

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DURATION MEDIA, LLC,
Petitioner,

v.

RICH MEDIA CLUB, LLC,
Patent Owner.

IPR2023-00953
Patent 11,443,329 B2

Record of Oral Hearing
Held: May 29, 2024

Before KARL D. EASTHOM, MICHAEL J. FITZPATRICK, and
JASON M. REPKO, *Administrative Patent Judges*.

IPR2023-00953
Patent 11,443,329 B2

APPEARANCES:

ON BEHALF OF THE PETITIONER:

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The above-entitled matter came on for hearing on Wednesday, May 29, 2024, commencing at 1:00 p.m., at the U.S. Patent and Trademark Office, 600 Dulany Street, Alexandria, Virginia.

P R O C E E D I N G S

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JUDGE EASTHOM: Please be seated.

Good afternoon. I'm Judge Easthom. Judge Repko is here with me, and we have Judge Fitzpatrick on the video link.

This is Duration Media LLC versus Ridge Media Club, LLC, IPR 2023-00953 involving challenges to the claims of US patent number 11,443,329 B2, which we'll refer to as the '329 patent.

Can I have appearances by the parties, please.

Petitioner, you can go first thing.

MR. GREENLEAF: Good afternoon, Your Honor. This is Kevin Greenleaf, lead counsel. With me is Mr. Joel Bock presenting Petitioner, Duration Media LLC.

JUDGE EASTHOM: Okay. And welcome, gentlemen.

And then Mr. Bock, will you be presenting, or?

MR. BOCK: I will not be presenting at this time.

Okay. Mr. Greenleaf, you will?

MR. GREENLEAF: Yes.

JUDGE EASTHOM: Okay. And then Patent Owner, who do we have?

MR. BERTEN: Good morning, Your Honor. It's David Berten for the patent owner. With me is Alison Richards, and my partner, Ragnar Olson. I'll be the primary presenter for the patent owner. Ms. Richards may address a couple of the evidentiary issues.

JUDGE EASTHOM: Excellent. Okay. Welcome.

Each party has an hour to present its case. Petitioner has the burden

1 of proving unpatentability, and he'll proceed first -- they'll proceed first,
2 followed by Patent Owner and then followed by respective rebuttals by
3 either of the parties if they reserve the time.

4 I want to caution everybody this hearing is open to the public, so
5 every -- any demonstrative or anything that you present here is going to be
6 seen by the public. I don't know if that presents an issue, but I know Patent
7 Owner, you filed all your demonstratives as "Board and Parties Only," so
8 how do you want to proceed with that?

9 MR. BERTEN: Well, I believe there's only one member of the public
10 here in the room, that's Mr. Rosenblum, who represents some parties that
11 have been contacted by the patent owner. The sensitive information
12 concerns the sales or revenue numbers for both the patent owner and the
13 petitioner. Those numbers are included in the demonstrative, but it's the
14 only information that is sensitive.

15 We could either ask Mr. Rosenblum to leave the hearing at that time,
16 or I may be able to modify the slides to not include that expressed number.

17 JUDGE EASTHOM: Okay. Well, the other thing is, is that -- the
18 other concern is that this is being live streamed. So I understand there are
19 some members of the public right now on the -- they'll be able to view
20 everything here, so...

21 MR. BERTEN: I -- I do actually have a set of the slides that's been
22 modified that doesn't include those expressed numbers, but they are different
23 than the demonstrative that were submitted to the Board.

24 So there's a particular set of slides about the relationship between
25 Duration Media and Rich Media Club, and its affiliated company, RealVu.
26 With -- that would largely just involve to leading. The interrogatory

1 responses from Duration about the extent of their sales and an excerpt from a
2 declaration we submitted about Rich -- RealVu sales.

3 So I can do that. With the board's permission, I can modify that
4 portion of the slides, and have it eliminated, and that would be fine for the
5 public to see that, I think, for both parties.

6 JUDGE EASTHOM: I think that would be an excellent way to do it.
7 Make things a lot easier.

8 And then after the hearing, could you please file those?

9 MR. BERTEN: Yes.

10 JUDGE EASTHOM: Thank you. I appreciate that.

11 And then, just one other bookkeeping item. We have this recent paper
12 filed for a motion to seal and it refers to, I think, paper 28 that has the -- that
13 has the -- what am I thinking of? -- the method by which you want to go by
14 to seal these documents. So that's in the appendix of paper 28.

15 Is that what you want to do? You want to go by that?

16 MR. BERTEN: Yes. It's the same information, Your Honor. So it's
17 in our demonstratives, so those would have to be sealed.

18 And then there was one deposition transcript that was filed by
19 Duration that includes the same information. That would have to be -- just
20 had that redacted, and then we'd file a redacted version of the transcript open
21 to the public.

22 JUDGE EASTHOM: Okay. And then I'm going to ask if my
23 colleagues have any questions about that seal order. Does anybody have a
24 question about that?

25 JUDGE FITZPATRICK: Yeah. Yes, I do. Mr. Berten for both -- I
26 guess, for both parties.

1 That most recent document referred to paper 28. Paper 28 was the
2 first motion that was the other cloud in this case. I believe it was by Patent
3 Owner. Patent Owner later moved to dismiss that motion, and the invention.

4 Then around that same time, both parties filed motions to seal, I
5 believe, to papers 39 and 40. And those motions did something I've never
6 seen before, which is why -- one of the reasons we haven't ruled on them
7 yet. They sought entry of two protective orders, each motion: The default
8 protective order and a modified protective order that was attached to No. 39.

9 So with those two papers and with the most recent paper, the most
10 recent motion with the PO paper, ultimately, we want to enter one protective
11 order in this case and only one.

12 So yeah, I don't know if this is a -- I don't know if this would be a
13 distraction right now or if it's something you want to follow up with after the
14 hearing, but it would be great to know which, if you guys can stipulate, to a
15 single protective order. And limit it to one of the protective orders that's
16 already on record in this case.

17 MR. GREENLEAF: I'm thinking we can send an email afterwards
18 just to, you know, be respectful to everybody's time.

19 JUDGE FITZPATRICK: Great.

20 JUDGE EASTHOM: Okay. With that, Petitioner, why don't you
21 reintroduce yourself for the record and we'll get started with you.

22 You have the burden of proof, so you'll go first. Like I said, how
23 many minutes do you want to reserve for rebuttal at this point? And that's
24 flexible. You can change it if you go over.

25 MR. GREENLEAF: Thirty minutes, please, Your Honor.

26 JUDGE EASTHOM: Okay. Give me a second to start.

1 Okay, you may proceed.

2 MR. GREENLEAF: Good afternoon, Your Honors. May it please
3 the Board, I'm Kevin Greenleaf, lead counsel for Petitioner Duration Media
4 LLC. And with me is Mr. Joel Bock, my backup counsel.

5 JUDGE REPKO: Just a moment while get the time set up for you.
6 We didn't have the time on the Board.

7 All right. You may proceed.

8 MR. GREENLEAF: All right. Thank you.

9 So I have up on the display currently slide 2, which is the outline of
10 the arguments for today. Just before I get into the outline in detail, I'm going
11 to be going through a lot of the record in the slides, and it won't be necessary
12 to read each slide for those viewing the presentation. I'll be explaining and
13 highlighting important parts of each -- of each slide, but the quotes are there
14 for a reference.

15 So the main issue here from Petitioner's perspective is the limitation
16 (b) and claims 1 and 6. I think it's limitation to claim 6. But the parties have
17 treated them identical, and they are substantively, if not entirely identical.

18 And Patent Owner's characterize this limitation as the "viewability
19 test." Patent Owner really hasn't focused on the claim language per se, but
20 has paraphrased it as a "viewability test," which is more of an industry term
21 of art. And so we're going to be focusing largely on that.

22 The second issue is whether Badros alone or in combination with
23 Krassner or Harkins, teaches the viewability test. And the petition addressed
24 each of the limitations in detail, including the so-called viewability test
25 limitation.

26 The third issue is whether Badros enables its description of

1 determining whether an ad is actually in view. Patent Owner's argument is
2 that that's referring to served impressions, i.e., downloaded impressions
3 versus viewed impressions, and so we're going to be talking about -- a lot
4 about that today.

5 Issue 4, which I think is Patent Owner's primary argument, is evidence
6 of secondary indicia which petitioner has -- has argued deserves a little
7 weight in this case because the grounds of unpatentability are so compelling.
8 The -- there's a strong showing of obviousness here. The Board frequently
9 rejects -- determines claims are unpatentable in compelling cases such as
10 this.

11 Secondly, Patent Owner has failed to demonstrate nexus either
12 co-extensiveness or nexus between the secondary indicia and the patent.

13 And finally, Petitioner has presented the testimony of Dr. Mandansky,
14 who has decades of experience, and in the ad industry rebutting Patent
15 Owner secondary indicia evidence.

16 Issue 5, the one of three safe harbor issue. Patent Owner has failed to
17 demonstrate that the invent -- the claimed inventions were made at the time
18 when the inventions were co-owned.

19 And finally, the sixth issue is -- concerns Harkins, which was applied
20 to some dependent claims that we'll get into.

21 So onto slide 3, the viewability test limitation here is identical for
22 claims 1 and 6, at least the parties have treated it as such.

23 On to slide 4, the decision on institute -- institution already
24 determined that Bandros teaches the viewability test, at least under the
25 reasonable likelihood of prevailing standard.

26 And so the only issue, again, for the claim limitations is this limitation

1 (b). So Patent Owner has essentially waived any other argument that the
2 other limitations of claims 1 and 6, you know, have -- are -- we make the
3 claim are patentable, so we're going to focus only on limitation (b). All the
4 other limitations are addressed in the petition and are unrebutted as disclosed
5 by the prior art.

6 Onto slide 7. The distinctions that Patent Owner makes are incorrect.
7 Badros does disclose viewable impressions, not served impressions. It
8 seems that the experts and the -- the inventors largely conceded that Badros
9 discusses viewable impressions.

10 So I don't know whether this argument is really preserved from Patent
11 Owner's perspective. I assume that they probably would argue it is,
12 but -- but they're -- the argument where they, I think, spent more time is
13 whether Badros is enabled for its -- determining whether an ad is actually in
14 view.

15 And so Petitioner argued in its reply that things that are well known
16 do not need to be disclosed in detail in the prior art reference. So for
17 example, if you have a patent disclosing screwing two pieces of wood
18 together, you don't need to disclose how to make a screw. Same thing
19 applies here.

20 Prior art is replete with disclosure of viewability tests and did not need
21 to disclose code or a detailed algorithm for implementing a viewability test
22 because it's a predictable art and viewability tests were well known.

23 Badros disclosed the viewability test. A person of ordinary skill in the
24 art would have understood how to implement one, as Petitioner's expert
25 demonstrated within his supplemental declaration.

26 JUDGE REPKO: So with the visibility test, and looking at Badros in

1 particular, what's the predefined area? Is it the billboard that they're talking
2 about?

3 I guess you're discussing that in the petition, this billboard on the
4 screen, it was displaying the ad. And then how is that visibility test
5 accomplished with respect to that billboard?

6 MR. GREENLEAF: So let me pull up the petition.

7 JUDGE REPKO: I believe maybe it's on 20 of the petition. And
8 you're saying that Krassner does not disclose the predefined area of the ad,
9 and then Badros renders obvious this limitation and then you quote part
10 about an electronic billboard at a specific location on the web page.

11 MR. GREENLEAF: All right. Sorry. Give me a second here, just
12 pulling that page 20 up.

13 I'm showing Page 20 here.

14 JUDGE REPKO: Yeah. So there's the quote right there at the bottom
15 of the electronic billboard. Is that your predefined area?

16 MR. GREENLEAF: Yeah. So it would be the electronic billboard or
17 a specific location on a web page.

18 So the -- the advertisement -- obviously a person of ordinary skill in
19 the art, would have understood that an advertisement is essentially a picture
20 or a video that has, you know, a grid of coordinates that's located within the
21 web page on X and Y axis. And that would be a specific location on a web
22 page, whether you call that "electronic billboard" or whether you call that
23 "coordinates." It could -- you could use any different term.

24 But -- but yes, that section, that e.g. portion, would be the disclosure
25 in Badros along with the ordinary -- you know, the understanding of a
26 person of ordinary skill in the art that a JPEG or an MOV or some kind of

1 image or video would constitute a specific location on the web page for
2 example, as Badros discusses.

3 JUDGE REPKO: Right. The claim recites a predefined area. So
4 that's -- you're saying that's the predefined area, whatever that billboard is?

5 MR. GREENLEAF: Yes.

6 JUDGE REPKO: Okay. So then moving toward the visibility test,
7 which recites a determination that the predefined area that is used to display
8 the advertisement has been within the visible area of the browser for a
9 predetermined -- or predefined period of time. So then you quote from
10 column 11.

11 So does that discuss the -- how does that relate to the viewable area
12 and the billboard?

13 MR. GREENLEAF: Is there a specific page you're reading from?

14 JUDGE REPKO: Yeah, 21 -- or 23. Page 23 of the petition.

15 MR. GREENLEAF: Yeah. So Badros -- so the question again, if
16 I -- if I recall it correctly, is -- is how does Badros determines that -- where
17 does Badros disclose that a determination that the predefined area is on -- is
18 on the user's screen.

19 JUDGE REPKO: Right. That's what the limitation says, right, "The
20 determination that the area is used to display." And then it says, "Within the
21 visible area of the browser window."

22 So is that addressed in column 11, that visibility test? Is there
23 something there that Badros discloses with respect to the areas?

24 MR. GREENLEAF: So Badros defines its time multiplexing test as
25 determining when an ad is in view. It's not a term of art -- what -- the way
26 Badros defines it, and I can pull up that quote. Maybe Mr. Bock can help

1 me identify the definition of time multiplexing.

2 But -- but Badros defines time multiplexing. And I think -- the
3 Board's decision on institution -- we can pull that up -- stated this too that
4 time multiplexing means that when the ad is in view for a predefined period
5 of time, then you can replace it by time-multiplex. So multiple ads are
6 multiplexed, you know, based on how long they've been displayed.

7 So that's -- that's the whole idea in Badros's time-multiplexing
8 invention.

9 JUDGE REPKO: So it's like a timer and it displays it for a certain
10 period of time.

11 MR. GREENLEAF: Yes.

12 JUDGE REPKO: So then the claim limitation says the determination
13 about visibility. So when -- where's the determination in your timer?

14 MR. GREENLEAF: Well, so if it's going to determine how long the
15 ad's been in view, there needs to be a trigger for when the ad's in view and
16 not in view. So yes, there was no code, but you don't need to disclose code
17 to enable an invention in the computer arts.

18 The person of ordinary skill in the art reading Badros -- Badros
19 discloses a client-side timer. A client-side timer determines how long the
20 document is actually in view -- actually viewable on the user screen,
21 according to this disclosure in column 11.

22 And so the timer necessarily determines when the ad is in view and
23 not in view and times that. And then we'll multiplex the document when
24 that predefined period of time expires, say, 30 seconds.

