

From: [Naveed Hasan](#)
To: [Trials](#)
Cc: [Jaime Cardenas-Navia](#); [Michael Matulewicz-Crowley](#); [Carrano, Aliza George](#); [Mukerji, Indranil \(Indy\)](#); [Marshall, Steve](#); [Netflix-VL WFG](#); [RJ VideoLabs-Netflix](#)
Subject: RE: IPR2023-00891: Netflix, Inc. v. VL Collective, LLC
Date: Monday, February 12, 2024 5:36:11 PM

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Your Honors,

After meeting and conferring, Patent Owner and Petitioner are unable to agree to Patent Owner's discovery requests. As such, Patent Owner still seeks authorization to file a motion for additional discovery and request authorization for third party subpoenas to Unified Patents. Patent Owner believes that this is a complex topic, which includes dispositive issues such as named real-party of interests and estoppel, and therefore, should be thoroughly briefed. Patent Owner proposes the following page limits for the briefing:

1. Patent Owner's Motion For Additional Discovery and Third-Party Subpoenas (10 pages)
2. Petitioner's Opposition to Patent Owner's Motion For Additional Discovery and Third-Party Subpoenas (10 pages)
3. Patent Owner's Reply to Petitioner's Opposition (5 pages)

Patent Owner understood the board to have instructed the parties to provide an update regarding whether they could agree on Patent Owner's discovery requests — not to provide additional arguments on the issue, which was already thoroughly discussed. Thus, Patent Owner has not responded to Petitioner's arguments below, but intends to do so in the requested briefing.

Petitioner's Position

After the parties' meet and confer on February 8, 2024, Patent Owner identified several interrogatories and document requests that it seeks from Netflix. However, these requests have been denied by the Board. *See, e.g., Netflix Inc. et al. v. Divx LLC*, IPR2020-00052, Paper 10 at 7-8 (May 14, 2020). In an effort to compromise, Netflix agreed to answer one of the interrogatories and to provide either a declaration or answer an interrogatory that Netflix has no control or direction over Unified Patents and has had no involvement with IPR2022-01086 that was filed by Unified Patents. Patent Owner refused Netflix's offer and to confer any further.

Accordingly, Netflix opposes Patent Owner's request to file a motion for additional discovery as explained in Petitioner's position in the e-mail correspondence sent to the Board on January 30, 2024, and during the February 7, 2024 teleconference.

In the event the Board authorizes Patent Owner's motion for additional discovery, Petitioner proposes the following regarding briefing that is consistent with what the Board granted in *Netflix v.*

IPR2023-00891
Ex. 3001

Divx LLC, IPR2020-00052, Paper 7 at 3 (PTAB Dec. 19, 2019):

1. Patent Owner's Motion For Additional Discovery (5 pages)
2. Petitioner's Opposition to Patent Owner's Motion For Additional Discovery (5 pages)
3. No Reply

Regarding Patent Owner's request for authorization for third party subpoenas to Unified Patents, Petitioner also opposes this request. As the Board acknowledged during the February 7, 2024 teleconference, in IPR2022-01086 filed by Unified Patents, Mr. Jakel, a founder and current CEO of Unified Patents, submitted a declaration in that proceeding pertaining to the very issue in which Patent Owner seeks discovery. In IPR2022-01086, Patent Owner did not depose Mr. Jakel and did not request additional discovery on this issue. Patent Owner had the opportunity and chose not to pursue discovery in that proceeding. Patent Owner should not now be permitted to do so here.

* * *

Best regards,
Naveed

Naveed S Hasan | **REICHMAN JORGENSEN LEHMAN & FELDBERG LLP** | Office: (202) 894-7305 |
Mobile: (703) 347-3000

From: Naveed Hasan

Sent: Wednesday, January 31, 2024 3:01 PM

To: Trials <Trials@USPTO.GOV>

Cc: Jaime Cardenas-Navia <jcardenas-navia@reichmanjorgensen.com>; Carrano, Aliza George <ACarrano@willkie.com>; Mukerji, Indranil (Indy <IMukerji@willkie.com>; Marshall, Steve <SMarshall@willkie.com>; Netflix-VL_WFG <Netflix-VL_WFG@willkie.com>; RJ_VideoLabs-Netflix <RJ_VideoLabs-Netflix@reichmanjorgensen.com>

Subject: RE: IPR2023-00891: Netflix, Inc. v. VL Collective, LLC

Hi Esther,

Patent Owner and Petitioner are available on Wednesday, February 7, 2024 at 3:30 PM ET.

