UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

KAHOOT! ASA & KAHOOT EDU, INC.,
Petitioner

v.

AVIEL D. RUBIN,
Patent Owner.

Patent No. 9,064,376

PATENT OWNER'S CORRECTED PRELIMINARY RESPONSE TO THE PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 9,064,376

TABLE OF CONTENTS

I. INTRODUCTION 1

II. THE PETITION SHOULD BE DISMISSED BECAUE IT WAS NOT PROPERLY SERVED 1
- A. Kahoot! Missed the FedEx Pick-up Deadline, And Pick-up Was Not Scheduled Again Until "The Next Business Day" 2
- B. Kahoot!'s Petition Was Not Served Within the One-Year Time Limit 3
- C. Kahoot! Failed to Serve "by Priority Mail Express® or by means at least as fast and reliable as Priority Mail Express®" 4
- D. Equity Warrants Dismissal 7

III. CONCLUSION 9

TABLE OF AUTHORITIES

Cases

Facebook, Inc. v. Rembrandt Social Media, L.P.,
Case No. IPR2014-00415, Paper No. 9 (P.T.A.B. July 7, 2014) 6

CoolIT Sys., Inc., v. Asetek Danmark A/S,
Case No. IPR2020- 00522, Paper No. 9 (P.T.A.B Aug. 24, 2020) 5,6

Nuna Baby Essential, Inc. v. Britax Child Safety, Inc.,
Case No. IPR2018-01683, Paper No. 11 (P.T.A.B. Dec. 18, 2018) 4,7

Plaid Techs., Inc. v. Yodlee, Inc.,
Case No. IPR2016-00275, Paper No. 15 (P.T.A.B. June 9, 2016) 4,8

Terremark North America LLC v. Joao Control & Monitoring Sys., LLC,
Case No. IPR2015-01482, Paper No. 10 (P.T.A.B. Dec. 28, 2015) 3

Varian Med. Sys., Inc. v. Best Med. Int'l, Inc.,
Case No. IPR2020-00071, Paper 14 (P.T.A.B May 1, 2020) 5,6

Statutes

35 U.S.C. § 315(b) 2,8

Rules

37 C.F.R. § 42.6 1

37 C.F.R. § 42.104 1

37 C.F.R. § 42.105 1

37 C.F.R. § 42.105(b) ..... *passim*

I. INTRODUCTION

Dr. Aviel Rubin, the recently retired Technical Director of the JHU Information Security Institute in the department for computer science at Johns Hopkins University, is the inventor and patent owner of U.S. Patent No. 9,064,376 ("the '376 Patent"). In March 2022, Dr. Rubin sued Kahoot! ASA & Kahoot Edu, Inc. ("Kahoot!" or "Petitioner") in Federal court for infringement of the '376 Patent. By its petition for *inter partes review*, Kahoot! seeks to invalidate claims 1-5, 9-10, 12-17, and 23-25 ("the Challenged Claims") of the '376 Patent relying on two primary references and eight obviousness combinations (the "Petition"). The Board should not reach the merits of Kahoot!'s Petition because Kahoot! failed to timely serve its Petition.

II. THE PETITION SHOULD BE DISMISSED BECAUSE IT WAS NOT PROPERLY SERVED

On March 10, 2022, Kahoot! was served with a complaint for infringement of the '376 Patent, making **Friday, March 10, 2023,** the one-year deadline for Kahoot! to file its Petition. *See* 37 C.F.R. §§ 42.6, 42.104, 42.105. Kahoot! failed to properly serve its Petition and associated materials on or before March 10, 2023. Instead, Kahoots!'s Petition and associated materials were not *picked-up for service* until close-of-business on **Monday, March 13, 2023**, a full three (3) days later. Ex. 2001. The papers were not actually served until Wednesday, March 15,

