

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

DECENT ESPRESSO INTERNATIONAL LTD.,
Petitioner,

v.

DUVALL ESPRESSO IP ENFORCEMENT, LLC,
Patent Owner

Case IPR2024-01492

U.S. Patent No. 10,772,456

**PETITIONER’S NOTICE TO BOARD REGARDING
FINTIV FACTORS AND STAY OF LITIGATION**

Mail Stop “PATENT BOARD”
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Petitioner submits this notice in view of the United States Patent and Trademark Office's ("USPTO") withdrawal of the June 21, 2022 memorandum titled "Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation" (the "MEMO").

Petitioner respectfully brings the Board's attention to Exhibit 1025, filed herewith. Exhibit 1025 is an order staying the district court litigation captioned *Duvall Espresso IP Enforcement LLC v. Decent Espresso International Ltd.*, case no. 23-81246-CV-MIDDLEBROOKS, in the United States District Court for the Southern District of Florida.

Exhibit 1025 was entered by the district court on October 23, 2024, after the petition in this proceeding was filed. Thus, Petitioner could not bring the stay to the Board's attention at the time of filing the petition. Petitioner believes that the stay order has become more relevant in view of the USPTO's withdrawal of the MEMO.

As noted in Exhibit 1025, "This matter is STAYED until the U.S. Patent & Trademark Office completes its review of Defendant's IPR Petitions, relating the U.S. Patent No. 10,772,456 and U.S. Patent No. 11,576,524." Ex. 1025 p. 4. Thus, no district court proceedings or trial will occur before the Board issues a final decision in this proceeding.

Respectfully submitted,

By: /s/ Perry S. Clegg/

Perry S. Clegg, Reg. No. 65,304

Appendix of Exhibits for IPR2024-01492 - U.S. Patent 10,772,456

Exhibit	Description
1001	U.S. Patent No. 10,772,456
1002	Declaration of Ian Tinkler, dated September 26, 2024
1003	European Patent Publication EP 2 612 577 A1 (“Buttiker”)
1004	Translation of European Patent Publication EP 2 612 577 A1
1005	Declaration Certifying Translation of European Patent Publication EP 2 612 577 A1
1006	U.S. Patent Application Publication No. 2011/0097454A1 (“Coccia”)
1007	File History for U.S. Pat. App. Serial No. 16/383,607
1008	U.S. Patent No. 8,973,487 B2 (collectively with Ex1009, “Startz”)
1009	U.S. Patent Application Publication No. 2012/0291634A1 (collectively with Ex1008, “Startz”)
1010	U.S. Patent Application Publication No. 2014/0053734A1 (“Santi”)
1011	International Publication No. WO2012/146660A1
1012	U.S. Patent Application Publication No. 2012/0171332A1 (“Lai”)
1013	International Publication No. WO2011/151703A2 (“Majer”)
1014	International Publication No. WO2011/158131A1 (“Porzio”)
1015	File History for U.S. Pat. App. Serial No. 61/742,688
1016	Patent Owner Infringement Contention Pleading
1017	Patent Owner Claim Chart for 456 Patent
1018	U.S. Patent Application Publication No. 2006/0042470A1 (“Anson”)
1019	European Patent Publication 1 986 530 B1 (“Aigner”)
1020	Translation of European Patent Publication 1 986 530 B1
1021	Declaration Certifying Translation of European Patent Publication 1 986 530 B1
1022	U.S. Patent Application Publication No. 2008/0050480 (“Majer II”)
1023	International Publication WO/2013/003891A1 (“White”)
1024	Definition of “inhibit”
1025	District Court Order Staying Case, dated October 23, 2024

CERTIFICATE OF SERVICE

I hereby certify that on March 26, 2025, I caused a true and correct copy
of the foregoing materials:

- Petitioner's Notice to Board Regarding *Fintiv* Factors and Stay of Litigation
- Exhibit 1025

to be served via electronic mail on the following attorneys of record for Patent
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Respectfully submitted,

By: /s/ Perry S. Clegg/

Perry S. Clegg, Reg. No. 65,304