

From: [Stein, Alexander B.](#)
To: [Director PTABDecision Review](#)
Cc: [z/VectorFlow](#); [HID-VectorFlow-IPR](#); [Russell, Patricia](#)
Subject: RE: IPR2023-00353 - Vector Flow v. HID Global Corporation - Petitioner's Request for Rehearing by the Director
Date: Thursday, August 10, 2023 12:24:21 PM

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Dear Director Vidal and members of the Advisory Committee,

Patent Owner requests a response to Petitioner's Request for Rehearing by the Director to address at least the following three issues.

1. *First*, Petitioner's Request for Rehearing (and the follow-up email to the Board below) (collectively the Request) fails to comply with the Revised Interim Director Review process by (i) introducing new evidence (new exhibits 1013-1016), and (ii) failing to submit a priority-ranked list of the issues raised in the Request. If the Request's substance is to be considered, then due process warrants affording Patent Owner an opportunity to address the impermissibly-submitted new evidence.
2. *Second*, Patent Owner feels it necessary to respond to the exaggerated claims of applicability of the institution decision here to all IPR proceedings. Petitioner already addressed *Fintiv* in its Petition at page 11, and assignor estoppel in its Petition at page 8—even stating that "Patent Owner's contentions regarding assignor estoppel have no applicability to IPR," which is inconsistent with Petitioner's changed position now that assignor estoppel is highly relevant to the IPR.
3. *Third*, Petitioner is wrong that the Request relates to "an important substantive issue" that is a "novel legal question of how assignor estoppel impacts the analysis of the *Fintiv* factors." Petitioner raised both *Fintiv* and assignor estoppel in its Petition and thus took advantage of their opportunity to brief these issues. To the extent Petitioner assumed it would be entitled to a pre-institution reply brief after having reviewed Patent Owner's preliminary response, such a tactic prejudices Patent Owner (see Preliminary Response at 18-19). A strategic risk that it would get a reply brief, taken by one Petitioner in one IPR, does not merit Director-level review.

Thank you for your consideration.

Respectfully submitted,

Alex Stein (Reg. No. 71,397), counsel for Patent Owner

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From: Russell, Patricia <patricia.russell@cooley.com>

Sent: Friday, August 4, 2023 4:37 PM

To: Director_PTABDecision_Review@uspto.gov

Cc: z/VectorFlow <zVectorFlow@cooley.com>; HID-VectorFlow-IPR <HID-VectorFlow-IPR@morganlewis.com>

Subject: IPR2023-00353 - Vector Flow v. HID Global Corporation - Petitioner's Request for Rehearing by the Director

[EXTERNAL EMAIL]

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 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

Office Hours: 11 a.m. – 7 p.m.

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