

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DURATION MEDIA LLC,
Petitioner,

v.

RICH MEDIA CLUB LLC,
Patent Owner.

IPR2023-00953
Patent 11,443,329 B2

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

Opinion of the Board filed by *Administrative Patent Judge* FITZPATRICK,
joined by *Administrative Patent Judge* EASTHOM.

Additional Views filed by *Administrative Patent Judge* FITZPATRICK.

Opinion Dissenting filed by *Administrative Patent Judge* REPKO.

FITZPATRICK, *Administrative Patent Judge*.

JUDGMENT

Final Written Decision on Remand
Determining All Challenged Claims Unpatentable
35 U.S.C. § 318(a)

I. INTRODUCTION

A. Procedural Background

Petitioner, Duration Media LLC, filed a Petition to institute an *inter partes* review of all claims, namely claims 1–10, of U.S. Patent No. 11,443,329 B2 (“the ’329 patent”) pursuant to 35 U.S.C. § 311(a). Paper 1 (“Pet.”). Patent Owner, Rich Media Club LLC, filed a Waiver of Preliminary Response pursuant to 37 C.F.R. § 42.107(b). Paper 6. We granted the Petition and conducted an *inter partes* review. Paper 9.

During the review, Patent Owner filed a Patent Owner Response to the Petition (Paper 35 (“PO Resp.”)), Petitioner filed a Reply (Paper 50 (“Pet. Reply”)), and Patent Owner filed a Sur-Reply (Paper 56 (“PO Sur-Reply”). Oral hearing was held May 29, 2024. A transcript of that hearing is of record in this case. Paper 70 (“Tr.”).

On August 7, 2024, and over a dissent, we entered a Final Written Decision determining that Petitioner had failed to prove that claims 1–10 of U.S. Patent No. 11,443,329 B2 were unpatentable as challenged. Paper 71 (Board and Parties only); Paper 74 (re-entered and made publicly available (“Previous FWD”)).¹ Dispositive to the Previous FWD was the majority’s view that “Petitioner fails to meet its burden to show . . . that the prior art discloses or renders obvious ‘a determination that the predefined area that is used to display the advertisement has been in view within the visible area of the browser window for a predefined period of time,’ as recited in claim 1.” Majority 29; *but see* Dissent 1 (“I respectfully dissent from the Majority opinion primarily because, in my view, Petitioner shows persuasively that

¹ The Previous FWD contains a majority opinion and a dissenting opinion, which we cite respectively in the following formats, “Majority [page number(s)]” and “Dissent [page number(s)].”

Badros discloses the viewability test, namely, ‘a determination that the predefined area that is used to display the advertisement has been in view within the visible area of the browser window for a predefined period of time.’”).

On August 16, 2024, Petitioner filed a Request for Director Review of the Final Written Decision. Paper 73 (“Req.”). Patent Owner opposed the Request. Paper 77. On December 12, 2024, Director Vidal granted the Request and entered a Director Decision. Paper 78 (“Director Dec.”). The Director Decision states that “Petitioner persuasively shows that Badros discloses the viewability test.” Director Dec. 9. Accordingly, the Director Decision vacated the Previous FWD, and remanded back to us for further proceedings. *Id.* at 13.

We have jurisdiction under 35 U.S.C. § 6 and pursuant to the Director’s Decision. For the reasons discussed below, we determine that Petitioner has met its burden to prove, by a preponderance of the evidence, that claims 1–10 of the ’329 patent are unpatentable.

B. Real Parties in Interest

Each party identifies itself as the sole real party in interest. Pet. 5; Paper 16, 1.²

C. Related Matters

Rich Media Club LLC v. Duration Media LLC, Case No. 2:22-cv-02086 (D. Ariz.) (filed Dec. 9, 2022) involves the ’329 patent. Paper 33, 1.

² Patent Owner “established a related company, RealVu, Inc. (‘RealVu’) [to which it] licensed its patents.” PO Resp. 21. According to Patent Owner, “RealVu was the industry-facing entity used to sell the viewable ad space to advertisers and publishers.” *Id.* at 21–22.

Rich Media Club LLC v. Duration Media LLC, Case No. 2:22-cv-01967 (D. Ariz.) (filed Dec. 9, 2023) involves a related patent that issued during the present *inter partes* review, i.e., U.S. Patent No. 11,741,482. Paper 33, 1.

In addition, there are related applications pending before the Office. Paper 16, 1–2; Paper 33, 1.

D. The '329 Patent

1. '329 Patent Disclosure

The '329 patent is titled “System And Method For Creation, Distribution And Tracking Of Advertising Via Electronic Networks.” Ex. 1001, code (54). The prime exemplary electronic network identified is the Internet. *Id.* at 1:63. The '329 patent explains: “From the advertiser’s perspective, there are two main tasks to accomplish: 1) creation of an effective ad; and 2) effective placement of the ad. From the ad publisher’s perspective there are also two main tasks to accomplish: 1) display of the highest revenue-producing ads; and 2) reducing the amount of work necessary to place, maintain, track and process payments for advertising.” *Id.* at 1:67–2:6.

The '329 patent discloses “creating electronic advertisements using licensed digital content, and distributing such advertisements for display at desired network locations.” *Id.* at 2:45–48. “The digital content is delivered to designated advertising locations on the network and becomes part of an advertising display composed at the time requested by the network user/ad viewer.” *Id.* at 2:55–58.

The '329 patent “provides the ability for both publishers and advertisers to optimize the benefits of creating and distributing advertisements electronically, and manage and track every aspect of the

advertisement creation and distribution process.” *Id.* at 3:6–10. For example, it “provides ad publishers with the ability to automatically accept placement of advertising at their network locations by providing a display space module, or ‘billboard module’ that can be easily embedded at the network location where the ad will be displayed.” *Id.* at 3:11–15.

The ’329 patent describes the use of “correlator code” that “is written to or otherwise embedded on the ad content display page and interacts with the viewer’s browser.” *Id.* at 8:2–6.

The correlator JavaScript code on the ad content display page contains the variables and commands to continuously determine what ad content display page area(s) is/are within, or within a pre-defined distance outside of, the dimensions and scrolling position of the viewer’s browser, including whether the browser window where the content is rendered is open, minimized, or otherwise covered by another browser window or other application opened by a viewer.

Id. at 12:54–62. “The billboard module may also cease rendering or send additional requests to the ad dispatcher server to select a new ad/content to render in the billboard module, say if the billboard was in view for a pre-determined period of time, or has been scrolled outside the viewer’s browser window dimensions.” *Id.* at 12:65–13:3.

2. *The Challenged Claims*

Review was requested and instituted for all of the claims of the ’329 patent, namely claims 1–10. Claims 1 and 6 are independent. Claim 1 is illustrative and reproduced below with emphasis added to the limitation on which the Previous FWD had turned:

1. A method comprising:
 - (a) determining whether a predefined area of an ad content display page that is used to display an advertisement is in view within a visible area of a browser window of a browser

configured to be operated by a remote computing device, wherein the predefined area is a portion of the ad content display page, and wherein the ad content display page includes (i) the predefined area configured to display advertisement content, the predefined area being a portion of the ad content display page, and (ii) page content displayed in other portions of the ad content display page, the page content being separate from the advertisement content; and

(b) in response to *a determination that the predefined area that is used to display the advertisement has been in view within the visible area of the browser window for a predefined period of time*, causing a communication to be sent to one or more dispatcher servers, wherein the one or more dispatcher servers are configured to:

- (i) receive the communication;
- (ii) cause a replacement advertisement to be selected for display on the ad content display page; and
- (iii) cause the replacement advertisement to be served to the remote computing device;

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

Ex. 1001, 68:45–69:4 (emphasis added³).

Claims 2–5 depend from claim 1, and claims 7–10 ultimately depend from claim 6. *Id.* at 1001:68:45–70:33. According to Petitioner, “Claims 6–

³ It should be noted that both parties use various shorthand phrases in reference to the limitation that we emphasize above with italics. For example, both parties sometimes refer to the limitation as a “viewability test.” *See, e.g.*, Pet. 15; PO Reply 6; *see also* Ex. 2045 ¶59 (Mr. Sherwood: “I will refer to this claimed feature as a ‘viewability test’ or ‘viewability determination’.”). Additionally, Petitioner also refers to it as an “‘actually visible’ test.” PO Reply. 7. Finally, some witnesses refer to it as “geometric viewability” or a “geometric approach to viewability.” Ex. 1021, 12:11–13:15 (Mr. Edwards’s testimony on cross-examination); Ex. 1020, 58:4–14 (Dr. Tchibirev’s testimony on cross-examination). The Director’s Decision refers to it as the “viewability test.”

10 are drawn towards a system but are substantively identical to [method] claims 1–5.” Pet. 19 n.2. We agree. Nor has Patent Owner argued to the contrary.

3. Effective Filing Date of the Challenged Claims

The ’329 patent states that its underlying application is a

[c]ontinuation of application No. 12/384,403 [“the parent ’403 application”], filed on Apr. 4, 2009, now Pat. No. 11,004,090, which is a continuation-in-part [(“CIP”)] of application No. 11/803,779 [“the grandparent ’779 application”], filed on May 16, 2007, now Pat. No. 10,380,602, which is a continuation-in-part of application No. 11/643,245, filed on Dec. 21, 2006, now Pat. No. 10,380,597, said application No. 12/384,403 is a continuation-in-part of application No. 12/316,781, filed on Dec. 16, 2008, now abandoned.

Ex. 1001, code (63). Thus, the parent ’403 application is a CIP of the grandparent ’779 application.

Petitioner argues that certain features of the challenged claims, namely “replacement advertisement” and “predefined period of time,” constitute new matter as of the filing of the parent ’403 application that was not present in the grandparent ’779 application. Pet. 14. As a result, Petitioner argues that the challenged claims’ earliest effective filing date is the date on which the parent ’403 application was filed. *Id.* That date is April 4, 2009.⁴ Ex. 1015, code (22). Patent Owner concurs. *See* PO Resp. 2 (“The ’329 Patent issued from a continuation-in-part application that added new matter with a filing date of April 4, 2009.”).⁵

⁴ The Petition erroneously refers to this date as “April 3, 2009.” Pet. 13–14. We presume that is a typographical error.

⁵ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112–29, which was enacted September 16, 2011, made amendments to 35 U.S.C. §§ 102 and 103. AIA § 3(b)–(c). The amendments became effective

E. Asserted Prior Art

Petitioner relies on the following patents and published application.

