

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

KAHOOT! AS
Petitioner

v.

INTERSTELLAR INC.
Patent Owner

Case No. IPR2025-00696
U.S. Patent No. 10,339,825

PATENT OWNER'S DISCRETIONARY DENIAL BRIEF

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EXHIBIT LIST

Exhibit	Description
2002	Boost collaboration with team mode in Kahoot!, April 14, 2016, https://kahoot.com/blog/2016/04/14/boost-collaboration-team-mode-kahoot/
2003	10 Kahoot! innovations that made learning awesome, March 15, 2023, https://kahoot.com/blog/2023/03/15/kahoot-innovations-10-year-anniversary/
2004	Introducing Kahoot! themes: a customized experience to reflect your brand identity, Feb. 25, 2022, https://kahoot.com/blog/2022/02/25/introducing-kahoot-themes-customized-experience-2/

I. INTRODUCTION

Patent owner Interstellar Inc. (“Interstellar” or “Patent Owner”) respectfully requests that the Director exercise her discretion under 35 U.S.C. § 314(a) and deny institution of Kahoot! AS’s (“Kahoot!” or “Petitioner”) Petition for Inter Partes Review of U.S. Patent No. 10,339,825 (the “’825 Patent”).

II. LEGAL STANDARD

The Director has discretion whether to institute *inter partes* review. *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 273 (2016). Pursuant to the Memorandum issued by the Director on March 26, 2025, entitled “Interim Processes for PTAB Workload Management” (“Director’s Memorandum”), the Board’s decision on whether to institute an IPR is bifurcated so that the Director will first resolve issues of discretionary denial based on separate briefing, and only if the Director determines that discretionary denial is not appropriate will the Patent Owner’s Preliminary Response (“POPR”) be considered by a merits panel to determine whether to institute a trial based on the merits. (Director’s Memorandum, 1-2).

The Director’s Memorandum lists several considerations relevant to the decision whether to institute an IPR. Most relevant here, these include: (1) “the strength of the unpatentability challenge,” (2) “the extent of the petition’s reliance on expert testimony,” and (3) “settled expectations of the parties, such as the length of the time the claims have been in force.” (Director’s Memorandum, 2). As

will be demonstrated below, all three of these factors and the *Fintiv* factors weigh in favor of denying institution.

III. OVERVIEW OF THE '825 PATENT

The '825 Patent describes a web-based system and method that “facilitates live academic competition between teams and individuals on multiple choice or fill-in-the-blank questions and methods for fostering academic competition.” (Ex. 1001, 1:6-10). The system fosters collaborative teamwork and collective purpose, expanding access to academic-styled competition to users of various backgrounds including students, work group members, and so forth.

The patented system enables a manager user (e.g., coaches, teachers, managers, etc.) to activate an account, input profile information, form teams including the activation of accounts for individual competitor users, and then arrange competition activity for a team by dividing it into competing teams, by challenging another team, or by enrolling the team in a competition event created by an administrator user. (*Id.*, 15:53-17:20).

The system encourages contestants by creating a competitive environment similar to sporting events. (*Id.*, 1:59-60). During an academic competition, the participants are presented with one or more predetermined test questions at participant processing devices for response in a time frame allocated for the academic competition. (*Id.*, 2:39-42). A real-time scoreboard at the respective

participant processing devices (FIGS. 108-114) enables participants in the academic contests to track their progress with respect to both the allocated time frame for the contest and questions answered correctly. (*Id.*, FIGS. 108-114; 2:43-46). The scoreboard calculates and displays individual score and/or a team score. (*Id.*, 2:53-58). Combined, these features provide a competitive atmosphere akin to any team sport which measures and presents accuracy with respect to a targeted skill by utilizing a scoring system within a timed environment (e.g., basketball, football, etc.).

In the Reasons for Allowance, the Examiner expressed that the features of “enabling a user ...[to] ... search for and select at least one team for participation in an inter-team academic competition...[or] ... divide a team into multiple teams for an intra-team academic competition; and enabling teams of individual contestants to compete over a series of test questions for an allotted time period in an online format including both a test item presentation area and the real time scoreboard with time clock, at least one of (1) live, if the teams have common time availability, wherein the real time scoreboard displays at least one of the following in real time: individual contestant’s score, teams’ scores, and the individual contestant’s score and teams’ scores and (2) non-live, if the teams do not have common time availability, wherein the real time scoreboard displays at least one of the following in real time: individual contestant’s score, team score of the

individual contestant's team, and the individual contestant's score and team score of the individual contestant's team" were not anticipated or made obvious by the prior art. (Ex. 1004, pp. 25-27). Such features also are not made obvious by the prior art cited by Petitioner.

IV. THE MERITS OF THE PETITION ARE WEAK

The Petition and the references it relies upon are weak on the merits, one of the factors relevant to discretionary dismissal. Petitioner alleges that the '825 Patent's claims would have been obvious under 35 U.S.C. § 103. Obviousness is determined based on the scope and content of the prior art, any differences between the claims at issue and the prior art, and the level of ordinary skill in the art. *See Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). IPR petitions "must address the Graham factors." *Eizo Corp. v. Barco N.V.*, IPR2014-00358, Paper 11 at 29-30 (PTAB July 23, 2014) (citing *Graham*, 383 U.S. at 17-18) (faulting Petitioner for its failure to identify differences between the claimed subject matter and the prior art and its conclusory assertions about the teachings of the prior art).

