

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

PATENT OWNER'S NOTICE OF APPEAL

Pursuant to 35 U.S.C. §§ 141, 142, and 319; 37 C.F.R. §§ 90.2-90.3; Federal Rule of Appellate Procedure 15; and Federal Circuit Rule 15, Patent Owner Rich Media Club, LLC (“Patent Owner”) hereby provides notice that it appeals to the United States Court of Appeals for the Federal Circuit from the Final Written Decision on Remand Determining of the Patent Trial and Appeal Board (“Board”) entered on March 7, 2025 (Paper 80) (“Final Written Decision”) and the Order Denying Director Review of the Second Final Written Decision entered on May 29, 2025 (Paper 83) (“Director Review Order”) in IPR2023-00953, and from all underlying findings, determinations, rulings, opinions, orders, issues, and decisions regarding the *inter partes* review of U.S. Patent 11,443,329

In accordance with 37 C.F.R. § 90.2(a)(3)(ii), Patent Owner states that the issues on appeal include, but are not limited to:

- (i) the Board’s determination of unpatentability of claims 1-10 of the ’329 Patent;
- (ii) whether the process was “unfair to the Patent Owner” and should not have resulted in the first Director decision reversing and remanding the first Final Written Decision dated August 19, 2024 finding no challenged claims unpatentable as set forth the separate comments by Judge Fitzpatrick on remand;

- (iii) whether the Director erred in her December 12, 2024 decision reversing and remanding the matter back to the Board by, among other errors, substituting her non-expert opinion regarding the teachings of the prior art for the expert opinions submitted by both parties and directing the Board to follow her non-expert opinion on remand;
- (iv) whether, even in light of the Director’s non-expert opinion, the Badros reference taught the “in response to” limitation of the claims, which the Dissent explained in the Final Written Decision on remand it did not do.
- (v) whether any decision (the initial Final Written Decision, the initial Director decision reversing and remanding, the second Final Written Decision, and the second Director decision denying review) properly considered the extensive evidence of secondary indicia of non-obviousness under the “totality of the evidence” test required by *Volvo Penta*.
- (vi) the Board’s factual findings, conclusions of law, or other determinations supporting or related to that determination, as well as all other issues decided adversely to Patent Owner in any orders, decisions, rulings, or opinions.

The Director issued her decision denying Patent Owner's Petition for Review on May 29, 2025. This notice is therefore timely filed with sixty-three (63) days of the Director's decision, which is considered a request for rehearing, as prescribed by 35 U.S.C. § 142 and 37 C.F.R. § 90.3(a)(1).

Pursuant to 35 U.S.C. § 142 and 37 C.F.R. § 90.2, a copy of this Notice of Appeal is being e-filed with the Clerk's Office for the United States Court of Appeals for the Federal Circuit, along with payment of the required docketing fees, and to the Director of the Patent and Trademark Office c/o the Office of the General Counsel.

In accordance with Fed. Cir. Rule 15 and the associated Practice Notes, a copy of the Final Written Decision of the Board and the Order Denying Director Review of Final Written Decision are attached.

Dated: July 25, 2025

/Ragnar Olson/

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Case No. IPR2023-00953

U.S. Patent 11,443,329

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Rich Media Club, LLC

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing PATENT OWNER'S NOTICE OF APPEAL has been served in its entirety on July 25, 2025 by the PTAB's E2E electronic filing system, and also by U.S. Mail to the Director of the U.S. Patent and Trademark Office at this address:

Director of the United States Patent and Trademark Office
c/o Office of the General Counsel
United States Patent and Trademark Office
Mail Stop 8, Post Office Box 1450
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The undersigned also certifies that a true and correct copy of the foregoing PATENT OWNER'S NOTICE OF APPEAL has been filed in its entirety on July 25, 2025, via the electronic filing system, CM/ECF, with the Clerk's Office of the U.S. Court of Appeals for the Federal Circuit.

The undersigned also certifies that a true and correct copy of the foregoing PATENT OWNER'S NOTICE OF APPEAL was served in its entirety on July 25, 2025, by electronic mail (by consent) on the following attorneys of record for Petitioner:

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

DURATION MEDIA LLC,
Petitioner,

v.

RICH MEDIA CLUB LLC,
Patent Owner.

IPR2023-00953
Patent 11,443,329 B2

Before COKE MORGAN STEWART, *Acting Under Secretary of
Commerce for Intellectual Property and Acting Director of the United States
Patent and Trademark Office.*

ORDER

IPR2023-00953
Patent 11,443,329 B2

The Office received a request for Director Review of the Final Written Decision on Remand in the above-captioned case. *See* Paper 82. The request was referred to me.

Upon consideration of the request, it is:

ORDERED that the request for Director Review is denied.

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,
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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).

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DURATION MEDIA LLC,
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Patent Owner.

IPR2023-00953
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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.

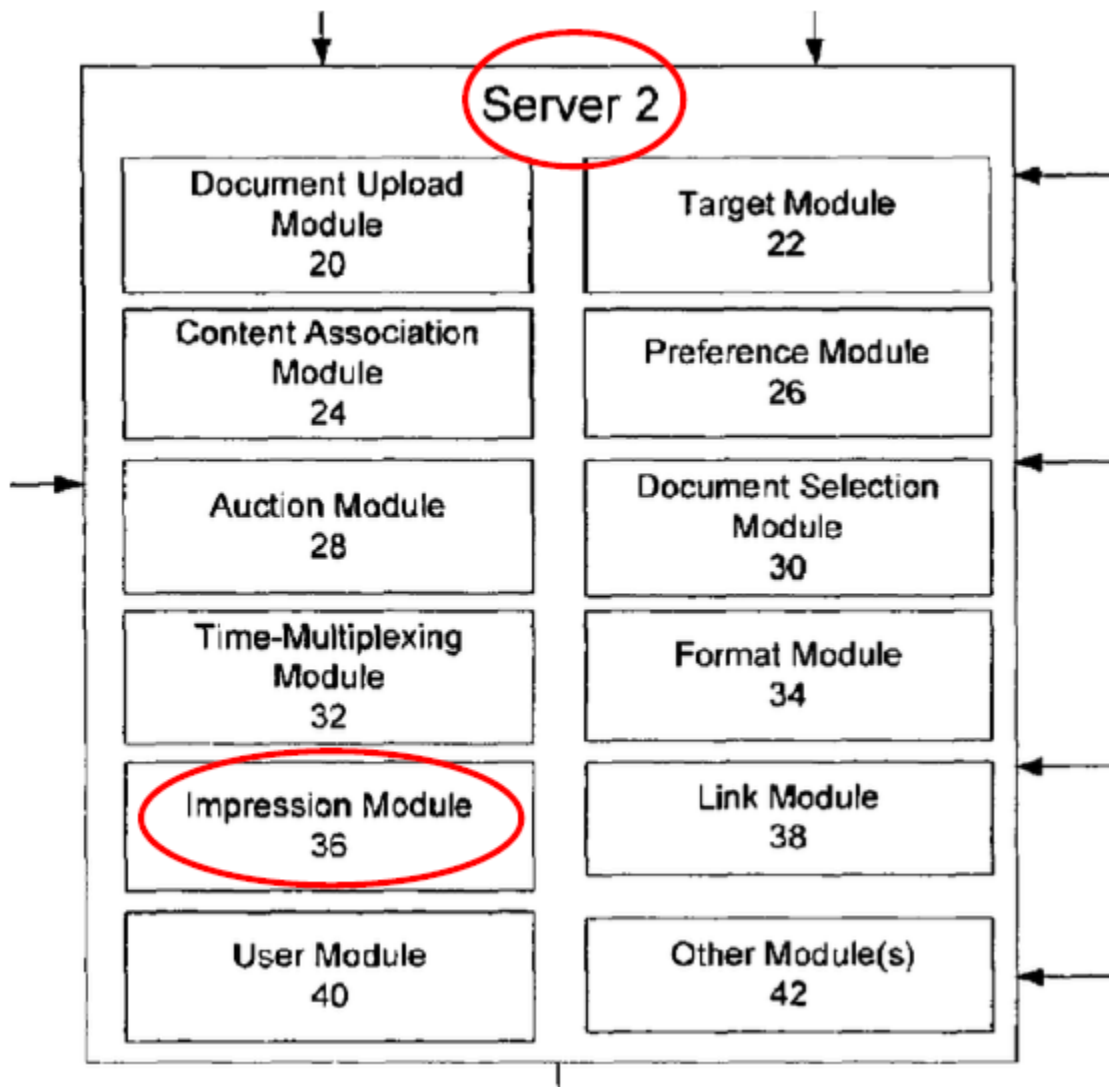
To address the recited viewability test in step (b) of claim 1, Petitioner cites Badros’s impression module 38 on server 2. *Id.* at 23 (citing Ex. 1003, 11:22–24; 12:37–40). One of the quoted sentences is from a paragraph explaining that impression module 38 determines whether the document is visible:

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

CUSTOMER COPY	
Town Restaurant	
123 Main Street	
Any Town, NJ 12345	
555-555-5555	
Date:	12/17/06
Time:	7:19 PM
Server:	76. Katie T.
Order:	13879
Description:	Table 9
Card Type:	AMEX
Card No:	XXXXXXXXXXXX5006
Purchases:	\$ 129.20
	\$ 129.20
Tip:	\$ 21.72
Subtotal:	\$ 150.92
Add'l Tip:	\$ _____
Total:	\$ _____
SMITH/ JOHN	
I agree to pay the above total amount according to the card issuer agreement.	
X	_____
<div style="border: 1px dashed black; padding: 10px;"> <div style="display: flex; justify-content: space-between; align-items: center;"> MANUFACTURER'S COUPON SERIES: 1234567  </div> <div style="text-align: center; font-size: 2em; font-weight: bold;">SAVE \$1.00</div> <p>On any sun block product</p> <div style="display: flex; justify-content: space-around;">   </div> <div style="display: flex; justify-content: space-between; font-size: 0.8em;"> 000000 000000 816110 000000 0000 </div> </div>	

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.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

DURATION MEDIA LLC,
Petitioner,

v.

RICH MEDIA CLUB LLC,
Patent Owner.

IPR2023-00953
Patent 11,443,329 B2

Before KATHERINE K. VIDAL, *Under Secretary of Commerce for
Intellectual Property and Director of the United States Patent and
Trademark Office.*

DECISION

Granting Director Review, Vacating the Final Written Decision,
and Remanding to the Patent Trial and Appeal Board for
Further Proceedings

I. INTRODUCTION

On May 24, 2023, Duration Media LLC (“Petitioner”) filed a Petition requesting an *inter partes* review of claims 1–10 of U.S. Patent No. 11,443,329 B2 (Ex. 1001, “the ’329 patent”) related to distribution and tracking of online advertising. Paper 1 (“Pet.”). On August 30, 2023, the Board instituted an *inter partes* review (Paper 9). On August 7, 2024, in a split decision, the Board issued a Final Written Decision (Papers 71, 74; “Dec.”)¹. The Board majority determined that Petitioner had not shown that claims 1–10 were unpatentable. Dec. 32. Specifically, the Board found that Petitioner failed to show that the prior art taught a claim limitation relating to determining whether an advertisement has been displayed to a user for “a predefined period of time” (the “viewability test”). *Id.* at 28–30. The Board also granted in part Patent Owner’s motion to exclude some of the evidence submitted with Petitioner’s Reply. *Id.* at 32. The dissent disagreed with the Board majority’s determination regarding the viewability test, as well as the majority’s ruling granting in part Patent Owner’s motion to exclude. Papers 71, 74, Dissent, 1–14 (“Dissent”).

On August 16, 2024, Petitioner filed a request for Director Review of the Board’s Decision. Paper 73 (“DR Request”). Petitioner argues that the Board majority erroneously concluded that the prior art reference Badros² does not teach the viewability test. *Id.* at 4–12. With my authorization,

¹ A non-public version of the Decision issued on August 7, 2024 (Paper 71) and a public version of the Decision issued on August 19, 2024 (Paper 74).

² U.S. Patent No. 7,725,502 B1, issued Aug. 13, 2019 (Ex. 1003).

Patent Owner filed a response to the DR Request. Paper 75 (order authorizing response); Paper 77 (“DR Resp.”).³

I have reviewed Petitioner’s DR Request, Patent Owner’s response to that request, the Board’s Final Written Decision, and the Papers and Exhibits of record in this proceeding. I determine that Director Review of the Board’s Final Written Decision is appropriate. *See* 37 C.F.R. § 42.75(e)(2). For the reasons discussed in further detail below, I respectfully vacate the Board’s Final Written Decision and remand for further proceedings consistent with this decision.

II. BACKGROUND

The ’329 patent is directed to “creating electronic advertisements using licensed digital content, and distributing such advertisements for display at desired network locations.” Ex. 1001, 2:45–48. As relevant here, the patent describes determining whether an advertisement has been in the user’s view for a predetermined period of time, thereby enabling a new advertisement to be displayed only after the user has had sufficient opportunity to view the previous advertisement. *Id.* at 12:65–13:3.

Figure 69 of the ’329 patent, reproduced below, depicts a browser window with a sample advertisement fully within the browser window and viewable to the user. *Id.* at 16:15–19.

³ Patent Owner filed an amended version of its response to the DR Request (Paper 77), correcting certain errors. Ex. 3101. Petitioner requested authorization to file a reply to Patent Owner’s response, which I denied. *Id.*

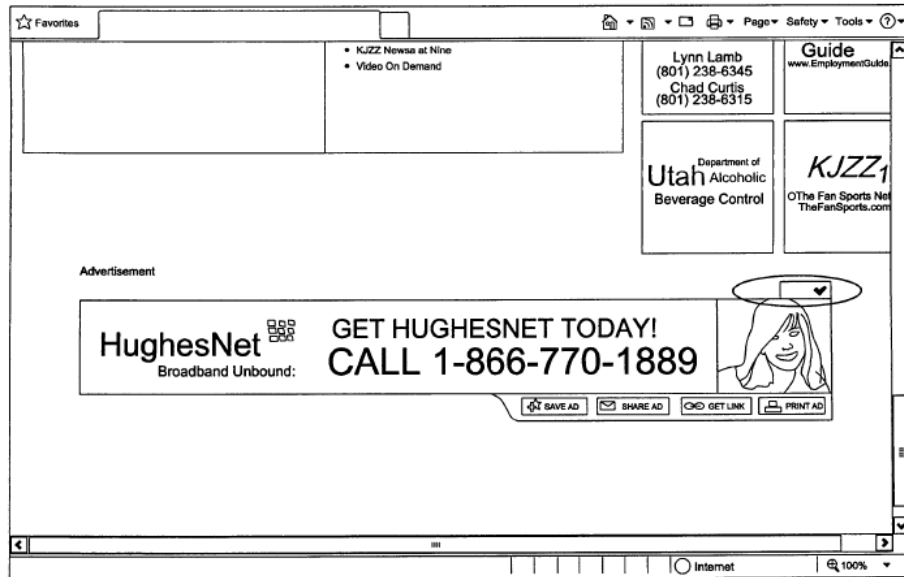


FIG. 69

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 8:3–6. The code “continuously determine[s] 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.” *Id.* at 12:54–62. The '329 patent discloses determining whether an advertisement has been in the user’s view for a predetermined period of time before rendering a new advertisement in its place. *Id.* at 12:65–13:3.

Independent claims 1 and 6 of the '329 patent both recite the viewability test. Claim 1 recites, in pertinent 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.” Ex. 1001, 68:58–61 (emphasis added). Independent claim 6 similarly recites, “determine whether the predefined area of the ad content display page that is used to display the advertisement *is in view within a visible area* of a browser window of a

browser configured to be operated by the remote computing device.” *Id.* at 70:2–6 (emphasis added).

In this proceeding, Petitioner proposed two grounds of unpatentability challenging claims 1–10 of the ’329 patent, each of which relies on Badros in combination with other references. Pet. 17–43. For both grounds, Petitioner relied solely on Badros as teaching the viewability test. *Id.* at 23 (citing Ex. 1003, 11:22–24, 12:37–40), 35–36 (citing Ex. 1003, 11:22–24, 12:36–39, 12:48–66).

Figure 4 of Badros, reproduced below, depicts webpage 3 comprising advertisement 1a that is displayed on a time-multiplexed basis. Ex. 1003, 21:15–20.