25 JUDGE REPKO: So specifically, I'm asking, what is the
26 determination there? Have you explained that in this paragraph what the

1 determination itself is?

2 This is what we have to work from, right? We have these quotes here,
3 so where is the determination in that?

4 MR. GREENLEAF: Well, column 12 literally uses the words, "May
5 determine whether a document is actually visible to a user, and it may track
6 the time duration during which the document is actually visible."

7 So it determines whether the document is visible --

8 JUDGE REPKO: Right.

9 MR. GREENLEAF: -- which essentially paraphrases the claim
10 language.

11 JUDGE REPKO: Well, you have two things there, right? It says,
12 "May determine whether a document is actually visible and track the
13 time" --

14 MR. GREENLEAF: Yes.

15 JUDGE REPKO: -- "during which the document is actually visible."

16 So which is it? Are you -- what's the determination here? Is it the
17 track -- the expiration of the timer or is it actually looking at that visibility
18 and making a determination based on that visibility? There are two aspects
19 of that sentence, right?

20 MR. GREENLEAF: Yes. I think the answer, if I'm understanding the
21 question correctly, is that the determination is both. So there's a
22 determination that the predefined -- I'm reading the claim limitation now.

23 JUDGE REPKO: Uh-huh.

24 MR. GREENLEAF: "A determination that the predefined area that is
25 used to display the advertisement has been in view within the visible area of
26 the web browser." -- and the word "and" isn't there, but -- and "for a

1 predefined period of time."

2 And that quote -- expressed quote from Badros basically says the
3 exact same thing. I don't really see what the difference is other than
4 different usage of words.

5 JUDGE REPKO: So we're -- there at -- I mean, one could argue that,
6 you know, you have a determination whether the document is actually
7 visible to the user, that's your -- maybe your billboard? You think that's
8 the -- that's that document stream back to the billboard that you had a
9 predefined area in limitation (a), for example?

10 MR. GREENLEAF: Yeah, the document and the billboard are the
11 same thing.

12 JUDGE REPKO: And then it's going to track the time duration
13 during which the document is actually visible to the user. Does that relate
14 back to the visible area of the browser window for the predefined period of
15 time?

16 MR. GREENLEAF: Yes. The document and the billboard are the
17 same thing. The document is the advertisement. It's, you know, patent
18 language. You know, you try to draft the patent broadly to say a document
19 could be a book or a picture or an ad or all these kinds of things.

20 But it's really focused on advertising, so a document is just another
21 way of defining the advertisement or the billboard.

22 JUDGE REPKO: I have no further questions on that. Thank you.

23 MR. GREENLEAF: Thank you, Judge Repko.

24 JUDGE EASTHOM: Just so -- for this quick follow up, I think your
25 friends argued that there's no way this could have been done because
26 everything is done at the server. You need something at the client side.

1 Can you address that, please?

2 MR. GREENLEAF: Yes, I will address that. We'll skip ahead in a
3 second.

4 But just finishing on my last point, slide 4 talks about the time
5 multiplexing and defining the time multiplexing. So I don't need Mr. Bock's
6 help with that, so I just wanted to complete that circle.

7 So let's look at the enablement argument: The server versus client-side
8 issue.

9 So this is the argument, Your Honors, referring to -- I believe that was
10 Judge Fitzpatrick?

11 JUDGE EASTHOM: Easthom -- it's fine.

12 MR. GREENLEAF: I'm sorry.

13 All right. So slide 19 is basically a summation of Patent Owner's
14 argument that the figure in Badros shows that the impression module 35 and
15 the user module 40 are on the server.

16 So if we look at slide 20, Petitioner's reply reinforced the arguments
17 from the petition that the user module may pass information to and receive
18 information from or about displays and users, e.g., directly or indirectly
19 through providers as a direct quote from the petition that was put into the
20 petitioner's reply.

21 And then the petition also adds in -- there's other cites to the petition
22 and then there's another quote in column 11 of Badros that says -- and adds a
23 lot of duration may be told according to viewable time instead of absolute
24 time. So this slide 20 demonstrates the user module is communicating with
25 the -- the client device.

26 JUDGE EASTHOM: Can you -- can you elucidate me on that?

1 Because the way I read that first sentence you said, it says it's from the
2 providers. Is that -- that's not the clients, right?

3 MR. GREENLEAF: It says -- it says, "The user module may
4 pass" -- the providers, I think you're right, Your Honor, that that those would
5 probably be some third party.

6 But above the displays and users are the users. So how does the
7 users --

8 JUDGE EASTHOM: Oh, "on users." I see. Okay, thank you. Sorry.

9 MR. GREENLEAF: But I think the next slide is even more
10 important. It's slide 21. This is a direct quote from Badros, and I'll read it.

11 "In some embodiments, user module 40 may cause code to be
12 downloaded and/or executed on a user computer 10 or display device 18.
13 The user module may cause a time multiplexing program or system to exist
14 and run on a user computer. The user module 40 may pass code to an output
15 terminal such as JavaScript, wherein the JavaScript switches the document
16 based on client-side timers."

17 These are the timers we were referring to earlier that are tracking the
18 time that that is viewable.

19 JUDGE EASTHOM: On the client site? Thank you.

20 MR. GREENLEAF: Yes.

21 And the petitioner has a reply and several other citations, including
22 column 13, lines 8 and 27, 14, 20 to 31; column 11, lines 22 to 35; and in
23 addition, column 13, lines 6 to 22 are also pertinent. More citations -- I'm
24 sorry. And 12, 50 to 57.

25 And that's just a sampling of relevant information in Badros.
26 Obviously, the experts opined on this as well.

1 Does that answer your question, Your Honor?

2 JUDGE EASTHOM: Yes. Thank you.

3 MR. GREENLEAF: Okay.

4 JUDGE FITZPATRICK: Mr. Greenleaf?

5 MR. GREENLEAF: Yes.

6 JUDGE FITZPATRICK: I want to ask a couple of questions that
7 relate to what we've been talking about, the limitation (b). That's the most
8 important thing that we're going to talk about today.

9 And a moment ago, maybe a couple of minutes ago, you talked about
10 the definition of -- of Badros's definition of time multiplexing. And I think
11 you directed us to column 11, lines 22 to 24, or a citation of it, that showed
12 up in your petition. Or maybe this the institutions within that --

13 I -- and I wrote this, I believe, and I put a bracket around "can be" in
14 the yellow there. So I wanted to go to the source and see what it said.

15 And it says, "Some embodiments may apply time-multiplexing
16 criteria for a plurality of documents based on the time during which a
17 document is actually viewable on the user's screen."

18 I read that to say that time-multiplexing criteria, it may be based on
19 the words that follow. Okay? I don't want to characterize whether that's
20 viewability, determination or not because there's arguments about that.

21 But I don't read -- just -- I don't read this as a definition that
22 multiplexing criteria -- if every time Badros talks about time multiplexing
23 that it means that we're talking about something that is actually viewable.

24 Would you agree with that? As opposed to, like, this is a species of
25 the genus of time multiplexing.

26 MR. GREENLEAF: Okay. To answer Your Honor's question

1 directly, this states that the time-multiplexing -- can be based on --

2 So I don't know what was going, what Your Honor was thinking
3 when -- when you inserted this "can be." I agree with that, and I think
4 further evidence --

5 JUDGE FITZPATRICK: Yeah, I just wanted to make it
6 grammatically correct the way I was inserting it into the sentence, of course.
7 But -- and it is grammatically correct in a different form of sentence --

8 MR. GREENLEAF: Uh-huh.

9 JUDGE FITZPATRICK: -- in the patent itself, in Badros.

10 But it says, "based on." It says, "how embodiments may apply," and
11 it's describing a type of time-multiplexing criteria. I don't think it's defining
12 time multiplexing as -- I don't think it provides a definition of time
13 multiplexing, which I think is what you had said earlier.

14 And if -- if that's the case, I'm inviting you to kind of like go back to
15 that and try to persuade me the definition, because I don't buy it right now.

16 MR. GREENLEAF: Okay. So I apologize if maybe I was reading
17 too much into the statement and that -- the decision on institution.

18 But for example, column 13 lines, 19 to 23 states, "The time
19 multiplexing system at a user's computer may cause a plurality of documents
20 to be displayed in a time-multiplexed manner as described herein."

21 And the time-multiplexed manner is as we've been discussing. The ad
22 or document or billboard is tracked for whether it's visible -- for how long
23 it's been visible, as opposed to total time and then swapped out for a new
24 advertisement.

25 So this -- this is another example, I think the entirety of Badros's
26 disclosure. I think even the title, it talks about time multiplexing. So you

1 know, we could --

2 JUDGE FITZPATRICK: Definitely it's all about time-multiplexing.
3 But I think in most instances, I think the emphasis is on let's not do this in a
4 dumb way like -- could just a rudimentary way. Let's -- let's pick the
5 sequence that the advertisers want and the time amounts that the advertisers
6 wants, things like that.

7 And that leads me to my next question, and I'll preface it first by
8 saying I don't think that -- that you have pointed to any purported disclosure
9 of this limitation from the claims of Badros. Is there any in the claims of
10 Badros? Do they claim? Do they claim this? Because I couldn't find it.

11 MR. GREENLEAF: I mean, let me look. I think you're right. I don't
12 recall the -- quoting the claims.

13 MR. BOCK: Claim 1.

14 JUDGE FITZPATRICK: That could be -- this could be a
15 time-consuming thing. I don't want to throw you off too much. Maybe your
16 co-counsel could be taking a look at the claims, and you could maybe
17 answer during a rebuttal after you've had time to talk.

18 MR. BOCK: Your Honor, in claim 1, I believe, the second paragraph
19 of claim 1.

20 JUDGE FITZPATRICK: Okay. Let's go in there.

21 MR. GREENLEAF: Okay. I have claim 1 up here. I mean, it has
22 space multiplexing, time multiplexing here. I don't know -- this is column
23 22, "Causing" this -- yeah, this is the second paragraph.

24 "Causing the display of the plurality of selected documents on a web
25 page to an output" --

26 JUDGE FITZPATRICK: Yeah, and I can cut you off because I think

1 we're going to come to the same kind of issue with the definition that I don't
2 think it's listed in this.

3 So they keep talking about time multiplexing. They even talk about
4 space multiplexing here in this -- in this rather large paragraph 2 of claim 1
5 of Badros.

6 But I don't see -- correct me if I'm wrong -- I don't see it talking about
7 any determinations of whether something's actually viewable, or actually
8 visible, or you know, anything analogous.

9 MR. GREENLEAF: Well, again, in column 22, line 53, it says,
10 "Wherein in time-multiplexing criteria determines a sequence of the selected
11 documents and a time duration of display for each of the selected documents
12 in the web page."

13 And as we've been -- you know, and it goes on determining the
14 location, it talks about the time durations, and more.

15 So this is all consistent with Badros's disclosure of putting a timer on
16 the client, determining whether the ad is in view, determining whether it's
17 been in view for a particular period of time, and then time multiplexing that
18 document, i.e., replacing it with more documents after each has been
19 displayed on the screen for the time period -- the "time duration," as Badros
20 calls it.

21 JUDGE REPKO: I think you're glossing over some limitations there,
22 right? The determination is really that the predefined area is used to display
23 the advertisement, and then there's a browser window there too.

24 It's the visible area of the browser window. It's more than just
25 showing the ad for a predetermined period of time. Some visibility
26 determination there as well.

1 MR. GREENLEAF: Yes. So there's -- there's -- this is -- I guess sort
2 of goes to Patent Owner's argument of the distinction between served
3 impressions and viewed impressions, if I'm understanding the question
4 correctly.

5 JUDGE REPKO: Yeah. I mean, there's -- I'm just saying there's more
6 to that determination than -- you keep paraphrasing it as if it's just showing
7 the advertisement for a period of time. And you're relying on this
8 time-multiplexing criteria, which looks at a lot of time for an ad and then
9 compares, you know, some sort of visibility.

10 But the claim language is specific about various areas, right? A
11 predefined area that's within view, and the visible area of the browser for
12 predetermined term period of time.

13 So I mean, I guess, you may need to be a little more specific about,
14 you know, what's going on in that limitation.

15 MR. GREENLEAF: Yeah, I understand Your Honor's concern, and I
16 share that concern.

17 This case has been kind of strange because Patent Owner has
18 summarized the claim language as the "viewability test," and it's focused
19 entirely on the difference between viewed impressions and served
20 impressions instead of the claim language. So that distracted us from
21 focusing on the claim language because we were just following Patent
22 Owner's arguments.

23 But -- so I appreciate Your Honor's diligence and focusing on the
24 claim language. And I want to direct your attention to slide 9 that talks
25 about Badros's timers and how they are not served impressions; they're
26 viewed impressions. So it's in quotes. This is from the petitioner's reply,

1 page 6.

2 "Badros distinguished its actually visible method from served
3 impressions. The number of actual, e.g., verified impressions, may be
4 distinguished from the number of times the document was output to the
5 client terminal. Also, the actual time during which the document was visible
6 on the monitor may be stored."

7 So Badros understood the distinction between served impressions and
8 viewed impressions. And there was a quote earlier that we read about
9 tolling the time when -- when the document is not in view, i.e., the ad is not
10 in view.

11 So Badros understood and expressly explained that there's a
12 distinction between total downloaded time and actually verified, viewable
13 time.

14 JUDGE REPKO: Uh-huh. And so these documents -- and you keep
15 referring back to the documents, not using them interchangeably with ads.
16 And definitely in column 4 of Badros, for example, it does sort of define
17 that, right?

18 It says -- I'm looking at column 4, lines 7 through 15, and it says the
19 document can be advertisements, it's how you've been using it. But it can
20 also be web pages, search results, emails, applications, and all these other
21 things.

22 The claim kind of distinguishes these ads from the browser window
23 itself, it has limitations to that.

24 So I mean, have you sufficiently addressed that limitation, if we're just
25 kind of looking at documents and time-multiplexing documents and things
26 like that, when documents could refer to a bunch of things, including the

1 browser itself?

2 MR. GREENLEAF: Yes. The -- so the answer to your question is
3 twofold.

4 One, yes, we have addressed it in the -- you know, now and in the
5 petition and Badros addresses itself.

6 But yes, the document can be an ad, it could be a web page, it could
7 be an email application, etc., etc. And this is just common parlance, the way
8 that patent attorneys work as we all understand.

9 So the document can be an ad. I think that's how we're treating it,
10 that's how I've been treating it, that's how it -- that's why Badros is relevant.

11 JUDGE REPKO: But it can be. So I guess going back to that quote
12 that you have in your petition on page 23, it's talking about specifically that
13 that time-multiplexing feature going to the document.

14 So does that mean -- is Badros using the word "document" in that
15 instance to mean ad, or is it meaning anything, the browser window overall?

16 Because the claim does make a distinction between the browser
17 window, and this predefined area. That is the billboard that you've mapped
18 in the first part of the claim.

19 So the question, I guess, to rephrase it, is Badros using the word
20 "document" exclusively to refer to ads in column 11, column 12, that
21 described the multiplexing?

