

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SLACK TECHNOLOGIES, LLC. and SALESFORCE, INC.,
Petitioner

v.

WRINKL, INC.,
Patent Owner

Case IPR2024-01489
Patent 11,973,731

**PATENT OWNER'S REPLY
IN SUPPORT OF MOTION TO TERMINATE¹**

¹ This same brief (with a different case caption) is being filed in both IPR2024-01489 and IPR2024-01490.

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I. INTRODUCTION

This *inter partes* review (IPR) must be dismissed because it is based on a petition filed within nine months of the patent's issuance, violating the clear mandate of 35 U.S.C. § 311(c)(1). Congress, in crafting the America Invents Act, sought to balance the rights of patent holders with those of patent challengers by specifying that only PGRs are available during a patent's first nine months of life, and only after this period may IPRs be filed. This statutory timeline is not merely procedural; it is a substantive protection that reflects Congress's considered judgment in weighing competing interests, and it serves the legislative intent to foster innovation and investment in new technologies.

Petitioner does not dispute that its petition was filed outside of the time period permitted by statute, nor does it dispute that it is the petitioner, not the patent owner, who has the burden here. Instead, Petitioner's entire brief is a misguided attempt to shift responsibility for ***Petitioner's error*** onto Patent Owner. But it was not Patent Owner's obligation to save Petitioner from its own mistakes. Such burden shifting has no basis in the statutory framework, federal regulations, or Patent Office guidance, and should be rejected.

Petitioner first argues institution decisions are "final and nonappealable." But this is not an appeal of an institution decision—appeals are heard exclusively by the Federal Circuit—and the Board has the power to terminate IPR proceedings

after institution if based upon a defective petition.

Petitioner next argues the nine-month statutory window is not jurisdictional but relies on a Board decision concerning a different statutory provision with substantially different text. Petitioner also argues the Board has discretion to waive § 311(c)(1)’s time bar, but Petitioner cites no authority for this proposition, and there is none. The Board must follow the statute—it is not discretionary.

Finally, and remarkably, Petitioner urges that Patent Owner should be “sanctioned” for not seeking dismissal of the Petition earlier, ignoring its own negligence in improperly certifying “that the ’731 Patent is available for *inter partes* review.” Paper 1 at 13. The responsibility here lies solely on Petitioner. Moreover, Patent Owner raised the untimeliness issue before the due date for its POR. Accordingly, there is neither waiver nor “sanctionable” conduct.

II. ARGUMENT

A. Section 314(d) Does Not Override the Time Bar of § 311(c)

This proceeding must be terminated because it is based on a petition that was filed in violation of 35 U.S.C. § 311(c)(1), which states that a petition for *inter partes* review “shall be filed after . . . the date that is 9 months after the grant of a patent.” This statute is mandatory, and not discretionary. *See SAS Inst., Inc. v. Iancu*, 584 U.S. 357, 362 (2018) (“The word ‘shall’ generally imposes a nondiscretionary duty.” (citation omitted)).

It does not matter that the Board rendered an institution decision that is “final and nonappealable” under § 314(d), or that Patent Owner did not seek rehearing of that decision within 14 days. Opp. at 2. Patent Owner seeks **termination** of this proceeding, not rehearing or appeal of the institution decision. Regardless, § 314(d) does not give Petitioner the “right to have the proceeding continue, in the face of the otherwise-applicable proscription of [§ 311(c)(1)], just because [Patent Owner] did not raise this ground before the initial institution decision was made or in a rehearing request within 14 days under 37 C.F.R. § 42.71(d).” *GTNX, Inc. v. INTTRA, Inc.*, 789 F.3d 1309, 1312 (Fed. Cir. 2015). Thus, despite an institution decision, the Board may “require[] termination of the proceedings.” *Id.* at 1312.

Nor does it matter that Patent Owner elected not to file a preliminary response to the Petition. A patent owner has no obligation to participate in the proceeding before institution. Preliminary responses are entirely “optional,” so “there is no waiver” if a patent owner raises arguments post-institution that it could have raised in a preliminary response. *Kingston Tech. Co. v. CATR Co.*, No. IPR2015-00559, Paper 60 at 9 (P.T.A.B. 2016), *aff’d in part and rev’d in part on other grounds sub nom. Pavo Sols. LLC v. Kingston Tech. Co.*, 711 F. App’x 1020 (Fed. Cir. 2017). Petitioner cites no authority suggesting a patent owner forfeits an issue by failing to raise it pre-institution, much less that the Board may ignore

statutory requirements after it makes an institution decision. Thus, Patent Owner had the right to wait and see whether institution would be granted.

Petitioner's characterization of Patent Owner's motion as an "effort to reopen" the Board's institution decision is thus incorrect. Considering whether the Petition complies with § 311(c)(1) is not revisiting the institution decision. In fact, the Board did not consider the § 311(c)(1) issue at institution. Rather, for purposes of institution, the Board relied on Petitioner's certification, which misrepresented that "the '731 Patent is available for *inter partes* review." Paper 1 at 13.