Name	Patent Document	Exhibit
Krassner	US 10,380,602 B2, filed May 16, 2007, issued Aug. 13, 2019	1002
Badros	US 7,725,502 B1, filed June 15, 2005, issued May 25, 2010	1003
Harkins	US 2008/0221982 A1, filed Mar. 6, 2007, published Sept. 11, 2008	1004

Petitioner asserts that each of these references constitutes prior art under 35 U.S.C. § 102(b). *See* Pet. 11 (“Krassner is prior art under pre-AIA § 102(b)”), 12 (“Badros is prior art under pre-AIA § 102(b). . . . Harkins is prior art under pre-AIA § 102(b).”). As we explained in the Institution Decision, none of these references is prior art under § 102(b) because none was patented or published more than one year prior to April 4, 2009. Paper 9 (“Inst. Dec.”), 10–11. However, we determined that the record at that time, which record lacked a preliminary response, supported that the references were prior art under § 102(e) because they stem from applications that were filed before April 4, 2009, and “by another” as that term is used in

eighteen months later on March 16, 2013, but the amendments do not apply to all applications and patents. Rather, the amendments apply only to applications and patents that contain (or previously contained) either (A) a claim with an effective filing date on or after March 16, 2013, or (B) a specific reference under any of 35 U.S.C. §§ 120, 121, or 365(c) to an application or patent with such a claim. *Id.* at § 3(n); *see also SNIPR Techs. Ltd. v. Rockefeller Univ.*, 72 F.4th 1372, 1376 (Fed. Cir. 2023) (explaining application of the AIA amendments). On the record presented, neither condition (A) nor condition (B) applies here. Accordingly, we apply the pre-AIA versions of 35 U.S.C. §§ 102 and 103. AIA § 3(n)(1); *SNIPR*, 72 F4th at 1376.

the statute. *Id.* at 11–12 (citing *EmeraChem Holdings v. Volkswagen Grp. of Am.*, 859 F.3d 1341, 1345 (Fed. Cir. 2017); *Ex parte DesOrmeaux*, 1992 WL 457519, *2–4 (BPAI 1992)).

During the review, the parties presented additional arguments about the prior art status of Krassner. Also, Patent Owner disputes whether Harkins is analogous art. We address both issues below.

F. Asserted Grounds

Petitioner asserts that claims 1–10 would have been unpatentable on the following grounds:

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

II. ANALYSIS

A. Legal Standards

A claim is unpatentable “if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” 35 U.S.C. § 103(a). “Obviousness is a question of law based on underlying facts.” *MobileMedia Ideas LLC v. Apple Inc.*, 780 F.3d 1159, 1167 (Fed. Cir. 2015). The underlying facts include “(i) the scope and content of the prior art, (ii) the differences between the prior art and the claimed invention, (iii) the level of ordinary skill in the field of the invention, and (iv) any relevant objective considerations of nonobviousness.” *Id.* (citing *Graham v. John Deere of Kan. City*, 383 U.S. 1, 17–18 (1966)). An additional underlying fact is whether there was a reason to combine prior art teachings when so asserted. *Id.*

B. Level of Ordinary Skill in the Art

In determining whether an invention would have been obvious at the time it was made, we consider the level of ordinary skill in the pertinent art at the time of the invention. *Graham*, 383 U.S. at 17. “The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry.” *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718 (Fed. Cir. 1991). The “person having ordinary skill in the art” is a hypothetical construct, from whose vantage point obviousness is assessed. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). “Factors that may be considered in determining level of ordinary skill in the art include: (1) the educational level of the inventor; (2) type of problems encountered in the art; (3) prior art solutions to those problems; (4) rapidity with which innovations are made; (5) sophistication of the technology; and (6) educational level of active workers in the field.” *Daiichi Sankyo Co. v. Apotex, Inc.*, 501 F.3d 1254, 1256 (Fed. Cir. 2007) (citation omitted).

Petitioner proposed that a person having ordinary skill in the art “would have had a bachelor’s degree in computer science, computer engineering or electrical (or similar) engineering with about three years of experience in computer science, computer engineering and electrical engineering.” Pet. 9. For purposes of deciding whether to institute, we adopted Petitioner’s proposed formulation of the level of ordinary skill in the art because it appeared consistent with the ’329 patent and the asserted prior art. Inst. Dec. 10.

Patent Owner argues that Petitioner’s proposed level of ordinary skill “fails to require experience with internet advertising, which is the entire subject of the ’329 patent and the Krassner and Badros references.” PO

Resp. 8; *see also id.* (arguing that the third reference, Harkins, involves advertising, albeit not internet advertising). As Patent Owner's declarant, Robert Sherwood, explains, under Petitioner's proposal, a person of ordinary skill in the art of the '329 patent is "someone with no experience in internet advertising or even computer programming" and includes, "for example, someone whose entire career may have been spent designing integrated circuits, with no knowledge of internet advertising." Ex. 2045 ¶44.

We find Patent Owner's argument persuasive. Indeed, it is unclear how Petitioner's proposal accounts for the types of problems encountered in the art or prior art solutions to those problems. *See Daiichi Sankyo*, 501 F.3d at 1256 (identifying these factors, among others, as "a guide to determining the level of ordinary skill in the art"). Nor does Petitioner, in its Reply, address, let alone rebut, Patent Owner's arguments that a person of ordinary skill in the art would have had some experience and/or knowledge in internet advertising. *See generally* Pet. Reply.

Patent Owner proposes that a "person of ordinary skill in the art would have a bachelor's degree in computer science or a similar major involving computer programming (or at least four years of practical computer programming experience) and at least two years of experience (in or out of college) in the field of internet advertising." PO Resp. 12 (citing Ex. 2045 ¶54). We agree that a person of ordinary skill in the art would have some experience in internet advertising, although we fail to see why one year would not be enough to familiarize sufficiently a computer scientist and/or programmer with the types of problems encountered in the art or prior art solutions to those problems.

Based on the competing proposals, arguments, and evidence before us, we adopt and apply the following level of skill in assessing Petitioner's

challenges to the patentability of the claims of the '329 patent: a person that would have had a bachelor's degree in computer science, computer engineering, or electrical (or similar) engineering with about three years of experience in computer programming with at least one year of said experience being in the field of internet advertising.

C. Claim Construction

The claims should be read in light of the specification, as they would be interpreted by one of ordinary skill in the art. *In re Suitco Surface, Inc.*, 603 F.3d 1255, 1260 (Fed. Cir. 2010). Thus, we generally give claim terms their ordinary and customary meaning. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007) (“The ordinary and customary meaning is the meaning that the term would have to a person of ordinary skill in the art in question.”) (internal quotation marks omitted); *see also* 37 C.F.R. § 42.100(b) (stating that claims are construed in IPRs according to the same standard as used in federal court).

In the Decision to Institute, we construed:

- “render” to mean “loading content so that it may be viewed, heard or otherwise perceived by a viewer communicating electronically using a browser”;
- “replacement advertisement” to mean “a new ad/content rendered in place of a previous ad/content”; and
- the “in response to” limitation of claim 1’s paragraph (b) as limiting, such that the recited “causing a communication” is a required step of the method of claim 1.

Inst. Dec. 7–8. During the review, neither party contested these constructions or proposed any additional constructions. Accordingly, we apply these express constructions in our analysis below.

D. Ground 1 (Krassner, Badros, and Harkins)

Under Ground 1, Petitioner argues that claims 1–10 would have been obvious over Krassner, Badros, and Harkins. Pet. 18–32. Among other things, Patent Owner disputes that Krassner is prior art and that Harkins is analogous art. We provide an overview of the references’ relevant disclosures and address these threshold arguments before our analysis of Petitioner’s challenge to patentability.

1. Krassner (Ex. 1002)

Krassner issued from application 11/803,779, which we describe above as the grandparent ’779 application. Ex. 1002, code (21). Like the ’329 patent, Krassner is assigned to Patent Owner. *Id.* at code (73). Also like the ’329 patent, Krassner discloses “creating electronic advertisements using licensed digital content, and distributing such advertisements for display at desired network locations.” Ex. 1002, 4:49–52; *see* Ex. 1001, 2:45–48 (same statement). In fact, Krassner shares a significant amount of disclosure with the ’329 patent.

As agreed by both parties, however, the ’329 patent includes new matter relative to Krassner. According to Patent Owner:

The new matter added in 2009 related in part to Rich Media Club’s invention of a method to determine if an advertisement on a web page had come within (or was approaching), the viewable portion of a user’s webpage in a browser (sometimes referred to as the “viewport”). The ability for publishers to know, for the first time, whether an ad was actually “in view” would ultimately transform the entire internet advertising ecosystem.

PO Resp. 2. This is consistent with Petitioner’s statement that “Krassner doesn’t disclose ‘a determination that the predefined area that is used to display the advertisement has been in view within the visible area of the browser window for a predefined period of time.’” Pet. 23 (emphasis

omitted) quoting claim 1); *see also id.* at 14–17 (arguing that the claim terms “replacement advertisement” and “predefined period of time” constitute new matter as of April 4, 2009).

a) Whether Krassner is Prior Art Under 35 U.S.C. § 102(b)

We previously determined that Krassner is not prior art under 35 U.S.C. § 102(b) because it did not issue more than one year prior to April 4, 2009; it issued more than ten years later on August 13, 2019. Inst. Dec. 10–11; Ex. 1001, code (45). In a Motion to Submit Supplement Information, Petitioner attempted to obfuscate the distinction between (1) Krassner, a United States patent asserted by the Petition, and (2) US 2007/0265923 A1, a United States patent application publication, which was published November 15, 2007, but which was not asserted by the Petition (“the Krassner publication”). *See* Paper 15, 4 (Petitioner arguing that the Krassner publication contains a “substantively identical disclosure[]” to what is “cited in the Petition” and thus “demonstrates publication over one year before the effective filing date of the ’329 patent”). We denied the Motion. Paper 21. Petitioner then filed a Request for Rehearing of our decision, and we denied the Request. Papers 25 and 26.

Yet, in its Reply, Petitioner again argues that Krassner is § 102(b) prior art because another document, the Krassner publication, which was published more than one year before April 4, 2009, contains the same disclosure. In doing so, Petitioner even cites a document that is not of record, “Ex-1017.” Pet. Reply 26. In an Updated List of Exhibits, Petitioner identifies Exhibit 1017 as the Krassner publication while acknowledging that it is “not filed.” Paper 63.

Petitioner’s resurrected argument is based on a fundamental misunderstanding of § 311(b). Section 311(b) provides: “A petitioner in an

inter partes review may request to cancel as unpatentable 1 or more claims of a patent only on a ground that could be raised under section 102 or 103 and *only on the basis of prior art consisting of patents or printed publication.*” 35 U.S.C. § 311(b) (emphasis added). Petitioner requested to cancel the claims of the ’329 patent on the basis of Badros, Harkins, and Krassner. Pet. 11. Petitioner did not base its request, in whole or in part, on the Krassner publication. *Id.*

Krassner clearly is a patent. It issued on August 13, 2019, far too late to be § 102(b) prior art. Even if we assume Krassner is also a “printed publication” withing the meaning of § 311(b), the same date would apply: August 13, 2019. Petitioner has not presented any evidence that the document that is Krassner was published prior to when it issued on August 13, 2019. That *another* document (the Krassner publication), which published much earlier, may contain the same or similar disclosure is not relevant to when Krassner was patented or published.

