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 IPR2024-01490
Patent 11,973,731

PATENT OWNER'S MOTION TO TERMINATE

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I. INTRODUCTION

Per the Board's authorization conveyed during yesterday's teleconference, Patent Owner respectfully submits this motion to dismiss the Petition and terminate this *inter partes* review proceeding because the Petition was premature under 35 U.S.C. § 311(c)(1), which precludes petitions filed less than nine months after the challenged patent issues. This motion is timely. *See Donner Tech., LLC v. Pro Stage Gear, LLC*, No. IPR2018-00707, Paper 13 at 3–4 (P.T.A.B. 2018).

II. LEGAL STANDARD

By statute, a petition for *inter partes* review of a patent that is subject to the America Invents Act (AIA) "shall be filed after . . . the date that is 9 months after the grant of a patent." 35 U.S.C. § 311(c)(1); *see also* 37 C.F.R. § 42.102; *Tarsco Bolted Tank Inc. v. Tank Connection, LLC*, No. IPR2016-01273, Paper 3 at 1–2 (P.T.A.B. 2016); *Samsung Elecs. Co., Ltd. v. Memoryweb, LLC*, No. IPR2022-00885, Paper 11 at 6 (P.T.A.B. 2022). A patent is subject to the AIA if it has an effective filing date after March 16, 2013. *See* Leahy-Smith America Invents Act, §3(n), Pub. L. No. 112–29, 125 Stat. 284, 293 (Sept. 16, 2011).

An IPR proceeding based on a petition filed within the nine-month waiting period must be terminated. *Tarsco*, No. IPR2016-01273, Paper 3 at 3; *Special Tactical Servs., LLC v. Hagedorn*, No. IPR2019-00240, Paper 7 at 4 (P.T.A.B. 2018); *Samsung*, No. IPR2022-00885, Paper 11 at 7.

The Board has the authority and the obligation to terminate an IPR proceeding even after institution if the petition was untimely. *See Ruiz Food Prods., Inc. v. MacroPoint LLC*, No. IPR2017-02016, Paper 25 at 13–14 (P.T.A.B. 2019); *GTNX, Inc. v. INTTRA, Inc.*, No. CBM2014-00072, Paper 20 at 3–4 (P.T.A.B. 2014).

Indeed, the Board lacks jurisdiction to consider an IPR petition that was filed outside the statutory time period. *See Wi-Fi One, LLC v. Broadcom Corp.*, 878 F.3d 1364, 1374 (Fed. Cir. 2018) (en banc) ("The timely filing of a petition . . . is a condition precedent to the Director's authority to act" and "sets limits on the Director's statutory authority to institute[.]"), *abrogated on other grounds by Thryv, Inc v. Click-To-Call Techs., LP*, 590 U.S. 45 (2020); *Click-To-Call Techs., LP v. Ingenio, Inc., YellowPages.com, LLC*, 899 F.3d 1321, 1325 (Fed. Cir. 2018) ("Because the subject petition was time-barred [under 35 U.S.C. § 315(b)], the Board lacked jurisdiction to institute the IPR proceedings."), *vacated on other grounds and remanded sub nom. Thryv, Inc v. Click-To-Call Techs., LP*, 590 U.S. 45 (2020), and *vacated on other grounds sub nom. Click-To-Call Techs., LP v. Ingenio, Inc.*, 810 F. App'x 881 (Fed. Cir. 2020); *Ruiz*, No. IPR2017-02016, Paper 25 at 13–14 ("[T]he time bar of § 315(a)(1) is a jurisdictional issue." (citations omitted)); *see also Monzo v. Dep't of Transp., F.A.A.*, 735 F.2d 1335, 1336 (Fed.

Cir. 1984) (holding statutory limitation on time for filing "petition for review" of agency decision is "jurisdictional").

The "Patent and Trademark Office cannot waive statutory requirements." *Kimberly-Clark Corp. v. Procter & Gamble Distrib. Co.*, 973 F.2d 911, 917 (Fed. Cir. 1992) (citation omitted). Section 311(c)(1) prescribes a nine-month waiting period, and "the Office's authority is limited to implementing that legislative directive." *Id.* As the Supreme Court explained, agencies "cannot waive 'explicit statutory requirements'" because "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)).

III. ARGUMENT

There is no dispute that the '731 patent is subject to the AIA and, thus, to the nine-month waiting period of § 311(c)(1). The earliest application to which the '731 patent claims priority was filed on November 10, 2015. Ex. 1001. Because the '731 patent does not claim priority to any applications filed before March 16, 2013, it has an effective filing date after March 16, 2013, and is thus subject to the AIA. 35 U.S.C. §100(i); AIA § 3(n); 37 C.F.R. § 42.102; *Tarsco*, No. IPR2016-01273, Paper 3 at 1–2; *Samsung*, No. IPR2022-00885, Paper 11 at 6.

There is also no dispute that the Petition was premature under § 311(c)(1).

The challenged '731 patent issued on April 30, 2024. Petitioner filed its Petition only five months later, on September 26, 2024. The Petition therefore does not comply with § 311(c)(1), and the IPR must be terminated. *Tarsco*, No. IPR2016-01273, Paper 3 at 3; *Special Tactical Servs.*, No. IPR2019-00240, Paper 7 at 4; *Samsung*, No. IPR2022-00885, Paper 11 at 7.

Although Patent Owner "could have included arguments about [the timeliness of the Petition] in [a] Preliminary Response, Patent Owner was not required to put forth all (or any) of its arguments at that time." *Donner*, No. IPR2018-00707, Paper 13 at 3–4 (citing 37 C.F.R. § 42.107(a)).

IV. CONCLUSION

For these reasons, the Board should terminate this proceeding.

Respectfully submitted,

Dated June 6, 2025

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§42.6(e), the undersigned certifies that on June 6, 2025, a complete and entire copy of this Patent Owner's Motion to Terminate was provided by email to Petitioner by serving the correspondence email address of record as follows:

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