

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GUARDIAN ALLIANCE TECHNOLOGIES, INC.  
Petitioner,

v.

TYLER MILLER  
Patent Owner.

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Case IPR2020-00031  
Patent 10,043,188 B2

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**PATENT OWNER'S MOTION TO TERMINATE IPR PROCEEDING**

Miller requests termination of the IPR as time barred under 35 U.S.C. § 315(b) and because GAT's primary references are not prior art. In a related motion, GAT attempts to replace a non-prior art reference (Ex. 1002) with an alleged earlier reference. Despite this being styled as a Motion to Terminate, Petitioner's must prove entitlement to its filing date and that it is not time-barred.

**I. STATEMENT OF MATERIAL FACTS**

1. GAT's bar date was October 10, 2019, one year after service on the real-party-in-interest City of Oklahoma City ("OKC"). (Pet. at 1.)
2. In April 2019, OKC stated an IPR was coming. (Ex. 2018 at 3, ¶ 6.)
3. GAT apparently tried to evade service of a subpoena. (Ex 2019, 2020.)
4. OKC opposed having GAT named as a defendant. (Ex. 2021 at 5.)
5. Mr. Talley sought permission to serve IPR documents on October 10, 2019, but did not identify GAT as petitioner. (Ex. 2022.)
6. Metadata for Ex. 1002 indicates creation on Dec. 20, 2012. (Ex. 2023.)
7. On Jan. 23, 2020, Mr. Talley first alleged that the wrong exhibit had been uploaded to PTAB E2E. He referred to Ex. 1002 as the "2012 video." He identified the "new exhibit" as BGS-006247.
8. BGS-006247 is one of more than 13,600 files produced by a third party on or about August 8, 2019. BGS-006247 is an "FLV" file, an antiquated

format that cannot be uploaded to E2E or played on Mr. Rylander's computer without additional software.

9. In a conference call, Mr. Talley stated he did not contest the fact that "BGS-006247" had never been served on Miller by Guardian.

10.OKC's Invalidity Contentions were not filed in Court prior to the Bar Date.

11.GAT has not provided or identified any public source for BGS-006247 between August 2019 and today.

## **II. GAT FAILED TO SERVE ITS EVIDENCE PRIOR TO THE BAR DATE**

"A petitioner who files a petition shortly before the time bar should be well aware of the risks..." *Nuna Baby Essentials, Inc. v. Britax Child Safety, Inc.*, IPR2018-01683, Paper No. 11, p. 8 (P.T.A.B. Dec. 18, 2018). Despite listing five counsel of record, not one discovered the alleged error: 1) on the day of filing, 2) after receiving a notice that at least one exhibit was defective (*see* Paper No. 5 at 2), or 3) prior to Patent Owner's Preliminary Response ("POPR") more than three months later, in dereliction of their obligations to review filings. *See Nuna at 6-7.*

A "petition is only accorded a filing date once (1) a petition has been filed; (2) payment has been made; and (3) the complete petition is served on the patent owner." *Terremark NA LLC v. Joao Control & Monitoring Sys., LLC*, IPR2015-01482, Paper #10, p. 7 (P.T.A.B. 2015); *also Luv'n Care, Ltd. v. McGinley*, IPR2017-01216, Paper #13, pp. 2-3 (P.T.A.B. Jan. 10, 2018) (Informative).

Although initially afforded a filing date of October 10, 2019, GAT's assertion that it inadvertently filed the wrong exhibit also results in an admission that did not serve the all materials on Patent Owner (*see* MF 9) as required by 35 U.S.C. § 312(a) prior to the bar date and is dispositive of this proceeding:

The obvious purpose of requiring service within the one-year statutory period set forth in 35 U.S.C. § 315(b) is either to provide a patent owner with timely notice that its patent is subject to an inter partes review proceeding, or else to give the patent owner repose at the end of the statutory period.

*Plaid Tech. Inc. v Yodlee, Inc.*, IPR2016-00275, Paper No. 15, p. 9.

**A. GAT Cannot Assert Service by a Third Party (OKC)**

35 U.S.C. § 312(a)(5) unambiguously requires that the petitioner provide copies of all patents and publications relied upon to the patentee. “Where a statute's language carries a plain meaning, the duty of an administrative agency is to follow its commands as written, not to supplant those commands with others it may prefer.” *SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1355 (2018). *See also* *Cuozzo Speed Technologies, LLC v. Lee*, 136 S.Ct. 2131, 2141 (2016) (noting that courts may invalidate “shenanigans” by the Director that are “outside [his] statutory limits”); *also Click-To-Call Tech. v. Ingenio, Inc.*, 899 F.3d 1321 (Fed. Cir. 2018) (en banc in relevant part) (holding that the Board could not subvert the plain meaning of “served with a complaint” in 315(b)). “The time-bar is not about

preliminary procedural requirements that may be corrected if they fail to reflect real world facts, but about real world facts that limit the agency's authority to act under the IPR scheme." *Wi-fi One LLC v. Broadcom Corp*, 878 F.3d 1364, 1374 (Fed. Cir. 2018) (en banc) (holding that time-bar determinations are reviewable).

Research has not located any case permitting service by a third-party, and the above decisions would necessarily overrule any such case. Indeed, the only case identified by GAT in its correspondence involved substitution of a reference that had been identified by the petitioner in the actual petition.

OKC is not a petitioner in the IPR. GAT is not a party to the litigation. But, GAT and OKC are playing a shell game. GAT wants the benefit of litigation activity, but none of the liabilities. Indeed, OKC has opposed adding GAT as a defendant. (MF 4.) Further, GAT apparently tried to evade service of a valid litigation subpoena. (MF 3.) It would be a tragic miscarriage of justice to permit GAT to use the Litigation proceedings as sword and shield.

**B. GAT Did Not Timely Comply with the Regulation**

Beyond § 312(a), 37 C.F.R. § 42.105(a) states that "the petitioner must serve the petition and exhibits relied upon as follows... at the correspondence address of record for the subject patent." Section (b) allows electronic service only on the agreement of the parties. Otherwise, service was required by Priority Mail Express or better. GAT did not serve any documents by mail or other physical method.

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