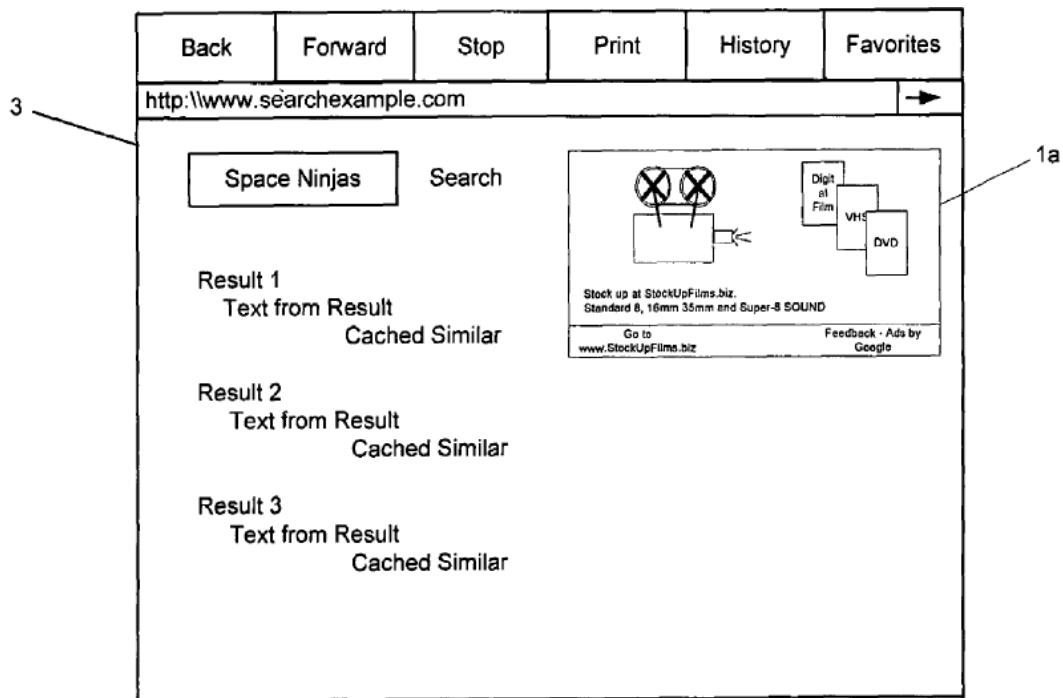


FIG. 4

Badros discloses applying a “time-multiplexing criteria for a plurality of documents based on the time during which a document is actually viewable on the user’s screen.” *Id.* at 11:22–24. Badros further discloses

tracking “the time duration during which the document is actually visible to the user.”⁴ *Id.* at 12:37–40.

Petitioner also relied on declaration testimony of Dr. Trevor Smedley in support of its contentions. *See* Ex. 1009 ¶¶ 70–71; Pet. 23, 36.

In response, Patent Owner argued that a person of ordinary skill in the art “would have understood the discussion of viewability in Badros as referring to a served impression in general,” (i.e., an ad impression served from the server regardless of viewability), or “an ‘above the fold,’ ‘good,’ or ‘high probability’ impression with a higher likelihood of falling within the viewable portion of a webpage.” Paper 35 (“PO Resp.”), 14–15 (citing Ex. 2045 ¶ 74); 17–19. According to Patent Owner, at the time Badros was filed, “the standard for determining whether an ad had been made ‘visible to the user’ was whether the ad had been served from the server,” and not whether the ad was actually in view within the visible area of the browser. *Id.* at 14.

Patent Owner also argued that Badros does not enable the viewability test because “Badros does not teach *how* to implement a viewability test.” *Id.* at 40–42. Patent Owner relied on testimony of Mr. Robert Sherwood in support of its contentions. *See* Ex. 2045 ¶¶ 68–69, 74.

Petitioner responded to Patent Owner’s arguments by arguing that Badros unambiguously discloses using the viewability test and expressly distinguishes “its ‘actually visible’ method from served impressions.” Paper 50, 6 (citing Ex. 1003, 12:39–41, 15:4–8). Petitioner further submitted a declaration from Dr. Michele Madansky, as well as a second

⁴ Because my decision below does not turn on any details associated with Petitioner’s other asserted references, a detailed explanation of these references is not necessary.

declaration from Dr. Smedley in support of its contentions. *See* Exs. 1026, 1027. Petitioner also argued that Badros’s disclosure was enabling because viewability tests were well known for more than a decade prior to the ’329 patent’s priority date. Paper 50, 7–12.

Patent Owner filed a Motion to Exclude Dr. Madansky’s declaration, Dr. Smedley’s second declaration, and other evidence submitted with Petitioner’s Reply. *See* Paper 60.

III. ANALYSIS

In the Final Written Decision, the Board majority agreed with Patent Owner that Badros’s discussion of viewability of advertisements refers only to *served* impressions and that Badros, therefore, does not disclose the claimed viewability test. Dec. 21–22 (citing Ex. 2045 ¶¶ 62, 68, 70, 74). In support, the Board observed that Petitioner’s expert Dr. Smedley had agreed on cross-examination that “Badros doesn’t teach how to do its viewability test,” (*id.* at 22 (citing Ex. 2050, 148:9–22)), and also that Petitioner had failed to identify any description or claim language in Badros directed to determining whether an advertisement is actually in view on an output display device. *Id.* (citing Ex. 1003, 22:40–26:52.5; Paper 70 (Hearing Transcript), 19:7–19).

The Board granted Patent Owner’s Motion to Exclude as to the relevant testimony in Dr. Madansky’s declaration and Dr. Smedley’s second declaration. *Id.* at 25. The Board explained that these declarations support a *prima facie* case of unpatentability and should have been presented with the Petition, not with Petitioner’s Reply. *Id.* at 26 (citing 35 U.S.C. § 312(a)(3); 37 C.F.R. § 42.104(b)(4)–(5); Board’s Consolidated Trial Practice Guide, 73 (Nov. 21, 2019)).

Having considered the Final Written Decision, I agree with Petitioner that the Board conflated enablement and obviousness by focusing on whether Badros discloses “how to” perform the viewability test. DR Request 5–7; *see* Dec. 21 (explaining that Badros lacks “any description of *how to* determine that a predefined area that is used to display an advertisement” (emphasis added)). As the dissent recognized, the Board’s analysis of whether Badros discloses how to perform the viewability test addresses the issue whether Badros’s disclosure is enabling—an issue that the Board majority did not reach. *See* Dissent 7–9; Dec. 22 n.5; *see In re Antor Media Corp.*, 689 F.3d 1282, 1290 (Fed. Cir. 2012) (“Enablement of prior art requires that the reference teach a skilled artisan *to make or carry out* what it discloses in relation to the claimed invention.” (emphasis added)). The Board misunderstood Patent Owner’s arguments as directed to whether Badros discloses the viewability test, and in adopting Patent Owner’s arguments, incorrectly decided that Badros’s disclosure was deficient for the purposes of teaching that claim limitation. *See* Dissent 2, 7–9. The Board failed to adequately explain why Badros does not *disclose* the viewability test. Dec. 21–30.

Badros discloses determining whether a document “is actually viewable on the user’s screen” or “visible to a user” and tracking “the time duration during which the document is actually visible to the user.” *See* Ex. 1003, 11:22–24, 12:37–40. Badros further discloses that “if several documents are intended to be *actually displayed* to a user for five seconds each before switching to the next document, then [the] impression module may keep track of the amount of time that each document is *actually output* on a user’s computer monitor.” *Id.* at 12:49–54 (emphasis added); Ex. 1009 ¶ 70). That is, Badros repeatedly uses phrases such as “actually viewable,”

“actually visible,” and “actually displayed” with reference to the advertisements being displayed. I find no basis to interpret Badros’s disclosure as referring to advertisements being served rather than being viewable to a user.

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. Dec. 21–22 (citing Ex. 2045 ¶¶ 62, 68, 70, 74). I find Mr. Sherwood’s testimony contrary to Badros’s clear disclosure. Badros expressly distinguishes viewed impressions from served impressions. *See* Ex. 1003, 15:4–8 (“The number of ‘actual’ (e.g., verified) impressions may be distinguished from the number of times a document was output to client terminal.”). Mr. Sherwood’s attempt to effectively rewrite Badros’s express teachings is improper and entitled to no weight. Petitioner persuasively shows that Badros discloses the viewability test.⁵

The Board here was troubled by Dr. Smedley’s testimony on cross-examination. Dec. 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. Dissent 6 (citing *Belden Inc. v. Berk–Tek LLC*, 805 F.3d 1064, 1079 (Fed. Cir. 2015), and *VirnetX Inc. v. Apple Inc.*, 665 F. App’x 880 (Fed. Cir. 2016), for the proposition that no law or rule requires the Board to rely on expert testimony to read the prior art). The claim limitation at issue here, and Badros’s

⁵ I agree with the dissent that whether Badros *claims* a viewability test or includes some claim language directed to the viewability test is simply irrelevant to the issue whether Badros *discloses* the viewability test. *See* Dissent 8; DR Request 7.

disclosure, are easily understandable without the need for expert explanatory testimony. *See Wyers v. Master Lock Co.*, 616 F.3d 1231, 1242 (Fed. Cir. 2010) (explaining that “expert testimony is not required when the references and the invention are easily understandable”).