Petitioner fails to address the *Graham* factors. In its analysis, Petitioner does not adequately consider the scope and content of the prior art. Instead, it selectively extracts seemingly supportive disclosures out of context in a manner calculated to obscure the fundamental distinctions between the prior art and claimed subject matter. In addition, Petitioner's expert declaration merely repeats positions from

the Petition, omitting both explanation of the state of the art at the time of the invention and demonstration as to how and why one skilled in the art would have combined the references to arrive at the claimed subject matter.

Indeed, Petitioner and its expert's arguments frequently amount to mere hindsight reconstruction of the '825 Patent claims rather than reasoned, step by step construction built upon the prior art. Utilizing a challenged claim as a roadmap to piece together disparate disclosures in hindsight fashion is improper. *See InTouch Techs., Inc. v. VGo Comm'ns., Inc.*, 751 F.3d 1327, 1351 (Fed. Cir. 2014) (reversing obviousness finding where "[i]t appears that [the expert] relied on the [] patent itself as her roadmap for putting what she referred to as pieces of a 'jigsaw puzzle' together."); *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007) ("A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning."). For these reasons, more thoroughly described in the examples below, Petitioner fails to establish a reasonable likelihood of obviousness with respect to the claimed subject matter.

For brevity, the discussion of the merits in this discretionary denial brief is limited to two elements present in both independent claims that are not taught or

suggested by the prior art.¹ A claim cannot be obvious if even one element of the claim is missing from the prior art. *See CFMT, Inc. v. YieldUp Int’l Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (“Obviousness requires a suggestion of all limitations in a claim.”) (citing *In re Royka*, 490 F.2d 981, 985 (C.C.P.A. 1974)). Independent claims 1 and 14 are reproduced below, with the elements to be addressed that are missing from the prior art highlighted in bold/italics.

Claim 1	Claim 14
1. A system for on-line academic competition, comprising: a database that stores test questions, team and individual contestant profiles, and test response statistics for the team and individual contestants; and a processor programmed to interact with the database and with individual contestant processing devices to perform the steps of: enabling the creation of teams of individual contestants for participation in an academic competition; <i>enabling a user, through a user interface connected to said database, to perform at least one of the following: (1) create a league of teams and a cycle of academic competition amongst the league of teams, (2)</i>	14. A method for on-line academic competition, comprising: enabling, using a processing device, the creation of teams of individual contestants for participation in an academic competition; <i>enabling a user, through a user interface, to perform at least one of the following: (1) create a league of teams and a cycle of academic competition amongst the league of teams, (2) search for and select at least one team for participation in an inter-team academic competition, and (3) divide a team into multiple teams for an intra-team academic competition;</i> <i>presenting, using a processing device, a series of test questions to the contestant processing devices of the</i>

¹ Patent Owner will provide a more complete analysis of the merits, including other missing limitations, in the upcoming POPR. However, even the limited merits analysis presented herein shows that institution should be denied.

Claim 1	Claim 14
<i>search for and select at least one team for participation in an inter-team academic competition, and (3) divide a team into multiple teams for an intra-team academic competition;</i> <i>presenting a series of test questions to the contestant processing devices of the individual contestants of competing teams for response in a time frame allocated for the academic competition;</i> providing a real time scoreboard with time clock to each contestant processing device that displays an individual contestant's progress with respect to both the time frame for answering questions and questions answered correctly while answering the series of questions during an academic competition, where each correctly answered question contributes on the real time scoreboard to at least one of (1) an individual score of the individual contestant and (2) a team score of the individual contestant's team; and enabling teams of individual contestants to compete over a series of test questions for an allotted time period in an online format including both a test item presentation area and the real time scoreboard with time clock, at least one of (1) live, if the teams have common time availability, wherein the real time scoreboard displays in real time at least one of (a) the individual score of the individual	<i>individual contestants of competing teams for response in a time frame allocated for the academic competition;</i> providing a real time scoreboard with time clock at each contestant processing device that displays an individual contestant's progress with respect to both the time frame for answering questions and questions answered correctly while answering the series of questions during an academic competition, where each correctly answered question contributes on the real time scoreboard to at least one of (1) an individual score of the individual contestant and (2) a team score of the individual contestant's team; and enabling teams of individual contestants to compete over a series of test questions for an allotted time period in an online format including both a test item presentation area and the real time scoreboard with time clock, at least one of (1) live, if the teams have common time availability, wherein the real time scoreboard displays in real time at least one of (a) the individual score of the individual contestant and (b) the team scores of the competing teams, and (2) non-live, if the teams do not have common time availability, wherein the real time scoreboard displays in real time at least one of (a) the individual score of the individual contestant and (b) the team

Claim 1	Claim 14
contestant and (b) the team scores of the competing teams, and (2) non-live, if the teams do not have common time availability, wherein the real time scoreboard displays in real time at least one of (a) the individual score of the individual contestant and (b) the team score of the individual contestant's team.	score of the individual contestant's team.

A. Overview of the Prior Art

An overview of the prior art focusing on disclosures related to team participation in question-and-answer experiences provides the foundation for demonstrating that the references fail to teach or suggest at least the claim limitations highlighted above.

1. Feeney

Feeney² describes systems, methods and techniques for conducting a question-and-answer contest which is played by multiple players across a communications network where the players compete to earn points (called “Dallions”) awarded by a central contest administrator. (Ex. 1005, Abstract). The individual players are ranked based on their total number of points. (*Id.*). In addition, individual players are allowed to select a sponsor from a set of previously identified sponsors and to earn points from the sponsors they select. (*Id.*). For this

² Ex. 1005, U.S. Patent No. 8,231,470 to Feeney et al.

purpose, individual sponsors are allocated points by the contest administrator and have flexibility regarding how to award their allocated points to the players that have selected them. (*Id.*). Sponsors are typically corporate, commercial, or charitable entities which desire to build brand loyalty with existing or potential customers. (*Id.*, 7:31-36, 12:31-41).