In sum, Krassner is not prior art under 35 U.S.C. § 102(b).

b) Whether Krassner is Prior Art Under 35 U.S.C. § 102(e)

Although Krassner is not prior under 35 U.S.C. § 102(b), we previously determined that the record at institution supported that Krassner was prior under § 102(e) because it was filed “by another” before April 4, 2009. Inst. Dec. 11–12; *compare* Ex. 1001, code (72) (listing Igor Tchibirev), *with* Ex. 1002, code (75) (not listing Mr. Tchibirev as an inventor); *see* Ex. 1002, code (22) (identifying May 16, 2007, as the filing date). As we noted, however, “[s]ubject matter” that is prior art under only 35 U.S.C. § 102(e), (f), and/or (g), cannot serve as prior art demonstrating obviousness of a claimed invention “where the subject matter and the claimed invention were, at the time the claimed invention was made, owned

by the same person or subject to an obligation of assignment to the same person.” 35 U.S.C. § 103(c)(1); Inst. Dec. 12–13. We also noted that, to invoke this safe haven, “Patent Owner would bear the burden of production to show (1) the date on which the claimed invention was made and (2) that as of that date, the ’329 patent and Krassner were ‘owned by the same person or subject to an obligation of assignment to the same person.” Inst. Dec. 13 (quoting 35 U.S.C. § 103(c)(1)).

Patent Owner argues that the safe haven of § 103(c) applies based on common ownership. PO Resp. 13–14. More specifically, Patent Owner argues the following:

As demonstrated by the face of the patents, USPTO assignment records, and the Second Declaration of Igor Tchibirev, the Krassner reference and the ’329 Patent were in fact commonly owned by the Patent Owner, Rich Media Club, LLC. *Compare* EX1001 *with* EX1002 (both listing “Rich Media Club, LLC” as the Assignee); *see also* EX2026 (Second Tchibirev Declaration); EX2015–EX2016 (assignment records).

Id.

Petitioner argues that Patent Owner fails to meet its burden because it has not shown that Krassner and the ’329 patent were commonly owned at the time the invention of the ’329 patent was made. Pet. Reply 28.

We agree with Petitioner. Patent Owner’s arguments do not identify when the claimed invention was made, let alone argue common ownership as of that date. PO Resp. 13–14. Nor does the evidence cited by Patent Owner carry its burden. First, Patent Owner cites to the ’329 patent and Krassner to show that they are both assigned to Patent Owner. This does not, and could not, show common ownership at the time the invention was made.

Next, Patent Owner cites to assignment records (Exhibits 2015 and 2016) and to Mr. Tchibirev's testimony, in reference to those assignment records, that "[t]he respective inventors assigned all divisionals, continuations, and continuations-in-part of Application Nos. 11/643,245 and 60/753,536, including Application Nos. 12/384,403, 12/316,781 and 11/803,779 to Rich Media Club, LLC on December 19, 2006 and November 24, 2008." Ex. 2026 ¶4.

Exhibit 2016 is an assignment executed December 19, 2006, by four of the five inventors listed on the '329 patent, excluding Mr. Tchibirev. Ex. 2016. Exhibit 2015 is an assignment executed November 24, 2008, by four of the five inventors listed on the '329 patent, excluding Fred Bernstein. Ex. 2015. Thus, Mr. Tchibirev did not assign his interest in what would become the '329 patent until November 24, 2008. And, as Petitioner argues, with persuasive support in the record, the invention that ultimately would be claimed in the '329 patent was made in early 2008. Pet. Reply. 28 (citing Ex. 1020, 54:14–55:13; Ex. 1021, 8:2–9:16).

Patent Owner does not dispute that the invention was made before November 2008. PO Sur-Reply 24. Nor does Patent Owner argue, let alone provide evidence, that Mr. Tchibirev had, at the time the invention was made, an obligation to assign his rights therein. *Id.*; PO Resp. 13–14. Instead, Patent Owner directs us to Mr. Tchibirev's testimony that "at the time of the invention of the '329 patent, the '329 patent and the Krassner reference were commonly owned." PO Sur-Reply 24 (quoting Ex. 2026 ¶5). This testimony, however, is a legal conclusion, which is not supported by the evidence Mr. Tchibirev discusses. It is not persuasive.

On the record presented, Krassner is prior art under 35 U.S.C. § 102(e).

2. *Badros (Ex. 1003)*

Badros states that “[a]dvertisers and other providers of content on the Internet compete for a user’s attention on a webpage.” Ex. 1003, 1:12–13. Prior to Badros, content providers had “begun providing multiple advertisements at the top of a page (and in other discrete locations) in a time-multiplexed fashion. . . . For instance, a single banner ad on one page may rotate every five seconds between an ad for a razor and an ad for a new soft drink.” *Id.* at 1:31–38. However, these pre-Badros systems would “rotate such time-multiplexed advertisements in a random or otherwise arbitrary order and provide equal time for each ad,” which Badros notes was a “drawback[.]” *Id.* at 1:42–46.

Badros teaches “time-multiplexing the display of a plurality of electronic documents” based on various criteria. Ex. 1003, 1:50–55. For example, a “plurality of selected documents [may be] displayed at an output device in a predetermined sequence.” *Id.* at 1:55–57. “The time-multiplexing criteria may be a variety of criteria related to the selected documents, the source of the selected documents, or other factors such as the selected documents’ relevance to a concept and one or more preferences associated with the selected documents.” *Id.* at 1:57–62.

“The documents may be displayed at a display source such as a monitor or electronic billboard, and the documents may be displayed in connection with the display of another document such as a webpage.” *Id.* at 2:47–51. “For instance, if a user requests a webpage related to water skiing, the system may send the user a webpage related to water skiing that displays a plurality of time-multiplexed water skiing-related ads within a single ad space on the webpage.” *Id.* at 2:59–63.

The Director found “Badros expressly distinguishes viewed impressions from served impressions.” Director Dec. 9 (citing Ex. 1003, 15:4–8, which states: “The number of ‘actual’ (e.g., verified) impressions may be distinguished from the number of times a document was output to client terminal.”). Thus, as discussed above in the Procedural Background, the Director determined “Petitioner persuasively shows that Badros discloses the viewability test.” *Id.*

3. *Harkins (Ex. 1004)*

Harkins discloses “systems and methods for selecting one or more advertisements for placement with one or more advertising agents and/or in one or more advertising mediums,” in which “such placement is based upon the bids placed by one or more advertisers, wherein the bids may be based upon a plurality of criteria associated with the advertising agents and/or advertising mediums.” Ex. 1004 ¶2. The prime exemplary medium is a printed receipt at a point of sale. *Id.* ¶9.

In one aspect of [Harkins], the advertising agents are retail merchants who utilize a common card processing service and the advertisements are text, logos, coupons, or the like printed on the face of a card receipt. In another aspect, the rights to print such card receipt advertisements at particular retail advertising agent locations are auctioned to potential advertisers via an Internet-based auction system.

Id., Abstr.

“Although § 103 does not, by its terms, define the ‘art to which [the] subject matter [sought to be patented] pertains,’ this determination is frequently couched in terms of whether the art is analogous or not, *i.e.*, whether the art is ‘too remote to be treated as prior art.’” *In re Clay*, 966 F.2d 656, 658 (Fed. Cir. 1992) (quoting *In re Sovish*, 769 F.2d 738, 741 (Fed. Cir. 1985)). “Whether a reference in the prior art is ‘analogous’ is a

fact question.” *Clay*, 966 F.2d at 658. “Two criteria have evolved for determining whether prior art is analogous: (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor’s endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved.” *Id.* at 658–59.

Patent Owner argues that Harkins is not analogous art because it “is directed to ad placement on the paper receipt issued to a credit card user at a merchant” and “has nothing to do with advertising on the internet.” PO Resp. 17.

Petitioner responds that, contrary to Patent Owner’s argument, “Harkins teaches that its invention can be used in web pages.” Pet. Reply 18 (citing Ex. 1004 ¶30). Although Petitioner’s citation is off by one paragraph, Petitioner’s response about what Harkins teaches is correct. *See* Ex. 1004 ¶29 (“The present invention may be implemented for provision of virtually any type of advertising (e.g., print, radio, television, Internet, billboard, etc.) via any type of advertising medium (e.g., newspaper, magazine, radio broadcast, Web pages, billboards, etc.) without departing from the scope of the present invention.”).

We find that Harkins is from the same field based on its express statement that it is applicable to “virtually any type of advertising” and “any type of advertising medium,” including “Web pages.” Ex. 1004 ¶29. Further, even if this were insufficient to place Harkins in the same field as the ’329 patent, we find that Harkins is reasonably pertinent to the particular problems with which the ’329 patent inventors were involved.

In sum, we find that Harkins is analogous art to the ’329 patent.

4. *Claim 1*

As discussed above, Krassner and the '329 patent share a significant amount of disclosure, with Krassner issuing from an application in the chain of priority applications identified by the '329 patent. As also discussed above, the '329 patent includes new matter relative to Krassner, which Patent Owner describes as follows:

The new matter added in 2009 related in part to Rich Media Club's invention of a method to determine if an advertisement on a web page had come within (or was approaching), the viewable portion of a user's webpage in a browser (sometimes referred to as the "viewport"). The ability for publishers to know, for the first time, whether an ad was actually "in view" would ultimately transform the entire internet advertising ecosystem.

PO Resp. 2.

In Petitioner's Ground 1 challenge to claim 1, Petitioner essentially relies on Badros for teaching the new matter, which corresponds to the viewability test, and Krassner for teaching everything but the new matter. *See generally* Pet. 18–31; *see also id.* at 23 (“[E]ven though Krassner doesn't disclose ‘a determination that the predefined area that is used to display the advertisement has been in view within the visible area of the browser window for a predefined period of time[,],’ Badros does.” ((emphasis omitted) citing Ex. 1003, 11:22–24, 12:37–40; Ex. 1009 ¶¶67–68)). Also, Petitioner cites Harkins, alternatively to Krassner, as teaching “causing a communication to be sent to one or more dispatcher servers,” as recited in claim 1. *See* Pet. 25 (citing Ex. 1004 ¶76).

Petitioner argues that “[i]t would have been obvious to a POSA to consider Badros' method for time multiplexing the display of a plurality of electronic documents in a predetermined sequence in the methods of Krassner” and “the POSA would have been motivated to take advantage of

Badros’ teaching by modifying Krassner to display multiple advertisements instead of just one.” Pet. 18 (citing Ex. 1002, Abstr.; Ex. 1003, 3:13–17; Ex. 1009 ¶¶48–49, 51, 53–54). Petitioner also argues that “[i]t would have been obvious to a POSA to combine the teachings of Harkins to modify Krassner to incorporate multiple real-time auctions to determine the advertisements to be displayed instead of just one auction” because Harkins discloses that “an auction may be repeated when additional advertisements are needed.” *Id.* at 19 (citing Ex. 1004, Abstr.; Ex. 1009 ¶55).

Patent Owner does not dispute any of Petitioner’s reasons to combine the asserted prior art teachings or Petitioner’s mapping of the prior art to claim 1. Rather, Patent Owner argues only that (1) Krassner is not prior art (PO Resp. 13–14), (2) Badros does not teach the viewability test (*id.* at 14–16), (3) Badros does not enable the viewability test (*id.* at 40–42), and (4) objective indicia show the claim would have been non-obvious (*id.* at 44–57). *See also id.* at 58–62 (Patent Owner summarizing its arguments).

Patent Owner’s argument that Krassner is not prior art is not persuasive; as discussed above, Petitioner has shown that Krassner is prior art under 35 U.S.C. § 102(e).