In response to the DR Request, Patent Owner argues that in Badros’s system, the module running the viewability test resides on a server, and “no known system can meet the determination limitation from the server-side.” DR Resp. 6–9 (citing PO Resp. 19–21). According to Patent Owner, this “is evidence demonstrating that one of ordinary skill, reading Badros at the time of the invention, would have [understood] the reference to be talking about ads *likely to be seen* rather than those that were *determined* to be ‘in view.’” *Id.* at 9. As an initial matter, the Board did not consider this argument in reaching its decision. *See* Dec. 21–22. Moreover, Patent Owner’s argument is once again directed to whether a skilled artisan would have been able *to make or carry out* what Badros discloses in relation to the claimed invention, i.e., enablement, not to whether Badros adequately *discloses* the viewability test. *See Symbol Techs., Inc. v. Opticon, Inc.*, 935 F.2d 1569, 1578 (Fed. Cir. 1991) (explaining that “a non-enabling reference may qualify as prior art for the purpose of determining obviousness under § 103”); *Beckman Instruments, Inc. v. LKB Produkter AB*, 892 F.2d 1547, 1551 (Fed.Cir.1989) (“Even if a reference discloses an inoperative device, it is prior art for all that it teaches”). As discussed above, Badros plainly discloses tracking whether an advertisement is *actually* visible to the user, not just whether it is *likely* to be viewed by the user. *See* Ex. 1003, 11:22–24, 12:37–40. That disclosure sufficiently *teaches* the limitation, regardless of whether that teaching alone, or in combination with other evidence of record, would have enabled an ordinarily skilled artisan to carry out the claimed viewability

test—an issue the Board has not fully addressed. *See Raytheon Techs. Corp. v. General Electric Co.*, 993 F.3d 1374, 1380–81 (Fed. Cir. 2021) (explaining that “a prior art reference asserted under § 103 does not necessarily have to enable its own disclosure, i.e., be ‘self-enabling,’ to be relevant to the obviousness inquiry”). As discussed below, on remand, the Board should consider whether Badros is self-enabling, and if not, whether other evidence of record would enable an ordinarily skilled artisan to make and use the viewability test. *Id.*

Patent Owner also argues that the Board’s decision was correct in light of Dr. Smedley’s cross-examination testimony declining to confirm that Badros taught the viewability test. DR Resp. 1–3 (citing Dec. 23–24), 10–15 (citing Ex. 1009 ¶¶ 70–71). As discussed above, I agree with the dissent that, given Badros’s disclosure, expert testimony is not dispositive, or even necessary, to resolve whether Badros discloses the viewability test. 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.” DR Resp. 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). Patent Owner’s suggestion that the Board was required to ignore all other evidence in light of Dr. Smedley’s cross-examination testimony is incorrect.

Lastly, Patent Owner argues that Petitioner’s request ignores all evidence of objective indicia of nonobviousness. DR Resp. 4–6. On remand, the Board will have an opportunity to address Patent Owner’s

remaining arguments, including those related to objective indicia of nonobviousness.

Therefore, I respectfully vacate the Board’s Final Written Decision and remand to the Board for further proceedings. 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”). I agree with the Board that “it was proper for Petitioner to submit new evidence with its Reply to rebut Patent Owner’s lack of enablement argument” (Dec. 29 n.10), and thus, the Board should consider Petitioner’s evidence, including Dr. Madansky and Dr. Smedley’s testimony, in making its enablement determination.⁶ *See*

⁶ Petitioner argues that Badros’s disclosure is remarkably similar to the disclosure of the ’329 patent, and that it has demonstrated that Badros enables the viewability test. DR Request 7–10. In addition, Petitioner argues that because viewability tests were well known at the time of Badros, there was no need for Badros to “explain what was already well known.” *Id.* at 10–11. On remand, the Board should consider these arguments, as well as any other relevant record material, in determining whether Patent Owner has met its burden to prove that Badros’s viewability test is not enabled. *See*

Apple Inc. v. Andrea Elecs. Corp., 949 F.3d 697, 707 (Fed. Cir. 2020) (finding that the Board abused its discretion in ignoring petitioner’s responsive arguments to issues raised by patent owner during trial); *Rembrandt Diagnostics, LP v. Alere, Inc.*, 76 F.4th 1376, 1384 (Fed. Cir. 2023) (“there is no blanket prohibition against the introduction of new evidence during an IPR”).

The Board shall 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.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Director Review is granted;

FURTHER ORDERED that the Board’s Final Written Decision (Papers 71, 74) is vacated; and

FURTHER ORDERED that the captioned proceeding is remanded to the Board for further proceedings consistent with this decision.

In re Wands, 858 F.2d 731, 737 (Fed. Cir. 1988) (listing factors to be considered in determining enablement).

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

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

FITZPATRICK, *Administrative Patent Judge*, joined by *Administrative
Patent Judge Repko*.

EASTHOM, *Administrative Patent Judge*, dissenting.

JUDGMENT

Final Written Decision

Determining No Challenged Claims Unpatentable

35 U.S.C. § 318(a)

Dismissing-in-part and Granting-in-part Patent Owner's Motion to Exclude

I. INTRODUCTION

A. *Background and Summary*

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 carried out 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.”).

We have jurisdiction under 35 U.S.C. § 6, and this Final Written Decision, issued pursuant to 35 U.S.C. § 318(a), addresses issues and arguments raised during the review. For the reasons discussed below, we determine that Petitioner has not met its burden to prove, by a preponderance of the evidence, that any of claims 1–10 of the ’5329 patent is unpatentable.

B. *Real Parties in Interest*

Each party identifies itself as the sole real party in interest. Pet. 5; Paper 16, 1.¹

¹ 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.

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.

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 this Decision turns:

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 added).

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 6–10 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, 2009.² Ex. 1015, code (22). Patent Owner concurs. *See* PO Resp. 14 (“The '329 Patent issued from a continuation-in-part application that added new matter with a filing date of April 4, 2009.”).³

² The Petition erroneously refers to this date as “April 3, 2009.” Pet. 13–14. We presume that is a typographical error.

³ 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 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

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 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)).

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.

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 (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. 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 (72) (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.

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 ¶4. 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. Analysis of Claim 1

Claim 1 recites “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.”⁴ Petitioner relies

⁴ It should be noted that both parties use various shorthand phrases in reference to this limitation. For example, both parties sometimes refer to the limitation as a “viewability test.” *See, e.g.,* Pet. 15; PO Reply 6; *see also* Ex.

exclusively on Badros for teaching this limitation. *See* Pet. 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.” (citing Ex. 1003, 11:22–24, 12:37–40; Ex. 1009 ¶¶67–68)).

The cited portions of Badros state:

- “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).

The Petition’s citation to paragraphs 67 and 68 of Exhibit 1009 (the first declaration of Trevor Smedley, Ph.D.) appear to be a typographical error. Instead, it appears that paragraphs 70 and 71 were the intended paragraphs. In paragraphs 70 and 71, Dr. Smedley quotes the above-noted excerpts, as well and two additional excerpts, from Badros and concludes that they “demonstrate[] that it would have been obvious to request

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).

additional advertisements from a server in response to determining an ad has been displayed for a predetermined time because it discloses tracking the time duration of display and sending a request to a server for replacement advertisements.” Ex. 1009 ¶¶70–71 (quoting Ex. 1003, 11:22–24, 12:36–40, 12:48–66, 5:13–21).

Patent Owner argues that a person of ordinary skill in the art “would have understood the discussion of viewability in Badros as referring to a served impression in general or as one that had been served to a viewer or an ‘above the fold,’ ‘good,’ or ‘high probability’ impression with a higher likelihood of falling within the viewable portion of a webpage.” PO Resp. 14–15 (citing Ex. 2045 ¶74). In other words, Patent Owner argues that Badros, at best, teaches *an assumption* that an advertisement is viewable based on its premium location within, for example, a webpage, but does not teach a determination that it is actually “in view within the visible area of the browser window for a predefined period of time,” as recited in claim 1. *See* Ex. 2045 ¶70 (“[T]he 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.”).

Patent Owner’s interpretation of Badros is consistent with Badros’s lack of (1) any description of how to determine that a predefined area that is used to display an advertisement has been in view within the visible area of the browser window for a predefined period of time and (2) any claim limitation directed to such a determination, as its witness, Mr. Sherwood, testified. *See* Ex. 2045 ¶62 (“I reach this opinion in part because there is no disclosure in Badros about how to actually run a viewability test.”), ¶68

(“Badros does not teach or claim a viewable impression and further Badros does not teach how to do a viewability test.”). Petitioner’s own witness, Dr. Smedley, agreed that “Badros doesn’t teach how to do its viewability test.” *See* Ex. 2050, 148:9–22 (agreeing with this statement but adding: “that’s not a difficult thing to do”). And, none of Badros’s claims includes language directed to determining whether an advertisement is actually in view on an output display device. Ex. 1003, 22:40–26:52.⁵

During the hearing, the Board asked counsel for Petitioner to identify any example of such claim language in Badros. Tr. 19:7–10. Counsel for Petitioner identified one purported example, namely the second paragraph of Badros claim 1. Tr. 19:18–19. That paragraph recites the following:

determining time-multiplexing criteria and space-multiplexing criteria for displaying a plurality of selected documents associated with a concept on a time-multiplexed basis, the time-multiplexing criteria and the space-multiplexing criteria based on at least one of a relevance of each of the selected documents to the concept, a cost per click, or a click through rate associated with each of the selected documents.

