

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PLAID TECHNOLOGIES, INC.,
Petitioner,

v.

YODLEE, INC. and YODLEE.COM, INC.,
Patent Owner.

Case IPR2016-00275
Patent 6,199,077 B1

Before SALLY C. MEDLEY, MICHAEL R. ZECHER, and
JOHN A. HUDALLA, *Administrative Patent Judges*.

HUDALLA, *Administrative Patent Judge*.

DECISION

Denying Institution of *Inter Partes* Review
35 U.S.C. § 314(a) and 37 C.F.R. § 42.108

Denying Motion to Change Filing Date
37 C.F.R. § 42.5 and 37 C.F.R. § 42.104(c)

Petitioner, Plaid Technologies, Inc. (“Plaid”), filed a Petition (Paper 1, “Pet.”) requesting an *inter partes* review of claims 1–12 of U.S. Patent No. 6,199,077 B1 (“the ’077 patent,” Ex. 1001) pursuant to 35 U.S.C. §§ 311–19. Patent Owner, Yodlee, Inc. and Yodlee.com, Inc. (“Yodlee”),

filed a Preliminary Response. Paper 11 (“Prelim. Resp.”). We have jurisdiction under 35 U.S.C. § 314.

Plaid’s Petition was accorded a filing date of December 3, 2015. Paper 3, 1. Subsequently, we authorized Plaid to file a motion to change the filing date accorded to the Petition from December 3, 2015, to December 2, 2015. Paper 8. Plaid filed its motion to change the filing date of the Petition. Paper 9 (“Mot.”). Yodlee filed an opposition to the motion. Paper 10 (“Opp.”). Plaid filed a reply in support of its motion. Paper 13 (“Reply”).

For the reasons set forth below, we determine that Plaid did not serve timely the Petition in accordance with 37 C.F.R. § 42.106(a)(2) within the one-year period set forth in 35 U.S.C. § 315(b). We also determine that Plaid does not show good cause for us to waive the service requirement as a prerequisite for according a filing date, or otherwise to excuse Plaid’s late action. We additionally determine Plaid failed to file a complete petition in accordance with 37 C.F.R. §§ 42.104(b)(1–5), 42.106(a)(1) within the statutory period of 35 U.S.C. § 315(b), and that this failure did not constitute a clerical mistake under 37 C.F.R. § 42.104(c). Accordingly, we deny Plaid’s motion to change the filing date accorded to the Petition, and we do not institute *inter partes* review of the ’077 patent.

I. BACKGROUND

A. *Related Proceedings*

Both parties identify the following proceeding related to the ’077 patent (Pet. 1–2; Paper 7, 2): *Yodlee, Inc. v. Plaid Technologies, Inc.*, Case No. 1:14-cv-01445-LPS-CJB (D. Del.) (filed Dec. 1, 2014). Plaid was

served with the complaint in this case on December 2, 2014. *See* Pet. 2 (citing Ex. 1002).

Plaid also has filed a petition requesting a review of claims 1–12 of the '077 patent under the transitional program for covered business method patents in Case CBM2016-00037. In addition, Plaid filed another petition for *inter partes* review of U.S. Patent No. 6,317,783 B1, which also is owned by Yodlee, in co-pending Case IPR2016-00273. *See* Pet. 2.

B. Factual Background Related to Filing

Before it began filing two petitions for *inter partes* review on the evening of December 2, 2015, Plaid allegedly waited for supporting declarations from Todd C. Mowry, Ph.D., “in case he had any changes that would need to be reflected in the other petition papers.” Mot. 4 (citing Ex. 1021 ¶ 4; Ex. 1022 ¶ 4). At around 10:30 p.m., when Dr. Mowry’s signed declarations were received, Plaid’s counsel began filing sequentially the two petitions.¹ *Id.* at 1–2, 4 (citing Ex. 1021 ¶¶ 2, 4; Ex. 1022 ¶¶ 2, 4). Plaid’s counsel finished filing the first Petition, which pertained to co-pending Case IPR2016-00273, by clicking “Submit” at around 11:40 p.m. *Id.* at 2 (citing Ex. 1021 ¶ 7; Ex. 1022 ¶ 5). Plaid’s counsel then attempted to start filing the Petition in the instant case, but counsel asserts that the Patent Review Processing System (“PRPS”) system “froze” before any papers could be uploaded. *Id.* at 2–3 (citing Ex. 1021 ¶¶ 9–10; Ex. 1022 ¶ 6). This attempt at filing was aborted. *Id.* at 3 (citing Ex. 1021 ¶ 10).

