

From: [Trials](#)
To: [Alistair Kelman](#)
Cc: [Trials](#); [Adam Shartz](#); [cordell@fr.com](#); [riffe@fr.com](#); [Jack R. Wilson](#); [lee@fr.com](#); [Jacob Henry](#); [William Ramey](#)
Subject: RE: IPR2023-01116 challenging patent 9,392,302.
Date: Wednesday, January 24, 2024 8:03:32 AM

Mr. Kelman,

From the Patent Trial and Appeal Board –

(1) Even though you are the sole listed inventor, you cannot represent Patent Owner, Safecast Ltd., or file papers with the Board on Safecast’s behalf, so the Board cannot recognize your recent letter (as reproduced in the email chain below) or any other such correspondence directly from you; and (2) Safecast (via a registered USPTO patent attorney) must immediately file Mandatory Notices (which are past due) or the Board may enter adverse judgment against Safecast affecting U.S. Pat. No. 9,392,302 B2, owned by Safecast. In other words, Patent Owner, Safecast, “is advised of the requirement to submit mandatory notice information under 37 C.F.R. § 42.8(a)(2) within 21 days of service of the petition.” Paper 4 (latest Notice of Filing Date Accorded to Petition and Time for Filing Patent Owner Preliminary Response) (“NFA”).

Further explanation as to the two main items above (and certain points raised in Mr. Kelman’s recent letter (as reproduced in the email below) follow:

Per the latest NFA, per Mr. Kelman’s query, a preliminary response (assuming Patent Owner decides to file same), is *due no later than three months after* the date of mailing of the that NFA, January 9, 2024. Paper 4.

Further to item (1) above, lead counsel must be a registered practitioner at the USPTO and Patent Owner must file a designation of counsel and power of attorney as part of the mandatory notices requirement. See Paper 4; 37 C.F.R.

§§ 42.8, 42.10. In addition, as the NFA states, “unless otherwise permitted by 37 C.F.R. § 42.6(b)(2), all filings in this proceeding must be made electronically in the Patent Trial Appeal Case Tracking System (P-TACTS), accessible from the Board Web site at <http://www.uspto.gov/PTAB>.” Paper 4. Accordingly, the Board will not further consider the points in the letter/email below raised by Mr. Kelman unless filed properly as part of a preliminary response filed by a designated counsel of record for Patent Owner.

Further as to item (2) above, the Petition certifies service of the Petition on Patent Owner’s designated correspondence and attorney of record, namely KILPATRICK TOWNSEND & STOCKTON LLP - WEST COAST Mailstop: IP Docketing – 22, 1100 Peachtree Street, Suite 2800, Atlanta, GA 30309. Paper 2 (Petition, Certificate of Service). Therefore, the *filing of mandatory notices is past due*. Accordingly, as indicated in item (2) above, Patent Owner must *promptly file mandatory notices or face adverse consequences* regarding the challenged patent, U.S. Pat. No. 9,392,302 B2. Note: Patent Owner should update the designated correspondence and attorney of record if it is stale as the letter/email and circumstances indicate.

Finally, per the electronic filing requirements noted above in the NFA and Board rules, we caution Mr. Kelman (and the parties) not to present further substantive arguments to the Board via letter or email because the panel may not consider them.

If Mr. Kelman and/or Patent Owner require further guidance, please contact Petitioner's counsel (although hiring counsel is strongly encouraged as noted above) and arrange a time to jointly teleconference with the panel and email the Board at Trials@USPTO.GOV to set up a time to teleconference with the panel.

Regards,

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

From: Alistair Kelman <ali.kelman@safecast.co.uk>
Sent: Tuesday, January 23, 2024 3:00 AM
To: Sweeney, Karen <Karen.Sweeney@USPTO.GOV>
Cc: Trials <Trials@USPTO.GOV>; Adam Shartzter <shartzter@fr.com>; cordell@fr.com; riffe@fr.com; Jack R. Wilson <jwilson@fr.com>; lee@fr.com; Jacob Henry <jhenry@rameyfirm.com>; William Ramey <wramey@rameyfirm.com>
Subject: IPR2023-01116 challenging patent 9,392,302.

CAUTION: This email has originated from a source outside of USPTO. **PLEASE CONSIDER THE SOURCE** before responding, clicking on links, or opening attachments.

**UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD**

DISH NETWORK L.L.C. AND DISH TECHNOLOGIES LLC,

Petitioner,

V.

SAFECAST LIMITED LLC,

Patent Owner

**PATENT OWNER PRELIMINARY RESPONSE TO PETITION FOR INTER
PARTES REVIEW OF U.S. PATENT NO. 9,392,302**

FAO: KAREN I SWEENEY - Trial Paralegal

Dear Ms Sweeney,

I am the sole inventor and a director of Safecast Limited which is the owner of U.S. Patent 9,392,302 (hereinafter referred to as '302). I am a retired English barrister who practiced at the Intellectual Property Bar. As required under the Rules, this letter from the original inventor and CEO of Safecast Limited is being copied to both the Petitioner's attorneys and our US attorneys.

My US Attorneys, Ramey & Co, recently sent me a copy of the *"Notice of Filing Date accorded to Petition"*. I understand from looking at the records on the PTAB site that there was an earlier document mailed on August 15 2023 which was never served on me or on my US attorneys. This earlier document was addressed to "Cachebox TV Limited" which was the previous name of Safecast Limited. The recently received copy of the *"Notice of Filing Date accorded to Petition"* is marked as Mailed on January 9 2024. However this document says that "the petition for inter-parte review filed in the above proceedings has been accorded the filing date June 22 2023". In view of the fact that the document mailed on August 15 2023 bearing the same filing date of June 22 2023 was never received by me or my US attorneys by reason of the fact that it was wrongly addressed and was not served, I respectfully request that the PTAB allows the Patent Owner to make a Preliminary Response to this Petition on the basis that the three month period for filing a Preliminary Response began on January 9 2024, which is the date when the notice was mailed. I further request that the requested review is not proceeded with on the following grounds.