22 MR. GREENLEAF: No, Badros is not using the word "document" to
23 refer exclusively to ads. Badros has defined "document" in all of these
24 ways, including an advertisement.

25 So in all of those places -- I have not done the analysis and I'm not
26 going to be able to do that now, whether, you know, this would apply -- how

1 this would apply to emails or search results, etc.

2 But the analysis for whether it applies to ads is -- is what was given in
3 the petition, and has been in expert declarations, and we're talking about in
4 depositions, we've been talking about extensively here today. The document
5 for our purposes is an advertisement. Well, it could be other things. What's
6 relevant here is that it can be an advertisement too.

7 JUDGE REPKO: Uh-huh. And I guess my concern is with the two
8 separate concepts being recited in that limitation and then your particular
9 mapping on page 23 of your petition, that kind of refers to the document
10 which could be either the web browser or the advertisement.

11 I mean, can you cite anything that would alleviate those concerns, or
12 would it just the claim mapping itself?

13 MR. GREENLEAF: Okay. So two ways to address this, I think. One
14 is that Badros -- let's see.

15 In the background of the invention, first word is "advertisers." Badros
16 is -- an advertisement of -- different versions of the word "advertisement"
17 and advertisements appear, I don't know, a few hundred -- several hundred
18 times in the patent.

19 Badros is clearly directed at advertising. Whether the patent attorney
20 drafting -- this is just a common patent attorney trick is you use a broad
21 terminology to define all of these things so that in the unlikely event you
22 want to apply this patent to a Coke machine, you can do that. But Badros's
23 Google patent is clearly directed to online advertising, and that's what its
24 primary purpose was.

25 Second way to respond to that is back to the fastener example. Two
26 pieces of wood fastened together. It could be fastened with glue, it could be

1 fastened with a nail, it could be fastened with a screw, it could be fastened
2 with a clamp, all different kinds of -- and that's how a patent attorney would
3 describe it. It doesn't matter how they're clamp together. It could be all
4 different kinds of ways.

5 And that's why Badros doesn't need to disclose how to do a
6 viewability test because it can be done -- according to Dr. Smedley's
7 testimony, I believe in paragraph 22 of his -- Exhibit 1027, says that it could
8 be done infinite ways. Literally infinite ways you could develop a
9 viewability test. There was no need to describe it in detail.

10 And so Badros clearly -- in the words of Mr. Sherwood -- discusses
11 viewability. Mr. Sherwood would say that Badros does not explain how to
12 do it. The petitioner's position is that you don't have to, and that's the
13 position of the law.

14 JUDGE REPKO: Yeah, I mean, there's -- your kind of characterizing
15 is that -- you see the enablement stuff where they're characterizing this as a
16 enablement issue.

17 But I mean, just looking at -- those sentences that you quoted are
18 talking about documents and documents can be applications themselves.

19 So does this actually say that -- or anything about an advertisement
20 itself? And specifically, the claim language recites predefined area and
21 browser window where this document does -- doesn't refer to either.

22 I guess my concern is again with the -- whether Badros is actually
23 saying what you think it's saying there because it's saying "document,"
24 which could be anything.

25 It doesn't say "advertisement." And yeah, it could be an
26 advertisement, but is it the specific type of advertisement that's recited in the

1 claim that is the predefined area within a browser window?

2 For example, let's look at that example of where they're looking at
3 actual allotted time for a browser when it's minimized, and it's not
4 minimized. So if someone minimizes it, that maybe is not counted as being
5 actually visible. But maybe it's maximized, but the ad is off the screen,
6 right? Because maybe that billboard is off the screen and that's not
7 viewable.

8 MR. GREENLEAF: Uh-huh.

9 JUDGE REPKO: But that document they're referring to there is the
10 application itself, right?

11 So I mean, is there anything there in that column 11 or anything that
12 might tell you that what they're actually tracking there is advertisements
13 within the browser. That is maybe a document within a document.

14 MR. GREENLEAF: So my -- my co-counsel here has directed me to
15 column 11:60 to 65 that I think addresses Your Honor's question, which I
16 have up here on the screen.

17 It says, "The format module, massive scale the document to fit a
18 predefined size or shape, e.g., fit a rectangle of uniform size within the
19 document as may be scaled the different sizes. For example, certain ads may
20 be sized or shaped differently based on the advertiser's willingness to pay an
21 additional amount."

22 So this is associating the document to an advertisement and that is
23 what Badros is focused on, is that the advertisers want to know whether their
24 ad was actually displayed to the screen. And that's what Badros is focused
25 on.

26 It uses the word "document" and all of this -- this Patent Owner

1 broadening language. But really, what it's directed to is advertising.

2 JUDGE REPKO: Okay. I have no further questions on that.

3 MR. GREENLEAF: Okay. And just kind of one thing that I was
4 thinking as I was reading this was, talking to ad experts, they used terms like
5 a 300-600 ad and there's just standard ad sizes.

6 So that's I think what Badros is directed to here is that there's different
7 standardized ad sizes. And then that's the document, and that's what Badros
8 is checking.

9 JUDGE REPKO: Okay.

10 MR. GREENLEAF: So any further questions on that issue?

11 JUDGE REPKO: No. Thank you very much.

12 JUDGE EASTHOM: Okay. So I know you probably saw the clock,
13 so you're eating into your rebuttal time, but I think some of the judges have
14 more questions. So we're going to kind of be -- probably grant more time to
15 both parties depending on how it goes.

16 MR. GREENLEAF: Okay.

17 JUDGE FITZPATRICK: Yeah. Yeah. We aren't committed to a
18 specific amount of time. I'd say it would be at least five minutes extra.

19 I had a -- Mr. Greenleaf, I don't know if you want to follow your
20 outline. We've asked you a lot of questions, but there's a couple of things in
21 the outline I want -- I would like to hear from you about. Maybe the
22 secondary considerations. That can be in your rebuttal. I don't know how
23 you want to do that.

24 But I'd like to know about Harkins, what your response is on the real
25 time limitation. I understand the auction part, but where you -- I mean, I
26 know you've seen Patent Owner's response, of course. They say -- well,

1 there's no -- the real time aspect of that feature that you're trying to borrow
2 from Harkins is not taught by Harkins. So what's your response to that?

3 MR. GREENLEAF: So I believe this was addressed in the
4 petitioner's reply, and in the last slide of this presentation. But I'm going to -
5 - I'm going to pull up the petition here.

6 Page 29 onto page 30 talks about Krassner, discloses the option being
7 done in real time.

8 Let's go to page 41. Badros discloses the auction being done in real
9 time. And then in combination with Harkins, discloses the replacement
10 advertisement is done with a second auction. So Badros discloses the
11 auction being done in real time. So the auction process may be used to
12 determine which advertisement to show in sequence, or other display criteria
13 such as duration.

14 So Badros is in real time determining when to switch the -- the
15 advertisement. And to the extent that there needs to be a replacement
16 auction, Badros can be combined with Harkins to execute a replacement,
17 you know, to repeat the steps it's already done to -- to perform the
18 replacement auction.

19 JUDGE FITZPATRICK: I understand --

20 MR. GREENLEAF: So both the combination of Badros and Harkins.
21 It's not just Harkins alone.

22 JUDGE FITZPATRICK: So even after -- maybe you won't concede
23 it, but even if Harkins doesn't teach a real time auction, it's not critical to
24 your case.

25 MR. GREENLEAF: That is true. And Harkins, too, discloses when it
26 runs out of advertisement, it executes another auction, so that necessarily is

1 done in real time too. So Your Honor --

2 JUDGE FITZPATRICK: Well, that's -- that's where there is a factual
3 dispute. Patent Owner says, you know, that the application of Harkins that I
4 believe is situations like digital receipt at stores. And they might run these
5 things for a week, who buys the ad space to be printed out on the receipt,
6 and then they run another auction after that. Contract is, you know, coming
7 up to be expiring. It's not really -- the real time is what -- is what I believe
8 your -- you know, the '329 patent claims.

9 MR. GREENLEAF: Yeah. Patent Owner's other argument is
10 that -- that Harkins is focused on, as Your Honor pointed out, receipts. And
11 that's true.

12 But -- but like Badros, the patent attorney was doing their job and said
13 that the invention could be applied equally to the internet, billboards, such as
14 Badros, web pages. So --

15 JUDGE FITZPATRICK: Understood. And I don't -- and I don't want
16 you to waste your time talking about like getting into the analogous art. I
17 think we can -- we can figure that out based on everything that's in the
18 papers.

19 I was just wondering what the real time aspect taught. Is it taught
20 directly by Harkins, and if not, what is your -- you know, what is your
21 position? You've explained how Badros -- you have it in combination, and I
22 get that. So thank you.

23 MR. GREENLEAF: Okay. All right. So I think we addressed pretty
24 much all of the issues except -- you know, I think Your Honor is right. I
25 would like to talk about secondary considerations after hearing Patent
26 Owner's case. But I do want to talk about the 103(c) issue.

1 And Patent Owner's contention -- give me a second here -- that there
2 is no evidence, zero, that Mr. Tchibirev's -- Mr. Tchibirev's testimony that
3 the inventions were owned at the time of the invention that, then there's zero
4 testimony -- there's zero evidence against that. That's plainly false.

5 There's at least three main points of evidence that we have here. One
6 is the invention was made means when it was conceived or reduced the
7 practice. Currently, we have assignments from -- you know, the original
8 assignment, from the original priority application, and then we have the
9 second assignment for the CIP, which was in November of '08.

10 Both inventors testified the invention was conceived in early '08, way
11 before November.

12 Second, you know, that shows that the invention wasn't co-owned
13 until after the invention was made.

14 And finally, there's nunc pro tunc assignment that Patent Owner has
15 not addressed, executed in 2022 that included, I believe, it's the fifth
16 inventor, Mr. Fred Bernstein, that was not on the -- the other assignment.

17 So slides 41 and 42 include testimony from the inventor. Slide 43 has
18 the executed assignments, both for the --

19 JUDGE FITZPATRICK: Mr. Greenleaf, instead of focusing on
20 assignment, can you also tell us what your theory is under subject for an
21 obligation for assignment. Because I believe -- doesn't the safe harbor
22 include that? And maybe these assignments were made after a date that you
23 find significant, but subject to an obligation that it existed at the time the
24 invention was made.

25 MR. GREENLEAF: You know, I -- I cannot speculate on that, Your
26 Honor. I suspected that Patent Owner might have filed employment

1 agreements, but those are not on the record, and I know it would be too late
2 to submit those now.

3 And therefore, we have no evidence that the inventions were
4 co-owned at the time of the invention, other than Mr. Tchibirev's testimony
5 that relies purely on the assignments that plainly show that the inventions
6 were not co-owned when they were made.

7 JUDGE FITZPATRICK: And they just completely not addressed the
8 subject to its obligation -- of the agreement --

9 MR. GREENLEAF: That's correct, Your Honor.

10 JUDGE FITZPATRICK: There's no evidence about that?

11 MR. GREENLEAF: Other than the assignments which contradict the
12 requirements of 103(c).

13 JUDGE EASTHOM: What's your primary argument about lack of
14 nexus? Are you saying that this feature of the visibility that was already
15 well known in the art, is that the thrust?

16 MR. GREENLEAF: That and Patent -- it's Patent Owner's burden to
17 demonstrate nexus. And Patent Owner had not done that, and we can talk
18 about that now.

19 The -- Your Honors granted in part Patent Owner's motion to strike
20 the claim charts, that Patent Owner relies entirely on for demonstrating
21 nexus, which included the analysis for how the claims allegedly apply to the
22 evidence.

23 Patent Owner's response and expert reports contain only conclusory
24 statements that those claim charts support their nexus argument.

25 And so we can talk about that now, since it's come up, which I'm
26 happy to do. I have a slide on that.

1 Slide 28 talks about the IBG case that Your Honors cited with
2 support, and the order granting in part the motion to strike.

3 IBG addressed this issue identically in the bottom of this highlighted
4 portion here. It says -- there's Exhibit 2233 explaining how each claim
5 element is presented in -- explaining how each claim element is
6 presenting -- present -- is present in MD Trader.

7 So the 2233 was a claim chart and the Board in the final written
8 decision said that: Such an incorporation by reference is inappropriate as
9 Patent Owner's response fails to explain how MD Trader includes the
10 features of the claims.

11 Another case that addressed this is Endo v Depot
12 Med -- IPR2014-00652, paper 68, pages 36 to 37 -- that addressed the same
13 exact issue that arguments need to be in the main papers. That's kind of
14 standard Board practice.

15 You can't incorporate them by reference to -- those claim charts are
16 unsupported by any arguments in the main briefing. Their only conclusions
17 analyzing them -- which the case I just cited Endo v Depo Med and IBG,
18 which the Board followed in its order, say that claim charts alone are
19 insufficient for demonstrating nexus.

20 JUDGE EASTHOM: What about the praise of the -- I forgot what the
21 praiser's name was, but it was affiliated with one of the advertisement that's
22 prominent in one of the briefs. That 4A Association American Advertising.

23 And I thought -- yeah, you have it up, I think.

24 MR. GREENLEAF: Yeah.

25 JUDGE EASTHOM: Doesn't that sort of hit the -- the limitation at
26 issue here at least? And then the -- why isn't that sufficient for nexus?

1 MR. GREENLEAF: So there needs to be nexus to the claimed
2 invention. So under the law, there -- you can't -- you can't claim nexus to a
3 claim limitation that was already known in the prior art.

4 So viewability was known in the prior art. You can't say, oh, well
5 now I invented viewability, and this guy who's trying to sell his accreditation
6 services says my invention is great, and therefore, I have nexus and my
7 claims are patentable.

8 That's not how nexus works. And the nexus needs to be based on
9 something that is not in the prior art.

10 JUDGE EASTHOM: Right. That's why I was asking the question
11 before.

12 Okay. That's your -- that's your main thrust for that? Okay.

13 MR. GREENLEAF: Yeah, amongst -- amongst other issues that we
14 can get into in my rebuttal, unless Your Honors have other questions about it
15 now. I'm happy to address any further questions.

16 JUDGE FITZPATRICK: I'd like to ask a couple of questions. One
17 is -- so those charts Exhibits 2046 and 2049, we didn't strike them. We
18 struck the analysis out.

19 So with that being said, is it your position that those charts,
20 without -- you know, just imagining the analysis column exists, because
21 that's what we're doing -- those charts do not show that any of those services
22 are covered by, for example, claim 1 of the '329 patent, or is it that they don't
23 show co-extensiveness, or both?

24 MR. GREENLEAF: Both. Bare claim charts themselves cannot
25 demonstrate nexus, according to both the IBG case, which was cited in the
26 Board's order as persuasive authority, and also in that other case I mentioned

1 earlier. Their claims --

2 JUDGE FITZPATRICK: Right, I agree that -- I'm sorry to interrupt
3 you, because I want to save some time.

4 I agree that the co-extensiveness is going to be hard to show that in a
5 claim chart unless it's, you know, not your normal --

6 But if we go to like, for example, Exhibit 2046, can you -- like, for
7 claim 1, can you tell me a limitation that you dispute? Just -- not being
8 there.

