

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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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 IPR2019-00423  
Patent No. 6,574,638

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**PETITIONERS' NOTICE OF APPEAL**

via PTAB E2E  
Patent Trial and Appeal Board

via Priority Mail Express  
Director of the United States Patent and Trademark Office  
c/o Office of the General Counsel

United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

via CM/ECF  
United States Court of Appeals for the Federal Circuit

Notice is hereby given, pursuant to 37 C.F.R. § 90.2(a), that Petitioners 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. (collectively, “Petitioners”) hereby appeal to the United States Court of Appeals for the Federal Circuit from the Decision Denying Institution of *Inter Partes* Review of the Patent Trial and Appeal Board (“Board”) entered June 12, 2019 (Paper No. 9) as it relates to U.S. Patent No. 6,574,638 (“the ’638 patent”), and from all underlying findings, determinations, orders, decisions, rulings and opinions relating to that decision or the ’638 patent. A copy of the Board’s Decision Denying Institution of *Inter Partes* Review is attached hereto as Exhibit A.

In accordance with 37 C.F.R. § 90.2(a)(3)(ii), Petitioners further indicate that the expected issues on appeal include, but are not limited to, the following:

- The Board’s determination that this *inter partes* review or Petition (Paper No. 1) is time-barred by 35 U.S.C. § 315(b), and

any other finding or determination (legal or factual) supporting or related to this determination;

- The application of the statutory bar under 35 U.S.C. § 315(b) when the underlying complaint is filed by a non-patent owner, such as a licensee;
- The Board's decision to not institute the Petition (Paper No. 1);
- The Board's decision to not address *Sling TV, LLC v. Realtime Adaptive Streaming, LLC*, IPR 2018-01331, Paper No. 9 (Jan. 31, 2019) and related arguments in Petitioners' Reply (Paper No. 7), pp. 2-3; and
- The Board's decision to not address the factual and legal arguments in Petitioners' Reply (Paper No. 7).

along with any finding or determination supporting or related to those issues, as well as all other issues decided adversely to Petitioners in any orders, decisions, opinions, and rulings.

A copy of this Notice of Appeal is being concurrently filed with the Board and Director of the United States Patent and Trademark Office. In addition, three copies of this Notice of Appeal, along with the required docketing fees, are being filed with the Clerk's Office for the United States Court of Appeals for the Federal Circuit.

Dated: July 1, 2019

Respectfully submitted,

By: /Frank M. Gasparo/

Frank M. Gasparo

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*Attorneys for Petitioners*

**CERTIFICATE OF FILING**

The undersigned hereby certifies that, in addition to being electronically filed with the Patent Trial and Appeal Board, the above-captioned Petitioners' Notice of Appeal is being filed by Priority Mail Express or equivalent on July 1, 2019, with the Director of the United States Patent and Trademark Office, at the following address (pursuant to 37 C.F.R. §§ 90.2(a), 104.2):

Director of the United States Patent and Trademark Office  
c/o Office of the General Counsel  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

**CERTIFICATE OF FILING**

The undersigned certifies that a true and correct copy of the foregoing Petitioners' Notice of Appeal was filed electronically with the Clerk's Office of the United States Court of Appeals for the Federal Circuit on July 1, 2019.

**CERTIFICATE OF SERVICE**

Pursuant to 37 CFR § 42.6(e), the undersigned hereby certifies that a true and correct copy of Petitioners' Notice of Appeal was served in entirety on July 1, 2019, by electronic mail to Patent Owner's counsel of record as follows:

HARDY PARRISH YANG, LLP  
Minghui Yang (myang@hpylegal.com)  
R. Floyd Walker (fwalker@hpylegal.com)  
SPICEWOOD BUSINESS CENTER

Case IPR2019-00423

Patent No. 6,574,638

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Date: July 1, 2019

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# **EXHIBIT A**

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MINDGEEK USA INC., MINDGEEK S.À.R.L.,  
MG FREESITES LTD., MG FREESITES II LTD.,  
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9219-1568 QUÉBEC INC. d/b/a ENTREPRISE MINDGEEK CANADA,  
and COLBETTE II LTD.,  
Petitioner,

v.

UNIVERSITY OF SOUTHERN CALIFORNIA,  
Patent Owner.

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Case IPR2019-00423  
Patent 6,574,638 B1

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Before SALLY C. MEDLEY, KEVIN C. TROCK, and  
JESSICA C. KAISER, *Administrative Patent Judges*.

MEDLEY, *Administrative Patent Judge*.

DECISION  
Denying Institution of *Inter Partes* Review  
35 U.S.C. § 315(b)

## I. INTRODUCTION

MindGeek USA Inc., along with several other entities (“Petitioner”),<sup>1</sup> filed a Petition for *inter partes* review of claims 1–26 of U.S. Patent No. 6,574,638 B1 (Ex. 1001, “the ’638 patent”). Paper 1 (“Pet.”). University of Southern California (“Patent Owner”)<sup>2</sup> filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). With our authorization, Petitioner filed a Reply. Paper 7 (“Reply”). Also with our authorization, Patent Owner filed a Sur-Reply. Paper 8 (“Sur-Reply”). For the reasons provided below, we determine the Petition is time-barred pursuant to 35 U.S.C. § 315(b). Accordingly, we do not institute *inter partes* review of the ’638 patent in this proceeding.

