

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Duration Media LLC
Petitioner,

v.

Rich Media Club LLC
Patent Owner.

US Patent No. 11,741,482
Filing Date: October 7, 2022
Issue Date: August 29, 2023
Title: System And Method For Creation, Distribution And Tracking Of
Advertising Via Electronic Networks

Review No.: IPR2024-00937

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I. LIST OF EXHIBITS

This list of exhibits includes several exhibits that are already of record in related IPR2023-00953 (“’953 IPR”).

Ex. No.	Description
1001	US Patent No. 11,741,482 (“’482 patent”)
1002	US Patent No. 8,135,616 (“Callaghan”)
1003	US Publication No. 2007/0265923 (Appl. No. 11/803,779) (“Krassner” or “’779 appl.”)
1004	INTENTIONALLY BLANK
1005	International Publication No. WO2006/138400A1 (“Badros”)
1006	US Publication No. 2005/0177401 (“Koeppel”) (’953 IPR Ex-1025)
1007	File History of US Patent Application No. 17/961,952 (“’952 appl.”) (File History for ’482 patent)
1008	US Publication No. 2009/0265243 (Appl. No. 12/384,403) (“’403 appl.”)
1009	INTENTIONALLY BLANK
1010	INTENTIONALLY BLANK
1011	Declaration of Trevor J. Smedley, Ph.D. in Support of Petition for <i>Inter Partes</i> Review
1012	C.V. of Trevor J. Smedley, Ph.D.
1013	Document compare of specification of Appl. No. 12/384,403 (the parent of Krassner) with the specification of Krassner
1014	Docket Navigator Judge Roslyn O. Silver Statistics
1015	Docket Navigator Arizona District Statistics
1016	Docket Navigator Arizona District Stay Grant Rate
1017	Duration Media Response to ROG 2 (’953 IPR Ex-2056)
1018	International Publication No. WO2007/089082A1 (“Seo”)
1019	INTENTIONALLY BLANK
1020	US Patent No. 6,477,575 (“Koeppel ’575”)
1021	MRC Industry Communication Viewable Impression Advisory (Nov. 14, 2012) (’953 IPR Ex-2018)
1022	Press - Duration Media (’953 IPR Ex-2022)
1023	Patent Information - Duration Media (’953 IPR Ex-2023)
1024	David Cohen - Curious Thoughts from Curious Minds: This Could Change Everything - David Cohen – MediaBizBloggers (’953 IPR Ex-2024)

1025	INTENTIONALLY BLANK
1026	Smedley Deposition Exhibit - Media Ratings Council Accreditation Letter (April 13, 2010) ('953 IPR Ex-2017)
1027	Second Declaration of Igor Tchibirev (Under Seal) ('953 IPR Ex-2026) - Confidential Attorneys Eyes Only
1028	Declaration of Alan Edwards ('953 IPR Ex-2027)
1029	Smedley Deposition Exhibit - IAB Annual Report 2013 ('953 IPR Ex-2028)
1030	Smedley Deposition Exhibit - Measurementnow.net homepage from Internet Archive 7-21-12 ('953 IPR Ex-2029)
1031	Smedley Deposition Exhibit - Measurementnow.net FAQs from Internet Archive 7-22-12 ('953 IPR Ex-2023)
1032	Smedley Deposition Exhibit - Measurementnow.net Who's Involved from Internet Archive 7-22-12 ('953 IPR Ex-2031)
1033	Smedley Deposition Exhibit - Measurementnow.net Benefits from Internet Archive 7-22-12 ('953 IPR Ex-2032)
1034	IAB - Our Story ('953 IPR Ex-2033)
1035	Media Rating Council homepage ('953 IPR Ex-2034)
1036	Smedley Deposition Exhibit - Volunteer Landing from Online Standards Inch Closer to Standarization ('953 IPR Ex-2035)
1037	Smedley Deposition Exhibit - Think with Google – See How Viewability is Measured ('953 IPR Ex-2036)
1038	Smedley Deposition Exhibit - Google Ads Help from Understanding viewability and Active View reporting metrics ('953 IPR Ex-2037)
1039	MRC's Update to November 2012 Viewable Impression Advisory (June 12, 2013) ('953 IPR Ex-2038)
1040	MRC Accredited Viewability Verification Disclosure August 1, 2013 ('953 IPR Ex-2039)
1041	MRC Viewable Impression Advisory Update, November 2013 ('953 IPR Ex-2040)
1042	MRC Lifts Viewable Impression Advisory for Display Advertising (March 31, 2014) ('953 IPR Ex-2041)
1043	RealVu Revolutionizes Internet Advertising Measurement with the Viewable Impression ('953 IPR Ex-2042)
1044	Declaration of Robert Sherwood in Support of Patent Owner's Response to the Petition (Under Seal) ('953 IPR Ex-2045) - Confidential Attorney Eyes Only
1045	Deposition Transcript of Trevor Smedley 10-25-23 ('953 IPR Ex-2050)

1046	IAB 2004 Ad Guidelines ('953 IPR Ex-2053)
1047	Screenshots - Viewability Panel - IAB Ad Ops Summit 2011 ('953 IPR Ex-2054)
1048	MRC Accreditation Renewal Press Release ('953 IPR Ex-2057)
1049	Lume - The Display Ad Tech Landscape 9-28-2010 ('953 IPR Ex-2058)
1050	DoubleVerify Aims to Police the Online Advertising World 7-24-2010 ('953 IPR Ex-2059)
1051	David Evans - The Online Advertising Industry: Economics, Evolution, and Privacy Summer 2009 ('953 IPR Ex-2060)
1052	Benjamin Edelman - Harvard Business Review - The Dark Underbelly of Online Advertising 11-17-2009 ('953 IPR Ex-2061)
1053	Patent Owner's Response "POR" ('953 IPR, Paper 35)
1054	Igor Tchibirev Deposition Transcript January 30, 2024 ('953 IPR Ex-1020) - Confidential Attorney Eyes Only
1055	Alan Edwards Deposition Transcript January 31, 2024 ('953 IPR Ex-1021) - Confidential Attorneys Eyes Only
1056	Robert Sherwood Deposition Transcript February 6, 2024 ('953 IPR Ex-1022)
1057	US Patent No. 6,317,782 ("Himmel") (titled "Method and apparatus for detecting actual viewing of electronic advertisements," priority 1998) ('953 IPR Ex-1028)
1058	US Pub. No. 20080222503 ("Sandige") (titled "Rendering of two-dimensional markup messages," priority 2007) ('953 IPR Ex-1029)
1059	US Pub. No. 2006/0155615 ("Loo") (titled "Object placement within computer generated multidimensional environments," priority 2005) ('953 IPR Ex-1030)
1060	Overview of Viewability and Active View - Google Ad Manager Help ('953 IPR Ex-1033)
1061	US Patent No. 5,778,372 ("Cordell") ('953 IPR Ex-1034)
1062	US Patent No. 6,418,470 ("Blumenau") (titled "Metering of Internet Content using a control")
1063	ComScore, Inc. v. Ad Safe Media, Ltd. Complaint for Patent Infringement ('953 IPR Ex-1036)
1064	Audience 2.0 - Time - Alenty - Web 2.0 Marketing ('953 IPR Ex-1038)
1065	Agnes Le Gonidec - Alenty analyzes the visibility of advertisements on the Internet September 7, 2008 ('953 IPR Ex-1039)

1066	AdExchanger - AppNexus Buys Paris-Based Viewability Firm Alenty June 4, 2014 ('953 IPR Ex-1040)
1067	Mike Shields - Ad Viewability Debate Disrupts the Marketplace June 23, 2013('953 IPR Ex-1041)
1068	Need the list of Auditors for MRC accreditation. Adops ('953 IPR Ex-1042)
1069	Moat – Moat Becomes First Company Accredited by the MRC for Mobile Viewable Impression Measurement- October 30, 2015 ('953 IPR Ex-1043)
1070	DoubleVerify - Double Verifies Earns MRC Accreditation for Suite of Programmatic Targeting Services - March 3, 2022 ('953 IPR Ex-1044)
1071	IAS - Integral Ad Science Becomes First MRC-Accredited Viewability Measure to Gain Accreditation for SIVT Detection for Desktop and Mobile Web Traffic – September 22, 2016 ('953 IPR Ex-1045)
1072	IAB - Viewability Has Arrived: What You Need To Know To See Through This Sea Change - March 31, 2014 ('953 IPR Ex-1046)
1073	C.V. of Michele Madansky, Ph.D. ('953 IPR Ex-1047)
1074	MRC Announces Changes to Accreditation Statuses of Comscore Digital Measurement Products – April 26, 2022 ('953 IPR Ex-1048)
1075	Laura Chaibi - Ad Formats: from concept to award winning - November 7-11, 2011 ('953 IPR Ex-1049)
1076	DoubleVerify - DoubleVerify Raises \$10 Million in Series B Funding - March 8, 2010 ('953 IPR Ex-1050)
1077	IAB - Internet Advertising Revenue Report Full Year 2021 Results – April 2022 ('953 IPR Ex-1051)
1078	IAB - U.S. Programmatic Ad Revenues Totaled \$10.1 Billion in 2014, According to First-Ever IAB Programmatic Revenue Report – July 20, 2015 ('953 IPR Ex-1052)
1079	IAB - 3MS Initiative Releases Five-Part Digital Marketing Measurement Solution – September 19, 2011 ('953 IPR Ex-1054)
1080	AdExchanger - A History Of Programmatic And The Era Of Control - February 9, 2018 ('953 IPR Ex-1055)
1081	MRC Viewable Ad Impression Measurement Guideline – June 30, 2014 ('953 IPR Ex-1056)
1082	Declaration of Dr. Michele Madansky (substantively the same as '953 IPR Ex-1026)

