

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

THE WALT DISNEY COMPANY, DISNEY STREAMING SERVICES LLC,
HULU LLC, and NETFLIX INC.
Petitioners

v.

WAG ACQUISITION, L.L.C.
Patent Owner

U.S. Patent No. 9,729,594

Inter Partes Review Case No. 2023-00813

**PATENT OWNER MANDATORY NOTICES
INFORMATION UNDER 37 C.F.R. § 42.8**

Pursuant to 37 C.F.R. § 42.8, WAG ACQUISITION, L.L.C. respectfully submits the following Mandatory Notices.

I. REAL PARTY IN INTEREST

Patent Owner WAG ACQUISITION, L.L.C. is the real party in interest.

II. RELATED MATTERS

A. Judicial Matters:

U.S. Patent No. 9,729,594 is involved in four pending district court proceedings:

1. *WAG Acquisition, L.L.C. v. Amazon.com, Inc. et al.*, Case No. 6:21-cv-00815 (W.D. Tex.), filed on August 6, 2021.
2. *WAG Acquisition, L.L.C. v. Google LLC et al.*, Case No. 6:21-cv-00816 (W.D. Tex.), filed on August 6, 2021.
3. *WAG Acquisition, L.L.C. v. Netflix, Inc.*, Case No. 6:21-cv-01083 (W.D. Tex.), filed on October 18, 2021.
4. *WAG Acquisition, L.L.C. v. The Walt Disney Company et al.*, Case No. 2:21-cv-08230 (C.D. Cal.), filed on October 18, 2021.

U.S. Patent No. 9,729,594 was involved in the below case, which was consolidated with *WAG Acquisition, L.L.C. v. The Walt Disney Company et al.*, Case No. 2:21-cv-08230 and closed on February 23, 2022:

1. *WAG Acquisition, L.L.C. v. Hulu LLC*, Case No. 2:21-cv-08230 (C.D.

Cal.), filed on October 18, 2021.

U.S. Patent Nos. 8,122,141, 8,327,011, 8,185,611, and 8,364,839 are related to U.S. Patent No. 9,729,594 and are involved in the below pending district court proceeding, which is currently stayed:

1. *WAG Acquisition, LLC v. FriendFinder Networks, Inc. et al.*, Case No. 3:19-cv-05036 (N.D. Cal.), originally filed as Case No. 2-14-cv-03456 (D.N.J.) on May 30, 2014.

U.S. Patent Nos. 6,766,376, 8,122,141, 8,327,011, 8,185,611, and 8,364,839 are related to U.S. Patent No. 9,729,594 and were involved in one or more of the below district court proceedings, which all have been dismissed:

1. *WAG Acquisition, L.L.C. v. XM Satellite Radio, Inc. et al.*, Case No. 1:08-cv-06357 (S.D.N.Y.), originally filed as Case No. 4:07-cv-00034 (N.D. Miss.) on Feb. 27, 2007.
2. *WAG Acquisition, LLC v. Sobonito Investments, Ltd. et al.*, Case No. 2-14-cv-01661 (D.N.J.), filed on March 14, 2014.
3. *WAG Acquisition, LLC v. Multi Media, LLC et al.*, Case No. 2:19-cv-07076 (C.D. Cal.), originally filed as Case No. 2-14-cv-02340 (D.N.J.) on April 11, 2014.
4. *WAG Acquisition, LLC v. Data Conversions, Inc. et al.*, Case No. 3:19-cv-00489 (D.N.V.), originally filed as Case No. 2-14-cv-02345 (D.N.J.)

on April 11, 2014.

5. *WAG Acquisition, LLC v. Flying Crocodile, Inc. et al.*, Case No. 2:19-cv-01278 (W.D. Wash.), originally filed as Case No. 2-14-cv-02674 (D.N.J.) on April 25, 2014.
6. *WAG Acquisition, LLC v. Gatty Group S.à r.l. et al.*, Case No. 2-14-cv-02832 (D.N.J.), filed on May 5, 2014.
7. *WAG Acquisition, LLC v. MFCXY, Inc. et al.*, Case No. 2-14-cv-03196 (D.N.J.), filed on May 16, 2014.
8. *WAG Acquisition, LLC v. Vubeology, Inc. et al.*, Case No. 1:19-cv-00805 (W.D. Tex.), originally filed as Case No. 2-14-cv-04531 (D.N.J.) on July 17, 2014.
9. *WAG Acquisition, LLC v. GameLink Int'l Ltd. et al.*, Case No. 2-15-cv-03416 (D.N.J.), filed on May 18, 2015.
10. *WAG Acquisition, LLC v. Webpower, Inc. et al.*, Case No. 9:19-cv-81155 (S.D. Fla.), originally filed as Case No. 2-15-cv-03581 (D.N.J.) on May 27, 2015.

B. Administrative Matters:

U.S. Patent No. 9,729,594 is or was the subject of the below proceedings:

1. *Inter Partes* Review Case No. IPR2022-01346, filed on August 2, 2022 (institution was denied).

2. *Inter Partes* Review Case No. IPR2022-01411, filed on August 12, 2022
(this is the IPR that the Petitioners seek to join in).

3. *Inter Partes* Review Case No. IPR2022-01429, filed on August 24, 2022
(institution was denied).

U.S. Patent Nos. 9,742,824 and 9,762,636 are related to U.S. Patent No. 9,729,594 and are the subject of one or more of the below proceedings, which are pending and certain of which were filed by Petitioners:

1. *Inter Partes* Review Case No. IPR2022-01228, filed on July 8, 2022 by
Petitioners The Walt Disney Company, Disney Streaming Services LLC,
Hulu LLC, and Netflix Inc.