9 MR. GREENLEAF: So I would like to reserve that for my rebuttal, if
10 I could, please, Your Honor.

11 JUDGE FITZPATRICK: That's absolutely fine.

12 MR. GREENLEAF: Okay.

13 JUDGE FITZPATRICK: Another question. Because nexus can come
14 in different forms based on the criteria, based on the type of secondary
15 consideration evidence. For example, if sales of service show that product
16 and service that you provide, the nexus, that goes with that.

17 But the praise -- the praise -- and I think Patent Owner had a large
18 quote in the Patent Owner's response. I think it's at -- yeah, page 20, by
19 Mr. -- by Mr. David Cohen. It begins on page 22 of the Patent Owner
20 response.

21 And nexus can be proved two ways. Indirectly is the more common
22 way. It's -- I think that the go-to word for that is presumption, you stick with
23 the presumption to it.

24 You could also prove nexus directly, that the evidence -- secondary
25 considerations evidence, for example, praise, is a direct result of the unique
26 characteristics of the claimed invention. And as you said earlier, it has to be

1 from something that's not from the prior art.

2 Here we have a little bit of a chicken and egg problem, because you
3 are telling us that viewability was in the prior art. Patent Owner is telling us
4 the opposite. And we're trying to weigh this evidence without -- you can't
5 assume either when we're trying to weigh this evidence. We have to figure
6 out where the evidence is ultimately looking at.

7 MR. GREENLEAF: Uh-huh.

8 JUDGE FITZPATRICK: And so it's not persuasive argument to say
9 that we can just ignore Mr. Cohen because he's talking about something that
10 already existed. Except, I would respond to that and say, well is he
11 completely just misguided then? You know, why did he have this reaction if
12 it's something that had been around for 15 years?

13 So if you could address specifically the argument by Mr. Cohen.
14 Because I think one of the things you addressed about it in your briefing was
15 that he was, you know, talking about the accreditation process because
16 Patent Owner sufficiently rebutted that theory. And he's not talking about
17 that because it came before -- before Patent Owner was -- or RealVu was
18 accredited.

19 Is that -- it was a long-winded question. So pages 22 to 24 of the
20 Patent Owner response, as Mr. Cohen -- I believe your response -- you
21 know, your reply was that this -- is that he is talking about the -- he's lauding
22 their accreditation, not their invention. And it's not an invention.

23 But it's -- but then Patent Owner comes back and says, hey, this -- this
24 quote existed. This guy said this thing before the accreditation. So clearly,
25 he's talking about viewability.

26 Do you have a further response to that?

1 MR. GREENLEAF: So again, Dr. Mandansky addressed this in her
2 declaration that these accreditation -- and Mr. Cohen's was talk -- was
3 referring to MRC in his discussion here. I don't entirely remember the
4 context of this -- this blog post.

5 But -- but both IAB and MRC are in the business of creating metrics
6 and measuring whether people are following those metrics.

7 And yes, they do know what they're talking about. But they are
8 interested, as Dr. Mandansky testified, that people don't really want to work
9 with MRC and IAB if they don't have to.

10 She goes on in several paragraphs, and I can pull up more in my
11 rebuttal, that talk about how people would not and still don't seek
12 accreditation because it's not important.

13 If you can sell your service without accreditation, why would you go
14 through the rigorous process -- as this person on the internet called the
15 "Mafia" -- and get your -- technology accredited when you can sell your
16 service without accreditation and save that cost?

17 So both Mr. Cohen and I think Mr. -- I think it's Igor from MRC are
18 self-interested. And this goes to Patent Owner's point about Volvo Penta,
19 which I'm sure we're going to hear a lot about shortly, is that even if there is
20 some nexus somewhere or some secondary consideration, we need to weigh
21 the totality of the evidence, including Dr. Mandansky's testimony that
22 demonstrates that this industry praise was self-interested. The Board needs
23 to weigh all of the factors in determining whether they outweigh the
24 compelling showing of obviousness that Badros provides, and they do not.

25 JUDGE FITZPATRICK: Okay. Focus to -- I understand
26 self-interested argument to make the conflict of interest, but I want to raise

1 that, and I understand that point there.

2 But this statement by Mr. Cohen, will you concede -- and if not, why,
3 that it -- that this does not establish that there is -- that there is not nexus
4 between this statement and the claimed invention of the '329 patent?

5 And I'd like to draw your attention to paragraph 3 at the bottom of
6 page 22.

7 He says, "It would appear that, among other things, RealVu has
8 developed a technology that allows them to identify when an on-line ad is
9 within the viewable area of a user's screen and for what duration."

10 MR. GREENLEAF: Uh-huh.

11 JUDGE FITZPATRICK: And then -- so that's the invention he says
12 he's talking about and he's -- and he's lauding, so he is praising what I
13 consider to be the invention.

14 And if that's not true, do you have an argument to support that?

15 MR. GREENLEAF: The nexus is not simply that you claim
16 something and somebody says something great about it. The nexus is that
17 you have an inventive concept, and somebody makes a statement lauding
18 that inventive concept.

19 There is no nexus here because viewability was not an inventive
20 concept. So on the legal standard of what nexus means, based on federal
21 circuit case law, that is not nexus, because viewability was not an inventive
22 concept.

23 Are the two tied together? Clearly, they are. He talks about
24 viewability, but that doesn't meet the legal requirement of nexus.

25 Are there any more questions?

26 JUDGE EASTHOM: I don't see any on the table, so you probably

1 have two-and-a-half minutes in your original rebuttal and then we'll add five,
2 so that'll make it seven-and-a-half minutes left for you, Mr. Greenleaf.

3 MR. GREENLEAF: Thank you, Your Honors.

4 JUDGE EASTHOM: Thank you.

5 And Ms. Richards, are we going to hear from you or -- no. Okay.
6 You're the -- that's right, evidentiary. And so, Mr. Berten, would you like to
7 reserve some rebuttal time?

8 MR. BERTEN: Well, I was going to reserve 15 minutes based on his
9 original 30. But why don't I make it five for the time being, and if I happen
10 to get through these quickly enough, and --

11 JUDGE EASTHOM: Reserve five? I'm sorry.

12 MR. BERTEN: I'll reserve five.

13 JUDGE EASTHOM: Okay.

14 MR. BERTEN: And if you give me one second.

15 JUDGE EASTHOM: Okay. If you would, please, when you start,
16 introduce yourself to the record again.

17 MR. BERTEN: Yes, Your Honor.

18 One minute. I think I'm ready.

19 JUDGE EASTHOM: Okay.

20 MR. BERTEN: Good afternoon. My name is David Berten. I
21 represent the patent owner in this case, Rich Media Club. And we'll be
22 going through a few sets of slides.

23 I will have -- be happy to answer any questions the Board might have
24 about this case, but our presentation is going to focus, obviously, on the '329
25 Patent.

26 And that patent, just to read the entire -- or part, the first claim, starts

1 with determining -- this is actually where some of your
2 questions started -- determining whether a predefined area of ad content
3 display page that is used to display an advertisement is in view within a
4 visible area of the browser.

5 Then you get down to element (b), which is if you've made that
6 determination that that ad has been in view for a predefined period of time,
7 then you cause a replacement ad.

8 So we've called this determination that the predefined area is within
9 the visible area of the browser window, the "ad viewability test." It's a
10 determination of whether the ad has been in view on the user's browser. If
11 that happens, a replacement advertisement can be sent to the ad.

12 Claims 2 and 3 say that that replacement advertisement is based on an
13 auction, and Claim 3 says that auction has to happen in real time.

14 Judge Fitzpatrick, you were asking about the real time presence of
15 Harkins. We're going to talk about that a little bit in the presentation today,
16 but that's what Claims 3 and 8 both require, is a real time auction.

17 The theme here, of course, is that the petitioner has not met their
18 burden. They originally relied on three different references: Krassner,
19 Badros, and Harkins.

20 The obvious main thrust of the reliance is Badros. We're to start by
21 looking at Badros and how their paid expert Dr. Smedley admitted that
22 Badros was unwilling to testify that it teaches the viewability test, so that
23 will be out.

24 Krassner is a 102(e) reference and under the 103(c) safe harbor, it
25 should be out. Harkins is not analogous art. It also doesn't teach the real
26 time auction so, it can't be relied upon, then, to teach that element for Claims

1 3 and 8.

2 But the real fundamental problem in this analysis is that nowhere in
3 the petition or even in the reply has the petitioner applied the required test by
4 the Federal Circuit when secondary considerations are present, laid out in
5 the Volvo Penta petition, and they can't -- or case.

6 They can't argue that they were surprised about a reliance on Volvo
7 Penta or that, you know, why they didn't raise it in the reply. We cited
8 something like a dozen times in the response that we thought that it was a
9 controlling authority in this case.

10 And what does that mean? It means that the entire analysis for
11 obviousness changes. The Board has to consider the totality of the evidence
12 that's been presented, a long felt need, praise, surprise, failure by
13 others -- which may become the most important thing that you consider
14 when you look at the secondary considerations -- licensing, copying,
15 commercial success, all in relation to the combined teachings of the
16 references relied upon in the petition.

17 When the Court does that analysis, you'll see that the petition has to be
18 rejected and all the claims should remain valid. But let's start with what
19 Mr. Smedley said during his deposition. And I want to make sure that we all
20 make -- that we're all talking about the same determination test.

21 We've called it the viewability test. It's that part (b) of -- of the '329
22 Patent. It's also the test that's mentioned in the petition at page 23.

23 It's from Smedley's declaration in paragraph 65, and it's from the cross
24 examination of Mr. Smedley over a several page period from pages 50 to 52
25 during his deposition, where I asked him -- you'll see five different
26 times -- five different times -- whether he agreed that Badros taught that

1 limitation.

2 And his opinion -- his statement was, his sworn testimony was, "I
3 don't -- I didn't have that opinion when I filed my report, and I cannot form
4 that opinion today."

5 So let's just look at his deposition testimony.

6 Question: "That's exactly my question. Is it your testimony that you
7 do not know whether Badros teaches to" -- And here's the language straight
8 out of paragraph (b) -- "to make a determination that the predefined area that
9 is used to display the advertisement has been in view within the visible area
10 of the browser for a predefined period of time?"

11 Answer, sworn testimony: "That is not something I've given an
12 opinion on."

13 Next question: "My question is, as you sit here today, is it your
14 opinion that Badros teaches that or not?"

15 Answer: "That's not something I've given an opinion on here, and I
16 can't formulate that sort of opinion as we sit here. I'd have to -- it's
17 something I haven't done, so I'd have to sit down and analyze whether he's
18 proposed -- what he's proposed carefully and would take longer than we
19 have to sit here today."

20 Question: "I want to know whether Badros teaches, in your opinion,
21 the same language from paragraph (b)?"

22 Answer: "It's not something I'm able to do as I sit here right now."

23 Question: "How long is it going to take you?"

24 Answer: "I don't know. This is all about the key viewability test. It's
25 all from Badros."

26 In law school, they teach you, when you get an admission like this,

1 you stop. I didn't. I actually issued Mr. Smedley a warning, and I said,
2 "Well, I actually need to know an answer to that question, because I need to
3 know whether Badros teaches that or not. Because if it doesn't teach it, I
4 don't see how Badros can invalidate, how your opinion can support the
5 petition."

6 Objection from Mr. Greenleaf: "Asked and answer. Is there a
7 question there?"

8 Question: "The question is, you do not have an opinion about whether
9 Badros teaches to make a determination, same language, that the viewability
10 test is satisfied."

11 Answer: "That's not something I've given an opinion on, and it's not
12 something I'm able to give an opinion on as we sit here today. Same
13 question; same answer. I'm not able to form a question about
14 whether -- about Badros teaching as I sit here today about Badros teaching,
15 I'd say that pretty much of anything that I've analyzed."

16 Now, that's five admissions by their paid expert witness that he is
17 unwilling to testify that Badros contains a teaching.

18 The Board had questions about whether Badros has that teaching or
19 not. Their expert would not opine that it did. And his admissions were
20 particularly odd because he had stated in his declaration that it's his opinion
21 that Badros alone discloses these steps. But when we got to deposition, he
22 refused to back that testimony up, and that prevented us from doing things
23 like asking the very questions the Board's asked here: Where does it teach
24 it? How does it explain it? Is it confusing the billboard model? Is it in the
25 impression module? Is it on the server? All the questions that would
26 normally get asked of an expert because he opined that he did not have and

1 would not form that opinion.

2 There's the five different times on slide 7 where he gave the exact
3 answer, contrary to what he stated in his declaration that he hadn't formed
4 the opinion.

5 So this is a conclusion that the Board can draw. This is a question of
6 who has the burden of proof. It's the petitioner. They have not met their
7 burden. Their paid expert under oath at his deposition would not testify that
8 Badros teaches the viewability test. So that's the first issue with
9 Dr. Smedley.

10 So what do they try to do? On reply, the petitioner submitted a
11 renewed declaration from Dr. Smedley saying, essentially, forget what I said
12 in my deposition. I do have the opinion that Badros teaches the viewability
13 test.

14 And there are at least four problems with the attempt in reply to
15 introduce that opinion. The first, as we said in our surreply, It's not allowed
16 under the code. The petition is supposed to identify the printed publications
17 that are relied upon and identify what they're going to use as support it.

18 JUDGE EASTHOM: Well, let's say we look at this and we say, okay,
19 we discount the expert on his first declaration because he was evasive at
20 your deposition.

21 And then we say -- we go to 11 to 12 columns of Badros, saying, it
22 says it's visible there. It says they're going to time it. It looks like that's
23 what they say. So why wouldn't we do that?

24 I mean, I was on a case once where we -- we had to ignore the expert
25 testimony and we went forward.

26 MR. BERTEN: Well, you could certainly say that we're going to

1 ignore Dr. Smedley. You know, he's not credible.

2 JUDGE EASTHOM: Right.

3 MR. BERTEN: And in reaching that determination, though, you have
4 to ask yourself, why did he testify so many times that he was not willing to
5 give an opinion to back up what the petitioner's been saying?

6 JUDGE EASTHOM: Right.

7 MR. BERTEN: And there I would go to the very questions you were
8 asking of the petitioner. I think at best, Badros is a confused reference. And
9 part of the confusion comes from a new argument that's also in reply, which
10 is that this system in Badros is actually working on the client's side.

11 It says in Badros -- we can pop ahead a few slides here.

12 When you look at Badros, it says, and this is the primary reference
13 they relied upon in the petition. They rely upon the impression module,
14 which is clearly on server 2 in Badros, and it actually says it in column 12,
15 the primary column, they rely upon in the petition, that it's on the server.
16 And that's something else that Smedley admitted during his cross
17 examination, that it shows the impression module inside a box on the server.

18 And the problem is that there is no evidence that any server-side
19 program is able to determine what is in view on the user's computer while
20 they're surfing the internet.

21 So part of Badros is -- and our expert, Mr. Sherwood -- Dr. Sherwood,
22 testified to this -- is you can't find it in how it would work on the server.
23 And that's the problem with Badros. So you have the combination of an
24 expert, that is --

25 JUDGE EASTHOM: And what about their evidence that there's a
26 communication with the client that we just talked about. Your friends put up

1 the quote from Badros?