The parties indicate that the ’638 patent is the subject of *Preservation Technologies LLC v. MindGeek USA Inc. et al.*, Case No. 2:17-cv-08906-DOC-JPR (C.D. Cal.) and *Preservation Technologies LLC v. MG Content RK Ltd. et al.*, Case No. 2:18-cv-03058-DOC-JPR (C.D. Cal.), both currently pending. Pet. 3; Paper 3, 2. The parties also list at least one relevant dismissed proceeding, which we discuss in more detail below. Pet. 3; Paper 3, 2.

## II. DISCUSSION

The issue before us is whether Petitioner timely filed its Petition under § 315(b). We determine that Petitioner did not.

Section 315(b) states, “[a]n *inter partes* review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date

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<sup>1</sup> The header on page 1 of this Decision lists all parties representing Petitioner. Petitioner lists the same as real parties-in-interest. Pet. 1, 3.

<sup>2</sup> Patent Owner lists exclusive licensee Preservation Technologies LLC as a real party-in-interest. Paper 3, 2; Prelim. Resp. 2.

on which the petitioner . . . is served with a complaint alleging infringement of the patent.” 35 U.S.C. § 315(b). In *Click-to-Call Technologies, LP v. Ingenio, Inc.*, 899 F.3d 1321, 1328–36 (Fed. Cir. 2018) (en banc in relevant part), the court held the time bar of § 315(b) “applies to bar institution when an IPR petitioner was served with a complaint for patent infringement more than one year before filing its petition, but the district court action in which the petitioner was so served was voluntarily dismissed without prejudice.” *Id.* at 1328 n.3. That holding applies to both voluntary, and involuntary, dismissals without prejudice. *Bennett Regulator Guards, Inc. v. Atlanta Gas Light Co.*, 905 F.3d 1311, 1314–15 (Fed. Cir. 2018).

Exclusive licensee, Preservation Technologies LLC, filed a complaint against MindGeek USA Inc. for infringement of the ’638 patent. Pet. 5. The complaint was served on October 14, 2014. *Id.* On February 2, 2015, Preservation Technologies LLC filed a notice of voluntary dismissal of the complaint. *Id.* Petitioner filed the Petition on December 11, 2018, several years after the 2014 complaint against MindGeek USA Inc. was served.

Petitioner acknowledges the holding in *Click-to-Call*, but argues that “*Click-to-Call* was incorrectly decided.” *Id.* at 5–6. Petitioner argues that we should instead follow *Sling TV, LLC v. Realtime Adaptive Streaming, LLC*, IPR2018-01331, Paper No. 9 (Jan. 31, 2019), a non-precedential Board decision where a Board panel determined that § 315(b) requires petitioner be served with a *patent owner’s* complaint to trigger the one-year time bar. Reply 2–3. Patent Owner argues that “*Click-to-Call* is clearly relevant to the present IPR and its holding that a complaint’s later voluntary dismissal has no bearing on the one year time bar of 35 U.S.C. § 315(b) is controlling.” Prelim. Resp. 6. Patent Owner further argues that “[t]he 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).” Sur-Reply 1. As such, Patent Owner argues that Petitioner is time barred under 35 U.S.C. § 315(b) and the Petition should be denied. Prelim. Resp. 6; Sur-Reply 2. We agree with Patent Owner.

Here, Petitioner filed the Petition more than one year after the October 14, 2014 service of the complaint alleging infringement of the ’638 patent. As in *Click-to-Call*, the defendant (Petitioner) was served with a complaint by an exclusive licensee (Preservation Technologies LLC), not the patent owner. The court in *Click-to-Call* held that such service (from an exclusive licensee) barred the defendant from filing a petition for *inter partes* review more than a year later, despite the fact that the complaint was subsequently voluntarily dismissed. 899 F.3d at 1328 n.3. *Sling TV* is a non-precedential Board decision, which we are not bound to follow. In addition, we note *Sling TV* did not address the issue of whether service by an exclusive licensee of a complaint triggers the one-year bar in § 315(b).<sup>3</sup> Based on current case law regarding 35 U.S.C. § 315(b), the Petition was not timely filed, and therefore, we do not institute *inter partes* review of the ’638 patent.

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<sup>3</sup> We also observe that an exclusive licensee can have standing to sue in its own name, without joining the patent holder. *See, e.g., Int’l Gamco, Inc. v. Multimedia Games, Inc.*, 504 F.3d 1273, 1276 (Fed. Cir. 2007).

### III. CONCLUSION

For the foregoing reasons, we determine the Petition is time-barred pursuant to 35 U.S.C. § 315(b), and do not institute *inter partes* review in this proceeding.

### IV. ORDER

Accordingly, it is:

ORDERED that the Petition is *denied*.

IPR2019-00423  
Patent 6,574,638 B1

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