Ex. 1003, 22:42–49. Nothing in this paragraph is directed to determining whether an advertisement (or any other content) is actually in view on an output display device.

⁵ The Dissent suggests that we are treating these facts (lack of enablement and lack of claiming) as determinative of a lack of description in Badros. We are not. As stated above, we find Badros’s lack of any description of how to determine whether an advertisement is actually in view on an output display device as well as Badros’s lack of any claim limitations directed to such a determination as being “consistent” with our finding that Badros does not disclose such a feature. In other words, we can rule out the possibility that our understanding of what Badros discloses is contradicted by what Badros enables or claims.

Perhaps the most troublesome evidence for Petitioner is that its own witness, Dr. Smedley, repeatedly testified on cross-examination that he did not know whether Badros teaches the “determination” limitation of claim 1, despite having considered Badros and offering other opinions about Badros.

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.

With its Reply, Petitioner submitted a second declaration by Dr. Smedley. Ex. 1027. In it, Dr. Smedley testifies that, at the time of his deposition, he “had not yet formed an opinion on whether Badros disclosed” the “determination” limitation. Ex. 1027 ¶9 (citing Ex. 2050, 50:22–52:19). In his second declaration, he testifies that he now has an opinion in that regard, said opinion being that “Badros discloses Patent Owner’s ‘viewability test.’” Ex. 1027 ¶11. With its Reply, Petitioner also submitted a declaration by Michelle Madansky, Ph.D, in which she testified that “it is [her] opinion that Dr. Smedley accurately characterized Badros and other prior art as disclosing viewability tests.” Ex. 1026 ¶4.

Dr. Smedley paints his new opinion as timely because, in his first declaration, he had opined that the “determination” limitation was optional, and it was only thereafter that we rejected such a construction. Ex. 1027 ¶10; *see also* Ex. 1009 ¶66 (“It is my opinion that the ‘in response to’ limitation is an optional step that might be performed only when there is a ‘determination’ as specified in the limitation.”); Inst. Dec. 8 (rejecting the proposed construction). Despite Dr. Smedley’s explanation, his new opinion that Badros teaches the “determination” limitation is belated.

As Patent Owner succinctly argues in its Motion to Exclude:

The “viewability test” claim element was always part of the ’329 patent claims and Petitioner always had the burden to meet it with prior art and to present and explain this in its Petition that it chose to file. [Dr.] Smedley and Petitioner decided not to

proffer any expert opinion on the issue of whether Badros disclosed a “viewability test” with its Petition. This decision was entirely within their control.

Paper 60 (“PO Mot. To Exclude”), 9–10.⁶ Patent Owner is correct in this regard and, thus, we grant Patent Owner’s Motion to Exclude with respect to the testimony in the second Smedley Declaration and the Madansky Declaration opining that Badros teaches the determination limitation. Paper 60, 9–12.

Petitioner, in its Opposition to the Motion to Exclude, argues that Patent Owner’s arguments about the “viewability test” were “surprising.” Paper 62, 8. We are not persuaded by Petitioner’s argument. The “viewability test” is a claim limitation. Petitioner should have anticipated that Patent Owner would argue that limitation. *See In re Gardner*, 449 F. App’x 914, 916 (Fed. Cir. 2011) (“This court has held that when evaluating claims for obviousness under 35 U.S.C. § 103, all the limitations of the claims must be considered and given weight.” (citing *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530 (Fed. Cir. 1983)); *Univ. of Strathclyde v.*

⁶ Patent Owner’s Motion to Exclude seeks to exclude, in part or in whole, Exhibits 1020–1022, 1025–1030, and 1034–1040, which were submitted with Petitioner’s Reply, of which Exhibits 1026 and 1027 are the declaration by Dr. Madansky and the second declaration by Dr. Smedley, respectively. Mot. To Exclude. 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”). Apart from the portions of Dr. Smedley’s second declaration and Dr. Madansky’s declaration opining that Badros teaches the “determination” limitation, we dismiss the Motion to Exclude as moot.

Clear-Vu Lighting LLC, 17 F.4th 155, 160 (Fed. Cir. 2021) (“An obviousness determination generally requires a finding that “all claimed limitations are disclosed in the prior art’.” (citing *PAR Pharm., Inc. v. TWI Pharms., Inc.*, 773 F.3d 1186, 1194 (Fed. Cir. 2014)).

Petitioner argues that “[v]iewability tests were well known for well over a decade prior to the ’329 patent’s priority date.” Reply 9. If that were the case, then Petitioner should have made its argument in the Petition. Section 312(a) of Title 35 is titled “Requirements of Petition,” and it specifies that a petition must identify, among other things, “the evidence that supports the grounds for the challenge to each claim, including . . . (B) affidavits or declarations of supporting evidence and opinions, if the petitioner relies on expert opinions.” 35 U.S.C. § 312(a)(3); *see also* 37 C.F.R. § 42.104(b)(4)–(5) (“The petition must specify where each element of the claim is found in the prior art patents or printed publications relied upon; and . . . the supporting evidence relied upon to support the challenge.”). Thus, “Petitioner may not submit new evidence or argument in reply that it could have presented earlier, e.g. to make out a prima facie case of unpatentability.” Board’s Consolidated Trial Practice Guide, 73 (Nov. 21, 2019).⁷ Dr. Smedley’s testimony in his second declaration, that “Badros discloses Patent Owner’s ‘viewability test’” (Ex. 1027 ¶11), is clearly evidence to make out a prima facie case of unpatentability. The same is true of Dr. Madansky’s testimony that she agrees with Dr. Smedley in this regard. Ex. 1026 ¶4.

⁷ The TPG is available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

Nothing prevented Dr. Smedley from presenting his opinion of whether Badros teaches the “determination” limitation in his first declaration. In fact, unlike Dr. Smedley’s first declaration, the Petition itself argued both that (1) the “determination” recited in claim 1 need not occur, and (2) Badros nonetheless teaches the “determination.” *See* Pet. 22 (“Firstly, this ‘*in response to*’ limitation is non-limiting because it requires a condition precedent [(i.e., the determination)] that need not ever occur.”), 23 (“Secondly, even though Krassner doesn’t disclose “*a determination that the predefined area that is used to display the advertisement has been in view within the visible area of the browser window for a predefined period of time[,]*” Badros does.”). Dr. Smedley, in his first declaration, could have presented opinions in support of both arguments but only presented an opinion on the claim construction argument.⁸

According to Dr. Smedley, at the time of his deposition, he “had not yet formed an opinion on whether Badros disclosed” the “determination” limitation. Ex. 1027 ¶9 (citing Ex. 2050, 50:22–52:19). Dr. Smedley further explains:

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

⁸ Dr. Smedley’s claim construction opinion was not only unpersuasive but also wholly unsupported. He simply stated: “It is my opinion that the ‘in response to’ limitation is an optional step that might be performed only when there is a ‘determination’ as specified in the limitation.” Ex. 1009 ¶66. The idea that such a self-serving and unsupported opinion gave Petitioner the right to withhold, until its reply brief, evidence about how the prior art allegedly teaches the limitation is objectionable.

Ex. 1027 ¶10. His new opinion and his offer to be cross-examined regarding it are much too late.

We entered our Institution Decision on August 30, 2023. Inst. Dec. 1. Dr. Smedley's deposition occurred almost two months later on October 25, 2023. Ex. 2050. During his deposition, Dr. Smedley testified that he had seen the Institution Decision. Ex. 2050, 110:13–21. He also testified that he was aware that the Institution Decision had rejected his opinion that the “in response to [a] determination step” was optional. *Id.* at 112:13–19. Despite knowing our claim construction and despite having already studied Badros (*see, e.g.*, Ex. 1009 ¶35), he testified extensively at his deposition that he had no opinion of whether Badros teaches the limitation. Ex. 2050, 50:22–52:19.⁹

Citing Dr. Madansky's declaration, Petitioner argues that “Badros and many other prior art references taught and enabled viewability tests.” Pet.