1083	The Decade of Display That Wasn't 2007 – 2017 ('953 IPR Ex-1023)
1084	File History for Appl. No. 13/731,742 (Cousin of the '482 Patent)
1085	File History for Appl. No. 12/316,781 (Cousin of the '482 Patent)

II. INTRODUCTION

Petitioner requests *inter partes* review of claims 1-14 of US Patent No. 11,741,482 (“’482 patent”) assigned to Rich Media Club LLC (“Patent Owner” or “RMC”). Patent Owner argued in related IPR2023-00935 that 1) geometric viewability tests were unknown as of the 2009 priority date; 2) the prior art thus did not enable geometric viewability tests; and 3) secondary indicia demonstrate nonobviousness. Petitioner rebutted these arguments by demonstrating 1) that the asserted art taught geometric viewability; 2) geometric viewability was well known for decades and therefore need not be disclosed in extreme detail in the asserted art; and 3) the secondary indicia lack nexus. Moreover, as discussed in detail below, the Board held that the Koeppel reference rendered obvious very similar claims in a cousin of the ’482 patent, which ultimately lead to abandonment. ’781 appl., Ex-1085, 163.

III. MANDATORY NOTICES UNDER 37 C.F.R. § 42.8(B)(1)-(4)

A. Real Parties-In-Interest

The sole real party-in-interest is Duration Media LLC.

B. Related Matters

- *Rich Media Club LLC v. Duration Media LLC*, 2-23-cv-01967 (DAZ) (Sept. 23, 2023)

- *Rich Media Club LLC v. DMG Media, Ltd. d/b/a Dailymail.com*, 2-23-cv-00388 (EDTX) (Aug. 29, 2023)
- *Duration Media LLC v. Rich Media Club LLC*, IPR2023-00953

C. Counsel

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D. Service Information

Petitioner consents to electronic service to lead and back-up counsel, as well as IPT-Docket@dentons.com.

E. Proof of Service on the Patent Owner

The attached certificate of service certifies service of a copy of this petition and its exhibits to the Patent Owner's attorney of record at the address listed in the USPTO's records pursuant to 37 C.F.R. § 42.6.

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PHILADELPHIA, PA 19103

Petitioner is also providing courtesy copies to Patent Owner's counsel from Global IP Law Group in the district court proceedings and the related IPR.

F. Power of Attorney

Powers of Attorney have been filed designating counsel pursuant to 37 C.F.R. § 42.10(b).

G. Standing

Per 37 C.F.R. § 42.104(a), Petitioner certifies that the '482 patent is available for *inter partes* review and that Petitioner is not barred or estopped from requesting *inter partes* review.

H. Fees

The undersigned authorizes the Director to charge the fees specified in 37 C.F.R. § 42.15(a)(1)-(4), and any additional fees that might be due in connection with this Petition to deposit account no. 19-3140.

IV. PRECISE RELIEF REQUESTED

Petitioner requests cancelation of claims 1-14 based on the grounds below.

V. THE '482 PATENT

A. Summary of '482 Patent Family

The '482 patent issued from US Appl. No. 17/961,952 ("the '952 appl."), filed on October 7, 2022, and is a continuation ("CON") of US Appl. No. 17/316,499 ("the '499 appl."), filed on May 10, 2021, which is a CON of US Appl. No. 12/384,403 ("the '403 appl."), filed on April 4, 2009 (now US Pat. No. 11,004,090 ("the '090 patent")) and a continuation-in-part ("CIP") of Appl. No. 12/316,781

(“’781 appl.”), filed on December 16, 2008, and a CIP of Appl. No. 11/803,779, filed on May 16, 2007.

B. Prosecution History of the ’952 Application

1. Filing and Terminal Disclaimer

RMC filed the ’952 appl. on October 7, 2022, which matured into the ’482 patent. *See* Ex-1007 for the entire prosecution history; *see also* Ex-1011, ¶¶33-35. On November 21, 2022, RMC preemptively filed a terminal disclaimer over several patents, including the ’602 great-grandparent patent, which issued from the Krassner publication (Ex-1003). Ex-1007, 279-80.

2. Examination

On December 23, 2022, the Examiner issued a non-final rejection based on double patenting, patent-ineligible subject matter, and various combinations of prior art references not at issue in this petition. *Id.*, 292-304. RMC filed a response on March 23, 2023 (*id.*, 394-422), in which RMC argued that it had already filed a terminal disclaimer. The Examiner allowed the claims on March 30, 2023, over the Patel reference because it did not disclose determining whether an ad was in view. *Id.*, 488-94. Patent Owner filed an after-final amendment on April 11, 2023 (*id.*, 592-97), and paid the issue fee on April 14, 2023. *Id.*, 600.

On June 9, 2023, RMC petitioned to withdraw the application from issue to submit an IDS citing the ’953 IPR Petition together with a boilerplate statement that

Badros did not teach the “*predefined portion*” limitations. *Id.*, 610-27 RMC requested an interview that was held on June 14, 2023, but never filed an interview summary. The Examiner filed an interview summary and second notice of allowance on June 30, 2023. *Id.*, 628-35. The ’952 appl. issued as the ’482 patent on August 29, 2023. *Id.*, 827-30.

VI. LEGAL STANDARDS

A. Person of Ordinary Skill in the Art (“POSA”)

The ’482 patent is directed to a system and method for creation, distribution and tracking of advertising via electronic networks. A POSA 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/or electrical engineering.

Patent Owner argued in the ’953 IPR that the POSA 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. Ex-1044, ¶54. Patent Owner claims this is important because it claims it was the first to invent a viewability test. Ex-1044, ¶75. However, both inventors testified that viewability prior-art tests were known. Ex-1054, 49:12-50:12; Ex-1055, 13:13-14:10. Moreover, as explained throughout this petition, viewability tests were well known.

The Patent Owner's standard is incorrect because there is no special need for a narrow use case when the invention only requires generalized knowledge that any college graduate having a computer or electrical degree is exposed to, which in this case is web development. There is no requirement for a perfect match between an expert's qualifications and the relevant field. *See Microsoft Corporation v. Royal J. O' Brien*, IPR2021-00015, Paper 32, 18 (P.T.A.B. Apr. 25, 2022) (citing *SEB S.A. v. Montgomery Ward & Co.*, 594 F.3d 1360, 1373 (Fed. Cir. 2010); Consolidated Trial Practice Guide, 34.)

B. Claim Construction

Petitioner believes that no terms need to be construed in this IPR, just as in the related the '953 IPR, but reserves the right to address any new claim construction arguments. Patent Owner does not concede that the claims satisfy pre-AIA 35 U.S.C. § 112.

VII. OVERVIEW OF THE PRIOR ART

A. US Publication No. 2007/0265923 ("Krassner")

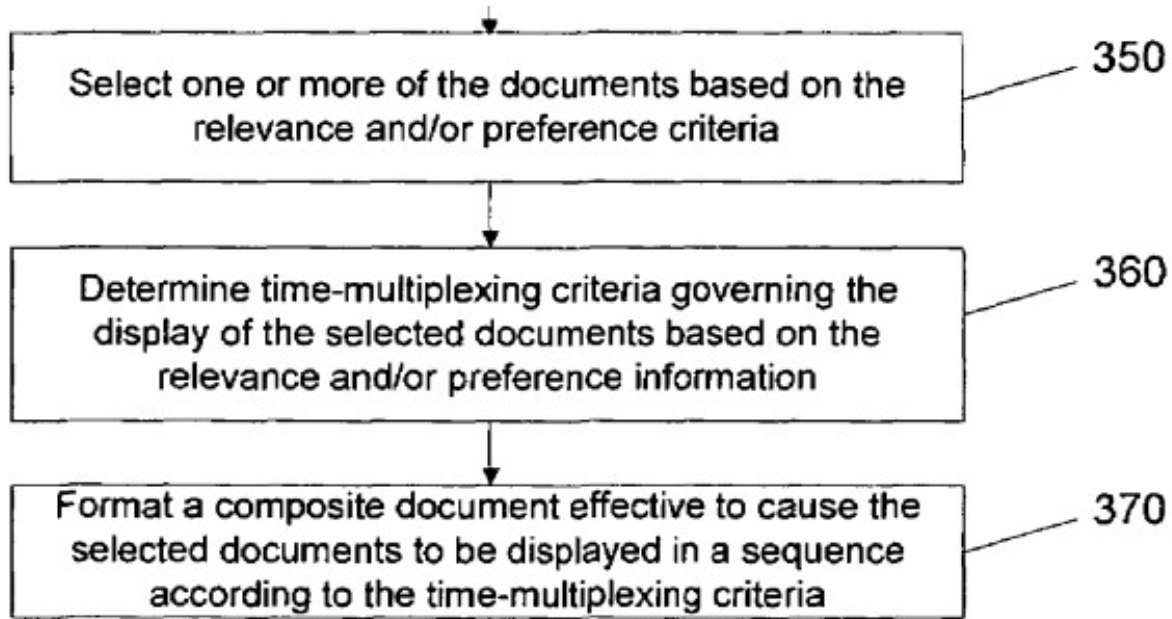
Krassner published in 2007 and is prior art under pre-AIA § 102(b). Krassner eventually issued as the '602 patent, from which the '482 patent is a continuation-in-part. RMC also filed a terminal disclaimer admitting that the '482 patent was patentably indistinct from Krassner. Ex-1007, 279-80. As explained in § VIII below, the '482 patent claims new matter and therefore does not have priority to Krassner.

