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6 **IN THE UNITED STATES DISTRICT COURT**  
7 **FOR THE DISTRICT OF ARIZONA**  
8

9 Rich Media Club LLC,  
10 Plaintiff,

11 v.

12 Duration Media LLC,  
13 Defendant.  
14

No. CV-22-02086-PHX-JJT

**ORDER**

15 At issue is Defendant Duration Media LLC's Motion to Dismiss Pursuant to Fed.  
16 R. Civ. P. 12(b)(6) (Doc. 27, MTD), to which Plaintiff Rich Media Club LLC filed a  
17 Response (Doc. 30, Resp.) and Defendant filed a Reply (Doc. 33, Reply). The Court has  
18 reviewed the parties' briefs and finds this matter appropriate for decision without oral  
19 argument. *See* LRCiv 7.2(f). For the reasons set forth below, the Court denies Defendant's  
20 Motion to Dismiss.

21 **I. BACKGROUND**

22 In the Amended Complaint, the operative pleading, Plaintiff states that online  
23 advertising is one of the largest advertising markets in the world and faces many challenges  
24 that are not common in other media. (Doc. 20, Am. Compl. ¶¶ 7–8.) While advertisements  
25 placed in print media or on broadcast television are readily verifiable to advertisers, online  
26 advertising presents a different challenge because, for any given content, the size of the  
27 user's browser window determines the viewability of the content at any given time. (Am.  
28 Compl. ¶¶ 8–9.) Plaintiff develops and sells products and services to provide advertising

1 and marketing solutions to businesses. With regard to online advertising, Plaintiff  
2 developed patented technology that ensures that an advertisement appears on the portion  
3 of a web browser window being viewed by a potential consumer. (Am. Compl. ¶¶ 10–11.)

4 This matter arises out of Plaintiff’s patent infringement claim against Defendant  
5 under 35 U.S.C. § 271. As of October 11, 2022, Plaintiff had “received ten issued United  
6 States patents for inventions related to ad viewability, monitoring, and confirmation.” (Am.  
7 Compl. ¶ 13.) Among those patents is U.S. Patent No. 11,443,329 (“’329 Patent”), titled  
8 “System and Method for Creation, Distribution, and Tracking of Advertising Via  
9 Electronic Networks,” which was issued to Plaintiff by the United States Patent and  
10 Trademark Office (“USPTO”) on September 13, 2022. (Am. Compl. ¶¶ 14–15.) The ’329  
11 Patent relates to a system and method for “determining whether a predefined area of an ad  
12 content display page that is used to display an advertisement is in view within a visible area  
13 of a browser window,” rendering an advertisement within that predefined area based upon  
14 a real-time auction, and rendering a replacement advertisement within the area after a  
15 predefined length of time. (*See* Doc. 30-1, Resp. Ex. A, ’329 Patent columns 67–69.)

16 Claims 1, 2, 3, and 5 of the ’329 Patent recite:

17 What is claimed is:

18 1. A method comprising:

- 19 (a) determining whether a predefined area of an ad content display  
20 page that is used to display an advertisement is in view within a  
21 visible area of a browser window of a browser configured to be  
22 operated by a remote computing device, wherein the predefined  
23 area is a portion of the ad content display page, and wherein the ad  
24 content display page includes (i) the predefined area configured to  
25 display advertisement content, the predefined area being a portion  
26 of the ad content display page, and (ii) page content displayed in  
27 other portions of the ad content display page, the page content  
28 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.
2. The method of claim 1 wherein the replacement advertisement is selected at least partially as a result of a replacement auction.
  3. The method of claim 2 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.
  4. [not at issue] . . .
  5. The method of claim 1 wherein the predefined area of the ad content display page currently displays an advertisement, and wherein the replacement advertisement replaces the currently displayed advertisement.

(’329 Patent columns 68–69.)

