

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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NETNUT LTD.,

Petitioner

v.

BRIGHT DATA LTD.,

Patent Owner

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Case IPR2021-01492

Patent No. 10,257,319

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**PATENT OWNER'S SUR-REPLY TO PETITIONER'S REPLY TO  
PATENT OWNER'S PRELIMINARY RESPONSE UNDER  
AUTHORIZATION FROM THE BOARD<sup>1</sup>**

Mail Stop PATENT BOARD  
Patent Trial and Appeal Board  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

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<sup>1</sup> Authorized via email on January 7, 2022.

## PATENT OWNER'S LIST OF ADDITIONAL EXHIBITS

<b>Exhibit Number</b>	<b>Description</b>
2011	Order, <i>Uniloc USA, Inc. v. Ringcentral, Inc.</i> , No. 2-17-cv-354, Dkt. 100 (E.D. Tex. Feb. 12, 2018)
2012	Motion, <i>Uniloc USA, Inc. v. Ringcentral, Inc.</i> , No. 2-17-cv-354, Dkt. 97 (E.D. Tex. Feb. 8, 2018)
2013	Order, <i>Uniloc USA, Inc. v. Ringcentral, Inc.</i> , No. 2-17-cv-354, Dkt. 99 (E.D. Tex. Feb. 9, 2018)
2014	Joint Motion, <i>Bright Data Ltd. v. NetNut Ltd.</i> , No. 2:21-cv-225, Dkt. 79 (E.D. Tex. Dec. 22, 2021)
2015	Motion, <i>Bright Data Ltd. v. NetNut Ltd.</i> , No. 2:21-cv-225, Dkt. 80 (E.D. Tex. Dec. 23, 2021)
2016	Letter, dated Dec. 30, 2021, from Bright Data Ltd. to NetNut Ltd. regarding the scheduling of depositions in the case of <i>Bright Data Ltd. v. NetNut Ltd.</i> , No. 2:21-cv-225 (E.D. Tex.)
2017	Declaration of Mr. Thomas M. Dunham

Patent Owner respectfully submits this Sur-Reply in response to Petitioner's Reply (Paper 10) relating to the discretionary factors in *Apple Inc. v. Fintiv, Inc.*, IPR2020-0019, Paper 11 (PTAB March 20, 2020)(precedential)(“*Fintiv*”).

**Regarding *Fintiv* factor 1**, Patent Owner has explained that it is *unlikely* that the judge will issue a stay, even if review is instituted, given that the NetNut Litigation will “clearly [be] at an advanced stage” as of the 3/27/2022 deadline for an institution decision. (See Patent Owner Preliminary Response (“POPR”)(Paper 9) at 19-20).

Petitioner's cited *Uniloc* case (Dkt. 100, dated 2/12/2018, EX. 2011) is inapplicable because (a) that Court had already granted an unopposed motion to stay (Dkt. 97, EX. 2012) filed by the plaintiff (*see* Dkt. 99, dated 2/9/2018, EX. 2013); and (b) the Board instituted review of *every asserted claim of all asserted patents* and as of the institution decision, the claims had not yet been construed by that Court. *Uniloc USA, Inc. v. Ringcentral, Inc.*, No. 2-17-cv-354 (E.D. Tex.). Unlike *Uniloc*, the Board will not resolve every asserted claim of all asserted patents in the NetNut Litigation (*see, e.g.*, POPR at 29; *see also* EX. 2002 at 2<sup>2</sup>) and the Court has already, previously construed claim terms from the asserted ‘319 and ‘510 Patents (*see, e.g.*, POPR at 14). Accordingly, this factor weighs in favor of denial.

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<sup>2</sup> There is a total of five asserted patents in the NetNut Litigation.

**Regarding *Fintiv* factor 2**, the NetNut Litigation has trial scheduled approx. 6.5 months before the 3/27/2023 deadline for a final written decision (*see* POPR at 21-22) and the Board has previously declined to speculate whether there may be further delays in the district court (*see* POPR at 23).

Petitioner's implication regarding extensions (*see* Reply at 2) is misleading. First, the parties submitted a Joint Motion (Dkt. 79, EX. 2014) for a 1-month extension to continue additional mediation with the same Judge Gandhi, rather than the new Judge Folsom. That mediation occurred on 1/25/2022. Second, Patent Owner submitted a Motion (Dkt. 80, EX. 2015) for a 3-week extension to amend infringement contentions based on source code review given that (a) the expert could not begin his review until 1/5/2022 given the holidays and his work schedule and (b) this left insufficient time to amend infringement contentions by 1/13/2022 for the five asserted patents. The Court granted-in-part the Motion and extended the deadline to 1/26/2022. (EX. 1103). Neither of these requested extensions suggests Patent Owner intends to delay the 9/12/2022 trial date in the NetNut Litigation. Accordingly, this factor weighs in favor of denial.

**Regarding *Fintiv* factor 3**, Patent Owner has explained that the parties will have invested significant resources in the NetNut Litigation by the 3/27/2022 deadline for an institution decision (*see* POPR at 22 (citing section III.A.1 at 19-20)). This is consistent with the *Fintiv* analysis. (*See Fintiv* at 9-10).

Also, Petitioner's statement that "[n]o depositions have been taken or noticed" (*see* Reply at 2) is misleading. On 12/30/2021, Patent Owner sent a letter to Petitioner regarding the scheduling of depositions February 14-25, 2022 for seven of Petitioner's employees. (EX. 2016). Petitioner sent a response on 1/11/2022 and there has been subsequent email correspondence regarding availability of witnesses.

Moreover, "[t]his investment factor is related to the trial date factor". (*Fintiv* at 10). Patent Owner anticipated Petitioner's argument regarding the possibility of a delayed trial date (*see* Reply at 2) and has explained that the parties will have invested even more resources by the 3/27/2023 deadline for a final written decision (*see* POPR at 23-24). There are many asterisked deadlines in the Docket Control Order (EX. 2003) unlikely to change, even if the trial date is ultimately changed.

Furthermore, Petitioner argues alleged diligence (*see* Reply at 3) based on the timing of the Petition relative to the statutory deadline. However, Petitioner attempts to minimize the timing of the Petition relative to the investment/progress in the NetNut Litigation. Also, Petitioner fails to explain its alleged diligence in view of its other litigation activity. Petitioner merely states that those "events... concern other patents, parties, and types of proceedings." (Reply at 3). However, Petitioner has not explained (a) when it became aware of the '319 and '510 Patents and/or (b) when it became aware of the Crowds, Border, and Morphmix references, in order to justify why Petitioner could not have filed the Petitions before September 2021.

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