Krassner teaches a system and method for creation, distribution and tracking of advertising via electronic networks, enabling creation of advertisements using licensed third-party content and placement of said ads at desired network locations, utilizing an auction of ad spaces based on bids placed by advertisers to have their ads displayed at such locations. Ex-1003, abstract; Ex-1011, ¶¶37-38. When a network user/ad viewer requests an ad by clicking or other action, an auction algorithm executes to select the ad to be displayed from those that bid for display at such ad space location and then the ad is composed and delivered to the ad space location by accessing a relational database storing commands that retrieve, assemble, and dispatch the licensed ad content. *Id.* Usage and display of licensed content on designated ad space is tracked to enable cost-per-use charging for both use of licensed content and ad display at the designated ad space. *Id.*

B. International Publication No. WO2006138400A1 (“Badros”)

Badros published in 2006 and is prior art under pre-AIA § 102(b). Badros was cited, but the teachings relevant to this IPR were not discussed by the examiner during prosecution of the '428 patent.

Badros teaches a system and method for time-multiplexing the display of a plurality of electronic documents. Ex-1005, abstract; Ex-1011, ¶¶39-40. Time-multiplexing criteria for displaying a plurality of selected documents associated with a concept on a time-multiplexed basis is determined. *Id.*

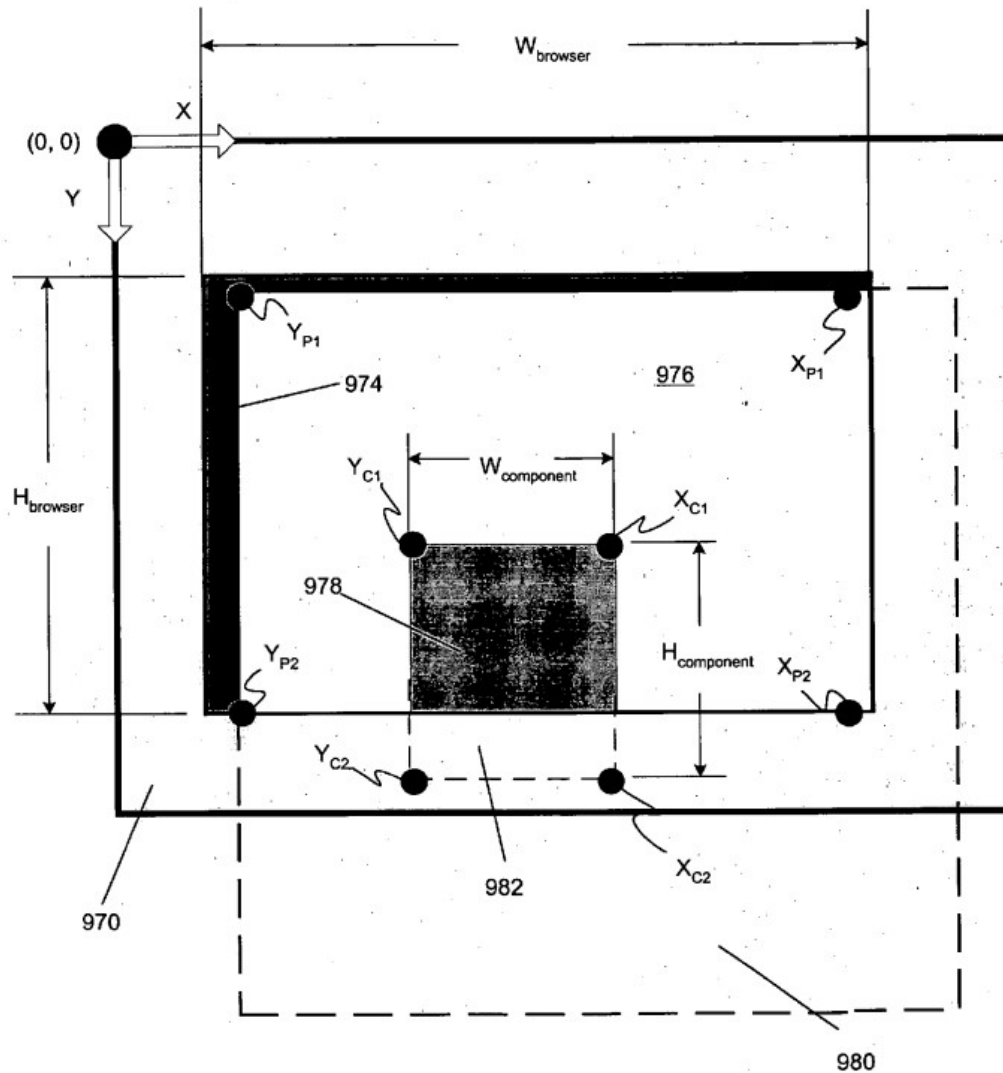


Id., FIG. 3.

The plurality of selected documents is displayed at an output device in a predetermined sequence according to the time-multiplexing criteria. *Id.* 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 a relevance to a concept and one or more preferences associated with the selected documents. *Id.*

C. US Publication No. 20050177401 (“Koeppel”)

Koeppel was published in 2005 and is prior art under pre-AIA § 102(b). Koeppel is titled, “system and method for performing Web based in-view monitoring.” It teaches a client-side script to determine the coordinates of various components of a webpage on a display and whether they are in view. Ex-1006, ¶¶85-185; Ex-1011, ¶41.



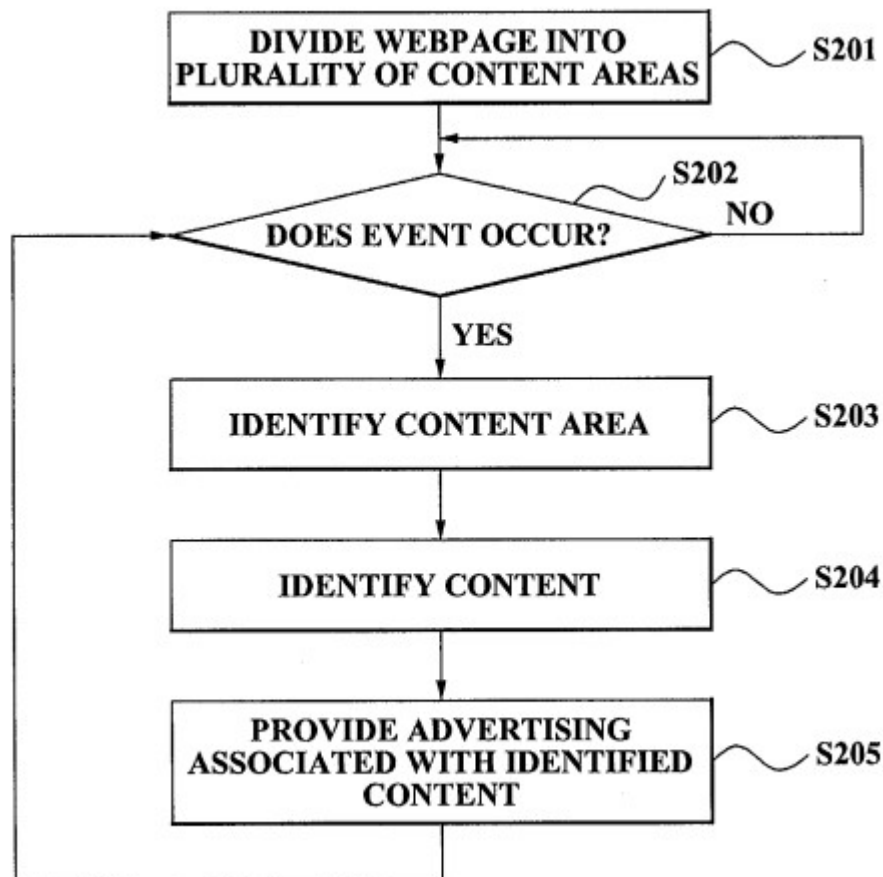
Id, FIG. 9B

FIG. 9B includes a representation of an unseen portion 980 of Web page 976, and an unseen portion 982 of target component 978. FIG. 9B also includes values W_{browser} , H_{browser} , Y_{P1} , Y_{P2} , Y_{C1} , Y_{C2} , X_{P1} , X_{P2} , X_{C1} , X_{C2} , $W_{\text{component}}$, and $H_{\text{component}}$, which will be described in further detail later. In order for the client side script to determine whether a component is in view to a user, detailed positional information is collected and stored in client side data store 160.