Plaintiff alleges that the individual elements in the claim—and the claimed combination—in the ’329 Patent were not routine, well-understood, or conventional at the time of the invention. (Am. Compl. ¶ 22.) For its part, Defendant was issued U.S. Patent No. 11,195,210 (“’210 Patent”) on December 7, 2021.<sup>1</sup> (Am. Compl. Ex. E, ’210 Patent at 2 of 20.) The ’210 Patent “relates generally to systems and methods for real-time viewable advertising, and more specifically, to systems and methods that programmatically sell the same ad space on the same computing device multiple times.” (’210 Patent column 1.) The ’210 Patent includes a diagram nearly identical to Figure 51 contained in the ’329 Patent, which Plaintiff alleges was copied by Defendant from one of Plaintiff’s patents. (Am. Compl. ¶ 55.)

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<sup>1</sup> Plaintiff’s ’329 Patent is a continuation-in-part of related Patent Application No. 12/384,403, filed on April 4, 2009, now Patent No. 11,004,090, which is a continuation-in-part of Patent Application No. 11/803,779, filed on May 16, 2007, now U.S. Patent No. 10,380,602, which is a continuation-in-part of Patent Application No. 11/643,245, filed on Dec. 21, 2006, now U.S. Patent No. 10,380,597, which claimed the benefit of the earlier filing date of U.S. Patent Application No. 60/753,536, filed on December 24, 2005. (See ’329 Patent column 1.)

1           On December 9, 2022, Plaintiff filed suit against Defendant for one count of patent  
2 infringement, claiming that Defendant “directly infringed [at least claims 1, 2, 3, and 5 of]  
3 the ’329 Patent . . . by making, using, offering for sale, and/or selling Infringing Services[.]”  
4 (Am. Compl. ¶ 45.) Plaintiff requests that the Court declare that Defendant infringed the  
5 ’329 Patent under 35 U.S.C. § 271 and enter an injunction preventing Defendant from  
6 continuing to infringe the ’329 Patent. Additionally, Plaintiff seeks monetary relief,  
7 increased damages for willful and deliberate infringement under 35 U.S.C. § 284, and  
8 recovery of its attorneys’ fees and costs incurred in prosecution under 35 U.S.C. § 285.  
9 (Am. Compl. ¶¶ 55, 56 & at 22–23.)

10           In its reasserted Motion to Dismiss, filed March 22, 2023, Defendant seeks dismissal  
11 of the Amended Complaint with prejudice pursuant to Federal Rule of Civil Procedure  
12 12(b)(6). (MTD at 1.) Defendant contends that Plaintiff’s ’329 Patent is invalid because it  
13 is directed to patent-ineligible subject matter under 35 U.S.C. § 101: specifically, an  
14 “abstract idea.” (MTD at 1.)

## 15   **II.   LEGAL STANDARD**

16           Rule 12(b)(6) is designed to “test[] the legal sufficiency of a claim.” *Navarro v.*  
17 *Block*, 250 F.3d 729, 732 (9th Cir. 2001). A dismissal under Rule 12(b)(6) for failure to  
18 state a claim can be based on either: (1) the lack of a cognizable legal theory; or (2) the  
19 absence of sufficient factual allegations to support a cognizable legal theory. *Balistreri v.*  
20 *Pacifica Police Dep’t*, 901 F.2d 696, 699 (9th Cir. 1990). When analyzing a complaint for  
21 failure to state a claim, the well-pled factual allegations are taken as true and construed in  
22 the light most favorable to the nonmoving party. *Cousins v. Lockyer*, 568 F.3d 1063, 1067  
23 (9th Cir. 2009). A plaintiff must allege “enough facts to state a claim to relief that is  
24 plausible on its face.” *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007). “A claim has  
25 facial plausibility when the plaintiff pleads factual content that allows the court to draw the  
26 reasonable inference that the defendant is liable for the misconduct alleged.” *Ashcroft v.*  
27 *Iqbal*, 556 U.S. 662, 678 (2009) (citing *Twombly*, 550 U.S. at 556). “The plausibility  
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1 standard is not akin to a ‘probability requirement,’ but it asks for more than a sheer  
2 possibility that a defendant has acted unlawfully.” *Id.*

3 “While a complaint attacked by a Rule 12(b)(6) motion does not need detailed factual  
4 allegations, a plaintiff’s obligation to provide the grounds of his entitlement to relief requires  
5 more than labels and conclusions, and a formulaic recitation of the elements of a cause of  
6 action will not do.” *Twombly*, 550 U.S. at 555 (cleaned up and citations omitted). Legal  
7 conclusions couched as factual allegations are not entitled to the assumption of truth and  
8 therefore are insufficient to defeat a motion to dismiss for failure to state a claim. *Iqbal*, 556  
9 U.S. at 679–80. However, “a well-pleaded complaint may proceed even if it strikes a savvy  
10 judge that actual proof of those facts is improbable, and that ‘recovery is very remote and  
11 unlikely.’” *Twombly*, 550 U.S. at 556 (quoting *Scheuer v. Rhodes*, 416 U.S. 232, 236 (1974)).

