

From: [Trials](#)
To: [Ryan Richardson](#); [Maiorana, David M.](#); [Marlott, John A.](#); [Luchesi, Kenneth](#); [Breetz, Robert M.](#); [Nightingale, Joshua R.](#); [Daniel E. Yonan](#); [Kyle E. Conklin](#); [Christopher O'Brien](#)
Cc: [Trials](#)
Subject: RE: Ecto World & SV3 v. RAI Strategic Holdings (IPR2024-01280) // Recent Supplemental Authority
Date: Tuesday, June 17, 2025 11:33:00 AM
Attachments: [image001.png](#)
[image002.png](#)

Counsel,

The parties' positions are noted, and further briefing is not necessary at this time.

Regards,

Franchesca I. Alicea Villanueva
Supervisory Paralegal
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Ryan Richardson <RRICHARDSON@sternekessler.com>
Sent: Monday, June 16, 2025 4:58 PM
To: Trials <Trials@USPTO.GOV>
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Subject: Ecto World & SV3 v. RAI Strategic Holdings (IPR2024-01280) // Recent Supplemental Authority

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Your Honors,

Last Thursday (June 12, 2025), Acting Director Stewart issued a Decision Denying Patent Owner's Request for Discretionary Denial in *Microsoft Corp. v. Partec Cluster Competence Center GmbH*, IPR2025-00318, Paper 9 (PTAB Jun. 12, 2025), which Petitioner believes to be highly-relevant to the two issues that were remanded to the Board in IPR2024-01280. These issues are: (1) the Board's exercise of discretion under 35 U.S.C. § 325(d); and (2) whether denial is appropriate under *Fintiv* based on the parallel ITC investigation. Both of these issues were specifically addressed in the Decision in IPR2025-00318 last Thursday. In relevant part, the Decision found:

Ex. 3001
IPR2024-01280

“Although the scheduled district court trial is set to precede the expected final written decision due date by a month (DD Opp. 14), discretionary denial of institution is not warranted because of Petitioner’s showing of material error during patent examination [under § 325(d)]. Ordinarily, a scheduled district court trial date that precedes the date projected for a Board final written decision weighs in favor of exercising discretion to deny the Petition. Here, however, the Petitioner appears to show a material error by the Office [under § 325(d)] and it is an appropriate use of Office resources to review the potential error.”

Should the Board wish to hear from the parties on how this decision impacts the pending papers and upcoming institution decision, Petitioner is generally available for a call at any point this week, and is also available to submit a short written response if preferred.

Petitioner conferred with Patent Owner regarding this email, and Patent Owner provided the following responses:

Patent Owner opposes Petitioner’s request. In *Microsoft*, the Director instituted IPR notwithstanding a district court trial set to precede the final written decision “because of Petitioner’s showing of material error during patent examination.” IPR2025-00318, Paper 9 at 3. *Microsoft* is irrelevant because Petitioner here has not shown material error. All of the petition’s grounds are plainly deficient (see Papers 9, 12, and 14), and the size of Patent Owner’s IDS does not by itself establish material error. Paper 13 (Stewart Order) at 6-7. More relevant is the decision in *Klein Tools, Inc. v. Milwaukee Electric Tool Corp.*, IPR2024-01400 (Paper 22) (PTAB Jun. 9, 2025), where the Director vacated institution in light of the advanced stage and significant overlap with an ITC investigation—circumstances that are present here. Should the Board wish to have a call, Patent Owner can be available at the Board’s convenience.

Best,
Ryan Richardson
Counsel for Petitioner, Ecto World, LLC and SV3, LLC



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