

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LIGHTRICKS LTD.,
Petitioner

v.

PLOTAGRAPH, INC. and SASCHA CONNELLY,
Patent Owner

IPR2023-00154
Patent 10,621,469 B2

PETITIONER'S REPLY TO PATENT OWNER'S
PRELIMINARY RESPONSE

Petitioner's Exhibit List

Exhibit	Shorthand	Description
1001	'469 Patent	U.S. Patent No. 10,621,469
1002	Greenspun	Declaration of Philip Greenspun, Ph.D.
1003	AEM	Adobe® After Effects® Help and tutorials, Adobe (2013)
1004	IMU-Home	Wayback Machine Capture dated Mar. 27, 2012 of Anthony Thyssen, <i>Examples of ImageMagick Usage (Version 6)</i> , ImageMagick (Mar. 15, 2011), http://www.imagemagick.org/Usage/ [https://web.archive.org/web/20120327064501/http://www.imagemagick.org/Usage/]
1005	IMU-Distorting	WayBack Machine Capture dated Mar. 29, 2012 of Anthony Thyssen, <i>ImageMagick v6 Examples - - Distorting Images</i> , ImageMagick (Mar. 21, 2012), http://www.imagemagick.org/Usage/distorts/ [https://web.archive.org/web/20120329131929/http://www.imagemagick.org/Usage/distorts/]
1006	IMU-Masking	Wayback Machine Capture dated Sept. 28, 2012 of Anthony Thyssen, <i>ImageMagick v6 Examples - - Masks</i> , ImageMagick (Mar. 10, 2011), http://www.imagemagick.org/Usage/masking/ [https://web.archive.org/web/20120928070642/http://www.imagemagick.org/Usage/masking/]
1007	IMU-Animating	Wayback Machine Capture dated Mar. 10, 2012 of Anthony Thyssen, <i>ImageMagick v6 Examples - - Animation Basics</i> , ImageMagick (Feb. 8, 2011), http://www.imagemagick.org/Usage/anim_basics/ [https://web.archive.org/web/20120310193613/http://www.imagemagick.org/Usage/anim_basics/]
1008	IMU-Windows	Wayback Machine Capture dated Apr. 5, 2012 of Anthony Thyssen, <i>ImageMagick v6 Examples -- Usage under Windows</i> , ImageMagick (Mar. 21, 2012), http://www.imagemagick.org/Usage/windows/ [https://web.archive.org/web/20120405151502/http://www.imagemagick.org/Usage/windows/]

1009	Okabe	Makato Okabe, et al., <i>Creating Fluid Animation from a Single Image using Video Database</i> , 30 Computer Graphics Forum 1973 (2011)
1010	Li	Yin Li, et al., Lazy Snapping, 23 ACM Transactions on Graphics 303 (2004)
1011	'469 PH	Prosecution history of U.S. Patent No. 10,621,469
1012	Archive	Declaration of Nathaniel E Frank-White of the Internet Archive
1013	Lindahl	U.S. Patent No. 9,466,127
1014	McNally	U.S. Patent No. 9,070,222
1015	Siddharth	U.S. Patent App. Pub. No. 2014/0087797
1016	Brookhart	U.S. Patent No. 9,400,942
1017	Sakiyama	U.S. Patent No. 9,692,974
1018	Forbes	Angus Graeme Forbes et al., <i>Analyzing Intrinsic Motion Textures Created from Naturalistic Video Captures</i> , 2014 International Conference on Information Visualization Theory and Applications 107 (2014)
1019	Luo	U.S. Patent No. 8,280,164
1020	Tang	U.S. Patent No. 8,913,847
1021		Notice of Docketing, <i>Plotagraph, Inc. v. Lightricks, Ltd.</i> , No. 23-1048, Dkt. No. 1 (Fed. Cir. Oct. 17, 2022)
1022		Plaintiffs' Unopposed Sworn Motion for Leave to Extend Time to Comply with P.R. 3-1 and P.R. 3-2 Disclosure [sic] of Asserted Claims and Preliminary Infringement Contentions and Make Document Production, <i>Plotagraph, Inc. v. Lightricks Ltd.</i> , Civil Action No. 4:21-cv-03873, Dkt. No. 38 (S.D. Tex. May 5, 2022)
1023	'342 Patent	U.S. Patent No. 10,558,342
1024	Hair	U.S. Patent No. 6,014,491
1025	Waiver	Waiver of the Service of Summons from <i>Plotagraph, Inc. v. Lightricks Ltd.</i> , 4:21-cv-03873 (S.D. Tex. 2021)
1026	Complaint Exhibits	Exhibits A-D of the Complaint from <i>Plotagraph, Inc. v. Lightricks Ltd.</i> , 4:21-cv-03873 (S.D. Tex. 2021)

