

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VERTIV CORPORATION,
Petitioner

v.

VALTRUS INNOVATIONS LTD.,
Patent Owner

Case No. IPR2025-00669
Patent No. 6,862,179

PATENT OWNER'S PRELIMINARY RESPONSE

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	OVERVIEW OF THE '179 PATENT	3
III.	THE PETITION FAILS TO SHOW A REASONABLE LIKELIHOOD OF SUCCESS.....	8
A.	Neither <i>Bash</i> nor <i>Patel</i> Discloses the Claimed “Controllable Partition” and Therefore Neither Reference Anticipates the Challenged Claims.	8
1.	The '179 Patent discloses that “partitions” and “vents” are separate structures.....	10
2.	<i>Bash</i> and <i>Patel</i> disclose vents, not the claimed “controllable partition,” and therefore do not anticipate any Challenged Claim.	19
B.	<i>Bishop</i> in View of <i>Feeney</i> and <i>Kochavi</i> Does Not Render Challenged Claims 1-6 or 11-13 Obvious.....	25
1.	<i>Bishop</i> does not disclose the claimed “controllable partition.”	27
2.	The combination of <i>Bishop</i> and <i>Feeney</i> does not disclose the claimed “controllable partition” or claim steps 1[a] or 1[d].	27
3.	Petitioner fails to show that a POSITA would have been motivated to modify, and had a reasonable expectation of success in modifying, <i>Bishop</i> in light of <i>Feeney</i> to achieve the claimed invention of the '179 Patent.	32
IV.	THE BOARD SHOULD NOT CONSIDER THE PETITION BECAUSE PETITIONER FAILED TO NAME ALL REAL PARTIES IN INTEREST AND PRIVIES.....	40
A.	Proper Identification of RPIs is Required by Statute to Consider a Petition.....	40
B.	Petitioner Failed to Identify All RPIs.....	43

C.	The Board’s Prior Decisions Permitting Parties to Not Name all RPIs are Incorrect and Procedurally Void.	47
V.	CONCLUSION.....	48

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Active Networks, Inc. v. Verizon Commc’ns, Inc.</i> , 694 F.3d 1312 (Fed. Cir. 2012)	35
<i>Augme Techs., Inc. v. Yahoo! Inc.</i> , 755 F.3d 1326 (Fed. Cir. 2014)	18
<i>Bungie, Inc., v. Worlds Inc.</i> , IPR2015-01264, Paper 64 (PTAB Jan. 14, 2020)	46
<i>CAE Screenplates Inc. v. Heinrich Fiedler GmbH & Co.</i> , 224 F.3d 1308 (Fed. Cir. 2000)	18
<i>Clear-Vu Lighting, LLC v Univ. of Strathclyde</i> , IPR2019-00588, Paper 24 (PTAB Sept. 30, 2019).....	46
<i>Duncan Parking Techs., Inc. v. IPS Grp., Inc.</i> , 914 F.3d 1347 (Fed. Cir. 2019)	2
<i>Ericsson Inc. v. Regents of the Univ. of Minn.</i> , IPR2017-01213, Paper 56 (PTAB June 19, 2020)	46
<i>Hamilton Beach Brands, Inc. v. freal Foods, LLC</i> , 908 F.3d 1328 (Fed. Cir. 2018)	35
<i>Intouch Techs., Inc. v. VGo Commc’ns, Inc.</i> , 751 F.3d 1327 (Fed. Cir. 2014)	35
<i>Karlin Tech. Inc. v. Surgical Dynamics, Inc.</i> , 177 F.3d 968 (Fed. Cir. 1999)	17
<i>PayPal, Inc. v. Ioengine, LLC</i> , IPR2019-00884, Paper 22 (PTAB Oct. 3, 2019).....	42, 45
<i>PayPal, Inc. v. Personal Web Techs., LLC</i> , IPR2019-01111, Paper 27 (PTAB Nov. 22, 2019).....	46
<i>Phillips v. AWH Corp.</i> , 415 F.3d 1303 (Fed. Cir. 2005)	11

<i>RPX Corp. v. Applications in Internet Time, LLC</i> , IPR2015-01750, Paper 128 (PTAB Oct. 2, 2020)	47
<i>SharkNinja Operating LLC v. iRobot Corp.</i> , IPR2020-00735, Paper 11 (PTAB Oct. 13, 2020)	47
<i>TQ Delta, LLC v. Cisco Sys., Inc.</i> , 942 F.3d 1352 (Fed. Cir. 2019)	35
<i>Ventex Co. Ltd. v. Columbia Sportswear N.A., Inc.</i> , IPR2017-00651, Paper 148 (PTAB Jan. 24, 2019)	42, 45
<i>Volkswagen Grp. of Am., Inc. v. Arigna Tech. Ltd.</i> , IPR2021-01263, Paper 16 (PTAB Jan. 21, 2022)	43, 45
<i>Wenger Mfg., Inc. v. Coating Mach. Sys., Inc.</i> , 239 F.3d 1225 (Fed. Cir. 2001)	17
<i>Xerox Corp. v. Bytemark, Inc.</i> , IPR2022-00624, Paper 9 (PTAB Aug. 24, 2022)	<i>passim</i>

Statutes

35 U.S.C. §102(e)	1, 2
35 U.S.C. §103(a)	1
35 U.S.C. §312(a)(2)	40, 45

Regulations

37 C.F.R. §42.8(b)(1)	45
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PATENT OWNER’S UPDATED EXHIBIT LIST

No.	Exhibit Description
2001	<i>Interim Processes for PTAB Workload Management</i>
2002	Vertiv Consolidation Order, No. 2-24-cv-00361, Dkt. 42
2003	DataBank Consolidation Order, No. 2:24-cv-00777, Dkt. 11
2004	Defendant DataBank Holding Ltd.’s Answer and Counterclaims, No. 2:24-cv-00777, Dkt. 12
2005	Defendant TierPoint, LLC’s First Amended Answer, No. 2:24-cv-00777, Dkt. 17
2006	Vertiv Corporation Complaint for Declaratory Judgment, No. 3:24-vc-01152, Dkt. 1
2007	Memo ISO Plf Vertiv’s Resp. in Oppos. to Def’s MTD, No. 3:24-cv-01152, Dkt. 25
2008	Defendant DataBank Holdings, Ltd.’s Unopposed Motion to Change Lead Counsel, No. 2:24-cv-00777, Dkt. 51
2009	Notice of Appearance Daniel Schwartz on Behalf of TierPoint, 2:24-cv-00776, Dkt. 15
2010	Letter from Alexander to Berkowitz dated May 21, 2025 on behalf of DataBank Regarding Discovery Disputes
2011	Letter from Alexander to Berkowitz dated May 21, 2025 on behalf of TierPoint Regarding Discovery Disputes
2012	Email from Girgis to Berkowitz dated April 1, 2025 attaching “Vertiv’s Invalidity Contentions” on behalf of DataBank and TierPoint
2013	Email from Girgis to Berkowitz attaching documents produced by DataBank dated April 1, 2025
2014	Email from Girgis to Berkowitz attaching documents produced by TierPoint dated April 1, 2025
2015	Order denying stay in <i>Cardware Inc. v. Samsung Elecs. Co., Ltd.</i> , No. 2:22-cv-00141-JRG-RSP
2016	Docket Control Order, No. 2:24-cv-00361, Dkt. 60
2017	Netlist Order Denying Stay, No. 2:22-cv-00293, Dkt. 689
2018	Amended Docket Control Order, No. 2:24-cv-00777, Dkt. 32
2019	Vertiv’s Motion to Intervene, No. 2:24-cv-00142, Dkt. 46
2020	Returned Summons, No. 2:24-cv-00139, Dkt. 10
2021	Vertiv Corporation’s Invalidity and Ineligibility Contentions and Disclosures Pursuant to Patent Rule 3-3, No. 2:24-cv-00361

No.	Exhibit Description
2022	Appendix 3 to Vertiv’s Preliminary Ineligibility Contentions for U.S. Patent No. 6,862,179, No. 2:24-cv-00361
2023	Defendants’ Invalidity and Ineligibility Contentions and Disclosures Pursuant to Patent Rule 3-3, No. 2:24-cv-00777
2024	Guidance on USPTO’s recission of “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation”
2025	Docket Navigator Statistics for Judge Gilstrap
2026	Federal Court Statistics
2027	Email from Girgis to Berkowitz attaching Vertiv’s Invalidity Contentions dated April 1, 2025
2028	Ineligibility Contentions for U.S. Patent 6,862,179 attached to Vertiv’s Invalidity Contentions dated April 1, 2025
2029	U.S. Patent No. 6,775,997 (“ <i>Bash</i> ”)
2030	U.S. Patent No. 6,868,683
2031	Vertiv’s First Supplemental Initial and Additional Disclosures, 2:24-cv-00361
2032	DataBank’s Initial and Additional Disclosures, 2:24-cv-00777
2033	TierPoint’s Initial Disclosures Pursuant to Discovery Order, 2:24-cv-00777
2034	Docket Navigator Report Showing Payment of Maintenance Fees for U.S. Patent No. 6,862,179
2035	Press Release by Vertiv, titled “ <i>Veteran technology executive Rob Johnson to lead new standalone company following sale to Platinum Equity</i> , dated Dec. 1, 2016), available at https://www.vertiv.com/en-in/about/news-and-insights/news-releases/2016/emerson-network-power-rebrands-as-vertiv--appoints-new-ceo/
2036	Vertiv Timeline, available at https://www.vertiv.com/49c2fd/globalassets/images/infographics/vertiv-timeline-infographic-en-gl-2025-1.pdf
2037	Form 10-K for Emerson Electric. Co. (Filed: November 25, 2008; period: September 30, 2008)
2038	“An Introduction to Vertiv,” available at https://www.vertiv.com/globalassets/documents/blog/vertiv-corporateoverview-pr-en-gl_174923_01.pdf
2039	File History for U.S. Patent Application No. 11/670,208
2040	U.S. Patent Application Publication No. 2008/0092577
2041	Assignment Record for U.S. Patent Application No. 11/670,208

No.	Exhibit Description
2042	Information Disclosure Statement in U.S. Patent Application No. 11/873,236, filed on October 16, 2007
2043	U.S. Patent No. 7,857,214
2044	Assignment Abstract of Title for U.S. Patent Application No. 11/873,236
2045	U.S. Patent No. 6,775,997
2046	U.S. Patent No. 6,945,058
2047	U.S. Patent No. 6,694,759

I. INTRODUCTION

On February 26, 2025, Petitioner Vertiv Corporation (“Petitioner”) filed a Petition requesting *inter partes* review of claims 1-15 (the “Challenged Claims”) of U.S. Patent No. 6,862,179 (“the ’179 Patent”; EX1001), asserting three Grounds. In Ground 1, Petitioner asserts that independent claim 1 and dependent claims 2-15 are anticipated under 35 U.S.C. §102(e) by *Bash*. Petition (Paper 1), 31. In Ground 2, Petitioner asserts that claims 1-7 and 10-15 are anticipated under 35 U.S.C. §102(e) by *Patel*. Petition (Paper 1), 48. In Ground 3, Petitioner asserts that claims 1-6 and 11-13 are rendered obvious under 35 U.S.C. §103(a) by the combination of *Bishop*, *Feeney*, and *Kochavi*. Petition (Paper 1), 61. On April 14, 2025, the Board issued a Notice of Filing Date Accorded for the Petition and set the time for filing Patent Owner’s Preliminary Response. Paper 5.

On June 13, 2025, pursuant to the Director’s interim process memorandum, Patent Owner filed a brief requesting discretionary denial of the Petition. Paper 6. Patent Owner believes that discretionary denial is particularly appropriate under the circumstances of this case. However, should the Board reach the merits, it should deny institution because Petitioner fails to meet its burden of demonstrating a reasonable likelihood of success that its prior art references anticipate or render obvious any of the Challenged Claims.

