

IN THE
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

Inter Partes Review Case No. IPR2023-00693
Patent No. 9,064,376

**PETITIONER'S REPLY BRIEF TO
PATENT OWNER PRELIMINARY RESPONSE**

Mail Stop Patent Board
Patent Trial and Appeal Board
P.O. Box 1450
Alexandria, VA 22313-1450

July 14, 2023

LIST OF EXHIBITS

1001	Rubin, U.S. Patent 9,064,376 (“the ’376 patent”)
1002	Declaration of Sigurd Meldal, Dr.Scient.
1003	Prosecution History File Wrapper of the ’376 patent (excerpts)
1004	U.S. Patent 9,497,565 (“Zha”)
1005	CN 2013/10674692 (“Zha-Priority-Application”)
1006	Certified English translation of the <i>Zha-Priority-Application</i>
1007	U.S. Patent Pub. 2015/0011318 (“Takahashi”)
1008	PCT/JP2012/007595 (“Takahashi-Priority-Application”)
1009	Certified English translation of <i>Takahashi-Priority-Application</i>
1010	U.S. Patent Pub. 2014/0006485 (“Tsushima”)
1011	U.S. Patent 9,591,083 (“Gumbula”)
1012	U.S. Patent Pub. 2012/0017236 (“Stafford”)
1013	U.S. Patent 9,330,531 (“Wakeford”)
1014	Patent Owner’s Preliminary Infringement Contentions in <i>Rubin v. Kahoot! ASA et al.</i> , Civil Action No. 6:22-cv-00236 (W.D. Tex.) (Sept. 28, 2022)
1015	U.S. Patent Pub. 2012/0253841 (“’841 Application”)
1016	U.S. Patent Pub. 2012/0209770 (“’770 Application”)
1017	U.S. Patent Pub. 2014/0121015 (“Massing”)
1018	U.S. Patent Pub. 2006/0058088 (“Crawford”)
1019	March 10, 2023 Email from W.Beard (Petitioner) to E.Benisek (PO)
1020	March 14, 2023 Email from E.Benisek (PO) to D.Adams (Petitioner)
1021	FedEx Proof of Delivery of Service Copy of Petition

TABLE OF AUTHORITIES

Cases

<i>CoolIT Systems, Inc. v. Asetek Danmark A/S</i> , IPR2020-00522 (PTAB, Aug. 24, 2020)	4, 5
<i>DynaEnergetics Europe GmbH et al v. QinetiQ Limited</i> , PGR2023-00003 (PTAB, April 13, 2023)	4
<i>Facebook, Inc. v. Rembrandt Social Media, L.P.</i> , IPR2014–00415 (PTAB, July 31, 2014)	2, 3
<i>Varian Med. Sys., Inc. v. Best Med. Int’l, Inc.</i> , IPR2020-00071 (PTAB, May 1, 2020)	4, 5

Statutes

35 U.S.C. § 312(a)(5)	1
35 U.S.C. § 315(b)	1, 4
37 C.F.R. § 42.105(a)	1, 2, 3
37 C.F.R. § 42.105(b)	3
37 C.F.R. § 42.106(a)(2)	2, 3, 5
37 C.F.R. § 42.6(e)(2)	1, 2

Petitioner files this reply pursuant to the Board’s July 3, 2023, authorization. Patent Owner’s (“PO”) sole basis for challenging the Petition—that the Petition’s accorded filing date is unwarranted because service was untimely—should be rejected.

It is undisputed the Petition filing complies with the governing statutes, which merely require *filing* (as opposed to service) prior to the one-year bar date, *see* 35 U.S.C. § 315(b), and service on the PO at an *unspecified* time, *see* 35 U.S.C. 312(a)(5).¹ The PTO’s regulations entirely govern the timeliness of service—37 C.F.R. § 42.105(a) (Petition “must” be served on PO at the correspondence address of record) and 37 C.F.R. § 42.6(e)(2) (requiring service simultaneous with filing). Here, Petitioner served its Petition (1) at the correspondence address of record (2) *on the same day* as the Petition filing by depositing a service copy at a FedEx location. Service was thus perfected under the governing regulations. To the extent service was defective in any manner (it is not), Petitioner requests the Board waive its regulations (as it has done many times) and maintain the accorded filing date because PO suffers no prejudice and Petitioner effected service in good faith,

¹ PO admits March 10, 2023, was the one-year deadline under 35 U.S.C. 315(b) (POPR at 1), and there is no dispute Petitioner filed the Petition on that day. The dispute between the parties boils down to the propriety of the Petition’s service.

including advising PO of the Petition filing on the same day.

Relevant Facts. Petitioner filed its petition at approximately 7:50PM (CT) on Friday, March 10, 2023, using the P-TACTS system. Ex. 1019. Six minutes later, Petitioner sent an email to PO's counsel of record, Eric Benisek, notifying PO of the Petition, including the Petition number. *Id.* Twenty-seven minutes after filing its petition (i.e., 8:17PM (CT)), Petitioner deposited a service copy at an authorized FedEx drop-off site with Priority Overnight service. Ex. 2002 at 2–3. The parcel was addressed to the PO correspondence address of record. Ex. 1021. PO checked his P.O. Box for the Petition on Monday, March 13. Ex. 1020. FedEx attempted delivery on Tuesday, March 14, at 5:53PM, but “Customer not available or business closed.” Ex. 2002 at 3. FedEx successfully delivered the service copy the next day, Wednesday, March 15. *Id.* at 4.

