

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

STINGRAY GROUP INC. AND STINGRAY MUSIC USA, INC.,
PETITIONERS,

v.

DR. EDWIN A. HERNANDEZ-MONDRAGON,
PATENT OWNER.

CASE IPR2025-00349 PATENT
10,123,074

REPLY TO PETITIONERS' BRIEF REGARDING FINTIV FACTORS
AND PATENT OWNER'S COUNSEL'S MOTION TO
WITHDRAW FROM DISTRICT COURT PROCEEDING

CURRENT EXHIBIT LIST

No.	Brief Description
1001	U.S. Patent No. 10,123,074
1002	Declaration of Mr. Stuart Lipoff
1003	U.S. Patent No. 8,954,600 to Avellan, et al. (“Avellan”)
1004	U.S. Patent No. 8,819,043 to Durante, et al. (“Durante”)
1005	U.S. Patent No. 9,635,075 to Ma, et al. (“Ma”)
1006	U.S. Patent No. 6,463,445 to Suzuki, et al. (“Suzuki”)
1007	U.S. Patent Application Publication No. 2004/0031052 to Wannamaker, et al. (“Wannamaker”)
1008	U.S. Patent No. 7,778,279 to Heikens, et al. (“Heikens”)
1009	U.S. Patent No. 9,264,750 to Matthews, et al. (“Matthews”)
1010	U.S. Patent No. 9,240,966 to Wilsher, et al. (“Wilsher”)
1011	File History of the ’074 Patent
1012	Declaration of Michael D. McBride in Support of Petitioners’ Notice of Intent to Designate Provisionally Recognized Attorney Michael D. McBride as Backup Counsel
1013	Edwin A. Hernandez, et al. v. Stingray Group Inc., et al., Case No. 1:24cv-21226, Dkt. 190 (February 12, 2025, Order Denying Motion to Stay Pending IPRs)
1014	Edwin A. Hernandez, et al. v. Stingray Group Inc., et al., Case No. 1:24cv-21226, Dkt. 202 (March 10, 2025, Order Denying Motion for Preliminary Injunction)
1015	April 9, 2025, correspondence from Plaintiffs’ counsel serving Third Amended Complaint and dismissing Counts 8 and 9
1016	Edwin A. Hernandez, et al. v. Stingray Group Inc., et al., Case No. 1:24cv-21226, Dkt. 82 (July 15, 2024, Plaintiffs’ Second Amended Complaint)
1017	Edwin A. Hernandez, et al. v. Stingray Group Inc., et al., Case No. 1:24cv-21226, Dkt. 207 (March 12, 2025, Order Denying Plaintiffs’ Motion to Strike Reply Brief and sua sponte Order Cancelling Scheduled Markman Hearing)

1018	SDFL Trial Stats
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No.	Brief Description
1019	Edwin A. Hernandez, et al. v. Stingray Group Inc., et al., Case No. 1:24cv-21226, Dkt. 214 (April 9, 2025, Plaintiffs' Third Amended Complaint)
1020	Edwin A. Hernandez, et al. v. Stingray Group Inc., et al., Case No. 1:24cv-21226, Dkt. 214 (April 9, 2025, Plaintiffs' Exhibit 24 to Third Amended Complaint)
1021	Edwin A. Hernandez, et al. v. Stingray Group Inc., et al., Case No. 1:24cv-21226, Dkt. 215 (April 11, 2025, Defendants Stingray Group, Inc.'s and Stingray Music USA, Inc.'s Stipulation Regarding the Defense of Patent Invalidity)
1022	April 11, 2025, correspondence from Defendants AT&T Enterprises, LLC, Blue Stream Communications, LLC, and Millicom International Service, LLC's counsel serving Plaintiffs' counsel with Stipulation Regarding the Defense of Patent Invalidity.
1023	Edwin A. Hernandez, et al. v. Stingray Group Inc., et al., Case No. 1:24cv-21226, Dkt. 13 (May 7, 2024, Plaintiffs Filing of Proof of Service on Defendant Stingray Music USA, Inc.)
1024	Edwin A. Hernandez, et al. v. Stingray Group Inc., et al., Case No. 1:24cv-21226, Dkt. 266 (May 28, 2025, Motion for Leave to Withdraw as Counsel for Plaintiffs Dr. Edwin A. Hernandez and Egla Corp.)
1025	Edwin A. Hernandez, et al. v. Stingray Group Inc., et al., Case No. 1:24cv-21226, Dkt. 258 (May 20, 2025, Order Granting Joint Motion for Continuance of Certain Pre-Trial Deadlines)
1126	Edwin A. Hernandez, et al. v. Stingray Group Inc., et al., Case No. 1:24cv-21226, Dkt. 288 (NOTICE of Filing Plaintiffs' Opposition to Motion to Withdraw by Edwin A. Hernandez, EGLA Corp. re 266 MOTION for Leave to Withdraw as Counsel for Plaintiffs Dr. Edwin A. Hernandez and EGLA Corp. and Incorporated Memorandum of Law in Support Thereof (Martinez, Elio) (Entered: 06/05/2025))