First, even if both *Bash* and *Patel* qualify as prior art,¹ the Petition’s anticipation Grounds 1 and 2 still fail as neither *Bash* nor *Patel* discloses numerous claim limitations in independent claim 1 (and correspondingly, any challenged dependent claims), including, for example, the claimed “controllable partition.” Petitioner’s theory—that “vents” in *Bash* and *Patel* correspond to the claimed “controllable partition”—is based exclusively on Petitioner’s (incorrect) assertion as to Patent Owner’s “expected” construction. It is also contradicted by the intrinsic record (including the ’179 Patent specification, prosecution history, and claims), which record confirms these are separate structures.

Second, the Petition’s obviousness Ground 3 fails because none of *Bishop*, *Feeney*, or *Kochavi*, alone or in combination, disclose several claim limitations, including, for example, the claimed “controllable partition.” Ground 3 additionally fails because Petitioner does not show that a person of ordinary skill in the art would

¹ To the extent that the Board institutes, Patent Owner will demonstrate other failures with the Petition, including that *Bash* and *Patel*—which share two inventors with the ’179 Patent and, like the ’179 Patent, arose out of inventive activities at Hewlett-Packard—are not “by another” and thus not prior art under pre-AIA 35 U.S.C. §102(e). *See, e.g., Duncan Parking Techs., Inc. v. IPS Grp., Inc.*, 914 F.3d 1347, 1358 (Fed. Cir. 2019).

have been motivated to combine, and had a reasonable expectation of success in combining, the references.

Third, Petitioner fails to name all the real parties in interest or privies, which is an independent statutory requirement for the Board to consider the Petition at all.

Accordingly, Petitioner has failed to show a reasonable likelihood of success for any claim on any Ground and Patent Owner respectfully submits that the Board should deny institution.

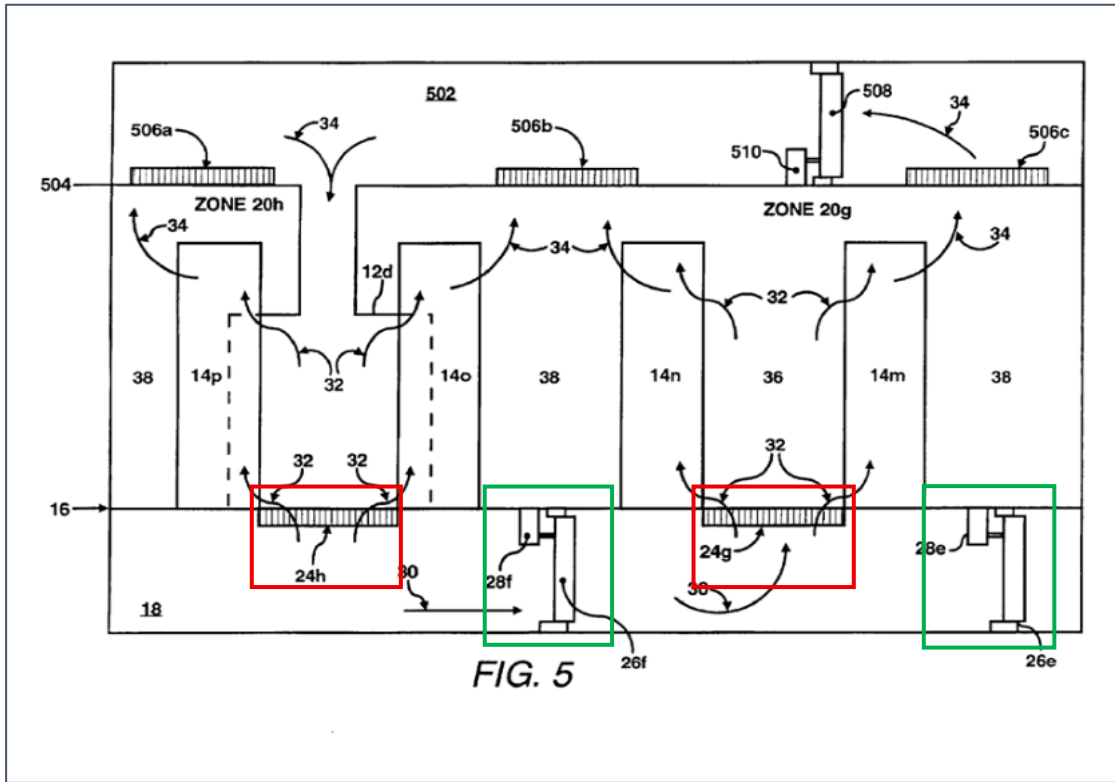
II. OVERVIEW OF THE '179 PATENT

The '179 Patent, along with the two references in Petitioner's Grounds 1 and 2 (*Bash* and *Patel*), arose from research and development activity at Hewlett-Packard. EX1001, Cover Page; EX1005, Cover Page; EX1006, Cover Page. The '179 Patent lists two inventors, Albdlmonem H. Beitelmal and Chandrakant D. Patel, EX1001, Title Page, who are also named inventors on *Bash* and *Patel*. EX1005, Cover Page; EX1006, Cover Page.

The '179 Patent, titled "Partition for Varying the Supply of Cooling Fluid," explains that "[c]onventional data center air conditioning units do not vary their cooling fluid output based on the distributed needs of the data center," and "[i]nstead, these air conditioning units generally operate at or near a maximum compressor power even when the heat load is reduced inside the data center." EX1001, 1:58-63. Per the patent, this "substantially continuous operation of the air conditioning units"

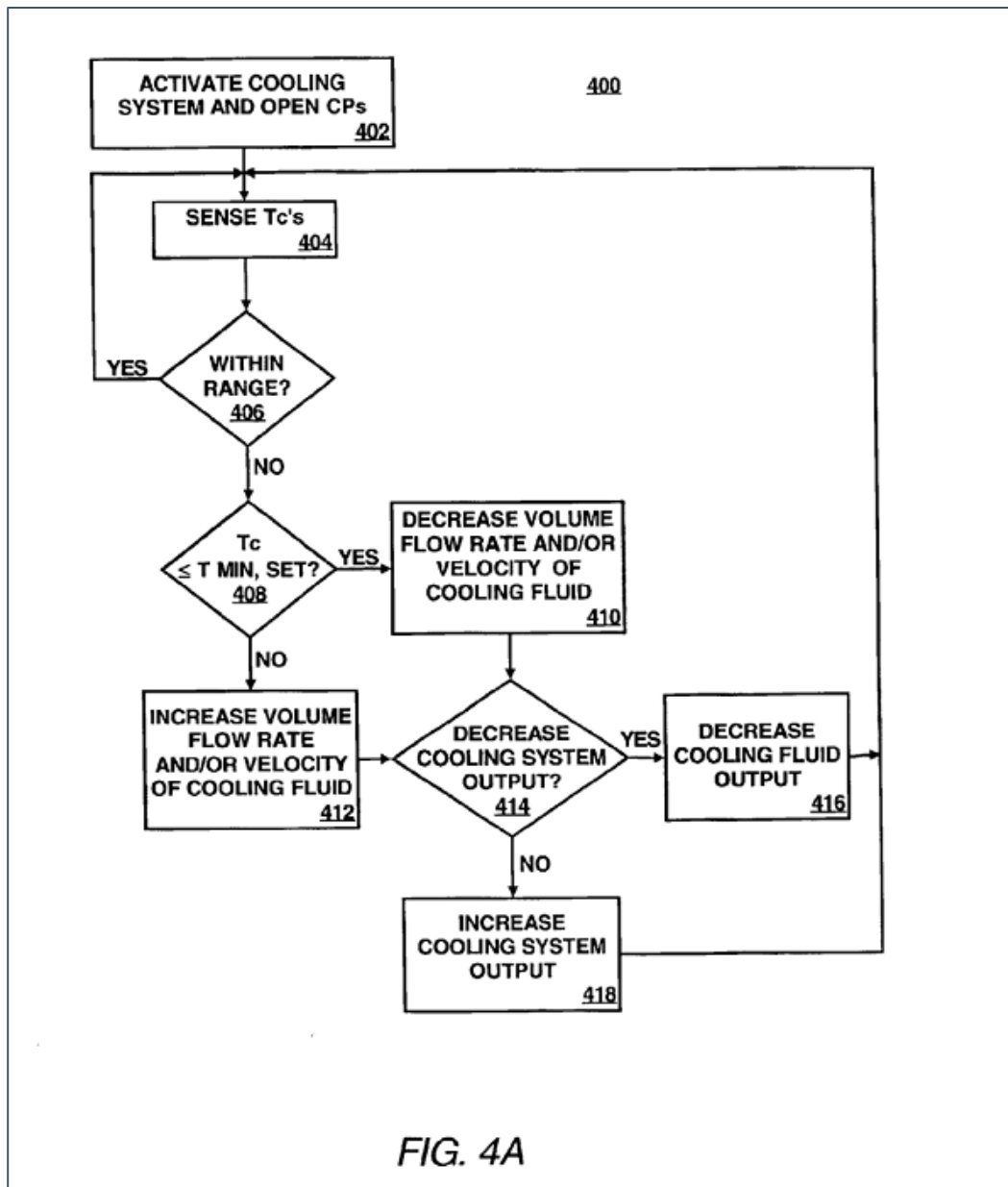
can result in the cooling of “components that may not be operating at a level which may cause its temperature to exceed a predetermined temperature range.” EX1001, 2:2-4. The ’179 Patent further explains that “conventional cooling systems generally supply cooling fluid to the components in an inefficient manner and substantially indiscriminate manner” through the use of “plenums[,] which may not vary the volume flow of cooling fluid according to fluctuations in the cooling requirements.” EX1001, 2:4-10. “Consequently, conventional cooling systems often incur greater amounts of operating expenses than may be necessary to sufficiently cool the heat generating components contained in the racks of data centers.” EX1001, 2:10-13.

To overcome these drawbacks, the ’179 Patent discloses a novel method and system that uses a controllable partition that varies the supply of cooling fluid within a zone of a data center. EX1001, Abstract. The controllable partition is configured to vary the supply of cooling fluid within the data center, sense the temperature of at least one rack in the data center, determine if the sensed temperature is within a predetermined range, and manipulate the partition to vary the supply of cooling fluid to the zone if the measured temperature is outside of that range. EX1001, Abstract. Such a controllable partition can be seen, for example, in Figure 5, reproduced below, with controllable partitions 26f and 26e in the **green** boxes and separate vents 24h and 24g in the **red** boxes:



EX1001, FIG. 5 (annotated).

Figure 4A of the '179 Patent, reproduced below, is a flow chart of a disclosed method (where “CPs” is short for “controllable partitions”):



EX1001, FIG. 4A.

Petitioner challenges claims 1-15 of the '179 Patent. The sole challenged independent claim (claim 1) recites, with labeling as added by Petitioner:

1[pre] A method of cooling a plurality of racks in a data center, said method comprising:

1[a] activating a cooling device and opening a *controllable partition* configured to vary a supply of cooling fluid within a zone of said data center, said zone including at least one associated rack of said plurality of racks,

1[b] sensing the temperature of said at least one associated rack;

1[c] determining whether said sensed temperature is within a predetermined temperature range; and

1[d] manipulating *said controllable partition* to vary said supply of said cooling fluid to said zone in response to said sensed temperature being outside said predetermined temperature range.

EX1001, cl. 1 (emphasis added). Dependent claims 2-15 depend, directly or indirectly, from claim 1 and recite further details. For example, dependent claim 7 introduces the additional concept of “vents” being opened and controlled: “opening a plurality of *vents*, said vents being configured to supply cooling fluid to said racks; controlling one or more of said plurality *vents* to decrease the supply of said cooling fluid to said at least one associated rack having a measured temperature that fall below or equal said predetermined minimum set point temperature; and controlling said one or more *vents* to increase the supply of said cooling fluid to said at least one associated rack having a measured temperature that exceed said predetermined minimum set point temperature.” EX1001, cl. 7 (emphasis added).

For the purposes of this Patent Owner Preliminary Response (“POPR”), Patent Owner identifies flaws in Petitioner’s theories for independent claim 1, which also apply to each of the dependent claims equally and are dispositive of Petitioner’s grounds.

