UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MINDGEEK USA INC., MINDGEEK S.A.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.A.R.L., 9219-1568 QUEBEC INC. d/b/a ENTERPRISE MINDGEEK CANADA, and COLBETTE II LTD.,
Petitioners,

v.

UNIVERSITY OF SOUTHERN CALIFORNIA,
Patent Owner.

Case IPR2019-00421
Patent 6,199,060

PATENT OWNER'S SUR-REPLY TO PETITIONERS' REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE

I. Controlling Federal Circuit Authority Makes Clear Service by an Exclusive Licensee Triggers 35 U.S.C. §315(b)'s Time Bar

The Federal Circuit in *Click-To-Call* already considered the exact fact pattern at issue in this proceeding and determined service by an exclusive licensee triggers the time bar of 35 U.S.C. §315(b). *Click-To-Call Techs., LP v. Ingenio, Inc.*, 899 F.3d 1321, 1326 (Fed. Cir. 2018).

In *Click-To-Call*, the Federal Circuit explicitly relied upon service by an exclusive licensee in its decision applying 35 U.S.C. §315(b)'s time bar: "On June 8, 2001, ***Inforocket.com, Inc. ("Inforocket"), the exclusive licensee of U.S. Patent No. 5,818,836*** ("the '836 patent"), ***filed a civil action*** in the United States District Court for the Southern District of New York. ***Inforocket served a complaint asserting infringement of the '836 patent on defendant Keen, Inc.*** ("Keen")…" *Id*. Critically, Inforocket remained the sole plaintiff throughout the Keen action, even though USPTO records show Steven DuVal, the '836 patent's inventor, was its owner. (Ex. 2001). DuVal never served a complaint against Keen. Rather, Inforocket, in its capacity as the exclusive licensee, was the only party to serve a complaint against Keen (which later changed its name to Ingenio).

In its review, the Federal Circuit was expressly asked to review the Board's determination that exclusive licensee Inforocket's service of a complaint failed to meet § 315(b)'s time bar: "Notwithstanding the absence of any facial ambiguity in the phrase 'served with a complaint,' the Board concluded that [Click-To-Call] 'has not established that ***service of the complaint*** in the infringement suit brought

by Inforocket against Keen bars Ingenio, LLC from pursuing an inter partes review for the '836 patent." *Click-To-Call*, 899 F.3d at 1332. Based on these facts, the Federal Circuit rejected the Board's interpretation of § 315(b) and determined service by Inforocket, the exclusive licensee, triggered § 315(b)'s time bar. *Id*. at 1333. Thus, contrary to Petitioners' arguments at 1, no discussion of *Sling TV* is necessary as *Click-To-Call* squarely teaches service by an exclusive licensee is sufficient to trigger § 315(b)'s time bar.

Here, USC's exclusive licensee Preservation Technologies, like Inforocket in *Click-To-Call*, served a complaint on Petitioners alleging infringement of the patent at issue more than one year before the filing of the instant petition. Based upon the Federal Circuit's binding determination in *Click-To-Call* that exclusive licensee Inforocket's service of a complaint on Ingenio's predecessor Keen barred Ingenio under § 315(b) from review of its late-filed petition, USC's exclusive licensee Preservation Technologies' service of a complaint on Petitioners must likewise bar Petitioners under § 315(b) from review of their late-filed petition.

II. The Plain Language of 35 U.S.C. §315(b) Clearly Does Not Require Service by a Patent Owner

Contrary to Petitioners' Reply at 3, §315(b)'s text and legislative history do not suggest or support restricting service of the complaint to patent owners. §315(b) is titled "Patent Owner's Action"–not "Service by Patent Owner"–and thus contemplates any action by patent owner, including, for example, licensing the patent to another, giving the licensee the right to sue in the licensee's name,

and allowing the licensee to serve a complaint. The fact the remaining statutory language is written in the passive voice ("***is*** **served with a complaint**") reinforces the conclusion that Congress intended the statute to apply to any service, not just service by a patent owner. Indeed, the Federal Circuit explicitly noted the same use of the passive voice during Senate debates as indicative that the statute's drafters did not intend to narrowly restrict the estoppel provision: "Senator Kyl made clear that… 'if a party has been sued for infringement and wants to seek *inter partes* review, he ***must do so*** within 6 months of ***when he was served*** with the infringement complaint.'" *Click-To-Call*, 899 F.3d at 1331 (emphasis in original).

III. No Policy Reason Justifies Treating Exclusive Licensees Differently Than Patent Owners

Restricting §315(b)'s time bar provision to only patent owners unfairly prejudices those owners who chose to exclusively license their patents rather than enforce the patent rights themselves. Such an interpretation would require every exclusive licensee to join the licensing patent owner in an infringement suit–in direct contradiction to extensive Federal Circuit authority holding exclusive licensees may bring suit in their own name for infringement because an exclusive licensee possesses all substantial rights to enforce the patent. *Luminara Worldwide, LLC v. Liown Elecs. Co.*, 814 F.3d 1343, 1350-51 (Fed. Cir. 2016). Interpreting the statute this way serves no policy objective and only undermines a well settled regime of patent enforcement– a regime the drafters of §315(b) gave no intention of wishing to disturb. Accordingly, the Petition must be denied as untimely.

Date: May 28, 2019

Respectfully Submitted,

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