

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NETFLIX, INC.,
Petitioner,

v.

VL COLLECTIVE IP LLC,
Patent Owner.

IPR2023-00891
Patent 8,605,794 B2

Before KARL D. EASTHOM, JEFFREY S. SMITH, and
DAVID C. McKONE, *Administrative Patent Judges*.

EASTHOM, *Administrative Patent Judge*.

ORDER
Granting Patent Owner's Request to File a
Motion to Terminate the Proceeding under 35 U.S.C. § 315(e)(1)
37 C.F.R. § 42.20

INTRODUCTION

Pursuant to our authorization, VL Collective IP, LLC (“Patent Owner”) filed a Motion for Additional Discovery on February 28, 2024 (Paper 21, “Motion for Discovery”). Netflix, Inc. (“Netflix,” “Petitioner”) filed an Opposition to the Motion on March 6, 2024 (Paper 22, “Opp.”). Patent Owner filed a Reply in support of the motion on March 12, 2024 (Paper 23). We *granted* the Motion for Discovery. Paper 26 (Order Granting Patent Owner’s Motion for Additional Discovery) (“Order”).

Per the Order, Patent Owner obtained discovery from Petitioner. Then, Patent Owner requested a teleconference, held on May 21, 2024, to request leave to file a motion to terminate the proceeding under 35 U.S.C. 315(e)(1). During the teleconference, Patent Owner explained that its basis for seeking termination is that the discovery shows that Petitioner was a real party in interest (“RPI”) in a related proceeding involving challenges to some of the same claims of the same patent at issue here. *See Unified Patents, LLC v. Collective IP, LLC*, IPR2022-01086, Paper 37 (PTAB Dec. 18, 2023) (holding claims 1, 3, 5, 9, 12, 13, and 15 unpatentable and claims 20 and 21 not unpatentable) (the “’086 IPR”).

The parties appeared to agree during the teleconference that the discovery failed to show that communication between Netflix and Unified occurred regarding IPR2022-01086 and IPR2023-00891, which, *inter alia*, Patent Owner sought to show in its discovery. Nevertheless, Patent Owner argued other circumstances show that Netflix was an RPI of Unified in IPR2022-01086 (e.g., alleging that Unified agreed to protect a class of patents that include the challenged patent). *See* Order (listing sought-after discovery and alleged circumstances regarding RPI status).

In order to obtain a complete record of the parties' positions, at the conclusion of the teleconference, the Board granted Patent Owner leave to file a motion to terminate of no more than 8 pages due on or before May 31, 2024, and Petitioner leave to file an opposition of no more than 8 pages due on or before June 11, 2024.

So Ordered.

For PETITIONER:

Aliza Carrano
Indranil Mukerji
John Moulder
WILLKIE FARR & GALLAGHER LLP
acarrano@willkie.com
imukerji@willkie.com
cmoulder@willkie.com

For PATENT OWNER:

Christine Lehman
Michael Matulewicz-Crowley
Naveed Hasan
Jaime Cardenas-Navia
REICHMAN JORGENSEN LEHMAN & FELDBERG LLP
clehman@reichmanjorgensen.com
mmatulewicz-crowley@reichmanjorgensen.com
nhasan@reichmanjorgensen.com
jcardenas-navia@reichmanjorgensen.com