III. THE PETITION FAILS TO SHOW A REASONABLE LIKELIHOOD OF SUCCESS.

A. Neither *Bash* nor *Patel* Discloses the Claimed “Controllable Partition” and Therefore Neither Reference Anticipates the Challenged Claims.

Petitioner asserts that *Bash* and *Patel* both anticipate Challenged Claims. In particular, Petitioner asserts that *Bash* anticipates claims 1-15, and *Patel* anticipates claims 1-7 and 10-15. Petition (Paper 1), 31, 48. However, as demonstrated below, neither *Bash* nor *Patel* discloses key elements of independent claim 1, and therefore neither reference anticipates any Challenged Claim.

For example, neither *Bash* nor *Patel* discloses the claimed “controllable partition” found in claim step 1[a] “activating a cooling device and opening a *controllable partition* configured to vary a supply of cooling fluid within a zone of said data center” and claim step 1[d] “manipulating said *controllable partition* to vary said supply of said cooling fluid to said zone in response to said sensed temperature being outside said predetermined temperature range.”

Petitioner attempts to overcome this deficiency by arguing that the “vents” of *Bash* and *Patel* correspond to the “controllable partition” of the ’179 Patent, based

solely on Petitioner’s incorrect assertion as to Patent Owner’s “expected construction.” Petition (Paper 1), 31, 34, 48, 52.² But the intrinsic record demonstrates this is wrong. First, the specification of the ’179 Patent shows that there is a patentable difference between a “controllable partition” and “vents.” Second, the prosecution history similarly demonstrates that both the Examiner and the Applicant understood there to be a patentable difference between “vents” and a “controllable partition.” Third, because the claims separately claim “vents” and a “controllable partition” that are each “open[ed],” *see* EX1001, claims 1, 7, the doctrine of claim differentiation and the presumption that different claim terms have different meanings militate against Petitioner’s interpretation that “vents” are “controllable partitions.”

Patent Owner explains below the intrinsic record, followed by why *Bash* and *Patel* do not disclose the claimed “controllable partition.”

² Petitioner does not argue that *Bash* or *Patel* anticipate any claim under Petitioner’s asserted “plain and ordinary meaning”; rather, Petitioner’s anticipation Grounds are premised exclusively on its (incorrect) assertion as to Patent Owner’s “implied” or “expected” construction. Petition (Paper 1), 31, 34 (*Bash* ground), 48, 52 (*Patel* ground); *see also id.*, 14-15 (constructions).

1. The '179 Patent discloses that “partitions” and “vents” are separate structures.

Petitioner argues that the claimed “partition” as recited in the '179 Patent should be understood as a “barrier or wall that subdivides a space,” but that Patent Owner’s “implied” (or “expected”) construction is that a partition is “a device capable of manipulating cooling fluid flow.” Petition (Paper 1), 14-15. Petitioner later asserts that, under the latter construction only, a “vent” corresponds to the claimed “controllable partition” for purposes of its *anticipation* Grounds 1 and 2. Petition (Paper 1), 30, 48, 52.

Petitioner does not—in its Petition—support either of its proposed constructions, or its resulting conclusion, with cites to, or discussion of, the intrinsic record (citing, without explanation or analysis, to nearly twenty paragraphs of its expert’s declaration [EX1002 ¶¶77-95]).³ Notwithstanding, the intrinsic record demonstrates that there is a patentable difference between a “vent” and a

³ For the purposes of this POPR, the precise construction of the terms is unnecessary. Instead, as discussed herein, the Board need only consider whether a “vent” corresponds to the claimed “controllable partition” (it does not) to determine that Petitioner has failed to demonstrate a reasonable likelihood of success that either *Bash* or *Patel* anticipates independent claim 1 (and, by dependency, any challenged dependent claim).

“controllable partition” and that they are different structures. Thus, Petitioner’s anticipation grounds (Grounds 1 and 2)—which rely on a “vent” as the claimed “controllable partition”—necessarily fail.

Patent Owner addresses below the intrinsic record—the ’179 Patent specification, the prosecution history, and the claims—all of which support the idea that “vents” and “partitions” are different.

First, the ’179 Patent specification itself confirms that a “vent” and a “partition” are two different structures. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 (Fed. Cir. 2005) (“The specification is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term.”) (cleaned up); *see also id.* at 1318 (expert testimony “that is clearly at odds with the claim construction mandated by the claims themselves, the written description, and the prosecution history, in other words, with the written record of the patent” should be discounted).

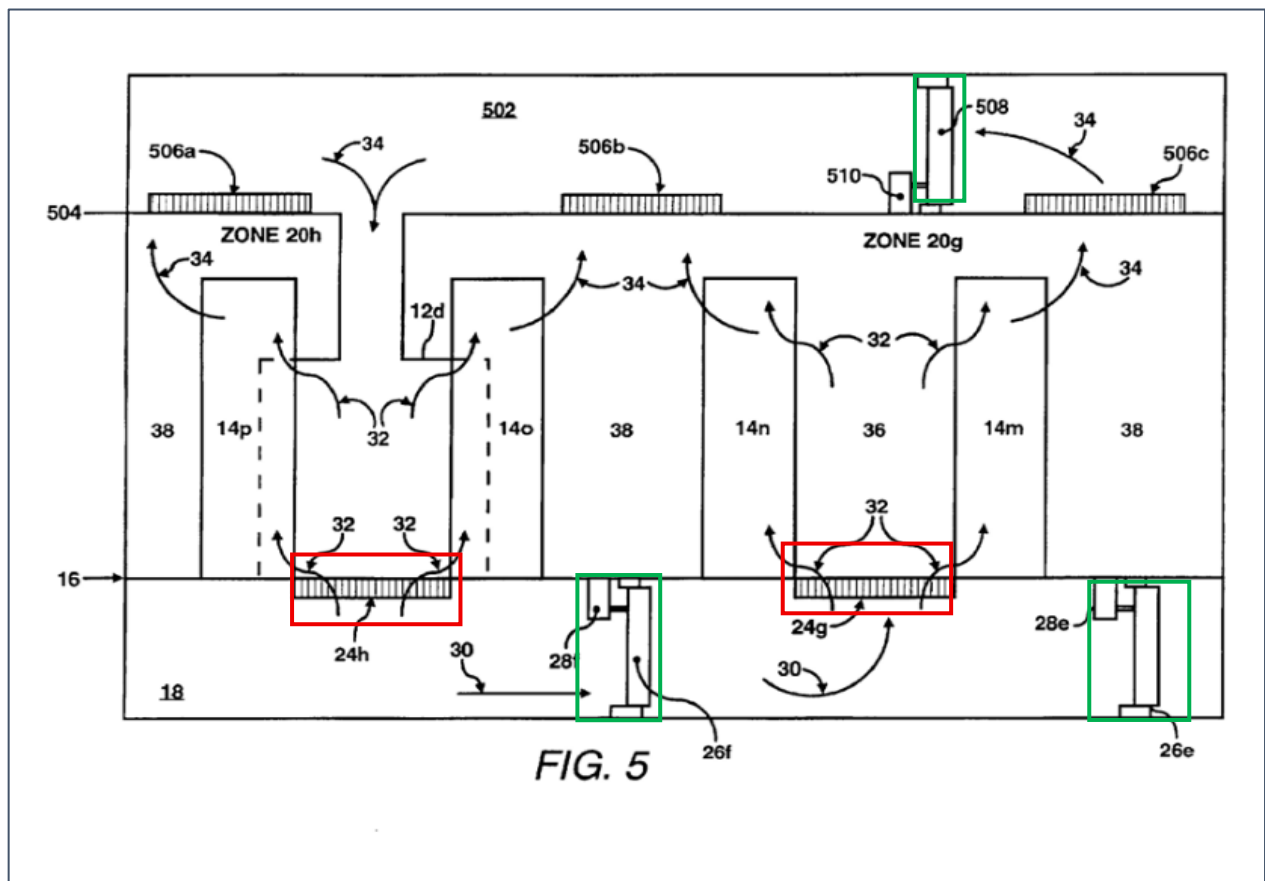
For example, the ’179 Patent specification discloses, as to “controllable partitions,” that:

In various embodiments of the invention, the [Controllable Partitions] 26a-26f may include louvered, rotating and/or retractable partitions. Each of the [Controllable Partitions] 26a-26f may include a respective motor 28a-28f. However, it is to be understood that any suitable actuating

device may be substituted for some or all of the motors 28a–28f. Examples of reasonable actuating devices include, but are not limited to, electromagnetic, pneumatic, and like devices.

EX1001, 4:24-31. Importantly, the '179 Patent consistently describes and depicts partitions and vents as being *separate*. For example, the patent explains that “[i]n addition to controlling the flow of cooling fluid by controlling the [Controllable Partition] 26f, it is within the scope of the invention that flow of cooling fluid *may also be controlled* by the manipulation of dynamically *controllable vents*.” EX1001, 5:30-33 (emphasis added). The patent also discloses the interplay between a “vent” and a “controllable partition”: “[i]n another example, the baffle 62 may be controlled to direct the flow of cooling fluid upwards (e.g., *out of a vent* 24a-26h) or downwards (e.g., *to increase the flow towards a partition* 26a-26f).” EX1001, 8:19-23 (emphasis added). That a “vent” and “partition” are different is consistent throughout the specification. *See also, e.g.*, EX1001, 4:16-39 (separately describing “vents 24a-24h” and “controllable partitions (‘CPs’) 26a-26f”), 5:2-18 (same), 17:46-50 (discussing step 412 of FIG. 4A and separately disclosing controllable partitions (CPs) and vents: “[i]n this respect, based upon the analysis, the CP supplying the respective zone and/or the vent supplying that rack with cooling fluid and/or another CP and/or vent may be caused to vary the volume flow and/or velocity of the cooling fluid.”), 16:15-25, 16:30-36 (disclosing vents 24a-h, controllable partitions 26a-f,

and controllable partition 508), FIGs. 1, 2A (separately depicting vents 24a-h and controllable partitions 26a-26f), FIG. 5 (separately depicting vents 24a-h and controllable partitions 26a-26f and 508). For example, this separation can be seen in Figure 5, reproduced below, with **controllable partitions 26f, 26e, and 508** separate from **vents 24g and 24h**:

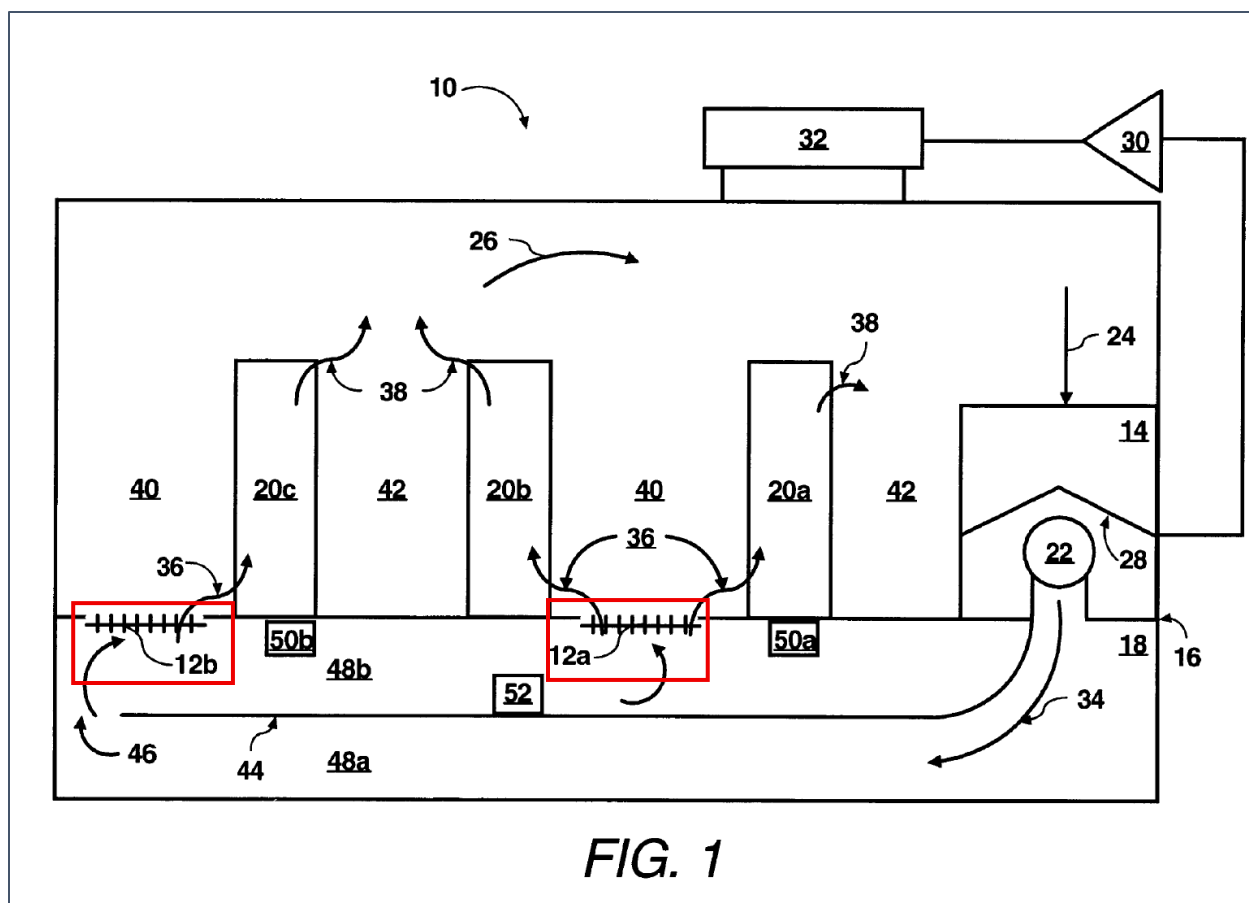


EX1001, FIG. 5 (annotated).

