

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GREEN REVOLUTION, INC.
Petitioner,

v.

MIDAS GREEN TECHNOLOGIES, LLC,
Patent Owner.

CASE: IPR2025-00196
U.S. PATENT NO. 10,405,457

PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW

TABLE OF CONTENTS

	Page(s)
Contents	
I. INTRODUCTION	1
II. FACTUAL BACKGROUND.....	4
III. LEGAL STANDARD FOR DIRECTOR REVIEW	8
IV. ARGUMENT	8
A. The Board Erred by Placing Significant Weight on Factor 4	8
B. The Board Erred in Its Evaluation of the Merits Under Factor 6	10
C. Rebalancing the <i>Fintiv</i> Factors Supports Denial of Institution	11
V. CONCLUSION.....	15

TABLE OF AUTHORITIES

Page(s)

Cases

<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 11	<i>passim</i>
<i>Eunsung Global Corp. v. Hydrafacial LLC</i> , IPR2024-01491, Paper 17, 2025 WL 1090383 (PTAB Apr. 11, 2025)	12
<i>Impinj, Inc. v. NXP USA, Inc.</i> , No. 6:21-CV-00530-ADA, 2023 WL 7476358 (W.D. Tex. May 18, 2023)	13
<i>Ingenico Inc. v. IOENGINE, LLC</i> , 136 F.4th 1354 (Fed. Cir. 2025)	<i>passim</i>
<i>Motorola Solutions, Inc. v. Stellar, LLC</i> , IPR2024-01205, Paper 19 (USPTO Dir. Mar. 28, 2025)	4, 15
<i>Solus Advanced Materials Co. v. SK Nexilis Co.</i> , IPR2024-01460, Paper 14, 2025 WL 1171851 (PTAB Apr. 22, 2025)	12
<i>Sotera Wireless, Inc. v. Masimo Corp.</i> , IPR2020-01019, Paper 12	<i>passim</i>

Statutes

35 U.S.C. § 314(a)	4, 5
35 U.S.C. § 315(e)(2)	2, 9

LIST OF EXHIBITS

Exhibit No.	Description
Ex-2001	Docket Navigator research showing time to trial statistics for Judge Alan D. Albright from Jan. 1, 2021 to March 15, 2025
Ex-2002	Lex Machina research showing time to trial statistics for Judge Alan D. Albright for patent cases from Jan. 1, 2020 to March 17, 2025
Ex-2003	Court's Preliminary Constructions, <i>Midas Green Techs., LLC v. Green Revolution Cooling, Inc.</i> , No. 6:24-cv-00166 (W.D. Tex. Feb. 20, 2025)
Ex-2004	Claim Construction Hearing Transcript, <i>Midas Green Techs., LLC v. Green Revolution Cooling, Inc.</i> , No. 6:24-cv-00166 (W.D. Tex. Feb. 21, 2025)
Ex-2005	Docket Report for <i>Midas Green Techs. LLC v. Green Revolution Cooling, Inc.</i> , Case No. 6:24cv166 (W.D. Tex.), as of March 10, 2025.
Ex-2006	Green Revolution Cooling, Inc.'s Disclosure of Prior Art and Preliminary Invalidity Contentions, <i>Midas Green Techs. LLC v. Green Revolution Cooling, Inc.</i> , Case No. 6:24cv166 (W.D. Tex. Oct. 7, 2024)
Ex-2007	Plaintiff Midas Green Technologies, LLC's First Set of Request for Production, <i>Midas Green Techs. LLC v. Green Revolution Cooling, Inc.</i> , Case No. 6:24cv166 (Feb. 4, 2025)
Ex-2008	Plaintiff Midas Green Technologies, LLC's First Set of Interrogatories, <i>Midas Green Techs. LLC v. Green Revolution Cooling, Inc.</i> , Case No. 6:24cv166 (Feb. 4, 2025)
Ex-2009	Plaintiff Midas Green Technologies, LLC's Second Set of Interrogatories, <i>Midas Green Techs. LLC v. Green Revolution Cooling, Inc.</i> , Case No. 6:24cv166 (Feb. 18, 2025)