Generally, the contests described in Feeney are “conducted over a significant period of time (e.g., at least 2-3 days, a week, 2-3 weeks, a month or even longer).” (*Id.*, 3:23-27). In preferred embodiments, the approach entails “multiple individual contests, each typically involving questions to be answered or other problems to be solved and often played over an extended period of time, such as anywhere from several days to a month, or even longer.” (*Id.*, 20:2-8). Feeney describes delivering a few problems per day to players participating in various contests. (*Id.*, 20:9-28). “While the various players are participating in different contests, the same kinds of points (typically called ‘Dallions’ herein) preferably are earned across all contests and, in some cases, are capable of being earned independent of any contest.” (*Id.*, 20:29-37). These Dallion points can be earned by answering questions correctly, performing tasks assigned by a sponsor such as reading their materials, watching their videos, or evaluating their products. (*Id.*, 8:4-9). Dallions can also be subtracted from an individual’s total if they redeem them for a sponsor’s products or services. (*Id.*, 8:9-13, 20:33-35).

Although Feeney primarily focuses on individuals interacting with contests and sponsors, it provides an option for players to associate into teams called “rings.” These can be formed in several ways, but are always organized by the players themselves, not by an administrator. In one embodiment, a player starts a ring and selects or entices players to join the ring. (*Id.*, 21:63-67). Players can also message each other to request to join another’s ring. (*Id.*, 18:16-19). These rings are loosely described as being able to compete against each other, with ring scores appearing in rankings, but the specification omits further, detailed discussion as to how such activity is organized, initiated, or completed in the system. (*Id.*, 21:56-59, 12:66-13:3). Indeed, Feeney focuses on individual-based, not team-based, activity.

To conclude, in the Feeney system the contests are intended to create an opportunity for businesses/sponsors to communicate and interact with purchasers, which is the primary purpose of the invention more generally. (*Id.*, 12:31-41; 1:37-52; 7:31-8:17). This mercantilist orientation stands in stark contrast to the educational purpose of the ’825 Patent claimed subject matter. Such divergence of purpose between Feeney and the ’825 Patent highlights the inadequacy of Petitioner’s selection of Feeney as its foundation for an obviousness argument, as shown by further analysis below.

2. Rogers

Rogers³ describes an online test platform for the development, delivery, and management of educational tests with interactive participation by students, teachers, proctors and administrators, even when some or all of them are remotely located. (Ex. 1006, Abstract). As described with respect to FIG. 8, the test screens of the online test platform may include the number of questions to answer, the number of minutes allowed, and progress indicators for time used and questions completed. (*Id.*, 19:16-20, FIG. 8). The described platform permits test proctors to monitor the test sessions, provide assistance to test takers, and pause or add time to a test, among other functions. (*Id.*, 2:21-26, 2:50-4:7, 26:19-27:8).

Rogers provides illustrative test screens, including FIG. 9. The test interface includes buttons to “GO-ON” and “GO-BACK” which allow a test taker to skip questions and return to unanswered questions later during the testing session. (*Id.*, 19:28-37, 19:55-20:15). As with traditional paper tests, the test taker’s screens in Rogers do not have an indicator for the number of questions answered correctly (only for the number of questions attempted). Also, Rogers only addresses test takers taking the test individually, with no mention of team formation or competition between teams.

³ Ex. 1006, U.S. Patent No. 10,861,343 to Rogers et al.

3. Maurseth

Maurseth⁴ describes “a method for teaching and developing the culture, values, and skills of an organization” using a Monopoly-styled gameboard. (Ex. 1007, Abstract). An organization is divided into associated small teams through a succession of divisions. (*Id.*). Teams work together to complete the board game using tokens that advance based on randomly generated numbers such as by rolling a die. (*Id.*, FIG. 3, [0038]). As each small team completes the educational board game, which might involve answering questions around industry knowledge and company history or similar topics, members of the small team assist other teams in completing the educational game. (*Id.*, Abstract, [0007], [0027]). Maurseth includes no disclosure or suggestion relating to online competition, databases, player profiles, or real-time scoreboards.

B. The Petition Does Not Show That Claims 1 and 14 Are Unpatentable Under Ground 1 (Feeney and Rogers)

Ground 1, Feeney in combination with Rogers,⁵ does not establish a reasonable likelihood that Petitioner will prevail with respect to at least one challenged claim as required for institution. Petitioner fails to demonstrate that independent claims 1 or 14 (and therefore, any of the dependent claims) would

⁴ Ex. 1007, US Patent Pub. No. 2004/0004325 to Maurseth.

⁵ Petitioner relies on Rogers for a claim limitation that is not addressed in this brief but will be addressed in the POPR. Discussion of Rogers herein is not necessary to defeat Petitioner’s Ground 1 argument.

have been obvious because the prior art does not ultimately teach or suggest several claim limitations.