Id., ¶86. The target component can be an image, such as an advertisement. *Id.*, ¶18. Koeppel uses information about whether an advertisement is “in-view or partially in-view” to generate billing records. *Id.*, ¶177. Note that Koeppel (*Id.*, ¶1) incorporates by reference Koeppel ’525 (Ex-1020), which Petitioner includes for completeness of disclosure, further support for enablement, and in case it becomes more relevant later in the case.

D. International Publication No. WO2007089082A1 (“Seo”)

Seo was published in 2007 and is prior art under pre-AIA § 102(b). Seo is titled, “Method for offering advertisement in association with contents in view and system for executing the method.” It discloses identifying a user event, such as scrolling, corresponding to a content area becoming visible, and downloading an advertisement in response to the event. Ex-1018, 5:1-14; Ex-1011, ¶¶42-43.



Id., FIG. 2.

Seo determines whether a user is “currently viewing” by detecting whether an event, such as scrolling, occurs (S202), and displays an advertisement only when the content area is visible. *Id.*, 10:16-18.

VIII. THE PRIORITY DATE OF THE '482 PATENT IS APRIL 4, 2009, BECAUSE OF NEW MATTER.

A. The '482 Patent Has Priority to the '403 Appl., not the '779 Appl. (“Krassner”)

The '482 patent was filed on October 7, 2022. As mentioned above, the '482 patent is a CON of the '499 appl., which is a CON of the '403 appl. and a CIP of

the '781 appl. The '403 appl. is a CIP of the '779 appl. *Id.* Patent Owner has the burden to prove it is entitled to any earlier priority date. *See PowerOasis, Inc. v. Mobile USA, Inc.*, 522 F.3d 1299, 1303 (Fed. Cir. 2008). When a dispute arises concerning whether a CIP patent application is entitled to priority to the original application and the Patent Office has not addressed the issue, the burden of proof ordinarily rests with the party claiming priority to the date of the original application. *Id.* If an application is a CIP, the priority date of any claim depends on whether that claim relates to new matter. If so, the priority date of the claim is the filing date of the earliest application having the supporting written description. *Id.* To obtain an earlier priority date, Patent Owner would need to prove that the patent claim does not relate to new matter and was fully disclosed in the earlier application. *See id.* “Subject matter that arises for the first time in [a] CIP application does not receive the benefit of the filing date of the parent application.” *Augustine Med., Inc. v. Gaymar Indus., Inc.*, 181 F.3d 1291, 1302 (Fed. Cir. 1999)

With respect to the '482 patent, the earliest priority date that can be claimed is April 4, 2009, the filing date of the '403 appl. (the application that resulted in the '090 patent) because the '403 appl. contains new matter, specifically the description of “*predefined portion of the predefined area of the ad content display page is in the visible area*” and “*causing a communication to be sent,*” that does not appear in the '779 appl. (the application that resulted in Krassner). Ex-1011, ¶¶44-

49. Therefore, the claim limitations of the '482 patent are based on new matter. *Id.* This can be seen by comparing the content of the specification of the '403 appl. with Krassner's specification. *Id.*; Ex-1013. Certain portions of the text in the '403 appl. specification are new as compared to the text of the Krassner specification and therefore any patent claim based on the new text has the priority date of April 4, 2009, the filing date of the '403 appl. *Id.*

B. The Claimed “*Predefined Portion of the Predefined Area of the Ad Content Display Page Is in the Visible Area*” Is New Matter.

All claims expressly recite new matter. Claim 1 is representative and specifically “*predefined portion of the predefined area of the ad content display page is in the visible area*” in the following limitations:

Claim 1:

1. A method for rendering advertisement content in an ad content display page, wherein the ad content display page includes (i) a 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, the ad content display page being scrollable to allow a portion of the ad content display page to appear in a visible area of a browser window of a browser that is configured to be operated by a remote computing device, the method comprising:

(a) determining whether a predefined portion of the predefined area of the ad content display page is in the visible area of the browser window; and

(b) in response to a determination that the predefined portion of the predefined area of the ad content display page is in the visible area of the browser window, causing a communication to be sent from the remote computing device to one or more dispatcher servers, wherein the one or more dispatcher servers are configured to:

(i) receive the communication, and

(ii) cause advertisement content to be served to the remote computing device,

wherein the browser is configured to render the advertisement content in the predefined area of the ad content display page, and

wherein the advertisement content first appears in the predefined area of the ad content display page only after the one or more dispatcher servers serve the advertisement content to the remote computing device and the browser renders the advertisement content in the predefined area of the ad content display page.

The above limitation “*predefined portion of the predefined area of the ad content display page is in the visible area*” and support thereof, only arguably originated in the new matter added to the ’403 appl. See Ex-1001, 7:18-65; Ex-1011, ¶¶44-49. The parent ’403 appl. includes, for example:

In one embodiment, the invention further includes a system and method for delivering and rendering the ad content automatically and only when and/or to the extent that a pre-defined area of the ad content

display page where the content is to be rendered, ... is within the viewer's browser window dimensions and scrolling position, or within a pre-defined distance from the viewer's browser window dimensions and scrolling position. As used herein, the term “render” or “rendering” refers to the process of requesting and loading content so that it may be viewed, heard or otherwise perceived by a viewer communicating electronically using a browser.

Ex-1008, ¶20.

Krassner does not have this disclosure. Therefore, the earliest priority date the '482 patent can rely on is the filing date of the '403 appl., which is April 4, 2009. *See PowerOasis*, 522 F.3d at 1305-06 (Federal Circuit held that the asserted claims were based on new matter in the continuation-in-part patent application and therefore the asserted claims had the priority date of the CIP filing date and not any earlier filing date).

C. “The Claimed “*Causing a Communication to be Sent*” Is New Matter.

Krassner does not disclose the “*causing a communication to be sent*,” limitation, which all claims require. Like the “*predefined portion of the predefined area of the ad content display page is in the visible area*,” this limitation only arguably originated in the new matter added to the '403 parent appl. For example, the '403 parent appl. includes “communicating with said correlator code to cause

said one or more billboard modules to be activated.” Ex-1008, ¶158. Further details include:

The system software applications for creating and writing to or otherwise embedding on said designated ad content display page a correlator code to determine when said designated ad content display page triggering area is within, or within a pre-defined distance outside of, a content viewer’s browser window dimensions and scrolling position, for dynamically generating a marker for said designated ad content display page rendering area, and for communicating with said correlator code to cause said one or more billboard modules to be activated, causing such real time auction(s) to occur...

Ex-1008, ¶158. Krassner’s failure to adequately disclose “causing a communication to be sent” denotes a lack of priority. “Entitlement to a filing date does not extend subject matter which is not disclosed but would be obvious over what is expressly disclosed.” *Collaborative Agreements, LLC v. Adobe Sys. Inc.*, 2016 WL 1461487, at *6 (N.D. Cal. Apr. 14, 2016). The ’482 patent cannot rely on Krassner (the ’779 appl.) to claim an earlier priority date.

IX. THE GROUNDS DEMONSTRATE THAT THERE IS A REASONABLE LIKELIHOOD THAT THE CHALLENGED CLAIMS ARE UNPATENTABLE

The following grounds demonstrate that the claims are unpatentable:

Ground	Claim(s) Challenged	35 USC. §	Reference(s) Basis
A	1-14	103(a)	Koeppel, Seo (Optionally Krassner)

B	6 and 13	103(a)	Koeppel, Seo, Badros (Optionally Krassner)
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A. Koeppel in View of Seo and Optionally Krassner Renders Obvious Claims 1-14

1. Rationale to Combine Koeppel and Seo

Koeppel and Seo are both directed to a system of determining whether an online advertisement is in view. Ex-1006, abstract; Ex-1018, abstract; Ex-1011, ¶51. Seo further teaches that it would be beneficial to only download advertisements “associated with a content that the user is currently viewing.” Ex-1018, 2:9-11. The combination of known elements of Koeppel and Seo would achieve the predictable result of downloading an advertisement in response to a predefined area, or portion thereof, appearing in the visible area of a display. This would be an obvious solution to try given the fact that both Koeppel and Seo teach downloading advertisements. Ex-1006, abstract; Ex-1018, 5:1-14, 10:16-18.

1. Rationale to add Krassner to the Combination of Koeppel and Seo

Koeppel, Seo, and Krassner are directed to different ways to monetize online ad revenue. Ex-1006, abstract; Ex-1018, abstract; and Ex-1011, ¶57. Krassner provides additional support that it was conventional to have webpages request advertisements. Ex-1003, ¶¶96, 112. Krassner discloses that monetizing ad space using auctions is one way to “optimize benefits.” *Id.*, ¶13. Using Krassner’s auction to identify an ad buyer is simply using a known technique to improve the

combination of Koeppel and Seo to use a similar ad monetization method.