1027	Rosenberg-Segalovitz	Declaration of Noa Rosenberg-Segalovitz
1028	Jan. 4 Service	January 4, 2022 Correspondence to Lightricks's Jerusalem, Israel Office from Israel's Courts Administration
1029	Cover Page Translation	English Translation of the Cover Page of the January 4, 2022 Correspondence to Lightricks's Jerusalem, Israel Office from Israel's Courts Administration
1030	Megidish	Declaration of Idan Megidish
1031	Matam Park	Map of Matam Park and List of Buildings in Matam Park, <i>available at</i> https://www.matam.co.il/wp-content/uploads/Map-of-Matam-Park-2021.pdf and https://www.matam.co.il/en/buildings/
1032	Waiver Correspondence	Email correspondence between Robert Greeson, Erik Janitens, and Marcellous McZeal regarding service of the complaint and waiver of service
1033	Ling	Declaration of Lu Ling
1034	Greeson	Declaration of Robert Greeson
1035	Email Submission	January 23, 2023 Emails from Lu Ling to Trials@uspto.gov and PTABP-TACTSAdmin@uspto.gov submitting the Petition, Power of Attorney, and Exhibits in IPR2023-00154
1036	Email Confirmation	January 23 to January 24, 2023 Emails between Lu Ling and Trials@uspto.gov regarding submission of Petition, Power of Attorney, and Exhibits in IPR2023-00154
1037	P-TACTS Public	P-TACTS Public Search Results for IPR2023-00154 on https://ptacts.uspto.gov/ptacts/ui/public-search
1038	P-TACTS Private	P-TACTS AIA review information for IPR2023-00154, <i>available at</i> https://ptacts.uspto.gov/ptacts/ui/case-viewer/16162206/IPR2023-00154/aia-review-info
1039	USPTO Payment Methods	USPTO Accepted payment methods, <i>available at</i> https://www.uspto.gov/learning-and-resources/fees-and-payment/accepted-payment-methods

PO contends that § 315(b) bars institution because PO “served Petitioner with [a] Complaint” on “December 23, 2021” and “January 4, 2022,” which “are more than one year before Petitioner filed the present petition.” POPR, 1-3. But the Petition is timely because service on those dates was defective and instead occurred on January 21, 2022, when PO filed Petitioner’s waiver of service (EX1025). Both Parties relied on the waiver’s filing date as the operative service date in the Litigation, and only now, for the first time, does PO raise this issue.