Best regards,
Naveed

Naveed S Hasan | **REICHMAN JORGENSEN LEHMAN & FELDBERG LLP** | Office: (202) 894-7305 |
Mobile: (703) 347-3000

From: Trials <Trials@USPTO.GOV>

Sent: Wednesday, January 31, 2024 10:05 AM

To: Naveed Hasan <nhasan@reichmanjorgensen.com>; Trials <Trials@USPTO.GOV>

Cc: Jaime Cardenas-Navia <jcardenas-navia@reichmanjorgensen.com>; Carrano, Aliza George

<ACarrano@willkie.com>; Mukerji, Indranil (Indy <IMukerji@willkie.com>; Marshall, Steve <SMarshall@willkie.com>; Netflix-VL_WFG <Netflix-VL_WFG@willkie.com>; RJ_VideoLabs-Netflix <RJ_VideoLabs-Netflix@reichmanjorgensen.com>

Subject: RE: IPR2023-00891: Netflix, Inc. v. VL Collective, LLC

CAUTION: EXTERNAL SENDER

Counsel,

The panel is available for a teleconference on Monday, Feb. 5, 2024, from 10 am –1 pm ET, and on Wednesday, Feb. 7, 2024, after 12 noon ET. Please confer to select a mutually agreeable time for a teleconference and respond to the Board with same.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Naveed Hasan <nhasan@reichmanjorgensen.com>

Sent: Tuesday, January 30, 2024 9:10 AM

To: Trials <Trials@USPTO.GOV>

Cc: Jaime Cardenas-Navia <jcardenas-navia@reichmanjorgensen.com>; Carrano, Aliza George <ACarrano@willkie.com>; Mukerji, Indranil (Indy <IMukerji@willkie.com>; Marshall, Steve <SMarshall@willkie.com>; Netflix-VL_WFG <Netflix-VL_WFG@willkie.com>; RJ_VideoLabs-Netflix <RJ_VideoLabs-Netflix@reichmanjorgensen.com>

Subject: IPR2023-00891: Netflix, Inc. v. VL Collective, LLC

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Your Honors,

As reflected in the Patent Owner's Mandatory Notices (Paper 7), the '794 patent is also at-issue in the following proceeding: *Unified Patents, LLC v. VL Collective IP, LLC*, IPR2022-01086 ('086 IPR). A Final Written Decision (FWD) was issued in the '086 IPR that addressed claims 1, 3, 5, 9, 12, 13, 15, 20, and 21.

Patent Owner intends to show that Netflix is a real party in-interest (RPI) in the '086 IPR and/or that Unified Patents is an RPI in IPR2023-00891 ('891 IPR). Patent Owner seeks authorization from the Board to move to (1) terminate the '891 IPR because Netflix and Unified are estopped from maintaining the '891 IPR; (2) request additional discovery from Netflix in support of Patent Owner's motion to terminate; and (3) request authorization for third party subpoenas to Unified Patents in

support of Patent Owner's motion to terminate. 35 U.S.C. § 315(e)(1); 37 C.F.R. § 42.52(a).

Netflix has previously produced evidence demonstrating that Netflix is an active member of Unified Patents in *Netflix Inc. et al. v. Divx LLC*, IPR2020-00052, EX2033, (May 14, 2020) and as such Netflix is a clear beneficiary that has a preexisting relationship with Unified. The discovery being requested is likely to yield additional evidence corroborating the relationship between Netflix and Unified and that they should be found to be real parties in interest in one another's petitions. As indicated below, Patent Owner intends to seek authorization from the Board to move to terminate the '891 IPR because Netflix and Unified are estopped from maintaining the '891 IPR pursuant to at least 35 U.S.C. § 315(e)(1) based on the RPI status of Netflix and Unified. Similar requests were granted in *Samsung Electronics Co., Ltd. v. MemoryWeb, LLC*, IPR2022-00222, Paper 44 (August 22, 2023).

Petitioner's Position

Petitioner Netflix opposes each of Patent Owner's requests. Patent Owner has no evidence that Netflix controlled or directed the filing of the '086 IPR or that Unified Patents has had any involvement with the '891 IPR. Patent Owner merely alleges that because Netflix is a member of Unified Patents then Netflix and Unified Patents must be real parties in interest in one another's petitions, despite there being no overlapping prior art between the two petitions. Accordingly, Patent Owner's mere allegation does not establish a sufficient basis for seeking discovery, and the Board should deny Patent Owner's requests. *See Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26, 6 (PTAB 2013) (precedential); *see also Unified Patents Inc. v. Universal Secure Registry LLC*, IPR2018-00067, Paper 54 at 72-75 (May 1, 2019).

* * *

Patent Owner and Petitioner are available for a telephone conference on the following dates and times:

- Wednesday, January 31: 11 am - 1 pm
- Thursday, February 1: 12 pm – 2:30 pm
- Friday, February 2: 11 am – 1 pm

Best Regards,

Naveed S Hasan

REICHMAN JORGENSEN LEHMAN & FELDBERG LLP

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