

From: [Director_PTABDecision_Review](#)
To: ["Greenleaf, Kevin R."](#)
Cc: [Alison Richards](#); [David Berten](#); [Ragnar Olson](#); [Bock, Joel N.](#); [Kristina Martin](#); [Franzinger, Michael R.](#)
Subject: RE: IPR2023-00953 // Request for Authorization to File a Reply
Date: Monday, October 28, 2024 9:47:00 PM

Counsel,

Thank you for your email. The Director has determined that no further briefing on Petitioner's pending Director Review request (Paper 73) is necessary at this time. Petitioner's request for authorization to file a five-page reply to Patent Owner's response is therefore denied. See Revised Interim Director Review Process, *available at* <https://www.uspto.gov/patents/ptab/decisions/revised-interim-director-review-process>, Section 5.A.ii.b ("Director Review decisions are generally made based on the existing record, without the need for responsive or *amici curiae* briefing. Responsive or *amici curiae* briefing may only be submitted if requested by the Director.").

Your email and this response will be entered into the record of the proceeding. See *id.* at Section 3.G ("All communications will be entered into the record of the proceeding.").

Thank you.

From: Greenleaf, Kevin R. <kevin.greenleaf@dentons.com>
Sent: Friday, October 18, 2024 9:34 AM
To: Director_PTABDecision_Review <Director_PTABDecision_Review@uspto.gov>
Cc: Alison Richards <arichards@giplg.com>; David Berten <dberten@giplg.com>; Ragnar Olson <rolson@giplg.com>; Bock, Joel N. <joel.bock@dentons.com>; Kristina Martin <kmartin@giplg.com>; Franzinger, Michael R. <michael.franzinger@dentons.com>
Subject: IPR2023-00953 // Request for Authorization to File a Reply

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Honorable Director and Advisory Committee,

Petitioner requests a five-page reply limited to the following new issues raised in Patent Owner's Response (Paper 76) to Petitioner's Request for Director Review (Paper 73):

- Unauthorized amendment of the response (Paper 77)
- Mischaracterization of Badros and Dr. Smedley's testimony
- Secondary indicia

Petitioner believes these reasons provide good cause for a reply, and Petitioner could not have been anticipated that Patent Owner would argue secondary indicia, which is outside the scope of the response authorized by the Director (Paper 75).

IPR2023-00953
Ex. 3101

The parties have met and conferred. Patent Owner opposes the request itself and the requested relief, and states its position as follows:

As to the request, there is no mechanism in the Director Review rules for a party to seek to file additional argument. Patent Owner did not request the ability to file a response because the Director Review website states: “Unless authorized by the Director, no response to the Director Review request is permitted.” Director Review website, Section 3.E. There is no provision for requesting to file anything, let alone to file a Reply. The Director Review website does not mention replies, and Patent Owner is unaware of any being filed in response to whether the Director will conduct a review.

As to the substance of the request, if Petitioner is be afforded an extra five pages of argument—a 33% increase in argument—at a minimum due process and fairness requires that Patent Owner also be given a similar increase. More importantly, the Director Review website states: “Any argument not made within the Request may be deemed waived.” Director Review website, Section 3.E. The Petitioner did not mention secondary considerations in the Request, despite the dictate in *Volvo Penta* and the known presence of the issues in this case. The Director can determine on her own review of the Badros reference and Smedley testimony whether it was mischaracterized. There is no need for additional briefing.

As to the corrected Response, Patent Owner apologizes again for the mistakes in the quote from the FWD. The Director Review website has no provision for filing a corrected Response (or guidance on how to request to file one), but Patent Owner thought the Director should be aware of the mistakes in the quotation.

Best regards,
Kevin Greenleaf
Lead Counsel for Petitioner

Kevin R. Greenleaf

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From: Alison Richards <arichards@giplg.com>

Sent: Thursday, October 17, 2024 12:36 PM

To: Director_PTABDecision_Review@uspto.gov

Cc: David Berten <dberten@giplg.com>; Ragnar Olson <rolson@giplg.com>; Greenleaf, Kevin R. <kevin.greenleaf@dentons.com>; Bock, Joel N. <joel.bock@dentons.com>; Kristina Martin <kmartin@giplg.com>

Subject: Re: Duration Media v. Rich Media Club IPR202300953 - Patent Owner's Response to Petitioner's Request for Director Review

[WARNING: EXTERNAL SENDER]

Dear Director:

The Patent Owner inadvertently made errors quoting the FWD on page 1 of the Response. An amended version with the corrected quote on page 1 is attached. Patent Owner apologizes for the error.

Thank you,
Alison Aubry Richards
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From: Kristina Martin <kmartin@giplg.com>

Sent: Tuesday, October 15, 2024 6:27 PM

To: Director_PTABDecision_Review@uspto.gov <Director_PTABDecision_Review@uspto.gov>

Cc: David Berten <dberten@giplg.com>; Alison Richards <arichards@giplg.com>; Ragnar Olson

<rolson@giplg.com>; Greenleaf, Kevin R. <kevin.greenleaf@dentons.com>; Bock, Joel N. <joel.bock@dentons.com>

Subject: Duration Media v. Rich Media Club IPR202300953 - Patent Owner's Response to Petitioner's Request for Director Review

Dear Honorable Director,

Please see the attached Patent Owner's Response to Petitioner's Request for Director Review that was filed with the PTAB today for case IPR2023-00953.

Thank you,

Kristina Martin

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