### 12 **III. ANALYSIS**

13 Patent eligibility is a question of law that may also contain underlying questions of  
14 fact. *Coop. Ent., Inc. v. Kollektive Tech., Inc.*, 50 F.4th 127, 130 (Fed. Cir. 2022). As such,  
15 patent eligibility can be determined as a matter of law on a motion to dismiss only when  
16 there is no issue of material fact regarding the claim elements or claimed combination. *Id.*  
17 Put another way, determination of patent eligibility at the pleading stage is appropriate  
18 “only when there are no factual allegations that, taken as true, prevent resolving the  
19 eligibility question as a matter of law.” *Aatrix Software, Inc. v. Green Shades Software,*  
20 *Inc.*, 882 F.3d 1121, 1128 (Fed. Cir. 2018).

21 Patents granted by the USPTO are presumed to be valid. *See* 35 U.S.C. § 282(a);  
22 *Microsoft Corp. v. i4i Ltd. P’ship*, 564 U.S. 91, 100 (2011). This presumption reflects the  
23 fact that experts in the technical field have “already examined whether the patent satisfies  
24 the ‘prerequisites for issuance of a patent,’ including § 101.” *Cellspin Soft, Inc. v. Fitbit,*  
25 *Inc.*, 927 F.3d 1306, 1319 (quoting *Microsoft*, 564 U.S. at 95–96). However, “[a] party  
26 asserting an invalidity defense may overcome this presumption with ‘clear and convincing  
27 evidence’ proving otherwise.” *Datanet LLC v. Microsoft Corp.*, 2023 WL 3947829, at \*2

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1 (W.D. Wash. June 12, 2023) (quoting *Microsoft*, 564 U.S. at 97); *see also Cisco Systems,*  
2 *Inc. v. Uniloc USA, Inc.*, 386 F. Supp. 3d 1185, 1190 (N.D. Cal. 2019).

3 The Patent Act identifies patent-eligible subject matter where it states that  
4 “[w]homever invents or discovers any new and useful process, machine, manufacture, or  
5 composition of matter, or any new and useful improvement thereof, may obtain a patent  
6 therefor . . . .” 35 U.S.C. § 101. The term “process” means “process, art or method, and  
7 *includes a new use of a known* process, machine, manufacture, composition of matter, or  
8 material.” 35 U.S.C. § 100(b) (emphasis added). The United States Supreme Court has  
9 repeatedly affirmed that there are three categories of exceptions to this provision: “‘laws  
10 of nature, natural phenomena, and abstract ideas’ are not patentable subject matter under  
11 § 101 of the Patent Act . . . .” *Mayo Collaborative Servs. v. Prometheus Lab’ys, Inc.*, 566  
12 U.S. 66, 70 (2012) (quoting *Diamond v. Diehr*, 450 U.S. 175, 185 (1981)). However, “all  
13 inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural  
14 phenomena, or abstract ideas.” *Id.* at 71. Therefore, in order to avoid a too-broad  
15 interpretation of the exclusionary principle that would “eviscerate” patent law, the Supreme  
16 Court has stated that an invention may well be patentable if the nature of the claimed  
17 process or claimed combination transforms the patent-ineligible concept into a patent-  
18 eligible application of that concept. *Id.*

