

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

GREEN REVOLUTION COOLING, INC.,
Petitioner

v.

MIDAS GREEN TECHNOLOGIES, LLC,
Patent Owner.

Patent No. 10,405,457 to Boyd, et al.

IPR Case No.: IPR2025-00196

PETITIONER'S AUTHORIZED RESPONSE
TO DIRECTOR REVIEW REQUEST

Patent Owner's ("PO") Director Review Request ("Request") purportedly seeks guidance on applying recent PTO guidance relating to *Sotera* stipulations in view of a recent Federal Circuit decision. *See* Paper 9. PO's Request omits key facts, mischaracterizes the record, and should be denied.

PO submitted its POPR on March 19, 2025, relying on "the Office's recent rescission of its June 2022 memorandum regarding *Sotera*-type stipulations" in its *Fintiv* factor 4 analysis. (Paper 6 at 63.) Though the Federal Circuit's *Ingenico* decision issued on May 7, 2025, PO did not inform the Board of its alleged relevance. The Institution Decision ("ID") subsequently issued on May 23, 2025.

PO contends that the Board erroneously weighed *Fintiv* factor 4 in view of the *Ingenico* decision and factor 6 in view of the merits. PO further contends that, *if* factor 4 received less weight, *and* any of factors 1, 3, or 6 were reevaluated, *and* all factors re-weighed, *then* the IPR should have been denied. PO's primary contention underlying these arguments is that the Board "overestimated" the effect of Petitioner's *Sotera* stipulation in view of *Ingenico*. However, there was no error.

I. *Fintiv* Factor 4 Weighs Heavily in Petitioner's Favor Due to Petitioner's Stipulations

Petitioner provided a *Sotera* stipulation with the filing of the Petition. (Ex-1016.) After institution, and in accordance with the USPTO's new Workload Management FAQ relating to system prior art, Petitioner further stipulated that it:

will not pursue any invalidity grounds based on the CarnoJet product in

combination with Best-2008 (Ex-1004), Osada (Ex-1005), and/or Best-2012 (Ex-1006).

Petitioner provided this stipulation in response to an email it received from PO seeking “leave to file request leave to submit GRC’s final invalidity contentions” in view of the CarnoJet product. After receiving Petitioner’s CarnoJet stipulation, PO dropped its request.

PO’s reliance on *Ingenico* is inapposite because Petitioner has agreed not to rely on the patents and printed publications asserted in the IPR in combination with the CarnoJet product in the district court. *Ingenioc Inc. v. IOENGINE, LLC*, 136 F. 4th 1354, 1366 (Fed. Cir. 2025). Contrary to PO’s arguments, there is no potential overlap between the invalidity arguments at issue in the district court proceedings and in the IPR. As in the POPR (Paper 6 at 64), the Request contends that CarnoJet is cumulative of Best-2012. (Paper 9 at 2, 10.) Yet, the Board already addressed that argument at institution (ID at 16), and Petitioner has stipulated not to assert the CarnotJet product with the IPR prior art in the district court. Unlike the Director’s decision vacating institution in IPR2024-01400, or in *Motorola Solutions, Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 (Stewart, March 28, 2025), there is no overlap here between the prior art asserted in the IPR and in the district court. *See* IPR2024-01400, Paper 22 at 2-3 (Stewart, June 9, 2025). Accordingly, there is no error in the Board’s *Fintiv* factor 4 analysis, which heavily favors institution.

II. The Board Correctly Assessed *Fintiv* Factors 6, 1, and 3

A. The Board's *Fintiv* factor 6 assessment is correct

The Board found that “the unpatentability challenge presented in the Petition is reasonable and ‘sufficiently strong’ on the merits to overcome the threshold for institution.” (ID at 17.) The Board further stated that it is

satisfied that Petitioner has met its burden for institution. No argument by Patent Owner persuades us otherwise. Petitioner has shown that each limitation and element of claim 1 is taught or suggested by the combination of Best-2008 and Osada.

(ID at 42.) Simply because the Board did not use the word “compelling” does not mean any error exists. Indeed, the Board’s thorough analysis shows Petition’s case is compelling.