2 MR. BERTEN: There is -- they do say that in reply --

3 JUDGE EASTHOM: Uh-huh.

4 MR. BERTEN: -- again, not in the petition, but in reply, they make a
5 new argument that Badros has communications between the server and the
6 client. But they never explain how the impression module is going to be
7 code that resides on the client, that allows the client to execute the
8 viewability test that you need to have in order to practice a claimed
9 invention.

10 So that's -- I mean, that's the answer there, is that the reference
11 nowhere clearly describes you've got to load this information on the client
12 side to make it work.

13 JUDGE EASTHOM: Well, isn't that something that an artisan of
14 ordinary skill would know, like -- I mean, Badros says it's viewable. We can
15 talk about how long it's viewable. We can do this.

16 And then, I thought their other expert -- yeah, they had about five or
17 six old references that said, okay, you can clock where the pixels are on the
18 screen and you can do all these things that anybody could code once you
19 know that's what you want to do and find out how long this thing is visible
20 or would have been visible.

21 MR. BERTEN: So there's two responses.

22 JUDGE EASTHOM: Thank you.

23 MR. BERTEN: The first is the references that you were describing
24 were all submitted on reply. They go to a core limitation in the claim.

25 JUDGE EASTHOM: Right.

26 MR. BERTEN: So they want to -- they want to argue that they're

1 allowed to do that because they're just rebutting us, but this is evidence that
2 goes to a core limitation of the claim. If they're going to rely on new -- on
3 new evidence on reply, all the case law and the trial practice guidelines and
4 the code say they can't do that.

5 JUDGE EASTHOM: But wait a minute. I mean, you raise the
6 enablement issue. The presumption of enablement applies.

7 You say, hey, I'm looking at this column. I don't see how you can do
8 it.

9 And they say, well, everybody knows how you can do it. You have to
10 do it this way, and all these references show us that everybody knows how to
11 do it.

12 It doesn't seem that they're -- you know, they're not shifting anything.
13 They're just responding to what you -- you raised.

14 MR. BERTEN: Well, that's -- that's certainly what they're going to
15 argue.

16 JUDGE EASTHOM: Right.

17 MR. BERTEN: I would argue the opposite, that they're attempting to
18 shift the entire basis of the petition, because they have a hole in Badros, as
19 demonstrated by their own expert who was unwilling to testify that Badros
20 teaches this element claim (b) for the viewability test.

21 And when they're unwilling to do that and in reply, they start to
22 introduce a bunch of new documents, then as the Board, you know, correctly
23 instructed us, we're not allowed to introduce any -- any contradictory
24 evidence to that new evidence that they put in reply. We're -- we have
25 to -- you know, we can't do anything, which is why the Board in the past has
26 said, you're just -- you're very limited on the new evidence that you could

1 submit in reply.

2 JUDGE EASTHOM: Right.

3 MR. BERTEN: Some of the stuff on the secondary considerations I
4 understand. You know, they're going to want to attack some of the
5 secondary considerations. Those are introduced in the response, and I'll talk
6 some more about that in a second.

7 But on the core issue of does -- did they submit with the petition? Did
8 they carry their burden of demonstrating that a viewability test was in the
9 prior art? The answer is no.

10 JUDGE EASTHOM: And what about I -- what about on the merits?
11 Did you -- I know you couldn't submit evidence, but in your surreply, did
12 you address whether or not those references do show one of skill could --

13 MR. BERTEN: We -- we have limited ability to do so in the response
14 without an ability to submit, for example, an additional declaration by an
15 expert to say what these multiple references teach. I don't think we'd be able
16 to do it anyway, in response.

17 Their reliance on them was pretty limited. I mean, they would -- they
18 would have a one sentence sort of summary of, well, it's -- it's in this
19 reference. And it's in this reference.

20 You know, I want to be careful about what I can say or not say about
21 those references, but I'll paint a hypothetical. What if, for example,
22 references submitted in the reply can be sworn behind?

23 JUDGE EASTHOM: Right.

24 MR. BERTEN: We're not able to do that in the surreply. So there are
25 lots of things in the surreply that -- that limit our ability to respond to those
26 positions.

1 JUDGE EASTHOM: Right.

2 MR. BERTEN: And so the second thing I would say in response to
3 all of their evidence on viewability supposedly being known is that's why the
4 secondary indicia are so critical in this case, is because what you have in this
5 case is independent and third-party contemporary statements by others,
6 expressing what I would call, you know, shock and -- and not just shock, but
7 almost disbelief that this is something that could actually happen, that you
8 could actually determine whether an ad was viewable or not.

9 And if you go back and look at the exhibits that we submitted -- and
10 we'll go through these -- and look at the industry reaction to what RealVu
11 demonstrated as a working, actual system in late 2009 and going into 2010.
12 It shifted in no -- I'm not understating this here. It shifted the online internet
13 advertising industry.

14 You'll see the entire industry got together to say, now that a company
15 has demonstrated --

16 JUDGE EASTHOM: But isn't that a bootstrap argument? You're
17 saying it's shifted -- it shifted everything. And I get that. And I mean,
18 that's -- that's very important evidence.

19 But how does it show whether or not it's already been done? I mean,
20 they have four or five references.

21 It seems to me -- it seems -- it doesn't seem, you know -- maybe this is
22 hindsight or reading Mandasky's declaration but, you know, she's talking
23 about looking at where the pixels are on the screen.

24 And how -- how did you- how did you do it? What was your -- what
25 was your inventor's method of figuring out whether it was viewable?

26 MR. BERTEN: They developed what's called a "geometric

1 viewability test," trying to figure out, based on coordinates on the page, how
2 it works. But the one critical thing that they did first is they knew that they
3 had to download code onto the page.

4 JUDGE EASTHOM: Okay.

5 MR. BERTEN: So if you look -- if viewability tests were available to
6 some degree in the art -- and in my opinion, the only thing that the Board
7 should be focused on is Badros. Did Badros demonstrate that they work?

8 JUDGE EASTHOM: Did you -- but did you -- with all due respect,
9 did you, you know, as an attorney, working on your expert and surreplies
10 say, look, this reference doesn't do this because the code is not on the client?
11 Or something -- did you dispute that those references showed that that was
12 already done?

13 MR. BERTEN: The problem is that I'm not able on surreply to --

14 JUDGE EASTHOM: Well, you can make an argument. You can
15 make --

16 MR. BERTEN: I can make an argument, but I can't --

17 JUDGE EASTHOM: You can point us to the reference, and you can
18 say, look this reference is wrong because blah, blah, blah, blah.

19 MR. BERTEN: So the surreply does have some indication about why
20 some of that presentation is incorrect. So for example, one of the references
21 that they rely upon is a company called Alenty, where they have three
22 references that allude to some sort of viewability test that Alenty may or
23 may not have had.

24 And we moved to strike those references, and that motion is still
25 pending before the Board, because they're here saying a bunch of other stuff.
26 But they're a good example of no understanding of what's involved in that

1 viewability test.

2 So I'm aware of one other potential viewability test that I think
3 that -- is discussed in one of the references where the -- the reference
4 actually required sort of downloading an extension into the browser --

5 JUDGE EASTHOM: Okay.

6 MR. BERTEN: -- to get it to work. It wasn't something that sat as
7 part of the browser code itself that came down with each new document each
8 time a particular website was called up.

9 JUDGE EASTHOM: Okay.

10 MR. BERTEN: So that's -- some of that argument is in our surreply,
11 but you know, this -- this case when you look at the combination of -- you
12 may recall the clerical error on Krassner --

13 JUDGE EASTHOM: Right.

14 MR. BERTEN: -- where -- where the references that were submitted
15 with the petition had problems with them, and Badros did too.

16 And if the petitioner can shift those on reply, it just so limits the
17 ability under the rules that the Board has here for the patent owner to
18 respond that, you know, we did what we could in our response to try and
19 address those.

20 But substantively trying to march through eight different references
21 and explain why each one is wrong, where all you're going to get is lawyer
22 argument, I don't know how the Board could rely upon that.

23 But -- but here's what I think the Board can rely upon, and it's this
24 secondary indicia of non-obviousness, starting with the industry reaction to
25 the invention.

26 So if we start with -- bear with me for one second. I'm going to have

1 to disconnect for a second.

2 JUDGE EASTHOM: And also, you know, while you're thinking
3 about it. It dawned on me -- it seems as if -- and I hear you -- I hear your
4 frustration. It seems like this is probably a -- as a result of the presumption
5 of enablement. But also, when you raised the issue of nexus, why isn't it
6 proper for them to say, hey, this has already been done?

7 MR. BERTEN: Because the whole point is if the industry reacts to
8 say it hasn't been done --

9 JUDGE EASTHOM: Right.

10 MR. BERTEN: -- if they're going to look at references in reply that
11 we can't respond to, and the industry reaction is there's something brand new
12 that fundamentally changes the way that we can track advertisements.

13 That's what Volvo Penta says, you have to consider that and say, well,
14 the -- the industry wouldn't react that way if this art was already in the
15 industry. If everybody already knew how to see if an ad was viewable or
16 not, why would somebody like David Cohen have the reaction that he had?

17 So if you start with the invention on April 4th, 2009, you've already
18 raised Exhibit 2024, which is the David Cohen blog post. At the time, he
19 was an executive with an ad agency called Universal Media, and you've read
20 some of the quotations. It's extensively quoted in the response. But --

21 JUDGE EASTHOM: What was that date?

22 MR. BERTEN: That was -- that was November 10th, 2009.

23 JUDGE EASTHOM: Okay. Because I thought Badros was published
24 in May of 2010?

25 MR. BERTEN: Badros was published in 2010. It has a 2005 filing
26 date.

1 JUDGE EASTHOM: So this guy might not have ever seen Badros,
2 obviously, right?

3 MR. BERTEN: Nobody in the industry had seen Badros.

4 JUDGE EASTHOM: Right.

5 MR. BERTEN: There was no -- there was no -- nobody in the
6 industry had seen a working viable viewability test until RealVu started
7 showing it to people after they invented it in 2009.

8 JUDGE EASTHOM: But I mean, how does that cut it if it was filed
9 in 2005 and if -- if they, you know -- if they -- arguably, they talked about it,
10 you know. You dispute whether it was enabled. I have another question
11 about that later.

12 But yeah, how would they know about it if it as in the -- it was 102
13 ER, basically, compared to what?

14 MR. BERTEN: Well, they would have known about it because
15 Google would have brought AdView into fruition earlier.

16 You'll see at the end of the slide that Google didn't bring its solution
17 until about three years -- at least for its accredited solution until about three
18 years after RealVu had been accredited by the MRC.

19 JUDGE EASTHOM: Okay.

20 MR. BERTEN: So there's another article that was published in 2009
21 talking about how bad the problem was and this goes to felt need. It's
22 Exhibit 2062 from the Harvard Business Review, about how the industry
23 had this problem. And it's actually in the -- in the David Cohen testimony,
24 too, where he says, we don't need any more Wall Street Journal's articles
25 talking about invisible ads.

26 This was a problem that the industry recognized that there was an

1 ongoing issue that nobody else had solved about how to deal with the fact
2 that so many ads were what was called "below the fold," and advertisers
3 were getting charged for those ads when they never made it into the visible
4 area of a browser. And that Harvard Business Review article covers some of
5 the same information.

6 While this was going on, the MRC started its accreditation process
7 based on RealVu's contribution. RealVu in April of 2010, became the first
8 company that was accredited by the MRC, and that's Exhibit 2017. And
9 Exhibit 2039 explains or confirms again that they were the first company
10 that received this accreditation.

11 A press release was issued in June of 2010. This is one of these
12 documents -- that the petitioner calls "self-serving," but they're overlooking
13 who the quotations are coming from.

14 So one of them was David Cohen again. At the time, I said he was the
15 executive vice president at a company called Universal McCann. He is now
16 the CEO of the Interactive Advertising Bureau or the IAB.

17 Another person who agreed to be quoted was Kyo Kim, who at the
18 time was a vice president at MSNBC Digital. And she stated that she
19 believes that this innovation was now going to allow these advertisers to
20 become more trusted.

21 A third person who was quoted was the former CEO of the IAB by a
22 man -- by the name of George Stewart, who said that they missed a key
23 major factor when they introduced the served impression. Served
24 impressions are the impressions that were counted at the server -- again,
25 some of the confusion that gets introduced from Badros -- as opposed to
26 having a system that would allow confirmation that an ad was viewable on

1 the client side.

2 So what happened next was, and this is -- this is one of these things
3 that I don't think the Board can discount -- in that you have these four major
4 advertising agencies get together -- so something called the ANA, the IAB,
5 the 4A's -- and they bring the media ratings counsel on board the MRC, to
6 try and create a brand new standard, the viewed impression that is based on
7 RealVu's demonstration that viewed impression is now something that's
8 possible. Nobody's seen it before and that's something that put that on the
9 map.

10 So I'm going to try to do this here, if I can. If you're interested, I
11 can -- I can actually show you the YouTube video where these gentlemen
12 from that time period are talking about what happened when they were
13 introduced to RealVu. It's Exhibit 2054. That's where the YouTube link is.
14 I have to have two things work to be able to show you this. The first is the
15 internet.

16 JUDGE REPKO: If you have any objections, please raise them
17 during your own time.

18 MR. GREENLEAF: Thank you, Your Honor. I object that this is
19 evidence not on record. He can bring up the exhibits --

20 JUDGE REPKO: Please -- please object during your own time.

21 MR. GREENLEAF: I'm sorry?

22 JUDGE REPKO: If you have, objections, please just preserve that for
23 your time.

24 MR. BERTEN: Well, he wants to object. He doesn't want us to see
25 this, I guess. I think it's not going to prejudice us if we -- we'll know. Let
26 me -- let me -- let me just talk to my --

1 JUDGE FITZPATRICK: Can I just ask -- is it -- is the tech, is what
2 you would say (inaudible).

3 JUDGE EASTHOM: Mike, you're breaking up. I mean, Judge
4 Fitzpatrick.

5 JUDGE FITZPATRICK: Oh, so sorry.

6 JUDGE EASTHOM: Go ahead.

7 JUDGE FITZPATRICK: We've got multiple mics going on at the
8 same time.

9 JUDGE EASTHOM: Go ahead.

10 JUDGE FITZPATRICK: I could hear something, too. I don't know
11 if -- I'm wondering if just -- if the quotes that appeared in that exhibit are
12 sufficient.

13 MR. BERTEN: I mean, this -- they're sufficient. I mean, this -- I
14 would say that this link and the document of record, we put it in as
15 Exhibit 24 and it's in the thing that I was going through with those
16 quotations from there.

17 But the Board is free on their own -- you can go and click the link
18 yourself, and it's only about a three-minute video. But it shows in
19 November of 2011, the industry coming together and confirming all these
20 things, a felt need, industry surprise, and praise.

21 The guy who's leading the panel was George Ivie. He's the same
22 executive director and CEO of the MRC that accredited RealVu for the first
23 time. He starts off by saying viewability is on the map. He passes it off to
24 David Cohen.