¹ Plaid believed it had to file sequentially the two petitions because they were signed by the same counsel. Mot. 4 (citing Ex. 1021 ¶ 6; Ex. 1022 ¶ 4). We are not aware of any such requirement.

At around 11:45 p.m., Plaid’s counsel began a second attempt to file the Petition in the instant case on a different computer. *Id.* (citing Ex. 1021 ¶ 12; Ex. 1022 ¶ 8). Before midnight, Plaid’s counsel “managed to enter the identifying information for the [Petition in the instant case], along with party information, upload the [P]etition, pay the fee and upload some of the exhibits.” *Id.* (citing Ex. 1021 ¶ 12; Ex. 1022 ¶ 8). Still, Plaid’s counsel did not complete uploading of the remaining exhibits and clicking “Submit” until the early morning of December 3, 2015. *Id.* at 3–4 (citing Ex. 1021 ¶ 13; Ex. 1022 ¶ 8).

After filing had been completed on December 3, 2015, the Petition and supporting evidence were deposited with FedEx for next-day delivery to Yodlee. Ex. 1022 ¶ 9. Tracking information provided by Plaid shows these papers were not picked up by FedEx until the evening of December 3, 2015, and not delivered to Yodlee until the morning of December 4, 2015. Ex. 1024. Notwithstanding, the Certificate of Service for the Petition indicates service was effected on December 2, 2015. *See* Pet. 61.

II. ANALYSIS

Section 315(b) of Title 35 of the United States Code states that “[a]n inter partes review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner . . . is served with a complaint alleging infringement of the patent.” Given that the complaint in the underlying district court case was served on December 2, 2014, *see* Pet. 2 (citing Ex. 1002), the one-year deadline in this case under § 315(b) was December 2, 2015.

The requirements for a petition are set forth in 35 U.S.C. § 312(a). This section specifies that “[a] petition filed under section 311 may be considered only if” the enumerated requirements are met. 35 U.S.C. § 312(a). Among the requirements germane to this case is “evidence that supports the grounds for the challenge to each claim, including . . . copies of patents and printed publications that the petitioner relies upon in support of the petition; and . . . affidavits or declarations of supporting evidence and opinions.” 35 U.S.C. § 312(a)(3)(B). These requirements are reflected in a corresponding regulation, 37 C.F.R. § 42.104, which specifies the required content of a petition. Notably, § 42.104 includes a provision that states “[a] motion may be filed that seeks to correct a clerical or typographical mistake in the petition. The grant of such a motion does not change the filing date of the petition.” 37 C.F.R. § 42.104(c).

Section 312(a)(5) of Title 35 of the United States Code also states that the petitioner must “provide[] copies of any of the documents” required under the same section “to the patent owner” in order for a petition to be considered. *Id.* The corresponding regulation states that “[t]he petition and supporting evidence must be served on the patent owner at the correspondence address of record for the subject patent.” 37 C.F.R. § 42.105(a).

Furthermore, 37 C.F.R. § 42.106(a) enumerates the requirements for obtaining a filing date in an *inter partes* review. This section states that a “[c]omplete petition” that complies with 37 C.F.R. § 42.104 is required in order for a filing date to be accorded. 37 C.F.R. § 42.106(a)(1). In addition, a petitioner must “[e]ffect service of the petition” on a patent owner in

accordance with 37 C.F.R. § 42.105(a) in order for a filing date to be accorded. 37 C.F.R. § 42.106(a)(2).

Regarding Plaid's motion to change the filing date accorded to the Petition, Plaid has the burden of proof to establish that it is entitled to the requested relief. 37 C.F.R. § 42.20(c).

