

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

KAHOOT! AS,
Petitioner

v.

INTERSTELLAR INC.,
Patent Owner.

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

PETITIONER'S DISCRETIONARY DENIAL OPPOSITION

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LIST OF EXHIBITS

Ex. No.	Description	Previously Submitted
Ex. 1001	U.S. Patent No. 10,339,825 to Kelley et al. (“the ’825 patent”)	X
Ex. 1002	Declaration of Gregory Abowd, Ph.D.	X
Ex. 1003	Curriculum Vitae of Gregory Abowd, Ph.D.	X
Ex. 1004	Prosecution History of U.S. Patent No. 10,339,825	X
Ex. 1005	U.S. Patent No. 8,231,470 to Feeney et al.	X
Ex. 1006	U.S. Patent No. 10,861,343 to Rogers et al.	X
Ex. 1007	U.S. Patent Pub. No. 2004/0004325 to Maurseth et al.	X
Ex. 1008	U.S. Application No. 11/539,179 to Feeney, filed January 3, 2007	X
Ex. 1009	U.S. Patent No. 6,752,396 to Smith	X
Ex. 1010	U.S. Patent No. 6,086,381 to Downs et al.	X
Ex. 1011	U.S. Pat. Pub. No. 2010/0030578 to Siddique et al.	X
Ex. 1012	U.S. Patent Pub. No. 2009/0104591 to Panetta	X
Ex. 1013	Exhibit 2 attached to Complaint in <i>Interstellar Inc. v. Kahoot! EDU, Inc. et al</i> , Case No. 1:24-cv-00727-JRP (W.D. Tex.)	X
Ex. 1014	Pacer Case Docket for <i>Interstellar Inc. v. Kahoot! EDU, Inc.</i> , C.A. No. 1:24-cv-00727-ADA (W.D. Tex.)	
Ex. 1015	Defendants' Answer to Plaintiff's Complaint for Patent Infringement, <i>Interstellar Inc. v. Kahoot! EDU, Inc.</i> , C.A. No. 1:24-cv-00727-ADA, DI 17 (W.D. Tex. Feb. 12, 2025)	

I. INTRODUCTION

The instant Petition does not present a situation where exercise of discretion would advance the Board's objective of efficient administration of post-grant challenges and maintaining the integrity of the patent system. Indeed, the usual reasons that warrant exercise of discretion are clearly absent here, which is evident by the fact that Patent Owner Interstellar ("Interstellar") presents a merits challenge as its lead argument for discretionary denial. (*See* DD Req.)

First, the co-pending district court action is stayed pending adjudication of the IPR. Interstellar itself *consented* to the stay and the stay was granted prior to any investment in the district court proceeding by the parties. The parties' agreement to stay their district court litigation pending IPR underscores the parties' understanding that the Board is the appropriate venue for resolving the parties' validity dispute. A discretionary denial in such a situation is entirely inappropriate.

Second, settled expectations in this case favor referral, not denial. Specifically, the subject '825 patent issued on July 2, 2019 and the instant Petition was filed on March 7, 2025, i.e., within six years of patent issuance. Thus, settled expectations based on the length of time the '825 patent has been in force do not favor denial. *See, e.g., Berkshire Hathaway v. Birchtech Corp.*, IPR2025-00274, Paper 23 at 3 (July 2, 2025) (finding no settled expectations for a patent issued in 2019). Even setting aside the length of time the patent has been in force, strong reasons exist for

why the Board should review the challenged claims. Kahoot!’s accused infringing functionality has been in the public domain since at least 2016. And Interstellar has known about Kahoot! since 2015, as evidenced by its remarks to the Patent Office regarding Kahoot! during prosecution. (Ex. 1004 at 349.) Interstellar’s failure to assert the patent against Kahoot! despite knowing about Kahoot! for almost a decade tips the settled expectations scale in favor of Kahoot!. *Intel Corp. v. Proxense LLC*, IPR2025-00327, Paper 12 at 2–3 (June 26, 2025) (explaining that settled expectations may not favor a discretionary denial when a “patent may have been in force for years but may not have been . . . asserted, marked, licensed, or otherwise applied in a petitioner’s particular technology space, if at all.”).

Third, Interstellar’s claim that the Petition unduly relied on Dr. Abowd’s expert declaration rings hollow. There is no support for the position that Kahoot! used Dr. Abowd’s declaration “to fill gaps in the prior art” given that Kahoot! alleges that every feature claimed by the ’825 patent is taught directly by the prior art. *iRhythm Technologies, Inc. v. Welch Allyn*, IPR2025-00363, Paper 10 at 2–3 (June 6, 2025). In the absence of such gap-filling testimony, mere overlap between the Petition and the expert declaration is insufficient to warrant a discretionary denial.

