

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MINDGEEK USA INC., MINDGEEK S.À.R.L.,
MG FREESITES LTD., MG FREESITES II LTD.,
MG CONTENT RK LTD., MG CONTENT DP LTD.,
MG CONTENT RT LTD., MG PREMIUM LTD.,
MG CONTENT SC LTD., MG CYPRUS LTD.,
LICENSING IP INTERNATIONAL S.À.R.L.,
9219-1568 QUÉBEC INC. d/b/a ENTREPRISE MINDGEEK CANADA, and
COLBETTE II LTD.,

Petitioners

v.

UNIVERSITY OF SOUTHERN CALIFORNIA
Patent Owner

Case IPR2019-00422
Patent No. 6,212,527

**PETITIONERS' REPLY TO PATENT OWNER'S PRELIMINARY
RESPONSE FOR *INTER PARTES* REVIEW**

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Bennett Regulator Guards, Inc. v. Atlanta Gas Light Co.</i> , 905 F.3d 1311 (Fed. Cir. 2018).....	2
<i>Click-To-Call Techs., LP v. Ingenio, Inc.</i> , 899 F.3d 1321 (Fed. Cir. 2018).....	1, 2
<i>GoPro v. 360Heros</i> , IPR2018-01754, Paper No. 23 (May 10, 2019).....	2
<i>Sling TV, LLC v. Realtime Adaptive Streaming, LLC</i> , IPR2018-01331, Paper No. 9 (Jan. 31, 2019).....	1, 2, 3
Statutes	
35 U.S.C. §100(d).....	3
35 U.S.C. §313.....	3
35 U.S.C. §315(a)(2)(A)&(B).....	3
35 U.S.C. §315(b).....	passim
Other Authorities	
IPR2019-00420, IPR2019-00421, IPR2019-00423.....	1

I. INTRODUCTION

In response to the petition for *Inter Partes* Review (“IPR”), University of Southern California (“USC”) alone filed a preliminary response. *USC defined itself as the “Patent Owner”* and excluded from this definition purported exclusive licensee Preservation Technologies LLC (“PT”). Given only USC is the Patent Owner and given USC never served Petitioners with a complaint alleging infringement, Petitioners are not time barred under §315(b). *Sling TV, LLC v. Realtime Adaptive Streaming, LLC*, IPR2018-01331, Paper No. 9, 7 (Jan. 31, 2019) (holding that “§ 315(b) . . . requir[es] the Petitioner to be served with a *patent owner’s* complaint to trigger the one-year time bar.”) (emphasis in original).

II. BACKGROUND

On October 10, 2014, PT—not Patent Owner—served MindGeek USA with a complaint and dismissed without reason on February 2, 2015. Petition, at 6. After several years of complete silence, on December 11, 2017, PT filed suit again. *Id.*, 6. On December 11, 2018, Petitioners filed IPR petitions: IPR2019-00420, IPR2019-00421, IPR2019-00422 and IPR2019-00423. Attorneys from Hardy Parrish Yang appeared for Patent Owner USC. *See* Paper Nos. 3-4. No attorney has appeared for PT in this IPR. On January 31, 2019, the Board rendered *Sling TV*. In its Preliminary Response on April 11, 2019, USC defined only itself as the “Patent Owner,” but it still argued that *Click-To-Call Techs., LP v. Ingenio, Inc.*, 899 F.3d 1321 (Fed. Cir.

2018) bars Petitioners and not surprisingly failed to mention *Sling TV*. See Paper No. 6, 1-2 (“POPR”). On May 13, 2019, the Board authorized this reply. Of note, the Precedential Opinion Panel recently accepted a case that may address related issues. *GoPro v. 360Heros*, IPR2018-01754, Paper No. 23 (May 10, 2019).

III. THE PETITION IS NOT TIME BARRED UNDER §315(b)

A. *Sling TV*: §315(b) Applies Only to a Patent Owner’s Complaint

In *Sling TV*, Realtime Data LLC (“Realtime Data”) filed and dismissed a complaint because “it did not own the . . . patent . . . [as] it had previously recorded an assignment” to Realtime Adaptive Streaming (“RAS”). *Sling TV*, 5. RAS later filed a complaint and contended that *non-patent owner* Realtime Data’s dismissed complaint triggered the time bar because allegedly §315(b) “endorses no exceptions for dismissed complaints.” *Id.*, 6; *Bennett Regulator Guards, Inc. v. Atlanta Gas Light Co.*, 905 F.3d 1311, 1315 (Fed. Cir. 2018); *Click-To-Call*, 899 F.3d at 1330.

Rejecting this argument, the Board held that “only a patent owner’s action triggers § 315(b)’s time bar.” *Sling TV*, 7. This holding was based on the title of the relevant section of the statute (“Patent owner’s action”) and the legislative history (“patent owner has filed an action for infringement”), which both emphasize the patent owner. *Id.* (citations omitted). The Board further distinguished *Click-To-Call* because that case did not address “whether a complaint filed without standing triggers § 315(b)’s time bar” *Id.*, 6-7 (citing *Hamilton Beach Brands, Inc. v.*

F'real Foods, LLC, 908 F.3d 1328, 1337 (Fed. Cir. 2018) (noting this issue was “not present, or considered, in *Click-to-Call*.”)). Thus, *Sling TV* requires a patent owner’s complaint—not an exclusive licensee’s complaint—to trigger the §315(b) time bar.

B. USC, the Self-Identified Patent Owner, Is Bound By *Sling TV*

USC is in the same position as RAS in *Sling TV* by arguing that a complaint filed by a “non-patent owner” (PT and Realtime Data) triggers the one-year time bar. Thus, *Sling TV* is binding here, and USC cannot escape it. Indeed, USC conceded that it alone is the Patent Owner, both in the caption and text. POPR, cover page, 1; Paper No. 3. PT has not appeared in this IPR. *Id.*, 7 (“Counsel for Patent Owner” USC). Because Patent Owner USC never served Petitioners with a complaint alleging infringement, Petitioners’ petition is not time barred. This conclusion, as noted in *Sling TV*, is supported by §315(b)’s text and legislative history, which both reference action by the “patent owner.” Other provisions reinforce that reading. First, provisions related to §315(b) reference patent owner not an exclusive licensee. §§315(a)(2)(A) & (B); §313. Second, despite defining patentee in 35 U.S.C. §100(d) with “successors in title to the patentee,” Congress in §315(b) chose the narrower “patent owner” with no such successor language. Otherwise, a patent owner could shield itself from IPR review if any party (e.g., non-exclusive licensee, inventor) files and serves a complaint, even if meritless. The statutory text and history support no such expansive reading. Petitioners respectfully request that the IPR be instituted.

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