Patent Owner’s argument that Badros does not teach the viewability test is foreclosed by the Director’s finding to the contrary.

a) Enablement by the Prior Art

In the Director’s Decision, she instructed:

The Board shall issue a new decision addressing the patentability of claims 1–10 of the ’329 patent, including addressing whether the evidence of record shows that Badros’s viewability test is enabled. Consistent with *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1355 (Fed. Cir. 2003), the Board should apply a presumption “that both the claimed and unclaimed disclosures in a prior art patent are enabled,” and place the

burden on Patent Owner to prove that Badros’s viewability test is not enabled. *See Apple Inc. v. Corephotonics, Ltd.*, No. 2020-1438, 2021 WL 2577597, at *4 (Fed. Cir. June 23, 2021) (explaining that “prior art patents and publications enjoy a presumption of enablement, and the patentee/applicant has the burden to prove nonenablement for such prior art”).

Director Dec. 12. We apply that presumption here, and find that Patent Owner fails to rebut it as explained below.⁶

The enablement requirement, like the written description requirement, is set forth in 35 U.S.C. § 112(a). “Whether making and using an invention would have required undue experimentation, and thus whether a disclosure is enabling under 35 U.S.C. § 112, ¶ 1 (1994), is a legal conclusion based upon underlying factual inquiries.” *Johns Hopkins Univ. v. CellPro, Inc.*, 152 F.3d 1342, 1354 (Fed. Cir. 1998); *see also* AIA § 4(c)⁷ (recodifying 35 U.S.C. § 112 ¶1, essentially word for word, at 35 U.S.C. § 112(a)). As summarized in *In re Wands*, 858 F.2d 731 (Fed. Cir. 1988), relevant factors *may* “include (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims.” 858 F.2d at 737. This is not a

⁶ In considering the issue of enablement on remand, the Director specifically instructed us to consider arguments Petitioner made in its Request for Director Review. Director Dec. 12 n.6 (citing Req. 7–10). Because Patent Owner fails to rebut the presumption that Badros enables the viewability test based on the record at the time we entered the Previous FWD, Petitioner prevails even absent consideration of arguments it raised thereafter in its Request for Director Review. Accordingly, we do not consider such arguments.

⁷ Pursuant to the AIA, § 112 ¶1 was recodified, essentially word for word, at § 112(a). AIA § 4(c)(1)(A).

mandatory or exclusive list of facts to be considered. *Id.* For example, factor (8) clearly is inapplicable here.

In its Patent Owner Response, Patent Owner correctly states that “[p]rior art patents and publications ‘enjoy a presumption of enablement, and the patentee/applicant has the burden to prove nonenablement.’” PO Resp. 40 (quoting *Apple Inc. v. Corephotonics, Ltd.*, 861 Fed. Appx. 443, 450 (Fed. Cir. 2021)). However, Patent Owner’s nonenablement arguments are quite limited and do not address the *Wands* factors. *Id.* at 41–42. Further, much of what Patent Owner does argues in terms of a purported lack of enablement is premised on Badros not disclosing a viewability test, which the Director rejected. Director Dec. 9.

First, Patent Owner argues that “both *experts* agree that Badros does not teach *how* to implement a viewability test” and that Petitioner’s Dr. “Smedley goes farther, three times admitting that he has no opinion on whether Badros teaches the element at all, let alone enables it.” PO Resp. 41 (no citation provided, *but see* Ex. 2050, 50:22–52:19).

We do not find Patent Owner’s reliance on Dr. Smedley’s cross-examination testimony persuasive, as the Director found said testimony to be contrary to “the clear disclosure in Badros.” Director Dec. 9. More specifically, the Director held the following:

The Board here was troubled by Dr. Smedley’s testimony on cross-examination. [Majority] 23–26 (citing Ex. 2050, 50:22–52:19). Regardless of Dr. Smedley’s testimony, I agree with the dissent that Patent Owner’s arguments fail to undermine the clear disclosure in Badros.

Director Dec. 9.

As for Patent Owner’s witness, Mr. Sherwood, Patent Owner argues that he “opines that Badros does not enable a viewability test.” PO Resp. 41

(citing Ex. 2045 ¶¶68–69). However, the cited declaration testimony is not persuasive, primarily because it too erroneously is premised on Badros not disclosing a viewability test.

In the first cited paragraph, Mr. Sherwood states the following:

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

Ex. 2045 ¶68.

In paragraph 68, reproduced above, Mr. Sherwood concludes that a person of ordinary skill in the art “would not know how to program the [viewability] test in 2005,” but his conclusion is premised on Badros failing to teach a viewability test. *Id.* Because the Director has found to the contrary, that argument is not persuasive. In fact, the Director expressly identified paragraph 68 of Mr. Sherwood’s declaration as being “contrary to Badros’s clear disclosure.” *See* Director Dec. 9 (“The Board’s finding that Badros does not disclose viewability was based primarily on Mr. Sherwood’s testimony that a person of ordinary skill would have understood Badros’s disclosure as relating to served impressions. [Majority] 21–22

(citing Ex. 2045 ¶¶ 62, 68, 70, 74). I find Mr. Sherwood’s testimony contrary to Badros’s clear disclosure.”).

In the second cited paragraph, Mr. Sherwood states the following:

69. Put differently, in my opinion, Badros does not enable one skilled in the art to program a viewable impression test. Among other shortcomings, Badros suggests that the viewability test can be determined on the server. As I understand it, both RealVu’s and Duration’s solution require code on the client’s computer. [Igor] Tchibirev, for example, is not aware of any viewable impression system that operates without client-side code.³

³ I am aware that another portion of Badros not relied upon in the Petition or Smedley’s declaration, suggests that a different module (the “user module”) may also “determine whether a particular document is currently viewable on a user’s screen.” Ex. 1003, 14:20–21. In my opinion, the Petition did not rely on this language or other language in column 14 because there is also no explanation of how the user module would actually perform this function. It suffers from the same lack of disclosure as the impression module.

Ex. 2045 ¶69 (no citation provided for assertion regarding Mr. Tchibirev⁸).

In paragraph 69, reproduced above, Mr. Sherwood opines that “Badros does not enable one skilled in the art to program a viewable impression test.” Ex. 2045 ¶69. The explicit basis he identifies for that opinion is that “Badros suggests that the viewability test can be determined on the server,” yet it would not have been possible to perform a viewability

⁸ Mr. Tchibirev is a named inventor on the ’329 patent. Ex. 1001, code (72). Mr. Tchibirev executed two declarations that were submitted by Patent Owner in this case. Ex. 2025; Ex. 2026. In discussing what Mr. Tchibirev is allegedly “aware” of, Dr. Sherwood does not cite to any particular statement by Mr. Tchibirev. Ex. 2045 ¶69. Neither of Mr. Tchibirev’s declarations discusses Badros. Ex. 2025; Ex. 2026.

test without some involvement of the client-side (e.g., “user module” per Badros or “remote computing device” per claim 1). *Id.* In other words, according to Mr. Sherwood’s testimony, what Petitioner allegedly cites from Badros would have taught the person of ordinary skill in the art to attempt in vain to perform a viewability test exclusively on the server side, but doing so would have been impossible.

However, Mr. Sherwood ultimately acknowledges, albeit in a footnote, that “another portion of Badros . . . suggests that a different module (the ‘user module’) may also ‘determine whether a particular document is currently viewable on a user’s screen.’” Ex. 2045 ¶69 n.3 (quoting Ex. 1003, 14:20–21). Mr. Sherwood attempts to downplay this teaching by Badros, stating that it was “not relied upon in the Petition or Smedley’s declaration.” *Id.* For two reasons, we are not persuaded by Patent Owner.

First, as a patent, Badros is presumed to enable whatever it discloses. *See Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1355 (Fed. Cir. 2003) (“a presumption arises that both the claimed and unclaimed disclosures in a prior art patent are enabled”). Thus, Petitioner was not obligated to identify how Badros enables the viewability test.

Second, the Petition and Dr. Smedley’s declaration both cite a portion of Badros that explicitly describes involvement of the user module in meeting the viewability test limitation. *See* Pet. 35–36 (“User module may pass information to and receive information from (or about) displays and users, e.g., directly or indirectly through providers.” (quoting Ex. 1003, 12:48–66 (quote appearing at 12:64–66))); Ex. 1009 ¶70 (same).

Next, Patent Owner argues that “[t]he only ‘evidence’ supporting enablement is Smedley’s *ipse dixit* testimony that the mere words ‘actually visible to the user’ in Badros . . . would teach how to do a viewability test

because one skilled in the art would know how to implement the test.” PO Resp. 41; *see also id.* at 42 (similarly arguing that “a reference like Badros . . . that does not disclose how to run a viewability test does would not enable the skilled artisan to practice the test before RMC’s invention in 2009.”). This argument is not persuasive for multiple reasons. First, the burden was on Patent Owner to show nonenablement; thus, Petitioner has no obligation to identify evidence supporting enablement unless Patent Owner rebuts the presumption, which its conclusory arguments do not do. Second, Mr. Sherwood testified that, even though Badros itself does not teach how to do a viewability test, a person of ordinary skill in the art could have made and used the invention.

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

MR. GREENLEAF: Objection, vague.

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

Q. Do you know if it was difficult to do back at the time of the invention?

A. Speaking generally and not to its specific use in advertising, at the time of the invention, the people knew how to tell if something was on the screen.

Ex. 2050, 148:12–22. Mr. Sherwood’s point is legally sound. As the Court of Appeals has explained:

The enablement requirement is often more indulgent than the written description requirement. The specification need not explicitly teach those in the art to make and use the invention; the requirement is satisfied if, given what they already know, the specification teaches those in the art enough that they can make and use the invention without “undue experimentation.”

Amgen, Inc. v. Hoechst Marion Roussel, Inc., 314 F.3d 1313, 1334 (Fed. Cir. 2003).

We have considered Patent Owner’s arguments and determine that Patent Owner has failed to rebut the presumption that Badros enables a viewability test.

b) Objective Indicia/Secondary Considerations of Non-Obviousness

The Supreme Court has held that various factors may “serve to ‘guard against slipping into use of hindsight,’ and to resist the temptation to read into the prior art the teachings of the invention in issue.” *Apple Inc. v. Samsung Elecs. Co.*, 839 F.3d 1034, 1052 (Fed. Cir. 2016) (quoting *Graham*, 383 U.S. at 36)). “These factors are commonly known as secondary considerations or objective indicia of non-obviousness.” *Apple Inc.*, 839 F.3d at 1052. “Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy.” *Graham*, 383 U.S. at 17–18.

However, “to be accorded substantial weight in the obviousness analysis, the evidence of secondary considerations must have a ‘nexus’ to the claims, *i.e.*, there must be ‘a legally and factually sufficient connection’ between the evidence and the patented invention.” *Henny Penny Corp. v. Frymaster LLC*, 938 F.3d 1324, 1332 (Fed. Cir. 2019); *see also Ormco Corp v Align Tech. Inc.*, 463 F.3d 1299, 1311–12 (Fed. Cir. 2006) (“Evidence of commercial success, or other secondary considerations, is only significant if there is a nexus between the claimed invention and the commercial success.”). If the objective indicia evidence is derived from a feature or limitation known in the prior art, the evidence is not probative of non-obviousness. *See Ormco*, 463 F.3d at 1312 (“[I]f the feature that creates the commercial success was known in the prior art, the success is not

pertinent.”); *J.T. Eaton & Co. v. Atl. Paste & Glue Co.*, 106 F.3d 1563, 1571 (Fed. Cir. 1997) (“Eaton cannot demonstrate commercial success, for purposes of countering the challenge of obviousness, unless it can show that the commercial success of the product results from the claimed invention. Furthermore, the asserted commercial success of the product must be due to the merits of the claimed invention beyond what was readily available in the prior art.”).