Fourth, Interstellar’s arguments going to the merits of Kahoot!’s unpatentability challenge are more appropriate for review by the merits panel. Even if the Board considers them here, they are meritless.

Accordingly, referral to the merits panel is respectfully requested.

II. **FINTIV DOES NOT FAVOR DENIAL BECAUSE THE PARALLEL LITIGATION HAS BEEN STAYED**

The *Fintiv* factors support a referral to the merits panel because the district court case is stayed pending IPR (Ex. 1014 at 4 (March 25, 2025 Order)) and no progress had been made in that case prior to the stay. Prior to the stay, the parties did not even receive a scheduling order, much less start investing into discovery or any other briefing. (Ex. 1014 at 2–4 (D.I. 1–5, 7–9, 17); Ex. 1015.) Under these circumstances, institution of *inter partes* review will not undermine the Board’s objectives to advance “efficiency, fairness, and the merits.” *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5– 6 (Mar. 20, 2020) (precedential).

The **first factor** (stay) weighs in favor of institution because the district court litigation is stayed pending this proceeding. On March 24, 2025, Kahoot! filed an *unopposed* motion to stay the district court litigation pending this proceeding. (Ex. 1014 at 4 (D.I. 19).) On March 25, 2025, the district court litigation was stayed pending this proceeding. (*Id.* at 4 (March 25, 2025 Order).) *See also Advanced Micro Devices, Inc. v. Concurrent Ventures, LLC*, IPR2025-00479, Paper 10 at 2 (July 10, 2025) (referring a petition challenging a recently issued patent in a stayed case in the Western District of Texas).

The **second factor** (proximity of trial date) weighs in favor of institution because there is no scheduled trial date.

The **third factor** (investment in parallel proceedings) weighs in favor of institution. The district court did not even issue a scheduling order prior to the stay. Nor did it issue any other substantive orders. The parties likewise have not engaged in any discovery, claim construction, or other activity in the district court action.

The **fourth factor** (overlap in parallel proceedings) weighs in favor of institution. There is no overlap because the district court litigation is stayed, and Kahoot! is challenging all of the asserted claims of the '825 patent.

The **fifth factor** (parties) weighs in favor of institution because although Kahoot! and Interstellar are the same parties as in district court, the district court litigation is stayed so the Board will address the patent first. *See Google LLC v. Parus Holdings, Inc.*, IPR2020-00846, Paper 9 at 21 (Oct. 21, 2020) (“Petitioner is the defendant in the parallel proceeding. This fact could weigh either in favor of, or against, exercising discretion to deny institution, depending on which tribunal was likely to address the challenged patent first.”).

The **sixth factor** (other) weighs in favor of institution. As further explained below, the Petition presents meritorious challenges that would plainly lead to the conclusion, based on a preponderance of the evidence, that at least one or more claims are unpatentable. Additionally, resolving the Petition’s challenges before the Board would be more efficient for all the parties. Indeed, even Interstellar concedes that “if Petitioner is ultimately successful in this proceeding, total costs for Patent

Owner will be lower.” (DD Req. at 33.) Although Interstellar makes the unsupported attorney argument that it will prevail before the Board and hypothesizes that the parties will then have to litigate in the district court (*id.*), such argument is speculative at best and moreover is baseless in view of the deficiencies in Interstellar’s merits arguments as explained below. Interstellar even appears to acknowledge that both parties will be burdened with higher costs by litigating in district court: “[t]his bifurcated approach will increase the overall costs of the dispute, which is prohibitive for **Petitioner**, a small company seeking to enforce its patent rights.” (*Id.* at 34 (emphasis added).) The Petition should therefore be referred to the Board to efficiently resolve the meritorious issues raised by the Petition.

III. SETTLED EXPECTATIONS FAVOR REFERRAL, NOT DENIAL

Kahoot! filed the IPR within six years of the issuance of the ’825 patent. Specifically, the ’825 patent issued on July 2, 2019 (Ex. 1001 at code 45) and the IPR was filed on March 7, 2025 (Paper 1). Thus, settled expectations based on the length of time the ’825 patent has been in force (i.e., within six years of issuance, which is commensurate with the six year infringement recovery bar) support referral, not denial. *See Dabico Airport Solutions Inc. v. AXA Power APS*, IPR2025-00408, Paper 11 (June 18, 2025) (identifying the six year infringement recovery bar under 35 U.S.C. § 286 as relevant to settled expectations); *Berkshire Hathaway*, IPR2025-00274, Paper 23 at 3 (finding no settled expectations for a patent issued in 2019);

Cambridge Industries USA, Inc., v. Applied Optoelectronics, Inc., IPR2025-00434, Paper 11 at 2–3 (June 26, 2025) (finding no settled expectations for a patent issued in 2019).

