

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LIGHTRICKS LTD.,
Petitioner,

v.

PLOTAGRAPH, INC. and SASCHA CONNELLY,
Patent Owners

IPR2023-00153
U.S. Patent No. 10,346,017

**PATENT OWNERS PLOTAGRAPH, INC. AND SASCHA
CONNELLY'S PRELIMINARY RESPONSE**

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Patent Owners Plotagraph, Inc. and Sascha Connelly (“Patent Owners”) hereby submit this Preliminary Response to the Petition filed by Lightricks Ltd. (“Petitioner”) on January 17, 2023 in case IPR2023-00153 for review of claims 1-18 of U.S. Patent No. 10,346,017 (the ‘017 Patent).

I. Introduction

Petitioner filed a Petition for *Inter Partes* Review of U.S. Patent No. 10,346,017 Under 35 U.S.C. §312 (“the ‘017 Patent”, Exh. 1001) on January 17, 2023 (IPR2023-00153, Paper No. 1 (“Petition”)). But *inter partes* review is barred under 35 U.S.C. §315(b) because Petitioner was served, twice, with a Complaint alleging infringement of the ‘017 Patent more than one year before the Petition was filed.

II. Inter Partes Review is Barred Because Petitioner was Served with a Complaint More than One Year Prior to the Petition

Patent Owners filed a Complaint alleging infringement of three patents, including the ‘017 Patent, on November 24, 2021 in the U.S. District Court for the Southern District of Texas. (EX2001) That case, which the Petition refers to as “the Litigation” was *Plotagraph, Inc. v. Lightricks, Ltd.*, No. 4:21-cv-03873 (S.D. Tex. 2022). Exhibit 2002 is a Declaration attesting to facts

showing that Patent Owners served Petitioner with the Complaint at its Haifa, Israel office on December 23, 2021.

CERTIFICATE

The undersigned authority, **upon authorization from the Director of Courts**, has the honor to certify, in conformity with Article 6 of the Convention,

- 1) That the documents directed to **Lightricks** have been served*
 - The 23\12\21
 - At Andrei Saharov 9 Street, Haifa 3508409 Israel.

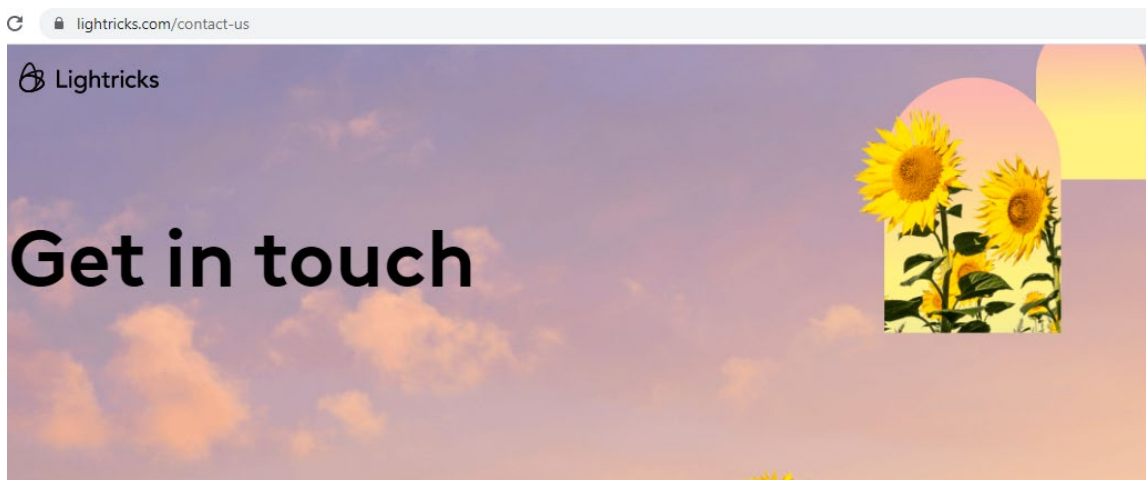
(See EX2002, p. 5). Then, Patent Owners served Petitioner at its Jerusalem, Israel office on January 4, 2022.

CERTIFICATE

The undersigned authority, **upon authorization from the Director of Courts**, has the honor to certify, in conformity with Article 6 of the Convention,

- 1) That the documents directed to **Lightricks Company** have been served*
 - The 04\01\22
 - At Prof. Rakach Street 5.4, Jerusalem 9190401 Israel.
- a) In accordance with the provisions of sub-paragraph (a) of the first paragraph of Article 5 of the Convention*.

(EX2002, p. 7). Both service locations are Lightricks offices according to its website:



www.lightricks.com/contact-us retrieved on March 17, 2023. Both service dates are more than one year before Petitioner filed the present petition on January 17, 2023.

35 U.S.C. §315(b) states that “[a]n *inter partes* review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner . . . is served with a complaint alleging infringement of the patent.” 35 U.S.C. §315(b). To be timely, Petitioner needed to file its Petition no later than December 23, 2022.

III. Conclusion

The Petition should be and must be denied. *Inter partes* review is statutorily barred here.

Dated this 15th day of June, 2023.

Respectfully submitted,

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PATENT OWNERS' EXHIBIT LIST

Exhibit 2001 – Plaintiffs' Original Complaint and Demand for Jury Trial for Plotagraph v. Lightricks Litigation.

Exhibit 2002 – Declaration of Marcellous S. McZeal

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §42.6(e) the undersigned certifies that on June 15, 2023, the foregoing PATENT OWNERS PLOTAGRAPH, INC. AND SASCHA CONNELLY'S PRELIMINARY RESPONSE was served via electronic mail upon the following counsel of record for the Petitioner:

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CERTIFICATE OF WORD COUNT

The foregoing PATENT OWNERS PLOTAGRAPH, INC. AND SASCHA CONNELLY'S PRELIMINARY RESPONSE complies with the type-volume limitations of 37 C.F.R. §42.24(b)(2). Excluding the items listed in 37 C.F.R. 42.24(a)(1) as not included in the word count, and using the word count of the word-processing system used to prepare the paper (Microsoft Word), the Response contains 348 words.

/s/ Shawn Hunter
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