1. Feeney Does Not Disclose “Enabling a user...to...search for and select at least one team for participation in an inter-team academic competition”

Petitioner alleges that Feeney discloses the following limitation in claims 1 and 14:

enabling a user, through a user interface connected to said database, to perform at least one of the following: (1) create a league of teams and a cycle of academic competition amongst the league of teams, (2) search for and select at least one team for participation in an inter-team academic competition, and (3) divide a team into multiple teams for an intra-team academic competition;

Petitioner specifically focuses on (2) from the claim: “enabling a user, through a user interface connected to said database, to ... search for and select at least one team for participation in an inter-team academic competition.” (Petition, 23-27).⁶

Petitioner relies on a mischaracterization of Feeney to support its argument, incorrectly conflating Feeney’s disclosure of “[t]he act of requesting to join a team” with “select[ing] at least one team for participation in an inter-team academic competition.” (Petition, 26; Ex. 1002, ¶64).

⁶ Feeney clearly does not teach, and Petitioner does not allege that Feeney teaches, creating a league of teams and a cycle of academic competition amongst the league of teams (sublimitation (1)) or dividing a team into multiple teams for an intra-team academic competition (sublimitation (3)), which are claimed in the alternative.

The '825 Patent claims and describes searching for and selecting a team for participation in an inter-team academic competition. That is, the user (such as a teacher or coach) is looking for a team(s) to match against his/her team in a competition between the teams. The specification explains, "The processor also enables one team to search for and then challenge another team of common time availability to an academic competition and enables a team to be divided into multiple teams for an intra-team academic competition." (Ex. 1001, 3:15-20, FIG. 83, 33:52-58, 32:10-14). "The educator can arrange competition events for that team by dividing it into two or more opposing teams (here students can work independently or in small groups), or by challenging another team in the Interstellar Network on a specific date." (*Id.*, 1:43-47; *See also* 3:35-41; 16:33-41). The '825 Patent claims address the creation of a competition between teams where the user searches for and selects an entire team as a participant.

In contrast with the claimed subject matter, Feeney does not describe searching for and selecting a team for participation in an inter-team academic competition. Not one of the three types of users (Contest Administrator, Sponsor, Player) is described as having an ability to search for and select an opponent team for matched play. Facing this gap in Feeney's disclosure, Petitioner states that a player can click the "Advanced tab 425" to "perform a search for a ring or team." (Petition, 25). But Petitioner truncates the quote from Feeney to fit the '825 Patent

claim language. The full statement in Feeney is that a player can click the Advanced tab 425 to narrow the search “across any combination of a variety of different parameters,” including “ring or team *membership*.” (Ex. 1005, 18:37-46 (emphasis added)). That is, the search made possible in Feeney is one where a player searches for another player and can narrow that search to that player’s membership in a specific ring. Searching for a player to join one’s team or to join their team in Feeney is a decidedly different action than searching for a team and inviting it to participate in an inter-team competition in the ’825 Patent claims.

Petitioner’s reliance on an individual player searching for other individual players based on team membership demonstrates a fatal error in its Ground 1 analysis. This limitation is present in independent claims 1 and 14. As a result, the Petition fails on Ground 1 because this limitation is not disclosed or taught by the prior art, and the challenge of all dependent claims fails as well.

2. Feeney Does Not Disclose “Presenting a series of test questions to the contestant processing devices of the individual contestants of competing teams...”

Petitioner alleges (Petition, 27-31) that Feeney discloses the following limitation in claims 1 and 14:

presenting a series of test questions to the contestant processing devices of the individual contestants of competing teams for response in a time frame allocated for the academic competition;

In the head-to-head team competition format claimed in the '825 Patent, all contestants are presented with the same series of questions during a single contest. The series of test questions is referenced several times in the claim (displaying a contestant's or team's progress as they answer the series of questions, and enabling teams to compete over the same series of test questions live or non-live if the teams do not have common time availability) (Ex. 1001, Claims 1, 14), highlighting that the competition tests teams on the same set of questions.

The '825 Patent specification confirms that contestants receive the same series of questions, explaining an embodiment of the invention as “presenting predetermined test questions to the processing devices of the individual contestants of competing teams...” (*Id.*, 2:39-40). The advantage of having the same series of questions is two-fold: objectivity and predictability. First, it is a fair manner to compare scores between teams for the purpose of deciding a winner and a loser since the content is the same for all players. In the real world, teachers and business managers highly value such objectivity when evaluating their teams. Second, a pre-selected series of questions allows the match-creating user to test the exact topics desired.

In Feeney, players do not compete over the same set of pre-selected questions as claimed in the '825 Patent and described in the specification. Petitioner cites Feeney regarding “a stream of problems” provided by a server

(Petition, 27 citing Ex. 1005, 20:18-25), but ignores how these problems are actually delivered for test purposes.⁷ The “stream of problems” in Feeney has an altogether different meaning than the “series of test questions” in the ’825 Patent claims. Feeney teaches that the “stream of problems” is a central repository or question bank from which various problems are selected and delivered to players, explaining: “problems are selected (e.g., randomly or based on expressed preferences as to time of day) from the stream and made available to the players (e.g., 1-3 problems per day).” (Ex. 1005, 20:22-25). The same “problem stream” is used across multiple different contests, and players participate in one or more contests that they select from time to time. (*Id.*, 20:38-45). The “problem stream” in Feeney is used “across multiple different contests” which “provides both efficiency for the contest administrators and personalized selection by the various players.” (*Id.*).

Feeney further highlights that not all players in a contest receive the same problems, explaining that problems delivered may be based on a player’s geographic location, their web browsing history, previous text messages, and/or product ordering history. (*Id.*, 20:53-21:11). Players may choose to decline

⁷ Petitioner’s citation to the “stream of problems” in Feeney is another example of taking a cited passage in Feeney out of context. A POSA would not have ignored the surrounding context of Feeney that undermines Petitioner’s conclusion.

problems based on difficulty or to customize the level of difficulty of problems delivered to them. (*Id.*, 23:3-12).