Considering this statutory and regulatory background, and based on the particular factual circumstances of this case, we determine that Plaid failed to complete the following two prerequisites for obtaining a filing date before the expiration of the one-year statutory period of 35 U.S.C. § 315(b): (1) Plaid did not attempt to serve Yodlee with a copy of the Petition before the deadline; and (2) Plaid did not file a complete petition before the deadline. Accordingly, and for the following reasons, we determine Plaid has not met its burden of establishing that it is entitled to change the filing date accorded to the Petition. As a result, we may not institute an *inter partes* review because the Petition is time-barred under 35 U.S.C. § 315(b).

A. *Plaid's Late Service of the Petition*

Plaid argues "section 315(b), which imposes the one-year time limitation, only speaks in terms of when the Petition 'is filed,' without regard to when it is served." Mot. 9. Accordingly, Plaid argues "section 312 does not require service by any specific date for purposes of section 315(b)." *Id.*; *see also* Reply 5 ("§ 312(a) has no date requirement for service and § 315(b) does not mention service at all.").

Yodlee highlights that Plaid "did not serve (or even attempt service) until December 3rd." Opp. 2 (citing Ex. 1024). Yodlee argues "the plain

language of the statute makes clear that service is a requirement for a petition[] to be ‘considered’ as ‘filed.’” *Id.* at 4 (citing 35 U.S.C. § 312(a)).

Plaid’s Petition “will not be accorded a filing date” until it satisfies a number of requirements, one of which includes serving the Petition and supporting evidence on Yodlee. *See* 37 C.F.R. §§ 42.106(a)(2), 42.105(a). We agree with Yodlee that Plaid failed to provide evidence that service was attempted by midnight on the bar date, i.e., December 2, 2015. Plaid’s counsel attests that the Petition was deposited with FedEx “shortly after filing” was completed on December 3, 2016. Ex. 1022 ¶ 9. The evidence of record also reflects that the Petition was not picked up by FedEx until the evening of December 3, 2016, and it was not delivered until the morning of December 4, 2016. Ex. 1024. Therefore, based on Plaid’s evidence related to service, we determine that December 3, 2016, is the earliest date by which Plaid satisfied the service requirement for according the Petition a filing date. *See* 37 C.F.R. §§ 42.105(a), 42.106(a).

B. Plaid Has Failed to Show Good Cause to Excuse Late Service

Plaid contends we should excuse its late service of the Petition and supporting evidence under 37 C.F.R. § 42.5(c)(3). Mot. 10. Section 42.5(c)(3) states “[a] late action will be excused on a showing of good cause or upon a Board decision that consideration on the merits would be in the interests of justice.” 37 C.F.R. § 42.5(c)(3). Plaid reasons “[t]here is no prejudice to Patent Owner and service was accomplished promptly,” and that “Patent Owner received the service copies on December 4, 2015, the same day had service been effected via Priority Mail Express after 5p.m. on December 2nd.” Mot. 10 (citing 37 C.F.R. § 42.6(e); Exs. 1024, 1026).

Plaid also cites two previous Board decisions as supporting the application of § 42.5(c)(3) in this case. *Id.* (citing *CoreLogic, Inc. v. Boundary Sols., Inc.*, Case IPR2015-00226, slip op. at 3 (Oct. 27, 2015) (Paper 34) (“*CoreLogic*”); *Ricoh Ams. Corp. v. MPHJ Tech. Invs., LLC*, Case IPR2013-00302, slip op. at 3–4 (Mar. 11, 2014) (Paper 32) (“*Ricoh*”). Plaid additionally contends that we may waive the requirements to obtain a filing date under our authority in 37 C.F.R. § 42.5(b). Mot. 6, 9–10; Reply 4–5.