	Brief Description
1127	IPR Discretionary Denial – June 2025
1128	Emails with discussion with Stingray Group awareness of patents and Patent applications from 2017.
1129	Email to Petitioner Showing “Notice of Allowance” of US Patent 10,123,074 to Lloyd Feldman, VP of Legal at Stingray with Attachments
1130	Reasons for Allowance, Attached to Ex. 1029
1131	Notice of Allowance, Attached to Ex. 1029
1132	Allowed Claims Attached to Ex. 1029
1133	OmniBus Order - Edwin A. Hernandez, et al. v. Stingray Group Inc., et al., Case No. 1:24cv-21226, Dkt. 291
1134	Petitioner’s counsel cancels mediation
1135	NDA with Petitioner signed by Patent Owner
1136	Declaration validating Ex. 1128, 1129, and 1135

On May 28th, 2025, Petitioner contacted Patent Owner prior-counsel and without authorization from Patent owner, requested to file a brief that this response is for, as shown in an email dated June 2nd, 2025 at Ex.1126 at Pg. 21-22. As shown in that email thread, Patent Owner told prior counsel that they were not authorized to proceed with any decisions related to his patents *Id.* at Pg. 21. Despite petitioner knowing that prior counsel had withdrawn from the case. Petitioner and prior counsel, that had already withdrawn, negotiated to file an additional brief on this proceeding. Moreover, Patent owner prior-counsel waited to withdraw in the PTAB court until June 9th, 2025 and which left Patent Owner with no way to file this reply electronically faster.

Patent owner is then entitled to file a reply. The Board will recognize that petitioner contacting a withdrawn plaintiff (patent owner) attorney and requesting them to make decisions on behalf of a client made is an unethical act.

Therefore, the board should deny this entire petition based on Petitioners unethical actions.

Besides, Patent Owner recently learned that this board denied a Petitioner that knew about the challenged patents for around 10 years as shown by IPR2025-00363, IPR2025-00374, IPR2025-00376, and IPR2025-0377 (Ex. 1127). In that decision, this board stated that:

“Petitioner’s awareness of Patent Owner’s applications and failure to seek early review of the patents **favours denial and outweighs the above-discussed considerations.**” **(emphasis added)**

This is the case here; Petitioner knew about the patents and patent applications as early as October 2017 and October 2018.

- As shown in October 2017, EGLA CORP and Patent Owner exchanged emails with Petitioner, Stingray Group, Inc (Ex. 1128) and under NDA (Ex.1135) , Dr. Hernandez showed the patent applications to Petitioner,
- Later As of October 2018, Dr. Hernandez forwards email to Petitioner with Notice of Allowance (Ex. 1129) with Attachments: Notice of Allowance (Ex. 1030) citing Patent Appl 15/538,911 which is Application No. for the 10,123,074. 10,524,002, and 11,140,441 patents, Reasons for Allowance (Ex. 1131), and Patent Allowed Claims (Ex. 1132)

Therefore, Petitioner knew about the patents and applications since 2017 and did nothing, meets the same criteria to the decision made for the IRythm IPR (Ex. 1127) and this petition should be denied.

On June 5, 2025, Patent Owner’s file a notice in opposition for the “Motion to Withdraw”. Ex. 1126 and presents in Exhibits A-G evidence that the arguments made by prior counsel in their “Motion to Withdraw” are false and inaccurate. Arguments petitioner relies on in their brief. For example, Petitioner failed to pay

mediator and did not pay for mediation but singled out patent owner as it was the only party without paying. In contrast, Patent Owner proceeded to pay mediator as shown in Ex.1126 at Pg. 35, while Petitioner unilaterally cancelled mediation on June 5th, 2025 (see Ex. 1134) without knowing what the judge was going to order on June 9th, 2025 (see Ex. 1133)

Additionally, Petitioner further speculates that “The litigation cannot proceed until Plaintiff EGLA Corp.—the exclusive licensee of the Patents-at-Issue—is represented by counsel)” when EGLA CORP is already represented by Dickinson & Wright in multiple patent prosecution matters and has other attorneys’ relationships that are being interviewed to handle the case in Florida. Dr. Hernandez has an “Expert Witness” practice and has multiple options of attorneys that can represent him and his company, EGLA CORP (Ex. 1136 at ¶1)

Moreover, Petitioner makes false and inaccurate statements to this board that are erroneous, for example:

- Petitioner claimed that “Plaintiffs’ unwillingness to participate in litigation—including their refusal to comply with the Court’s mediation requirements and refusal to be deposed—risks dismissal of the case.” This is false, Patent Owner provided deposition dates via ZOOM and despite Petitioner has scheduled ZOOM depositions, refuses to depose Patent Owner via ZOOM. (Ex. 1126 at Pg. 17) and ignores health reasons related

to Dr. Edwin Hernandez' father (Ex. 1136 at ¶2-4) hence Patent Owner is not blocking litigation, counsel was notified (Ex.1126 at Pg. 24) of the health issues.

- Judge Torres is giving Patent Owner and EGLA CORP until June 22nd, 2025 to find new counsel which is being done as we speak, any impact on the schedule should be minimum (Ex. 1133). Hence, the statement "but it makes it even more likely that the Court will stay the case upon institution for purposes of Fintiv Factor 1" did not consider Judge's order, as that was made (Ex. 1133 on June 9th,2025) as the brief was filed on June 4th, 2025

Lastly, given unethical counsel's behavior, and recently made decisions by this board, the Board should deny Petitioner's request, and find appropriate sanctions for Petitioner's violation of ethical rules.

Dated: June 11, 2025 Respectfully submitted,

/s/ Edwin A . Hernandez

Patent Owner