes Duration's Product [EX2023]
Dec 22, 2021
Copying and Commercial Success



2023

Secret: Duration files '210 Patent App [EX2005]
Aug 6, 2020



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The copied patent explains how Duration's technology works, and it works the same way RealVu's does.

Duration Earns Another \$xx Million Using Copied Tech [EX2055]

Jan 1, 2021 – Dec 4, 2023

Copying and Commercial Success

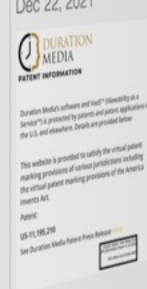
[Confidential]

2020: Duration earns \$xx Million using RMC Tech [EX2055]
Jan 1 – Dec 31, 2020
Copying and Commercial Success

[Confidential]

Duration Terminates Agreement [EX2026]
Sep 2, 2020

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Copying and Commercial Success

2022

2023

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Jan 1, 2021 – Dec 4, 2023
Copying and Commercial Success
[Confidential]

'210 Patent Describes Duration's Product [EX2023]
Dec 22, 2021



Copying and Commercial Success

s Agreement [EX2026]

2022

21

Petitioner Has **Not** Met Its Burden ***Volvo Penta*** & Petitioner's Legal Failure

Invention Timeline Shows Admissible, Unrebutted Facts Demonstrating

- Industry Surprise & Commercial Praise
- Long-felt Need & Failure by Others

Duration-RealVu Timeline Shows Admissible, Unrebutted Facts Demonstrating

- RealVu's Own Commercial Success
- Duration's Licensing & Commercial Success
- Duration's Copying & Commercial Success

Petitioner Has **Not** Met Its Burden **Volvo Penta** & Petitioner's Legal Failure

The totality of the evidence of obviousness, including the teachings of the combined references in relation to secondary considerations

- **Badros, which Smedley will not testify teaches the viewability test claim element**
- **Industry surprise, commercial, praise, long-felt need & failure by others for RealVu's viewability solution**
- **Harkins, which is non-analogous and does not teach a real-time auction**
- **RealVu's own commercial success, Duration's licensing & commercial success, Duration's copying and commercial success of specifically the approach set forth not only in claims 1 & 6, but claims 2, 3 (real-time auction viewable ad replacement), 7 & 8 (real-time auction viewable ad replacement).**

Petitioner Has **Not** Met Its Burden ***Volvo Penta*** & Petitioner's Legal Failure

The totality of the evidence of obviousness, including the teachings of the combined references in relation to secondary considerations

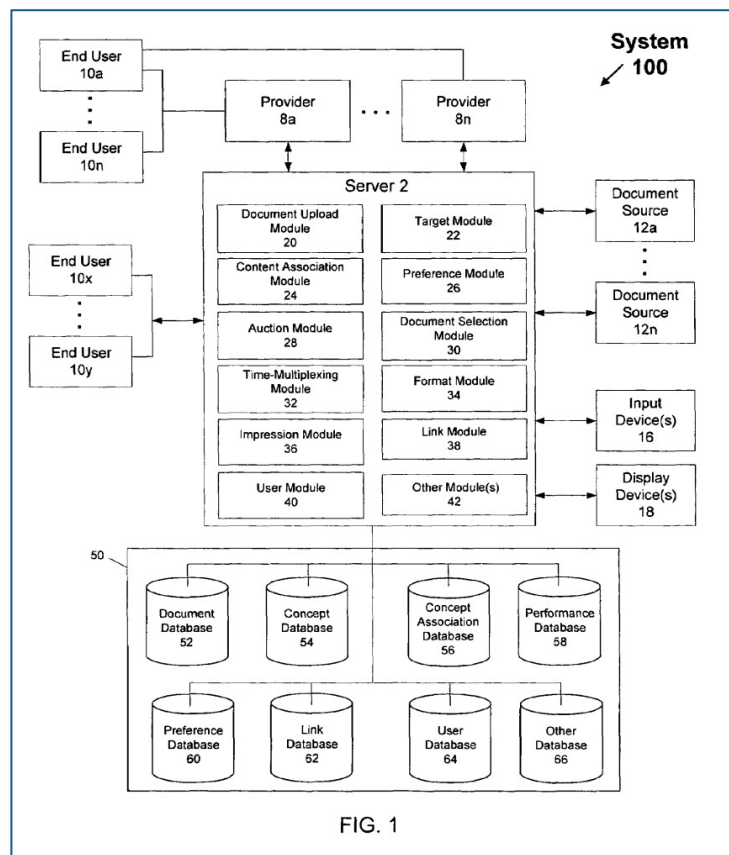
- Patent Owner and Patent Owner's Expert applied *Volvo Penta*.
Paper 50, **Response**, at 59-62; and EX2045, **Sherwood**, ¶¶ 92-119
- Petitioner does not cite, discuss, or apply *Volvo Penta*
- Proper consideration of the evidence compels a final written decision upholding the patentability of all claims.