Moreover, in addition to the short time the '825 patent has been in force, persuasive reasons exist for why the Board should review the challenged claims. *Intel*, IPR2025-00327, Paper 12 at 2 (“There may be persuasive reasons why the Board should review challenged claims several years after their issuance date.”). In particular, as explained below, Interstellar failed to assert the '825 patent against Kahoot! despite knowing about Kahoot! and its technology for almost a decade. Interstellar’s failure supports referral, not denial. *Id.* (no settled expectations when a “patent may have been in force for years but may not have been . . . ***asserted***, marked, licensed, or otherwise applied ***in a petitioner’s particular technology space, if at all.***”) (emphasis added).¹

Kahoot! has strong settled expectations that it would not be subject to suit by Interstellar on its product offerings that have existed in the marketplace for almost a decade. Interstellar admits that it knew Kahoot! added team competition capability

¹ There is also no evidence that Interstellar marked or licensed its patent in Kahoot!’s technology space of game-based learning.

as early as 2016 when it allegedly entered “into the area that was the subject of Patent Owner’s invention and business.” (DD Req. at 31.) Interstellar admits that it has known about Kahoot!’s game-based learning offerings since at least 2015. (*Id.* at 30–31.) Specifically, during prosecution, Interstellar expressly distinguished its claims from Kahoot!’s approach, in order to overcome a rejection by the Patent Office in 2015:

However, unlike the invention, Kahoot! is individual-based, not team-based. In the Kahoot! approach, each student competes against all other students simultaneously, not as part of a team. By contrast, in the claimed system and method, every match created has a team component. . . . Kahoot! does not enable the creation of teams of individual contestants for participation in an academic competition as claimed. Kahoot! also does not provide both a team score and an individual score that are updated in real time by notifying the student that he/she has answered a question correctly.

(Ex. 1004 at 349.) Yet, Interstellar “first alerted [Kahoot!] to the ’825 Patent in February of 2024” (DD Req. at 32) almost a decade after Kahoot! purportedly introduced team based competition features. By Interstellar’s own admissions, it “noticed” Kahoot!’s sales soaring from 2020-2023 but it did not bother notifying Kahoot! of the alleged infringement during those years. (*Id.* at 31.)

The above facts demonstrate that Kahoot!, not Interstellar, has settled expectations that its offerings, which have been in the public domain for almost a decade, are not at risk of lawsuit from a party such as Interstellar. Just as the Director considers a Petitioner's delay in challenging a patent, the Director should also consider a Patent Owner's delay in alleging infringement. Indeed, it is unfair for Kahoot! to have invested in its business (and grown its sales) for years to only get sued by a wait-and-see plaintiff like Interstellar.

IV. PETITIONER'S EXPERT TESTIMONY DOES NOT GAP FILL THE PRIOR ART

Interstellar confuses overlap between the Petition and Dr. Abowd's declaration as "undue reliance" on expert testimony. (DD Req. at 25-29.) There is, however, no rule or Board case law prohibiting overlap between the Petition and an expert declaration. Here, there is no support for the argument that Kahoot! has used Dr. Abowd's declaration "to fill gaps in the prior art" given that Kahoot! has alleged that every feature claimed by the '825 patent is taught directly by the prior art. *iRhythm Technologies*, IPR2025-00363, Paper 10 at 2–3. Dr. Abowd appropriately provides helpful context explaining the motivation to combine patents and printed publications that underpin the unpatentability grounds of the Petition, and includes "citations to evidence in support of his statements." *Id.* Thus, Dr. Abowd's declaration and the Petition's independent grounds for challenging the validity of the '825 patent cannot form the basis of a discretionary denial.