Moreover, Koeppel teaches that it was known to use third-party ad distribution services: “The content in the Web page may be provided by third party entities that pay predetermined fees to have the Web server render their content in a Web page.” Ex-1006, abstract. Therefore, it would have been obvious to use Krassner’s auction to choose ads to display using the method taught by the combination of Koeppel and Seo.

2. Detailed Explanation

- a. Claims 1 and 8: A method for rendering advertisement content in an ad content display page, wherein the ad content display page includes (i) a 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, the ad content display page being scrollable to allow a portion of the ad content display page to appear in a visible area of a browser window of a browser that is configured to be operated by a remote computing device:*

Koeppel discloses “*a method for rendering advertisement content in an ad content display page*” (e.g., “The content in the Web page may be provided by third party entities that pay predetermined fees to have the Web server render their content in a Web page.” Ex-1006, abstract) “*wherein the ad content display page includes (i) a predefined area configured to display advertisement content the predefined area being a portion of the ad content display page*” (e.g., “Window 974 includes a

Web-page 976 and a target component 978, which is located on Web page 976. Target component 978 may be associated with a number of different types of Web-page content” *Id.*, ¶85) “(ii) *page content displayed in other portions of the ad content display page, the page content being separate from the advertisement content*” (e.g., “FIGS. 4A-4C show Web page rendering examples of alternate versions of content representing credit card offers from a financial institution.” *Id.*, ¶61, FIGS. 4A-4C. These images show the well-known idea that webpages include both content and advertisements, which Koepfel sometimes refers to a “target components.”) “*the ad content display page being scrollable to allow a portion of the ad content display page to appear in a visible area of a browser window of a browser that is configured to be operated by a remote computing device*” (e.g., “A plurality of user browsing activities affect how the client side script, or Web server 110, determines whether a target component is actually viewable by a user. The activities may include, but are not limited to, scrolling and resizing browser windows.” *Id.*, ¶84).

b. the method comprising: (a) determining whether a predefined portion of the predefined area of the ad content display page is in the visible area of the browser window; and

Koepfel discloses,

in accordance with an aspect of the invention, Web server 110 recognizes when third party content was included in the rendered Web

page and in response to this determination performs additional in-view analysis specifically for the third party content. This analysis includes determining the in-view characteristics of each third party content (Step S.820). That is, analytical program 115 may determine the number of times each third party content was in-view or partially in-view on each rendering of the Web page. Utilizing the results of the in-view analysis performed by analytical program 115, billing program 113 generates a billing record associated with each third party entity 180 (Step S.830).

Ex-1006, ¶177, *see also*, ¶¶85-185 (discussing a client-side algorithm using coordinates to determine whether a target component “*is in the visible area of the browser window.*”).

c. (b) in response to a determination that the predefined portion of the predefined area of the ad content display page is in the visible area of the browser window, causing a communication to be sent from the remote computing device to one or more dispatcher servers, wherein the one or more dispatcher servers are configured to:

(i) receive the communication, and

(ii) cause advertisement content to be served to the remote computing device,

Firstly, this “*in response to*” limitation is non-limiting because it requires a condition precedent that need not ever occur. *See* MPEP § 2111.04 (II) and *Ex parte Schulhauser*, Appeal 2013-007847, 2016 WL 6277792 (Apr. 28, 2016) (precedential); *see also Ex Parte Botman*, Appeal 2021-004052, 2022 WL 4093710

(Sept. 2, 2022); *Ex Parte Gopalan*, Appeal 2017-007009, 2018 WL 2386111 (May 21, 2018); *Ex Parte Erhart*, Appeal 2019-004505, 2021 WL 195811 (Jan. 8, 2021). Therefore, a prior art reference need not disclose this optional limitation to render the claim obvious. *See also* Ex-1011, ¶¶51-56.

Koeppel nonetheless discloses performing an action “*in response to a determination that the predefined portion of the predefined area of the ad content display page is in the visible area of the browser window*”:

[I]n accordance with an aspect of the invention, Web server 110 recognizes when third party content was included in the rendered Web page and in response to this determination performs additional in-view analysis specifically for the third party content. This analysis includes determining the in-view characteristics of each third party content (Step S.820). That is, analytical program 115 may determine the number of times each third party content was in-view or partially in-view on each rendering of the Web page. Utilizing the results of the in-view analysis performed by analytical program 115, billing program 113 generates a billing record associated with each third party entity 180 (Step S.830).

Ex-1006, ¶177. Koeppel explains that the client notifies the server when “user events” occur, including “whether content is actually in-view.” *Id.*, ¶82. Koeppel also teaches “determining the proportion of a component in view.” *Id.*, ¶125 *et seq.*

Koeppel, however, does not disclose “*in response to a determination that the predefined portion of the predefined area of the ad content display page is in the visible area of the browser window ... cause advertisement content to be served to the remote computing device.*” Seo discloses this limitation:

FIG. 2 is a flowchart illustrating a method of providing advertising associated with a content in a visible area using an event according to an exemplary embodiment of the present invention.

In operation S201, a system for providing advertising associated with a content in a visible area divides a webpage into a plurality of content areas using a predetermined area division scheme. In this instance, the area division scheme may include a scheme of dividing the webpage into the plurality of content areas using a program code which is divided into content units to constitute the webpage. Also, the area division scheme may include a scheme of dividing the webpage into the plurality of content areas using a blog bulletin board.

In operation S202, the system identifies whether the event occurs. When the event occurs, the system performs operation S203, otherwise, the system waits for the event to occur. In this instance, the event may include a user enter event or a scrolling event. [...]

In operation S205, the system provides advertising associated with the identified content. In this instance, the system selects any one of a skyscraper type advertising and a fixed type advertising

depending upon a scrolling event, and provides the advertising in the selected type.

Ex-1018, 5:1-14, 10:16-18 (“[I]t is possible to provide advertising associated with a content that a user is currently viewing, and thereby fit an advertiser’s intention to provide advertising associated with the content that the user is interested in.”), and FIG. 2. Therefore, Seo teaches waiting “*the predefined portion of the predefined area of the ad content display page is in the visible area of the browser window*” until it causes “*a communication to be sent from the remote computing device to one or more dispatcher servers.*” Koepfel also explains the well-known fact that advertisements are delivered to browsers because a server “*receive[d] a communication*” from the browser.

A billing account may describe how a third party entity 180 may be charged for particular renderings of third party content within a Web page served by Web server 110. Utilizing the detailed features of the in-view analysis described previously, Web server 110 may diversify its third party content fees based on whether particular content was actually viewable by a user browsing the Web page served by Web server 110. For instance, Web server 110 may charge a third party entity 180 a certain fee only when an in-view analysis of the user response data indicates that the third party entity’s content was actually viewable to a user. This fee may be altered based on whether the third party content was fully in-view or partially in-view.

Ex-1006, ¶172; Ex-1011, ¶¶51-56.

Optionally, if neither Koeppel nor Seo discloses,

causing a communication to be sent from the remote computing device to one or more dispatcher servers, wherein the one or more dispatcher servers are configured to:

(i) receive the communication, and

(ii) cause advertisement content to be served to the remote computing device,

Krassner discloses an “an ad billboard module [that] causes the website or other location to communicate with the dispatcher server to execute a real-time auction to select the ad to be displayed, and then retrieve the stored ad” Ex. 1003, ¶¶98, 112 (“When the website page is requested, the billboard module communicates with the dispatcher server and an advertiser's ad is selected and rendered in the billboard module space on the designated page.”).

d. wherein the advertisement content first appears in the predefined area of the ad content display page only after the one or more dispatcher servers serve the advertisement content to the remote computing device and the browser renders the advertisement content in the predefined area of the ad content display page.

Seo discloses, “A webpage 701 may display advertising associated with a content, which a user is interested in, by identifying a content of a content area where a user enter event 702 occurs, and changing fixed type advertising 703 into another fixed type advertising 704 associated with the content.” Ex-1018, 7:5-9.

Render is a computing term that means display so that content may be viewed. Ex-1001, 7:27-31.

RMC argued in a response during prosecution that “the advertisement content to be placed in the predefined area and rendered by the browser only after the predefined portion ... of the predefined area is in the visible area of the browser window.” Ex-1007, 414 (emphasis original). The Seo disclosure above states explicitly that that a “user event,” such as scrolling, can cause “changing fixed type advertising 703 into another fixed type advertising” Ex-1018, 7:5-9. “Also, the step of identifying the visible area may include the step of: identifying a content area, occupying a largest proportion of content area among the plurality of content areas, as the visible area, the plurality of content areas being outputted according to a scrolling event *after* the scrolling event occurs.” *Id.*, 3:15-18; *see also*, FIGS. 5, 11, 6:16-19, 9:2-7. This disclosure is clearer than what RMC quoted as support for the claimed limitation. Ex-1007, 413-14.

