

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

EDWIN A. HERNANDEZ-MONDRAGON,
Patent Owner.

CASE IPR2025-00349
PATENT 10,123,074

AUTHORIZED RESPONSE TO DIRECTOR REVIEW REQUEST¹
37 C.F.R. § 42.75(c)(1)

¹ The Director authorized this response via email on July 14, 2025. *See* Ex. 3100.

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I. THE REQUEST IS LATE AND RELIES UPON NEW EVIDENCE

The Director should deny this request as inexcusably late. The Board instituted trial on June 13, 2025. Paper 19. The deadline for Patent Owner to file was June 27, 2025, fourteen days after institution. 37 C.F.R. §§ 42.75(c)(1), 42.71(d)(1). Patent Owner waited until July 13, 2025, to file. *See* Paper 28 (“Request”). Patent Owner has not requested an extension, asked the Director to excuse his late filing, or provided “good cause” for his tardiness.

In any case, Patent Owner could not show such good cause. Patent Owner was always represented by counsel, as his counsel explained. Ex. 2025 at 1 (“Until we are substituted out as counsel in the IPRs, we still represent you in those matters.”). Patent Owner admitted that he was aware of the “settled expectations” doctrine as well as the evidence he now relies upon at least as early as June 11–12, 2025. Ex. 2028 at 5 (citing *iRhythm Techs., Inc. v. Welch Allyn, Inc.*, IPR2025-00363-10 (PTAB June 6, 2025)); Request at 2 (noting Patent Owner previously filed exhibits on June 11–12, 2024). And Patent Owner represented that as of June 9, 2025, withdrawal of counsel “will not have an adverse effect on the Petitioner or otherwise delay the proceeding in this matter.” Paper 13 at 3. Likewise, Patent Owner’s new counsel moved to substitute lead counsel on the deadline for the Request, June 27, 2025, and represented that “Mr. Drolet and Mr. Ravicher . . . are ready and able to take over representation in these proceedings” and “[t]he

withdrawal will not have an adverse effect on the Petitioner or otherwise delay the proceeding in this matter.” Paper 23 at 2.

Therefore, Patent Owner could have filed the Request on time but did not. And he has not, and cannot, now show that change of counsel, change of law, or unavailability of evidence should justify his delayed Request or the “adverse effects” it has on Petitioners.

Ignoring the late filing, the Director should also deny the Request because § 42.75(c)(3) forbids submission of new evidence absent permission. *See also* Request (citing new Exhibits 2031–38). Patent Owner says the Director should nonetheless consider this new evidence because supposedly “they were [previously] submitted by a party not authorized to file without counsel under PTAB rules” and “[t]he documents were not rejected on any substantive grounds, nor was their content found improper,” *id.* at 2, but this is incorrect.

The Board expunged the documents because Patent Owner filed them without authorization. Paper 18 at 4. On May 30, 2025, the Board granted both parties authorization to file, by June 4, two-page briefs addressing how withdrawal of Patent Owner’s district court counsel affects the *Fintiv* analysis. Ex. 3002. Patent Owner’s counsel informed Patent Owner of the Board’s directions. Ex. 2026. Yet, Patent Owner chose to ignore the Board’s instructions, refused to communicate with his counsel, and waited until June 11–12 to file a “reply” brief that was twice the length

authorized by the Board and addressed non-authorized topics. Ex. 2028; Paper 21 at 7 (“Patent Owner also has ceased communicating with counsel on important issues in this proceeding.”) and 4 n.3 (“Had Patent Owner communicated with counsel in advance of this filing, counsel would have informed Patent Owner of the need to obtain authorization from the Board before filing a reply and exhibits.”). As such, Patent Owner’s expunged filings were entirely “improper.” See § 42.12 (providing for expungement and precluding a party from raising issues for failure to comply with a rule or order).

Finally, the “new evidence” rule is in place because this is supposed to be a “review” of previously submitted evidence and argument, and it is unfair to allow Patent Owner to submit new evidence in support of a new argument in this Request for the first time, where Petitioner is unable to provide counter evidence. See Ex. 3100 (“No new evidence is permitted.”).

II. THE PTAB SHOULD REVIEW THE PATENT

First, the ’074 Patent issued November 6, 2018, about six years before Petitioners filed this IPR Petition on December 20, 2024, much less than the situation in the relied upon *iRhythm*. Cf. *iRhythm Techs.*, IPR2025-00363-10, at 3 (noting earliest patent issued about 12 years before petition). And the ’074 Patent is part of a family that includes U.S. Patent No. 11,140,441, issued only three years prior to the Petition and that is subject to instituted IPR2025-00351. It makes sense for the

PTAB to review these patents together.

Second, regardless of how long a patent has been in force, there was no reason to seek an IPR where the patent had never been “commercialized, asserted, marked, licensed or otherwise applied in a petitioner’s particular technology space, if at all,” like here. *Intel Corp. v. Proxense LLC*, IPR2025-00327-12, at 2–3 (PTAB June 26, 2025). The ’074 Patent has never been licensed in any arms-length transaction² and has never been reduced to practice much less commercialized, so there has never been a product to mark. The Request does not say otherwise. *See* Request. Moreover, until Patent Owner’s lawsuit against Petitioners in *Hernandez, et al. v. Stingray Group Inc., et al.*, Case No. 1:24-cv-21226 (S.D. Fla. filed Apr. 2, 2024) (“Florida Litigation”), Patent Owner never asserted the ’074 Patent against anyone. *See, e.g.* Paper 25 at Related Matters.

Third, the Florida Litigation shows that Patent Owner has significantly changed his view of the scope of his claims. While it is true that Dr. Edwin Hernandez approached Stingray in 2017, the contact regarded “an alternative way for Stingray to get out of the Music Choice lawsuit.” Ex. 2032 at 6; *see also* Ex. 2033 at 1 (“[M]y patent and technology are an alternative solution to Music Choices’ patents.”). That is, Dr. Hernandez was proposing that Stingray ***change the way its***

² Dr. Hernandez purports to have given an oral license to his closely held company, EGLA Corp. Paper 21 at 9.

system worked to implement the theoretical technology described in the '074 Patent, showing that no one, including Patent Owner, believed Petitioners implemented Patent Owner's patent. Patent Owner only indicated it had a broader view of claim scope in 2024 when it filed the Florida Litigation, and Petitioners quickly filed their Petitions the same year in light of this change. Just like where "a significant change in law may have occurred since the patent issued . . . [that] directly bears on the patentability of the challenged claims" justifies the PTAB reassessing patentability, *Intel*, IPR2025-00327-12, at 2, so too should a Patent Owner's significant change in his view of claim scope.

Fourth, and finally, given the particularly weak showing regarding the "settled expectations" as just described, this additional factor does not tip the previous *Fintiv* analysis in favor of discretionary denial where the Board has already found "[t]he merits of the Petition here are compelling" and "[o]nly the fifth *Fintiv* factor favors denial—i.e., the petitioners are related to the defendants in the Florida Litigation. The rest of the factors weigh against denial—two strongly so." Paper 19 at 8–9.

III. CONCLUSION

The Director should deny the Request for the reasons herein.

Dated: July 21, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that on the twenty-first day of July, 2025, a complete and entire copy of the foregoing “AUTHORIZED RESPONSE TO DIRECTOR REVIEW REQUEST,” including exhibits, if any, was served on the following counsel of record via email per Petitioners’ written consent to electronic service.

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