

From: [Russell, Patricia](#)
To: [Director PTABDecision Review](#)
Cc: [z/VectorFlow; HID-VectorFlow-IPR@morganlewis.com](#)
Subject: IPR2023-00353 - Vector Flow v. HID Global Corporation - Petitioner's Request for Rehearing by the Director
Date: Friday, August 4, 2023 7:40:29 PM
Attachments: [2023-08-04 Request for Rehearing.pdf](#)
[2023-08-04 Updated Exhibit List.pdf](#)
[EX1013 \(Opening Brief on Assignor Estoppel Motion\).pdf](#)
[EX1014 \(Opposition Brief on Assignor Estoppel\).pdf](#)
[EX1015 \(Reply Brief on Assignor Estoppel\).pdf](#)
[EX1016 - Mace Stein email thread re preliminary reply.pdf](#)

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Sent on behalf of Heidi L. Keefe, Esq., Counsel for Petitioner

Director Vidal,

Petitioner Vector Flow, Inc., respectfully notifies the parties and the USPTO of its filing of the attached Request for Rehearing by the Director ("Request"), Paper 9, filed pursuant to 37 C.F.R. § 42.71(d) and the Revised Interim Director Review Process adopted on July 24, 2023, of the decision by the Board denying institution (Paper 8) in IPR2023-00353.

The Request presents important issues affecting a great number of PTAB proceedings in which pre-institution *Fintiv* discretionary denial arguments are made. As the Director is aware, *Fintiv* arguments have become common occurrences in IPR proceedings filed during the pendency of parallel litigation. The Board's decision here provides a good vehicle for Director Review to address two exceedingly important and recurring procedural issues regarding *Fintiv*, and one important substantive issue.

The two procedural issues are closely-related and commonly confronted by parties, practitioners, and the PTAB: (1) whether IPR petitioners have an obligation to anticipate and affirmatively rebut possible *Fintiv* challenges in their IPR petitions to avoid discretionary denial under § 314(a), and if so, under what circumstances, and (2) the procedure for IPR petitioners to seek leave of the Board to file pre-institution reply briefs to address *Fintiv* challenges. There is no authoritative guidance on these issues, which has led to confusion on the part of practitioners and parties, and inconsistent treatment by the PTAB. The decision by the Board here, as detailed in the Request, provides a vivid example of the problems that arise because of the lack of authoritative guidance on these issues.

The Request also raises an important substantive issue relating to *Fintiv*: the impact of assignor estoppel arguments by a patent owner in parallel litigation on the *Fintiv* analysis. As detailed in the Request, after the filing of the IPR petition here, Patent Owner brought a motion for summary judgment in the pending litigation based on assignor estoppel, seeking to preclude Petitioner from raising any invalidity defenses at trial. The motion remains pending. The Board never considered the impact of the assignor estoppel arguments on its *Fintiv* analysis, because Patent Owner neglected to mention them in its preliminary response and the Board did not allow Petitioner to be heard on this issue, as fully explained in

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Ex. 3100

the Request in connection with issues (1) and (2). The Director should also take this opportunity to address this novel legal question of how assignor estoppel impacts the analysis of the *Fintiv* factors.

Respectfully submitted,

/s/ Heidi L. Keefe

Heidi L. Keefe

Cooley LLP

Lead Counsel for Petitioner Vector Flow, Inc.

Attachments: Paper Nos. 9 and 10 filed 8/4/2023 and Exhibits 1013-1016

Patty Russell

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