19 In *Mayo*, the Supreme Court set forth a two-step framework for distinguishing  
20 patents that claim one of the judicial exceptions from those that claim “patent-eligible  
21 applications of those concepts.” *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 573 U.S. 208, 217  
22 (2014) (citing *Mayo*, 556 U.S. at 72). The Supreme Court further developed the utility of  
23 this framework in *Alice*, where it applied the two-part test to determine whether a patent  
24 was directed to an abstract idea. *Id.* at 217. The first step of the *Alice* test asks whether the  
25 patent is directed to an abstract idea. *Id.* If it is not, then the ineligibility inquiry ends. *See*  
26 *Enfish, LLC v. Microsoft Corp.*, 822 F.2d 1327, 1339 (Fed. Cir. 2016). However, if a claim  
27 is directed to an abstract idea, then step two of the *Alice* test asks whether the elements of  
28 the claim individually and as an ordered combination contain an “inventive concept”

1 sufficient to transform the claimed abstract idea into a patent-eligible application of that  
2 idea. *Alice*, 573 U.S. at 217–18 (citing *Mayo*, 566 U.S. at 71–72, 77–78) (internal  
3 quotations omitted).

4 **A. Abstractness**

5 Step one of the *Alice* test examines whether the asserted patent is directed to an  
6 abstract idea by focusing on the claims “in their entirety to ascertain whether their character  
7 as a whole is directed to excluded subject matter.” *Internet Pats. Corp. v. Active Network,*  
8 *Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015). Defendant argues that the ’329 Patent is  
9 directed to patent-ineligible subject matter because Claim 1 “is directed to the abstract idea  
10 of organizing human activity, namely, displaying an advertisement when a certain  
11 condition is met.” (MTD at 5.) However, Defendant mischaracterizes the ’329 Patent by  
12 describing it as strictly an advertisement placement function and therefore a process that  
13 could be performed mentally by a human. (MTD at 9.) The ’329 Patent recites a process  
14 that is significantly more than performing a conventional economic activity based on  
15 meeting a predefined condition, because the claim language describes with sufficient  
16 specificity how the steps are performed beyond reciting the generic computer components  
17 necessary to implement the functions and is therefore not results-focused. Specifically, for  
18 example, Claim 1 recites steps that include “*determining* whether a predefined area of an  
19 ad content display page . . . is in view within a visible area of a browser window[.]”  
20 “*causing* a communication to be sent[;] . . . a replacement advertisement to be selected for  
21 display . . .; and . . . the replacement advertisement to be served to the remoted computing  
22 device[.]” and “*configur[ing]*” the browser to “*render* the replacement advertisement in  
23 the predefined area.” (’329 Patent columns 68–69 (emphasis added).) While Defendant  
24 asserts that the ’329 Patent’s claims recite a process that is as simple as a sign holder  
25 waving a sign at passing cars, Plaintiff’s claimed system as a whole is an advertisement  
26 placement function utilizing electronic networks, contains ad tracking and viewability  
27 software and real-time analysis, and necessarily depends on browser window sizing  
28 assessment technology.

1 Further, Plaintiff asserts that the claims at issue are “not directed to [the allegedly  
2 abstract idea of] displaying an advertisement when a predefined condition has been met,  
3 but rather a specific, improved method for rendering advertisements in web browsers.”  
4 (Resp. at 10.) “In the context of computer innovations and software, the ‘step-one inquiry  
5 often turns on whether the claims focus on ‘specific asserted improvements in computer  
6 capabilities,’ which are patentable . . . .” *Datanet*, 2023 WL 3947829, at \*3 (quoting *Int’l*  
7 *Bus. Machs. Corp. v. Zillow Grp., Inc.*, 50 F.4th 1371, 1377 (Fed. Cir. 2022)). “Indeed,  
8 some improvements in computer-related technology when appropriately claimed are  
9 undoubtedly not abstract . . . .” *Enfish*, 822 F.2d at 1335. In the Amended Complaint,  
10 Plaintiff alleges that the claimed inventions in the ’329 Patent “make specific  
11 improvements to the functionality and usefulness of electronic networks used for  
12 advertising[:.]”

13 The present invention does not embed advertising HTML files within a web  
14 page, providing considerable economies to advertisers in saved labor, time  
15 and cost in terms of both inserting advertisements into web page files, and  
later changing any of those advertisements.

16 (Am. Compl. ¶ 17.)

