

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 REQUEST FOR DIRECTOR REVIEW

Table of Contents

I.	INTRODUCTION	1
II.	ARGUMENT	4
III.	CONCLUSION.....	7

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Cambridge Industries USA, Inc. v. Applied Optoelectronics, Inc.</i> , IPR2025-00436, Paper 11 (June 26, 2025).....	2, 4, 5, 6
<i>Dabico Airport Solutions Inc. v. AXA Power ApS</i> , IPR2025-00408, Paper 21 (Director June 18, 2025)	2, 4, 5
<i>In re: Google LLC</i> , No. 25-144 (Fed. Cir. filed August 18, 2025)	7
<i>Intel Corp. v. Proxense LLC</i> , IPR2025-00327, Paper 12 (June 26, 2025).....	3, 5, 6
<i>In re: Motorola Solutions, Inc.</i> , No. 25-134 (Fed. Cir. filed June 23, 2025).....	7
<i>In re: SAP America, Inc.</i> , No. 25-132 (Fed. Cir. filed June 16, 2025).....	7
Statutes	
5 U.S.C. § 553	7
5 U.S.C. § 706(2)(A).....	6, 7
35 U.S.C. § 286	2, 4, 5
35 U.S.C. § 315(b)	7
35 U.S.C. § 316(a)	7

I. INTRODUCTION

Kahoot! respectfully requests Director Review of the Director’s Decision (Paper 12, hereinafter “Decision”) denying institution of *inter partes* review. The Decision denied review based on an incorrect assumption that the challenged U.S. Patent No. 10,339,825 (the “’825 patent”) “has been in force for over six years.” (Decision at 2.)¹ Respectfully, the Decision overlooked or misapprehended the fact that, at the time the Petition was filed on March 7, 2025, the ’825 patent had **not** been in force for six years. (*See* DD. Opp. (Paper 9) at 1, 5.) It appears that the Decision arrived at the six-year period by using the date of the Decision rather than the actual filing date of the Petition. Under the proper calculation method—in accordance with the Director’s decisions in other cases—the ’825 patent had not been in force for over six years.

Indeed, in a prior decision, directly on point and involving identical

¹ While the Decision notes that the determination to exercise discretion was “based on a holistic assessment,” the Decision offered no other reason for the denial beyond “settled expectations” based on erroneous assumption that the ’825 patent had been in force for over six years at the time the IPR petition was filed. (Decision at 2.) Furthermore, as explained below, the Decision appears to have overlooked that there was undisputed evidence that outweighed any claim of settled expectations.

circumstances, the Director found no settled expectations where the Petition was filed less than six years from the patent issue date but the Director's Decision issued more than six years after the issue date. *See Cambridge Industries USA, Inc. v. Applied Optoelectronics, Inc.*, IPR2025-00436, Paper 11 (June 26, 2025) (finding no settled expectations for a Petition filed within six years of the June 4, 2019 issue date of U.S. Patent No. 10,313,024). This precedent aligns with the Director's prior comparison with other approaches to settled expectations such as the six year limitation on damages set forth in 35 U.S.C. § 286. *See Dabico Airport Solutions Inc. v. AXA Power ApS*, IPR2025-00408, Paper 21 (Director June 18, 2025). Notably, the six-year damages period under 35 U.S.C. § 286 is calculated from "the filing of the complaint or counterclaim for infringement." Thus, consistent with the intent underlying the Director's settled expectations policy, the six-year date for purposes of the "settled expectations" determination should likewise be calculated from the filing of the petition (as opposed to the date the Director issues a decision on a discretionary denial request).²

² Even if the six-year period is determined from the date of Patent Owner's request for discretionary denial (June 15, 2025), there should still be no finding of

The Decision also overlooked or misapprehended Kahoot!’s argument that any claim of settled expectations is outweighed by the fact that the ’825 patent was not “**asserted**, marked, licensed, or otherwise applied” in Kahoot!’s “particular technology space.” (See DD. Opp. at 6 (citing *Intel Corp. v. Proxense LLC*, IPR2025-00327, Paper 12 at 2–3 (June 26, 2025)).) Following closely the Director’s guidance in *Intel*, Kahoot! provided a detailed argument with relevant **undisputed** facts—Kahoot! has operated the accused infringing functionality since at least 2016, and Patent Owner has known about Kahoot! since at least 2015, yet failed to assert the patent against Kahoot! until recently. Despite being presented with this undisputed evidence regarding Kahoot!’s settled expectations, per the Director’s guidance in *Intel*, the Decision summarily dismissed this argument as insufficient to “defeat Patent Owner’s settled expectations” without any analysis or explanation. (Decision at 2.)

Given that no other considerations weigh in favor of denial and the parallel litigation remains stayed, the Decision should be vacated and the instant Petition referred to the Board.

settled expectations because the ’825 patent had not been in force for more than six years as of that filing.

II. ARGUMENT

Under the Director's prior decisions, there was no basis for finding settled expectations in favor of a discretionary denial. The Petition challenged the '825 within six years of issuance and Patent Owner failed to assert that '825 patent for almost a decade despite knowing about Kahoot!'s offerings since at least 2015.