Koeppel also explains that the client notifies the server when “user events” occur, including “whether content is actually in-view.” *Id.*, ¶82. Koeppel also teaches “determining the proportion of a component in view.” *Id.*, ¶125 *et seq.* Therefore, the combination of Koeppel and Seo would produce the predictable result of outputting an advertisement after an event, such as determining a portion of the ad space is in view.

e. Claims 2 and 9: The method of claim 1 wherein after the one or more dispatcher servers receive the communication, the one or more dispatcher servers further:

(iii) cause advertisement content to be selected for display on the ad content display page, wherein the selected advertisement content is then served to the remote computing device

Seo discloses, “A webpage 701 may display advertising associated with a content, which a user is interested in, by identifying a content of a content area where a user enter event 702 occurs, and changing fixed type advertising 703 into another fixed type advertising 704 associated with the content.” Ex-1018, 7:5-9. Render is a computing term that means display so that content may be viewed. Ex-1001, 7:27-31.

f. Claims 3 and 10: The method of claim 2 wherein the advertisement content is selected at least partially as a result of an auction.

Krassner discloses “*the method of claim 2 wherein the advertisement content is selected at least partially as a result of an auction*” (e.g., “The present invention is a system and method for creating electronic advertisements [...], whereby the ad to be displayed at a particular network location is selected from a group of ads that reference the same keyword or category and network location via an auction when the display location is acted upon by a network user/ad viewer.” Ex-1003, ¶13).

g. Claims 4 and 11: The method of claim 3 wherein the auction is conducted in real time between the time the

communication is sent from the remote computing device and the time that the advertisement content is selected.

Krassner discloses “*the method of claim 3 wherein the auction is conducted in real time between the time the communication is sent from the remote computing device and the time that the advertisement content is selected*” (e.g., “The 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” *Id.*, ¶15; “The billboard module can contain instructions, including ad space size location and keywords associated with the ad space and may display more than one ad simultaneously or rotate different advertising in the same ad space.” *Id.*, ¶17; “This ‘billboard module’ [...] provides instructions to render the advertising in the module” *Id.*, ¶14).

h. Claims 5 and 12: The method of claim 1 wherein the predefined portion is 90%.

Koeppel discloses “*the method of claim 1 wherein the predefined portion is 90%*” (e.g., “client side script may utilize the coordinate information to determine the proportion of viewable components in relation to the web page 976. ... [I]f it is determined that a portion of component is not in view, the appropriate coordinate side would have a proportion calculation performed against it [*i.e.*, functions (9)-(12)], to generate an in view percentage characteristic.” Ex-1006, ¶¶125-152).

Koeppel does not disclose precisely 90%, a person of ordinary skill in the art

would have understood that Koeppel's proportion/percentage could be any value between 0-100%. *See* MPEP § 2131.03.

i. Claims 6 and 13: The method of claim 1 further comprising:

(c) maintaining the same advertisement content that was previously rendered in the predefined area for at least a predefined period of time during the time period that the predefined portion of the predefined area of the ad content display page is in the visible area of the browser window.

Koeppel discloses determining the amount of time that an advertisement is 100% viewable or partially viewable. *Id.*, ¶78. Koeppel defines determining how long an advertisement is viewable as rendering time. *Id.*, ¶159. Koeppel inherently teaches that the advertisement will be rendered for at least a predefined period of time because it maintains the ad in the predefined area for the entire time it is viewable.

j. Claims 7 and 14: The method of claim 1 wherein the determination that the predefined portion of the predefined area of the ad content display page is in the visible area of the browser window occurs periodically.

Koeppel discloses, "The analysis performed by analytical program 115 may be performed periodically based upon predetermined conditions set by Web server 110. These conditions may include, but are not limited to, a predetermined clock cycle time and the data store 120 reaching a maximum data threshold." *Id.*, ¶161.

Koeppel and Seo, and Optionally Krassner, further in View of Badros
Renders Obvious Claims 6 and 13.

**B. Koeppel and Seo, and Optionally Krassner, further in View of
Badros Renders Obvious Claims 6 and 13**

1. Rationale to Combine

Koeppel, Seo, Krassner, and Badros are from the same field of art, *i.e.*, online advertising. Ex-1006, abstract; Ex-1018, abstract; Ex-1005, abstract; Ex-1003, abstract; and Ex-1011, ¶57. Koeppel is a parent application to the '329 patent, and it relates to the system and method for creation, distribution and tracking of advertising via electronic networks. Ex-1003, abstract. Koeppel also teaches charging fees for advertisements that “may be altered based on whether the third party content was fully in-view or partially in-view.” Ex-1006, ¶172. Similarly, Badros teaches a system and method for time-multiplexing the display of a plurality of electronic documents. Ex-1005, abstract; Ex-1011, ¶¶39-40. The plurality of selected documents is displayed at an output device in a predetermined sequence according to the time-multiplexing criteria. *Id.* An advertisement is an electronic document available for viewing in a portion of a display. It 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. As Badros explains, “one advantage of time-multiplexing the display of documents is that more than one document can be output to users.” Ex-1005, ¶¶17, 69. In

embodiments related to webpage advertisements, more than one advertisement may be displayed in a single ad space of a single webpage. Ex-1005, 3:15-17. Accordingly, the POSA would have been motivated to take advantage of Badros' teaching by modifying Krassner to display multiple advertisements instead of just one.

2. Detailed Explanation

a. Claims 6 and 13: The method of claim 1 further comprising:

(c) maintaining the same advertisement content that was previously rendered in the predefined area for at least a predefined period of time during the time period that the predefined portion of the predefined area of the ad content display page is in the visible area of the browser window.

The combination of Koeppel, Seo, and optionally Krassner, teaches claims 6 and 13. *See* § IX.A above. In case the Board believes that the combination does not teach the limitation, Badros also teaches determining whether “*the ad content display page is in the visible area.*”

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).

Ex-1005, ¶69. Badros also teaches maintaining the same ad “*in the predefined area for at least a predefined period of time.*” *Id.*, ¶70 (“impression module may keep track of the amount of time that each document is actually output on a user's computer monitor 10.”); *see also*, ¶141 (“Each document 1 a-1 c may be displayed for the same or a different amount of time.”).

X. THE BOARD SHOULD NOT EXERCISE ITS DISCRETION TO DENY INSTITUTION 35 USC. § 314(A)

A. Whether a Stay Exists or Is Likely to be Granted If a Proceeding Is Instituted

Petitioner will file a motion to stay either before or after institution. Judge Roslyn O. Silver is hearing the district court case in Arizona. She has held three patent trials. Ex-1014. Her longest case lasted over 4 years and 5 months before a decision on validity and enforceability. *Id.* The Arizona court has a history of granting most stays, particularly when a proceeding is instituted. Ex-1016. There is no indication that the court would not stay the case. This factor weighs heavily towards institution.

B. Proximity of the Court's Trial Date to the Board's Projected Statutory Deadline

There is currently no trial date scheduled. Jury trials in Arizona generally take almost 3 years. Ex-1015. This factor weighs heavily toward institution.

C. Investment in the Parallel Proceeding by the Court and Parties

The district court case is moving slowly. It was filed on September 19, 2023. There is no schedule for a *Markman* hearing. Accordingly, this factor weighs toward institution.

D. Overlap Between Issues Raised in the Parallel Proceeding

The district court is not currently considering any disputes relevant to this proceeding. Given the average length of trial and the likelihood of a stay, the full IPR estoppel will be in effect should the Patent Owner succeed in this IPR. Accordingly, this factor weighs toward institution.

E. Whether the Petitioner and the Defendant in the Parallel Proceeding Are the Same Party

The parties are the same in this proceeding and the district court case.

F. Other Circumstances that Impact the Board's Exercise of Discretion

Further, the grounds above present “compelling merits” for institution. *CommScope Techs. LLC v. Dali Wireless, Inc.*, IPR2022-01242, Paper 23 (P.T.A.B. Feb. 27, 2023) (precedential). For example, the first ground relies on a grandparent of the '482 patent in combination with prior art showing that determining whether a predefined portion of the predefined area of the ad content display page is in the visible area was known, as was causing a communication to be sent from the remote

computing device to one or more dispatcher servers. The grounds in this petition are compelling at least for this reason. The Arizona district court is an uncommon jurisdiction for patent cases and is slow compared to courts that hear more patent infringement cases. The Arizona court and the parties would benefit from the Board's guidance on claim construction and other issues, as the Board, with its substantial experience, can address these complicated issues accurately, efficiently, justly, and inexpensively. 37 C.F.R. § 41.1.

Petitioner reserves the right to request a reply to any discretionary denial arguments made in the preliminary response.

XI. THE PROPOSED GROUNDS ARE NOT SUBSTANTIALLY THE SAME AS PREVIOUSLY CONSIDERED ART OR ARGUMENTS

A. Factors (a), (b) and (d): “(a) the similarities and material differences between the Asserted Art and the prior art involved during examination; (b) the cumulative nature of the Asserted Art and the prior art evaluated during examination; (d) the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art.”

RMC cited Koeppel in an IDS, but the examiner and the Patent Owner never discussed Koeppel on the record. Ex-1007, 238. There is also no overlap between the art considered on the record and Koeppel. To the extent that factor 1 is met, the examiner erred in a material manner by failing to reject the claims based on Koeppel, as discussed further below.

