

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FOIL BOARDING COMPANY, INC.

Petitioner,

v.

MHL CUSTOM, INC.

Patent Owner.

IPR2024-00086 (Patent 9,359,044 B2)

PETITIONER'S REPLY TO PRELIMINARY RESPONSE REGARDING FINTIV
FACTORS

On April 3, 2024, the Board *sua sponte* authorized additional briefing to address the *Fintiv* factors raised in Patent Owner’s Preliminary Response. The most relevant *Fintiv* factors show that the Board should institute.

1. *Fintiv* Factors 1, 3, 4 Favor Institution

Factor 1 favors institution because the parties have stipulated to a stay of the parallel proceeding and the Court has institute a stay of the litigation pending each of the requested IPR proceedings¹. On March 5, 2024, Defendant-Petitioner Foil Boarding Company, Inc. (“GetFoil”) filed a motion seeking a stay of the parallel litigation pending in the Northern District of Florida. On March 19, 2024, the parties filed a stipulation in which the parties requested that the Court stay the litigation as to each asserted patent while the Petition was pending institution and continuing upon institution of trial before the PTAB. The Court ordered the stay on March 21, 2024. *See* Exhibit 1024 (Stipulation and Order Staying Proceedings, ND-FL-3:22-cv-21258, D.E. 42).

Because the case has granted a stay related to the challenged patent, no parallel proceedings any potential concerns of inefficiency or conflicting decisions

¹ The Court also stayed the parallel litigation pending the *ex parte reexamination* instituted with respect to the ‘659 Patent.

are wholly abrogated. Accordingly, based solely on Factor 1, trial should be instituted.

Factor 3 favors institution because there has been nominal investment in the parallel proceeding, and the Petitioner was diligent in filing the Petition. No *Markman* hearing has been held in the case, and *Markman* briefing has been filed yet. To date, the only *Markman* related briefing that has been filed with the Court has been a Joint Claim Construction Statement and Chart on March 1, 2024. While fact discovery has begun and initial documents have been produced between the parties, no depositions have been noticed, expert reports are not yet due, and substantive motions are not yet due. This factor heavily supports institution. *See e.g. STMicroelectronics, Inc., v. Ocean Semiconductor LLC* IPR2021-01349, Paper 13 at 11 (PTAB Mar. 4, 2022); *DJI Europe B.V. v. Textron Innovations*, IPR2022-00163, Paper 11 at 11-12 (PTAB May 26, 2022) (Trial instituted when “fact discovery is in its early stages, with document production ongoing and depositions not yet underway, expert reports not yet due, and substantive motions practice is yet to come.”)

Factor 4 favors institution because Petitioner stipulates that, if the Board institutes this IPR, it will not pursue in the parallel proceeding the specific grounds raised in this IPR or any other ground that reasonable could have been raised in this IPR. *Sontera Wireless, Inc. v. Massimo Corp.*, IPR2020-01019, Paper 12 at

18-19 (PTAB Dec. 1, 2020). This obviates any concerns about potential overlap and heavily favors institution. *Id.* at 19 (explaining stipulation “weigh[ed] strongly in favor of not exercising discretion to deny institution.”)

2. Factors 2, 5, and 6 are Neutral

Factor 2 does not call for a discretionary denial. While the Court had anticipated that the case would be ready for trial in November 2024, the Court has since issued a stay in the case. Accordingly, the dates set by the Court will be pushed if trial is instituted, and this factor does not apply to the determination of the *Fintiv* factors. Factor 5 is also neutral, even though Petitioner and Patent Owner are the same parties in the district court case. *Protect Animals With Satellites v. Unpoint Sys., LLC*, IPR 2021-01483, Paper 11 at 17 (PTAB Mar. 4 2022). Patent Owner did not raise any other circumstances that might impact the Board’s exercise of discretions. Accordingly, Factor 6 is neutral.

Because *Fintiv* Factors 1, 3, and 4 heavily favor institution, and Factors 2, 5, and 6 are neutral regarding institution, Petitioner requests institution.

Respectfully Submitted,

/J. Hunter Adams/
J. Hunter Adams
Reg. No. 69,994

Exhibit	Description
1001	U.S. Patent No. 9,359,044 (“’044 Patent”)
1002	Declaration of Stefan Brizzolara, Ph.D.
1003	Certified English Translation of Evolo slutrapport (“Evoloreport”)
1004	Affidavit of Bjorn Lofgren Regarding Translation of EvoloReport
1005	Swedish-Language Version of Evolo slutrapport
1006	YouTube.com, <i>Evolo prototype run</i> [https://www.youtube.com/watch?v=a-_OCN50aWo&t=10s] (“Evoloprototypelrun”)
1007	Screenshot of EvoloPrototypelrun Page Information
1008	YouTube.com, <i>Evolo movie</i> [https://www.youtube.com/watch?v=zL9fO8tF118] (“Evolomovie”)
1009	Screenshot of EvoloMovie Page Information
1010	YouTube.com, <i>Test run – the new Torqeedo 4.0 R installed on Evolo!!!</i> [https://www.youtube.com/watch?v=fKOQ0JwQnjc] (“Evolotorqeedo”)
1011	U.S. Patent No. 6,443,786 (“Woolley”)
1012	U.S. Patent No. 4,020,782 (“Gleason”)
1013	U.S. Patent No. 8,290,636 (“Manning”)
1014	Torqeedo Motor Operating Manual for Torqeedo Cruise 2.0 S/L
1015	U.S. Patent No. 9,586,659 (“’659 Patent”)
1016	Prosecution History of ‘044 Patent
1017	Prosecution History of ‘659 Patent
1018	Declaration of Jakob Kutenkeuler
1019	Affidavit of Ingmarie Rohdin Regarding English Language Translation of Batnytt Magazine Article; Swedish Language Version of Batnytt; English Translation of Båtnytt Magazine Article (“Batnytt”)

Exhibit	Description
1020	Affidavit of Ingmarie Rohdin Regarding Translation of Batnytt Magazine Viewership Information for 2009; Swedish Language Version of Batnytt Viewership Information; English Language Translation of Batnytt Viewership Information (“BatnyttViewership”)
1021	Internet Archive Declaration of Nathaniel E Frank-White
1022	Screenshot of EvoloTorqeedo Page Information
1023	Claim Construction Order from <i>MHL CUSTOM, INC. v. WAYDOO USA, INC. and SHENZHEN WAYDOO INTELLIGENCE TECHNOLOGY CO., LTD</i> , C.A. No. 21-0091-RGA
1024	Stipulation and Order Staying Proceedings from <i>MHL CUSTOM, INC. v. FOIL BOARDING COMPANY, INC.</i> , No. 3:22-cv-21258