As explained in *Dabico Airport Solutions Inc. v. AXA Power ApS*, IPR2025-00408, Paper 21 (Director June 18, 2025), while “there is no bright-line rule on when expectations become settled,” the Director's approach to settled expectations “aligns with other approaches to settled expectations and incentives” such as 35 U.S.C. § 286, which provides that “no recovery shall be had for any infringement committed more than *six years prior to the filing* of the complaint or counterclaim for infringement in the action.” 35 U.S.C. § 286, *quoted in Dabico*, IPR2025-00408, Paper 21 at 3 (emphasis added). Thus, consistent with the Director's stated approach, just like the six-year period in § 286 is calculated from the filing date of a complaint, the six-year period for a settled expectations analysis for a discretionary denial request should likewise be calculated here based on the filing date of the Petition, especially given other cases like *Cambridge Industries*.

Here, the Decision appears to have overlooked or misapprehended the fact that Kahoot! filed the IPR petition within six years of the issuance of the '825 patent. (DD. Opp. at 1, 5.) Specifically, the '825 patent issued on July 2, 2019 (Ex. 1001 at

code 45) and the Petition was filed on March 7, 2025 (Paper 1). The Decision's finding that the '825 patent had been in force for "over six years" (Decision at 2) thus was either in error or presumably based on a calculation from the date of the Decision, as opposed to the date the Petition was filed. That appears to have been an inadvertent oversight that the Director should correct on rehearing.

The Director's recent prior decision finding no settled expectations in another case with virtually identical facts further supports reversal on rehearing. Specifically, in *Cambridge Industries*, IPR2025-00436, the Director found no settled expectations for U.S. Patent No. 10,313,024 where the petition was filed less than six years after the issuance of the patent (as is the case here), even though the Decision date (June 26, 2025) was more than six years from the issue date of that patent (June 4, 2019). Thus, consistent with the approach of § 286 and the Director's statement in *Dabico*, the Director considered the Petition filing date, as opposed to the Decision date, in her six-year calculation. Respectfully, the instant Petition and the Patent Owner's request for discretionary denial should have been evaluated under the same approach.

Additionally, the Decision overlooked the detailed explanation in Kahoot!'s Opposition brief (DD. Opp. at 2, 5-8), which closely followed the Director's guidance in *Intel*, regarding Kahoot!'s **own** settled expectations and the **undisputed** evidence weighing against Patent Owner's purported settled expectations. For example, Kahoot! explained that Patent Owner has known about Kahoot!'s offerings

since at least 2015 and has known that Kahoot! offered the allegedly infringing functionality since 2016. (DD. Opp. at 5-8.) Patent Owner even “noticed” Kahoot!’s sales soaring from 2020-2023. (*Id.*) Nevertheless, Patent Owner did not notify Kahoot! of any alleged infringement until only recently. Thus, Patent Owner’s non-assertion for almost a decade, despite knowledge of the allegedly infringing instrumentality, creates settled expectations for Kahoot! that it has no threat of a lawsuit. The fact that Patent Owner failed to “assert[], mark[], license[], or otherwise appl[y]” the ’825 patent in Kahoot!’s “particular technology space” weighs against Patent Owner’s settled expectations. *See Intel*, Paper 12 at 2–3; *see also* DD. Opp. at 2, 6.

The Decision appears to have overlooked or misapprehended the record and undisputed facts, which supports referral, not denial.³

³ An arbitrary application of the Director’s six-year settled expectations policy to institute review in one proceeding (such as *Cambridge Industries*) yet to deny institution in another proceeding with materially the same facts (such as here) would constitute an agency action that is “arbitrary, capricious, [and] an abuse of discretion,” in violation of the Administration Procedure Act. *See* 5 U.S.C. § 706(2)(A). Moreover, the Director’s six-year settled expectations policy was

III. CONCLUSION

For the foregoing reasons, Kahoot! respectfully requests that the Director vacate the Decision Denying Institution and refer the Petition to the Board.

Respectfully submitted,

Dated: August 29, 2025

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promulgated without the required compliance with the notice-and-comment rulemaking requirements of 5 U.S.C. § 553 and 35 U.S.C. § 316(a). Finally, the six-year rule is also “arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law” under 5 U.S.C. § 706(2)(A) because it contravenes Congress’s express timing limit set forth in 35 U.S.C. § 315(b) and the lack of any timing restriction in 35 U.S.C. § 311(c). The Office’s discretionary denial practices are currently being challenged in, for example, *In re: SAP America, Inc.*, No. 25-132 (Fed. Cir. filed June 16, 2025); *In re: Motorola Solutions, Inc.*, No. 25-134 (Fed. Cir. filed June 23, 2025); *In re: Google LLC*, No. 25-144 (Fed. Cir. filed August 18, 2025); and *In re: HighLevel, Inc.*, No. 25-148 (Fed. Cir. filed August 29, 2025). Petitioner respectfully requests the benefit of any relief that may be granted in that appeal or other challenges to the Office’s discretionary denial practices.

CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. §42.24(d), the undersigned certifies that the foregoing Petitioner's Request For Director Review of the Decision Denying Institution of Inter Partes Review is no more than 15 pages and therefore complies with the limitations of 37 C.F.R. § 42.24(a)(1)(v). The page count does not include the Table of Contents, the Table of Authorities, the Certificate of Compliance, or the Certificate of Service.

Respectfully submitted,

Dated: August 29, 2025

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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 Request For Director Review of the Decision Denying Institution of Inter Partes Review by electronic means on August 29, 2025:

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