UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LIGHTRICKS LTD.,
Petitioner,

v.

PLOTAGRAPH, INC. and SASCHA CONNELLY,
Patent Owners

IPR2023-00154
U.S. Patent No. 10,621,469

PATENT OWNER PLOTAGRAPH, INC. AND SASCHA CONNELLY'S PRELIMINARY SUR-REPLY

"The IPR petitioner bears the burden of persuasion to demonstrate that its petitions are not time-barred under 315(b)." *Worlds Inc. v. Bungie, Inc.*, 903 F.3d 1237, 1242 (Fed. Cir. 2018). Petitioner has failed to meet that burden. Although Petitioner disputes that it received a complaint at all on December 23, 2021, notwithstanding that Patent Owner possesses evidence Petitioner was properly served on that date (EX2002), Petitioner concedes that it was served with a complaint on January 4, 2022. Petitioner's Reply at 3 ("did not receive Dec. 23 attempt, and Exhibits A-D missing from Jan. 4 attempt"). This is sufficient to bar *inter partes* review in this case.

Even though Petitioner repeatedly claims that "service" was defective, this is a mischaracterization since Petitioner actually was served with the complaint thereby providing it with notice of the lawsuit on January 4, 2022. Petitioner's own Exhibit 1028 proves that the complaint itself was included in what was served upon Lightricks on January 4, 2022 in accordance with the law under the Hague Convention and FRCP Rule 4(l)(2)(A)(see Petitioner's Exhibit 1028, pps. 1-2 evidence service under the Hague Convention, pps. 3-5 are the Court issued Summons, pps. 6-18 are the Court's file-stamped complaint). Indeed, Petitioner's counsel contacted Patent Owners' counsel as a result of this service under the Hague Convention.

Petitioner was Provided Notice of the Litigation

"Congress chose the date of service, as opposed to some other event, as the trigger for §315(b)'s time bar because service of a complaint is the seminal notice-conferring event in a district court action." *Click-to-Call Techs., LP v. Ingenio, Inc.*, 899 F.3d 1321, 1332 (Fed. Cir. 2018)(en banc in part). Service of the complaint, as precisely required by 35 U.S.C. §315(b), gave Petitioner notice of the lawsuit on January 4, 2022. Petitioner's correspondence with Mr. McZeal on January 6, 2022 concedes that the complaint was served by stating that ". . . not all of the complaint was sent to Lightricks." Exhibit 1032 at 4. Exhibits A-D to the complaint were merely a cease-and-desist letter which Petitioner has been sent previously and copies of the patents-in-suit which are publicly available documents. See Exhibit 1026, pps. 1-68. Even if these exhibits were not included with the complaint served on January 4, 2022 their absence did nothing to prevent Petitioner from being placed on notice of the litigation.

§315(b)'s Time Bar is Triggered Despite a Defect in the Complaint

Petitioner is really alleging that the served complaint itself was defective because it was missing Exhibits A-D as attachments. But a defect in the complaint does not prevent the statutory time bar from being triggered.

The Board has held that "[t]he service of a pleading asserting a claim alleging infringement, including where the serving party lacks standing to sue or the pleading is otherwise deficient, triggers the one-year time period for a petitioner to file a petition under 35 U.S.C. §315(b)." *GoPro, Inc. v. 360Heros, Inc.*, Case IPR2018-01754, slip op. at 24 (PTAB August 23, 2019)(Paper No. 38)(Precedential)(emphasis added). "For purpose of conferring notice, it does not matter whether the complaint was proper." *GoPro*, slip. op. at 15.

Petitioner's Case Citations are Distinguishable

Patent Owner submits that the *GoPro* and *Click-to-Call* decisions are controlling authority here. Cases that Petitioner has cited to try to show that "service" in this case was defective are either inapplicable or not controlling here. *In-Depth Geophysical, Inc. v. ConocoPhillips Co.* was a case in which the patent owner merely mailed the ". . . Texas Complaint and Summons via certified mail to . . ." the petitioner. IPR2019-00850, Paper 14 at 10 (PTAB Sep. 6, 2019). There was no service involved as there is here. *Ringgold v. Burgett, Inc.*, 2022 U.S. Dist. LEXIS 188622 (E.D. Cal. Oct. 14, 2022) simply cites *dicta* from an order by a magistrate judge recommending dismissal of a motion to dismiss and granting a *pro se* "plaintiff an extension of time to

effectuate proper service of the summons and complaint upon the defendants." 2022 U.S. Dist. LEXIS 188622 at 1. *Ringgold* did not involve 35 U.S.C. §315(b).

The Waiver of Service is Unimportant

Petitioner's reply makes much of the fact that a waiver of service was later filed with the district court and that the "Parties" allegedly "relied on the waiver's filing date as the operative service date . . . ." Reply at 1. A waiver under FRCP Rule 4(d) is unimportant if service has previously been completed, as is the case here. "Simply put, §315(b)'s time bar is implicated once a party receives notice through official delivery of a complaint in a civil action, irrespective of subsequent events." *Click-to-Call* at 1330. "[W]e consider only the date on which a complaint was *served* in accordance with the law, without the added condition of whether that complaint was a *proper* complaint – e.g., . . . not otherwise containing a defect." *GoPro*, slip. op. at 15. The later waiver of service does not "unring the bell" or reset the date for §315(b)'s time bar clock to start. This is why it would make no difference at all even if the parties were to choose to treat the waiver's filing date as the operative service date. Petitioner was provided notice on January 4, 2022, and nothing changes that. As the Board noted in *GoPro*, ". . . the plain language of 'served with a complaint' does not contain any exceptions or

exemptions . . . .” *GoPro*, slip op. at 9 (citing *Click-to-Call*). More to the point, “. . . a party ‘served with a complaint’ ‘remains served with the complaint,’ regardless of whether . . . the pleading was otherwise deficient.” *Id.* at 21. The one-year time bar in this case was triggered and began to run on January 4, 2022 without regard to a later filing of a waiver of service. Because Petitioner’s petition is time-barred, the Board lacks jurisdiction to institute IPR proceedings. *Click-to-Call* at 1325. *Inter partes* review must be denied.

Dated this 28th day of June, 2023.

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §42.6(e) the undersigned certifies that on June 28, 2023, the foregoing PATENT OWNERS PLOTAGRAPH, INC. AND SASCHA CONNELLY'S SUR-REPLY was served via electronic mail upon the following counsel of record for the Petitioner:

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