Exhibit No.	Description
Ex-2010	Plaintiff Midas Green Technologies, LLC's Third Set of Interrogatories, <i>Midas Green Techs. LLC v. Green Revolution Cooling, Inc.</i> , Case No. 6:24cv166 (Feb. 24, 2025)
Ex-2011	Plaintiff Midas Green Technologies, LLC's Fourth Set of Interrogatories, <i>Midas Green Techs. LLC v. Green Revolution Cooling, Inc.</i> , Case No. 6:24cv166 (Feb. 27, 2025)
Ex-2012	Defendant Green Revolution Cooling, Inc.'s First Set of Requests for Production of Documents, <i>Midas Green Techs. LLC v. Green Revolution Cooling, Inc.</i> , Case No. 6:24cv166 (March 10, 2025)
Ex-2013	Defendant Green Revolution Cooling, Inc.'s First Set of Interrogatories, <i>Midas Green Techs. LLC v. Green Revolution Cooling, Inc.</i> , Case No. 6:24cv166 (March 12, 2025)
Ex-2014	Plaintiff Midas Green Technologies, LLC's Notice of Deposition for Jason Mayo, <i>Midas Green Techs. LLC v. Green Revolution Cooling, Inc.</i> , Case No. 6:24cv166 (March 11, 2025)
Ex-2015	Plaintiff Midas Green Technologies, LLC's Notice of Deposition for Paul Dierkes, <i>Midas Green Techs. LLC v. Green Revolution Cooling, Inc.</i> , Case No. 6:24cv166 (March 11, 2025)
Ex-2016	Plaintiff Midas Green Technologies, LLC's Notice of Third-Party Subpoena – Mark Tlapak, <i>Midas Green Techs. LLC v. Green Revolution Cooling, Inc.</i> , Case No. 6:24cv166 (March 11, 2025)
Ex-2017	Subpoena to Testify at a Deposition to Alex McManis, <i>Midas Green Techs. LLC v. Green Revolution Cooling, Inc.</i> , Case No. 6:24cv166 (March 14, 2025)
Ex-2018	Subpoena to Testify at a Deposition to Luis Fautsch, <i>Midas Green Techs. LLC v. Green Revolution Cooling, Inc.</i> , Case No. 6:24cv166 (March 14, 2025)

Exhibit No.	Description
Ex-2019	Plaintiff Midas Green Technologies, LLC's Notice of Third-Party Subpoena – Mark Garnett, <i>Midas Green Techs. LLC v. Green Revolution Cooling, Inc.</i> , Case No. 6:24cv166 (March 11, 2025)
Ex-2020	Docket Navigator research showing dispositions of Motions to Stay Pending IPR before Judge Alan D. Albright from 2019 to 2025
Ex-2021	Joint Claim Construction Statement, <i>Midas Green Techs., LLC v. Green Revolution Cooling, Inc.</i> , No. 6:24-cv-00166 (W.D. Tex. Feb. 20, 2025)

Pursuant to 37 CFR § 42.75, Patent Owner, Midas Green Technologies, Inc. (“Patent Owner”) respectfully requests Director Review of the Board’s decision Granting Institution of *Inter Partes* Review of U.S. Patent 10,405,457. *See* Paper 7 (“Decision”).

I. INTRODUCTION

The Decision rests on a misapplication of the *Fintiv*¹ framework, especially in view of recent developments of policy from the USPTO² and law from the Federal Circuit.³ The Board acknowledged that three *Fintiv* factors (Factors 2, 3, and 5) favor Patent Owner and that two (Factors 1 and 6) marginally favor Petitioner, but found that under Factor 4—overlap of issues—Petitioner’s *Sotera*⁴ stipulation was

¹ *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5–6 (PTAB Mar. 20, 2020) (precedential).

² Guidance on USPTO’s rescission of “Interim Procedure for Discretionary

Denials in AIA Post-Grant Proceedings with Parallel District Court

Litigation,” March 24, 2025 (available at www.uspto.gov/sites/default/files/documents/guidance_memo_on_interim_procedure_rescission_20250324.pdf) (hereinafter “March 2025 USPTO *Fintiv* Memo”).