Second, the prosecution history further confirms the difference between a “controllable partition” and “vent.” During prosecution, the Examiner issued an initial office action on June 14, 2004 rejecting all the pending claims. EX1003, 303-

306. The sole reason for this rejection was the Examiner’s assertion that the claims were obvious under the judicially created double patenting doctrine over U.S. Patent No. 6,694,759 (“*Bash* ’759”; EX2047). EX1003, 305-306.

Like the *Bash* reference in Petitioner’s Ground 1, *Bash* ’759 lists as named inventors Cullen E. Bash, Chandrakant D. Patel, Abdimonem Beitelmal, and Ratnesh K. Sharma, and was developed at, and assigned to, Hewlett-Packard. EX2047, Cover Page. *Bash* ’759, titled “Pressure Control of Cooling Fluid Within a Plenum Using Automatically Adjustable *Vents*,” discloses that “cooling fluid within a plenum” is “controlled by activating the cooling system, sensing pressure within the plenum in at least one zone of the data center” and “modulating at least one of a plurality of automatically adjustable *vents* in response to the pressure being outside the predetermined pressure range.” EX2047, Abstract (emphasis added). Figure 1 of *Bash* ’759, reproduced below with red boxes added, discloses one such embodiment with *vents 12a and 12b* (but no controllable partitions as the Applicant explained during prosecution):



EX2047, FIG. 1 (annotated).

The specification of *Bash* '759 discloses that vents 12a and 12b (i) can be used to “modulate the flow of cooling fluid flowing” in “chamber 48b,” (ii) may be used to adjust the cooling fluid in the plenum to the “cooling requirements of the racks 20a-20b,” and (iii) are horizontally disposed between the racks 20a-20c and allow for air to pass directly from the plenum to the rack area. EX2047, 8:1-22.

During prosecution of the application leading to the '179 Patent, the Applicant traversed the Examiner's rejection, and argued, among other things, that the pending claims were patentably distinct from the claims of *Bash* '759 because pending claim

1 “pertains to manipulation of a *controllable partition* in response to sensed temperatures at an associated rack” whereas claim 1 of *Bash* ’759 “pertains to actuation of an automatically *adjustable vent* in response to detected pressure in a plenum.” EX1003, 300-301 (emphasis added). And as such, the Applicant explained that “even if one were to modify Claim 1 of the [application leading to the ’179 Patent] as suggested in the Office Action, such a modification would *not* cause Claim 1 of the [application leading to the ’179 Patent] to be unpatentable over the claims contained in [*Bash* ’759].” EX1003, 301 (emphasis added).

In response, the Examiner allowed the claims. EX1003, 268-273 (Notice of Allowance and Notice of Allowability). In the Notice of Allowability, the Examiner stated the “reasons for allowance”:

[T]he allowability recites at least in part: means for activating a cooling device and opening a controllable partition configured to vary a supply of cooling fluid within a zone of the data center, the zone including at least one associated rack of the plurality of racks; means for sensing the temperature of the at least one associated rack; means for determining whether the sensed temperature is within a predetermined temperature range; and means for manipulating the controllable partition to vary the supply of the cooling fluid to the zone in response to the sensed temperature being outside the predetermined temperature range.

EX1003, 272. The prosecution history thus further demonstrates that there is a distinction between a “controllable partition” (as in the ’179 Patent only) and a “vent” (as in *Bash* ’759 and the ’179 Patent, as well as in *Bash* and *Patel* as discussed below in Section III.A.2).

Third, the doctrine of claim differentiation and the presumption that different claim terms have different meanings additionally clarify that a “controllable partition” is not simply a “vent.”

As to the doctrine of claim differentiation, “each claim in a patent is presumptively different in scope.” *Wenger Mfg., Inc. v. Coating Mach. Sys., Inc.*, 239 F.3d 1225, 1233 (Fed. Cir. 2001). “This doctrine, which is ultimately based on the common sense notion that different words or phrases used in separate claims are presumed to indicate that the claims have different meanings and scope, normally means that limitations stated in dependent claims are not to be read into the independent claim from which they depend.” *Karlin Tech. Inc. v. Surgical Dynamics, Inc.*, 177 F.3d 968, 972 (Fed. Cir. 1999) (internal citations omitted).

Independent claim 1 of the ’179 Patent recites “activating a cooling device and opening a controllable partition...” and “manipulating said controllable partition to vary said supply of said cooling fluid....” EX1001, 18:39-40, 18:48-49. Dependent claim 7—which depends from claim 4, which depends from claim 1—further recites “opening a plurality of vents, said vents being configured to supply

cooling fluid to said racks,” “controlling one or more of said plurality vents to decrease the supply of said cooling fluid...,” and “controlling said one or more vents to increase the supply of said cooling fluid...” EX1001, 19:16-17, 19:19-20, 19:24-25. The doctrine of claim differentiation thus also supports that the meaning and scope of “vents” as disclosed in dependent claim 7 is different from the “controllable partition” recited in claim 1 (both of which are claimed, separately, to be “open[ed]”).

Moreover, the use of different claim terms—“vent” and “controllable partition”—in the claims, consistent with the usage in the ’179 Patent specification and prosecution discussed above, additionally evidences that they are *different*. *See, e.g., Augme Techs., Inc. v. Yahoo! Inc.*, 755 F.3d 1326, 1333 (Fed. Cir. 2014) (different claim terms are presumed to have different meanings); *CAE Screenplates Inc. v. Heinrich Fiedler GmbH & Co.*, 224 F.3d 1308, 1317 (Fed. Cir. 2000) (“In the absence of any evidence to the contrary, we must presume that the use of these different terms in the claims connotes different meanings.”).

Yet, despite the sum of this intrinsic evidence, Petitioner argues that the “vents” of *Bash* and *Patel* constitute the claimed “controllable partition” of the ’179 Patent. Petitioner supplies no reasoning as to why the same inventors of *Bash*, *Patel*, *Bash* ’759, and the ’179 Patent, who—consistent with the disclosure in the ’179 Patent specification—previously asserted that a patentable difference between

“vents” and “partitions” exists, would equate the two concepts as Petitioner now attempts to do. Because Petitioner cannot overcome the significant evidence in the intrinsic record that the “controllable partitions” of the ’179 Patent are not “vents,” the Board should reject Petitioner’s attempt to equate the two. And, as discussed below, this is dispositive of both of Petitioner’s anticipation grounds (Grounds 1 and 2).

2. *Bash* and *Patel* disclose vents, not the claimed “controllable partition,” and therefore do not anticipate any Challenged Claim.

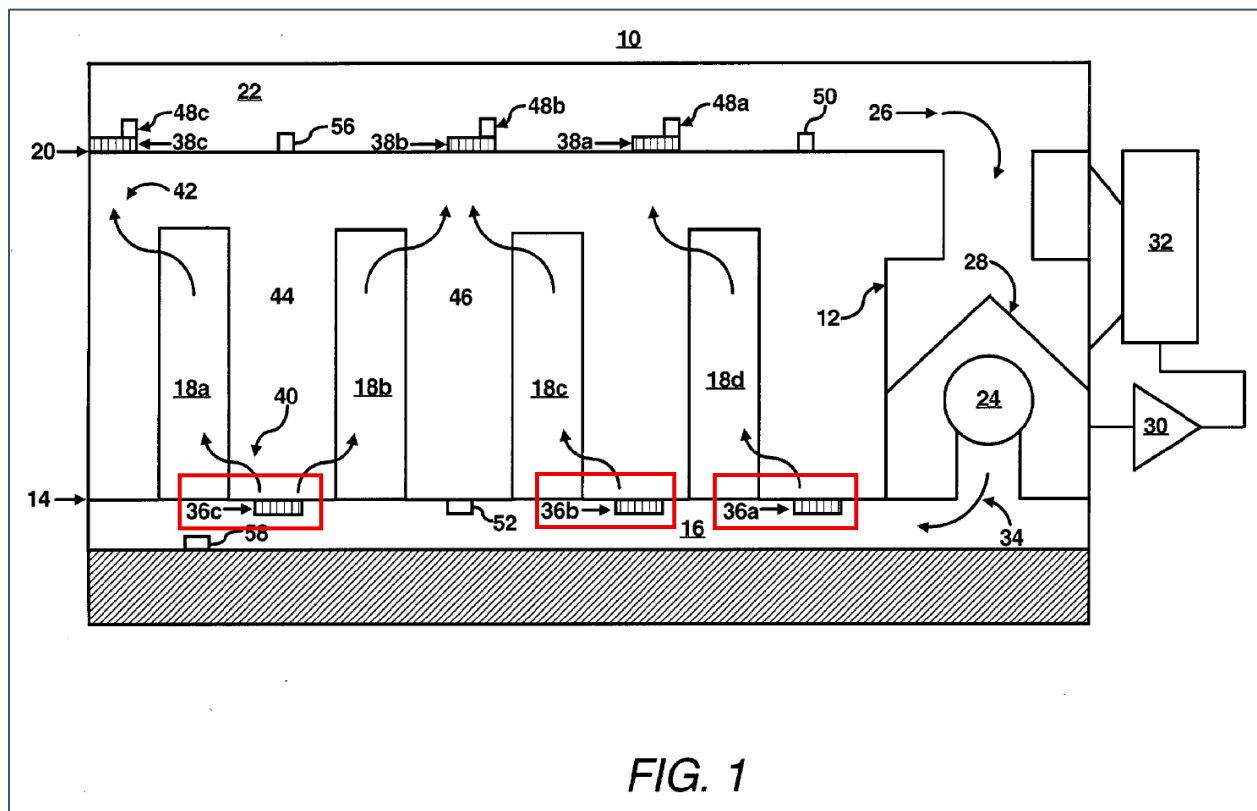
Petitioner asserts that “vents” in *Bash* and *Patel* correspond to the claimed “controllable partition.” But as explained above in Section III.A.1 and further in this Section III.A.2, the “vents” disclosed in *Bash* and *Patel* are not a “controllable partition,” as confirmed by the intrinsic record.