First, Interstellar’s assertion that Dr. Abowd’s testimony is a “reiteration of the Petition’s arguments” and is lengthy (DD Req. at 25–26) ignores that Dr. Abowd’s extensive analysis is necessitated by the lengthy claims of the ’825 patent. (See Ex. 1001 at 40:40–41:40, 42:13–18, 42:25–29, 42:38–43:32, 44:6–11, 44:18–22.) Despite the fact that the ’825 patent contains 42 claims, Kahoot! focused its Petition by challenging Interstellar’s asserted claims 1, 2, 9, 11, 14, 15, 22, and 24 (of which 14, 15, 22 and 24 are similar to 1, 2, 9, and 11) along with claims 3–5 and similar claims 16–18. (See Pet. at 1; Ex. 1001 at 40:40–48:39; Ex. 1013.) Dr. Abowd directed his testimony to the challenged claims as well, but also provided additional analysis. (See, e.g., Ex. 1002 at ¶¶19–25, 60, 75, 83–88, 119–121, 128–129, 133–138.) Contrary to Interstellar’s characterization, the focused petition and independent analysis of Dr. Abowd weighs in favor of referral.

Second, Interstellar’s repeated allegations that Dr. Abowd’s testimony is a “mirror” of the Petition (see, e.g., DD Req. at 26, 28) are unpersuasive. Interstellar identifies no claim limitation for which Kahoot! relied solely on Dr. Abowd’s testimony to fill in a gap in the prior art. To the contrary, the petition thoroughly disclosed how the prior art disclosed each of the challenged claim limitations, without relying on expert testimony for gap filling. (See, e.g., Pet. at 13–15, 23–27, 62–65 (multiple prior art based theories for optional limitations).) Thus, Interstellar’s cited authority (see, e.g., *Xerox Corp. v. Bytemark, Inc.*, IPR2022-

00624, Paper 9 at 15 (Aug. 24, 2022) (precedential) and *Samsung Electronics Co., Ltd. et al v. RightQuestion, LLC*, IPR2022-00251, Paper 17 at 24 (June 9, 2022)) is readily distinguishable.

Third, contrary to Interstellar’s own conclusory arguments (DD Req. at 27-29), Dr. Abowd’s testimony is not conclusory. (*See, e.g.*, Ex. 1002 at ¶¶16–44 (explaining skill in the art, technical background, and overview of the ’825 patent and references), 83–86 (setting forth motivation to combine Feeney and Rogers), 119–121 (setting forth motivation to combine Feeney, Rogers, and Downs), 128–129 (setting forth motivation to combine Feeney, Rogers, and Siddique), 133–138 (setting forth motivation to combine Feeney, Rogers, Panetta, Maurseth, Downs, and Siddique).²) As for Interstellar’s reference to a “battle of the experts” (DD Req. at 29), this argument is baseless because Interstellar has not provided any expert testimony to dispute Dr. Abowd’s testimony.

For at least the above reasons, the Petition’s reliance on the testimony of Dr. Abowd does not warrant a discretionary denial.

V. STRONG MERITS SUPPORT REFERRAL

Lacking any rational, let alone persuasive, reasons for a purely discretionary

² Interstellar’s challenge to the merits of Dr. Abowd’s testimony (*see, e.g.*, DD Req. at 27) is further addressed below in Section V.

denial, Interstellar pivots to offering merits-based arguments that are better suited for review by the merits panel. Even if considered, Interstellar’s arguments are meritless, which underscores the compelling merits of the Petition.

A. “Search for and select a team”

Interstellar argues that Feeney does not disclose searching for and selecting a team for participation in a competition because the search is for a player (as opposed to a team). (DD Req. at 14–15.) Interstellar, however, admits that Feeney allows a player to perform a search using “team membership” as a criterion. (*Id.* at 15 (citing Ex. 1005 at 18:37–46).) Indeed, Feeney discloses “giving the player options for entering more specific or targeted search criteria, such as . . . ring or team membership.” (Ex. 1005 at 18:37–46.) Feeney thus discloses “search for . . . at least one team,” as claimed.

Interstellar also does not dispute that Feeney discloses a player can review the search results and select a player’s team to join. (DD Req. at 14-15; *see also* Pet. at 25–26.) Instead, Interstellar seeks to read limitations into the claim by arguing that Feeney does not disclose “inviting [a team] to participate in” the competition. (DD Req. at 15; *see also id.* at 27 (criticizing Dr. Abowd’s testimony).) But the claim merely requires “search for and select a team for participation in an inter-team academic competition,” which Feeney clearly discloses by allowing a player to select a team to join. There is no requirement in the claims that the system allow a player

to “invit[e]” a team to participate in the competition.

B. “Presenting a series of test questions”

The claims require “presenting a series of test questions to the contesting processing devices of the individual contestants of competing teams.” Interstellar, however, contends that while Feeney presents a “stream of problems” to the contestants, Feeney does not present the “*same* set of questions” to all contestants. (DD Req. at 16-18 (emphasis added).) Per Interstellar, in “Feeney, players do not compete over the same set of pre-selected questions.” (*Id.*) This argument fails for at least two reasons.