Patent Owner argues that numerous objective indicia demonstrate that the claims would have been nonobvious. PO Resp. 49–53 (arguing “***Long Felt Need, Failure by Others, Skepticism, and Commercial Praise***”), 53–57 (arguing “***Commercial Success, Licensing, and Copying***”). In an attempt to establish nexus, Patent Owner argues that its objective indicia evidence stems from the very feature that the Director found to already exist in the prior art, i.e., the viewability test. *See, e.g.*, PO Resp. 50 (“[T]he industry documentation of the need to replace the ‘served impression’ with the ‘viewable impression’ is quintessential ‘long felt need.’”), 51–52 (“David Cohen’s ***skepticism and surprise*** upon seeing RealVu[’s] operational viewability test is additional evidence that weighs significantly in favor of a finding of non-obviousness. He would not have expressed those opinions if Badros/Google has actually presented a viewability test solution in 2005 instead of RealVu doing it in 2009.”), 52 (“[T]he industry recognition of RMC/RealVu’s contribution includes other examples of ***commercial praise***, including George Ivie’s recognition that ‘***RealVu essentially invented viewability***’.” (quoting Ex. 2035)). Under established case law, such evidence is not probative of non-obviousness. *See Ormco*, 463 F.3d at 1312; *Eaton*, 106 F.3d at 1571.

c) Conclusion as to Claim 1

Petitioner has shown by a preponderance of the evidence that claim 1 would have been obvious over Krassner, Badros, and Harkins.

5. Claims 9–10

a) Claim 2

Claim 2 depends from claim 1 and recites “wherein the replacement advertisement is selected at least partially as a result of a replacement auction.” Ex. 1001, 69:5–7. Petitioner argues that Badros teaches this limitation. Pet. 29 (citing Ex. 1003, 22:12–15, 26:2–5, 18:40–42). For example, Badros states that “a new plurality of ads will be passed for display after documents 1*a*–1*c* have been displayed” and “[t]he plurality of advertisements may be selected based on an auction process.” Ex. 1003, 22:12–13, 18:40–42. Petitioner also argues that Harkins independently teaches this limitation, quoting its disclosure that “a new auction for advertising in the run period after the run period of the previously ended auction may be initiated.” Ex. 1004 ¶76.

Patent Owner does not dispute Petitioner’s citations to these teachings or their application to claim 2. Nor does Patent Owner present any additional arguments as to claim 2.

Petitioner has shown by a preponderance of the evidence that claim 2 would have been obvious over Krassner, Badros, and Harkins.

b) Claim 3

Claim 3 depends from claim 2 and recites “wherein the replacement auction is conducted in real time between the time the second communication is sent from the remote computing device and the time that the replacement advertisement is selected.” Ex. 1001, 69:8–12. Petitioner argues that Krassner teaches this limitation. Pet. 30 (citing Ex. 1002, 5:56–

60). Indeed, Krassner states that “[t]he system selects the advertisement to display in a designated ad space by conducting a real-time auction based at least in part on the bids placed by the advertisers for display of their ad at the location.” Ex. 1002, 5:56–60. Patent Owner does not dispute Petitioner’s citations to these teachings or their application to claim 3. Nor does Patent Owner present any additional arguments as to claim 3 under Ground 1.

Petitioner has shown by a preponderance of the evidence that claim 3 would have been obvious over Krassner, Badros, and Harkins.

c) Claim 4

Claim 4 depends from claim 1 and recites “wherein the determination that the predefined area that currently displays the advertisement has been in view within the viewable area of the browser window for a predefined period of time *occurs periodically*.” Ex. 1001, 69:13–16 (emphasis added). Petitioner argues that Krassner in view of Badros discloses this limitation “because both references disclose displaying ads, and Badros discloses periodically checking whether an advertisement has been displayed for the ‘tolled’ amount of time, *i.e.*, ‘*periodically*.’” Pet. 30–31 (citing Ex. 1002, 7:25–27; Ex. 1003, 11:23–26). Patent Owner does not dispute Petitioner’s citations to these teachings or their application to claim 4. Nor does Patent Owner present any additional arguments as to claim 4.

Petitioner has shown by a preponderance of the evidence that claim 4 would have been obvious over Krassner, Badros, and Harkins.

d) Claim 5

Claim 5 depends from claim 1 and recites “wherein the predefined area of the ad content display page currently displays an advertisement, and wherein the replacement advertisement replaces the currently displayed

advertisement.” Ex. 1001, 69:17–20. Petitioner argues that Krassner teaches this limitation because it describes selecting advertisements to be displayed in a designated ad space by conducting a real-time auction, and the selected advertisements may replace previously selected and displayed advertisements. Pet. 31 (citing Ex. 1002, 5:56–60). Petitioner also argues that Badros independently teaches this limitation because it describes, for example, that “three different ads may be cycled clockwise between three different ad locations” and, “[a]fter each ad has appeared at each location once, a new set of three ads may be rotated through the various locations.” Pet. 31 (quoting Ex. 1003, 10:66–11:2). Patent Owner does not dispute Petitioner’s citations to these teachings or their application to claim 5. Nor does Patent Owner present any additional arguments as to claim 5.

Petitioner has shown by a preponderance of the evidence that claim 1 would have been obvious over Krassner, Badros, and Harkins.

e) Claims 6–10

According to Petitioner, and not disputed by Patent Owner, “[c]laims 6–10 are drawn towards a system but are substantively identical to [method] claims 1–5.” Pet. 19 n.2. We agree. *Compare* Ex. 1001, 68:45–69:20, *with id.* at 69:21–70:32. Patent Owner does not present any arguments regarding claims 6–10.

Thus, for essentially the same reasons as with claims 1–5, Petitioner has shown by a preponderance of the evidence that claims 6–10 would have been obvious over Krassner, Badros, and Harkins.

E. Ground 2 (Badros and Harkins)

In Ground 2, Petitioner relies on Badros and Harkins without Krassner. Pet. 31. Because Petitioner shows that all of the challenged

claims are unpatentable under Ground 1, we need not reach Ground 2. *See SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1359 (2018) (holding that a petitioner “is entitled to a final written decision addressing all of the claims it has challenged”); *Boston Sci. Scimed, Inc. v. Cook Grp. Inc.*, 809 F. App'x 984, 990 (Fed. Cir. 2020) (nonprecedential) (stating that the “Board need not address issues that are not necessary to the resolution of the proceeding,” such as “alternative arguments with respect to claims [the Board] found unpatentable on other grounds”).

F. Patent Owner’s Motion to Exclude

Patent Owner filed a Motion to Exclude, in part or in whole, Exhibits 1020–1022, 1025–1030, and 1034–1040, which were submitted with Petitioner’s Reply. Paper 60. The Motion to Exclude also seeks to exclude “Exhibits” 1017 and 1018, which are not filed or of record in this case but which are referenced in the Reply. *Id.* For example, Exhibit 1017 is the Krassner publication, which Petitioner unsuccessfully moved to add to the record as supplemental information. *See* Paper 21, 3 n.1 (expunging the Krassner publication and stating that it “need not -- and indeed may not -- be re-filed under a new exhibit number”). Because we do not rely on any of the exhibits that are the target of Patent Owner’s Motion to Exclude, we dismiss the Motion as moot. *Boston Sci. Scimed*, 809 F. App'x at 990.

III. CONCLUSION

A preponderance of the evidence fails to show that claims 1–10 are unpatentable. In summary:

Claim(s)	35 U.S.C. §	Reference(s)/Basis	Claim(s) Shown Unpatentable	Claim(s) Not Shown Unpatentable
1–10	103	Krassner, Badros, Harkins	1–10	
1–10	103	Badros, Harkins		
Overall Outcome			1–10	

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that claims 1–10 of U.S. Patent No. 11,443,329 B2 are unpatentable;

FURTHER ORDERED that Patent Owner’s Motion To Exclude is dismissed as moot; and

FURTHER ORDERED that, because this Decision is final, a party to the proceeding seeking judicial review of the Decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.⁹

⁹ Should Patent Owner wish to pursue amendment of the challenged claims in a reissue or reexamination proceeding subsequent to the issuance of this decision, we draw Patent Owner’s attention to the April 2019 *Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding*. See 84 Fed. Reg. 16,654 (Apr. 22, 2019). If Patent Owner chooses to file a reissue application or a request for reexamination of the challenged patent, we remind Patent Owner of its continuing obligation to notify the Board of any such related matters in updated mandatory notices. See 37 C.F.R. § 42.8(a)(3), (b)(2).

IPR2023-00953
Patent 11,443,329 B2

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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

FITZPATRICK, *Administrative Patent Judge*, Additional Views.

“Established in 2011, inter partes review is an adversarial process by which members of the PTAB reconsider whether existing patents satisfy the novelty and nonobviousness requirements for inventions.” *United States v. Arthrex, Inc.*, 594 U.S. 1, 8 (2021); *see also SAS Inst., Inc. v. Iancu*, 584 U.S. 357, 359 (2018) (Inter partes review “allows private parties to challenge previously issued patent claims in an adversarial process before the Patent Office that mimics civil litigation.”). A significant part of the adversarial process is the cross-examination of witnesses providing direct testimony. *See, e.g., Daubert v. Merrell Dow Pharms., Inc.*, 509 U.S. 579, 596 (1993) (championing the “the capabilities . . . of the adversary system generally” and naming, among them, “[v]igorous cross-examination”); *Briscoe v. LaHue*, 460 U.S. 325, 333–34 (1983) (“[T]he truth-finding process is better served if the witness’s testimony is submitted to ‘the crucible of the judicial process so that the factfinder may consider it, after cross-examination, together with the other evidence in the case to determine where the truth lies.’” (quoting *Imbler v. Pachtman*, 424 U.S. 409, 440 (1976) (White, J., concurring in the judgment))). In my view, the Director’s Decision to vacate the Previous FWD, notwithstanding the cross-examination of Dr. Smedley, upends the adversarial process here and puts Patent Owner in an impossible position.

In the Previous FWD, the Board entered judgment for Patent Owner because, in the view of the majority, Petitioner failed to meet its burden to show, by a preponderance of the evidence, that the prior art discloses or renders obvious “a determination that the predefined area that is used to display the advertisement has been in view within the visible area of the browser window for a predefined period of time,” i.e., claim 1’s so-called viewability test. Majority at 29 (citing 35 U.S.C. § 316(e)). Critical to the

decision was the disputed meaning of the following statements from Badros, which were cited on page 23 of the Petition as purportedly satisfying the claim's viewability test:

- “Some embodiments may apply time-multiplexing criteria for a plurality of documents based on the time during which a document is *actually viewable* on the user's screen.” Ex. 1003, 11:22–24 (emphasis added); and
- “For instance, impression module 38 may determine whether a document (e.g., a document containing a link) is actually visible to a user, *and it may track the time duration during which the document is actually visible to the user.*” *Id.* at 12:36–40 (emphasis added).