³ *Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354 (Fed. Cir. 2025).

⁴ *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (PTAB

“highly relevant” (Decision at 15 and 18) and, therefore, favored institution. *See id.* at 9-18. The Board relied heavily on Factor 4 to tip the balance toward institution. *Id.* at 18. But that reliance was misplaced and erroneous.

The Board gave determinative weight to Petitioner’s *Sotera* stipulation, finding it sufficient to eliminate meaningful overlap between the IPR and the parallel district court litigation. *See id.* at 15, 16, and 18. However, that assumption no longer holds. In *Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354 (Fed. Cir. 2025), the Federal Circuit made clear that IPR estoppel under 35 U.S.C. § 315(e)(2) does not extend to system prior art, even when that art is cumulative of printed publications asserted in the IPR. *Ingenico*, 136 F.4th at 1365–66. Rather, IPR estoppel “precludes a petitioner from asserting grounds that were raised or reasonably could have been raised during an IPR.” *Id.* Consequently, substantial overlap remains here: the district court will still adjudicate the validity of the challenged claims over the CarnotJet product (a system) that is cumulative of prior art in the IPR grounds, particularly Best-2012 (Ex-1006), in combination with Osada (Ex-1005).

These legal developments arrive alongside an important policy shift. In its March 2025 USPTO *Fintiv* Memo, the USPTO clarified that *Sotera* stipulations are

Dec. 1, 2020) (precedential as to § II.A).

not dispositive when assessing discretionary denial under *Fintiv*.⁵ This represents a marked departure from past Board practice, where such stipulations frequently compelled institution regardless of other factors.⁶ When *Ingenico* and the USPTO’s updated policy are read together, they present a critical inflection point for discretionary denial: significant overlap between proceedings may persist despite a *Sotera* stipulation, and that stipulation alone no longer warrants overriding other factors. That guidance is directly relevant here.

The Board also erred in its analysis of Factor 6. Although it concluded the Petition warranted institution, its analysis of the merits was flawed—most notably in its treatment of the independent claims’ limitation requiring that the dielectric fluid be dispensed “substantially uniformly upwardly through each appliance slot.” Decision at 43. The Board accepted an inference from “temperature uniformity” to “flow uniformity” without explanation or evidentiary support. *Id.* That inference lacks scientific basis and finds no support in the Petition or expert declaration. No reference relied upon by the Petition teaches or suggests fluid that is “dispensed substantially uniformly upwardly through each appliance slot,” as claimed.

⁵ March 2025 USPTO *Fintiv* Memo, *supra* note 2, at 2–3.

⁶ See *Samsung Elecs. Co. v. Mojo Mobility Inc.*, 2024 WL 87819 at *21 (PTAB Jan. 8, 2024) (“[A] *Sotera* stipulation obviates the need for any *Fintiv* factor weighing”).

A stay is also unlikely given the parties' competitive relationship. Consequently, with the overlap intact, the technical weakness of the merits apparent, and a trial date approaching quickly after substantial investment by the parties and court, the *Fintiv* factors weigh against institution. The Director has previously reversed institution in comparable circumstances. *See Motorola Solutions, Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 (USPTO Dir. Mar. 28, 2025).

Given that the March 2025 USPTO *Fintiv* Memo confirms that *Sotera* stipulations are not dispositive—and *Ingenico* confirms that overlap persists despite them—the Board's heavy reliance on the stipulation contravenes both current law and policy. This proceeding presents an important opportunity for the Director to provide guidance on how those developments should inform the *Fintiv* analysis going forward.

Patent Owner respectfully requests that the Director grant review, vacate the institution decision, and deny institution under § 314(a).

II. FACTUAL BACKGROUND

Patent Owner⁷ and Petitioner⁸ are competitors, both based in Austin, Texas, that design, develop, manufacture and sell liquid immersion cooling equipment that

⁷ Patent Owner currently conducts business as "Midas Immersion Cooling."

⁸ Petitioner currently conducts business as "GRC."

are used to cool electrical appliances, such as computer servers in data centers.