Yodlee argues Plaid has failed to satisfy the statutory criteria of 35 U.S.C. §§ 312(a) and 315(b), so “37 C.F.R. § 42.5 does not grant the Board any authority to grant an earlier filing date.” Opp. 5–6. Yodlee also contends that, by waiting until the last minute for potential changes to Dr. Mowry’s declarations, Plaid “knowingly risked not meeting the one year bar by not leaving enough time to complete filing and service.” *Id.* at 9. Yodlee further contends granting Plaid’s motion “would be highly prejudicial to [Yodlee] by allowing [Plaid] to circumvent the statutorily-prescribed one-year deadline for filing petitions for *inter partes* review.” *Id.*

We need not address whether, under appropriate circumstances, we have authority to grant an earlier filing date, because we determine based on the current record that Plaid has failed to show good cause to warrant exercising our authority under 37 C.F.R. § 42.5(b) or (c)(3) to waive the service requirement imposed by 37 C.F.R. §§ 42.105(a) and 42.106(a). We agree with Yodlee that Plaid’s “problems arose from its own intentional delay in completing the petition.” Opp. 1. We also agree with Yodlee that, by waiting for potential changes to Dr. Mowry’s declarations, Plaid “knowingly risked not meeting the one year bar by not leaving enough time to complete filing and service, much less enough time to do the multitude of

tasks that would have been required in the case of any changes.” *Id.* at 9–10. In our view, Plaid’s belief that it had sufficient time, *see* Reply 5, should not insulate Plaid from the consequences of the risk it took. And, more importantly, Plaid puts forth no evidence of extenuating circumstances that forced Plaid or its declarant, Dr. Mowry, to wait until such a late hour to complete the supporting declarations prior to filing and serving the Petition and supporting evidence. Put simply, and based on the evidence presented, Plaid freely chose the time frame of its filing and service activities. Plaid left itself no margin for error despite having had one year to prepare the Petition.

In addition, the cases cited by Plaid do not support a waiver of timely service of the Petition, because they both pertain to deadlines that occurred after the institution of *inter partes* review, rather than at the time of filing a petition. *See CoreLogic*, slip op. at 1–3 (relating to late filing and service of a Patent Owner Response to the Petition); *Ricoh*, slip op. at 1–3 (relating to late filing and service of Patent Owner’s Motion to Amend).

Although Plaid argues its late service caused no prejudice to Yodlee, we are not persuaded by this argument. The obvious purpose of requiring service within the one-year statutory period set forth in 35 U.S.C. § 315(b) is either to provide a patent owner with timely notice that its patent is subject to an *inter partes* review proceeding, or else to give the patent owner repose at the end of the statutory period. As such, Yodlee is entitled to rely on the statutory and regulatory provisions governing service, a circumstance Plaid’s prejudice analysis does not acknowledge. Moreover, to the extent there is prejudice to Yodlee here, it was created by Plaid’s own delay. Plaid could have taken any number of steps to serve timely Yodlee, such as by emailing

the papers to Yodlee's counsel before the deadline, but the record is devoid of evidence showing such effort on Plaid's behalf. And Plaid's allusion to Priority Mail delivery time frames (*see* Mot. 10) rings hollow when service in this case ultimately was not even attempted until the one-year statutory period expired. *See* Ex. 1024.

Finally, we consider whether it is in the interests of justice to excuse Plaid's late service. On one hand, Plaid's Petition will be time-barred if we do not excuse the late service. On the other hand, as recognized by Yodlee, *see* Opp. 9, Yodlee would be prejudiced if Plaid were allowed to circumvent the one-year deadline so as to allow Plaid's Petition to go forward. These considerations mirror one another. On balance, however, we find that Plaid had control over the fate of the Petition, whereas Yodlee did not. In addition, we are troubled that Plaid's proffered evidence regarding service contradicts Plaid's Certificate of Service for the Petition. *Compare* Ex. 1022 ¶ 9 (counsel declaring that Plaid did not attempt service until after filing was completed on December 3, 2015) *with* Pet. 61 (indicating that the Petition was served on December 2, 2015). Plaid never attempted to amend its Certificate of Service to conform to the factual record. Accordingly, we do not find that excusing Plaid's belated service of the Petition and supporting evidence would be in the interests of justice.

For these reasons, we decline to excuse Plaid's late service of the Petition under our authority in 37 C.F.R. § 42.5(b) and (c)(3).