RMC also submitted Badros in a post-allowance IDS, along with the history of the '953 IPR. *Id.*, 616. The only on-the-record statement is from the examiner in an interview summary that did not expressly address Badros. *Id.*, 635. RMC never filed the required interview summary. 37 C.F.R. § 1.133.

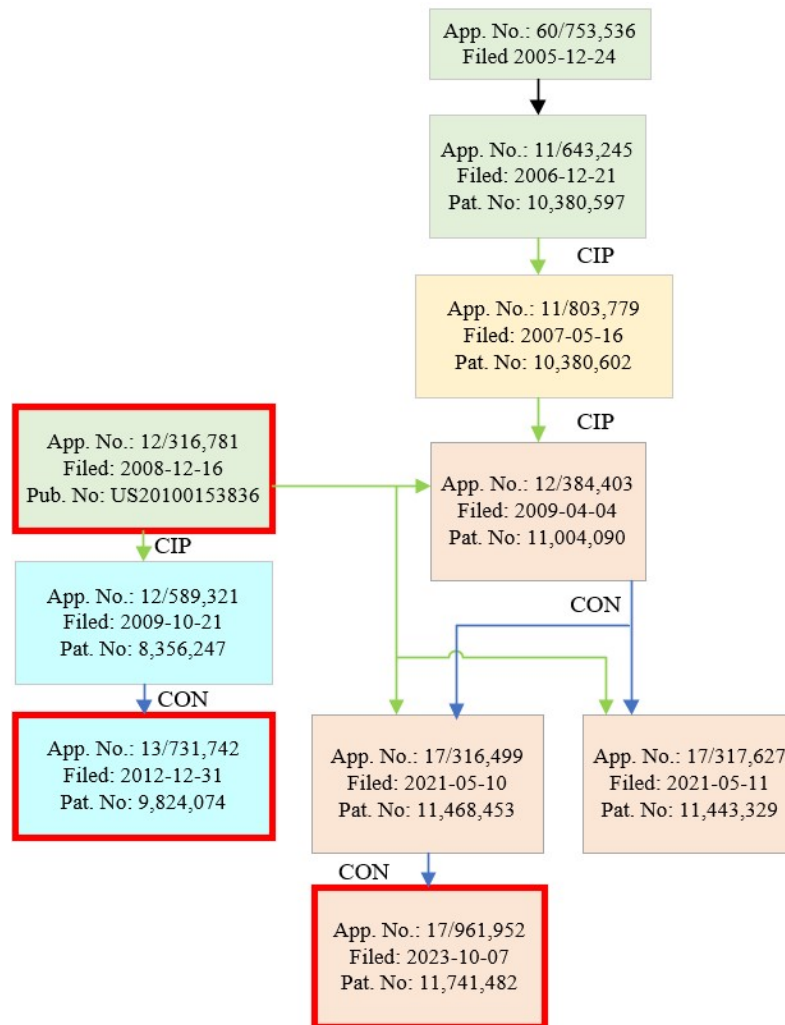
B. Factors (c), (e), and (f): “(c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection; (e) whether petitioner has pointed out sufficiently how the examiner erred in its evaluation of the asserted prior art; (f) the extent to which additional evidence and facts presented in this petition warrant reconsideration of the prior art or arguments.”

The examiner gave general reasons for allowance, stating that the prior art did not teach all the claimed limitations. Ex-1007, 493. Patent Owner argued that the primary reference from the office action did not teach determining whether “*the ad content display page is in the visible area.*” *Id.*, 419 (3/23/23 response, 26). Koeppel undeniably teaches this limitation. *See* § **Error! Reference source not found.** Therefore, Koeppel is different from the prior art the examiner discussed on the record and demonstrates that the examiner materially erred in failing to address Koeppel’s teachings of what was allegedly missing from the prior art discussed. Accordingly, Petitioner asks the Board to institute review because § 325(d) does not apply given these facts. *Keysight Technologies, Inc. v. Centripetal Networks, Inc.*, IPR2022-01421, Paper 14, 8 (P.T.A.B. Aug. 24, 2023) (Director reversing denial of institution when examiner erred by not addressing art cited in

an IDS); *see also Oticon Medical AB v. Cochlear Limited*, IPR2019-00975, Paper 15, 19-20 (October 16, 2019) (most references were of record during prosecution but not considered) (precedential); and *Parse Biosciences, Inc. v. 10x Genomics, Inc.*, IPR2023-00876, Paper 7, 16 (P.T.A.B. Oct. 13, 2023) (instituting review because the examiner did not consider the relevant teachings, despite prior art having been discussed on the record). Furthermore, neither the examiner nor RMC addressed Koeppel on the record. Therefore, the examiner made an error in failing to consider Koeppel.

Finally, the examiner never expressly considered the references nor the grounds presented in this petition. Therefore, Petitioner asks the Board to find that the Koeppel-based grounds present a reasonable likelihood of prevailing because they teach the limitation requiring rendering the advertisement “*only after*” the predefined area or portion thereof is visible, and Seo was never before the examiner.

Koeppel was discussed in two related cases highlighted in the patent family charted below:



1. Prosecution history of appl. no. 12/316,781 supports that an error was made.

The Board found that Koeppel taught remarkably similar claim limitations in a grandparent of the '482 patent, *i.e.*, the '781 appl. Ex-1085, 163. Below are the relevant claim limitations:

'781 appl. (claims 23, 75, and 80)	'482 patent (claim 1)
<i>determining ... whether a pre-defined area of a content page is ... at least partially within a visible area of an application window on a display device</i>	<i>(a) determining whether a predefined portion of the predefined area of the ad content display page is in the visible area of the browser window</i>

Id. The Board held, “Koeppel teaches monitoring what is ‘in view’ during a user session and then using that information for updating Web pages for future user sessions.” *Id.*, 165. The Board ultimately reversed the rejection of claim 23 (but affirmed the rejections of claims 75 and 80) because Koeppel did not disclose the claim limitation below, which is like another limitation in the ’482 patent *Id.*, 165, 169.

’781 appl. (claim 23)	’482 patent (claim 1)
<i>causing an advertisement to be rendered in the pre-defined area of the content page in response to determining that the pre-defined area is ... at least partially in the visible area of the application window</i>	<i>(b) in response to a determination that the predefined portion of the predefined area of the ad content display page is in the visible area of the browser window, ... the browser is configured to render the advertisement content in the predefined area of the ad content display page,</i>

On remand, the examiner rejected claim 23 as obvious over US Patent No. 6,983,331 (the “331 patent”) in view of Koeppel. *Id.*, 109. RMC amended claim 75 to including similar rendering limitations and canceled claim 80. *Id.*, 57-60. The examiner maintained the rejection after a response to the non-final, and the applicant abandoned the application after the final action. *Id.* 1, 3, 41.

Claim 1 of the ’482 application has a similar claim limitation, which the examiner rejected based on the ’331 patent, and Petitioner relies on Seo for this limitation. Therefore, an examiner and the Board have already determined that

Koeppel teaches what RMC calls a “viewability test,” and it was error to not apply Koeppel to the ’482 patent.

2. Prosecution history of appl. no. 13/731,742 (“the ’742 appl.”) supports that an error was made.

Yet another examiner considered Koeppel in a distant relative of the ’482 patent, *i.e.*, the ’742 appl. Ex-1084. The ’742 appl., which issued as US Patent No. 9,842,074, contained an extensive discussion of Koeppel, including admissions by RMC.

The examiner relied on Koeppel as a secondary reference late in prosecution of the ’742 appl., which included limitations reciting, “*determine whether the pre-defined area of the content page in which content is to be rendered is within at least a portion of a visible area of a viewer’s browser window.*” Ex-1084, 71. *Id.*

The examiner rejected the claims three times, and each time RMC made admissions such as, “[While] the cited portions of Koeppel [¶¶84-85] may disclose monitoring in-view features of a web page, they do not disclose [the completely outside limitation].” *Id.* 89; *see also*, 155, 388. RMC finally overcame Koeppel by amending the claim to require determining whether the “*pre-defined area ... is completely outside of the visible area of the browser window and is also within a pre-defined distance outside of the visible area.*” (emphasis added). The claims of the ’482 patent do not include this limitation and are substantially similar to those thrice rejected during prosecution of the ’742 appl. Therefore, Patent Owner

surrendered the claims of the '482 patent and improperly recaptured them with a different examiner who erred by not following the course of the examiner in the '742 application.

XII. SECONDARY INDICIA

The Board must properly consider all evidence of secondary indicia when determining whether a summation of the evidence overcomes the findings of obviousness. *Volvo Penta of the Americas v. Brunswick Corp.*, 81 F. 4th 1202, 1215 (Fed. Cir. 2023). When properly considered, the Patent Owner's and Petitioner's evidence demonstrates that the secondary indicia are insufficient to overcome the strong showing of obviousness. *See Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) and *Pfizer, Inc. v. Apotex, Inc.*, 480 F.3d 1348, 1372 (Fed. Cir. 2007).

Patent Owner and Petitioner submitted dozens of exhibits in the '329 IPR related to the various secondary indicia factors, most or all of which are included in this IPR. While this IPR does not address each exhibit in detail, it does address each factor and the experts considered all evidence when rendering their opinions. Petitioner included all exhibits in this IPR for completeness of the record, even though several exhibits, *i.e.*, Exs-1021-38, Ex-1041, Ex-1043, Exs-1045-56, Ex-1060, Ex-1073, and Ex-1076, were not discussed, but the experts considered them when rendering their opinions.