I. THE PRE-WAIVER SERVICE ATTEMPTS WERE DEFECTIVE

Section 315(b)’s language “means ‘presented with a complaint or delivered a complaint in a manner prescribed by law,’” which “is governed by Federal Rule of Civil Procedure 4 (‘Rule 4’).” *GoPro, Inc. v. 360Heros, Inc.*, IPR2018-01754, Paper 38 at 8-10 (PTAB Aug. 23, 2019) (precedential); *In-Depth Geophysical, Inc. v. ConocoPhillips Co.*, IPR2019-00850, Paper 14 at 8 (PTAB Sep. 6, 2019); *Game & Tech. Co. v. Wargaming Grp. Ltd.*, 942 F.3d 1343, 1350 (Fed. Cir. 2019). “Strict compliance with the Federal Rules of Civil Procedure is required for service” to trigger § 315(b). *Laskowski v. AG of Tex.*, 2005 U.S. Dist. LEXIS 49707, at *2 (S.D. Tex. Aug. 12, 2005); *In-Depth*, IPR2019-00850, Paper 14 at 11-12 (no “case holding that Section 315(b) may be triggered by delivery of a complaint in a manner that does not constitute service under Rule 4[.]”). The Dec. 23 and Jan. 4 service attempts did not comply with Rule 4 and thus did not trigger the § 315(b) time bar.

A. Both Attempts: Petitioner Did Not Receive the Full Complaint

Because Petitioner is a foreign corporation, Rule 4 requires “serv[ice of] a copy of the complaint” by a means “authorized by the Hague Convention on the Service Abroad of Judicial and Extrajudicial Documents” (the “Convention”). Fed. R. Civ. P. 4(c)(1), (f), (h)(2), committee note to 1993 amendment (Convention is “mandatory”). PO asserts that the allegedly-delivered document—EX2001—is the “filed [] Complaint,” but omits that the complaint relied upon “[a]ttached” Exhibits A-D (EX1026)¹ that the allegedly-delivered EX2001 does not contain. POPR, 1-3; EX2002, ¶¶2-4; EX2001, ¶¶14, 21, 31, 42. Because “a complaint” is a “pleading” (Fed. R. Civ. P. 7) and “an exhibit to a pleading is a part of the pleading for all purposes” (Fed. R. Civ. P. 10(c) (emphasis added)), “the exhibits to the [complaint] must also be served, regardless of whether they were filed at the same time.” *Rodriguez*, 748 F.3d at 1076-77 (emphasis added); *Sixta v. Thaler*, 615 F.3d 569, 572 (5th Cir. 2010) (must “serve both the [pleading] *and* any exhibits attached

¹ While PO included Exhibits A-D as a subsequent filing before the service attempts, it did not serve them, and “documents filed separate from the [pleading], but referred to in it, are considered part of the [pleading] and are therefore also subject to the service requirement.” See EX1026 (“Filed on 12/14/21”); *Rodriguez v. Fla. Dep’t of Corr.*, 748 F.3d 1073, 1076 (11th Cir. 2014) (emphasis added).

thereto”). This Rule 4 requirement for what must be served (Fed. R. Civ. P. 4(c)(1)) is unchanged by the Convention’s means of service (Fed. R. Civ. P. 4(f)). Convention, Articles 3, 5 (specifying delivery “method,” not contents of “document to be served”); *Pta-Fla, Inc. v. Zte Corp.*, 2014 U.S. Dist. LEXIS 203434, at *5 (D. S.C. Nov. 18, 2014) (“service under the Hague Convention was inadequate” for lacking “the exhibits to the complaint” that “is incomplete without them”).

PO does not assert that it attempted service of Exhibits A-D, and Petitioner did not receive them. POPR, 1-3 (only EX2001); EX2002, ¶¶2-4 (same); EX1027, ¶¶7-15 (did not receive Dec. 23 attempt, and Exhibits A-D missing from Jan. 4 attempt); EX1028 (no Exhibits A-D in received document); EX1030, ¶¶2-4 (did not receive Dec. 23 attempt). Because Petitioner was not “served with a complete copy of the operative complaint, including its attachments,” the service attempts did “not compl[y] with Rule 4” and thus did not trigger the § 315(b) time bar. *Ringgold v. Burgett, Inc.*, 2022 U.S. Dist. LEXIS 188622, at *3-5 (E.D. Cal. Oct. 14, 2022); *Danik v. Hous. Auth.*, 396 F. App’x 15, 16 (4th Cir. 2010) (service of “only the complaint, without the appended materials” is defective). Indeed, Mr. McZeal—after informed of these defects (EX1032, 4)—tacitly agreed that the attempts were not deadline-triggering: he “agree[d] with [Petitioner’s] interpretation of the Rules” that “the deadline” for a “responsive pleading” was based on when “the request [for waiver of service] was sent” under “FRCP 4(d)(3)” (*id.*, 2-4), not “within 21 days”

of the service attempts as would have been required if the service attempts were legally operative (Fed. R. Civ. P. 12(a)(1)(A)).