First, the claim does not require presenting the “same” set of questions to all contestants. It is well-settled that “a” refers to “one or more” absent specific evidence to the contrary. *Salazar v. AT&T Mobility LLC*, 64 F.4th 1311, 1315 (Fed. Cir. 2023). Here, the claim language itself supports a plural interpretation by presenting “*a*” series of test questions “to the . . . individual contestants” and then “enabling teams of individual contestants to compete over *a* series of test questions.” (Ex. 1001 at 40:59-60, 41:6-7.) *Cf. Salazar*, 64 F.4th at 1317 (“We agree with the district court that while the claim term ‘a microprocessor’ does not require there be only one microprocessor, the subsequent limitations referring back to ‘said microprocessor’ require that at least one microprocessor be capable of performing each of the claimed functions.”)

Second, Interstellar completely ignores the Petition’s analysis explaining how the **same** set of questions are presented to all players. The Petition explains that Feeney describes delivery of the questions “simultaneously” to multiple participating players “as described in the ’179 Application” (Ex. 1005 at 20:47-49), which is “incorporated by reference [in Feeney] . . . in full.” (*Id.* at 2:66-3:6; Pet. at 27.) The ’179 application describes simultaneous delivery of a number of problems, which may include “multiple-choice” or other types of questions, to a user interface (illustrated below) of each player device. (Ex. 1008 at ¶¶ [68], [77], [79], FIG. 8.) And it expressly describes presenting the **same** problems to each player. (*Id.* at ¶ [68] (“each problem is made available to all of the players at substantially the same time”).)

C. “Divide a team into multiple teams”

Interstellar’s final substantive argument (which is only necessary for consideration if Interstellar prevails on the first “search for and select a team” limitation) is that a POSITA would not have combined Feeney and Maurseth because they “are directed to unrelated game environments.” (DD Req. at 21.) According to Interstellar, “Maurseth is not a time-based question and answer game” and is instead, a “physical game played by . . . using a physical board with dice.” (*Id.* at 21-22.) But Interstellar does not, and cannot, show that Maurseth’s teachings are limited to physical board games. Exemplary implementations in Maurseth relating to board

games do not negate the fact that Maurseth is generally disclosing team games, just like Feeney. Indeed, “[c]ommon sense teaches . . . that familiar items may have obvious uses beyond their primary purposes.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 405 (2007).

Interstellar does not dispute that the addition of the ability to divide teams in Feeney would have been a beneficial feature to better manage a competition if the teams got too large. (DD Req. at 22.) For example, Interstellar does not dispute Dr. Abowd’s testimony that adding such a feature in Feeney would provide more flexibility to the administrator to manage a contest. (Ex. 1002 at ¶136 (“Having looked to Maurseth, a POSITA would have recognized that contest administrators need the flexibility to be able to divide teams into mini-teams depending on the needs of a contest. For example, 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. Thus, 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 84.”).) Instead, Interstellar contends that Feeney is not concerned with the number of players in a game or team. (*Id.*) But Feeney need not be concerned with limiting the size of teams because a motivation can come from “the background knowledge possessed by a person having ordinary skill in the art,” which is the case here. *KSR*, 550 U.S. at 405.

For at least the above reasons, Interstellar offers no persuasive reasons for a finding that the Petition is weak on the merits.

VI. CONCLUSION

For the foregoing reasons, Kahoot! respectfully requests that the Acting Director refer this petition to the merits panel.

Respectfully submitted,

Dated: July 16, 2025

By: /Chetan Bansal/
Chetan Bansal (Reg. No. 81,590)
Counsel for Patent Owner

CERTIFICATE OF COMPLIANCE

Pursuant to Acting Director Stewart's March 26, 2025 Memorandum on Interim Processes for PTAB Workload Management, the undersigned certifies that the foregoing Petitioner's Discretionary Denial Opposition contains, as measured by the word-processing system used to prepare this paper, 3,426 words. This word count does not include the items excluded by 37 C.F.R. § 42.24.

Respectfully submitted,

Dated: July 16, 2025

By: / Chetan Bansal /
Chetan Bansal (Reg. No. 81,590)
Counsel for Patent Owner

CERTIFICATE OF SERVICE

I certify that I caused to be served on the counsel identified below a true and correct copy of the foregoing Petitioner's Discretionary Denial Opposition by electronic means on July 16, 2025:

By: / Chetan Bansal /
Chetan Bansal (Reg. No. 81,590)
Counsel for Patent Owner