A. Long-Felt Need, Failure by Others, Skepticism, and Commercial Praise

The Petition demonstrates that RMC was not the first to meet any so-called “long-felt need.” *Newell Cos. v. Kenney Mfg. Co.*, 864 F.2d 757, 768 (Fed. Cir. 1988) (“once another supplied the key element, there was no long-felt need or, indeed, a problem to be solved.”). Furthermore, “A nexus may not exist where, for example, the merits of the claimed invention were ‘readily available in the prior art.’” *ClassCo, Inc. v. Apple, Inc.*, 838 F.3d 1214, 1220 (Fed. Cir. 2016). “[T]he identified objective indicia must be directed to what was not known in the prior art.” *Henny Penny Corp. v. Frymaster LLC*, 938 F.3d 1324, 1333 (Fed. Cir. 2019). “If commercial success is due to an element in the prior art, no nexus exists.” *Tokai Corp. v. Easton Enters., Inc.*, 632 F.3d 1358, 1369 (Fed. Cir. 2011). The ’482 patent discloses nothing new.

Patent Owner’s so-called “viewability test” was well known for at least a decade prior to the 2009 priority date. *See, e.g.*, Ex-1057 (“Himmel,” titled “Method and apparatus for detecting actual viewing of electronic advertisements,” priority 1998); Ex-1006 (“Koeppel,” titled “System and method for performing Web based in-view monitoring,” priority 2000); Ex-1058, ¶63 (“Sandige,” “To provide greater accuracy in advertising metrics, may supplement the existing server-based web-page advertisement metrics and tracking with detailed accurate client viewability information.” priority 2007); Ex-1002, abstract (“Callaghan,”

“Embodiments are configured to provide browsing and other functionality that can be used to provide viewable data based in part on a current viewable space of a browser interface”).¹ Indeed, one prior art publication describes “time visible” as “common metric” for advertising in 2005. US Pub. No. 20060155615 (“Loo”). Ex-1059, ¶4.

Alenty was a company that had a prior-art viewability product on the market. Ex-1064 (distinguishing page views from determining whether “content is visible”); Ex-1065 (“Alenty offers a technology to measure the actual visibility of online banner ads”); Ex-1066 (Alenty was “the first company to measure in-view impressions.”). Ex-1082, ¶11.

The online advertising industry had not completely shifted from a served or pay-per-click standard to a viewed standard at the effective filing date because other standards were extremely lucrative at that time. Ad sellers had incentive to

¹ RMC filed a rule 1.131 declaration in appl. no. 13/731,742 that the Office accepted to swear-behind Callaghan. Callaghan still supports the idea that viewability tests were well known and enabled in the 2008-2009 period. Petitioner also disputes that the declaration sufficiently demonstrated a reduction to practice of the claims of the ’482 patent or any other patent.

maintain the status quo. There was also no motivation to switch to a viewability standard until programmatic advertising was more prevalent. Ex-1082, ¶¶29-35.

As explained above, combinations of Koeppel, Seo, Krassner, and Badros (in addition to many other prior art references) taught and enabled viewability tests. Ex-1082, ¶¶10-21. There was no long-felt need; indeed, there was no need because most advertising at that time went to traditional entities, such as the New York Times, and not distributed programmatically around the Internet like it is today. Ex-1082, ¶¶29-35. Moreover, viewability was not important until the industry shifted from more traditional media outlets to programmatic ad serving on smaller websites, known as the long tail. *Id.*

Patent Owner cannot demonstrate a nexus between any alleged “commercial praise” of its ad service and the claimed invention. Any statements by MRC relating to software that provided viewability determinations were self-serving statements to promote MRC’s expensive accreditation process and RealVu’s ad service. The prior art demonstrates that ad sellers knew that viewability tests were possible, but they had no motivation to change. The alleged praise does not have a nexus to the claims of the ’482 patent because 1) they were in the prior art; and 2) the praise could have been the result of RealVu’s early request for certification, not that it wasn’t known.

B. Commercial Success, Licensing, and Copying

1. Copying

Duration was a licensee of RMC between 2018-2020. Despite that relationship, Duration did not engage in any copying of any software code from RMC. Duration could not copy RMC's confidential back-end source code because it never had access to it. Ex-1054, 15:14-21; Ex-1017, 2. RMC provided a public tag that Duration could insert into webpages. Ex-1054, 11:12-12:14; Ex-1017, 2. The tag allowed communications with RMC's confidential backend source code and returned machine-generated code for providing advertisements but did not allow review of the confidential backend source code. Ex-1001, 7:65-9:40. Patent Owner cannot present any evidence of Duration having tried and failed or otherwise needing to copy RMC's confidential backend source code implementing well-known functionality. Indeed, any similarities between RMC's and Duration's products is because viewability tests were well known for more than 20 years prior to Duration releasing its product. *See, e.g.*, Ex-1057; Ex-1011, ¶¶50, 58.

Duration intentionally avoided copying RMC's product. Ex-1017, 3. Duration maintained separate engineers who never interacted with RMC to design a new system for which Duration received its own patents. *Id.* Even if Duration did copy, which it did not, "more than the mere fact of copying by an accused infringer is needed to make that action significant to a determination of the obviousness issue." *Cable Elec. Prods., Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1028 (Fed. Cir.

1985). “[C]opying is only equivocal evidence of non-obviousness in the absence of more compelling objective indicia of other secondary considerations.” *Ecolochem, Inc. v. S. Cal. Edison Co.*, 227 F.3d 1361, 1380 (Fed. Cir. 2000); *see also*, *Vandenberg v. Dairy Equip. Co.*, 740 F.2d 1560, 1567 (Fed. Cir. 1984).

Because Petitioner never had access to nonpublic information of Patent Owner to copy, there can be no copying. *See, L’Oréal USA, Inc. v. Liqwd, Inc.*, PGR2017-00012, Paper 120, 9-11 (P.T.A.B. December 9, 2020). Also, any allegedly copied features are prevalent in the prior art. Ex-1082, ¶¶10-28.

2. Licensing and Commercial Success

Patent Owner cannot demonstrate a nexus between any commercial success and the claimed invention because the claimed invention was well known but had not yet fully replaced the served-impression standard as of the effective filing date. The various combinations of Koepfel, Seo, Krassner, and Badros teach all claim limitations; thus, the licensed technology was known.

Objective evidence like that submitted in the ’953 IPR is entitled little weight and generally has no bearing on the legal issue of obviousness. *See In re Vamco Machine & Tool, Inc.*, 752 F.2d 1564, 1577 (Fed. Cir. 1985). Patent Owner must show that the claimed invention captured a substantial share of the marketplace, which it will be unable to show because Patent Owner’s services represent only a small fraction of the marketplace. *In re Huang*, 100 F.3d 135, 140

(Fed. Cir. 1996) (“[E]vidence related solely to the number of units sold provides a very weak showing of commercial success, if any.”). Ex-1082, ¶¶29-35.

C. Industry Praise

Any evidence of “industry praise” relating to Patent Owner’s services is nothing more than a set of self-serving statements from organizations promoting their services and standards. First, RealVu self-published a statement quoting George Ivie, CEO of MRC, stating that RealVu was the first to seek accreditation, implying that others should also seek accreditation. Ex-2057. The exhibit does not demonstrate that viewability was unknown, only that no one saw a need to pursue the burdensome and expensive accreditation process. Ex-1082, ¶¶29-34, 36-39, 40-42. Second, Ex-2035 is a second instance of Mr. Ivie, CEO of MRC, promoting the fact that RealVu purchased its accreditation services, so Mr. Ivie was self-interested in promoting his accreditation services.

XIII. CONCLUSION

For the reasons given above, Petitioners request institution of *inter partes* review for claims 1-14 of the ’482 patent.

Dated: May 17, 2024

By: /Kevin Greenleaf/
Reg. No. 64,062
Joel Bock
Reg. No. 36,456

CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24(d), the undersigned hereby certifies that the word count for the foregoing Petition for *Inter Partes* Review totals 9,631 as counted by Word Count feature of Microsoft Word, which is less than 14,000 allowed under 37 C.F.R. § 42.24(a)(1)(i), excluding the parts of the paper exempted by 37 C.F.R. §42.24(a), and complies with typeface requirements of 37 C.F.R. §42.6(a)(ii) and the style requirements of 37 C.F.R. §§42.6(a)(iii) and (iv.)

Dated: May 17, 2024

By: /Kevin Greenleaf/
Reg. No. 64,062

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the above-captioned Petitioner
Duration Media LLC is being served on the Patent Owner, Rich Media Club LLC,
on May 17, 2024, by filing this document through the Patent Trial and Appeal
Case Tracking System (P-TACTS), and by U.S. Mail to the following address:

PANITCH SCHWARZE BELISARIO & NADEL LLP
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Petitioner also provided courtesy copies to Patent Owner's litigation counsel
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Respectfully submitted,

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