1. The references asserted to establish that the claims are unpatentable are not in fact prior art.
2. The conduct of the Petitioner raises a statutory estoppel whereby the Petitioner's petition is in fact a second petition following on from IPR 2023-00652 which was issued by Google LLP on March 1 2023, whereby there was an instituted decision on October 10 2023. My US attorneys filed their Response on Jan 2 2024 and the matter is scheduled for Oral Argument on July 18 2024. The statutory estoppel arising from the continuance of the Petitioner's petition would undermine the integrity of both the USPTO and Federal Courts

Point 1 - The references asserted to establish that the claims are unpatentable are not in fact prior art.

The Petitioner at page iii of its Petition said:

"During prosecution, the Applicant amended its claims to overcome prior art rejections by requiring each advertisement to have two header values. The first value reflects a "local broadcasting time regulation [that] restricts the time of day" for presenting the advertisement. EX1001, claim 1. The second value counts the "number of times" the advertisement has been played"

This statement is incorrect. The proposed Claim Amendments filed by the Patent Owner's then attorneys

on 6 January 2016 (as recorded in the official USPTO records) were filed to improve clarity rather than to avoid prior art as part of a Request for Continued Examination under 37 CFR §:1.114. Specifically, the cited references did not disclose each and every element of the claims and were silent as to where “counters” may be stored. Consequently, the amendment to place the counter in the header was a clarification of the scope of the invention and not a modification to avoid a prior art rejection. The fact that this was a clarification is further supported by the Examiner Initiated Interview Summary of 21 March 2016.

Point 2 The conduct of the Petitioner raises a statutory estoppel

In the MANDATORY NOTICES UNDER 37 C.F.R § 42.8(a)(1) to the Petitioner’s Petition the Petitioner says:

...

B. Related Matters Under 37 C.F.R. § 42.8(b)(2) As set forth in the following table, Petitioner is aware of the following disclaimers, reexamination certificates, petitions for inter parte review, and civil actions involving the subject matter for the '302 patent.

	Case Number	Filing Date
1	IPR2023-00652, Google LLC f/k/a Google Inc. v. Safecast Limited LLC	March 1, 2023
2	Safecast Limited v. Dish Network Corporation, 1-22-cv03037 (DCO)	November 22, 2022
3	SafeCast Limited v. Microsoft Corporation, 6-22-cv-00983 (WDTX)	September 19, 2022
4	SafeCast Limited v. AT&T Corp., 6-22-cv-00676 (WDTX)	June 27, 2022
5	SafeCast Limited v. DISH Network Corporation, 6-22-cv00677 (WDTX)	June 27, 2022
6	SafeCast Limited v. Google LLC f/k/a Google Inc., 6-22-cv00678 (WDTX)	June 27, 2022
7	SafeCast Limited v. Home Box Office, Inc., 6-22-cv-00679 (WDTX)	June 27, 2022
8	SafeCast Limited v. NBC Universal, Inc., 6-22-cv-00680 (WDTX)	June 27, 2022
9	SafeCast Limited v. Paramount Global d/b/a Paramount, Inc., 6-22-cv-00682 (WDTX)	June 27, 2022
10	SafeCast Limited v. Verizon Communications Inc., 6-22-cv00683 (WDTX)	June 27, 2022

By reason of its inclusion, the Google IPR issued on March 1 2023 was known about by the Petitioner at the time it filed its Petition on June 22 2023. Therefore this raises a statutory estoppel, in view of the fact that the Google IPR is scheduled for Oral Argument on July 18 2024 and must therefore present a conflict in respect of the Consolidated Trial Practice Guide (Federal Register/Vol. 77, No. 157/Tuesday, August 14, 2012/Rules and Regulations):

1. Real Party-in-Interest or Privy: The core functions of the “real party-in- interest” and “privies” requirement to assist members of the Board in identifying potential conflicts, and to assure proper application of the statutory estoppel provisions. The latter, in turn, seeks to protect patent owners from harassment via successive petitions by the same or related parties, to prevent parties from having a “second bite at the apple,” and to protect the integrity of both the USPTO and Federal Courts by assuring that all issues are promptly raised and vetted. Cf. Fed. R. Civ. P. 17(a)

(Advisory Committee Note to 1966 Amendment to Rule 17(a))

By reason of the matters set out above the Patent Owner requests that the Petition is not proceeded with.

I would be grateful if you could please confirm receipt and acceptance of this communication.

Yours sincerely

Alistair Kelman

CEO and Co-Founder

Tel: +44 20 3822 0399

SafeCast Limited

A Safe Harbour for On-Demand TV and Video

SafeCast® is a registered trademark of SafeCast Limited

<http://www.safecast.co.uk>

<https://safecast.global/>

Personal website:

<http://www.alikelman.com>

The information in this e-mail is confidential and may be legally privileged. It is intended solely for the addressee. Access by any other person to this e-mail is not authorised. If you are not the intended recipient, please delete this e-mail. Any disclosure of this e-mail or of the parties to it, any copying, distribution or any action taken or omitted to be taken in reliance on it is prohibited, and may be unlawful.

I am sending you this email during my working hours but unless it is marked as URGENT I do not expect a response outside of yours.