For *Bash*, Petitioner asserts that the claimed “controllable partition” is met by *Bash*’s disclosure of “vents:”

Bash teaches that “cooling fluid flows out of the raised floor 14 through a plurality of dynamically controllable vents 36a-36c that generally operate to control the velocity and the volume flow rate of the cooling fluid therethrough.” Ex. 1005, [0018] (emphasis added). Since the *vents of Bash are controllable and are capable of manipulating the flow (e.g., velocity and volume flow rate) of cooling fluid, the vents 36a-36c of Bash disclose the controllable partition* under Patent Owners’ expected

construction of “partition.” Therefore, the vents 36a-36c of Bash disclose the controllable partition recited in claim 1 under Patent Owners’ expected construction of “partition.” Ex. 1002 ¶¶175-176.

Petition (Paper 1), 34-35 (emphasis added); *see also* EX1005 (*Bash*), FIG. 1 (annotated below to show vents 36a-c in red):



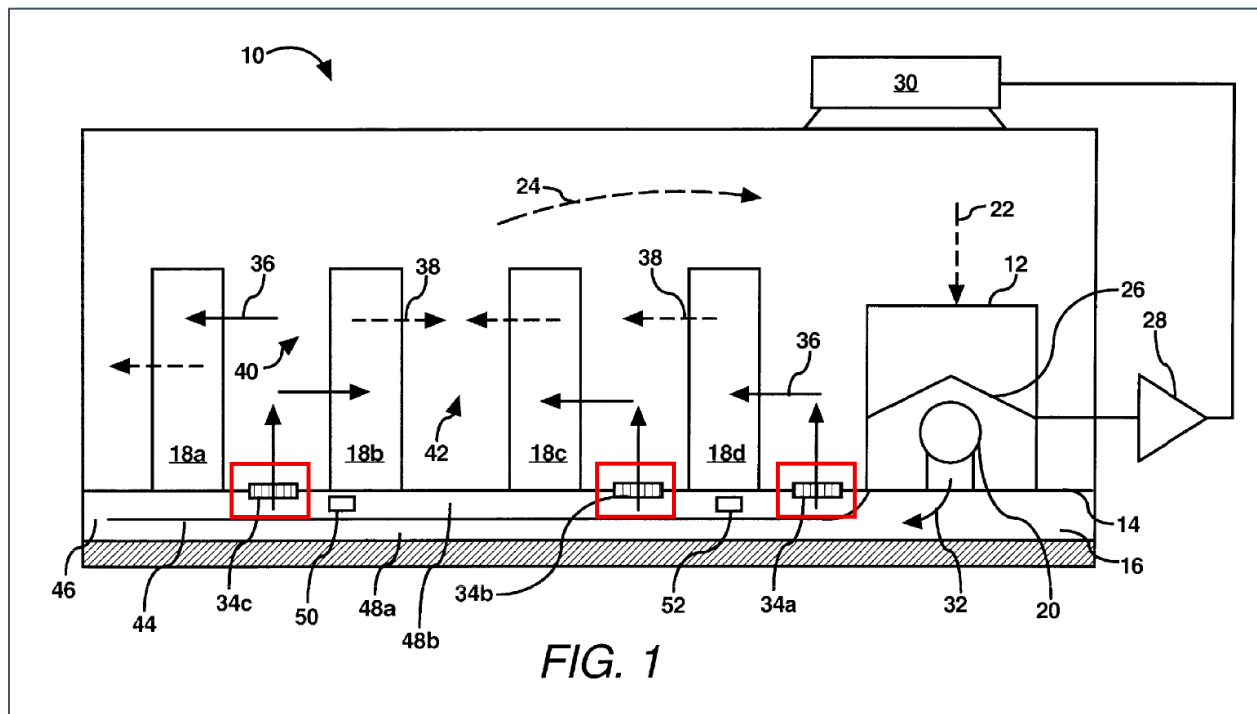
EX1005, FIG. 1 (annotated).

Similarly, Petitioner asserts that *Patel*’s “vents” disclose the claimed “controllable partition”:

With regard to a “controllable partition,” *Patel*’s controllable vents (e.g., 34a-34c) disclose the controllable

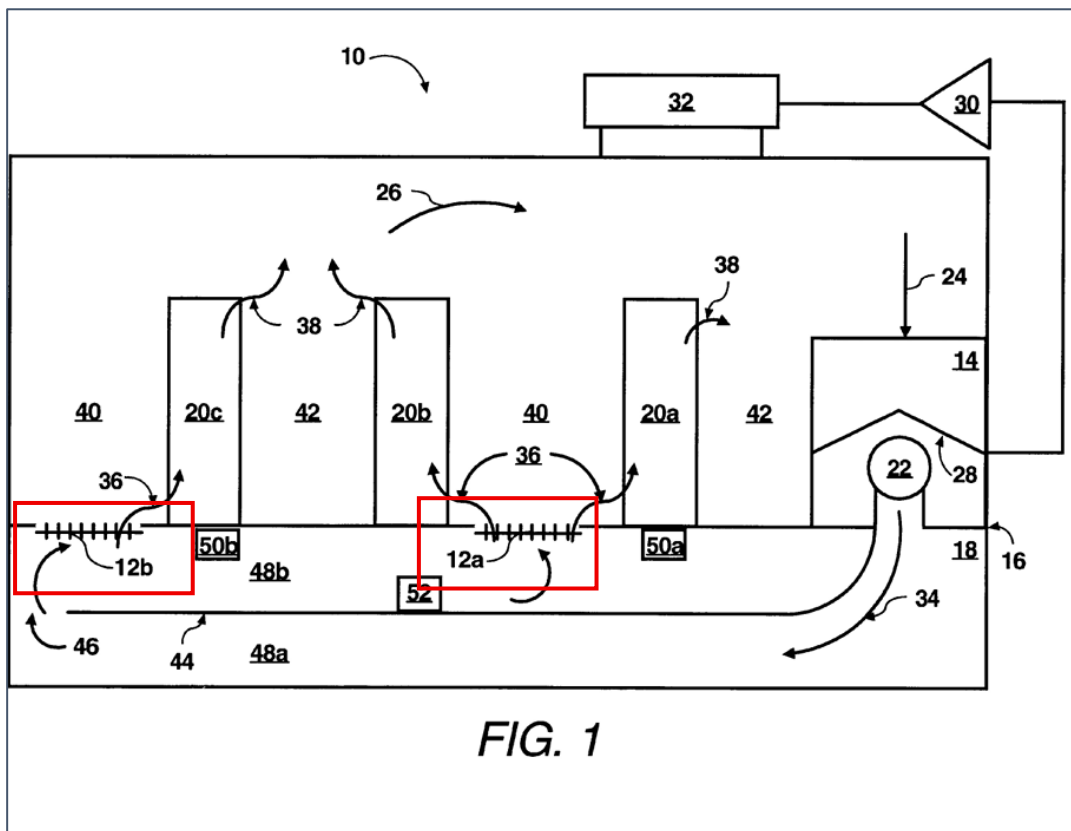
partition under Patent Owner’s expected construction of “partition” to encompass any device capable of manipulating the flow of cooling fluid. As discussed above, the dynamically controllable vents 34a-34c operate to control the velocity and the volume flow rate of the cooling air into aisles of the data center containing racks. Ex. 1006, 5:8–11. For example, Patel teaches that the “cool aisles 40 are those aisles that include the vents 3[4]a-3[4]c and thus receive cooling fluid for delivery to the racks 18a-18d.” Ex. 1006, 5:23–26. Ex. 1002 ¶¶287-288.

Petition (Paper 1), 52 (emphasis added); *see also* EX1006 (*Patel*), FIG. 1 (annotated below to show vents 34a-c in red):



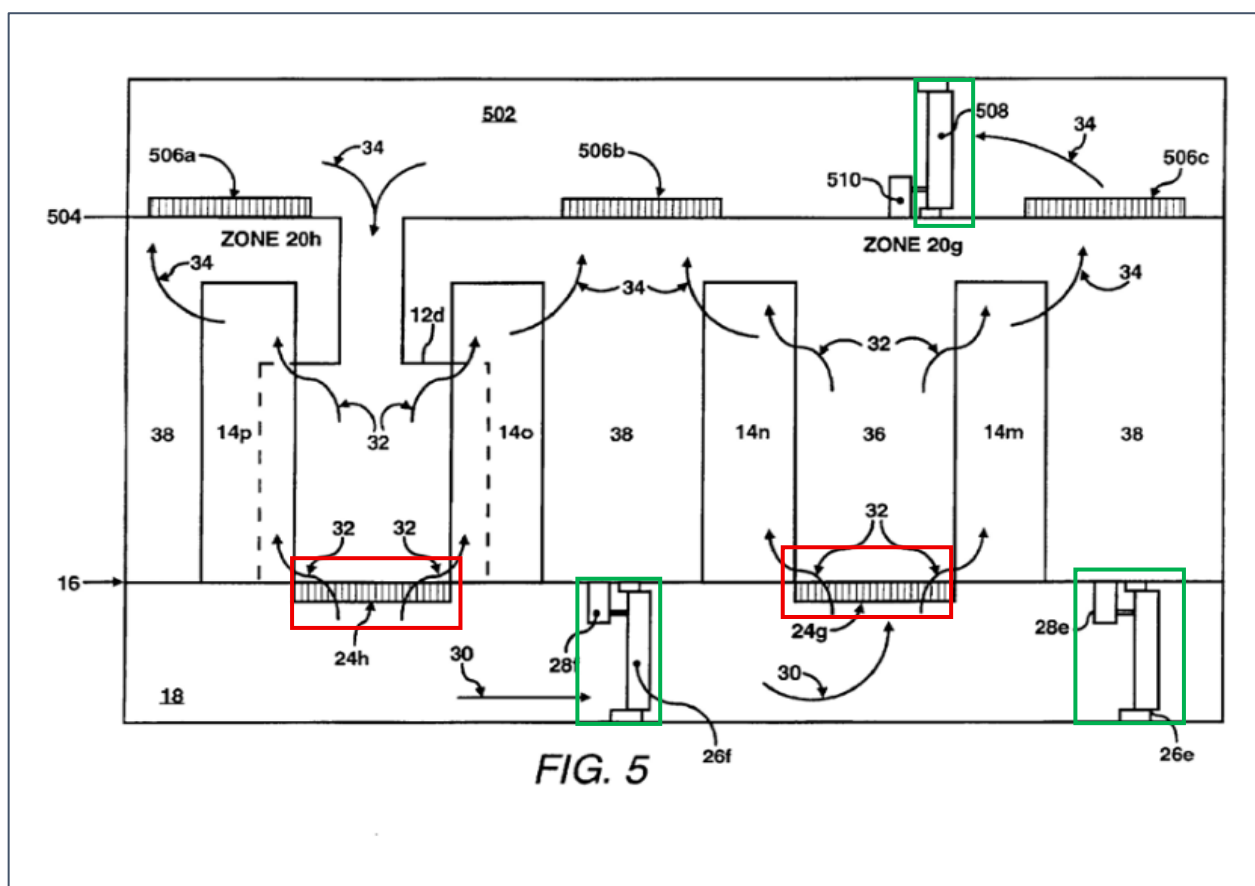
EX1006, FIG. 1 (annotated).

Importantly, the vents of *Bash* and *Patel* are also disclosed in *Bash* '759 (and separate from the “controllable partitions” disclosed only in the '179 Patent specification and explained in the prosecution history). For instance and as discussed in Section III.A.1, above, similar to *Bash* and *Patel*, *Bash* '759 discloses that vents 12a and 12b (i) can be used to “modulate the flow of cooling fluid flowing” in “chamber 48b,” (ii) may be used to adjust the cooling fluid in the plenum to the “cooling requirements of the racks 20a-20b,” and (iii) are horizontally disposed between the racks 20a-20c and allow for air to pass directly from the plenum to the rack area. EX2047, 8:1-22. This can be seen in Figure 1 of *Bash* '759, reproduced below:



EX2047 (*Bash* '759), FIG. 1 (annotated).