Backup or Rebuttal

Petitioner Has Not Met Its Burden **Badros & Smedley's Admissions**

Badros' User Module Is Also On the Server & Three Lines in Petition

EX1003, **Badros**, at Fig. 1



EX1003, **Badros**, 12:45-66

In this way, impression module 38 may determine information that may be used in causing a plurality of documents to be time-multiplexed at a display. For instance, if several documents are intended to be actually displayed to a user for five seconds each before switching to the next document, then impression module may keep track of the amount of time that each document is actually output on a user's computer monitor 10. The impression module 38 may prevent the display of a subsequent document until a first document has received its full "true" impression time.

Impression module 38 may also cause a composite document to switch to a subsequent document in the sequence when the document space is not visible on the user's screen (e.g., when the window is minimized). This minimizes the extent to which a user is exposed to a potentially distracting transition between two ads or other documents.

User module 40 may pass information to and receive information from (or about) displays 18 and users 10, e.g., directly or indirectly through providers 8. Importantly, user module

Paper 1, at 35-36

Petitioner Has Not Met Its Burden **Badros & Smedley's Admissions**

Smedley Does Not Explain Why He Testified as He Did

EX1027, Smedley 2nd Dec.

8. Firstly, I do not see a “make a determination” limitation in the ’329 patent. Rather, each claim of the ’329 patent includes an optional step:

(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

(Emphasis added). The Patent Owner defines this limitation as the “viewability test.”

POR, 3.

9. Secondly, I stated nothing about my belief. I stated that I had not yet formed an opinion on whether Badros disclosed any “make a determination...” limitation. Ex-2050, 50:22-52:19.

10. Thirdly, I testified that this limitation was optional. Ex-1009, ¶66. I understand that the Board rejected this opinion. Paper 9, 8. I now address the Board’s holding and Patent Owner’s false accusation about what I believe. I am willing and able to appear for a second deposition in case there is any confusion about my opinions.

11. I testified in ¶70 of my previous declaration concerning the steps performed “in response to” the determination. It is my opinion that the disclosure in ¶70 of my prior declaration and other disclosure in Badros discloses Patent Owner’s “viewability test.” For example, Badros has the following relevant disclosure:

Smedley’s first point is not about his testimony; it’s about the patent, and it’s wrong

1. A method comprising:

(a) determining whether a predefined area of an ad content display page that is used to display an advertisement is in view within a visible area of a browser window of a browser configured to be operated by a remote computing device, wherein the predefined area is a portion of the ad content display page, and wherein the ad content display page includes (i) the predefined area configured to display advertisement content, the predefined area being a portion of the ad content display page, and (ii) page content displayed in other portions of the ad content display page, the page content being separate from the advertisement content; and

(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:

(i) receive the communication;

(ii) cause a replacement advertisement to be selected for display on the ad content display page; and

Petitioner Has Not Met Its Burden **Badros & Smedley's Admissions**

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Smedley’s second point does not explain his testimony, it *confirms* his testimony: “I had not yet formed an opinion”

Petitioner Has Not Met Its Burden **Badros & Smedley's Admissions**

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EX1027, Smedley 2nd Dec.

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Smedley's “third” point repeats the first (it was “optional”), cites his declaration (not his deposition, where he made no such statement), and recognizes the Board rejected it.

Petitioner Has Not Met Its Burden **Badros & Smedley's Admissions**

Smedley Does Not Explain Why He Testified as He Did

EX1027, Smedley 2nd Dec.

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He reverts to the very paragraph in his declaration that he **retracted in his deposition, attempts to retract his retraction and present, in reply, new opinions about Badros**

Petitioner Has Not Met Its Burden **Badros & Smedley's Admissions**

The “**Sham Affidavit**” Doctrine Precludes Smedley’s Retraction of His Retraction *Sinskey v. Pharmacia Ophthalmics, Inc.*, 982 F.2d 494, 498 (Fed. Cir. 1992)

A party cannot create an issue of fact by supplying an affidavit contradicting his prior deposition testimony, without explaining the contradiction or attempting to resolve the disparity. See, e.g.,  *Martin v. Merrell Dow Pharmaceuticals, Inc.*, 851 F.2d 703, 706 (3d Cir.1988);

No explanation provided



 *Mack v. United States*, 814 F.2d 120, 124 (2d Cir.1987);  *Franks v. Nimmo*, 796 F.2d 1230, 1237 (10th Cir.1986). Where, as here, a party has been examined extensively at deposition and then seeks to create an issue of fact through a later, inconsistent declaration, he has the duty to provide a satisfactory explanation for the discrepancy at the time the declaration is filed. To allow him to preclude summary judgment simply by contradicting his own prior statements would seriously impair the utility of **Federal Rule of Civil Procedure 56**. The trial court properly disregarded the declaration in assessing the existence of a genuine issue of fact.