The challenged patent, U.S. Patent No. 10,405,457, discloses an immersion cooling system designed to enhance the cooling of electrical appliances with dielectric fluid. Ex-1001, 3:36-4:4. The system is notable for its use of a plenum structure 36 (positioned adjacent the bottom of the tank) to dispense cooled dielectric fluid substantially uniformly upwardly through each appliance slot, and a weir 22 to recover heated dielectric fluid into the dielectric fluid recovery reservoir 42. *Id.* Independent claims 1, 6 and 11 recite a plenum that is adapted “to dispense the dielectric fluid substantially uniformly upwardly through each appliance slot...” *Id.* at 9:49-51, 10:32-34, 11:6-9.

The Board balanced the six *Fintiv* factors to assess whether to discretionarily deny institution under 35 U.S.C. § 314(a) in view of the parallel district court litigation. Decision at 9-18. The Board weighed the factors as follows:

- **Factor 1** – The Board found this factor “marginally” favors Petitioner, noting that the district court denied Petitioner’s prior stay request, stating that it “will consider” a renewed stay motion if the IPR is instituted. Decision at 10.
- **Factor 2** – The Board found this factor favors Patent Owner, noting that the projected trial date is April or May 2026, which pre-dates the statutory deadline for the final written decision (May 23, 2026) by about one month. *Id.* at 12. The trial pre-dates the statutory deadline for the final written decision by

approximately 3.5 months if the scheduled February 2, 2026 trial date holds. Ex-1014, 5.

- **Factor 3** – The Board found this factor favors Patent Owner, stating that “substantial work has been expended” in the district court litigation, including a *Markman* hearing, a claim construction order, briefing on a motion to stay, infringement and invalidity contentions, and commencement of fact discovery. Decision at 12-14.⁹

- **Factor 4** – The Board found this factor “highly” favors Petitioner because of Petitioner’s *Sotera* stipulation, which the Board found to be “highly relevant” in its holistic balancing of the *Fintiv* factors. *Id.* at 14-18. The Board credited Petitioner’s *Sotera* stipulation even though in the parallel district court litigation Petitioner is relying on product prior art (the “CarnotJet” product) that embodies one of the references (Best-2012, Ex-1006) used in the Petition. *See* Decision at 6 (Ground 2).

- **Factor 5** – The Board found this factor favors Patent Owner, as both proceedings involve the same parties. *Id.* at 15-16. In that connection, the parties

⁹ The Board referred to the district court’s claim constructions as “preliminary.” *See* Decision at 12. In fact, the district court adopted those preliminary constructions as the court’s actual constructions. *See* Ex-2004 at 15:8-9, 23:16-17, 33:14-23.

are competitors. *See e.g.*, Petition (Paper 2) at 5, note 4; Ex-1012 at 1-2, ¶ 2; *id.* at 14, ¶ 98.

- **Factor 6** – The Board found this factor weighs against discretionary denial because Petitioner “sufficiently established a likelihood of showing at trial that at least one claim is unpatentable as alleged.” Decision at 18. The Board declined to characterize the merits as compelling. In fact, they are flawed.

The most glaring flaw in the Board’s merits analysis was its treatment of the “substantially uniformly upwardly” flow limitation found in each independent claim. The Board relied on references in Best-2008 to “*temperature* uniformity” to support a finding that the coolant flowed uniformly upward through each appliance slot. *See* Decision at 43. But uniform temperature is not a proxy for uniform flow—especially not for flow through multiple, discrete slots. Neither the Petition nor Petitioner’s expert explained how temperature uniformity equates to, or even suggests, the specific flow pattern recited in the claims. Best-2008’s disclosures of “flow augmentation devices” (e.g., nozzles, fans) only further undermine any suggestion of uniformity, as these devices are designed to vary (that is, “augment”) flow rates. *See* Ex-1004 at ¶ 124 (“The controller may adjust the flow of the cooled liquid coolant through each of the valves 918 to adjust the volume of the flow of the cooled liquid coolant among the different server racks 310”). The testimony of Petitioner’s expert, Dr. Dahm, on this point was conclusory and lacked substantive

analysis. *See* Ex-1003 at ¶¶ 197–200.