C. Plaid's Failure to File Timely a Complete Petition Further Supports Denying Institution

There is at least one additional consideration that weighs in favor of denying institution in this case—namely, Plaid's failure to file a complete

petition that complies with our regulations by the one-year statutory deadline under 35 U.S.C. § 315(b). *See* 37 C.F.R. § 42.106(a). We now consider Plaid’s arguments related to filing.

Plaid argues that 35 U.S.C. § 312(a) “cannot specify what it takes for the petition to be ‘filed’ in the first place” because this section “presupposes that petition has been ‘filed.’” Reply 2. In this way, Plaid attempts to draw a distinction between filing under § 315(b) and when a filed petition may be considered under § 312(a). *Id.* Plaid additionally argues that “fil[ing]” under 35 U.S.C. § 315(b) only requires filing of the Petition paper itself, and not the filing of all supporting evidence. Mot. 6; Reply 1–2. Plaid asserts that it at least filed the Petition paper before the midnight deadline on December 2, 2015. Mot. 3 (citing Ex. 1021 ¶ 12; Ex. 1022 ¶ 8), 6, 9; Reply 2. Yodlee contends that Plaid does not satisfy the requirements of § 315(b) by merely “uploading the [P]etition without exhibits (or with only some exhibits).” Opp. 3.

We are not persuaded by Plaid’s argument that only a petition paper—and not the supporting evidence—need be filed by the end of the one-year statutory period set forth in 35 U.S.C. § 315(b). Plaid’s Petition was required to include evidence supporting the grounds for challenging each claim, including copies of the affidavits, declarations, patents, and printed publications on which Plaid relies. 35 U.S.C. § 312(a)(3). This requirement is reflected in our regulations governing filing dates, wherein the Board does not accord a filing date to a petition until it satisfies a number of requirements. *See* 37 C.F.R. §§ 42.104, 42.106(a). Considering our regulations governing when a petition may be accorded a filing date, Plaid’s filing of a fronting document, standing alone, is inadequate to garner a filing

date for a *complete petition*. Moreover, the idea that filing only would require a fronting paper and not its exhibits is antithetical to the purpose of a petition, which is to give adequate notice to the Patent Owner of the basis for relief by laying out a petitioner's grounds and supporting evidence. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,763 (Aug. 14, 2012).

Nor are we persuaded by Plaid's contention that its failure to file a complete petition was a "clerical or typographical mistake" under 37 C.F.R. § 42.104(c). *See* Mot. 6–7. Indeed, past "clerical mistakes" cited by Plaid for which the Board has allowed correction relate to entirely different situations. For example, in two Board cases cited by Plaid, *see* Mot. 6–7; Reply 1, correction of a mistake was allowed where the petitioners uploaded timely all of their papers, but merely forgot to click the "Submit" button. *See 2Wire, Inc. v. TQ Delta LLC*, Case IPR2015-00239, slip op. at 4, 8 (Jan. 15, 2015) (Paper 10); *ConMed Corp. v. Bonutti Skeletal Innov., LLC*, Case IPR2013-00624, slip op. at 7 (Feb. 21, 2014) (Paper 18). Although Plaid attempts to characterize its late filing as merely being an inadvertent delay in clicking the "Submit" button, *see* Reply 4–5, this characterization belies Plaid's failure to file a complete petition before the one-year statutory deadline. We additionally observe that, in contrast to the instant case, service in *2Wire* and *ConMed* also was completed timely. *See 2Wire*, slip op. at 4; *ConMed*, slip. op. at 2.

In two other Board cases cited by Plaid, *see* Mot. 9; Reply 3, the petitioners filed timely one wrong exhibit, and, despite this mistake, the petitioners had at least served the correct exhibit. *See Nestle USA, Inc. v. Steuben Foods Inc.*, Case IPR2015-00195, slip op. at 4 (PTAB Jan. 21,

2015) (Paper 9); *Schott Gemtron Corp. v. SSW Holding Co.*, Case IPR2014-00367, slip op. at 3 (PTAB Sept. 22, 2014) (Paper 30). In another Board case cited by Plaid, see Mot. 8–9, the petitioner filed and served timely the petition, but included a European patent as an exhibit rather than the related European patent application publication that was referenced in the petition. *Syntroleum Corp. v. Neste Oil OYJ*, Case IPR2013-00178, slip op. at 3 (PTAB July 22, 2013) (Paper 21). These three Board cases are distinguishable from the instant case in that service was made timely in each case. In addition, the one exhibit filed incorrectly (but timely) in each case was either served correctly or available publicly; this differs from Plaid’s wholesale failure to file timely several exhibits before the one-year statutory deadline.

