

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

WRINKL, INC.,
Patent Owner

Case No.: IPR2024-01490
U.S. Patent No. 11,973,731

**PETITIONERS' REASONS FOR PARALLEL PETITIONS
AND PETITION RANKING**

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Patent Trial and Appeal Board
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Petitioners Slack Technologies, LLC and Salesforce, Inc. (collectively “Petitioners”) respectfully request *inter partes* review (“IPR”) of Claims 1-30 of U.S. Patent No. 11,973,731 (the “’731 Patent”). Petitioners are filing parallel petitions separately challenging Claims 1-30 of the ’731 Patent. The first petition challenges the alleged priority date of the ’731 Patent (IPR2024-01489) (“First Petition”) and the second petition assumes that the Patent Owner’s claimed priority date is valid, and addresses prior art references predating that priority date (IPR2024-01490) (“Second Petition”).

The Board should institute both petitions. The Board has recognized that multiple petitions may be necessary in certain circumstances, such as when a Patent Owner asserts a large number of claims in litigation or when there is a dispute regarding the priority date, requiring arguments under multiple prior art references. Patent Trial and Appeal Board Consolidated Trial Practice Guide (“CTPG”), 59 (November 2019). Both of these conditions are present here.

First, Petitioners are challenging 30 claims, with the claim language alone comprising approximately 3,000 words. Due to the number and length of the claims, and the complexity of the claims themselves, they cannot be adequately addressed in a single petition without exceeding the 14,000-word limit. Second, there is a dispute over the priority date, which the Patent Owner asserts as November 10, 2015, while Petitioners believe it is no earlier than June 21, 2018.

Additionally, the petitions are not duplicative; they efficiently address the validity of the '731 Patent. One petition challenges the priority date and introduces an intervening prior art reference within the alleged priority chain, while the other petition relies on prior art predating the Patent Owner's alleged priority date. As a result, the arguments in each petition rely on different prior art references, supporting the need for both.

I. REASONS WARRANTING ADDITIONAL PETITIONS

A. The Number and Specificity of the Claims Require Multiple Petitions to Sufficiently Address the Claims.

The '731 Patent has been asserted against Petitioners in co-pending litigation, *Wrinkl, Inc. v. Slack Technologies, LLC, et al.*, No. 1:24-cv-00620 (D. Del.) (“Delaware Action”), filed on May 23, 2024.¹ As discussed in the petitions, no rulings related to the '731 Patent have been issued. Trial is currently set to begin on May 18, 2026.² Given that the complaint alleges infringement of “at least” independent claims 1, 15, and 25, Petitioner has filed for IPR of all claims of the '731 Patent.

A single petition addressing only independent Claims 1, 15, and 25 (and the claims that depend therefrom) would not be sufficient. The Delaware Action is relatively early in its proceedings, and Patent Owner has not yet identified even a

¹ First Petition, Exh-1007; Second Petition, Exh-1009.

² First Petition, Exh-1008; Second Petition, Exh-1010.

preliminary list of asserted claims or committed that it will not assert any of Claims 2–14, 16–24, and 26–30 later in the Delaware Action.

Therefore, the complexity and sheer number of claims, combined with the Patent Owner’s vague infringement allegations and the disputed priority date, justify the need for multiple distinct grounds in the petitions.

B. The Petitions are Materially Different from Each Other and Efficiently Address the Validity of the ’731 Patent.

The petitions are materially different. The First Petition focuses on challenging the Patent Owner’s alleged priority date, arguing that the Patent Owner fails to meet the written description requirement and contesting Claims 1–30 of the ’731 Patent based on an intervening ancestral application’s publication. The Second Petition addresses Claims 1–30 using different prior art references that predate the alleged priority date.

Instituting both petitions would be efficient, as the First Petition’s resolution of the priority date issue could significantly impact the outcome of the Second Petition. If the priority date is invalidated, the intervening prior art application’s publication would likely anticipate the ’731 Patent as an ancestor, reducing the burden of reviewing the Second Petition. Additionally, the grounds for all claims between both petitions rely on four distinct, non-overlapping references: (1) Cohen, (2) Kakuta, (3) Matsumoto, and (4) Chang.

C. The Petitions Do Not Constitute an Abuse of Process.

Aside from the two petitions discussed here, no other petitions have been filed by any party challenging the claims of the '731 Patent. As mentioned above, addressing the numerous and lengthy claims in light of prior art necessitates thorough analysis. Instituting review on both petitions will enable efficient consideration of the priority date dispute and prior art predating the alleged priority date, ensuring that all potential claims that may be asserted against Petitioners in the Delaware Action are fully addressed.

II. ORDERING OF THE PETITIONS

Petitioners request that the Board consider the petitions in the following order and refrain from exercising its discretion to deny either. Prioritizing the First Petition will resolve the crucial priority date issue, which is essential for determining the relevant prior art.

Rank	Petition	Prior Art Ground	Claims
1	First Petition - IPR2024-01489	Cohen (Anticipation)	1-30
2	Second Petition - IPR2024-01490	Kakuta (Anticipation)	1-7, 9-12, 15-19, 21-22, 25-27, and 30
		Kakuta (Obviousness)	1-7, 9-19, and 21-30
		Kakuta in view of Matsumoto	1-7, 9-19, and 21-29
		Kakuta in view of Matsumoto and Chang	1-29
		Kakuta in view of Chang	30

Date: September 26, 2024

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