In sum, the Board found that three factors favored Patent Owner (Factors 2, 3, and 5) and three favored Petitioner (Factors 1, 4 and 6). But the Board’s analysis of Factors 1, 4, and 6 each contains material error. The Board discounted the relevance of the parties’ competitor status under Factor 1, gave outsized weight to Petitioner’s *Sotera* stipulation under Factor 4 despite *Ingenico*’s confirmation that overlap remains, and overestimated the merits under Factor 6 despite serious analytical gaps. When properly rebalanced, the *Fintiv* factors support denial of institution.

III. LEGAL STANDARD FOR DIRECTOR REVIEW

“Requests for Director Review of a Board’s decision on institution ... shall be limited to decisions presenting (a) an abuse of discretion, (b) important issues of law or policy, (c) erroneous findings of material fact, or (d) erroneous conclusions of law.” *Director Review Process*, (last modified May 23, 2025) (available at www.uspto.gov/patents/ptab/decisions/director-review-process).

IV. ARGUMENT

A. The Board Erred by Placing Significant Weight on Factor 4

The Board’s decision to institute review relied heavily on *Fintiv* Factor 4—overlap of issues between the IPR and district court litigation. The Board emphasized Petitioner’s *Sotera* stipulation and concluded that it mitigated any overlap, weighing this factor in favor of institution. Decision at 14–16. The Board,

however, overestimated the stipulation’s effect, particularly in light of the Federal Circuit’s recent decision in *Ingenico*, which confirms that a *Sotera* stipulation will not eliminate all meaningful overlap between parallel proceedings. The interplay between *Sotera* stipulations and the Federal Circuit’s *Ingenico* decision raise important policy issues in assessing discretionary denial.

In fact, the March 2025 USPTO *Fintiv* Memo confirms that *Sotera* stipulations are not dispositive. The USPTO rescinded its prior Interim Procedure for discretionary denial under *Fintiv*, stating that while a *Sotera* stipulation remains “highly relevant,” it “is not dispositive by itself.” 2025 USPTO *Fintiv* Memo at 2–3. The Board must instead conduct a “holistic analysis” in which the stipulation is one of several considerations. *Id.* That policy shift recognizes the potential for real-world overlap and aligns with the *Ingenico* court’s legal holding that estoppel under § 315(e)(2) does not extend to system art. Together, the USPTO’s policy and the Federal Circuit’s decision confirm that *Sotera* stipulations do not automatically negate meaningful overlap.

In *Ingenico*, the Federal Circuit held that IPR estoppel under § 315(e)(2) does not apply to system prior art—even where that system art is cumulative of the printed publications in the IPR grounds. *Ingenico*, 136 F.4th at 1365-66. Consequently, a petitioner may still rely in district court litigation on the same underlying subject matter (e.g., a system or product like the CarnotJet product) that corresponds to prior

art asserted in the IPR (such as here Best-2012, Ex-1006), so long as it is presented under a different legal basis—such as prior use or sale.

This limitation on estoppel leaves substantial room for duplication between district court litigation and IPR proceedings, even where the petitioner has executed a *Sotera* stipulation. That is the situation here. *See* Ex-1016 (Petitioner’s *Sotera* stipulation). If the IPR proceeds, the Board will consider whether the challenged claims would have been obvious over Best-2012 in combination with other references. *See* Decision at 6 (Ground 2). Meanwhile, the district court will consider whether the claims are obvious over the CarnotJet product—which is cumulative of Best-2012—in combination with other references. *See* Ex-2006 at 100–130 (Ex. A2 thereto). The *Ingenico* decision confirms the overlap is real. The Board’s reliance on Petitioner’s *Sotera* stipulation to negate overlap was therefore misplaced and Factor 4 cannot bear the determinative weight the Board assigned it.

B. The Board Erred in Its Evaluation of the Merits Under Factor 6

The Board found that Factor 6—other circumstances, including the merits—favors institution because Petitioner “sufficiently established a likelihood of showing at trial that at least one claim is unpatentable.” Decision at 18. However, the Board expressly declined to characterize the merits as compelling. That assessment, even if credited, cannot outweigh the strong showing under Factors 2 and 3, and the weakened status of Factor 4. More importantly, the merits were not

adequately assessed.