See Majority 20 (reproducing the same Badros statements); *see also* Pet. 23. Because the meaning of Badros's statements was disputed, we considered the testimony of each party's declarant, Dr. Smedley for Petitioner and Mr. Sherwood for Patent Owner. *See* Majority 20–30.

Notably, Petitioner's witness Dr. Smedley testified incredibly and inconsistently.

In his first declaration, Dr. Smedley testified that he had reviewed, among other things, Badros and the Petition. Ex. 1009 ¶4. Indeed, Dr. Smedley quoted and testified about the very same statements by Badros on which Petitioner's argument was based. *See* Ex. 1009 ¶70 (quoting Ex. 1003, 11:22–24, 12:36–37, 12:38–39). Further, he testified that “all the elements of the challenged claims are unpatentable” and “the references support Grounds 1 and 2 as set forth in the Petition for *Inter Partes* Review.” *Id.* at ¶62.

Then, during his cross-examination, Dr. Smedley repeatedly testified that *he did not know* whether Badros teaches the “viewability test” of claim 1.

Q. That’s exactly my question. Is it your testimony that you do not know whether Badros teaches to make a determination that the predefined area that is used to display the advertisement has been in view within the visible area of the browser window for a predefined period of time?

A. That’s not something that I have given an opinion on.

Q. My question is, as you sit here today, is it your opinion that Badros teaches that or not?

A. That’s not something I’ve given an opinion on here, and I can’t formulate that sort of opinion as we sit here. I’d have to – it’s something I haven’t done, so I’d have to sit down and analyze what he’s proposed carefully and it would take longer than we have to sit here today.

Q. I want to know whether Badros teaches, in your opinion, to make a determination that the predefined area that is used to display the advertisement has been in view within the visible area of the browser window for a predefined period of time?

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

Q. How long is it going to take you?

A. I don’t know.

Q. Well, I actually need an answer to that question because I need to know whether Badros teaches that or not because if it doesn’t teach it, I don’t see how Badros can invalidate, how your opinion can support the petition.

MR. GREENLEAF: Objection, asked and answered.

A. Is there a question there?

Q. The question is, you do not have an opinion about whether Badros teaches to make a determination that the predefined area that is used to display the advertisement has been in view within

the visible area of the browser window for a predefined period of time?

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

Ex. 2050, 50:22–52:19; *see also id.* at 42:20–50:21 (counsel for Patent Owner repeatedly rephrasing essentially the same question (i.e., Does Badros teach the viewability test?) with Dr. Smedley repeatedly unable to answer the question).

Finally, Petitioner submitted a second declaration by Dr. Smedley with its Reply. Ex. 1027. In his second declaration, Dr. Smedley testifies that “Badros discloses Patent Owner’s ‘viewability test.’” *Id.* ¶11.

The Director’s Decision excuses Dr. Smedley’s shifting testimony, stating:

Moreover, as Patent Owner acknowledges, in his first declaration, Dr. Smedley “expressly offered opinions about Badros (and only Badros) as supposedly teaching the determination limitation.” [Paper 77,] 12. And although he denied at cross-examination having formed such an opinion, the testimony he offers in his second declaration is no different than that in his first one. *See* Ex. 1027 ¶ 11 (citing Ex. 1009 ¶ 70, and quoting some of the same portions of Badros).

Director Dec. 11.

Thus, Dr. Smedley effectively thwarted any substantive cross-examination of his opinion that Badros discloses the viewability test. He did so by denying during his deposition that he had such an opinion and then subsequently submitting a reply declaration stating that he did. This is unfair to Patent Owner. *Cf. Sinskey v. Pharmacia Ophthalmics, Inc.*, 982 F.2d 494, 498 (Fed. Cir. 1992), *overruled on other grounds by Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55 (1998) (“Where, as here, a party has been examined extensively at deposition and then seeks to create an issue of fact through a

later, inconsistent declaration, he has the duty to provide a satisfactory explanation for the discrepancy at the time the declaration is filed. To allow him to preclude summary judgment simply by contradicting his own prior statements would seriously impair the utility of Federal Rule of Civil Procedure 56. The trial court properly disregarded the declaration in assessing the existence of a genuine issue of fact.”); *Grand Acadian, Inc. v. United States*, 87 Fed. Cl. 193, 206 (2009) (“If a party who has been examined at length on deposition could raise an issue of fact simply by submitting an affidavit contradicting his own prior testimony, this would greatly diminish the utility of summary judgment as a procedure for screening out sham issues of fact.” (quoting *Perma Research & Dev. Co. v. Singer Co.*, 410 F.2d 572, 578 (2d Cir. 1969))).

In contrast to Dr. Smedley, Patent Owner’s witness Mr. Sherwood testified credibly and consistently that “the discussion of viewability in Badros would be interpreted by a [person of ordinary skill in the art] as either referring to a served impression in general or an ‘above the fold’ ‘good’ ‘high probability’ impression with a higher likelihood of falling within the viewable portion of a webpage.” Ex. 2045 ¶74 (cited at PO Resp. 14–15). The Director finds Mr. Sherwood’s testimony “improper” because it “effectively rewrite[s] Badros’s express teachings.” Director Dec. 9. But his testimony does no such thing. Mr. Sherwood acknowledges what Badros states and provides his opinion regarding how it would have been understood by a person of ordinary skill in the art at the time of the claimed invention. *See* Ex. 2045 ¶74; *see also id.* ¶¶71–73 (identifying and explaining reasons for his opinion). This is a proper use of declaration testimony. *See Acoustic Tech., Inc. v. Itron Networked Sols., Inc.*, 949 F.3d 1366, 1373 (Fed. Cir. 2020) (“Expert testimony may shed light on what a

skilled artisan would reasonably understand or infer from a prior art reference.”); *Monsanto Tech. LLC v. E.I. DuPont de Nemours & Co.*, 878 F.3d 1336, 1345 (Fed. Cir. 2018) (“Extrinsic evidence ‘may be used to interpret the allegedly anticipating reference and [to] shed light on what it would have meant to [a PHOSITA].’” (quoting *Ciba–Geigy Corp. v. Alza Corp.*, 1995 WL 598380, at *2 (Fed. Cir. 1995))).

The Director assigns “no weight” to Mr. Sherwood’s declaration testimony regarding the meaning of the disputed Badros statements yet excuses Dr. Smedley’s inability on cross-examination to defend his own contrary position regarding the same statements. Director Dec. 9. In my view, this puts Patent Owner in an impossible position.

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

REPKO, *Administrative Patent Judge*, dissenting.

I respectfully dissent because I disagree that Petitioner has shown that all challenged claims are unpatentable.

I. CLAIMS 1 AND 6

Petitioner challenges claims 1–10. Paper 1 (“Pet.”), 18–31 (“Ground I”), 31–43 (“Ground II”). Claims 1 and 6 are independent. Ex. 1001, 68:45, 69:21.

Claim 1 recites a method. *Id.* at 68:45–69:4. Claim 6 recites a system with functions that are similar—but not identical—to those recited in claim 1. *Id.* at 69:21–70:18. For example, step (b) of claim 1 recites, in part,

in response to a determination that the predefined area that is used to display the advertisement has been in view within the visible area of the browser window for a predefined period of time, causing a communication *to be sent to one or more dispatcher servers*.

Id. at 68:59–64 (emphasis added). Claim 6 recites a similar limitation as part of a system,

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

Id. at 70:7–11 (emphasis added) (“limitation (b)(ii)”). The emphasized text illustrates the difference between the two limitations: claim 1 recites where the communication is sent to (“one or more dispatcher servers”), and claim 6 recites where the communication is sent from (“the remote computing device”).

Both claims recite that the communication is sent in response to *the viewability test*: “a determination that the predefined area that is used to display the advertisement has been in view within the visible area of the

browser window for a predefined period of time.” *See, e.g.*, Paper 35 (“PO Resp.”), 3.

II. DIRECTOR REVIEW

Upon review of the Board’s decision that Petitioner failed to show that claims 1–10 were unpatentable (Paper 74 (“Dec.”)), the Director found that “Badros plainly discloses tracking whether an advertisement is *actually* visible to the user.” Paper 78 (“Director Dec.”), 10 (citing Ex. 1003, 11:22–24; 12:37–40). The Director cited the paragraph describing Badros’s impression module 38 on server 2. *Id.* (citing Ex. 1003, 12:37–40). The Director instructed the Board to “consider all remaining necessary issues, and determine whether Petitioner has shown, by a preponderance of the evidence, that claims 1–10 of the ’329 patent would have been obvious.” *Id.* at 13.

I have reviewed the arguments and evidence in light of the Director’s Decision. I conclude that (1) one of ordinary skill in the art would not have combined Badros’s internet-advertising system with Harkins’s print-advertising system to arrive at step (b) in claim 1 and limitation (b)(ii) in claim 6, and (2) Petitioner’s alternative obvious-to-try rationale lacks sufficient reasoning and support.

III. THE PETITION

A. Badros’s Server

In Ground I, Petitioner argues that combining Krassner and Badros would have produced a server that causes a communication to a dispatch server:

Accordingly, combining Krassner with Badros would have yielded the predictable result of a server that “in response to a determination that the predefined area that is used to display the advertisement has been

in view within the visible area of the browser window for a predefined period of time, causing a communication to be sent to one or more dispatcher servers . . .”

Pet. 26 (quoting Ex. 1001, 68:59–64) (italics removed, underlining added).

Petitioner makes a similar argument in Ground II, relying on the same teachings but without expressly stating that the server is the result of the combination. *See id.* at 36, 38.