2023, a full five (5) days after the deadline. Ex. 2002. Nor did Kahoot! or its counsel attempt to provide Kahoot!'s Petition electronically to mitigate the late service. On occasion, the Board has accepted service of a petition after the one-year deadline where that petition was delivered to the mail carrier on the final day (Friday, March 10, 2023 in this case), and delivered to the patent owner "the next business day" (Monday, March 13, 2023 in this case). Kahoot!'s Petition falls outside these holdings because Kahoot! did not take steps to ensure service would be the next business day. Instead, actual service was three (3) business days after the deadline. While dismissal of Kahoot!'s Petition on this technical ground may seem harsh, it is not unfair when a petitioner such as Kahoot! waits until the last few hours of the very last day of a one-year deadline to file and serve its petition. Accordingly, Kahoot!'s Petition should be dismissed. *See* 35 U.S.C. § 315(b).

A. Kahoot! Missed the FedEx Pick-up Deadline, And Pick-up Was Not Scheduled Again Until "The Next Business Day"

At 8:49 p.m. Eastern time on Friday, March 10, 2023, Kahoot! completed upload of its Petition to the Patent Office. It was not until approximately 8:17 pm Central time (10:17 p.m. Eastern time), almost 90 minutes later, that Kahoot! chose to deliver its Petition to a FedEx location at a Walgreens in Austin, Texas. Ex. 2001. But the "pick-up" deadline for the next day delivery option at that particular Walgreens had passed. *Id*. ("Package received after final location pickup has

occurred. Scheduled for pickup next business day.") Thus, the next "pick-up" of the Petition was not until "the next business day," which was Monday, March 13, 2023, the day that the Petition should have been served on the Patent Owner. *Id*. Moreover, Kahoot! specified a P.O. Box for delivery of the Petition, however, Kahoot!'s chosen carrier, FedEx, does not deliver to P.O. Box address likely resulting in further delay of Kahoot!'s own making. By dropping off after hours at a location that could not possibly deliver the next "business day" and by specifying an improper delivery address for the chosen carrier, Kahoot!, through its own fault, missed the mailing deadline to ensure that its Petition would be delivered, and service would be complete, by the next business day--Monday, March 13, 2023.

B. Kahoot!'s Petition Was Not Served Within The One-Year Time Limit.

A "petition is only accorded a filing date once (1) a petition has been filed; (2) payment has been made; and (3) the complete petition is served on the patent owner." *Terremark North America LLC v. Joao Control & Monitoring Sys., LLC,* Case No. IPR2015-01482, Paper No. 10 at 7 (P.T.A.B. Dec. 28, 2015) (*citing* 35 U.S.C § 312(a), 37 C.F.R. § 42.106(a)). More than one year passed between Kahoot! receiving the complaint and Kahoot! attempting to properly file and serve its Petition. Kahoot!'s "problems arose from its own intentional delay in

completing the petition." *See Plaid Techs., Inc. v. Yodlee, Inc.*, Case No. IPR2016-00275, Paper No. 15 at 8 (P.T.A.B. June 9, 2016). By delaying the entire year, and waiting until late on the last day, Kahoot! "knowingly risked not meeting the one year bar by not leaving enough time to complete the filing and service." *Id.* at. 8-9. It is not good faith to wait until late on the last day to attempt filing and proper service. *Id.; see also Nuna Baby Essential, Inc. v. Britax Child Safety, Inc.*, Case No. IPR2018-01683, Paper No. 11 at 6 (P.T.A.B. Dec. 18, 2018).

C. Kahoot! Failed To Serve "by Priority Mail Express® or by means at least as fast and reliable as Priority Mail Express®"

The Board's rules on *how* to serve a petition are clear and mandatory:

> Service may be by Priority Mail Express® or by means at least as fast and reliable as Priority Mail Express®.

37 C.F.R. § 42.105(b).

Rule 6 clearly instructs litigants that any means for service can be used, provided that the means selected is "at least as fast and reliable as Priority Mail Express®." *Id.* Kahoot! did not serve its petition by Priority Mail Express® or by means at least as fast and reliable as Priority Mail Express®. Priority Mail Express offers an "overnight delivery guarantee" and is the U.S. Postal Service's "fastest domestic service, with limited exceptions, available 365 days a year." *See* Ex. 2001. Thus, to satisfy Rule 6, Kahoot! needed to use Priority Mail Express® or

another means that would deliver the materials the next day, on March 11, 2023, or at the very least, the "next business day," Monday, March 13, 2023.