The use of the “stream of problems” and delivery of problems highlights the varying purposes of the ’825 Patent and Feeney. The ’825 Patent’s claims are directed to head-to-head academic competitions between teams. The Feeney system is not designed to create such objective, predictable team competitions. Instead, the system is designed to engage individuals using questions in a way to stimulate, maintain, and expand purchasing relationships between consumers and sellers (i.e., sponsors). These vastly different goals result in different claims and disclosures, and explain why one system (the ’825 Patent) features the same set of questions to test opposing teams while the other (Feeney) does not. They also underscore why a person of ordinary skill in the art (“POSA”) would not have looked to Feeney for guidance in developing the ’825 Patent’s invention in the first place.

In sum, Feeney does not teach or suggest presenting a series of the same questions to contestants of competing teams. This limitation is present in independent claims 1 and 14. As a result, the Petition fails on Ground 1 for the additional reason that this limitation is not disclosed or taught by the prior art, and the challenge of all dependent claims fails as well.

C. The Petition Does Not Show That Claims 1 and 14 Are Unpatentable Under Ground 4 (Feeney, Rogers, Panetta, and Maurseth)

Ground 4, Feeney in combination with Rogers, Panetta, and Maurseth,⁸ does not establish a reasonable likelihood that Petitioner will prevail with respect to at least one challenged claim as required for institution. Petitioner fails to demonstrate that independent claims 1 or 14 (and therefore, any of the dependent claims) would have been obvious because the prior art does not ultimately teach or suggest several claim limitations.

Petitioner incorporates its analysis under Ground 1 in Ground 4 and provides no further explanation relating to “presenting a series of test questions to the contestant processing devices of the individual contestants of competing teams for response in a time frame allocated for the academic competition.” Patent Owner incorporates its response to the Petition relating to this element. (Sec. IV.B.2). Thus, Ground 4 fails for the same reasons as discussed above in Sec. IV.B.2. Ground 4 also fails for the additional reason provided below.

⁸ Petitioner relies on Rogers and Panetta for claim limitations that are not addressed in this brief but will be addressed in the POPR. Discussion of Rogers and Panetta herein is not necessary to defeat Petitioner’s Ground 4 argument.

**1. Feeney in Combination with Maurseth Does Not Disclose
“Enabling a user...to...divide a team into multiple teams for
an intra-team academic competition”**

Petitioner alleges that Feeney in combination with Maurseth discloses the following limitation in claims 1 and 14:

enabling a user, through a user interface connected to said database, to perform at least one of the following: (1) create a league of teams and a cycle of academic competition amongst the league of teams, (2) search for and select at least one team for participation in an inter-team academic competition, and (3) divide a team into multiple teams for an intra-team academic competition;

Petitioner focuses on (3) from the claim: “enabling a user, through a user interface connected to said database, to ... divide a team into multiple teams for an intra-team academic competition.” (Petition, 64-65).⁹

Petitioner’s reason for combining Feeney and Maurseth is that a “POSA would have looked to Maurseth because it relates to games involving teams like Feeney,” the same statement Dr. Abowd makes in his declaration. (Petition, 65 citing Ex. 1002, ¶136). This conclusory statement is not sufficient to show that a POSA would have selected and combined these two references. The conclusion of

⁹ Feeney and Maurseth clearly do not teach, and Petitioner does not allege that the combination teaches, creating a league of teams and a cycle of academic competition amongst the league of teams (sublimitation (1)), which is claimed in the alternative. As addressed above, Feeney does not teach searching for and selecting at least one team for participation in an inter-team academic competition (sublimitation (2)).

obviousness based on a combination of references must be supported with an explicit analysis of a reason to combine those references. *KSR*, 550 U.S. at 418. Such reasons must be more than “mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006); *see also LG Elecs., Inc. v. Cellular Commc’ns Equip. LLC*, IPR2016-00197, Paper 7 at 7-11 (PTAB Apr. 29, 2016) (petition’s conclusion of obviousness lacked sufficient articulated reasons with rational underpinnings for modifying references to achieve specific elements of the claims).

As addressed above (Sec. IV.A), Feeney and Maurseth are directed to unrelated game environments. Feeney generally discloses players taking part in one or more potentially simultaneous contests on an online platform designed to connect players with corporate sponsors as an advertising mechanism. These contests are played “over a significant period of time” such as at least 2-3 days, a month or even longer. (*Id.*, 3:23-27). The system functions via servers, a network, and personal devices to permit thousands of geographically dispersed players to participate in any of the contests. (Ex. 1005, 3:64-4:5).

On the other hand, Maurseth describes a physical game played by “small teams” using a physical board with dice. (Ex. 1007, [0038] (“Questions for the players are stored on the board in stacks at different locations”), Abstract).

Maurseth is not a time-based question and answer game. Moreover, Maurseth omits any discussion relating to online systems of play or systems of play involving a user interface (as recited by the challenged claims). The mere classification of Feeney and Maurseth as games having a team component does not amount to the articulated reasoning with rational underpinning required in an obviousness analysis.