PO incorrectly contends that the “Board relied on generalized references in Best-2008 ‘temperature uniformity’ to infer that the dielectric fluid flows uniformly through each appliance slot in Best-2008.” (Paper 9 at 11). Here, the Board tied together the undisputed disclosures of Best-2008 regarding uniform temperature with the undisputed disclosures of Best-2008 that the flow cools each server. (ID at 43.) As the Board stated, these and other disclosures of Best-2008 “at least suggests this uniformity of flow and, as the nozzles are disclosed to be below the servers and the coolant exit is at the tank’s top, the flow would be upward.” (*Id.*) The Board also found that “Best-2008 explains that a reason to configure its tank so coolant enters

at the bottom and exits at the top, and for providing fluid velocity augmentation devices like fans and nozzles below the servers, is to enhance/improve coolant flow, homogeneity, and temperature uniformity as it rises through the servers.” (*Id.*)

PO’s contention that Best-2008’s “flow augmentation devices ... are designed to create differential velocities” is unsupported by any testimony and is wrong. (Paper 9 at 7.) As the Petition explains, such devices may serve many purposes including improving “the flow of the coolant *through* the plurality of servers.” (Pet. at 52-54; Ex-1004-Best-2008 at [0107].) PO’s myopic view should be rejected.

B. The Board’s *Fintiv* factor 1 assessment is correct

PO suggests that there is an inconsistency between the Board’s characterization of the likelihood of a stay in the district court compared to how the district court ruled on Petitioner’s initial motion to stay. PO’s suggestion is unfounded. In denying Petitioner’s initial motion to stay, the district court held “that a stay is not appropriate *at this juncture* and notes that IPR has not yet been instituted.” (Ex-2005 (emphasis added).) Petitioner has now filed a renewed motion to stay and expects it to be granted given Judge Albright’s recent decision granting an opposed motion to stay pending IPR institution where, like here, Petitioner “demonstrated a reasonable likelihood” of invalidating at least one claim of the asserted patent in an instituted IPR and estoppel applies. *See ParkerVision, Inc. v. NXP Semiconductors N.V.*, Mem. Op. and Order Granting Defs’ Mot. to Stay

Pending *Inter Partes* Review, Case 6:23-cv-00389-ADA (W.D. Tex. May 27, 2025) (stating “whether a stay will simplify the issues” in the litigation is “the most important factor in the stay analysis”); see *Kirsch Rsch. and Dev., LLC v. IKO Indus.*, Case 6:20-cv-00317-ADA, 2021 WL 4555610 at *3 (W.D. Tex. Oct. 2021) (Judge Albright granting opposed motion to stay pending instituted IPR, identifying simplification of issues as the “most important factor” bearing on whether to stay). Factor 1 at least weighs marginally against discretionary denial, as the Board found.

C. The Board’s *Fintiv* factor 3 assessment is correct

PO contends that the parties’ investment in the district court litigation has increased since PO’s preliminary response and that, in view of *Motorola*, the Board did not give enough weight to this investment. While it is true that more has occurred in the litigation due to the passage of time, the Board did not commit error by assessing the parties’ investment in the litigation at the time that it issued the ID. There is no basis to weigh factor 3 more heavily.

D. The Board’s Overall *Fintiv* factor analysis is correct

The Board did not erroneously weigh the *Fintiv* factors. PO repeats points from its POPR or the ID as to factors 2 and 5 – these carry the same weight as already determined by the Board. Due to Petitioner’s additional CarnoJet stipulation, there is no basis to re-weigh factor 4. Similarly, the Board correctly weighed factors 1, 3, and 6. PO’s Request should be denied.

Respectfully submitted,
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Date: June 16, 2025

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CERTIFICATE OF SERVICE

In accordance with § 42.6(e)(1), the undersigned certifies that on the 16th day of June 2025, this paper (PETITIONER'S AUTHORIZED RESPONSE TO DIRECTOR REVIEW REQUEST) was served, via electronic mail, upon counsel of record for Patent Owner.

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