⁹ The Dissent posits that “Dr. Smedley's first declaration lacks any testimony on which to cross-examine him about the disputed actually visible limitation.” *See infra* (citing 37 C.F.R. § 42.53(d)(5)(ii), which provides: “For cross-examination testimony, the scope of the examination is limited to the scope of the direct testimony.”). We disagree. In his first declaration, Dr. Smedley testified that he had reviewed, among other things, Badros and the Petition. Ex. 1009 ¶4. Thus, Dr. Smedley had reviewed Petitioner's argument in its Petition that Badros teaches the “determination” limitation. *See* Pet. 35 (citing Ex. 1003, 11:22–24, 12:36–37, 12:38–39). In fact, in his first declaration, Dr. Smedley quotes and testifies about the very same excerpts of 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, in his first declaration, Dr. Smedley 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. Clearly, Patent Owner's cross-examination of Dr. Smedley about whether Badros teaches the “determination” limitation was within the scope of his first declaration.

Reply 22 (citing Ex. 1026 ¶¶ 10–21). Petitioner makes this argument in a section of its Reply brief dedicated to rebutting Patent Owner’s arguments regarding secondary considerations of evidence. *See* Pet. Reply 20–27. Dr. Madansky’s testimony may be proper reply evidence to the extent it addresses secondary considerations and/or enablement,¹⁰ but it is not proper reply evidence to support that Badros teaches the “determination” limitation in the first instance.

In sum, the reply declaration testimony of Dr. Smedley and Dr. Madansky offered to show that Badros teaches the “determination” limitation of claim 1 should have been submitted with the Petition. 35 U.S.C. § 312(a)(3). Accordingly, we do not consider it, and we grant Patent Owner’s Motion to Exclude with respect to the testimony in the second Smedley Declaration and the Madansky Declaration opining that Badros teaches the “determination” limitation. Paper 60, 9–12.

Based on the totality of the evidence that was timely submitted, we find that Petitioner fails to meet its burden to show, by a preponderance of that 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,” as recited in claim 1. *See* 35 U.S.C. § 316(e) (“[T]he petitioner

¹⁰ In addition to arguing that Badros does not teach the “determination” limitation, Patent Owner also argues that Badros does not enable it. PO Resp. 40–42. Because Badros is a patent, there is a rebuttable presumption that its entire disclosure is enabled. *See Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1355 (Fed. Cir. 2003) (“[W]e hold a presumption arises that both the claimed and unclaimed disclosures in a prior art patent are enabled.”). Thus, it was proper for Petitioner to submit new evidence with its Reply to rebut Patent Owner’s lack of enablement argument.

shall have the burden of proving a proposition of unpatentability by a preponderance of the evidence.”). Thus, the Petitioner fails to show, by a preponderance of that evidence, that claim 1 would have been obvious over Krassner, Badros, and Harkins.

5. Analysis of Claims 2–10

Claims 2–5 depend from claim 1. Thus, Petitioner fails to show, by a preponderance of that evidence, that claims 2–5 would have been obvious over Krassner, Badros, and Harkins. *See In re Fine*, 837 F.2d 1071, 1076 (Fed. Cir. 1988) (“Dependent claims are nonobvious under section 103 if the independent claims from which they depend are nonobvious.”).

6. Analysis of Claims 6–10

According to Petitioner, and not disputed by Patent Owner, “Claims 6–10 are drawn towards a system but are substantively identical to [method] claims 1–5.” Pet. 19 n.2. We agree.

In particular, we note the similarity between the limitation of independent claim 6 corresponding to the “determination” limitation of claim 1. It recites: “determine whether the predefined area of the ad content display page that is used to display the advertisement is in view within a visible area of a browser window of a browser configured to be operated by the remote computing device.” Ex. 1001, 70:2–6. Claims 7–10 ultimately depend from claim 6.

Thus, for the same reasons discussed in relation to claim 1, Petitioner fails to show, by a preponderance of that evidence, that claims 7–10 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.

Because, as discussed above, Petitioner fails to show that Badros teaches the “determination” limitation of claim 1 (and the substantively identical “determine” limitation of claim 6), Petitioner fails to show, by a preponderance of that evidence, that claims 1–10 would have been obvious over Badros and Harkins.

III. CONCLUSION¹¹

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		1–10
Overall Outcome				1–10

¹¹ 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).

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 not proven unpatentable;

FURTHER ORDERED that Patent Owner's Motion To Exclude is dismissed-in-part and granted-in-part; 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.

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

EASTHOM, *Administrative Patent Judge*, dissenting.

I respectfully dissent from the Majority opinion primarily because, in my view, Petitioner shows persuasively that 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.” Pet. 23. As Petitioner shows, Badros specifically states that “[s]ome 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.*” *Id.* (emphasis added) (quoting Ex. 1003, 11:22–24). Badros also states that 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.*” *See id.* (quoting Ex. 1003, 12:37–40). The Majority agrees that the Petition

addresses the viewability test by relying, *inter alia*, on the above-quoted disclosures in Badros. *See* Maj. 20.

The Majority recognizes that the parties refer to the disputed clause, *inter alia*, as the “viewability test,” or “actually visible” test, or similar phrases. *See* Maj. 19–20 note 4 (quoting PO Resp. 7). As quoted above, this is exactly what Badros discloses. The Majority, however, does not specify clearly why it holds that Badros does not disclose what it says, namely that “a document is actually viewable on the user’s screen” or that “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.” Ex. 1003, 11:22–24, 12:37–40. The Majority repeats Patent Owner’s arguments and states they are consistent with what amounts to a lack of enablement of the viewability test in Badros, as outlined further below, without actually reaching all the evidence about enablement set forth by Petitioner. *See* PO Resp. 21–22; Maj. 20–22. In other words, in my view, the Majority commingles reasoning and facts that are relevant to alleged lack of enablement to support its decision that Badros does not disclose the disputed viewability test. *See* Maj. 20–22 & note 5.

The Majority also faults Dr. Smedley’s testimony, and reasons it supports Patent Owner, because Dr. Smedley did not answer questions about Badros during his deposition and instead “testified extensively at his deposition that he had no opinion of whether Badros teaches the limitation.” Maj. 28 (Ex. 2050, 50:22–52:19). The Majority acknowledges that at the time of his deposition, Dr. Smedley stated he “had not yet formed an opinion on whether Badros disclosed” the “determination” limitation. Maj. 26 (Ex. 1027 ¶ 9 (citing Ex. 2050, 50:22–52:19)); *see also* Reply 7 (arguing that the Response “falsely stated that Dr. Smedley ‘does not believe Badros

teaches’ the limitation,” where “Patent Owner quoted testimony that Dr. Smedley’s declaration did not expressly give an opinion on that limitation” (citing PO Resp. 4; Ex. 2050, 50:22–52:19)).

There is no real dispute here. Dr. Smedley does not testify about the disputed limitation in his first declaration, as he credibly verified repeatedly during his deposition. *See* PO Resp. 9 (quoting Ex. 2050, 173:5–16). As the Majority recognizes, Dr. Smedley did not render an opinion about the disputed limitation because he originally opined that the actually visible limitation in question was an “optional” claim step. *See* Maj. 24; Ex. 1009 ¶ 66 (“It is my opinion that the ‘in response to’ limitation is an optional step that might be performed only when there is a determination as specified in the limitation.”); *Ex parte Schulhauser*, 2013-007847, 8 (April 28, 2016) (precedential) (holding that “the broadest reasonable interpretation of claim 1 encompasses an instance in which the method ends when the alarm is triggered in response to the cardiac signal data not being within the threshold electrocardiac criteria, such that the step of ‘determining the current activity level of the subject’ and the remaining steps need not be reached”). Then, in the Institution Decision, we rejected Dr. Smedley’s “optional” claim interpretation. *See id.*

Accordingly, Dr. Smedley’s first declaration lacks any direct testimony on which to cross-examine him about the disputed actually visible limitation as disclosed in Badros. The Majority agrees that Dr. Smedley “only presented an opinion on the claim construction argument” in his first declaration. Maj. 27. Yet, the Majority holds that Dr. Smedley should have answered questions about the disputed limitation based on the Institution Decision, the Petition, and Badros, even though he did not directly testify about whether Badros discloses the limitation. *See id.* Even if this holding

does not violate at least the spirit of 37 C.F.R. § 42.53.d.5.ii, under the circumstances here, the holding does not provide a proper basis for excluding Dr. Smedley's second declaration. *See id.* ("For cross-examination testimony, the scope of the examination is limited to the scope of the direct testimony.").

