

From: [Trials](#)
To: [Hector, Bill: Trials](#)
Cc: [Minghui Yang](#); [Floyd Walker](#); [Gasparo, Frank M.](#)
Subject: RE: IPR2019-00420, IPR2019-00421, IPR2019-00422 and IPR2019-00423 - Request for Reply to Patent Owner Preliminary Responses
Date: Monday, May 13, 2019 3:06:06 PM

Dear Counsel,

No conference call is necessary. Petitioner is authorized to file a three-page reply, due in each proceeding no later than May 21, 2019. Patent Owner is authorized to file a three-page sur-reply, due in each proceeding no later than May 29, 2019.

Regards,

Andrew Kellogg,
Supervisory Paralegal
Patent Trial and Appeal Board
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From: Hector, Bill <WAHector@Venable.com>
Sent: Friday, May 10, 2019 7:31 PM
To: Trials <Trials@USPTO.GOV>
Cc: Minghui Yang <myang@hpylegal.com>; Floyd Walker <fwalker@hpylegal.com>; Gasparo, Frank M. <FMGasparo@Venable.com>
Subject: IPR2019-00420, IPR2019-00421, IPR2019-00422 and IPR2019-00423 - Request for Reply to Patent Owner Preliminary Responses

Honorable Members of the Board,

We represent Petitioners, MindGeek USA, LLC, et al., (“Petitioners”) in the above-referenced IPRs and respectfully request permission to file a three-page reply to patent owner’s preliminary responses, based on the Board’s recent decision in *Sling TV, LLC v. Realtime Adaptive Streaming, LLC*, IPR2018-01331, Paper No. 9 (January 31, 2019) (attached). The *Sling TV* decision issued after Petitioners filed their IPRs. Patent Owner USC opposes.

In its preliminary responses, Patent Owner only, University of Southern California (“USC”), contends that *Click-To-Call Techs., LP v. Ingenio, Inc.*, 899 F.3d 1321 (Fed. Cir. 2018) bars Petitioners based on a prior litigation filed—not by the Patent Owner USC—but by its alleged exclusive licensee Preservation Technologies LLC. *See Preservation Technologies, LLC v. MindGeek USA Inc., et al.*, 17-cv-08906 and 18-cv-03058; Preliminary Response, IPR2019-00420, Paper No. 6, 1-2 (Apr. 11, 2019) (USC asserting that Preservation Technologies LLC is the exclusive licensee); Preliminary Response, IPR2019-00421, Paper No. 6, 1-2 (May 6, 2019) (same); Preliminary Response, IPR2019-00422, Paper No. 6, 1-2 (May 6, 2019) (same); Preliminary Response, IPR2019-00423, Paper No. 6, 1-2 (Apr. 15, 2019) (same).

But after Petitioners filed petitions for IPR on December 11, 2018, the Board issued *Sling TV* on January 31, 2019, holding that “§ 315(b) . . . require[es] the Petitioner to be served with a

patent owner's complaint to trigger the one-year time bar." *Sling TV*, 7 (emphasis in original). Patent Owner does not reference *Sling TV* in its preliminary responses, despite its persuasiveness, or explain why Petitioners are time barred when Patent Owner never filed a litigation against Petitioners.

Because Patent Owner, USC, never served Petitioners in a district court action, Petitioners are not time barred under the Board's new authority in *Sling TV*. Indeed, Patent Owner filed the preliminary responses on behalf of itself, not for Preservation Technologies, which further reinforces that Petitioners are not time barred. Out of fairness and given Petitioners and Patent Owner did not address *Sling TV*, Petitioners respectfully request a three-page reply. Replies are routinely granted in such situations. See *NRT Technology Corp. v. Everi Payments Inc.*, CBM2016-00080, Paper 9 (Sept. 29, 2016) (granting petitioner a three-page reply and patent owner a three-page sur-reply to address issues raised by a Fed. Cir. decision that issued after the Petition was filed).

Petitioners and Patent Owner are available for a conference call Wednesday thru Friday of next week or at the Board's convenience thereafter. We appreciate the Board's courtesy and consideration.

Respectfully submitted,
Bill Hector

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