Moreover, the understanding that the vents of *Bash* and *Patel* are also the vents of *Bash* '759—but not the controllable partitions in the '179 Patent—is bolstered by the fact that *Bash* '759 includes inventors listed on *Bash*, *Patel*, and the '179 Patent, who would logically have used the same term to describe the same feature. These same inventors understood that “controllable partitions” as described by the '179 Patent were not “vents” as disclosed by *Bash*, *Patel*, *Bash* '759, and the '179 Patent. That is, *Bash*, *Patel*, *Bash* '759, and the '179 Patent all share common inventors and disclose “vents,” but *only* the '179 Patent also discloses “controllable partitions” (and separately from the disclosed “vents” for that matter). This distinction, as discussed above in detail in Section III.A.1 and briefly below, is also consistent with the '179 Patent itself, which separately discloses vents (such as vents 24h and 24g) and controllable partitions (such as CPs 26f, 26e and 508):



EX1001, FIG. 5 (annotated); *see also* Section III.A.1, above (explaining additional disclosure in '179 Patent).

Like *Patel* and *Bash*, the '179 Patent discloses vents 24h and 24g which are located underneath racks 14m-14p. But in addition to these vents, and unlike *Bash* and *Patel*, the '179 Patent further discloses a controllable partition 26f which is disposed between vents 24h and 24g.

Compounding matters and further demonstrating the problems with Petitioner's theory for Grounds 1 and 2, Petitioner points to the same "vents" in *Bash* and *Patel* as disclosing both the "controllable partition" in independent claim 1 and

the separately claimed “vents” in dependent claim 7. Petition (Paper 1), 41-42, 57. Contrary to Petitioner’s assertion, these claims are not “redundant” and a vent, as disclosed in *Bash* and *Patel*, is not “one type of partition.”

Because both *Bash* and *Patel* fail to disclose the “controllable partition” in independent claim 1 (and by dependency, all challenged dependent claims), Petitioner has failed to show a reasonable likelihood of success for any Challenged Claim in its Grounds 1 and 2.

B. *Bishop* in View of *Feeney* and *Kochavi* Does Not Render Challenged Claims 1-6 or 11-13 Obvious.

In Ground 3 of the Petition, Petitioner asserts that *Bishop* in view of *Feeney* and *Kochavi* render claims 1-6 and 11-13 obvious. Petition (Paper 1), 61.⁴ Petitioner’s arguments fail.

Neither *Bishop* nor *Feeney*, alone or together, discloses the claimed “controllable partition”—let alone “manipulating said controllable partition to vary

⁴ While Petitioner identifies this Ground as being a three-reference combination, Petitioner does not cite to or rely on *Kochavi* (EX1011) in its analysis of independent claim 1. See Petition (Paper 1), 61-72. Instead, *Kochavi* is first discussed in reference to dependent claim 3. See Petition (Paper 1), 73; see also *id.*, 62 (identifying *Kochavi* with respect to claim 3). Therefore, *Kochavi* is irrelevant to the arguments in this POPR related to claim 1.

said supply of said cooling fluid to said zone in response to said sensed temperature being outside said predetermined temperature range”—under either Petitioner’s “plain and ordinary meaning” construction of “controllable partition” or Petitioner’s (incorrect) assertion as to Patent Owner’s “implied” construction.⁵

Moreover, even if the references disclose a controllable partition and that the controllable partition is manipulated based on a sensed temperature, Petitioner has failed to show a reasonable likelihood of success that a POSITA would have been motivated to modify, and had a reasonable expectation of success in modifying, *Bishop* with *Feeney* in order to achieve the invention of the Challenged Claims.

In the sections that follow, Patent Owner first addresses Petitioner’s assertions that rely on its incorrect view of Patent Owner’s “implied construction.” Patent Owner then explains why the combination of *Bishop* and *Feeney* still fails under Petitioner’s “plain and ordinary meaning” construction. And finally, Patent Owner explains Petitioner’s failures as to alleged motivation and reasonable expectation of success.

⁵ As explained in Section III.A above, Petitioner is wrong to equate “vents” with the “controllable partition.” Thus, Petitioner’s theory under such a construction necessarily fails in Ground 3 as it did in Grounds 1 and 2.

1. *Bishop* does not disclose the claimed “controllable partition.”

Petitioner first asserts that *Bishop*’s “damper” corresponds to the claimed “controllable partition.” Petition (Paper 1), 68. While Petitioner concedes that *Bishop* alone does not disclose this limitation under Petitioner’s “plain and ordinary meaning” construction, Petitioner nonetheless asserts that *Bishop*’s dampers meet the limitation under Petitioner’s mistaken view of Patent Owner’s “expected” construction. Petition (Paper 1), 68-69. Petitioner’s Ground 3 under this theory thus fails for the same reasons as Grounds 1 and 2, and Petitioner’s concession is enough to demonstrate that Petitioner fails to show a reasonable likelihood of success as to *Bishop*’s dampers alone meeting the claimed “controllable partition.”

2. The combination of *Bishop* and *Feeney* does not disclose the claimed “controllable partition” or claim steps 1[a] or 1[d].

After acknowledging that “Bishop does not expressly describe dampers that are associated with barriers that subdivide the space 78 below the raised floor 74,” Petitioner next argues that, “[t]o the extent that limitation 1[a] is interpreted to require a controllable wall or barrier that subdivides the plenum space, this would have been obvious to a POSITA based on the combined teachings of Bishop and Feeney and a POSITA’s knowledge of conventional technologies, tools, and practices.” Petition (Paper 1), 68-69.

While Petitioner’s theory as to what constitutes the claimed “controllable partition” is not entirely clear, Petitioner does concede that *Feeney* itself does not

disclose the claimed “controllable partition.” And, in any event, *Feeney* does not. Indeed, even assuming *Feeney* discloses the general concept of a “partition,” it does not disclose the claimed “controllable partition” in step 1[a], let alone a “controllable partition” that is “manipulat[ed] ... to vary said supply of said cooling fluid to said zone in response to said sensed temperature being outside said predetermined temperature range,” as required by step 1[d]. Nor does Petitioner so assert: it relies *exclusively* on *Bishop* to assert that step 1[d] is met. *See* Petition (Paper 1), iii (Challenged Claims), 72. Its entire discussion of step 1[d] in Ground 3 consists of a single, two-sentence paragraph which mentions only *Bishop* and cites only to *Bishop* paragraphs [0084]-[0085] (as well as three paragraphs from its expert’s declaration [EX1002 ¶¶410-412], which are a copy-and-paste of the Petition, without any additional analysis or explanation). Petition (Paper 1), 72 (citing EX1008 (*Bishop*), [0084]-[0085], EX1002 ¶¶410-412); *see also* *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9, 15 (PTAB Aug. 24, 2022) (precedential) (denying institution and giving little weight to expert opinion that “merely repeats, *verbatim*, the conclusory assertion for which it is offered to support.” (emphasis in original)). Even reviewing and crediting the disclosure of *Bishop* at paragraphs [0084]-[0085], it does not support Petitioner’s conclusory assertion for step 1[d]. These paragraphs discuss only that a controller decreases or increases a damper opening to reduce or increase “cooling air flow”; they say nothing about (i) the alleged “controllable

partition” or how that fits into Petitioner’s theory or (ii) such “controllable partition” being “manipulat[ed] ... to vary said supply of said cooling fluid to said zone...” as required by step 1[d].

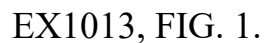
Petitioner’s two-sentence assertion as to step 1[d] alone shows that Petitioner has failed to meet its burden in Ground 3 as to the alleged *Bishop/Feeney* combination. This is because Petitioner concedes that *Bishop* does not disclose the claimed “controllable partition” but then proceeds, for step 1[d], to rely solely on *Bishop* (in cursory, two-sentence fashion, no less). There is simply no assertion—or any showing—that the combination discloses or renders obvious the claim as a whole (including as to how the combination applies to claim step 1[d]). Importantly, nowhere does Petitioner assert, or evidence, how the alleged “controllable partition”⁶ is “manipulat[ed] ... to vary said supply of said cooling fluid to said zone in response to said sensed temperature being outside said predetermined temperature range,” as required by step 1[d].

As to *Feeney*, Petitioner agrees that *Feeney* itself does not disclose the claimed “controllable partition.” And again, *Feeney* does not. *Feeney*, titled “Modular Floor

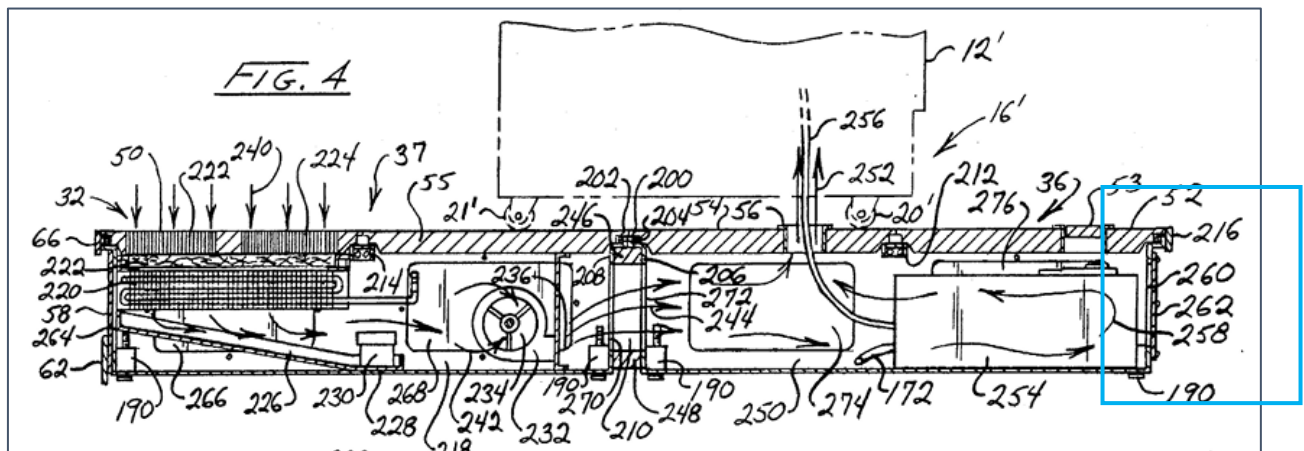
⁶ As best Patent Owner can understand, the alleged “controllable partition” under Petitioner’s “plain and ordinary meaning” construction is a combination of disclosure from *Bishop* and *Feeney*, together with the knowledge of a POSITA.

EX1013, FIG. 1.

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user can define the paths for cooling air flow under the raised floor and through vented floor tiles by selective closure of air transfer openings in vertically oriented walls that subdivide the plenum space.” Petition (Paper 1), 69 (citing EX1013, 10:20-22). *Feeney* at 10:20-22 is discussing Figure 4, and states that “[t]he airpaths thus described are defined by gasketing and the selective closure of the panel openings as earlier described at 96-101 in connection with FIG. 2.” EX1013, 10:20-22. *Feeney* then continues in the next sentence: “In this regard, the enclosure of the outside widthwise opening 260 of floor module 36 is by a thin sheet metal panel cover 262 which is connected to the module by sheet metal screws.” EX1013, 10:22-25. These screwed-on plates can be seen in Figure 4 of *Feeney*:



EX1013, FIG. 4 (annotated).

And even assuming, *arguendo*, that the “thin sheet metal panel cover 262” is a “partition,” *Feeney* does not disclose that this partition is controllable (nor does Petitioner so assert). *Feeney* discloses that this cover is either affixed or not affixed

by “sheet metal screws.” EX1013, 10:24-25. *Feeney* does not disclose that these affixed plates are in any way controllable, let alone controllable in the context of claim 1’s requirements. Again, claim 1 of the ’179 Patent requires a “*controllable* partition” including 1[a] “activating a cooling device and opening a controllable partition configured to vary a supply of cooling fluid within a zone of said data center, said zone including at least one associated rack of said plurality of racks” and 1[d] “manipulating said controllable partition to vary said supply of said cooling fluid to said zone in response to said sensed temperature being outside said predetermined temperature range.” These are not disclosed in *Feeney* (and regardless, Petitioner does not rely on *Feeney* at all for step 1[d]).

3. Petitioner fails to show that a POSITA would have been motivated to modify, and had a reasonable expectation of success in modifying, *Bishop* in light of *Feeney* to achieve the claimed invention of the ’179 Patent.