The Majority reasons that because Dr. Smedley reviewed the Institution Decision, Petition, and Badros, any questions about Badros are within the scope of his direct testimony. Maj. 28 note 9. Even though his review of these documents falls within "the scope of his direct testimony," as discussed above, Dr. Smedley essentially answered that he did not testify directly about whether Badros discloses the limitation in his first declaration. Nevertheless, the Majority attempts to bolster its holding by noting that "in his first declaration, Dr. Smedley 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.* (quoting Ex. 1009 ¶ 62). Therefore, the Majority reasons that Dr. Smedley's answers about Badros during his deposition provide the "most troublesome evidence for Petitioner." *Id.* at 22. But Dr. Smedley's limited testimony about the "elements of the challenged claims" and the grounds of the Petition (Ex. 1009 ¶ 62) is in context to his testimony that the disputed claim limitation is optional (*id.* ¶ 66), as he specifically signals in the sentence that immediately follows the sentence the Majority relies upon: "However, I provide some additional opinions on the following claim limitations" (*id.* ¶ 62).¹

¹ The Majority characterizes Dr. Smedley's claim interpretation of the disputed limitation as optional as "wholly unsupported" and therefore reasons that giving "Petitioner the right to withhold, until its reply brief, evidence about how the prior art allegedly teaches the limitation is

Therefore, contrary to the Majority's holding that Patent Owner met its burden in its Motion to Exclude portions of the Reply evidence (i.e., portions of the second Smedley Declaration and similarly, portions of the Madansky Declaration (Maj. 24–29)), it was proper for Petitioner to submit new evidence with respect to enablement and to the related new argument that “Badros does not mean what it said.” *See* Paper 62, 8 (“Petitioner . . . properly responded to [Patent Owner's] faulty enablement argument in case the Board desired additional evidence that Badros truly meant ‘actually visible to the user.’”). In other words, to reply to Patent Owner's lack of enablement argument raised for the first time in its Response, it was proper for Petitioner to provide evidence and argument as to how Badros's language, which the Petition largely cites, is enabling. Moreover, Dr. Smedley's testimony in his second declaration replies to a claim construction of the disputed limitation that we adopted in our Institution Decision, as the Majority also recognizes. *See* Maj. 24. For that additional reason, the declarations are proper reply evidence, because they respond to the Institution Decision and the Response, contrary to the Majority's determination otherwise. *See* 37 C.F.R. § 42.23(b) (“A reply may only respond to arguments raised in the corresponding opposition, patent owner preliminary response, patent owner response, or decision on institution.”).

objectionable.” Maj. 27, note 8. However, as indicated above, the Board's precedential *Schulhauser* decision reveals reasonable support for Dr. Smedley's claim interpretation (even if *Schulhauser* is distinguishable), the Petition shows where Badros teaches the disputed limitation, and the Reply and Reply evidence merely fill in gaps in response to Patent Owner's arguments, including by addressing Patent Owner's enablement arguments.

To reach its finding that Badros does not disclose the disputed limitation, the Majority repeats Patent Owner’s arguments at pages 14–15 of the Response. *See* Maj. 21 (repeating Patent Owner’s argument that a POSITA would have understood that “the discussion of viewability in Badros . . . refer[s] to a served impression in general or as one that had been served to a viewer or an ‘above the fold,’ ‘good,’ or ‘high probability’ impression with a higher likelihood of falling within the viewable portion of a webpage” (quoting PO Resp. 14–15 (citing Ex. 2045 ¶ 74)). The Majority characterizes this line of argument as “Patent Owner argu[ing] that Badros, at best, teaches *an assumption* that an advertisement is viewable.” *Id.*

There is nothing in Badros to support this reading. Rather, this is Patent Owner’s unsupported theory. *See* Maj. 21 (arguing that Patent Owner’s theory “is consistent with” a “lack of” “any description of how to determine” the viewability test and a lack of “any claim limitation” in Badros). Therefore, even without Dr. Smedley’s testimony, the Board easily can determine that Badros does not discuss this theory, which Patent Owner advances to undermine the clear language in Badros. *See Belden Inc. v. Berk–Tek LLC*, 805 F.3d 1064, 1079 (Fed. Cir. 2015) (holding “[n]o rule requires . . . an expert [to] guid[e] the [PTAB] as to how it should read prior art”); *VirnetX Inc. v. Apple Inc.*, 665 F. App’x 880 (Fed. Cir. 2016) (“[E]ven if the record contains expert testimony, the law does not require the PTAB to rely upon it.”). But to the extent the trial requires expert testimony to shed light on what Badros enables in terms of what it clearly states based on arguments in the Response, Petitioner properly provides reply expert declarations.

As indicated above, to support its conclusion that Badros does not disclose the limitation based on Patent Owner’s characterization of Badros

as disclosing a “served impression” (PO Resp. 14) that per the Majority merely provides an “assumption” of viewability, the Majority states as follows:

Patent Owner’s interpretation of Badros is consistent with Badros’s lack of (1) any description of *how to* determine that a predefined area that is used to display an advertisement has been in view within the visible area of the browser window for a predefined period of time and (2) *any claim limitation* directed to such a determination, as its witness, Mr. Sherwood, testified. *See* Ex. 2045 ¶¶62 (“I reach this opinion in part because there is no disclosure in Badros about *how to actually run a viewability test.*”), ¶68 (“Badros does not teach or claim a viewable impression and further Badros does not teach *how to do a viewability test.*”). Petitioner’s own witness, Dr. Smedley, agreed that “Badros doesn’t teach *how to do* its viewability test.” *See* Ex. 2050, 148:9–22 (agreeing with this statement but adding: “*that’s not a difficult thing to do*”). And, none of Badros’s claims includes language directed to determining whether an advertisement is actually in view on an output display device. Ex. 1003, 22:40–26:52.

Maj. 21–22 (emphasis added).

These observations primarily adopt Patent Owner’s arguments to attempt to show lack of enablement in Badros of the actually visible limitation. *See In re Antor Media*, 689 F.3d 1282, 1287–1288 (Fed. Cir. 2012) (For anticipation, “[e]nablement of prior art requires that the reference teach a skilled artisan to make or carry out what it discloses in relation to the claimed invention.”); *cf. In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988)) (listing breadth of claims in a patent as one factor for determining if a *patent* disclosure enables *its claims*).² In the next sentence that follows the “served

² Prior art references carry a presumption of enablement. *See Antor Media*, 689 F.3d at 1282; *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1355 (Fed. Cir. 2003) (“[W]e hold a presumption arises that both

impression” sentence that that the Majority relies upon, Patent Owner clearly argues lack of enablement: “Contrary to assertions in the Petition, Badros never explains *how* to determine if the ad was literally viewable, there’s no evidence that anyone had actually demonstrated viewable ad technology in 2005, and this feature was not included in the issued claims of the patent.” PO Resp. 15. Here, and throughout its Response, Patent Owner consistently and repeatedly argues lack of enablement in Badros (i.e., “how to” carry how the actually visible determination and “actually demonstrate[.]” it). With respect to Patent Owner’s argument as to what Badros itself “claims,” which the Majority relies upon as discussed above, it is not relevant to either what Badros discloses or what it enables. *See Antor Media*, 689 F.3d at 1287–1288. It is not surprising that Patent Owner argues a lack of enablement given that Badros discloses, *inter alia*, “*the time during which a document is actually viewable on the user’s screen.*” Ex.1003, 11:22–24).

As another example in the quotation above, the Majority notes that Mr. Sherwood testifies that “there is no disclosure in Badros about *how to actually run* a viewability test,” and “Badros does not teach or claim a viewable impression and further Badros does not teach *how to do* a viewability test.” *See* Ex. 2045 ¶¶ 62 (emphasis added), 68 (emphasis added). As noted above, whether Badros “claim[s]” a viewability test is irrelevant to disclosure or enablement of Badros. But “how to actually run a

the claimed and unclaimed disclosures in a prior art patent are enabled.”); *Apple Inc. v. Corephotonics, Ltd.*, No. 2020-1438, 2021 WL 2577597, at *4 (Fed. Cir. June 23, 2021) (nonprecedential) (holding that in the context of AIA trial proceedings, “regardless of the forum, prior art patents and publications enjoy a presumption of enablement, and the patentee/applicant has the burden to prove nonenablement for such prior art” and that “[i]t was error for the Board to suggest otherwise”).

viewability test” or “how to do a viewability test,” are both relevant to whether Badros enables the test. As quoted above, the Majority also relies on Dr. Smedley’s testimony that “Badros doesn’t teach *how to do* its viewability test,” but “that’s not a difficult thing to do.” Ex. 2050, 148:9–22 (emphasis added). Again, this testimony goes to enablement. *See Wands*, 858 F.2d at 737.