Plaid’s reliance on the clerical mistake in *ABB Inc. v. Roy-G-Biv Corp.*, Case IPR2013-00063 (PTAB Jan. 16, 2013) (Paper 21), also is unavailing. See Reply 3. In *ABB*, the petitioner filed timely papers related to two petitions, but mistakenly uploaded the wrong petition paper, exhibit list, and transmittal letter in one of the cases. See *ABB*, slip op. at 4. The petitioner nevertheless served timely the correct versions of both petitions on the patent owner. See *id.* at 5. Again, in contrast to this case, filing of all papers in *ABB*, including the mistaken ones, was completed timely, and service also was timely and correctly effected. Therefore, Plaid’s cited “clerical mistake” cases all involve petitioners that at least uploaded timely and served timely, albeit with inadvertent content errors or having failed to click “Submit.” In contrast, we do not view Plaid’s situation—where it intentionally waited to begin filing and it ultimately did not complete timely

the filing and service of the Petition and supporting evidence, *see* Mot. 2–4—to be a “clerical error.”

Finally, the evidence in this case undermines Plaid’s suggestion that PRPS errors constituted or caused a “clerical mistake.” *See* Mot. 5–6. This is borne out by the fact that Plaid continuously was able to upload documents both before and after the midnight deadline. *See id.* at 3–4 (citing Ex. 1021 ¶¶ 12–13; Ex. 1022 ¶ 8). Plaid has not provided any objective evidence that technical issues occurred with the PRPS system at the relevant time, and we are not aware of any. We also are not persuaded that PRPS downtime two weeks after Plaid’s filing had any bearing on Plaid’s ability to file timely a complete petition in the instant case during the evening of December 2nd and into the early morning of December 3rd. *See* Mot. 2 n.1. Therefore, to the extent Plaid contends the relevant “clerical mistake” relates to degraded performance of PRPS, we are not persuaded by this line of argument.

III. CONCLUSION

For the foregoing reasons, Plaid failed to serve upon Yodlee the Petition and supporting evidence in accordance with 37 C.F.R. § 42.105(a) such that the Petition satisfies all the requirements for according it a filing date imposed by 37 C.F.R. § 42.106 within the one-year period set forth in 35 U.S.C. § 315(b). We do not waive Plaid’s service requirement as a prerequisite for obtaining a filing date or excuse Plaid’s late service under 37 C.F.R. § 42.5(b) and (c)(3), because Plaid does not show good cause to do so. Plaid also failed to file a complete petition in accordance with 37 C.F.R. § 42.106(a) within the statutory period of 35 U.S.C. § 315(b), and we

determine this failure did not constitute a clerical mistake under 37 C.F.R. § 42.104(c). Accordingly, we deny Plaid's motion to change the filing date accorded to its Petition, and we do not institute an *inter partes* review on any of the asserted grounds as to any of the challenged claims of the '077 patent, because the Petition is time-barred under 35 U.S.C. § 315(b).

IV. MOTION FOR *PRO HAC VICE* ADMISSION

On April 7, 2016, Yodlee filed a motion for *pro hac vice* admission of David M. Barkan in this proceeding. Paper 14. In view of our decision denying institution of *inter partes* review herein, Yodlee's motion for *pro hac vice* admission is dismissed as moot.

V. ORDER

Accordingly, it is:

ORDERED that Petitioner's motion to change the filing date accorded to the Petition is *denied*;

FURTHER ORDERED that the Petition is *denied* as to all challenged claims and no trial is instituted; and

FURTHER ORDERED that Patent Owner's motion for *pro hac vice* admission of David M. Barkan is dismissed as moot.

Case IPR2016-00275

Patent 6,199,077 B1

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