The most conspicuous error in the Board’s merits analysis concerns the independent claims’ limitation requiring that the plenum “dispense the dielectric fluid substantially uniformly upwardly through each appliance slot.” Ex-1001 at 9:49–51, 10:32–34, 11:6–9. The Board relied on generalized references in Best-2008 to “temperature uniformity” to infer that the dielectric fluid flows uniformly through each appliance slot in Best-2008. Decision at 43. This reasoning is flawed. Uniform temperature is not synonymous with uniform flow, especially not with respect to flow distributed across multiple, discrete appliance slots. The Board did not identify any explanation from Petitioner or its expert connecting temperature uniformity to the claim’s required flow pattern. Indeed, Petitioner’s expert merely recited passages from Best-2008 without analysis or modeling. *See* Ex-1003, ¶¶ 197–200. Meanwhile, Best-2008’s disclosures of “flow augmentation devices,” such as fans or nozzles, militate against a finding of uniform flow, as those devices are designed to create differential velocities. Ex-1004, ¶ 124.

The Board’s failure to engage with these technical shortcomings undermines its conclusion that the merits support institution. This is not the only deficiency in the merits analysis. Accordingly, Factor 6 cannot support institution.

C. Rebalancing the *Fintiv* Factors Supports Denial of Institution

With Factor 4 weakened by the limited scope of IPR estoppel clarified in

Ingenico, and with the merits analysis under Factor 6 flawed, the remaining *Fintiv* factors take on greater significance. In particular, Factors 2 and 3 strongly favor denial of institution and warrant greater probative weight.

Factor 2 – The Board found this factor favored Patent Owner, noting that trial was scheduled approximately one to three-and-a-half months before the anticipated final written decision. Decision at 10-12.¹⁰ The Board has denied institution with similar time gaps, even with a *Sotera* stipulation. See *Eunsung Glob. Corp. v. Hydrafacial LLC*, IPR2024-01491, Paper 17 at 11-17, 2025 WL 1090383 at *3-7 (PTAB Apr. 11, 2025) (institution denied where ITC trial approximately four months before projected final written decision date and with *Sotera* stipulation); *Solus Advanced Materials Co. v. SK Nexilis Co.*, IPR2024-01460, Paper 14, 2025 WL 1171851 (PTAB Apr. 22, 2025) (district court trial less than six months before projected statutory deadline to issue a final written decision and with *Sotera* stipulation).

¹⁰ The time gap is approximately three-and-a-half months as measured from the currently scheduled trial start date (Feb. 2, 2026) to one year from the institution decision (May 23, 2026). The time gap is approximately one month if the trial is projected to start in April 2026 based on median time-to-trial statistics. Decision at 10-12.

Factor 3 – The Board correctly found that this factor favors Patent Owner, as “substantial work has been expended” by the parties in the district court litigation, including, as of the date of Patent Owner’s preliminary response, a *Markman* hearing, a claim construction order, briefing on a motion to stay, infringement and invalidity contentions, and commencement of fact discovery. Decision at 12-14. That investment has increased since Patent Owner’s preliminary response.

Factor 1 – The Board found this factor “marginally” favored Petitioner, particularly because the Board speculated that the district court “is likely to at least consider granting a stay if it becomes ‘appropriate’....” *Id.* at 9-10. But the district court did not say that it is likely to consider favorably a renewed stay request; it merely found that a stay in light of Petitioner’s initial stay request was “not appropriate at this junction” *Id.* at 9. In fact, even if the IPR is instituted, a stay is unlikely in the district court given the direct competitor dynamic between the parties. *See Impinj, Inc. v. NXP USA, Inc.*, No. 6:21-CV-00530-ADA, 2023 WL 7476358, at *2 (W.D. Tex. May 18, 2023) (“As competitors, NXP faces a nearly inherent prejudice in granting a stay because ‘the longer other ‘prominent players’ in the market ... continue to benefit from [NXP’s] inventions without attribution, the more customers and recognition [NXP] will lose.’”) (quoting *Ravgen, Inc. v. Lab. Corp. of Am. Holdings*, W-20-CV-00969-ADA, 2022 WL 4240937, at *2 (W.D. Tex. Aug. 16, 2022)). The Board’s Decision at page 9 acknowledges that the Patent

