

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INNOSCIENCE (ZHUHAI) TECHNOLOGY COMPANY, LTD., AND
INNOSCIENCE AMERICA, INC.
Petitioner

v.

EFFICIENT POWER CONVERSION CORPORATION,
Patent Owner

Case No. IPR2023-01381
U.S. Patent No. 8,350,294

**PATENT OWNER'S REQUEST FOR AN EXTENSION OF TIME TO
REQUEST DIRECTOR REVIEW**

A Final Written Decision Determining All Claims Unpatentable and Granting Patent Owner’s Motion to Amend (“FWD”) was entered in this matter on March 18, 2025. Pursuant to 37 CFR § 42.75(c)(1), Patent Owner requests that the time for filing a Petition for Director Review be extended by 14 days, to and including May 1, 2025. This is Patent Owner’s first request and is timely under and 37 CFR § 42.71(d)(2). Good cause exists for the requested extension.

On February 28, 2025, the Office issued a directive rescinding its June 21, 2022, memorandum on “Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation.” The February 28 rescission memorandum significantly changed the legal landscape regarding when and why the PTAB should exercise its discretion to dismiss an IPR in favor of a parallel proceeding in another forum. Less than a month ago, on March 24, 2025—seven days after the FWD was entered in this matter—the Office issued Guidance regarding the scope of its February 28 memorandum, explaining that “the Board will apply the *Fintiv* factors” to determine whether an IPR should be dismissed as a matter of discretion “when there is a parallel proceeding at the International Trade Commission (“ITC”).” In the same Guidance, the Office also explained that “the Interim Procedure's rescission applies to any case . . . where a request for rehearing or Director Review of an institution decision was filed and remains pending,” and that “the Board will

consider timely requests for additional briefing on the application of the Interim Procedure's rescission on a case-by-case basis.”

Patent Owner believes that the present case presents a perfect example of an IPR that should have been dismissed as a matter of discretion under the Director’s March 25 Guidance. The same patents as addressed in the FWD were litigated in parallel—and earlier—proceedings in the International Trade Commission involving the same parties. *Certain Semiconductor Devices and Products Containing the Same*, Inv. No. 337-TA-1366 (Violation). The same prior art as at the PTAB was raised at the ITC, but the ITC ultimately reached a different conclusion: Three months before the FWD was entered, the Commission found two of the three claims that were later invalidated by the FWD to be both infringed and *not* invalid. Based on that finding, the ITC issued an exclusion order. *See* 89 Fed. Reg. 90051-53 (Nov. 14, 2024). In short, the present IPR involves the same parties, the same patents, and the same prior art that already were litigated in the ITC. However, two different branches of the same Administration reached different, irreconcilable conclusions about the same patent claims. The *earlier ITC decision* resulted in an exclusion order that currently prevents the Petitioner here from importing its infringing products from China into the United States. But Petitioner is now seeking to use *the PTAB’s later decision* to rescind the exclusion order—having already failed in its appeal of the ALJ’s Initial Determination to the

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Commission. *See Certain Semiconductor Devices and Products Containing the Same*, Inv. No. 337-TA-1366, USITC Doc. ID 848577 (Apr. 11, 2025) (Modification).

Good cause exists for the requested extension because this IPR should have been dismissed pursuant to the new guidelines. But the Office issued the new guidelines merely three weeks ago, and Patent Owner requires a small amount of additional time to consider the Guidance and develop its arguments in detail for submission to the Director.

Good cause also exists because the patent owner is bringing in new counsel to assess and present these issues, including Andrei Iancu of Sullivan & Cromwell LLP. Patent Owner's new counsel need sufficient time to familiarize itself with the relevant legal issues and record. An extension of time would better enable preparation of a Request that will be helpful to the Director.

Accordingly, Patent Owner respectfully requests that the time for filing a Request for Director Review be extended by 14 days, to and including May 1, 2025.

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Dated: April 17, 2025

Respectfully submitted,

/s/ Dipu Doshi

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CERTIFICATE OF SERVICE

The undersigned certifies that a true and correct copy of the foregoing
**PATENT OWNER'S REQUEST FOR AN EXTENSION OF TIME TO
REQUEST DIRECTOR REVIEW** is being served on counsel of record by
filing this document through the Patent Review Processing System, with a copy
served via electronic mail to the following email address, as authorized in the
Petition:

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Dated: April 17, 2025

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