17 Plaintiff claims further improvements recited in the ’329 Patent, such as, “the  
18 present invention functions totally transparently to a network user . . . [and] does not require  
19 a network user to download or install . . . a separate application specifically to receive  
20 advertising . . . .” *Id.* Moreover, Plaintiff cites the approval of a related patent (Am. Compl.  
21 Ex. A, *Ex Parte Brad Krassner*) in its appeal to the USPTO’s initial § 101 rejection of  
22 Claim 1 of the ’329 Patent, in which Plaintiff stated: “[Claim 1] of the present application  
23 recites an improvement to the technical field of determining when to render an  
24 advertisement in a predefined area on a page displaying in a browser window.” (Am.  
25 Compl. ¶ 36, Ex. C at 6.) Plaintiff stated that the claimed process was an “improve[ment]  
26 upon prior art techniques for determining when to render an advertisement in a predefined  
27 area on a page displaying in a browser window . . . .” (Am. Compl. ¶ 37.) The ’329 Patent’s  
28 text includes several iterations of code sampled from the process during a preferred



1 embodiment, showing with sufficient specificity *how* the recited system and method  
2 achieve the improvements identified in the specification. (Am. Compl. ¶ 23; '329 Patent  
3 columns 24–35, 42–49, 65–68.) Additionally, Figures 51, 53, and 54-A, B, and C of the  
4 '329 Patent—which depict the method for creating a content rendering area space and  
5 implementing a correlator code—show with sufficient specificity the process for achieving  
6 the promised result. For all of these reasons, the Court finds that the '329 Patent is not  
7 directed to an abstract idea.

8 In light of the validity presumption for issued patents, *see* 35 U.S.C. § 282(a), the  
9 Court also finds persuasive the prosecution history of the '329 Patent's predecessors, as  
10 well as the fact that the “the claims of the '329 [P]atent underwent a § 101 analysis during  
11 prosecution.” (Am. Compl. ¶ 35.) In the Notice of Allowance for the '329 Patent from the  
12 USPTO, issued in response to the § 101 appeal, the Examiner expressly stated under the  
13 heading “Allowable Subject Matter”: “Claims 2-11 are allowed.”<sup>2</sup> Further, under  
14 Examiner's Reasons for Allowance, the Examiner concluded: “The amendment in  
15 combination with other limitations form an ordered combination and integrated practical  
16 application. 101 withdrawn.” (Am. Compl. Ex. D at 2.)

17 The Court also disagrees with Defendant regarding the applicability of *DDR*  
18 *Holdings, LLC v. Hotels.com, LP.*, 773 F.3d 1245 (Fed. Cir. 2014) to the '329 Patent.  
19 Defendant claims that the Patent Trial and Appeal Board's (“PTAB”) application of *DDR*  
20 *Holdings* to the '329 Patent's predecessors as a basis for reversing the § 101 rejection of  
21 claims in those patents is not applicable in this case. (MTD at 13–14.) While the Court is  
22 not bound by the prosecution history of the '329 Patent's predecessors, these related patents  
23 recite sufficiently similar claims to Claim 1 of the '329 Patent such that the Court finds  
24 persuasive the PTAB's reasoning in *Ex Parte Brad Krassner*. In *DDR Holdings*, the  
25 Federal Circuit affirmed the lower court's holding that the asserted claims of the infringed  
26 patents-at-issue were not so manifestly abstract as to render them invalid for failing to  
27 claim patentable subject matter, because the claims

28 <sup>2</sup> Claim 2 of Patent Application No. 17/317,627 is now Claim 1 (one of the claims at issue)  
of the issued '329 Patent.

1 [did] not merely recite the performance of some business practice known  
2 from the pre-Internet world along with the requirement to perform it on the  
3 Internet. Instead, the claimed solution [was] *necessarily* rooted in computer  
4 technology in order to overcome a problem specifically arising in the realm  
of computer networks.

5 *DDR Holdings*, 773 F.3d at 1257 (emphasis added).