Petitioner’s Ground 3 also fails to demonstrate a reasonable likelihood of success for an additional reason: lack of motivation to combine and reasonable expectation of success.

Petitioner asserts that a POSITA would have been motivated to combine, and had a reasonable expectation of success in combining, the teachings of *Bishop* with *Feeney* (and thus render obvious claim 1).⁷ In particular, Petitioner asserts that “[i]f

⁷ As discussed above in n.4, Petitioner does not rely on *Kochavi* for claim 1.

independent claim 1 is interpreted such that the controllable partitions are barriers that subdivide the plenum space, a POSITA familiar with Bishop's teachings and Feeney's teachings would have been motivated to modify a preferred embodiment of Bishop by providing cooling air flow control dampers in the form of barriers that subdivide the space beneath Bishop's raised floor platform." Petition (Paper 1), 62.

Petitioner also asserts that "[i]t would have been obvious to a POSITA familiar with Bishop's system and Feeney's additional teachings to modify Bishop to provide controllable dampers within barriers that subdivide plenum space 78 into sections or zones" and that "a POSITA would have recognized that breaking up the plenum space into smaller regions would help avoid undesirable pressure imbalances, a concern that Bishop specifically acknowledges." Petition (Paper 1), 69 (citing EX1008, [0088]). But *Bishop* at paragraph [0088] does not support the proposition for which Petitioner cites it. Rather, *Bishop* simply recognizes that "disparate pressures and temperatures in space 78 are relatively more important" in cases "where cool air is delivered to cabinet assemblies (e.g., 14a)," that "pressure and temperature sensors 50 and 52 are provided on each damper (e.g., 21) (see FIG. 2)," and that the readings from these sensors are "provided to supervising controller 16," which "uses these readings to diagnose problems such as obstructions within space 78, inefficient cooling and inefficient pressure generation." EX1008, [0088].

This says *nothing* about breaking up the plenum space or how that would allegedly “avoid undesirable pressure imbalances,” as Petitioner asserts “a POSITA would have recognized.” Moreover, although not cited by Petitioner here, its expert does not provide any additional analysis or support for this proposition. Instead, its expert’s declaration again is a word-for-word, copy-and-paste, without additional evidence or explanation. *Compare* Petition (Paper 1), 69 with EX1002 ¶397. Even if considered, the expert’s copy-and-paste should thus be afforded little to no weight, *see Xerox*, IPR2022-00624, Paper 9, 15, leaving Petitioner with no actual evidence to support its assertions.

The remainder of Petitioner’s conclusory assertions similarly fail—they consist of a handful of assertions that rely on the ’179 Patent, its expert’s copy-and-paste declaration, or nothing at all. Petition (Paper 1), 69-71.

As to Petitioner’s reliance on the ’179 Patent, Petitioner asserts that “[a] POSITA would further appreciate that this would provide other similar benefits to those stated in the ’179 patent, such as assuring that sufficient cooling air is distributed from one zone to another in order to better control the amount of cooling air delivered to the racks in each zone.” Petition (Paper 1), 69-70 (citing only to EX1001, 4:11-31). Critically, the ’179 Patent at 4:11-31 is disclosing benefits of its *own invention* (including its “controllable partitions”), and Petitioner’s reliance on the ’179 Patent as a roadmap is not evidence of obviousness, but rather evidence of

improper hindsight bias. *See Intouch Techs., Inc. v. VGo Commc'ns, Inc.*, 751 F.3d 1327, 1351-52 (Fed. Cir. 2014) (“It appears that [the expert] relied on the ’357 patent itself as her roadmap for putting what she referred to as pieces of a ‘jigsaw puzzle’ together. [The] expert also succumbed to hindsight bias in her obviousness analysis.”); *TQ Delta, LLC v. Cisco Sys., Inc.*, 942 F.3d 1352, 1361 (Fed. Cir. 2019) (“We repeatedly expressed concerns that crediting such testimony risks allowing the challenger to use the challenged patent as a roadmap to reconstruct the claimed invention using disparate elements from the prior art—i.e., the impermissible *ex post* reasoning and hindsight bias that *KSR* warned against”); *Hamilton Beach Brands, Inc. v. f’real Foods, LLC*, 908 F.3d 1328, 1342 (Fed. Cir. 2018) (“substantial evidence supports the Board’s finding that the combination [of prior art references] does not teach or suggest the [claim limitations] without relying on the claim as a roadmap for selecting and modifying the teachings” and therefore the references do not render the claims obvious) (cleaned up).

And although not cited by Petitioner here, its expert’s declaration once again is a copy-and-paste using this hindsight bias approach, without further analysis or evidence. *Compare* Petition (Paper 1), 69-70 with EX1002 ¶397; *see also Xerox*, IPR2022-00624, Paper 9, 15; *Active Networks, Inc. v. Verizon Commc'ns, Inc.*, 694 F.3d 1312, 1327-28 (Fed. Cir. 2012) (“the obviousness testimony by Verizon’s

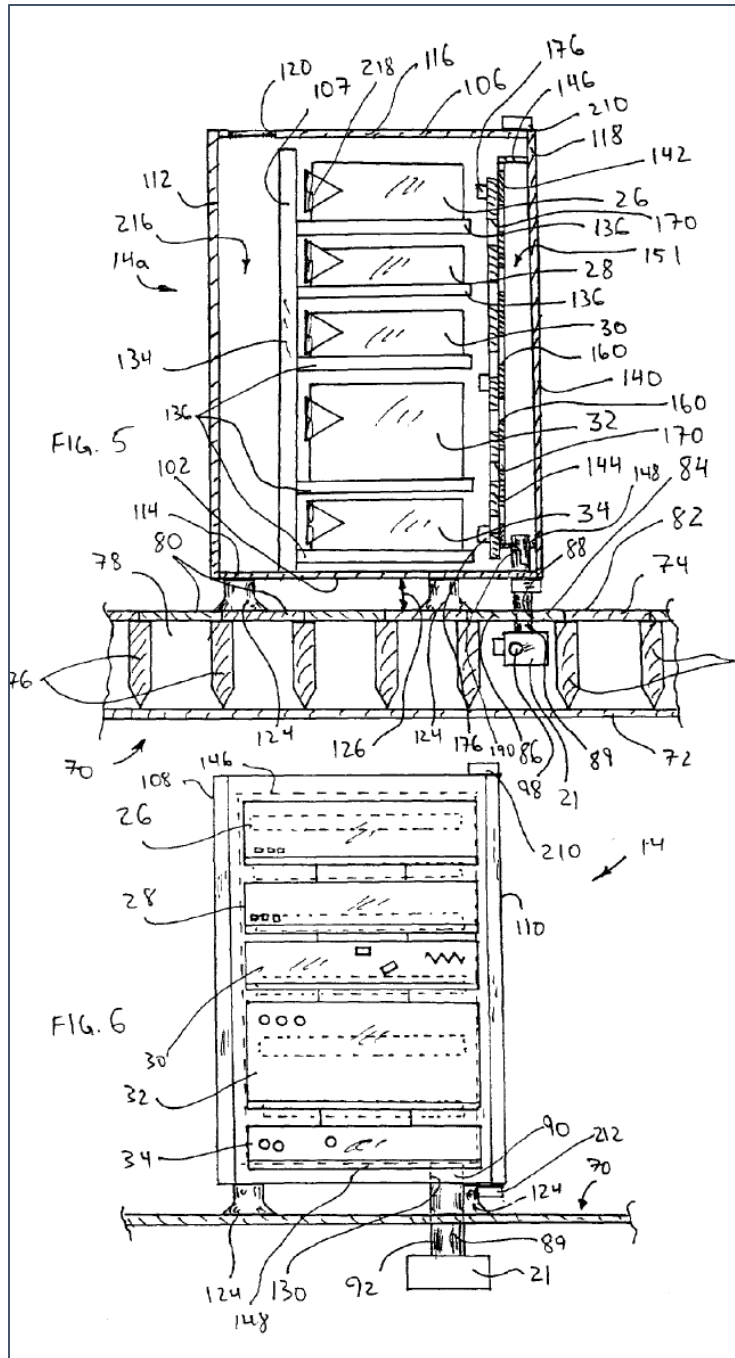
expert was conclusory and factually unsupported,” and thus insufficient to show obviousness).

Petitioner also conclusorily asserts there were “additional benefits in terms of flexibility to adjust the system to accommodate operating multiple cooling systems to provide cooling air to a large number of racks” that was “also suggested by Feeney” and that “[t]he system of Feeney has a subdivided pressurized plenum space to distribute cooling air from multiple cooling devices along optimized plenum flow paths using partitions to properly balance the supply of cooling fluid between cooling devices and heat loads.” Petition (Paper 1), 70 (citing EX1002 ¶397). Here too, the expert declaration is a copy-and-paste of the Petition, without additional analysis or evidence. EX1002 ¶397. *See also Xerox*, IPR2022-00624, Paper 9, 15.

Petitioner makes one last assertion that “modifying Bishop’s system to include subdividing barriers in the plenum space would improve both Bishop’s and Feeney’s systems because the vertical barriers would be controllable in response to changing temperature conditions.” Petition (Paper 1), 70. But again, Petitioner’s argument rests entirely on its unsupported and conclusory copy-and-paste opinion of its expert. EX1002 ¶398. *See also Xerox*, IPR2022-00624, Paper 9, 15.

Beyond these evidentiary failures, which alone demonstrate that Petitioner has failed to show a reasonable likelihood of success for its Ground 3, Petitioner—in one sentence—conclusorily asserts that the plenum space 78 of *Bishop* could be

broken into smaller regions using the plates of *Feeney* inserted into adjacent beams 76. Petition (Paper 1), 64-65. So too does its expert, repeating, *verbatim*, the same assertion. EX1002 ¶375. This assertion is both entirely conclusory and ignores the actual teachings of *Bishop*. The “support beams 76” in *Bishop* provide support for the cabinet assemblies. EX1008, [0063]. *Bishop* explains that “[c]ooling controller [21] is sized so that it fits between adjacent members 76 below assembly 74 and is positioned such that an opening 98 is *unobstructed* by any of members 76.” EX1008, [0065] (emphasis added). This design can be seen in Figures 5 and 6 of *Bishop*, reproduced below. Logically, the support beams 76, while oriented not to obstruct the controller, would not be designed to allow flow from a vertically disposed plate to reach the controller unobstructed. Nor does Petitioner point to any evidence that they would.



EX1008, FIGs. 5-6.

Notwithstanding, even if the area between support beams 76 could be structured such that the support beams 76 do not obstruct the newly added plate of *Feeney*, Petitioner still fails to explain how to modify the controller of the dampers

of *Bishop* to control the separate plates of *Feeney*. Instead, Petitioner simply concludes that using the controller of *Bishop*, a POSITA could modify *Feeney*'s fixed plates to be "controllable in response to changing temperature conditions" to manipulate airflow.⁸ Petition (Paper 1), 70. But how a fixed plate would be reconfigured to both (1) attach to a controller and (2) attach to the plenum area such that the plate could be opened or closed to vary the cooled fluid is entirely undisclosed and unexplained. Petitioner fails to show how a POSITA would modify the plate of *Feeney* with the damper controller of *Bishop* without the use of an actuator or equipment to attach the plate to the plenum, or that such a modification is disclosed in any of the cited references.

Notwithstanding, and even assuming that the structure of *Bishop* would allow for the further unobstructed subdivision of the plenum space by a plate *and* that a POSITA would understand how to effectively modify a fixed plate onto a plenum so as to allow for the control of air flow, Petitioner's combination would still fail because Petitioner has failed to provide any actual motivation, other than the '179 Patent itself (as discussed above), to make such a combination.

⁸ Amongst other reasons that this argument fails is that Petitioner does not explain why or how plates that are screwed down could be modified with a controller to vary airflow without fundamentally changing how the plate is affixed to the structure.