25 Cohen then repeats what he said, in his blog post was that, "I met with
26 RealVu just about the same time George did, and I was equally kind of

1 astounded."

2 And then they passed off to a guy named Julian, who also says that he
3 met with RealVu. He was the senior vice president of Starcom Media Group
4 at the time, and also very impressive.

5 And then he and George Ivie are actually talking over each other in
6 the video because George Ivie says something to the effect of RealVu was
7 getting around. RealVu was -- was promoting this solution and driving
8 industry change based on it.

9 JUDGE REPKO: So is this -- I just want to make clear that this is not
10 a time to introduce new evidence. Is this in the record? Has this been
11 developed in the record?

12 MR. BERTEN: It is developed in the record. It's Exhibit 2054.
13 There is a -- what we did is we took a still image. We put the link to the
14 YouTube video and then took a still image with -- from the YouTube video
15 with the quotations from that. It's part of Exhibit 2054.

16 JUDGE REPKO: Okay.

17 MR. BERTEN: Another Exhibit is 2035. This is one where George
18 Ivie, who we just talked about before, says that RealVu essentially invented
19 viewability. These are his words. He's crediting RealVu with that
20 development.

21 And in this article, it also says that there may be other solutions being
22 under review by comScore, Nielsen, and OmniSure. And that brings me to
23 what I think I alluded to before. The 3MS initiative is all over the papers.
24 It's something called the Making Measurement Make Sense Initiative that
25 the four parties got together to form -- and the four parties being the
26 advertising agencies -- to promote it.

1 But here's what happened. This is a document that I would ask the
2 Board to review carefully. It's Exhibit 2018, and it issued on
3 November 14th, 2012. And it describes an internal test by the Media
4 Ratings Council where they looked at 3 billion impressions -- ad
5 impressions. They had something like 21 different ad campaigns that they
6 looked at.

7 They were trying to measure the effectiveness of viewability tests by
8 five different providers. And instead of endorsing moving to a viewable
9 impression, they issued this advisory that said, we're not ready to do this
10 because based on large scale test of real advertiser campaigns as detailed
11 within while capabilities vary the ability to consistent to -- consistently
12 measure whether impressions are viewable is a challenge that must be
13 overcome by most of the vendors.

14 So three years after the invention, two years -- roughly 18 months
15 after the MRC accredited RealVu's solution, the MRC said nobody else is
16 ready.

17 Google would not get its accreditation for its solution
18 ActaView -- this is in Exhibit 2039 -- until April of 2013. So about two and
19 a half years or three years after RealVu's solution was accredited in 2010,
20 Google solutions accredited in 2013. So obviously, the issue is if
21 Badros -- if Google already had a way to do this and Badros disclosed it, the
22 evidence shows that every other non-accredited party in 2012 was unable to
23 get their viewability test to consistently work. And Google wasn't able to
24 get its accreditation until approximately eight years after the Badros
25 reference was filed.

26 JUDGE REPKO: So the specific teaching you're referring to in

1 Badros, just to clarify, there's a user module. The user module in Badros
2 sends code to the client. The client implements the viewability test. The
3 visibility test, is that specifically the code that you feel is not enabled such as
4 in lines 6 and 7 of column 13?

5 MR. BERTEN: That's not the code that's in the petition. So the code
6 that's in the petition is the impression module, first of all, which is important
7 because there were only two lines at the very bottom of a long quote that
8 talks mostly about the impression module where the petition picks up the
9 user module.

10 Again, in reply, there's a bunch of references to the user module doing
11 stuff that the petition relied on the impression module to do. And in my
12 opinion, it just contributes to the confusion that arises from Badros as a
13 reference.

14 Badros does not explain how all of these parts are supposed to work
15 together to allow a reliable and consistent viewability test. And if it did,
16 then the Board really has to focus on this Exhibit 2018.

17 Why is it when the industry is -- let's, you know -- let's talk about this
18 invention for one second, and the impact that it had on the internet
19 advertising industry. When -- it's pretty rare that you see an entire coalition
20 of organizations get together to create something like the Making
21 Measurement Make Sense Initiative.

22 JUDGE REPKO: Yeah, I know. Just -- I want to focus on my
23 question, though, because specifically, I just want to kind of nail down
24 exactly what you think is not enabled.

25 And it's really important, again, because there's so many models in
26 Badros, right? There's the impression modules, the format modules, the time

1 multiplexing module, and then the user module.

2 And then so I guess -- I just want -- you're still on the same page. I
3 kind of -- you know, I want to understand your position a little bit better.

4 The user module sends some code to the user's device, the client.
5 That collects some data, sends it back to the user module. Then the server
6 has -- is executing this impression module, which is going to make the
7 determination of how long an ad or browser window is -- the visibility test,
8 so to speak -- as you sort of said. Then that is going to feed data to the time
9 multiplexing module, which is going to make some determination based on
10 the test, based on the allotted time.

11 Is that a correct summary of the architecture of Badros?

12 MR. BERTEN: I don't think so. I honestly don't know what the
13 correct summary of the architecture of Badros is when it comes to the
14 viewability test itself. I don't know whether -- I don't think there's any
15 disclosure. And Mr. Greenleaf said this several times during his
16 presentation, that Badros has its client-side code in it. There's extremely
17 limited discussion of anything that happened on the client side in Badros.
18 And your questions, Your Honor, I think at the very start of this about what
19 exactly is the timer doing? Is it timing?

20 One way that Badros works is it sends a bunch of ads at once and then
21 just starts timers and starts changing the ads as the ads timeout. There's no
22 relation between that system and the viewability test itself.

23 So what -- what the petition has tried to do is cobble together different
24 parts of Badros and say, well, it's sort of all in there.

25 But if it was all in there, why is it that, you know, Google was unable
26 to make this determination until 2013 and the entire industry had its reaction

1 to the petitioner's solution?

2 And I'll end on -- on this aspect of the -- what the industry reaction
3 was with the 2013 IAB annual report.

4 JUDGE REPKO: Let's just stick with my question.

5 So I guess we're looking at column 13. It does say that the user
6 module may cause code to be downloaded and or executed on a user
7 computer. So there's something being executed on the user computer, right?

8 MR. BERTEN: Something.

9 JUDGE REPKO: And then they do talk about, "The code may be
10 effective to cause the time-multiplex display."

11 So that's focused at least on the display part. That's the -- you know,
12 whether -- and it's making -- some of that time-multiplexing display
13 according to the petition, they're viewing that as making those judgments
14 and determinations. So wouldn't that be on the client side?

15 MR. BERTEN: Something -- under the columns that are cited in the
16 reply and not in the petition of Badros, something can be sent from the client
17 to the client side that has some relationship to time multiplexing.

18 It's not clear whether that time multiplexing is -- I think Judge
19 Fitzpatrick alluded to this. It's not clear whether that time multiplexing has
20 any direct relation to a viewability test when you combine the user module
21 and the impression module.

22 So you know, what the evidence you have in this case is -- is a -- I'll
23 just call it a "reference" in Badros that is hard to follow, combined with five
24 admissions by their expert that he was unwilling to testify that it taught a
25 viewability test, combined with Sherwood's testimony that he doesn't think it
26 teaches a viewability test.

1 And that's -- that's -- this is a preponderance of the evidence,
2 burden-of-proof issue. Has the petitioner established by a preponderance of
3 the evidence and in light of everything I just told you, that this reference
4 teaches that in a way that actually worked?

5 JUDGE REPKO: I mean, the reference does say that the user module
6 may cause a time-multiplexing program to be executed. I mean,
7 that's -- that's in column 13, regardless of whether the expert testified so or
8 not. And then they're focused on, I guess, this column 11 time-multiplexing
9 criteria, right?

10 So in some embodiments, they apply the time multiplexing criteria. I
11 think that's what they're claiming. Whether or not that's going to teach, you
12 know, the visibility test or not, the code itself -- I think that you're
13 questioning enablement -- is whether or not the users and the client device
14 executing this code implements the visibility test, or whether it could,
15 whether it can send data back and forth, whether it could collect data.

16 Is that the real issue, at the heart of the enablement question is
17 whether that code is doing what is in the claim? At -- the stuff that -- the
18 thing is that is being downloaded, right?

19 So there's -- user modules sends some code to that user device. The
20 user device is executing that. It's -- and it says right here, it's performing
21 time multiplexing. That's what Petitioner is actually saying, reads on that
22 claim limitation.

23 MR. BERTEN: Well --

24 JUDGE REPKO: I guess I'm kind of confused about this enablement
25 issue and how could it not just -- how is it not just saying that explicitly?

26 MR. BERTEN: I don't think it is saying explicitly. What it's -- what's

1 unclear, and it goes right to Judge Fitzpatrick's question, and I think some of
2 the questions here earlier of the petitioner, which is, first of all, what is
3 time-multiplexing and what part of the -- whatever is being done for a
4 viewability test, if anything in Badros, relates to the actual predefined area
5 of the ad.

6 So there's -- there's in Badros -- and I want to go back to this point
7 that that user module was not in the petition. It's not something that's being
8 discussed in the petition.

9 And if it sent something, Badros doesn't explain anything other than it
10 can time multiplex, which could be changing ads not based on whether those
11 ads were actually visible. It could be changing documents. It could -- and
12 that's, again, some of the confusion that happens from Badros.

13 The bottom line is that Badros is a -- I find it to be a confused
14 reference that just doesn't clearly explain how, if at all, a viewability test is
15 being run.

16 JUDGE REPKO: Yeah, and so there's -- the viewability test and the
17 actual display of the ad, and maybe that's separate. I mean, lines 21 and 23
18 of column 13 states, "Collecting data at the user's computer."

19 MR. BERTEN: But what data? You know, it's collecting data that
20 may have -- that may have -- all it may be doing at the user's computer,
21 because it says elsewhere in Badros that it sends a timer down. Is it just
22 running time that -- that an ad below the fold?

23 So you've got to go back to the state that the advertising industry was
24 in 2009, where the like -- things like the Harvard Business Review talk
25 about invisible ads.

26 I asked questions of Dr. Smedley at his deposition, you know, "Do

1 you know what below the fold is?"

2 And he said, "I've never heard of it before."

3 And below the fold in internet advertising parlance is, you've got a
4 part of the page up and there's a bunch of content that's not in the visible area
5 of the user screen but is below it. And ads would get slotted into those ad
6 holes, if you will, and those could also be rotated based on timers and never
7 have any idea whether they were visible or not.

8 And if that's the time multiplexing that Badros is talking about, it has
9 nothing to do with confirming that the ad was in view for a predefined
10 period of time and then a replacement ad gets sent.

11 JUDGE REPKO: But -- I guess according to Petitioner, they're
12 saying these documents are the ads. And it does say that, you know, in the
13 time-multiplexing section, I guess column 11, that there's some
14 determination whether the document is actually viewable. So that would
15 kind of contradict what you're saying, that if the documents on screen means
16 that time multiplexing criteria is not going to be met.

17 MR. BERTEN: I think, again, Judge Fitzpatrick was questioning the
18 petitioner on this very issue, which is that the documents could be the
19 document itself. It could be the entire Web page.

20 It's not clear in Badros that they are actually determining whether the
21 predefined area that is the ad was in view for a predefined period of time
22 before they send a replacement ad to that ad hole.

23 So the combined teaching -- what the invention claims is all of those
24 things. You've got to first determine if the ad is in the predefined area for a
25 predefined period of time. If it is, then run a replacement ad. And claims 3
26 and 8 say, do it with an auction and do it in real time.

1 And that -- that -- what I think you might be able to understand about
2 why that is so relevant in this case, a particular articulation, is when you
3 consider the other evidence of objective indicia, which is licensing and
4 commercial success, and copying commercial success.

5 So what happened in this case is RealVu started selling what are
6 called "second-print ads" in 2015. They sold a number of those ads.

7 The references in the -- it's both in the response and the reply as to the
8 dollar amount. I won't state it on the record here, but it's there. And they did
9 that. The dollar amount is reported from 2015 until sometime in 2023.

10 What you don't have in that document is any activity from Duration,
11 and that's because Duration wasn't selling ads yet. So from December of
12 2015 and -- I'm sorry -- January of 2015 until December of 2023, RealVu,
13 Exhibit 2026, generated sales; that's commercial success.

14 Duration knocks on RealVu's door in August of 2018. They enter into
15 an NDA. That's Exhibit 2019.

16 A few -- a month or so later, they enter into a cooperation agreement
17 where Duration licenses RealVu solution. That's licensing.

18 It's direct evidence that Duration came to RealVu to license its
19 solution to determine whether ads were on screen so they could purchase
20 them in real time for viewability, leading to a high conversion rate and
21 viewable impressions.

22 They came to us, licensed our technology, and the record shows that
23 they had commercial success. That's Exhibit 2055. That's their
24 interrogatory response.

25 So they had licensing commercial success, and they had a lot of
26 commercial success. It continues in 2020. And they've broken it down by

1 year, how much they add each year.

2 In June of 2020, Duration sent RealVu this intent-to-renew
3 email -- it's Exhibit 2051 -- and said, we are going to renew our contract
4 because we've licensed your technology. We're commercially successful
5 doing it.

6 What they didn't tell us they were doing at that time is copying our
7 technology. So undisclosed to us -- this is set forth in Exhibit 2014, and
8 there was, you know, some skirmishes about this early on -- they started
9 copying our technology and it's all laid out on how they did it. And it's
10 unrebutted.

11 I'll check that. It's rebutted in a sort of shift-the-argument kind of
12 way. So we claim that they copied virtually every aspect of the technology
13 it had been purchasing for RealVu, including determining whether an ad
14 space was in or near the viewable area of a user's browser. In the event it
15 was, invoking a real time bidding auction to sell the viewable ad space and
16 then replacing the original ad with the auctioned-off ad. That's what they
17 were copying in secret in the summer of 2020.

18 They were also copying our patent. We indicated -- and the evidence
19 is replete in here. We even ran their patent and our original specification
20 through a plagiarism checker and found many, many passages of our patent,
21 including the diagrams from our patent, that were copied without attribution,
22 which is the definition of plagiarism, into their patent.

23 So when we talk about things like nexus, the fact that they copied and
24 then claimed that their system runs the same way as our patented
25 technology, that's all the nexus you need. And that's what happened when
26 they filed their patent in 2020. Again, undisclosed to us. It's still secret.

1 Then they told us after they had set their whole system up and copied our
2 patent and filed it that they were going to terminate the agreement.

3 What happened after they copied our system? They continued to have
4 commercial success, so you now have evidence of copying commercial
5 success.

6 And then this document. One reason why they're copying of our
7 patent is important is precisely for the point of nexus.

8 They advertised on their website that their solution is covered by their
9 patent. And if their solution is covered by their patent, and their patent
10 copied our patent, that's all you need to show nexus in terms of what they
11 did after they stopped licensing our solution and started copying it.