6 Here, the reasoning from *DDR Holdings* applies to the '329 Patent because the  
7 claims at issue are necessarily rooted in computer technology in order to overcome a  
8 problem unique to computer networks in the context of Internet advertising: “verifying  
9 whether an online ad entered a part of a web browser window that was viewable to each of  
10 many varied web browser/screen combinations . . . .” (Am. Compl. ¶ 10.) Accountability  
11 for and tracking of consumer viewability of an online advertisement, as promised by  
12 Plaintiff’s services, depend on a technology to determine the size of a browser window and  
13 the available space for an advertisement to be placed within the viewable space. As Plaintiff  
14 argues, this is a technological solution for a problem for which there is no direct pre-  
15 Internet analog. Defendant claims that the § 101 prosecution history of the '329 Patent’s  
16 predecessors “actually supports [Defendant]’s assertion that the '329 Patent is directed to  
17 an abstract idea[,]” because all of the '329 Patent’s “limitations reference generic computer  
18 components arranged in conventional fashion . . . .” (MTD at 13–14.) But Plaintiff contends  
19 the claimed solution in the '329 Patent “does not recite only conventional computer  
20 technology.” (Am. Compl. ¶ 23.) In support, Plaintiff points to the patent specification’s  
21 disclosure of over ten pages of sample computer code, including at columns 24–35, 42–49,  
22 and 65–68. (Am. Compl. ¶ 23.) Plaintiff asserts that the limitations of the claims of the  
23 '329 Patent indicate that the recited system and methods “seek[] to resolve problems rooted  
24 in computer technology and arising in the context of advertising on webpages . . . .” and thus  
25 recite significantly more than the abstract idea of advertisement placement as  
26 conventionally implemented on a generic computer. (*Ex Parte Brad Krassner* at 11–12.)

27 Here, as in *Enfish*, “we are not faced with a situation where general-purpose  
28 computer components are added post-hoc to a fundamental economic practice or

1 mathematical equation. Rather, the claims are directed to a specific implementation of a  
2 solution to a problem in the software arts.” *Enfish*, 822 F.2d at 1339. The ’329 Patent claims  
3 recite a method solving a problem unique to Internet advertising: assessing the size of a  
4 browser window to determine viewability and thus place an advertisement in the most  
5 advantageous place, responding to the “network-centric challenge” of consumers being  
6 able to use differently sized devices to access the Internet. (*Ex Parte Brad Krassner* at  
7 11-12.) While “not all claims purporting to address Internet-centric challenges are eligible  
8 for patent[,]” and claims that merely recite the abstract idea of Internet advertising along  
9 with “routine additional steps” do not overcome the judicial exception, *DDR Holdings*, 773  
10 F.3d at 1259, Plaintiff sufficiently alleges that the ’329 Patent claims “specify how  
11 interactions with the Internet are manipulated to yield a desired result—a result different  
12 from . . . the routine and conventional sequence of events ordinarily triggered.” (Am.  
13 Compl. ¶ 24.)

14 In sum, the ’329 Patent is directed to a non-abstract concept: a technological  
15 solution to a technological problem. There is no direct pre-computer analog to the problem  
16 of lack of accountability for consumer viewability of Internet advertisements caused by the  
17 consumer’s ability to access the Internet using variations of computer devices with  
18 differently sized browser windows. The code generation claim limitation narrows with  
19 sufficient specificity the allegedly abstract concept of advertising in a predefined area upon  
20 determination of a predefined condition and does so in response to a problem that is unique  
21 to the Internet. Therefore, the claimed process of the ’329 Patent is deeply rooted in  
22 technology and thus directed to a patent-eligible concept.

### 23 **B. Inventiveness**

24 If, contrary to the findings of the Patent and Trademark Examiner and this Court,  
25 the ’329 Patent were found to be directed to an abstract idea, the inquiry would move to  
26 step two of the *Alice* test, which provides for the validity of a patent even when it is found  
27 to be directed to an abstract idea. Specifically, step two of the *Alice* test asks whether the  
28 patent claims, when examined individually and as an ordered combination, contain an

1 inventive concept such that it transforms the patent-ineligible nature of the claim into a  
2 patent-eligible application. *Alice*, 573 U.S. at 217 (citing *Mayo*, 566 U.S. at 71–72, 77–78).

3 As noted above, the '329 Patent aims to solve a problem unique to online advertising  
4 that arises from consumers' ability to access the Internet from a variety of technological  
5 devices with differently sized browser windows; at the time of the invention, the problem  
6 with Internet advertising was that "certain advertisements were never displayed on the screen  
7 to the consumer." (Am. Compl. ¶ 21.) Through the method and process recited in the claims  
8 of the '329 Patent, Plaintiff promises a service that can "verify[] whether an online ad entered  
9 a part of a web browser window that was viewable . . ." to the consumer, and for how long  
10 the advertisement remained within that viewable area. (Am. Compl. ¶ 10.)

