



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

From Trials <Trials@USPTO.GOV>

Date Mon 5/20/2024 10:46 AM

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

Cc Carrano, Aliza George <ACarrano@willkie.com>; imukerji@willkie.com <IMukerji@willkie.com>; smarshall@willkie.com <SMarshall@willkie.com>; netflix-vl_wfg@willkie.com <Netflix-VL_WFG@willkie.com>; RJ_VideoLabs-Netflix <RJ_VideoLabs-Netflix@reichmanjorgensen.com>

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Counsel,

A conference call is scheduled with the Board **tomorrow, Tuesday, May 21, at 11:45 am–12:30 pm ET.**

The dial-in number is: 866-743-7756 and the passcode is: 3324333#.

Regards,

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

From: Naveed Hasan <nhasan@reichmanjorgensen.com>

Sent: Thursday, May 16, 2024 11:02 AM

To: Trials <Trials@USPTO.GOV>

Cc: Carrano, Aliza George <ACarrano@willkie.com>; imukerji@willkie.com; smarshall@willkie.com; netflix-vl_wfg@willkie.com; RJ_VideoLabs-Netflix <RJ_VideoLabs-Netflix@reichmanjorgensen.com>

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

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Your Honors,

Patent Owner seeks authorization from the Board to move to terminate IPR2023-00891('891 IPR) because Petitioner is estopped from maintaining the '891 IPR. 35 U.S.C. § 315(e)(1).

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. Pursuant to the Board's Order (Paper 26), Petitioner produced discovery related to its relationship with Unified and involvement with the '086 IPR. Based on the discovery produced by Petitioner, Patent Owner intends to show that Petitioner should have been named an RPI in the '086 IPR because Petitioner's relationship with Unified rises to the level of RPI status. See Trial Practice Guide (Nov. 2019) at 12-18; *Applications in Internet Time, LLC (AIT) v. RPX Corp.*, 897

F.3d 1336, 1351-1352 (Fed. Cir. 2018). As such, under 35 U.S.C. § 315(e)(1), the '891 IPR should be terminated, in part or in whole, and in any event, Petitioner should be estopped from maintaining the '891 IPR.

Petitioner's Position

Petitioner opposes Patent Owner's request for authorization as its basis for seeking relief is without merit. Contrary to Patent Owner's assertions, the discovery produced demonstrate that there were no communications between Petitioner and Unified Patents that would indicate that Petitioner had any direction, control, or involvement with the '086 IPR. *See Assa Abloy AB v. CPC Pat. Techs. Pty, Ltd.*, IPR2022-01045, Paper 42 at 49 (Dec. 20, 2023). Further, the Board has repeatedly held that simply being a member of Unified Patents does not make a petitioner an RPI. *See, e.g., Netflix v. DivX*, IPR2020-00052, Paper 10 (May 14, 2020); *Unified Patents Inc. v. Uniloc USA, Inc.*, IPR2018-00199, Paper 33 at 6–10 (May 31, 2019).

The parties are available for a teleconference on the following dates and times:

- Friday, May 17: 12 pm–2:30 pm ET
- Monday, May 20: 3 pm–4:30 pm ET
- Tuesday, May 21: 11:45 am–12:30 pm ET

Best Regards,

Naveed S Hasan

REICHMAN JORGENSEN LEHMAN & FELDBERG LLP

Office: (202) 894-7305

Mobile: (703) 347-3000

Email: nhasan@reichmanjorgensen.com

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