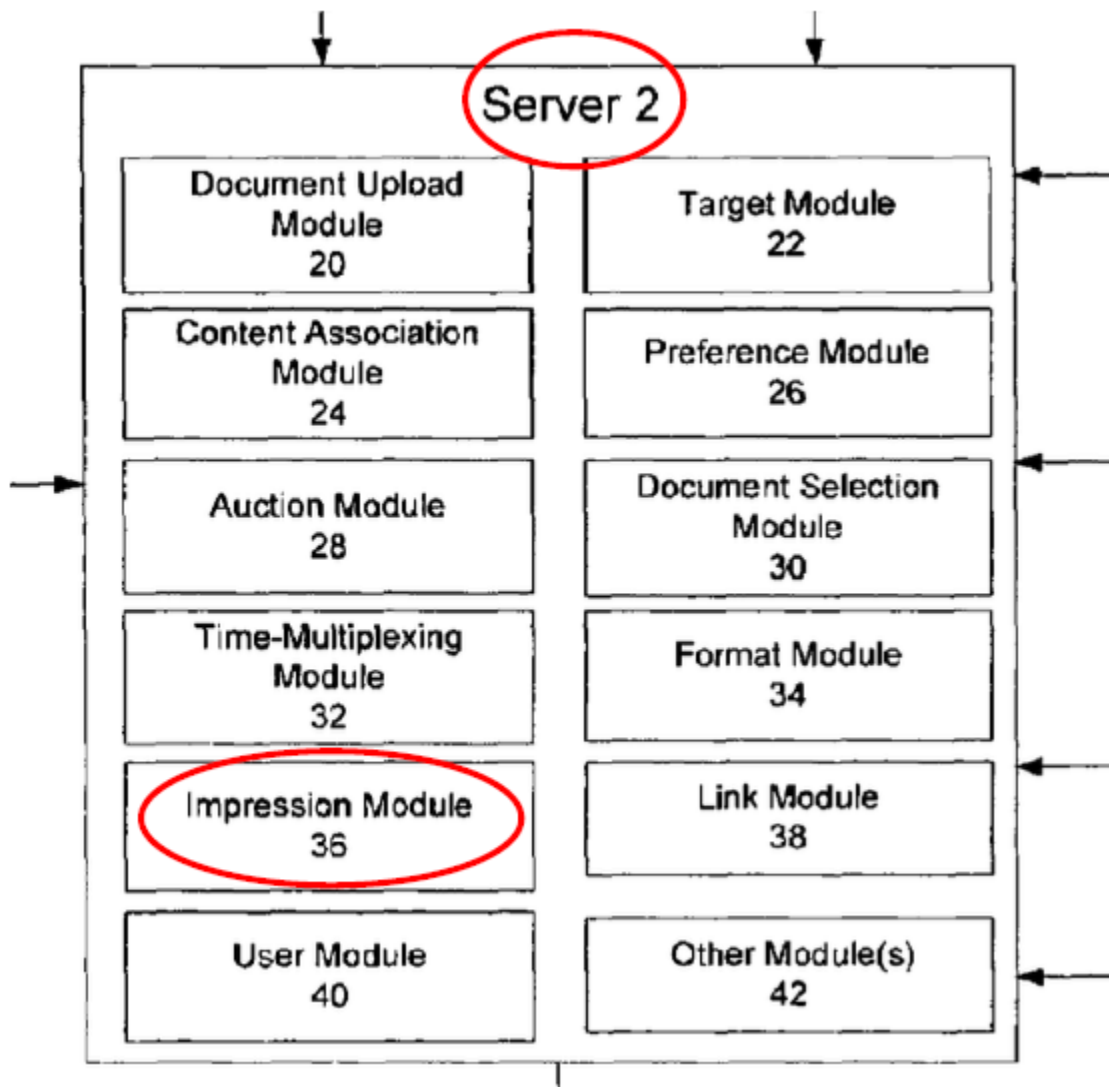
To address the recited viewability test in step (b) of claim 1, Petitioner cites Badros’s impression module 38 on server 2. *Id.* at 23 (citing Ex. 1003, 11:22–24; 12:37–40). One of the quoted sentences is from a paragraph explaining that impression module 38 determines whether the document is visible:

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

Ex. 1003, 12:34–47 (emphasis added). In the quoted passage above, I emphasize the part cited by Petitioner. *See* Pet. 23 (Ground I). The other sentence quoted in the Petition simply restates that Badros tracks the time that a document is actually visible to the user. *See* Ex. 1003, 11:22–24, *cited in* Pet. 23. Petitioner reproduces the same paragraph in Ground II but omits reference number 38 from the impression module. *See* Pet. 35–36. That is,

Petitioner's statement about creating a server by combining Krassner and Badros (*id.* at 26) is corroborated by the Petition's reliance on Badros's impression module 38 (*id.* at 23, 35–36) on server 2 (*see, e.g.*, Ex. 1003, 6:25–33, Fig. 1).

Indeed, Patent Owner relied on the Petition's server-side rationale in the Response to the Petition and in questioning Dr. Smedley. For example, Patent Owner argues that Badros does not explain how server 2 performs the viewability test. *See, e.g.*, PO Resp. 19–20. Patent Owner reproduces Badros's Figure 1, below, to illustrate its point. *Id.* at 20.



The figure above shows red circles over “Server 2” and “Impression Module 36”¹ added by Patent Owner. *Id.* Patent Owner notes that the impression module is shown inside the server. *Id.* Patent Owner also repeatedly questioned Dr. Smedley about a server-side viewability test and servers generally. *See, e.g.*, Ex. 2050, 134:1–6, 136:18–137:11, 141:4–10, 141:23–142:4, 143:11–23.

In concluding that Badros discloses the viewability test, the Director cited the same parts of Badros that Petitioner relied upon: the description of the impression module. *Compare* Director Dec. 10 (citing Ex. 1003, 12:37–40), *with* Pet. 23, 35–36.² The Director also acknowledged Patent Owner’s argument that “the module running the viewability test resides on a server.” Director Dec. 10 (citing DR Resp. 6–9).

In sum, the Petition indicates that basis for the challenge is a viewability test by the server (*see* Pet. 23, 26, 35–36, 38), Patent Owner understood the challenge to be based on the server’s operation (*see, e.g.*, PO Resp. 19–20), and the Director’s Decision cited and discussed the paragraph describing the server’s impression module (Director Dec. 10).

B. Badros’s Time-Multiplexed Display

To address step (b) in claim 1 and limitation (b)(ii) in claim 6, Petitioner relies on Badros’s displaying advertisements on a “time-multiplexed basis” controlled by the server’s viewability test. Pet. 18, 26, 32, 36 (citing Ex. 1003, 5:13–21); *see also* Paper 70 (“Tr.”), 11:24–14:22. A time-multiplexed basis includes displaying the documents with varying

¹ Patent Owner explains that Badros inconsistently numbers the link and impression modules as 38 or 36. PO Resp. 20 n.2.

² The Director’s Decision also cited column 11, lines 22–24, which refers to “some embodiments” generally. Director Dec. 10.

durations. *See, e.g.*, Ex. 1003, 6:20–24. Those durations can be determined using the time that the advertisement is actually viewable. *See id.* at 11:22–24, 12:37:40, *cited in* Pet. 23, 35. During oral argument, Petitioner argued that Badros’s time-multiplexed display scheme determines how long to display an advertisement using both a timer and a viewability determination. *See* Tr. 13:20–22 (“[T]he determination is both.”); *see also id.* at 19:21–22:13 (discussing the viewability test and time-multiplexing).

Thus, under Petitioner’s proposed combination, Badros teaches using the server-side viewability test to control the time that the user sees the advertisement.

C. Petitioner’s Rationale Based on Badros Alone or in Combination with Krasser

The Petition’s analysis does not sufficiently explain how Badros’s time-multiplexed display of previously selected advertisements discloses, teaches, or suggests requesting advertisements from a server in response to the viewability test. *See* Pet. 18–28 (Ground I), 31–40 (Ground II). In particular, claims 1 and 6 recite causing a communication to be sent in response to the viewability test. Ex. 1001, 68:59–64 (claim 1, step (b)); 70:7–11 (claim 6, limitation (b)(ii)). And the claimed dispatch server receives the communication and sends a replacement advertisement. *Id.* at 68:65–69:4 (claim 1); 70:11–16 (claim 6). The Petition’s analysis of these limitations is deficient for the reasons that follow.

In Ground I, Petitioner argues that “[i]t would have been obvious that Badros makes a request to the server for additional ads.” Pet. 25 (citing Ex. 1009 ¶¶ 57, 69). But Petitioner does not rely on any specific teachings from Badros. *Id.* Instead, Petitioner cites parts of Dr. Smedley’s declaration

that are not clearly relevant to this rationale. *Id.* For example, Petitioner relies on Dr. Smedley’s discussion of Harkins:

Harkins teaches systems and methods for selecting and placing advertisements via one or more advertising agents and/or advertising medium. Ex. 1004, Abstract. Harkins also teaches real time auctions to sell advertisements. *Id.*

Ex. 1009 ¶ 57, *cited in* Pet. 25. Petitioner also cites Dr. Smedley’s summary of Badros’s time-multiplexing display, but that summary does not describe where advertisements come from. *Id.* ¶ 69 (citing Ex. 1003, 22:12–15).

Petitioner provides no additional reasoning for how these teachings relate to Krassner’s or Badros’s communications. Pet. 18–19, 24. For example, the Petition lacks an explanation why the server needs the recited communication if the server itself performs the viewability test in the proposed combination. *Id.* at 25. At bottom, Petitioner has not fully explained its reasoning. *Id.* at 18–19, 24–25.

Petitioner’s explanation in Ground II is equally sparse. After citing Badros’s discussion of the impression module, Petitioner quotes Badros’s description of a request for advertisements. *Id.* at 36 (citing Ex. 1003, 5:13–21). The quoted paragraph states, in part, “*In response to the request*, the server 2 may cause a plurality of documents to be displayed on a time-multiplexed basis.” Ex. 1003, 5:13–21 (emphasis added). As discussed above, the time-multiplexed display uses the viewability test. *See id.* at 6:20–24, 11:22–24, 12:37:40; Tr. 13:20–22, 19:21–22:13. By contrast, the claimed communication requests do not trigger a viewability test but are made “in response to” one. *See* Ex. 1001, 68:59–64 (claim 1, step (b)); 70:7–11 (claim 6, limitation (b)(ii)). Thus, Petitioner’s bare citation to Badros in

Ground II is insufficient. Pet. 36; *see also id.* at 37 (citing Ex. 1003, 5:11–18, 2:9–21 (describing the same feature)).³

Badros provides little detail about what happens when the server’s impression module performs the viewability test. *See* Ex. 1003, 12:34–47. Indeed, Badros’s server-side viewability test has been thoroughly analyzed during this IPR because Patent Owner argued that the test was not enabled. *See, e.g.*, PO Resp. 14–16; Reply 7–12; Tr., 12:12–13:2, 74:22–77:13; Director Dec. 2–3. Apart from the enablement issue, though, the details about Badros’s viewability test are relevant to the remaining limitations because they recite communications that are sent in response to the test. *See* Ex. 1001, 68:59–64 (claim 1, step (b)); 70:7–11 (claim 6, limitation (b)(ii)).

In this IPR, Petitioner bears the burden of persuasion to prove unpatentability of the challenged claims, and this burden never shifts to Patent Owner. *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015). The arguments and evidence produced during trial show that Badros lacks express teachings about all the communications made in response to a server-side viewability test. *See* PO Resp 14–16.⁴ Indeed, Badros’s silence in this regard appears to have led Petitioner to

³ Petitioner also cites another part of Badros that, although related to displaying advertisements, does not discuss any communications. Pet. 37 (citing Ex. 1003, 22:12–15). Petitioner does not further explain their relevance. *See id.* I see no reason to piece together a separate obviousness theory from these bare citations. *See Netflix, Inc. v. DivX, LLC*, 84 F.4th 1371, 1382 (Fed. Cir. 2023) (“It was reasonable for the Board to consider only the theory encapsulated in the plain words of [Petitioner] and decline to discern another theory from the citations alone.”).

⁴ From this evidence, Patent Owner draws separate conclusions that Badros lacks a server-side viewability test and that Badros’s viewability test is not enabled. *See* PO Resp. 13–58.

argue that claim 1, step (b) and claim 6, limitation (b)(ii) (1) should be given no patentable weight, (2) would have been obvious over Harkins, and (3) would have been obvious to try. *See* Pet. 25, 27, 34–36, 39. As discussed below, these rationales are deficient.

D. Conditional Limitations

Petitioner argues that the “in response to” feature “is non-limiting because it requires a condition precedent that need not ever occur” and “a prior art reference need not disclose this optional limitation to render the claim obvious.” *Id.* at 22–23 (citing Manual of Patent Examining Procedure § 2111.04 (II); *Ex parte Schulhauser*, Appeal No. 2013-007847 (PTAB Apr. 28, 2016) (precedential); *Ex Parte Botman*, Appeal No. 2021-004052 (PTAB Sept. 2, 2022); *Ex Parte Gopalan*, Appeal No. 2017-007009 (PTAB May 21, 2018); *Ex Parte Erhart*, Appeal No. 2019-004505, 2021 (PTAB Jan. 8, 2021)) (Ground I); *id.* at 34–35 (Ground II).