To fill the gap, Dr. Abowd attempts to connect Maurseth and Feeney by identifying a potential problem that Feeney may have sought to solve. Dr. Abowd opines, “if teams get too large, the administrator could need the ability to divide the teams into sub-teams and host the competition between the sub-teams.” (Ex. 1002, ¶136). However, Feeney does not even hint that the number of players in a game or on teams has, or might have, any size limitation. Quite the opposite, Feeney emphasizes that the system is designed to accommodate thousands or even tens of thousands of players. (Ex. 1005, 19:61-64). The lack of a rational reason to combine the references betrays Petitioner’s use of the ’825 Patent claims and hindsight to find claim elements in prior art. *See Polaris Indus., Inc. v. Arctic Cat, Inc.*, 882 F.3d 1056, 1068–69 (Fed. Cir. 2018) (citing *InTouch*, 751 F.3d at 1352 (concluding that a party’s expert “succumbed to hindsight bias in her obviousness analysis” where such analysis “primarily consisted of conclusory references to her

belief that one of ordinary skill in the art *could* combine these references, not that they would have been motivated to do so”)) (emphasis in original).

Even allowing for the possibility that a POSA might combine Maurseth and Feeney, the disclosures do not teach the missing claim limitation. The ’825 Patent claim requires “enabling a user, through a user interface connected to said database” to “divide a team into multiple teams for an intra-team academic competition.” (Ex. 1001, Claims 1, 14). Maurseth also discusses an approach to team division (e.g., “Divide Organization into Aggregate Teams,” “Divide Aggregate Teams into Teams,” and “Teams Divide Themselves into Mini-Teams”). (*Id.*, FIG. 1). It describes that the teams at each given level are responsible for dividing themselves into the requisite number of lower-level teams: “To play the game, the organization divides (10) itself into a set of aggregate teams. Each aggregate team in the organization divides (12) itself into a set of teams. Each team in an aggregate team divides (14) itself into a set of mini-teams.” (*Id.*, [0024]; *see also* [0036] (“Mini-teams are selected by the team members based on their cross-functional expertise as mini-team members share knowledge and skills in order to succeed.”)). However, Maurseth does not discuss the utilization of a user interface or a database in its approach to team division; it is a *board game*. (Ex. 1007, Abstract). More specifically, it omits any description of users accessing

a user interface connected to a database to perform activity relating to dividing teams in a manner that enables intra-team competition.

In his advocacy of Maurseth's team division disclosure, Dr. Abowd relies on another mischaracterization. He states "a POSITA would have been motivated to configure the Feeney-Rogers system to provide the ability for the administrator to divide teams through Feeney's user interface" (Ex. 1002, ¶136). However, he carefully avoids a fact central to Feeney's system: players create and manage their own membership in teams, not an administrator. Identifying potential team members in Feeney requires searching through individual player profile cards and sending requests to join a team. Dr. Abowd's suggestion that providing the '825 Patent claim's team division feature "would take no more than basic coding" (*id.*) does not address that Feeney's interface (consisting of individual player cards presented one player card at a time) would have to be significantly transformed to permit a user to divide players between teams.

In sum, a POSA would not have been motivated to combine Feeney and Maurseth, and even so the combination does not teach or suggest the '825 Patent claim limitation of dividing a team into multiple teams. This limitation is present in independent claims 1 and 14. As a result, the Petition fails on Ground 4 for the additional reason that this limitation is not disclosed or taught by the prior art, and the challenge of all dependent claims fails as well.

D. The Petition Does Not Show That Any of the Claims Are Unpatentable Under Any Ground

All grounds presented in the Petition rely on Grounds 1 or 4 to allege independent claims 1 and 14 are obvious. If any of the elements addressed above are missing from Grounds 1 or 4, then they are also missing from all dependent claims. Grounds 2 and 5 incorporate other prior art to address only claims 9 and 22, Grounds 3 and 6 incorporate other prior art to address only claims 11 and 24. None of Grounds 2, 3, 5, or 6 can succeed due to the missing elements from the independent claims as to Grounds 1 and 4.

V. THE PETITION’S UNDUE RELIANCE ON EXPERT TESTIMONY WARRANTS DENYING INSTITUTION OF THE IPR

Petitioner submits a 101-page expert declaration of Dr. Abowd to support the Petition.¹⁰ The scope of the declaration weighs against institution. *See* FAQs for Interim Processes for PTAB Workload Management #21 (“The failure to provide focused expert testimony may weigh against institution.”).¹¹ Under 35 U.S.C. § 311(b), “[a] petitioner in an inter partes review may request to cancel as unpatentable 1 or more claims of a patent only on a ground that could be raised under section 102 or 103 and only on the basis of prior art consisting of patents or

¹⁰ Dr. Abowd states the opinions in the declaration are based on his “knowledge regarding motion sensing techniques and devices,” a technology not at issue in this proceeding. (Ex. 1002, ¶13).

¹¹ <https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management>

printed publications.” The submission of a 140-paragraph declaration which is cited approximately 80 times in the Petition calls into question whether Petitioner properly bases the validity challenge on prior art.

Moreover, the expert declaration amounts to little more than reiteration of the Petition’s arguments. It acts as a mirror, reflecting what the Petition claims a POSA “would understand” and the art a POSA would have combined to achieve the ’825 Patent’s claims. *TikTok Inc. v. NTech Properties, Inc.*, IPR2024-01339, Paper 9 at 16 (PTAB Feb. 25, 2025) (denying institution and giving little to no weight to an expert declaration that “repeats, almost verbatim, the language in the Petition”). Dr. Abowd’s declaration cites the same portions of the prior art as the Petition and provides the same explanations without more meaningful analysis.