B. December 23 Attempt: Not Delivered to Petitioner

The Dec. 23 service attempt was allegedly delivered to an unnamed person “[i]n accordance with” Article 5(a) of the Convention, i.e., per Israel’s “internal law.” EX2002, 5; Convention, Article 5(a). That attempt was independently defective and thus not time-bar-triggering because Israel requires “personal delivery” or mail “delivery ... to the [recipient’s] address” (EX1027, ¶5) and the attempt was to an address of a large business park (EX1031, 1-5) and not to Petitioner’s building-specific address (EX1027, ¶8; EX2002, 5 (omitting “Building 22”)). And Petitioner did not receive the attempt. EX1027, ¶¶6-9; EX1030, ¶¶2-4.

II. THE SERVICE DATE IS THE DATE PO FILED THE WAIVER

PO sent Petitioner a request for waiver of service (EX1032, 1), which Petitioner executed and PO filed on January 21, 2022 (EX1025). That waiver is dispositive of the Rule 4 and thus § 315(b) service date, regardless of the propriety of the pre-waiver service attempts: “[w]hen the plaintiff files a waiver ... these rules apply as if a ... complaint had been served at the time of filing the waiver,” on January 21, 2022. Fed. R. Civ. P. 4(d)(4) (emphasis added); *Motorola Mobility LLC v. Arnouse*, IPR2013-00010, Paper 20 at 6 (PTAB Jan. 30, 2013) (informative) (“the one-year time period begins on the date on which such a waiver is filed”).

One year from January 21, 2022 “f[e]ll[] on Saturday,” rendering “the next succeeding secular or business day”—January 23, 2023—the § 315(b) petition deadline. 35 U.S.C. § 21(b); *Samsung Elecs. Co., LTD. v. Immersion Corp.*, IPR2018-01468, Paper 10 at 17-19 (PTAB Feb. 20, 2019). On that day, Petitioner served all required IPR documents and filed them via both P-TACTS and—after receiving P-TACTS error notifications—email as P-TACTS instructed. Pet., 96, 98; EX1033, ¶¶3-15; EX1035, 1-7. Petitioner also successfully paid the IPR filing fee twice on January 23 via debit card and deposit account as the Office accepts (EX1039): P-TACTS, despite initially not registering the payments, stated that both were “processed” (EX1033, ¶¶5-6, 9-11), both payments were in fact processed (*id.*, ¶¶8, 12; EX1034, ¶¶3-4), the Office acknowledges that “[b]oth payments methods were successful” (EX1036, 3), and P-TACTS now reflects that the “Payment” was on “01/23/2023” (EX1038, 3). While the Notice of Filing Date Accorded (Paper 3) states that “the filing date [is] January 24, 2023,” Petitioner met all requirements of § 312 and 37 C.F.R. § 42.106 on January 23 (*supra*) such that—as P-TACTS reflects (EX1037)—the petition was timely filed on that day. *Toshiba Am. Elec. Components, Inc. v. Monument Peak Ventures, LLC*, IPR2021-00330, Paper 20 at 2, 8, 11-12, 15-16 (PTAB Jan. 14, 2022) (precedential) (revising filing date to when “Petitioner complied with the published USPTO instructions”).

Dated: June 22, 2023

/Robert Greeson/
Robert Greeson (Reg. No. 52,966)

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on June 22, 2023, copies of Petitioner's Reply to Patent Owner's Preliminary Response and Exhibits 1025-1039 were served on Patent Owner via email (by consent) to:

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