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Paper 22
Date: July 16, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LIGHTRICKS LTD.,
Petitioner,

v.

PLOTAGRAPH, INC. and SASCHA CONNELLY,
Patent Owner.

IPR2023-00153 (Patent 10,346,017 B2)
IPR2023-00154 (Patent 10,621,469 B2)
IPR2023-00568 (Patent 11,182,641 B2)[1]

Before PATRICK R. SCANLON, CHARLES J. BOUDREAU, and IFTIKHAR AHMED, *Administrative Patent Judges*.

AHMED, *Administrative Patent Judge*.

ORDER
Extending One-Year Pendency for Good Cause
35 U.S.C. § 316(a)(11); 37 C.F.R. § 42.100(c)

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[1] This Order addresses issues that are the same in all three cases. We therefore exercise our discretion to issue one Order to be filed in each case. The parties may not use this style heading for any subsequent papers without authorization.

DISCUSSION

Lightricks Limited ("Petitioner") filed petitions requesting *inter partes* review of claims 1–18 of U.S. Patent No. 10,346,017 B2; claims 1, 2, 6–14, and 18 of U.S. Patent No. 10,621,469 B2; and claims 1–4, 8–15, 19, and 20 of U.S. Patent No. 11,182,641 B2. IPR2023-00153, Paper 1; IPR2023-00154, Paper 1; IPR2023-00568, Paper 1. On September 5, 2023, we instituted trial in IPR2023-00153 and IPR2023-00154; and on October 2, 2023, we instituted trial in IPR2023-00568. IPR2023-00153, Paper 9; IPR2023-00154, Paper 9; IPR2023-00568, Paper 7. The one-year period normally available to issue a Final Written Decision in IPR2023-00153 and IPR2023-00154 expires on September 5, 2024; and the one-year period normally available to issue a Final Written Decision in IPR2023-00568 expires on October 2, 2024.

In the Petitions, Petitioner informed us that, in parallel litigation, the U.S. District Court for the Southern District of Texas found the claims challenged in these proceedings to be directed to patent-ineligible subject matter under 35 U.S.C. § 101 and dismissed parallel litigation between the parties under Fed. R. Civ. P. 12(b)(6) for failure to state a claim. IPR2023-00153, Paper 1, 93; IPR2023-00154, Paper 1, 96; IPR2023-00568, Paper 1, 93; *see Plotagraph, Inc. v. Lightricks Ltd.*, 620 F. Supp. 3d 591, 602 (S.D. Tex. 2022). On January 22, 2024, the U.S. Court of Appeals for the Federal Circuit entered a decision affirming the district court's determination, and. on March 26, 2024, the Federal Circuit denied a petition for *en banc*

rehearing of that decision. *See* Ex. 3002;[2] *See Plotagraph, Inc. v. Lightricks, Ltd.*, No. 2023-1048, 2024 WL 223185 (Fed. Cir. Jan. 22, 2024); *Plotagraph, Inc. v. Lightricks, Ltd.*, No. 2023-1048, slip op. at 2 (Fed. Cir. Mar. 26, 2024).

In a joint email message from the parties dated April 2, 2024, Petitioner requested that these three proceedings be stayed pending either (1) Patent Owner's decision to not file a certiorari petition by June 24, 2024, or otherwise (2) the Supreme Court's decision on such a petition. Ex. 3001. Patent Owner expressed that it would not oppose such a stay. *Id.* We denied that request. Paper 14, 3. Petitioner also requested that we extend the Final Written Decision deadlines in these proceedings to allow for a stay. Paper 16, 2 (citing 35 U.S.C. § 316(a)(11)). We denied Petitioner's request because Patent Owner had yet to file a petition for writ of certiorari with the Supreme Court. Paper 18, 6.

In an email message dated June 26, 2024, Petitioner informed the Board that Patent Owner "filed a petition for writ of certiorari on Monday, June 24, 2024, appealing the invalidation of all claims of all challenged patents under 35 U.S.C. § 101 in the parallel district court litigation." Ex. 3004. Petitioner further stated that, "[i]n view of Patent Owner now having filed the petition, Petitioner and Patent Owner jointly seek to renew the earlier request to stay the proceedings pending the Court's decision on the petition." *Id.* Petitioner contends that a decision on Patent Owner's petition can be expected by October 7, 2024, necessitating an extension of

[2] Unless otherwise indicated, references to exhibits and papers numbers herein refer to IPR2023-00153.

the final written decision deadlines in these proceedings. *Id.* (citing 37 CFR § 42.100(c)). Petitioner contends that "[t]he exceedingly high likelihood that Board and party resources would be preserved by a stay . . . provides . . . good cause" for such an extension. *Id.*

Pursuant to 35 U.S.C. § 316(a)(11), "the final determination in an inter partes review [shall] be issued not later than 1 year after the date on which the Director notices the institution of a review under this chapter, except that the Director may, for good cause shown, extend the 1-year period by not more than 6 months . . . ." The Director has delegated the authority to extend the one-year period to the Chief Administrative Patent Judge. *See* 37 C.F.R. § 42.100(c). In particular, 37 C.F.R. § 42.100(c) provides:

> An *inter partes* review proceeding shall be administered such that pendency before the Board after institution is normally no more than one year. The time can be extended by up to six months for good cause by the Chief Administrative Patent Judge . . . .

In accordance with 37 C.F.R. § 42.100(c), the Chief Administrative Patent Judge has determined that good cause exists to extend the one-year period for issuing a Final Written Decision here. IPR2023-00153, Paper 23; IPR2023-00154, Paper 23; IPR2023-00568, Paper 21; 37 C.F.R. § 42.100(c). Accordingly, the time to administer the present proceeding is extended by up to six months.

We also agree with the parties that there is a high likelihood that the Supreme Court may deny Patent Owner's certiorari petition, at which point the district court's decision invalidating all challenged claims will become final. Ex. 3004. The parties represent that, if the certiorari petition is

denied, they "will seek termination of the proceedings for mootness" at that point. *Id.* Based on this representation, we agree that a stay would likely save Board and party resources, and therefore, *grant* a stay pending the Supreme Court's decision on Patent Owner's petition.[3] The parties are directed to update us immediately with any developments in the parallel proceeding.

ORDER

Accordingly, it is:

ORDERED that good cause exists to extend the time of pendency in these proceedings;

FURTHER ORDERED that these proceedings are extended by up to six months;

FURTHER ORDERED that the parties file updated Mandatory Notices identifying the case pending before the U.S. Supreme Court; and

FURTHER ORDERED that all deadlines in these proceedings are stayed pending further notice.

[3] Based on the parties' representations, we stayed the oral argument in these proceedings, which had been scheduled for July 15, 2024. *See* Ex. 3005.

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