Owner provided statistical evidence to show that the district court is unlikely to grant a stay of proceedings. Yet, the Decision seemingly fails to weigh that evidence. *See* Decision at 10 (“We decline to guess as to how the court in the related litigation will decide any future request for a stay.”) Thus, Factor 1 should favor Patent Owner and does not even marginally favor Petitioner.

Factor 5 – This factor favors Patent Owner, as both proceedings involve the same parties. Decision at 16-17.

Factor 6 – While the Board found this factor favors Petitioner based on its assessment of the merits of the Petition, it did so without identifying the grounds as compelling and without grappling with significant flaws in Petitioner’s obviousness arguments. In particular, the Board relied on inferences about “temperature uniformity” to satisfy the claim limitation of “substantially uniform upward flow” (*see supra* Section B), a conclusion unsupported by the cited reference and by Petitioner’s own expert. The flawed merits analysis further weakens any justification for institution.

On balance, the *Fintiv* factors favor denial. Factors 2, 3, and 5 weigh in Patent Owner’s favor. The Board overestimated the significance of Petitioner’s *Sotera* stipulation under Factor 4 as significant overlap will persist between the district court and IPR proceedings. The Board’s merits analysis was flawed and Factor 1 is either neutral or also favors Patent Owner given that a stay of the district court litigation is

unlikely even if the IPR is instituted.

In that connection, the Director’s decision in *Motorola Solutions, Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 (USPTO Dir. Mar. 28, 2025) is instructive. In *Motorola*, the Director vacated the Board’s decision instituting the IPRs because the Board “did not give enough weight to the investment in the parallel proceeding and gave too much weight to Petitioner’s *Sotera* stipulation ... and its potential to reduce overlap with the issues raised in the parallel proceeding.” *Id.* at 2 (footnote omitted). Analogously here, the Board erred in its analysis of Factors 1, 3 and 4, and in its overall weighing of the *Fintiv* factors. Significantly, as shown by the *Ingenico* decision, Petitioner’s *Sotera* stipulation will not significantly reduce the overlap between district court and IPR proceedings. Therefore, just as in *Motorola*, Director review is warranted to correct the Board’s errors and to ensure consistent application of the *Fintiv* framework.

V. CONCLUSION

For the foregoing reasons, Patent Owner respectfully requests that the Director grant Director Review, order that the Board’s Decision granting institution be vacated, and further order that the Petition be denied and that no trial is instituted.

Dated: June 6, 2025

Respectfully submitted,

By: /Brian P. Bozzo/
Brian P. Bozzo (Reg. No. 77,190)
brian.bozzo@klgates.com

K&L Gates LLP
210 Sixth Avenue
Pittsburgh, Pennsylvania 15222
Tel. 412-355-6500

Counsel for Patent Owner

CERTIFICATION OF SERVICE UNDER 37 C.F.R. § 42.6(e)(4)

I hereby certify that on June 6, 2025, I caused a true and correct copy of the foregoing to be served on the following counsel for Petitioner by electronic mail to the following email address:

Heath J. Briggs
Ashley Moore
Stephen M. Ullmer
Julie P. Bookbinder
Greenberg Traurig, LLP
1144 15th St. Suite 3300
Denver, CO 80202
Telephone: 303-685-7418
Facsimile: 720-904-6118
Email: BriggsH@gtlaw.com
Email: Ashley.Moore@gtlaw.com
Email: UllmerS@gtlaw.com
Email: bookbinderj@gtlaw.com

By: /Brian P. Bozzo/
Brian P. Bozzo (Reg. No. 77,190)
brian.bozzo@klgates.com

K&L Gates LLP
210 Sixth Avenue
Pittsburgh, Pennsylvania 15222
Tel. 412-355-6500

Counsel for Patent Owner