12 Now, I'll note that that document says that -- that that is the
13 technology that's covered. So if there's any dispute about wanting to review
14 Exhibits 2046 to 2049 that are claim charts that show exactly how their
15 system used our system, all you really need to do is say, well, they copied
16 the patent and then claim that there is a --

17 JUDGE EASTHOM: Did they copy the claims too? Is that what
18 you're saying?

19 MR. BERTEN: The claims are shockingly similar to our claims.

20 JUDGE REPKO: Okay.

21 MR. BERTEN: If you look at -- if you look at their claim -- let's put
22 it this way. I think if we, you know, wanted to go through the time and
23 effort to provoke an interference, we could try and do that. Or one thing we
24 haven't heard is anything that's different about their claims that's not in our
25 claims.

26 JUDGE EASTHOM: Can I ask you a question? Let's shift to column

1 11 and maybe -- this is a quick -- it says in column 11, line 22 -- I keep
2 rereading this sentence. And this is -- gets to the thing about the -- about the
3 documents versus the ads.

4 It says, "Some embodiments may apply time-multiplexing criteria."

5 I'm sorry. I'll wait till you get there.

6 MR. BERTEN: No, no. Go ahead. I'm just --

7 JUDGE EASTHOM: Okay. I'll start over.

8 "Some documents may apply time-multiplexing criteria for a plurality
9 of documents based on the time during which a document is actually
10 viewable on the user screen, for instance, and adds a lot of duration, may be
11 tolled according to viewable time instead of absolute time."

12 Now, is your major contention that that's just a mistake? I mean,
13 they're saying that it's viewable, but it's not really because it's not enabled; is
14 that what you're saying?

15 MR. BERTEN: We're saying -- the document certainly says that it's
16 viewable --

17 JUDGE EASTHOM: Okay.

18 MR. BERTEN: -- but it doesn't explain how that viewability test is
19 accomplished. There's no explanation of it.

20 JUDGE EASTHOM: Okay. And --

21 MR. BERTEN: And that's -- that's -- Dr. Smedley admitted that
22 during --

23 JUDGE EASTHOM: Well, let me ask you this. Because this -- this is
24 another question I have about enablement.

25 Aren't you -- to show lack of enablement, don't we have to go through
26 the Wands factors? Don't we have to have all those things about level of

1 ordinary skill? What would one -- what one would know? And I don't
2 remember all the other factors off the top of my head, but have we done that
3 here? Do you have evidence for that?

4 MR. BERTEN: Well, what we have is that, we have several things
5 that answer that, and it's actually something that we haven't talked a lot
6 about.

7 The Board accepted the level of ordinary skill in the art that was set
8 forth in the petition.

9 JUDGE EASTHOM: Well, the main -- the main question is, is if you
10 have this disclosure, can one of ordinary skill produce the code to do that?

11 MR. BERTEN: And the answer is the petition didn't demonstrate
12 that.

13 JUDGE EASTHOM: Okay.

14 MR. BERTEN: So if you --

15 JUDGE EASTHOM: I think -- I thought it was your burden to show
16 lack of enablement, though.

17 MR. BERTEN: If -- if -- it is our burden to show for a disclosure that
18 it's not enabled, and we believe we've done that. We think we've done it first
19 and foremost through the testimony of their own expert.

20 Their own expert said, "I do not have that opinion, and I cannot form
21 it now that Badros teaches a viewability test."

22 Now, it's a preponderance-of-the-evidence case. It's their expert, and
23 if -- if their own expert is going to take the position in his deposition that he
24 hasn't formed that opinion and he won't do it during the deposition, I don't
25 know what else the patent owner is supposed to show.

26 JUDGE EASTHOM: I don't know how you can say that someone

1 meets their burden because the other party didn't show something. How do
2 you meet your burden on lack of enablement? What if they never even
3 follow an expert dec?

4 MR. BERTEN: If -- so, if they never -- let's say they never filed an
5 expert dec. Well, we have our own expert opinion that says that when he
6 reads Badros, what he's seeing is a reference that's talking primarily about a
7 served impression.

8 And you have to remember at this time that the viewable impression
9 didn't exist. It didn't exist. That, those words --

10 JUDGE EASTHOM: Well, it did exist because this -- oh, I see.
11 You're right. In 2005, when they filed this, right.

12 MR. BERTEN: When they filed it, the viewable impression didn't
13 exist. It wouldn't come into a standard as adopted by the MRC until
14 something like 2010.

15 JUDGE EASTHOM: Okay.

16 MR. BERTEN: So no, the actual standard wasn't adopted until 2013
17 or early 2014. I'm sorry. It was early 2014 when they actually adopted the
18 standard.

19 So at the time -- and this is -- this is one of the things that our expert
20 alluded to because he was actually active in the online advertising space at
21 the time when all this was happening and experienced all the below-the-fold,
22 invisible ads, getting charged for ads that are never viewable, that sort of
23 thing.

24 And he -- it's his opinion that when he reads Badros, it looks like it's
25 talking about counting impressions from the server module on
26 the -- sorry -- it's from the impression module that's on the server and not

1 explaining how you would actually conduct the viewability test.

2 JUDGE EASTHOM: But I don't see how that shows a lack of
3 enablement. He's -- he's not really addressing enablement. He's not saying
4 that, oh, it says -- it says it's viewable, but I don't think anybody would know
5 how to do it to encode the viewability.

6 MR. BERTEN: He does say that. I'll dig it up --

7 JUDGE EASTHOM: Okay. Maybe he does. I was asking --

8 MR. BERTEN: No, he does. He does.

9 JUDGE EASTHOM: Okay.

10 MR. BERTEN: He says -- so does Smedley.

11 JUDGE EASTHOM: Okay.

12 MR. BERTEN: Both of them say that Badros does not disclose how
13 to do it.

14 JUDGE EASTHOM: Okay.

15 MR. BERTEN: Okay. So Smedley says it doesn't have to because
16 there's infinite ways that --

17 JUDGE EASTHOM: Right.

18 MR. BERTEN: -- one in the ordinary skill would know how to do it.
19 He also is unable to identify a single way of doing it himself.

20 JUDGE EASTHOM: Okay.

21 MR. BERTEN: He refused to do that during his deposition, and he
22 didn't do it in his supplemental. We argue improper declaration. But
23 that's -- that's the issue.

24 And Dr. -- Mr. Sherwood says that's not disclosed in Badros.

25 JUDGE EASTHOM: Okay.

26 MR. BERTEN: So I'll try to find it during the rebuttal.

1 JUDGE EASTHOM: I'm sorry to put you through that. I should have
2 noticed that. I didn't see.

3 But I think I remember parts of that. All right. So --

4 JUDGE FITZPATRICK: Mr. Berten, can I ask a question on
5 Krassner? I don't know if this case is going to come out in -- but I want a
6 response.

7 They say the assignments are not -- at the time that the invention was
8 made or allegedly made, pursuant to the vendor zone maintenance, and that
9 you have not shown -- put in any evidence to show that those assignments
10 were executed pursuant to an obligation that exists at the time of the
11 invention.

12 MR. BERTEN: So there's -- there's two responses there. This is on
13 Krassner-1.

14 The first is that if you look at, I believe it's -- well, first, let me back
15 up.

16 The Tchibirev declaration, paragraph 6, expressly states -- it doesn't
17 mention the assignments or anything else. It expressly states -- it's a
18 statement of fact -- that at the time of the invention, the two patents were
19 commonly owned.

20 That's the evidence in the case. And to try and argue, well, the
21 conception date was before the assignment date, just misunderstands what
22 that sentence and that declaration states.

23 It says at the time of the invention, they were commonly owned. It
24 doesn't talk about --

25 JUDGE FITZPATRICK: I -- I'm going to push back on that. You're
26 100 percent correct that paragraph 5 states that, but that's a legal conclusion

1 about state law.

2 It -- it's -- you know, for example, you might be using that to say at
3 the time of the invention, you know, everyone knew that the employer
4 ultimately owned this one. But the record -- it was -- for example, if
5 paragraph 5 is correct, there would be no need for any assignments, right?

6 MR. BERTEN: There would be no what?

7 JUDGE FITZPATRICK: There would be need for any assignments.

8 MR. BERTEN: Well, yes and no. The -- you still need the
9 assignments, ultimately, if you're going to avoid the -- at least a facial
10 problem of every inventor having an undivided interest in the invention. So
11 you're ultimately going to want the assignments. But the assignments are
12 not the critical issue that's established by this declaration.

13 And, you know, that's what the evidence is, and there's no contrary
14 evidence. So there's no -- there's no evidence that -- for example, there was
15 some way that the invention was not commonly owned when -- and that's
16 what he testified to in his declaration and there was nothing in his deposition
17 to contradict that.

18 All of the arguments about things like, well, the conception date was
19 before the assignment date, don't have anything to do with the statement that
20 at the time of the invention, they were commonly owned.

21 So -- and on the assignments themselves, if you look at Exhibit 2016,
22 for example, the one that is signed by this fifth inventor that does pro tunc,
23 the assignment does say, it assigns all continuations. So whether -- and that
24 assignment was assigned back closer to the 2009 time period.

25 And as you know, nobody ever assigns an invention on the day that
26 they can see them. The assignments are always done after the conception

1 reduction, the practice date routinely. And that's why the
2 testimony -- unrebutted testimony of -- we call him Igor, because it's just
3 easier to say -- the unrebutted testimony of Tchibirev is that the invention
4 was commonly known at the time it was made.

5 I see I've eaten into a lot of my rebuttal time.

6 JUDGE EASTHOM: Well, I think you have -- we gave an extra five
7 to them. You've eaten in a minute and a half of your extra five. So you have
8 three and a half left.

9 MR. BERTEN: Okay. Thank you.

10 JUDGE EASTHOM: Thank you.

11 MR. BERTEN: Unless you have questions now.

12 JUDGE EASTHOM: No, we -- we appreciate all of your answers to
13 our various multiple questions.

14 MR. BERTEN: Thank you.

15 JUDGE EASTHOM: Mr. Greenleaf, you have 7 minutes and
16 30 seconds. Thank you.

17 MR. GREENLEAF: Okay. Thank you, Your Honors.

18 So first, I want to answer the question about the -- the nexus claim
19 charts to follow up from the previous discussion, whether the accused
20 product, such as it is, whether it is -- whether it meets every claim limitation.
21 And the answer is no. The claim -- each claim requires a visible area
22 measuring the time the visible area is in display.

23 I don't have it up on the screen, so you can ignore the slide. The -- the
24 visible area, not the advertisement being shown on the screen.

25 So this is a very nuanced position that's an issue that's not in this case.
26 The patent owner has failed to present it, but it is at issue in claim

1 construction and in a related proceeding.

2 What does that mean? Does that mean you're measuring whether the
3 ad is visible or whether the visible area is visible irrespective of whether an
4 advertisement is in it?

5 The claim chart does not address that at all. More importantly, the
6 Patent Owner response doesn't address it.

7 So under IBG and the other case I cited, we shouldn't even be
8 considering claim charts because the patent owner response does not address
9 the issue. And that's what the Board's rules require. That's what the Board's
10 case law and precedent require. But to the extent you even want to consider
11 the claim charts, the visible area limitation is not present in the accused
12 product.

13 So we've talked about -- a lot about time multiplexing, and we can
14 continue to talk about that.

15 But you know, my friend frequently says that the user module is not
16 discussed in the petition. I believe it's slide 6 in the presentation. It presents
17 how the petition does indeed talk about the user module. So that is
18 incorrect.

19 I think Dr. Smedley's testimony is something that came up at the end
20 of the discussion and throughout. I'm going to bring that up about, Patent
21 Owner --

22 JUDGE REPKO: So which modules are performing your
23 determination? We talked about the determination earlier and that number
24 brought up all these different modules, right, the impression modules, the
25 user module, which is some code on the user's computer or the toolbar, that
26 collects information about the user.

1 So under your mapping, your rationale in the petition, which module
2 was forming the determination that's pled in the claim (b)?

3 MR. GREENLEAF: The user module in conjunction with the client
4 side code that is sent to the client -- as in all computer internet architecture
5 works, you have a server, and you have a client. Every website works this
6 way then and now. It's inherent and, you know, if not obvious.

7 And so the user module sends code to the client and then the client
8 talks to user module, as mentioned in the petition on -- as on slide 6. User
9 module talks to the client and determines whether the ad was in view.

10 JUDGE REPKO: The user modules make a determination in
11 conjunction with the client code?

12 MR. GREENLEAF: Yes. Yes. Whether you call that part of -- I
13 mean, this is not -- a person of ordinary skill in the art, as Judge Easthom put
14 it earlier, would understand how to write the code and you could do it in
15 infinite ways, as Dr. Smedley testified.

16 So you know, Badros -- Badros just teaches how to do it in the way
17 that we've described. And there are infinite number of ways based on
18 Badros to accomplish it.

19 JUDGE REPKO: There's an infinite number of ways, I'm just
20 wondering what your mapping is. I just want to nail that down.

21 And we have columns 13 and 14, and they talk a lot about the user
22 module in Badros, what it does.

23 Then we have modules that are on the server itself, right? You have
24 the impressions module, the user module, and all these other modules.

25 So there's some executing on the server, and then there's some code
26 executing on the client. The client, you know -- there's this determination in

1 the claim. Then there's your mapping.

2 So that's -- that's kind of what I want to nail down. The server or the
3 client? Maybe that's another way to put this.

4 I know there's a number of ways you could do it in your -- in your
5 mapping. Is there a specific way that you're relying upon to address that
6 limitation in the claim?

7 MR. GREENLEAF: That's -- it's the way that we described it earlier,
8 which is the Badros and --

9 JUDGE REPKO: We put a claim to the formatting module, right?
10 That's the determining the positions of the composite document. That's the
11 document that's being created and shown to the user, right? So you're
12 formatting the document according to these specifications.

13 MR. GREENLEAF: So -- so I don't -- I can look at the formatting
14 module. I don't think either party has discussed the formatting module in
15 much detail at all. We're talking about the user module, not to --

16 Just to go back to Your Honor's original question: What disclosure
17 are we relying on?

18 It's this disclosure on slide 8, Badros column 13, lines 8 to 27, the user
19 module causes code to be downloaded to the user computer.

20 Whether that code on the user computer -- you call it the "user
21 module" -- I don't think matters much. You could; you couldn't. I think
22 that's different ways of looking at it.

23 But that's the disclosure that shows that Badros teaches making a
24 determination on the client-side.

25 JUDGE REPKO: All right. It seems like there is a little bit of a
26 distinction there. The user module causes the code to be downloaded and

1 executed on the user computer 10.

2 MR. GREENLEAF: Yeah.

3 JUDGE REPKO: So module 40, I believe that's on the server, right?

4 MR. GREENLEAF: Yes.

5 JUDGE REPKO: Module 40 is on the server; 10 is on the client.

6 MR. GREENLEAF: Well, the code that's downloaded to the user
7 computer is from the server.

8 So is the user module taking a portion of it itself and putting it on the
9 client? You could look at it that way. You could say, well, this code is not
10 part of the user module and put it on the client. I mean, you can look at it
11 either way.