At one relied-upon paragraph by the Majority, before Mr. Sherwood reaches his conclusion that “Badros does not teach or claim a viewable impression and further Badros does not teach how to do a viewability test,” Mr. Sherwood opines as follows:

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.”

Ex. 2045 ¶ 68. This testimony is difficult to understand. Does Mr. Sherwood actually “disagree” with what “Badros states”? Also, the testimony that “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” is ambiguous at best. Is Mr. Sherwood treating “serving an ad” as similar to “actual viewability”? Or is Mr. Sherwood treating “actual viewability” as similar to “seeing the add”? Even without the ambiguity, this testimony incorrectly assumes that Badros must describe a distinction created by Mr. Sherwood to support its clear disclosure of the disputed viewability test.

At any event, this testimony and corresponding argument turn on an implicit argument that Badros does not mean what it says, i.e., determining “the time during a document is actually viewable on the user's screen” and “determin[ing] whether a document . . . is actually visible to a user and it may track the time duration during which the document is actually visible to the user,” as Petitioner recognizes. *See* Pet. 23 (quoting Ex. 1003, 11:22–24; 12:37–40); Paper 45, 8 (referring to Patent Owner’s “clearly erroneous argument that RMC invented the ‘viewability test’ or that Badros did not mean what it said”).

In other words, Mr. Sherwood’s distinction turns on the notion that “the standard for determining whether an ad had been made ‘visible to the user’ was whether the ad had been served from the server.” *Id.*; *accord* PO Resp. 14. This is implicitly a lack of enablement argument, i.e., the argument reduces to the notion that because of some “standard” based on Mr. Sherwood’s “experience,” an artisan of ordinary skill reading Badros would have envisioned that Badros only enables an alleged “standard” of counting impressions from a server instead of what Badros plainly says it does, determining a document is “actually visible to the user” or “actually viewable on the user’s screen” (Ex. 1003, 11:22–24; 12:37–40). *See* Ex. 2045 ¶ 68; PO Resp. 14 (citing Ex. 2045 ¶ 68).

In addition to citing Mr. Sherwood’s testimony based on his “experience” to support the standards-based argument, Patent Owner cites other evidence. PO Resp. 14 (citing Ex. 2023, Exhibit 2027 ¶¶ 9–10, Ex. 2053). The cited testimony contradicts Mr. Sherwood and Patent Owner. Specifically, Mr. Edwards, Patent Owner’s witness, testifies that “[s]erved impressions would later be *distinguished from ‘viewable impressions,’*” which are ad impressions known to be actually within the viewable area of a

user's internet browser.” Ex. 2027 ¶ 10. In other words, it stands to reason based on the testimony of Mr. Edwards, that “actually viewable,” which Badros discloses and which is similar to “viewable impressions,” meant something different than “served impressions,” contrary to the testimony of Mr. Sherwood. Finally, Mr. Sherwood's testimony at the cited passage, based merely on his “experience,” is unsupported and is entitled to little or no weight. *See Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 12 at 5 (Vidal Feb. 10, 2023), *aff'g* Paper 9 at 15–17 (PTAB Aug. 24, 2022) (precedential). Patent Owner fails to provide context to the other two relied-upon exhibits, Exhibits 2023 and 2053. *See* PO Resp. 14. In any event, the documents that Patent Owner cites do not discuss the pertinent language in Badros and are of no help. *See* Ex. 2023, 2053.

Moreover, Petitioner shows that Badros expressly distinguishes the “actually visible” method from the served impressions by quoting Badros: “The number of ‘actual’ (e.g., verified) impressions may be distinguished from the number of times a document *was output to client terminal*. Also, the actual time during which a document was visible on a monitor may be stored.” Reply 6 (emphasis added) (quoting Ex. 1003, 15:4–8).³

In summary, Patent Owner argues that Badros does not disclose the viewability test primarily because Badros does not enable the test as

³ In another argument, Patent Owner maintains that the Badros server, absent some communication with a client, cannot determine what actually occurs at the client. *See* PO Resp. 19–21. Petitioner persuasively counters this by showing that Badros employs client-server architecture (in the Petition and Reply) to enable the viewability test. Reply 7–9 (citing Pet. 35–46). Petitioner also cites prior art publications and patents showing that viewability tests were well-known, further contradicting the standards-based and related enablement arguments. *Id.* at 9–10 (citing publications), 14–15 (citing patents).

evidenced in part by some vague standard that does not address the language of Badros. The Majority characterizes Petitioner as stating that “Patent Owner’s arguments about the ‘viewability test’ were ‘surprising.’” Maj. 25 (quoting Paper 62, 8 (Petitioner’s “Opposition to the Motion to Exclude”)). The Majority states it is “not persuaded” because “Petitioner should have anticipated that Patent Owner would argue that limitation,” and as such, any evidence in the Reply about the limitation is too late. *Id.* at 25–26 (noting “Petitioner may not submit new evidence or argument in reply that it could have presented earlier, e.g. to make out a prima facie case of unpatentability” (quoting Board’s Consolidated Trial Practice Guide, 73 (Nov. 21, 2019))). But the Petition meets the prima facie case by quoting the plain language of Badros as the Institution Decision further suggests, and Petitioner’s Reply evidence simply responds to new arguments by Patent Owner regarding enablement and the related argument that Badros does not teach what it plainly says (in conjunction with responding to the Board’s claim construction in the Institution Decision).

In full, at the quoted passage, Petitioner argues as follows:

Petitioner rightly presumed the prior art was enabled. Paper 50, 10 (citing *Analog Devices, Inc. v. Xilinx, Inc.*, No. IPR2020-01596, 2022 WL 1157604, at *14 (PTAB April 13, 2022)). Petitioner assumed that the case would focus on “replacement advertisement” limitations, not the clearly erroneous argument that RMC invented the “viewability test” or that Badros did not mean what it said. The rebuttal declarations—routinely entered in IPRs—responded to Patent Owner’s *surprising arguments that it invented the well-known “viewability test” and related issues*. The rules allow Patent Owner to argue that Badros, which is directed to a predictable art, was not enabled. Petitioner, too, properly responded to this faulty enablement argument in case the Board desired additional evidence that Badros truly meant “actually visible to the user.”

Nothing about this process is unusual, other than Patent Owner objecting to nearly all evidence submitted in petitioner's reply.

Paper 62, 8. For the reasons noted above, and as argued by Petitioner in its Opposition to the Motion to Exclude as summarized above, I disagree that Patent Owner met its burden in its Motion to Exclude portions of the Reply declarations. Nevertheless, even without the Reply declarations, the Petition and Reply show persuasively that Badros discloses the disputed limitation.

By focusing on the argument that Badros does not disclose what it says by conflating lack of enablement rationale to support its holding, and without actually reaching whether Badros enables the disputed limitation, the Majority does not squarely address the joined issue—whether Badros enables the disputed visibility test. *See Apple v. Corephotonics*, 81 F.4th 1353, 1361 (Fed. Cir. 2023) (reversing and remanding when the Board adopted an argument/issue that the patent owner, Corephotonics, “mentioned in passing only once in the Background section of the Response”).

Corephotonics noted that in *In re Magnum Oil Tools Int'l, Ltd.*, 829 F.3d 1364 (Fed. Cir. 2016), “[w]e held that, under the [Administrative Procedures Act], the Board erred in adopting an argument that the petitioner had not sufficiently made.” *Id.* at 1362 (citing *Magnum Oil Tools*, 829 F.3d 1381 (“[T]he Board must base its decision on arguments that were advanced by a party, and to which the opposing party was given a chance to respond.”)).

During the oral hearing, after the Board asked Patent Owner “*is your major contention that*” Badros’s discussion about viewability is “just a mistake” or “it’s not enabled,” Patent Owner responded that “[w]e’re saying—[Badros] certainly says that it’s viewable. . . . *but it doesn’t explain how that viewability test is accomplished*” (emphases added)). Tr. 67:8–19. By not addressing the “major contention” at trial, enablement, the Majority

raises an issue under the Administrative Procedure Act (“APA”) according to guidance in *Corephotonics*.

Specifically, *Corephotonics* further noted that

[o]ur decision in *Power Integrations, Inc. v. Lee* is similarly instructive. 797 F.3d 1318 (Fed. Cir. 2015). There, the Board spent a “significant portion of [its] decision” assessing the proper construction of a claim term that the parties did not dispute. *Id.* at 1325. We determined that because so much of the “[B]oard’s analysis is focused on a red herring,” it “failed to straightforwardly and thoroughly assess the critical issue” outlined by the parties and deprived the parties of an opportunity to respond to the Board’s claim construction. *Id.* This, we explained, was a violation of the APA.

Corephotonics, 81 F.4th at 1361.

For the above reasons, I respectfully dissent.