In sum: because Petitioner does not show that either *Feeney* or *Bishop* disclose the elements of claim 1 individually or in combination, or that a POSITA would have been motivated to combine, and had a reasonable expectation of success in combining, these references to meet the claims, Petitioner's obviousness ground fails. Petitioner has thus failed to show a reasonable likelihood of success for its final Ground 3.

IV. THE BOARD SHOULD NOT CONSIDER THE PETITION BECAUSE PETITIONER FAILED TO NAME ALL REAL PARTIES IN INTEREST AND PRIVIES

As an independent basis for denying institution, the Board should not consider the Petition because Petitioner failed to name all real parties-in-interest and privies. Here, Petitioner identified only Vertiv Corporation as a real party in interest. Petition (Paper 1), §II.A. However, as explained below, Petitioner is funding, directing, and controlling the litigation between Patent Owner and various district court defendants, including at least DataBank and TierPoint, making at least those parties RPIs or privies here that should have been identified in the Petition.

A. Proper Identification of RPIs is Required by Statute to Consider a Petition.

Section 312(a)(2) states that a Petition “may be considered only if ... the petition identifies all real parties in interest.” 35 U.S.C. §312(a)(2). As the Consolidated Trial Practice Guide explains:

The core functions of the “real party-in-interest” and “privies” requirements are to assist members of the Board in identifying potential conflicts, and to assure proper application of the statutory estoppel provisions. The latter, in turn, seeks to protect patent owners from harassment via successive petitions by the same or related parties, to prevent parties from having a “second bite at the apple,” and to protect the integrity of both the USPTO and federal courts by assuring that all issues are promptly raised and vetted.

CTPG, 12-13.

In determining if a party is a “real party-in interest” or “privy” the Office applies a flexible standard and “avoid[s] rigid definitions or recitation of necessary factors.” *Id.*, 13. Central to the RPI inquiry is a consideration of facts that “justify applying conventional principles of estoppel and preclusion.” *Id.* As to privy:

The notion of “privity” is more expansive, encompassing parties that do not necessarily need to be identified in the petition as a “real party-in-interest.” The Office intends to evaluate what parties constitute “privies” in a manner consistent with the flexible and equitable considerations established under federal caselaw. Ultimately, that analysis seeks to determine whether the relationship between the purported “privy” and the relevant other party is sufficiently close such that both should be bound by the trial outcome and related estoppels.

Id., 14-15.

A common consideration in determining whether a party is a privy is whether the party “exercised or could have exercised control” over a party. *Id.*, 16. Customers of a supplier have previously been considered RPIs if the manufacturer has indemnified the supplier and has the opportunity to control litigation involving the supplier’s use of the manufacturer’s goods. *See Ventex Co. Ltd. v. Columbia Sportswear N.A., Inc.*, IPR2017-00651, Paper 148, 8-9 (PTAB Jan. 24, 2019) (“The exclusive business relationship between Ventex and Seirus relating to the accused Heatwave fabric, and Ventex’s express desire to shield its customers and potential buyers from infringement lawsuits by Columbia strongly suggest that Ventex filed the Petition, at least in part, on Seirus’s behalf”); *PayPal, Inc. v. Ioengine, LLC*, IPR2019-00884, Paper 22, 9 (PTAB Oct. 3, 2019) (“*PayPal v. Ioengine*”) (“Although Petitioner and Ingenico are not codefendants in a single patent infringement proceeding, Ingenico filed a declaratory judgment action seeking a declaration that Ingenico and its customers, including Petitioner, do not infringe the ’047 patent and Patent Owner filed patent infringement counterclaims. The two district court actions have been consolidated for pre-trial purposes. Ingenico’s supplying products to Petitioner that Patent Owner alleges infringe the ’047 patent, the indemnification agreement between Petitioner and Ingenico, and the consolidated district court proceedings constitute a sufficiently significant

relationship between Ingenico and Petitioner for purposes of applying the General Plastic factors.”); *Volkswagen Grp. of Am., Inc. v. Arigna Tech. Ltd.*, IPR2021-01263, Paper 16, 11 (PTAB Jan. 21, 2022) (finding that “a customer-supplier relationship, with agreements between them that required one to indemnify the other” is sufficient to show that a non-party is a real party in interest).

B. Petitioner Failed to Identify All RPIs.

Here, Petitioner did not identify the correct RPIs or privies. Petitioner directs and controls two consolidated district court litigations involving the ’179 Patent, *Valtrus Innovations Limited v. DataBank Holdings Ltd.*, No. 2:24-cv-00777 (EDTX) (Lead Case) and *Valtrus Innovations Limited v. TierPoint, LLC*, No. 2:24-cv-00776 (EDTX) (Member Case) (together, the “*DataBank* Action”). The *DataBank* Action is a consolidated case involving two of Petitioner’s customers, DataBank and TierPoint. These cases were consolidated for all pre-trial activities, but the individual cases remain active for separate trials. EX2003, 1 (Consolidation Order).⁹ In both

⁹ With the exception of any patents (cited by column and line number) and citations to paragraph numbers, Patent Owner uses the exhibit page numbering in the lower righthand corner of the Exhibits. For example, exhibit page number 12 of Exhibit 2007 (cited below in the following paragraph in this Section IV.B) corresponds to numbered page 8.

cases, Patent Owner has asserted that Petitioner's customers directly infringe claims from the '179 Patent, and both DataBank and TierPoint have asserted defenses and counterclaims alleging that the '179 Patent is invalid and not infringed. EX2004, 10, 21-22; EX2005, 7-8, 15.

Petitioner has also claimed that there is declaratory judgment jurisdiction between it and Patent Owner because Petitioner "is contractually bound to indemnify and defend customers against patent infringement claims related to the use of Vertiv products pursuant to various contracts and sales agreements." EX2006, 12 (¶67). Petitioner has likewise admitted that it has indemnity obligations to DataBank and TierPoint and that, as part of those indemnification agreements, Petitioner "has the right to select counsel, *direct and control* the defense of the claims directed to Vertiv technology and generally control settlement negotiations." EX2007, 12 (emphasis added). Per Petitioner, "[u]nsurprisingly, [Petitioner's] customers have pursued those contractual rights" and have "demand[ed] that Vertiv indemnify and defend the claims directed to [Petitioner's] technology." EX2007, 12. As a result of those indemnification obligations, Petitioner has engaged the same lawyers in both actions, and Petitioner's counsel has appeared on behalf of both DataBank and TierPoint. EX2008, 1-2; EX2009, 1. As part of that representation, Petitioner's counsel has managed the day-to-day aspects of the litigation in the DataBank Action, including document productions, correspondence, and service of invalidity

contentions. *See* EX2010, EX2011, EX2012, EX2013, EX2014. Petitioner has also served invalidity contentions *bearing Petitioner’s name*. EX2012, 1 (serving “[o]n behalf of Tierpoint and DataBank” invalidity contentions including “Attachments: 2025-04-01 – Vertiv’s Invalidity Contentions – Cover Pleading.pdf”); *see also* EX2023 (contentions cover pleading).

In analogous circumstances, the Board has acknowledged that such supplier-customer indemnification agreements affect the consideration of estoppel in IPR proceedings. *See, e.g., Ventex*, IPR2017-00651, Paper 148, 8-9; *PayPal v. Ioengine*, IPR2019-00884, Paper 22, 9; *Volkswagen*, IPR2021-01263, Paper 16, 11. Here, the Board should reject Petitioner’s claim that it “is not a party to” the *DataBank* Action, Petition (Paper 1), 83, and acknowledge Petitioner’s central role in DataBank’s and TierPoint’s defense, including their invalidity arguments and strategy.

Importantly, Petitioner’s failure to name all of the real parties in interest (“RPIs”) or privies means that it failed to meet the statutory requirements under 35 U.S.C. §312(a)(2) (A Petition “may be considered *only if*” the “petition identifies all real parties in interest”) (emphasis added); *see also* 37 C.F.R. §42.8(b)(1). Petitioner identifies only Vertiv Corporation as an RPI or privy to the Petition and entirely ignores the roles of DataBank and TierPoint (and the *DataBank* Action) (as well as additional RPIs and privies from the earlier litigations). *See* Petition (Paper 1), 1.

But, as explained above, Petitioner has admitted that it has entered into indemnity agreements with DataBank and TierPoint (and others) and controls the defenses of both DataBank and TierPoint in the *DataBank* Action. The indemnification requirements of its agreements and the direction and control that Petitioner exerts over the *DataBank* Action makes DataBank and TierPoint RPIs or privies to this Petition. *Ericsson Inc. v. Regents of the Univ. of Minn.*, IPR2017-01213, Paper 56, 5, 14 (PTAB June 19, 2020) (finding that “supply agreements” that “require” a party to “indemnify” its customers against patent infringement and the “opportunity to control the defense” of other defendants creates a privity relationship between a petitioner and other “district court defendants”); *Bungie, Inc., v. Worlds Inc.*, IPR2015-01264, Paper 64, 35, 45 (PTAB Jan. 14, 2020) (finding that a non-party is a privy when an “indemnification provision” supports a finding that the Petitioner and non-party “had a preexisting business relationship regarding the defense of infringement allegations” and the non-party “benefited from the filing of the petitions” making the non-party RPI and finding the Petition “time-barred under § 315(b)”); *PayPal, Inc. v. Personal Web Techs., LLC*, IPR2019-01111, Paper 27, 23 (PTAB Nov. 22, 2019) (finding non-party to be a privy when it had a supplier-customer relationship with Petitioners, the non-party has “performed pursuant to [an] indemnity agreement” and “actually assumed control of the lawsuits involving its customers [and] defended them”); *Clear-Vu Lighting, LLC v Univ. of*

Strathclyde, IPR2019-00588, Paper 24,¹⁰ 9 (PTAB Sept. 30, 2019) (finding that a party is an RPI when it “would have been obligated to fund and control the defense” of a related patent litigation); *RPX Corp. v. Applications in Internet Time, LLC*, IPR2015-01750, Paper 128, 9, 25 (PTAB Oct. 2, 2020) (on remand from the Federal Circuit, finding that a Salesforce, a customer of RPX, was an RPI “given the significant relationship between Salesforce and RPX and the strong economic incentives on RPX to represent Salesforce’s interests”).

C. The Board’s Prior Decisions Permitting Parties to Not Name all RPIs are Incorrect and Procedurally Void.

Patent Owner recognizes that certain prior Board decisions, including *SharkNinja Operating LLC v. iRobot Corp.*, IPR2020-00735, Paper 11, 10-11 (PTAB Oct. 13, 2020) (precedential), found that the Board should not deny institution based on a failure to name all RPIs when there is no time bar implication due to the “interests of cost and efficiency.”¹¹ Respectfully, these decisions are both

¹⁰ Public version available at Paper 28.

¹¹ Patent Owner also respectfully submits that this is an important consideration under the facts here, as Petitioner filed its Petition only days before the statutory deadline for its RPIs and privies. *See* EX2020, 2; EX2019, 8. Not only does Petitioner’s affirmative failure demonstrate that Petitioner has failed, as a matter of

incorrect as a matter of law and are procedurally void because they are not the product of required notice-and-comment rulemaking. The Director is authorized to de-designate precedential decisions and issue a decision correctly interpreting the statute.

V. CONCLUSION

For the reasons explained above, Patent Owner respectfully submits that the Board should deny institution of the Petition.

Dated: July 14, 2025

Respectfully submitted,

/Patrick Colsher/

Patrick Colsher (Reg. No. 74,955)

Counsel for Patent Owner

law, to meet the IPR statutory requirements, but without a decision, Petitioner could file additional Petitions and force both Patent Owner and the Board to expend further unnecessary resources.

CERTIFICATE OF COMPLIANCE

I hereby certify that this paper complies with the type-volume limitation of 37 C.F.R. §42.24 (as determined by the Microsoft Word word-processing system used to prepare this paper) because it contains 8,942 words, excluding the parts of the paper exempted by 37 C.F.R. §42.24(a).

Dated: July 14, 2025

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CERTIFICATE OF SERVICE

I hereby certify that the foregoing document and any Exhibits listed on the List of Exhibits (not previously served) were served on July 14, 2025, via electronic mail upon counsel of record for Petitioner at the following email addresses:

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