12 JUDGE REPKO: Okay. I have no further questions on that. Thank
13 you.

14 MR. GREENLEAF: Okay. All right. To address my friend's points.

15 The MRC advisory in 2012 that there was a problem with having
16 viewability. There was no standard for viewability in 2012. There was no
17 standard in 2005 when Badros was filed. There was no standard in 2009
18 when the '329 patent party application was filed. There was no standard
19 until March 2014, as my friend mentioned. When that standard issued,
20 MRC removed its advisory.

21 So that timeline -- Dr. Mandansky goes through that timeline in great
22 detail. There was no need for viewability until programmatic advertising
23 became important.

24 The industry did shift, not in 2009 based on Rich Media's invention.
25 The industry shifted because they wanted to get more advertising on all
26 different kinds of websites. Instead of everybody advertising on The New

1 York Times, as Dr. Mandansky testified, we can advertise all across the
2 Web, but we need to make sure that when we're advertising on
3 radiocontroledcars.com that people are actually seeing our ads because we
4 don't trust radiocontroledcars.com. We trust the New York Times. We trust
5 Yahoo. We trust Google. We trust all these other websites, but we don't
6 trust what Dr. Mandansky called the "long tail."

7 And when we add that long tail, which is most of the internet, we get
8 a lot more advertising dollars. And that's when viewability became
9 important, and that's what was driving the revenue that -- the minuscule
10 revenue that Rich Media obtained beginning only in 2015.

11 Why did it take six years for this revolution -- allegedly revolutionary
12 invention to make money, when it was filed in 2009 until they -- you know,
13 they don't even report the revenue between 2009 and 2015?

14 JUDGE EASTHOM: Well, can you wrap it up, Counsel? We
15 have -- you're already a minute and a half over.

16 MR. GREENLEAF: Yeah, just a couple more quick points.

17 The geometric viewability test, my friend admitted viewability was
18 known.

19 Geometric viewability, the alleged invention based on both inventors
20 is not claimed.

21 Koepoel, which we did not get a chance to discuss, on slide -- let's see
22 here -- slides 15 and 16. I'm having some technical difficulties. But they
23 talk about Koepoel. And the reply on page 17, talks about Koepoel and how
24 it has a geometric viewability test, that is much more detailed than what the
25 '329 discloses.

26 And then finally, the copying. The -- the -- Duration Media has a

1 patent on a different invention. They cited prior art in the disclosure of
2 viewability.

3 Going back to Koepoel, Koepoel discloses basically the same figure
4 that -- that my friend is saying we copied.

5 So -- so again, there was no copying. You can't copy what was
6 already known in the prior art.

7 And that's the conclusion, if there are no further questions.

8 JUDGE EASTHOM: None for me.

9 Anybody?

10 JUDGE FITZPATRICK: Yeah. Unfortunately, I have a couple
11 questions.

12 JUDGE EASTHOM: Please.

13 JUDGE FITZPATRICK: -- for your opposing counsel, but I am
14 sympathetic to what Mr. Berten characterized as your patent. It is similar.

15 I think claim 1 is pretty similar to your claim, your claim 3 and the
16 patent -- I'm sorry. Start over.

17 Claim 1 of the Batkin patent, which I believe is Exhibit 2005, is pretty
18 similar to claim 3 of the patent that we've been talking about here, the '329
19 patent. There's a few -- I mean, if you look at Batkin, it talks a whole lot
20 about viewability.

21 And in claim 1, they have, I believe, the replacement auction whereas
22 the '329 patent doesn't get around to that until claim 3.

23 Can you tell me what you think the point of novelty is of the patent,
24 the '329 patent and how it's different?

25 MR. GREENLEAF: I cannot, but I'm sure my colleague who
26 prosecuted the application can. If you invite him -- if I can invite him up

1 here.

2 JUDGE FITZPATRICK: Absolutely. But before -- and then, why
3 don't we -- I'm going to ask another question first, just maybe more --

4 Why license what you licensed from RealVu and Patent Owner? Why
5 pay for all that, if it's been around and anyone can encode it? I think your
6 expert said it happened maybe a thousand different ways. Why -- why enter
7 into that licensing?

8 MR. GREENLEAF: Well, it was an attractive price. The price shot
9 up and then it was cheaper to, you know, implement their own unique
10 solution.

11 You know, if you go to McDonald's for a \$2 hamburger and
12 you -- why would you buy the \$2 hamburger and when you -- and it
13 becomes \$5, you say, well, why didn't -- why aren't you buying the \$5
14 hamburger? Well, because I liked the \$2 hamburger better.

15 So instead of, you know, when we jack the price up, then they -- it
16 was cheaper to do it themselves. There was and then --

17 JUDGE FITZPATRICK: I'll just say it seems like Mr. Smedley's
18 testimony doesn't really support that -- you know, that analogy because I
19 think he said, you know, any person of ordinary skill in the art -- one single
20 person of ordinary skill in the art could program this.

21 And I mean, would you have to pay that single person all the money
22 they paid RealVu? I can't imagine that being the case. I can't imagine the
23 license being cheaper than doing what Mr. Smedley said could have
24 happened.

25 MR. GREENLEAF: I don't have the facts, but that those are -- all of
26 the details. But as I understand it, it became at some point cheaper to

1 implement themselves. And, you know, just because a person of ordinary
2 skill in the art can do it without undue experimentation, does not mean that
3 it's cheap.

4 JUDGE FITZPATRICK: Okay. And then, yeah do you want to
5 introduce your co-counsel --

6 MR. GREENLEAF: Yes, but -- but to the -- to the copying, quickly.
7 Mr. Tchibirev, Igor, testified in Exhibit 2010 -- sorry, 1020 at 11 -- lines 14
8 to 12, line 8 and 14 -- on page 14, line 15 to page 16, line 15, that the patent
9 owner, the -- the petitioner could not have copied the source code. There
10 was no copying of source code and, therefore, you know, this was easy to
11 develop, and the idea was known. So again, no nexus.

12 But I'll let my co-counsel talk about the patentable distinction between
13 the back-end patent and the '329, if there are no further questions for me.
14 Thank you.

15 JUDGE FITZPATRICK: Thank you.

16 MR. BOCK: Unfortunately, Your Honor, I don't have a copy of the
17 two patent applications to review side by side. I do know that at the time
18 that the application was filed for -- for my client, I don't believe that this
19 application had yet been filed, the application that issued as this patent.

20 And when we analyzed -- we obviously had discussions with my
21 client about their invention, and they told me what they had come up with.
22 And we drafted an application covering their nuanced invention.

23 They said that they had been working with RMC for some time, and
24 that they had developed some -- some refinements to the technology or
25 improvements to the technology that differed from what RMC was doing at
26 the time.

1 And I drafted an application covering what they told me was new and
2 nuanced, and we filed an application with claims covering that -- that
3 invention.

4 JUDGE FITZPATRICK: Sounds like you just stand by whatever the
5 claims say, but you can't, standing here, tell me what those nuances are,
6 what the distinctions are.

7 MR. BOCK: That's -- that's correct. I don't believe that the RMC
8 patents were cited against the claims. Obviously, if they were, we would
9 have had to modify the claims, but -- you know, because of their priority
10 date. But I don't believe that they were.

11 And like I said, if they -- if they were, obviously, there would have
12 been known similarities and we would have modified our claims to avoid
13 those similarities.

14 But my understanding is that my client's technology actually operates
15 differently. I think one of the things that -- that Mr. Greenleaf mentioned
16 was that in the comparison chart, there is nothing that covers the way that
17 the ads are identified, right? So, for example, like, our -- our ads are
18 identified as opposed to an open slot. And I know that that's a difference
19 between the way the technologies have been implemented.

20 And similarly, viewability can be implemented in many different
21 ways, but you could still determine whether something is in view. You don't
22 necessarily have to do it the same way for -- for each invention.

23 Any further questions?

24 JUDGE FITZPATRICK: I have nothing. No, no. Thank you.

25 MR. BOCK: Thank you.

26 JUDGE FITZPATRICK: And I appreciate it.

1 MR. BOCK: Thank you, Your Honor.

2 JUDGE EASTHOM: Thank you.

3 Petitioner, they went over 10 minutes, so you have 13 minutes and 30
4 seconds.

5 MR. BERTEN: Yeah. Thank you, Your Honor.

6 JUDGE EASTHOM: I mean, Patent Owner, I'm sorry.

7 MR. BERTEN: That's okay. Thank you, Your Honor. I'll just have a
8 couple of brief responses.

9 First, we did -- we were able to check for the enablement discussion.
10 It's in the response on page 41, which references paragraphs 68 to 69 of
11 Smedley's declaration -- I'm sorry, not Smedley -- Sherwood's declaration.
12 And also footnote 3 in that declaration.

13 So the -- the meat of the paragraphs is discussing the impression
14 module, and how the impression module looks like it's trying to operate on
15 the server and wouldn't work and that's what he explains in those
16 paragraphs.

17 And then footnote 3 brings in the user module and how the user
18 module also doesn't explain what is -- code is sent down to the browser to
19 allow the browser to execute any sort of viewability test.

20 So the user module -- the only way to fairly describe that particular
21 discussion in this -- in this case is that it has come up when it became
22 apparent that the impression module couldn't do what Badros was claiming
23 it could do if it resided on the server.

24 So there was some discussion of it. As I said, it's -- I believe it's two
25 lines in the petition that mentioned the user module after discussion of the
26 impression module. And then all the stuff from paragraphs -- from pages 13

1 and 14 gets added in the reply. So in terms of enablement, that's where that
2 is.

3 In terms of where we just sort of ended right now on the copying, I do
4 know the Batkin file fairly well. The only thing that's evidence of record is
5 the actual patent itself. The prosecution history in that patent as it was the
6 first office action allowance against no IDS. No IDS was filed during the
7 Batkin prosecution until after the claims were allowed. Only after the claims
8 were allowed were multiple references along with several hundred other
9 references disclosed in an IDS.

10 Mr. Greenleaf, I believe, may have misspoke when he said that there
11 was a discussion in the prior art of other references in Batkin. There is not.
12 Batkin is presented of a whole cloth as being 100 percent the invention of
13 Duration.

14 I believe that you've just heard Mr. Bock be unable to articulate a
15 difference between what is claimed in Batkin, the Duration patent that was
16 filed in 2020, and what's disclosed in the technology that Duration first
17 licensed and then copied from Rich Media Club.

18 Finally, Mr. Greenleaf ended his presentation again, going back to
19 what could only be described as a classic red herring argument that there
20 wasn't any copying of the source code. That is a reference to the back-end
21 source code. All the code that's HTML source code is available; it's open
22 because that's how HTML works. And we never claimed that there was
23 copying of the source code.

24 If you read Tchibirev's declaration, as I did a few minutes ago, what
25 he claims is copied is every aspect of the way our system operated, which
26 includes a test for viewability for ads that are in or about to enter the

1 viewable area of the browser, an invocation of a real time auction, and then
2 replacement of that viewable ad with an ad that will be in view because you
3 made that determination. That's what was copied.

4 So the admission on their website that their system is covered by their
5 patent, which is a copy of our patent, is really all the evidence you need to
6 do of those secondary indicia, licensing and commercial success and copy
7 and commercial success.

8 There was also some reference to the price going up and the
9 hamburger analogy that you heard Mr. Greenleaf said. There's no evidence
10 of that in the record. The evidence in the record is we got an email saying,
11 we like this deal. We're going to extend. Then the secret copying of our
12 system followed by, we're going to get out of this deal because we've copied
13 your system and your patent.

14 So that -- that is the evidence here and, you know, your -- the correct
15 way of following the Volvo Penta petition, where evidence like this is
16 presented. And I want to say one thing about the secondary considerations.

17 Duration knew before they filed the petition about the licensing and
18 commercial success and the copy and commercial success. They didn't
19 address it in the petition.

20 Smedley says he considered secondary indicia. But if you read his
21 deposition -- and this is in our -- in our papers -- he refused to identify a
22 single objective indicium that he actually considered. Couldn't remember a
23 single thing about it. And it's just one of those other things about his
24 testimony that goes to his credibility. The Board can't trust him; that's the
25 bottom line.

26 So the Board needs to take all of that totality, the evidence of

1 commercial praise, failure by others -- and let me spend one more minute on
2 that on exhibit -- that demonstrates the failure.

3 There was some discussion in the rebuttal about accreditation. That's
4 not what they -- exhibit, I believe, it's 2012, talks about. Maybe 2018. It
5 talks about the unreliability of the test itself.

6 They weren't even going to start to accreditate people except RealVu,
7 because people weren't -- other companies were not able to demonstrate that
8 they had a reliable system to actually determine whether an ad was in view.

9 JUDGE EASTHOM: Let me ask you about that. So you said one of
10 the companies was about 70 percent successful or something; is that right?

11 MR. BERTEN: No. No, what I said was -- and if you read that
12 exhibit, it goes into detail on how the test is actually operated. So there was
13 something like 3 billion separate ads that were monitored. It was 21
14 different ad campaigns, I think, and I might be getting some of this wrong.

15 And there were five different companies who were attempting to
16 demonstrate that they could do viewability reliably in that large-scale,
17 independent, contemporaneous, third-party test, the results of which
18 were -- it's -- it's so unreliable right now, we have to tell people not to try to
19 do this yet until we're able to test more systems and make sure that they do
20 work. And that's what ultimately led to the lifting of that advisory in 2014.

21 And there's one final point, I guess I'd make on Dr. Mandansky. She's
22 come up a lot on behalf of the petitioner. Her declaration is another one of
23 these that only came in the reply.

24 And all I'll say about the dates is her declaration is absolutely 100
25 percent internally inconsistent. She says viewability didn't become a thing
26 until programmatic advertising became a thing sometime in 2014.

1 That's completely inconsistent with all the activity in 2011, when the
2 entire advertising industry was getting together, creating the Making
3 Measurement Make Sense Initiative, and starting to move the industry to the
4 viewable impression in 2011.

5 It's just one of these objective facts that she's just wrong about. And
6 the Board can clearly see that her explanation for viewability is just
7 misinformed. We've -- we've laid that out I believe in the surreply, so I
8 won't dwell on it.

9 And I'll just ask if there's any more questions, I'm happy to answer
10 them, but otherwise...

11 JUDGE EASTHOM: Is it -- is it feasible that the references they
12 cited in Mandansky's declaration about getting this visibility accomplished,
13 supposedly that they -- they just didn't work very well and...

14 MR. BERTEN: Yes, it's impossible that they -- it's possible that they,
15 A, didn't work very well or required things like loading and extension into
16 the browser to make it work. So it wasn't sort of a universal solution like the
17 one that Rich Media claim -- came up with in 2009.

18 JUDGE EASTHOM: Okay. Anybody have any other questions?

19 JUDGE REPKO: No.

20 JUDGE FITZPATRICK: I do not.

21 JUDGE EASTHOM: Well, I just want to say thank you to both
22 parties. This has been very instructive and obviously, you both know the
23 record very well. And you're going to help us -- you helped us to hopefully
24 come to the right conclusion here. So, appreciate that.

25 And with that, we're adjourned. Thank you.

26 (Whereupon the proceedings concluded at 3:37 p.m.)

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