Petitioner Has Not Met Its Burden **Badros & Smedley's Admissions**

Smedley Declines to Explain How to Program a Viewability Test

EX2050, Smedley Cross, at 141:4-21

4 Q. So how do you program the server to conduct
5 the viewability test?

6 A. I can't answer that question specifically
7 without knowing a lot more about the system,
8 but it strikes me as the sort of task you
9 could get any undergraduate student to do
10 when they graduate.

11 Q. Well, you understand that for Badros to --
12 let me rephrase the question.

13 If an undergraduate student could
14 do it, why can't you just explain it? How
15 do you program it?

16 A. The question as to how do you program it,
17 you sit down at the computer and write
18 programs. To write a program, you need
19 something more than just a vague -- an
20 undergraduate student would be able to
21 figure out what they needed to figure out
22 in order to do that.

EX2050, Smedley Cross, at 206-07

7 Q. I asked you this earlier about how you
8 would instruct or actually follow the
9 teaching in Badros to determine when and if
10 a particular document is actually visible
11 to the user on the user's desktop, and do
12 you recall saying that you would get the
13 undergraduate to program it?

14 A. I recall something to that effect, yes.

15 Q. And do you also recall not telling me a
16 single part of what that program would look
17 like based on Badros?

18 A. I can't tell you specifically what a
19 program would look like without knowing a
20 whole lot of other information, and I don't
21 know the language I'm going to be using
22 and the framework and APIs. It's not a
23 question that's possible to answer, unless
24 I'm misunderstanding what you mean by "a
25 part of the program."

Page 207

1 Q. I'm asking you to explain how, upon reading
2 that this module can do something with no
3 explanation of how that is done, a person
4 of ordinary skill in the art upon reading
5 that would simply know how to do it?

6 A. Well, a person of ordinary skill in the art
7 would have experience in programming in
8 whatever system they're going to be using
9 here and familiarity with the APIs and the
10 frameworks that they're using and would be
11 able to kind of put together the pieces to
12 detect kind of what's in front on the screen
13 and whether that's the thing we're talking
14 about here.

15 Q. So what are these pieces in your question

Petitioner Has Not Met Its Burden **Badros & Smedley's Admissions**

Smedley **Still** Declines to Explain How to Program a Viewability Test

EX1027, Smedley 2d, at ¶ 22

22. Mr. Sherwood testified in Ex-2045, ¶69 (FN3) that the petition did not rely on the user module. This is incorrect. *See e.g.*, Pet., 35-36, and Ex-1009, ¶70 (citing 12:48-66). I testified during my deposition that implementing Badros' viewability test was not "a difficult thing to do." Ex-2050, 148:12-22. There are basically infinite ways to implement it depending on various design choices. It is my opinion that Badros discloses more than enough information to enable the person of ordinary skill, irrespective of having any advertising experience, to determine whether an advertisement is visible in a browser. It does not matter whether the document being displayed is an advertisement or any other content.

Petitioner Has Not Met Its Burden **Badros & Smedley's Admissions**

In Reply, Duration Adds New Opinions About Client-Side Components

Paper 50 , **Reply**, at 7-8

NEW

B. Badros Enables Viewable Impressions by Using Both Client- and Server-Side Components

Badros' system and method teach running auctions to "time-multiplex" (*i.e.*, replace) advertisements using well-known client-side JavaScript, which should be obvious if not inherent. Ex-1003, 13:8-27, 14:20-31, and 11:22-34. The parties agree that *only* way to accomplish this feature is to have "a timer at the user computer." *Id.*, 23:61-62; Ex-2026, ¶14; Ex-2045, ¶69; Pet., 27, 38-39.

Accordingly, Badros expressly, inherently, and obviously discloses "client-side timers" to replace ads. Ex-1003, 23:61-62. Badros' disclosed client-server

Petitioner's Reply
IPR2023-00953

architecture works the same way as any web page since they were invented in the early '90's. Ex-1027, ¶19. All HTML websites work by storing code on servers (*e.g.*, a combination of HTML and JavaScript) that they transmit to browsers on client computers to render webpages. *Id.* ¶¶19-20. Therefore, a person of ordinary skill in the art would have understood that any document discussing websites necessarily included server-stored code transmitted to client-side browsers. *Id.*