The Board has interpreted "Priority Mail Express® or another means" to mean "the next business day." *See CoolIT Sys., Inc., v. Asetek Danmark A/S*, Case No. IPR2020- 00522, Paper 9 at 10–12 (P.T.A.B Aug. 24, 2020) (determining that next business day FedEx service is sufficiently akin to Priority Mail Express); *see Varian Med. Sys., Inc. v. Best Med. Int'l, Inc.,* Case No. IPR2020-00071, Paper 14 at 33–34 (P.T.A.B. May 1, 2020). In *Varian*, the Petitioner deposited the petition with FedEx on a Friday evening. Delivery was made the following Monday and held to be sufficiently akin to Priority Mail Express despite the Patent Owners argument that next day delivery should have been made on Saturday. *Id* at 33-34. ("Patent Owner's arguments would have us read a next-day service requirement into 37 C.F.R. § 42.105(b). We decline to do that."). Similarly, the Board in *CoolIT*, citing *Varian*, held that "we are satisfied that Petitioner's use of FedEx on a Friday evening Pacific Time followed by delivery on a Monday—*the next business day*—is sufficiently akin to Priority Mail Express to satisfy the service requirement § 42.105(b)." *CoolIT Sys., Inc., v. Asetek Danmark A/S*, Case No. IPR2020- 00522, Paper 9 at 12 (emphasis added).

Here, the Petitioner used FedEx which, under the right circumstances, can be sufficiently akin to Priority Mail Express, but it required Kahoot! to deliver timely

its Petition to a FedEx location so that the Petition would arrive by Monday- the "Next Business Day." The FedEx Detailed Tracking information informs that the Petition and related materials were "dropped off at FedEx OnSite -WALGREENS" in Austin, Texas on Friday March 10, 2023 at 8:17 p.m. Central time. Ex. 2001. The tracking information states "Package received after final location pickup has occurred. *Scheduled for pickup next business day." See id*. (emphasis added)*; see also Facebook, Inc. v. Rembrandt Social Media, L.P.*, Case No. IPR2014-00415, Paper No. 9 at 6-7 (P.T.A.B. July 7, 2014) (indicating that depositing with FedEx after the cut-off time fails to comply with 37 C.F.R. § 42.105(b)). Thus, Kahoot! failed to deliver the Petition materials to the FedEx location in time to make the next business day delivery the following Monday, March 13 and failed to specify a proper address for FedEx delivery to even occur. Indeed, on the next business day—Monday, March 13, 2023—the Petition was only just picked up for delivery, rather than actually delivered as required by the Rules and the Board's decisions *See Ex.* 2001. 2002. By its own tardy action, Kahoot! did not comply with the Board's rules requiring service "by means at least as fast and reliable as Priority Mail Express®." *See* 37 C.F.R. § 42.105(b).

D. Equity Warrants Dismissal

Kahoot!'s last minute filing—literally waiting to within a few hours of the one-year deadline—resulted in its failure to properly serve its Petition and related

papers. This extremely avoidable yet fatal flaw warrants dismissal of the Petition. The service rules for IPRs have been in effect for several years. The statutes and rules are clear, and consistent enforcement of those statutes and rules is essential for administration of the regime Congress devised. "[T]his issue is of Petitioner's own making. . . . there is no automatic right to petition for an *inter partes* review. . . . A petitioner who files a petition shortly before the time bar should be well aware of the risks associated herewith." *Nuna Baby Essential, Inc. v. Britax Child Safety, Inc.*, Case No. IPR2018-01683, Paper No. 11 at 8 (P.T.A.B. Dec. 18, 2018).

While deposited on the last day for next business day delivery has been held to be equitable and fair, Kahoot!'s service fails to comply with even that standard. When Kahoot! deposited the Petition materials at a FedEx drop off location, it was *already too late* for next business day delivery. The Rules must have force and permitting Kahoot!'s late service erodes the purpose of the prompt and timely service to establish a filing date. Kahoot's failure to effective timely service is of its own making and its concomitant failure to file within the statutory one year time limit dooms its petition. Kahoot!'s disregard for proper service should not be condoned.