11 Plaintiff asserts that the '329 Patent discloses a sizing technology that can, among  
12 other things:

- 13 (1) assist in loading ads just before a user is expected to scroll to the  
14 content;
- 15 (2) confirm that an ad is actually placed with the content regardless of  
16 whether it becomes viewable (and for how long);
- 17 (3) confirm that an ad actually became viewable (and for how long); and
- 18 (4) allow for the "first print" of an ad to be replaced with a "second print"  
of a different ad based on various criteria, such as how long the first  
print ad had been placed, was viewable, or both.

19 (Am. Compl. ¶ 11.)

20 Although Defendant contends that the claims require only conventional computer  
21 equipment—"browser," "remote computing device," and "dispatch server"—the '329  
22 Patent outlines with sufficient specificity a new and inventive process using these  
23 conventional technological devices to improve upon the functionality of Internet  
24 advertising at the time of the invention. (MTD at 10.) Plaintiff alleges that not only do the  
25 claims of the '329 Patent address Internet-centric problems, but also that "at the time of the  
26 invention, the individual elements in the claim, and the claimed combination, were not  
27 well-understood, routine, or conventional activity." (Am. Compl. ¶ 22.) The claimed  
28 process departs from a routine and conventional sequence of events after the condition

1 precedent has been met because it utilizes an inventive sizing technology to determine  
2 where to place the online advertisement based on the size of a particular consumer’s  
3 browser window. Considered as a whole, the recited steps do more than “merely organize  
4 the abstract idea into a stepwise description of a process used to perform the abstract idea.”  
5 (*Ex Parte Brad Krassner* at 8.)

6 The ’329 Patent contains an inventive concept: implementing a sizing technology  
7 in a process for using generic computer equipment in a novel way. As the Examiner stated  
8 regarding the ’329 Patent Application,<sup>3</sup> the claims of the ’329 Patent “in combination with  
9 other limitations form an ordered combination and integrated practical application” and  
10 thus overcome any objections to the validity of the ’329 Patent under 35 U.S.C. § 101.  
11 (Am. Compl. Ex. D at 2.) The claims of the ’329 Patent provide with sufficient specificity  
12 the process and method for Internet advertisement placement based on utilization of an  
13 inventive technology for determining the size of a user’s browser window.

#### 14 **IV. CONCLUSION**

15 Defendant fails to show that the ’329 Patent is invalid for being directed to patent-  
16 ineligible subject matter under 35 U.S.C. § 101. The Court finds at this—the motion to  
17 dismiss—stage that the claims recited in the ’329 Patent, in disclosing a solution to the  
18 technological problem of Internet advertisement placement and tracking, are deeply rooted  
19 in technology and thus directed to patent-eligible subject matter under *DDR Holdings*. The  
20 Court also finds applicable the same analysis as contained in the PTAB’s decision  
21 regarding § 101 prosecution of Plaintiff’s previously issued, closely related Patent No.  
22 10,380,602, of which the ’329 Patent is a continuation-in-part.

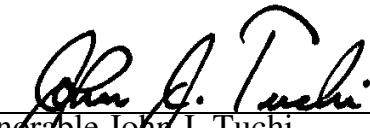
23 Additionally, the Court finds that the ’329 Patent contains an inventive concept  
24 rooted in technology such that it is directed to significantly more than an abstract idea.  
25 Because Defendant has not shown that the ’329 Patent is directed to patent-ineligible  
26 subject matter under 35 U.S.C. § 101 as a matter of law, Plaintiff survives Defendant’s  
27 Rule 12(b)(6) challenge.

28 \_\_\_\_\_  
<sup>3</sup> Patent Application No. 17/317,627.

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**IT IS THEREFORE ORDERED** denying Defendant's Motion to Dismiss  
Pursuant to Fed. R. Civ. P. 12(b)(6) (Doc. 27).

Dated this 11th day of July, 2023.

  
\_\_\_\_\_  
Honorable John J. Tuchi  
United States District Judge