In the Decision on Institution (Paper 9 (“Inst. Dec.”), 8), the Board disagreed. I stand by the reasoning in our Institution Decision. I add that claim 6 recites a system. Ex. 1001, 69:21. Like the system in *Schulhauser*, the system of claim 6 requires the structure for performing the function when the condition occurs:

This interpretation^[5] of the system claim differs from the method claim because the structure (i.e., a processor programmed to perform an algorithm for carrying out the recited function should the recited condition be met) is present in the system regardless of whether the condition is met and the function is actually performed. Unlike claim 1, which is written in a manner that does not require all of the steps to be performed should the condition

⁵ In *Schulhauser*, the Board applied the broadest reasonable interpretation to the claims. *Schulhauser* at 9.

precedent not be met, claim 11 is limited to the structure capable of performing all the recited functions.

Schulhauser at 14. Thus, Petitioner has not shown that claims 1 and 6 are unpatentable under its conditional-limitation rationale. *See* Pet. 22–23; Inst. Dec. 8.

E. Petitioner’s Rationale based on Badros and Harkins

In the analysis of step (b) of claim 1 and limitation (b)(ii) of claim 6, Petitioner relies on Harkins’s discussion of initiating a new auction:

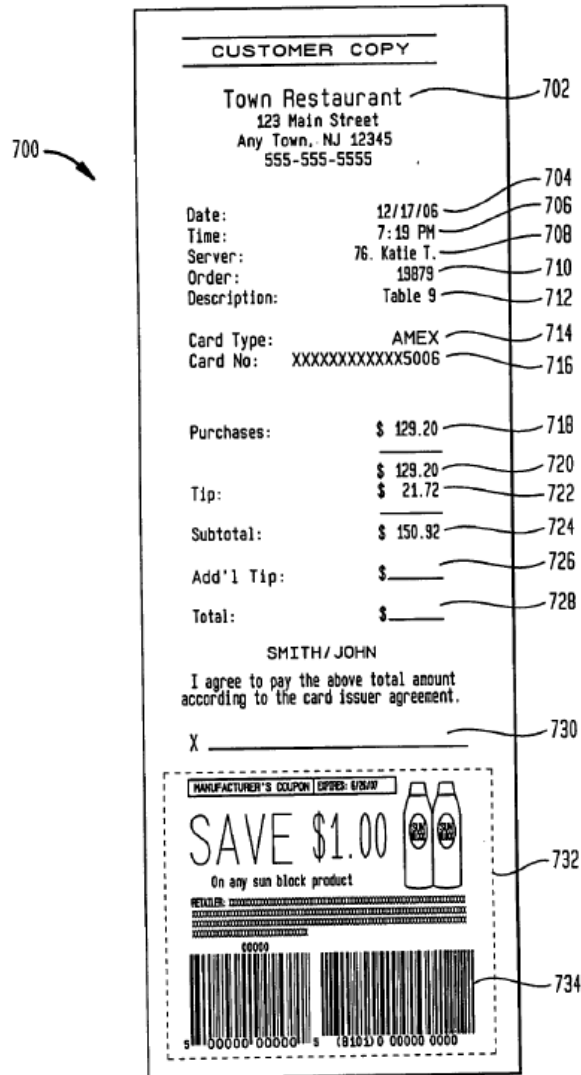
Even if neither Badros nor Krassner disclose this limitation explicitly, Harkins teaches “*causing a communication to be sent to one or more dispatcher servers*” (e.g., “At 424, a new auction is initiated. In our exemplary embodiment of the present invention, a new auction for advertising in the run period subsequent to the run period of the previously-ended auction may be initiated. However, virtually any form of new auction may be initiated without departing from the scope of the present invention.” [Ex. 1004 ¶ 76]). Therefore, the combination of Krassner, Badros and Harkins would disclose this limitation.

Pet. 25. Here, Petitioner does not explain why or how Harkins’s teaching would have been incorporated into the proposed combination with Badros or the Krassner-Badros combination. *Id.* Similarly, Petitioner’s discussion of Harkins in its “Rationale to Combine” lacks any analysis of devices (e.g., a client or server) or sending communications. *Id.* at 19, 32.

Harkins's Figure 7 shows a print advertisement from its system.

Ex. 1004 ¶ 21.

FIG. 7



Printed sales receipt 700 contains information about a restaurant transaction: name and address 702, date 704, time 706, server 708, order number 710, table number 712, card type 714, card number 716, purchase price 718, total purchase price 720, tip 722, subtotal 724, additional tip 726, total 728, and signature line 730. *Id.* ¶ 101. Harkins’s advertisement 732 is shown at the bottom of this printed receipt. *Id.*

Dr. Smedley's testimony appears to be based on hindsight reasoning. *See* Ex. 1009 ¶¶ 59–61. The cited teaching from Harkins is relied upon for nothing more than a communication sent to a server, generally. Pet. 25 (citing Ex. 1004 ¶ 76). This disregards the context in which Harkins's communication is sent and ignores the requirement that the communication is sent in response to a viewability test. *Id.* As Patent Owner points out, Harkins "has nothing to do with internet advertising." PO Resp. 17. So its communications cannot be in response to a viewability test. Dr. Smedley's testimony is nothing more than impermissible hindsight because he essentially opines "that all of the elements of the claims disparately existed in the prior art, but failed to provide the glue to combine these references." *See InTouch Tech., Inc. v. VGO Commc'ns, Inc.*, 751 F.3d 1327, 1348–49 (Fed. Cir. 2014).

Thus, I would find that Petitioner has not shown that it would have been obvious to add Harkins to the Badros-Krassner combination or Badros alone to arrive at step (b) in claim 1 and limitation (b)(ii) in claim 6. *See* PO Resp. 17.⁶

F. Petitioner's Obvious-to-Try Rationale

Petitioner's reliance on Badros's server 2 for the viewability test (Pet. 23, 35–36) undercuts the "obvious to try" rationale. In this rationale, Petitioner argues that it would have been obvious to try to send a request to the server because "the server would need to know when the previous ads had been displayed to know when to send a new set of ads." *Id.* at 27, 39. To the contrary, under Petitioner's reasoning, the server would not need to

⁶ Patent Owner also argues in the heading that Harkins is non-analogous art. PO Resp. 17. I view that as a separate issue and do not address it here.

know this if its impression module is able to “track the time duration during which the document is actually visible to the user.” Ex. 1003, 12:37–40, *quoted in* Pet. 23.

V. PETITIONER’S REPLY

During trial, Petitioner presented an entirely new obviousness rationale based on a client-side viewability test. *See* Reply 7–11. For example, Petitioner argues that “Badros’ system and method teach running auctions to ‘time-multiplex’ (i.e., replace) advertisements using well-known *client-side* JavaScript, which should be obvious if not inherent.” *Id.* at 7 (citing Ex. 1003, 13:8–27, 14:20–31, 11:22–24) (emphasis added). According to Petitioner, “The parties agree that [the] *only* way to accomplish this feature is to have ‘a timer at the user computer.’” *Id.* (citing Ex. 1003, 23:61–62; Ex. 2026 ¶ 14; Ex. 2045 ¶ 69; Pet. 27, 38–39).

Dr. Smedley, however, testified that, in a server-side viewability test, the server could receive information from a client. Ex. 2050, 143:11–23. Indeed, in one of Badros’s embodiments, user module 40 causes code to be installed at the user computer, and “[t]he code (or toolbar) at a user computer 10 may pass information about the user computer 10 to server 2.” Ex. 1003, 13:6–23. Badros’s toolbar collects information about a user’s screen. *See id.* at 14:10–19. Assuming Badros’s teachings are fully enabled, the toolbar embodiment (*id.* at 13:6–23, 14:10–19) and Dr. Smedley’s corresponding testimony (Ex. 2050, 143:11–23) contradict Petitioner’s argument that the “*only way* to accomplish” the visibility function is to have a timer at the user computer. Reply 7 (emphasis added). Thus, the Petition need not be based on a client-side viewability test.

Unlike the Petition’s reliance on impression module 38, Petitioner’s Reply discusses user module 40. *Id.* at 8 (citing Ex. 1003, 11:22–34, 12:48–

66, 13:8–27; Ex. 1009; Pet. 23, 30, 35–36, 43). Likewise, at oral argument, Petitioner’s counsel argued that user module 40 is the basis for its challenge. Tr. 75:3–4.

Dr. Sherwood explains that performing a viewability test on user module 40 belongs to a different embodiment than the one cited in the Petition. Ex. 2045, 30 n.3. I would credit Dr. Sherwood’s testimony on this point because it aligns with Badros’s Figure 2, which shows that the impression module is distinct from the user module. PO Resp. 20. Also, Badros describes the user module’s viewability test in connection with an embodiment found in another part of the detailed description. *See* Ex. 1003, 14:20–22. The Petition lacks any rationale for combining these distinct modules to arrive at a new module that satisfies all limitations of claims 1 and 6. Pet. 35 (citing Ex. 1003, 12:48–66 in Ground II); *see also id.* at 23 (citing Ex. 1003, 12:37–40 in Ground I).

In sum, Petitioner’s argument that it is relying on user module 40 contradicts the Petition’s citation to impression module 38 (*id.* at 23, 35) and the statement that the references could be combined to arrive at a server to perform the viewability test (*id.* at 26). The user-module viewability test is an entirely new obviousness theory presented for the first time in Petitioner’s Reply.

During oral argument, the Board questioned Petitioner about the new obviousness theory, and Petitioner maintained that the Petition relied on a client-side viewability test. *See* Tr. 12:12–13:2, 74:22–77:13. Patent Owner also attempted a similar line of questioning during the cross-examination of Dr. Smedley, explaining during oral argument that its questions went unanswered:

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

Id. at 42:18–25. During cross-examination, Dr. Smedley explained that he did not provide an opinion on whether Badros teaches the viewability test. *See, e.g.,* Ex. 2050, 52:17–53:53.

To be sure, “there is no blanket prohibition against the introduction of new evidence during an IPR.” *Rembrandt Diagnostics, LP v. Alere, Inc.*, 76 F.4th 1376, 1384 (Fed. Cir. 2023). But “an IPR petitioner may not raise in reply ‘an entirely new rationale’ for why a claim would have been obvious.” *Henny Penny Corp. v. Frymaster LLC*, 938 F.3d 1324, 1330–31 (Fed. Cir. 2019). “Unlike district court litigation—where parties have greater freedom to revise and develop their arguments over time and in response to newly discovered material—the expedited nature of IPRs bring[s] with it an obligation for petitioners to make their case in their petition to institute.” *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016). Here, I would hold Petitioner to the obviousness theory in the Petition.

IV. CONCLUSION

Petitioner bears the burden of persuasion to prove that the challenged claims are unpatentable. *Dynamic Drinkware*, 800 F.3d at 1378. In my view, Petitioner did not satisfy this burden. Thus, I respectfully dissent.