

Re: Please tell me it is going to be okay.....

From Amanda Prose <aprose@wck.com>
To mattguertin<MattGuertin@protonmail.com>
CC Megan Neumann<mneumann@wck.com>
Date Tuesday, November 8th, 2022 at 8:58 AM

Hi Matt,

I did some research on the Trojansky/Eyeline/Netflix patent application. I note there is also a PCT application that was just recently published. The PCT application had a search report that denied patentability to all 39 claims, but again, take that with a grain of salt. That is not uncommon. Further, the search was conducted back in July, which was before your PCT application and US applications published (which was in September) so your patent application was not searchable and thus not cited by the Korean examiner conducting the prior art search for the PCT application.

- 1) I also checked the status of the US application (publication no. US 2022/0319115): the application has not been examined yet, and it will likely be a while before it is examined. They have not submitted any prior art to the Patent Office either.
- 2) The videos you sent us that pre-date your filing date will need to be submitted to the patent office in a prior art disclosure. This is a requirement of your duty of candor to the Patent Office. We will do this ASAP. I do not expect this to affect the allowance of the system claims or the patent itself since we have deleted the apparatus claims.
- 3) Your next decision relates to how to make Netflix aware of your prior filed patent application. We can A) make sure that Netflix is aware of your prior pending patent application by either a third party submission of prior art or by sending the art to both Mr. Trojansky and his patent attorneys, as once they have become aware of the art they also have a duty to disclose it to the Patent Office; or B) do nothing and hope the US examiner finds your patent application and cites it.

In general, we have the opportunity to submit prior art in another party's pending patent application until 6 months from the date of publication. This gives us until April 6, 2023 to file your patent application as a prior art submission in the Trojansky/Netflix application. I suggest we consider this route, but waiting until the patent has issued if we can. It is much harder for them to make a stink when your patent is granted and also your duty to submit prior art references ends when the patent is granted. At this rate, you should have a patent granted soon so I think waiting will be OK.

Let me know if you have other questions.

Best regards,

Amanda

westman champlin & koehler
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