2. *Inter Partes* Review Case No. IPR2022-01227, filed on July 13, 2022 by
Petitioners The Walt Disney Company, Disney Streaming Services LLC,
and Hulu LLC.

3. *Inter Partes* Review Case No. IPR2022-01412, filed on August 12, 2022.

4. *Inter Partes* Review Case No. IPR2022-01413, filed on August 12, 2022.

5. *Inter Partes* Review Case No. IPR2022-01430, filed on August 23, 2022.

6. *Inter Partes* Review Case No. IPR2022-01433, filed on August 23, 2022.

U.S. Patent Nos. 8,122,141, 8,327,011, 8,185,611, and 8,364,839 are related to U.S. Patent No. 9,729,594 and are the subject of one or more of the below reexamination proceedings, which are pending:

1. *Ex Parte* Reexamination Control No. 90/014,833, which is pending.
2. *Ex Parte* Reexamination Control No. 90/014,834, which is pending.
3. *Ex Parte* Reexamination Control No. 90/014,836, which is pending.
4. *Ex Parte* Reexamination Control No. 90/014,835 was denied on November 12, 2021. The requesters filed a petition for review of the denial, which remains pending.

U.S. Patent Nos. 8,122,141, 8,327,011, 8,185,611, and 8,364,839 are related to U.S. Patent No. 9,729,594 and are the subject of one or more of the below PTAB proceedings, which have resulted in a final written decision or were terminated:

1. *Inter Partes* Review Case No. IPR2015-01033, in which a decision denying institution of *inter partes* review issued on Oct. 19, 2015.
2. *Inter Partes* Review Case No. IPR2015-01035, in which a decision denying institution of *inter partes* review issued on Oct. 23, 2015.
3. *Inter Partes* Review Case No. IPR2015-01036, in which a final written decision issued on Oct. 20, 2016.
4. *Inter Partes* Review Case No. IPR2015-01037, in which a decision denying institution of *inter partes* review issued on Oct. 19, 2015.
5. *Inter Partes* Review Case No. IPR2016-01161, in which a decision denying institution of *inter partes* review issued on Dec. 12, 2016.

6. *Inter Partes* Review Case No. IPR2016-01162, in which a decision denying institution of *inter partes* review issued on Dec. 12, 2016.
7. *Inter Partes* Review Case No. IPR2016-01238, in which a final written decision issued on Dec. 26, 2017.
 - a. *Inter Partes* Review Case No. IPR2017-00786, was joined with *Inter Partes* Review Case No. IPR2016-01238 on June 5, 2017 and was terminated.
 - b. *Inter Partes* Review Case No. IPR2017-00820, was joined with *Inter Partes* Review Case No. IPR2016-01238 on June 5, 2017 and was terminated.
8. *Inter Partes* Review Case No. IPR2016-01239, in which a final written decision issued on Dec. 26, 2017.
 - a. *Inter Partes* Review Case No. IPR2017-00784, was joined with *Inter Partes* Review Case No. IPR2016-01239 on Mar. 31, 2017 and was terminated.
 - b. *Inter Partes* Review Case No. IPR2017-00785, was joined with *Inter Partes* Review Case No. IPR2016-01239 on Apr. 13, 2017 and was terminated.
9. *Inter Partes* Review Case No. IPR2016-01655, in which a decision denying institution of *inter partes* review issued Feb. 27, 2017.

10. *Inter Partes* Review Case No. IPR2016-01656, in which a termination decision issued on Feb. 26, 2018.

11. *Inter Partes* Review Case No. IPR2016-01657, in which a decision denying institution of *inter partes* review issued Feb. 27, 2017.

12. *Inter Partes* Review Case No. IPR2016-01658, in which a termination decision issued on Feb. 27, 2018.

a. *Inter Partes* Review Case No. IPR2017-01179, was joined with *Inter Partes* Review Case No. IPR2016-01658 on Oct. 5, 2017 and was terminated.

III. COUNSEL

Lead Counsel	Back-up Counsel
Ronald Abramson (Reg. No. 34,762) ron.abramson@listonabramson.com Liston Abramson LLP 405 Lexington Ave, 46th Floor New York, NY 10174 Telephone: (212) 257-1630 Facsimile: (914) 462-4175	M. Michael Lewis (Reg. No. 50,478) Ari J. Jaffess (Reg. No. 74,558) Gina K. Kim (Reg. No. 69,639) michael.lewis@listonabramson.com ari.jaffess@listonabramson.com gina.kim@listonabramson.com Liston Abramson LLP 405 Lexington Ave, 46th Floor New York, NY 10174 Telephone: (212) 257-1630 Facsimile: (914) 462-4175

IV. SERVICE INFORMATION

Electronic mail address:

ron.abramson@listonabramson.com

michael.lewis@listonabramson.com

ari.jaffess@listonabramson.com

gina.kim@listonabramson.com

Electronic service on lead and back up counsel is approved and preferred.

Any postal mail, courier, or hand delivery regarding this proceeding may be directed to lead and back-up counsel at the addresses listed above.

Dated: August 26, 2023

Respectfully submitted,

/Ronald Abramson/

Ronald Abramson

(Attorney for Patent Owner)

Reg. No. 34,762

212-257-1643

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing Patent Owner Mandatory Notices Information Under 37 C.F.R. § 42.8, dated August 26, 2023, was served on Petitioners by filing through the Patent Trial and Appeal Case Tracking System (P-TACTS) and via email to larissa.bifano@dlapiper.com, thomas.fuller@us.dlapiper.com, and Jennifer.nall@us.dlapiper.com, as authorized in Petitioners' mandatory notices.

Dated: August 26, 2023

/Ronald Abramson/
Ronald Abramson
(Attorney for Patent Owner)
Reg. No. 34,762
212-257-1643