Indeed, even a brief comparison of the Petition with Dr. Abowd’s declaration reveals extensive repetition of the assertions made within the Petition without additional explanation or support. For example, when addressing the limitation “enabling a user, through a user interface...to...search for and select at least one team for participation in an inter-team academic competition,” Petitioner and Dr. Abowd cite to Feeney’s process of individual players requesting to join a team or inviting another to join theirs. They both come to the same conclusion expressed with the exact same language: “The act of requesting to join a team constitutes selecting ‘at least one team for participation in an inter-team academic

competition.” (Petition, 26; Ex. 1002, ¶64). Compounding the inadequacy, the claim element and the actions described in Feeney share nothing in common (as addressed in Sec. IV.B.1). Dr. Abowd does not explain how he makes the leap from a player searching through the profile of other players to effect joinder with a team in Feeney to a user such as a teacher or coach selecting another team to participate in competition against his or her own as in the ’825 Patent. Indeed, he adds no actual, insightful, explanatory support despite the criticality of the issue to Petitioner’s case. An expert’s “*ipse dixit* is an insufficient evidentiary basis and cannot substitute for disclosure in a prior art reference itself.” *ARRIS Solutions, Inc. et al v. Realtime Adaptive Streaming LLC*, IPR2019-01586, Paper 7 at 24 (Mar. 16, 2020) (citations and internal quotes omitted).

A similar example of Dr. Abowd repeating an assertion from the Petition, without providing clarifying insight, arises when he addresses the limitation: “presenting a series of test questions to the contestant processing devices....” Dr. Abowd, like the Petition, simply refers to the “stream of problems” in Feeney without addressing how those problems are assembled, selected and delivered to participating players. As addressed above, Feeney’s “stream of problems” is incongruent with the “series of test questions” in the ’825 Patent’s claims.

The reasoning Dr. Abowd does offer to support the combination of Feeney with Maurseth is nonetheless tainted by hindsight. Dr. Abowd argues that a POSA

would have looked to Maurseth because “it relates to games involving teams like Feeney.” (Ex. 1002, ¶136). However, Dr. Abowd does not explain further why a POSA would be motivated to combine disclosures relating to a physical board game with the online processes of Feeney. Later, Dr. Abowd argues that a POSA “would have recognized that contest administrators need the flexibility to be able to divide teams into mini-teams...if teams get too large.” (Ex. 1002, ¶136). Feeney does not even address administrators managing teams, let alone suggest that the number of teams or the number of players in the game might be “too large.” (*See also* Sec. IV.A.1, IV.C.1). Only the ’825 Patent claims recite benefits around team division to permit intra-team competition.

Dr. Abowd’s conclusory opinions, which frequently mirror the petition and display improper, hindsight reasoning, should be given little or no weight, especially around factual questions involving what a prior art reference would have disclosed. *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 at 15 (PTAB Aug. 24, 2022) (decision denying institution) (precedential) (“[T]he cited declaration testimony is conclusory and unsupported, adds little to the conclusory assertion for which it is offered to support, and is entitled to little weight.”); *Samsung Electronics Co., Ltd. et al v. RightQuestion, LLC*, IPR2022-00251, Paper 17 at 24 (PTAB June 9, 2022) (“Petitioner’s declarant also makes this same statement verbatim, without more, and with no further explanation or additional

citations to evidence. . . We give such conclusory, unsupported assertions by Petitioner’s expert little or no weight.”). In addition, Dr. Abowd’s reliance on simplifying statements to justify modifications to the prior art like “take no more than basic software coding”, without further explanation, expose the considerable leaps in logic that Petitioner must make to arrive at the ’825 Patent claims from the references cited. (Ex. 1002, ¶¶120, 136).

Given the extensive use of expert testimony, the Petition fails to comply with statutory requirements that an IPR be based on prior art. A “battle of the experts,” if appropriate, can be had in the district court proceeding between the parties.¹² Accordingly, this factor supports discretionary denial under 35 U.S.C. § 314(a) and the guidance of the Director’s Memorandum.

VI. SETTLED EXPECTATIONS WARRANT DENYING INSTITUTION OF THE IPR

The Director’s Memorandum identifies the “[s]ettled expectations of the parties, such as the length of time the claims have been in force” as one of the factors relevant to whether denying institution is appropriate. The ’825 Patent’s

¹² “While the Board may consider expert testimony, as a matter of efficiency, extensive reliance on expert testimony and/or reasonable disputes between experts on dispositive issues may suggest that the questions are better resolved in an Article III court. The statute and our reviewing court require that petitions be based on prior art patents and printed publications.” (FAQs for Interim Processes for PTAB Workload Management #21, <https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management>).

claims have been in force for six years, since July 2019, a considerable length of time. The application that led to the '825 Patent was filed in 2012 and thus public long before the patent issued, the Patent Owner having spent 7 years prosecuting the claims, addressing issues of obviousness and § 101. During that time, the Patent Owner's founder and CEO, also the inventor, first began work on a product featuring team-based academic competition based on question-and-answer quizzing which would encourage student participation by creating energetic, sports-like environments in the academic space. The inventor eventually built his business around the patented technology which makes possible online, real time, team-based competition, and is still operating that business today. A patent owner in this position would reasonably expect that its patent would continue in full force and effect given the thorough prosecution process followed by an uninterrupted, extensive period without challenge.