Service Was Perfected Under §§ 42.106(a)(2), 42.105(a), 42.6(e)(2). To be accorded a filing date, the Petition and accompanying exhibits must be served pursuant to 37 C.F.R. § 42.106(a)(2), which in turn requires effecting service on the PO's correspondence address of record as provided in § 42.105(a). *See Facebook, Inc. v. Rembrandt Social Media, L.P.*, Case IPR2014–00415, Paper 14, at 3 (PTAB, July 31, 2014). There is no dispute the relevant documents were served on PO at the correspondence address of record, on the same day as the Petition filing, as required by §42.6(e)(2). Ex. 1021 (proof of delivery). Service was thus perfected under the

mandatory provisions. PO based its argument solely on § 42.105(b). POPR at 4–6. Per PO, (1) compliance with § 42.105(b) is “mandatory” and (2) effective service requires “next business day” delivery. *Id.* PO is wrong on both fronts.

First, unlike 37 C.F.R. § 42.105(a), which uses mandatory “must” language—“the petition and supporting evidence **must be** served...” (emphasis added)—§ 42.105(b) uses permissive “may” language, indicating service “**may be** by Priority Mail Express® or by means at least as fast and reliable...” (emphasis added). Indeed, “42.106(a)(2) does not require compliance with § 42.105(b).” *Facebook*, Paper 14 at 3. Thus, compliance with § 42.105(b) is not “mandatory.”

Second, there is no “next business day” delivery requirement for service to be effective under the rules. In *Facebook*, the petition was deposited on Thursday, February 6, 2014 (the § 315(b) deadline) “after the ‘cut-off time.’” IPR2014–00415, Paper 9 at 6–7. FedEx delivered on Monday, February 10, four days after the § 315(b) deadline, and **not** on the “next business day.” *Id.* at 7.² Still, service was deemed effective because “Section 42.106(a)(2) does not require compliance with

² The *Facebook* petition was not delivered on the “next business day,” which would have been Friday, February 7, 2014. Paper 8 (POPR) at 3 n.4.

§ 42.105(b).” Paper 14, at 3.³ Similar to *Facebook*, PO would have received the service copy four days after the petition was filed (on the § 315(b) deadline) but for PO’s unavailability. Ex. 2002 at 3 (“Customer not available or business closed.”).⁴ And even more recently, the Board maintained the original filing date for a Petition received by the PO at least eight days after Petition filing due to an erroneous service. *DynaEnergetics Europe GmbH et al v. QinetiQ Limited*, PGR2023-00003, Paper 8 at 2–5 (PTAB, April 13, 2023). Here, PO suffered no prejudice and its attempt to avoid a merits-based adjudication of Petitioner’s challenge based on a procedural technicality should be rejected. Indeed, “the law is better served by allowing legal disputes to be decided on their substantive merits rather than by procedural

³ The Board found service effective when the Petition was deposited with Fedex after the deadline for next-day service. *CoolIT Systems, Inc. v. Asetek Danmark A/S*, IPR2020-00522, Paper 9 at 10–12 (PTAB, Aug. 24, 2020); *Varian Med. Sys., Inc. v. Best Med. Int’l, Inc.*, IPR2020-00071, Paper 14 at 33–34 (PTAB, May 1, 2020).

⁴ PO faults Petitioner for using FedEx because, allegedly, “FedEx, does not deliver to P.O. Box address.” POPR at 3. This is misleading because PO’s counsel confirmed PO’s counsel of record “checked [h]is PO Box yesterday (which receives FedEx’s)...” Ex. 1020. Further, FedEx actually delivered the parcel. Ex. 2001, 2002.

technicalities.” Paper 8 at 13.

No Prejudice to PO. First, Petitioner notified PO’s counsel (Eric Benisek) via email on March 10 (the day of filing), and provided PO with the IPR number so that PO could download the Petition from the P-TACTS system. Ex. 1019. On Tuesday, March 14, 2023, PO’s counsel indicated that James Denaro, who is listed as PO’s correspondence address of record, checked his P.O. Box for the Petition on Monday, March 13. Ex. 1020. Thus, PO was aware of the Petition at least as early as Monday, March 13, the next business day after filing. PO’s counsel would not have checked his P.O. Box if he was unaware of the Petition. Second, PO has not argued that 85 days was insufficient to prepare a POPR, which it timely filed. PO has not established any actual prejudice or harm arising from petitioner’s service via FedEx. See *Varian Med.*, Paper 14 at 33–34 (no prejudice by FedEx service).

Alternatively, the Board Should Exercise Its Discretion and Waive the Service Requirement. To the extent the Board finds any impropriety in service, Petitioner respectfully requests that the Board “waive regulatory requirements related to the timing of Petitioner’s service,” as it did in *CoolIT* and *Varian Medical*. *CoolIT*, Paper 9 at 12 (waiving requirement and citing 37 C.F.R. § 42.5(b)); *Varian Med.*, Paper 14 at 34 (same). Petitioner effected service in good faith as required by Section 42.106(a)(2). Dismissing on these grounds exalts form over substance and, thus, is unwarranted.

July 14, 2023
Date

/s/ R. William Beard, Jr.

R. William Beard, Jr. (Reg. No. 39,903)
Brian C. Banner (*Pro Hac Vice*)

Slayden Grubert Beard PLLC
401 Congress Avenue, Suite 1650
Austin, Texas 78701

Attorneys for Petitioner

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §42.6(e), the undersigned certifies that the foregoing Reply has been served simultaneous with filing via email on Patent Owner's lead and back-up counsel as follows:

Robert S. McArthur (mcarthur@vbllaw.com)

Eric W. Benisek (ebenisek@vbllaw.com)

July 14, 2023
Date

/s/ R. William Beard, Jr.

R. William Beard, Jr. (Reg. No. 39,903)
Brian C. Banner (*Pro Hac Vice*)

Slayden Grubert Beard PLLC
401 Congress Avenue, Suite 1650
Austin, Texas 78701

Attorneys for Petitioner