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To: [Trials](#)
Cc: [R. Ross Viquet](#); dwalker@schneiderwallace.com; ray.ferrera@arlaw.com; [Robert Greeson](#); shunter@schneiderwallace.com
Subject: RE: IPR2023-00153, IPR2023-00154, and IPR2023-00568
Date: Monday, April 1, 2024 5:43:54 PM
Attachments: [23-1048.ORDER.3-26-2024.pdf](#)

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Dear Board,

Petitioner's position is the following:

1. Regarding why the parties have allegedly "failed to update [the Board] regarding the Federal Circuit's decision," although the Federal Circuit indeed affirmed the district court's invalidity finding under 35 U.S.C. § 101 in January, Patent Owner filed a petition for en banc rehearing. The Federal Circuit's decision on that petition (attached) issued only last week (March 25, 2024) and denied rehearing, thereby indicating the court's final position on the matter. Thus, to the extent 37 C.F.R. § 42.8(a)(3) requires identifying not only a judicial matter that would affect the proceedings but also a final decision in the matter, that decision did not issue until last week. 21 days have not yet passed since then, and thus the parties still have the opportunity to comply with § 42.8(a)(3).
2. Regarding "how the Board should proceed in the above identified proceedings in light of the Federal Circuit's decision," Patent Owner currently has until June 24, 2024, to file a petition for writ of certiorari with the Supreme Court. Should Patent Owner choose to file, the Court has stated it will decide on the petition in, "[o]n the average, about six weeks," i.e., around August 5, 2024. See <https://www.supremecourt.gov/publicinfo/reportersguide.pdf> at 15. Should the Court then deny, the invalidation of all patents at issue will become final. Despite being decided under § 101, such would nevertheless moot the current IPRs by invalidating all instituted claims.

In other words, by around August 5, 2024, the Board and parties will know whether the IPRs may be terminated for mootness. However, oral arguments for the IPRs are currently scheduled before this date (May 31 and July 2, 2024), and final written decisions are due shortly after this date (Sept. 5 and Oct. 2, 2024). But because of the possibility of mootness, which Petitioner believes is high, the IPRs should be stayed pending either (1) Patent Owner's decision to not file a certiorari petition by June 24, 2024, or otherwise (2) the Court's decision on such a petition. The stay need not extend beyond this period, however, because if certiorari is granted, such a case would involve only a § 101 issue, which does not directly affect any issues in the IPRs.

Nonetheless, the proposed a stay would likely require an extension of the discussed final written decision deadlines. Under 35 U.S.C. § 316(a)(11), "the Director may, for good cause

shown, extend the 1-year period by not more than 6 months”—i.e., March 5 and April 2, 2025, which should provide sufficient time for adjudication after August 5, 2024. Good cause for both the stay and extension is shown by the high likelihood that the IPRs will be mooted, which would benefit the Office, both parties, and the public by conserving resources.

Patent Owner’s position is the following:

Patent Owner’s position as to why the parties allegedly “failed to update [the Board] regarding the Federal Circuit’s decision” is largely the same as that of Petitioner. Patent Owner would add that the Federal Circuit decision dealt only with whether the claims encompassed an abstract idea under 35 U.S.C. §101 and not at all with anticipation/obviousness under 35 U.S.C. §§102/103. Therefore, it was not a judicial matter which would be relevant to the anticipation/obviousness decisions to be made in the IPRs.

Patent Owner would not oppose a stay.

The parties are available for conference on April 9, 2024, at any time.

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From: Trials <Trials@USPTO.GOV>
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Subject: IPR2023-00153, IPR2023-00154, and IPR2023-00568

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Counsel,

From the Board –

Petitioner and Patent Owner in the above identified proceedings have identified the Federal Circuit

appeal in *Plotagraph, Inc. v. Lightricks, Ltd.*, No. 23-1048, as a related proceeding. *See, e.g.*, IPR2023-00153, Paper 1 at 1; Paper 5 at 2. Petitioner has represented that this appeal is from a district court decision finding the patents challenged in the above identified proceedings as invalid under 35 U.S.C. § 101. *See, e.g.*, IPR2023-00153, Paper 1 at 93. It appears that the Federal Circuit has affirmed the district court's decision and that the court's mandate will issue soon. *See Plotagraph, Inc. v. Lightricks, Ltd.*, No. 2023-1048, 2024 WL 223185 (Fed. Cir. Jan. 22, 2024). 37 C.F.R. § 42.8(a)(3) requires the parties to update us within 21 days of any changes of information in § 42.8(b), which includes "judicial . . . matter(s) that would affect . . . a decision in the proceeding." The parties are therefore directed to explain why they have failed to update us regarding the Federal Circuit's decision and also provide us with their position(s) on how the Board should proceed in the above identified proceedings in light of the Federal Circuit's decision. The parties also are directed to provide us with available times for a conference with Board during the weeks of April 1st and April 8th.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

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