Petitioner was founded in Norway in 2012 and also released a product into the U.S. market in 2013 which featured question-and-answer quizzing. However, at that time, Petitioner's product focused on individual competition while Patent Owner's product and invention focused on team-based competition. In establishing these separate markets, Patent Owner addressed the differences between Petitioner's product and the invention during prosecution of the '825 Patent. In a June 18, 2015, brief appealing § 101 rejections, Patent Owner explained, "unlike

the invention, Kahoot! is individual-based, not team-based. In the Kahoot! approach, each student competes against other students simultaneously, not as part of a team. By contrast, in the claimed system and method, every match created has a team opponent.” (Ex. 1004, p. 349). This comment evidences the settled expectation of the Patent Owner that while individual-based competition might be a lawful pursuit of companies like Petitioner’s, team-based functionality within the scope of the claims would be protected when the ’825 Patent issued.

Eventually, Patent Owner discovered that Petitioner was encroaching into Patent Owner’s team-based competition space. During the Covid years of approximately 2020-2023, Patent Owner noticed that Petitioner’s sales leapt from several million dollars per year pre-Covid, to hundreds of millions of dollars per year post-Covid. Seeking to understand the causes, Patent Owner re-examined Petitioner’s product line. Based on Petitioner’s website, Patent Owner discovered that in and around April 2016, Petitioner launched “Team Mode” capability (Ex. 2002), thereby evolving from its individual-based contest approach into the area that was the subject of Patent Owner’s invention and business. Petitioner further modified its product in or around June 2020 allowing users to create content (e.g., test items) and share it with other users, even to sell such content. (Ex. 2003, p. 3). This functionality is the subject of ’825 Patent’s dependent claims. Further encroaching on Patent Owner’s dependent claims, in or around February 2022,

Petitioner expanded its display options to include the capability of utilizing personalized backgrounds and themes. (Ex. 2004).

Patent Owner did not expect Petitioner to encroach on its intellectual property given its roots as an individual-based platform. Patent Owner approached Petitioner with a proposal to collaborate after discovering the encroachment, with no success. Specifically, Patent Owner first alerted Petitioner to the '825 Patent in February of 2024 via an email to Petitioner's Vice President of Corporate Development offering to collaborate and/or license the patent. Patent Owner had a conversation with Petitioner's representative and followed up with additional emails. While Petitioner knew about the '825 Patent at that time, it did not raise any questions regarding the patent's validity and declined the offer of collaboration and/or licensing. As a result, filing a patent infringement lawsuit became Patent Owner's only avenue for enforcing and protecting its intellectual property rights. The parties having originally launched different types of products, as well as Patent Owner's enjoyment of patent rights since 2019, led to a settled expectation that Petitioner would not interfere with Patent Owner's team-based product and approach.

VII. THE FINTIV FACTORS FAVOR DISCRETIONARY DENIAL

Petitioner briefly addresses the *Fintiv* factors. (Petition, 66-68). Patent Owner concedes that the parallel district court litigation is in the early stages:

Petitioner is a defendant in the litigation and has filed an answer. Petitioner also filed a motion to stay pending the outcome of this IPR that was granted.¹³

The fourth (overlap in parallel proceedings) and fifth (parties) factors weigh in favor of denial of institution and having the parties litigate all validity and infringement issues in district court. The district court action is pending before a judge with extensive experience in patent disputes (Judge Albright) in the U.S. District Court for the Western District of Texas and is between the same parties as this IPR. Patent Owner is a small company with less than half a million dollars in annual revenue while Petitioner is a global corporation with more than \$200 million in annual revenue. Petitioner's bifurcation of the issues that would all be raised in district court increases costs for the Patent Owner to pursue its claims. Admittedly, if Petitioner is ultimately successful in this proceeding, total costs for Patent Owner will be lower. However, given the weakness of the Petition's merits, the dispute regarding claim construction (that will be addressed in the POPR), and Petitioner's extensive reliance on flawed expert opinion, the more likely outcome is that the parties will expend resources in this proceeding and then be faced with the additional costs of addressing infringement and other validity questions in district court (e.g., indefiniteness, written-description issues, enablement, unenforceability issues, and invalidity grounds that Petitioner may argue fall

¹³ Patent Owner did not oppose the stay to preserve its and the Court's resources.

outside of 35 U.S.C. § 315(e)(2) estoppel¹⁴). This bifurcated approach will increase the overall costs of the dispute, which is prohibitive for Petitioner, a small company seeking to enforce its patent rights.

The sixth factor (merits) weighs strongly in favor of denying institution. As addressed above and will be further addressed in the POPR, the Petition is weak on the merits and ineffectively propped up by flawed expert testimony.

VIII. CONCLUSION

For the reasons addressed herein, Patent Owner respectfully requests that the Director exercise her discretionary powers and decline to institute *inter partes* review of the '825 Patent.

Dated: June 15, 2025

Respectfully submitted,

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¹⁴ Petitioner stipulates in the Petition that “if the IPR is instituted, Petitioner will not pursue the IPR grounds in the district court litigation” (Petition, 67) but does not address grounds that could have been raised.

CERTIFICATE OF WORD COUNT

The undersigned hereby certifies that the portions of the above-captioned PATENT OWNER'S DISCRETIONARY DENIAL BRIEF specified in 37 C.F.R. § 42.24 has 8,107 words in compliance with the 14,000 word limit set forth in 37 C.F.R. § 42.24 and the Director's Memorandum. This word count was prepared using Microsoft Word for Office 365.

Dated: June 15, 2025

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CERTIFICATE OF SERVICE

The undersigned certifies that on June 15, 2025, the foregoing Patent Owner's Discretionary Denial Brief was served via email upon counsel of record for Petitioner as follows:

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