B. The Case Law Uniformly Supports Patent Owner

In every case Patent Owner could find where a petitioner made the same error as Petitioner did here, the proceedings were terminated. *Tarsco Bolted Tank Inc. v. Tank Connection, LLC*, No. IPR2016-01273, Paper 3 at 3 (P.T.A.B. 2016); *Special Tactical Servs., LLC v. Hagedorn*, No. IPR2019-00240, Paper 7 at 4 (P.T.A.B. 2018); *Samsung Elecs. Co., Ltd. v. Memoryweb, LLC*, No. IPR2022-00885, Paper 11 at 7 (P.T.A.B. 2022). Petitioner argues that because the untimeliness issue was raised pre-institution in each of those cases, untimeliness must *always* be raised pre-institution. Opp. at 3. But *Tarsco*, *Special Tactical*, and *Samsung* say nothing of the sort. Moreover, the lack of any similar post-institution case is simply due to the rarity of petitioners making the error that Petitioner made here. Petitioner can point to no decision that "confirm[s]" that the untimeliness

issue “must be raised early.” Opp. at 3.

The Board should also reject Petitioner’s attempt to distinguish *Donner*, which granted a post-institution motion to terminate. *Donner Tech., LLC v. Pro Stage Gear, LLC*, IPR2018-00707, Paper 13 (P.T.A.B. July 5, 2018). Petitioner argues that *Donner* is inapt because the issue there (failure to name all RPIs) is a “fact-intensive inquiry often requiring discovery.” Opp. at 3. The *Donner* panel made no such distinction. Moreover, the *Donner* panel in fact ***denied*** the request for discovery, and thus the alleged need for discovery was not a basis for the decision. The Board did not mention discovery at all when it held that “Patent Owner was not required to put forth all (***or any***) of its arguments” in its preliminary response. *Id.* at 3 (emphasis added). *Donner* is therefore on point.

C. Section 311 Is Jurisdictional

“[A]ny time period required by statute” for filing an IPR petition limits the Board’s “[j]urisdiction.” 37 C.F.R. § 42.3(b). Indeed, Patent Owner’s opening brief cited binding Federal Circuit case law, as well as a Board decision, holding that statutory limitations on the time for filing a petition are jurisdictional. Paper 11 at 2-3. Petitioner does not even attempt to address three of those four cases (*Click-To-Call*, *Ruiz*, and *Monzo*). As for *Wi-Fi One*, although the Supreme Court abrogated its holding that courts can review Board decisions regarding compliance with § 315(b), the Court did not disturb *Wi-Fi One*’s holding that § 315(b)’s time

bar limits the PTO's "statutory authority" (i.e., its jurisdiction). *Wi-Fi One, LLC v. Broadcom Corp.*, 878 F.3d 1364, 1374 (Fed. Cir. 2018) (*en banc*).

Petitioner tries to analogize § 311(c)(1) to § 312(a), which the Board held is not jurisdictional in *Lumentum v. Capella*, IPR2015-00739, 2016 WL 2736005, at *3 (P.T.A.B. Mar. 4, 2016). Section 312(a), however, is fundamentally different because it does not impose temporal limitations on IPR petitions and thus does not preclude post hoc rectification of any noncompliance. *Id.* *Lumentum* is inapposite.

Moreover, even if § 311 did not deprive the Board of jurisdiction, the statute was nonetheless violated. Petitioner identifies no "exceptions" to the nine-month rule and does not argue that its conduct would somehow implicate doctrines such as "equitable tolling." See *Irwin v. Dep't of Veterans Affs.*, 498 U.S. 89, 96 (1990) (refusing to toll a filing deadline because equitable tolling principles "do not extend to what is at best a garden variety claim of excusable neglect").

D. The Board Lacks "Discretion" To Ignore Statutory Mandates

Petitioner's argument that the Board has discretion to simply ignore the statutory requirement of § 311(c)(1) is meritless. Petitioner cites 37 C.F.R. § 42.5(c)(3), but that regulation concerns noncompliance with deadlines *set by the Patent Office*. The time bar of § 311(c)(1), by contrast, is a deadline set by Congress, and "Congressional mandates, unlike regulations, 'must be observed and are beyond the dispensing power of [agency] officials.'" *Brown v. United States*,

22 F.4th 1008, 1012 (Fed. Cir. 2022) (quoting *Angelus Milling Co. v. Commissioner*, 325 U.S. 293, 296–97 (1945)). This rule applies equally to the PTO. *Kimberly-Clark Corp. v. Procter & Gamble Distrib. Co.*, 973 F.2d 911, 917 (Fed. Cir. 1992). The Board cannot “excuse” Petitioner’s violation of § 311.

E. Patent Owner Raised the Issue Before the POR Deadline and Nothing More Was Required—Patent Owner Is Not To Blame For Petitioner’s Actions

Petitioner asks this Board to weigh the “equities,” yet Petitioner fails to offer any excuse or justification for having mischaracterized the ’731 patent as “available for *inter partes* review.” Paper 1 at 13. Whereas Petitioner clearly violated a statute without explanation, Patent Owner’s conduct has been in keeping with the statutes and rules governing *inter partes* review. Under the IPR process, a patent owner need not participate until an institution decision is made and may raise defenses for the first time post-institution. *Donner*, IPR2018-00707, Paper 13 at 3-4. Thus, Patent Owner was not “dilatory” and did not make “improper use of the proceeding” or otherwise “harass” Petitioner. Opp. at 6.

III. CONCLUSION

An IPR petition is only valid if filed more than nine months after patent issuance, and proceedings based on premature petitions must be terminated. The Board lacks any authority to waive, forgive, amend filing dates, or fashion any other “remedy” to save Petitioner from its own failure to abide by the statute.

Respectfully submitted,

Dated June 20, 2025

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §42.6(e), the undersigned certifies that on June 20, 2025, a complete and entire copy of this Patent Owner's Reply in Support of Motion to Terminate was provided by email to Petitioner by serving the correspondence email address of record as follows:

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