

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MINDGEEK USA INC., MINDGEEK S.À.R.L.,
MG FREESITES LTD., MG FREESITES II LTD.,
MG CONTENT RK LTD., MG CONTENT DP LTD.,
MG CONTENT RT LTD., MG PREMIUM LTD.,
MG CONTENT SC LTD., MG CYPRUS LTD.,
LICENSING IP INTERNATIONAL S.À.R.L.,
9219-1568 QUÉBEC INC. d/b/a ENTREPRISE MINDGEEK CANADA,
and COLBETTE II LTD.,
Petitioner,

v.

UNIVERSITY OF SOUTHERN CALIFORNIA,
Patent Owner.

Case IPR2019-00423
Patent 6,574,638 B1

Before SALLY C. MEDLEY, KEVIN C. TROCK, and
JESSICA C. KAISER, *Administrative Patent Judges*.

MEDLEY, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 315(b)

I. INTRODUCTION

MindGeek USA Inc., along with several other entities (“Petitioner”),¹ filed a Petition for *inter partes* review of claims 1–26 of U.S. Patent No. 6,574,638 B1 (Ex. 1001, “the ’638 patent”). Paper 1 (“Pet.”). University of Southern California (“Patent Owner”)² filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). With our authorization, Petitioner filed a Reply. Paper 7 (“Reply”). Also with our authorization, Patent Owner filed a Sur-Reply. Paper 8 (“Sur-Reply”). For the reasons provided below, we determine the Petition is time-barred pursuant to 35 U.S.C. § 315(b). Accordingly, we do not institute *inter partes* review of the ’638 patent in this proceeding.

The parties indicate that the ’638 patent is the subject of *Preservation Technologies LLC v. MindGeek USA Inc. et al.*, Case No. 2:17-cv-08906-DOC-JPR (C.D. Cal.) and *Preservation Technologies LLC v. MG Content RK Ltd. et al.*, Case No. 2:18-cv-03058-DOC-JPR (C.D. Cal.), both currently pending. Pet. 3; Paper 3, 2. The parties also list at least one relevant dismissed proceeding, which we discuss in more detail below. Pet. 3; Paper 3, 2.

II. DISCUSSION

The issue before us is whether Petitioner timely filed its Petition under § 315(b). We determine that Petitioner did not.

Section 315(b) states, “[a]n *inter partes* review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date

¹ The header on page 1 of this Decision lists all parties representing Petitioner. Petitioner lists the same as real parties-in-interest. Pet. 1, 3.

² Patent Owner lists exclusive licensee Preservation Technologies LLC as a real party-in-interest. Paper 3, 2; Prelim. Resp. 2.

on which the petitioner . . . is served with a complaint alleging infringement of the patent.” 35 U.S.C. § 315(b). In *Click-to-Call Technologies, LP v. Ingenio, Inc.*, 899 F.3d 1321, 1328–36 (Fed. Cir. 2018) (en banc in relevant part), the court held the time bar of § 315(b) “applies to bar institution when an IPR petitioner was served with a complaint for patent infringement more than one year before filing its petition, but the district court action in which the petitioner was so served was voluntarily dismissed without prejudice.” *Id.* at 1328 n.3. That holding applies to both voluntary, and involuntary, dismissals without prejudice. *Bennett Regulator Guards, Inc. v. Atlanta Gas Light Co.*, 905 F.3d 1311, 1314–15 (Fed. Cir. 2018).

Exclusive licensee, Preservation Technologies LLC, filed a complaint against MindGeek USA Inc. for infringement of the ’638 patent. Pet. 5. The complaint was served on October 14, 2014. *Id.* On February 2, 2015, Preservation Technologies LLC filed a notice of voluntary dismissal of the complaint. *Id.* Petitioner filed the Petition on December 11, 2018, several years after the 2014 complaint against MindGeek USA Inc. was served.

Petitioner acknowledges the holding in *Click-to-Call*, but argues that “*Click-to-Call* was incorrectly decided.” *Id.* at 5–6. Petitioner argues that we should instead follow *Sling TV, LLC v. Realtime Adaptive Streaming, LLC*, IPR2018-01331, Paper No. 9 (Jan. 31, 2019), a non-precedential Board decision where a Board panel determined that § 315(b) requires petitioner be served with a *patent owner’s* complaint to trigger the one-year time bar. Reply 2–3. Patent Owner argues that “*Click-to-Call* is clearly relevant to the present IPR and its holding that a complaint’s later voluntary dismissal has no bearing on the one year time bar of 35 U.S.C. § 315(b) is controlling.” Prelim. Resp. 6. Patent Owner further argues that “[t]he Federal Circuit in

Click-to-Call already considered the exact fact pattern at issue in this proceeding and determined service by an exclusive licensee triggers the time bar of 35 U.S.C. § 315(b).” Sur-Reply 1. As such, Patent Owner argues that Petitioner is time barred under 35 U.S.C. § 315(b) and the Petition should be denied. Prelim. Resp. 6; Sur-Reply 2. We agree with Patent Owner.

Here, Petitioner filed the Petition more than one year after the October 14, 2014 service of the complaint alleging infringement of the ’638 patent. As in *Click-to-Call*, the defendant (Petitioner) was served with a complaint by an exclusive licensee (Preservation Technologies LLC), not the patent owner. The court in *Click-to-Call* held that such service (from an exclusive licensee) barred the defendant from filing a petition for *inter partes* review more than a year later, despite the fact that the complaint was subsequently voluntarily dismissed. 899 F.3d at 1328 n.3. *Sling TV* is a non-precedential Board decision, which we are not bound to follow. In addition, we note *Sling TV* did not address the issue of whether service by an exclusive licensee of a complaint triggers the one-year bar in § 315(b).³ Based on current case law regarding 35 U.S.C. § 315(b), the Petition was not timely filed, and therefore, we do not institute *inter partes* review of the ’638 patent.

³ We also observe that an exclusive licensee can have standing to sue in its own name, without joining the patent holder. *See, e.g., Int’l Gamco, Inc. v. Multimedia Games, Inc.*, 504 F.3d 1273, 1276 (Fed. Cir. 2007).

III. CONCLUSION

For the foregoing reasons, we determine the Petition is time-barred pursuant to 35 U.S.C. § 315(b), and do not institute *inter partes* review in this proceeding.

IV. ORDER

Accordingly, it is:

ORDERED that the Petition is *denied*.

IPR2019-00423
Patent 6,574,638 B1

For PETITIONER:

Frank M. Gasparo
William Hector
VENABLE LLP
fmgasparo@venable.com
wahector@venable.com

For PATENT OWNER:

Minghui Yang
Floyd Walker
HARDY PARRISH YANG LLP
myang@hpylegal.com
fwalker@hpylegal.com