It is also notable that the Patent Owner did not receive the Petition from Kahoot! until Wednesday, a full five (5) days after Kahoot! filed its Petition. This was a direct result of Kahoot!'s failure to follow a service method prescribed by 37

C.F.R. § 42.105(b). Dr. Rubin is supposed to have 90-days to file a "Preliminary Response" to Kahoot!'s Petition, but because of Kahoot!'s service method he effectively only received 85-days which unfairly and unnecessarily shorted his response time.

Further, Dr. Rubin will be prejudiced if Kahoot! is permitted to maintain its current filing date and the Board should not waive the requirements to obtain a filing date. It would be prejudicial to Dr. Rubin by allowing Kahoot! to circumvent the statutorily prescribed one-year deadline for filing petitions. *See Plaid Techs., Inc. v. Yodlee, Inc.*, Case No. IPR2016-00275, Paper No. 15, p. 9 (P.T.A.B. June 9, 2016)."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." *Id*. Dr. Rubin is "entitled to rely on the statutory and regulatory provisions governing service" particularly when it is Kahoot! who created the delay. *Id*. Indeed, Kahoot even neglected to email its Petition to Dr. Rubin's counsel which could have at least mitigated the prejudice caused by the Wednesday, March 15, 2023 delivery, five (5) days after the Petition was first filed. Kahoot!'s failure to comply with the service requirement was easily avoidable, and should not be excused. To do otherwise would be directly conflict with 37 C.F.R. § 42.105(b) and

the Board's own precedent, and erode what have otherwise been clear rules for proper service.

III. CONCLUSION

Kahoot!'s Petition should be dismissed because it was not properly served and trial should not be instituted on the '376 Patent.

Respectfully submitted,

Dated: June 20, 2023

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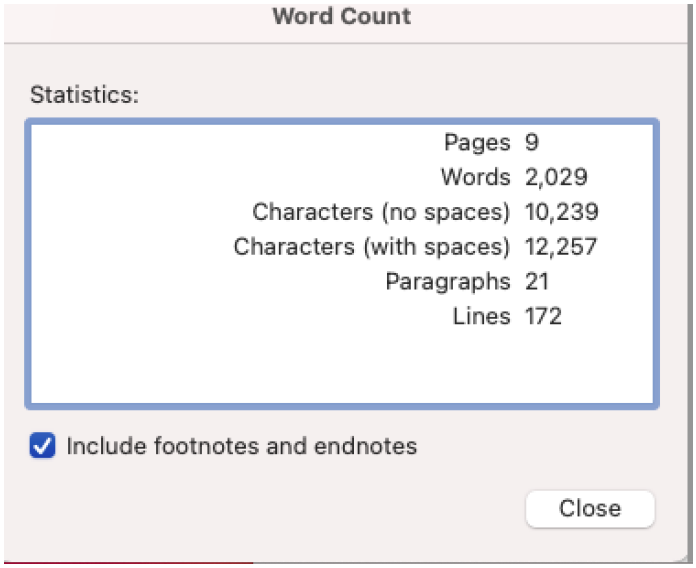
CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. §42.24(d), the undersigned certifies that the foregoing Petition, exclusive of the exempted portions as provided in 37 C.F.R. §42.24(a), contains 2,029 words and complies with the type-volume limitations of 37 C.F.R. §42.24(a) (fewer than 14,000). The word count was calculated by Microsoft Word.



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CERTIFICATE OF FILING AND SERVICE

I hereby certify that a true and correct copy of the foregoing PATENT OWNER'S CORRECTED PRELIMINARY RESPONSE TO THE PETITION FOR INTER PARTES REVIEW OF U.S. PATENT NO. 9,064,376 is being filed electronically via P-TACTS and served on counsel for Petitioner by electronic mail this 20th day of June 2023 as follows:

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