

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DYNATEMP INTERNATIONAL, INC. and FLUOROFUSION
SPECIALTY CHEMICALS, INC.,

Petitioner,

v.

R 421A LLC d/b/a CHOICE REFRIGERANTS,
Patent Owner.

PGR2021-00008
Patent 10,703,949 B2

Before GRACE KARAFFA OBERMANN, MICHELLE N. ANKENBRAND,
MONTÉ T. SQUIRE, and JAMIE T. WISZ, *Administrative Patent Judges*.¹

OBERMANN, *Administrative Patent Judge*.

DECISION
Dismissal Prior to Institution of Trial
35 U.S.C. § 314

¹ This is not an expanded panel. The caption identifies judges assigned to one or more of three related cases, namely, the instant case, IPR2020-01660 (“IPR660”) and IPR2021-00199 (“IPR199”). These judges presided over a consolidated teleconference in the three proceedings on May 18, 2021. We file related Decisions today in IPR660 and IPR199.

In an email to the Board dated May 11, 2021, Petitioner requested permission to file a motion to withdraw the Petition. Ex. 3001. Petitioner stated that Patent Owner opposes the request. *Id.* The Board (Judges Squire, Obermann, Ankenbrand, and Wisz) held a telephonic conference call on May 18, 2021, attended by counsel for Petitioner, Mr. Jon Trembath, and counsel for Patent Owner, Mr. Jason Perilla. Neither party retained a court reporter. This Decision represents the official record of the teleconference.

The Board provided Petitioner and Patent Owner, sequentially, an opportunity to present arguments relating to Petitioner's request. Petitioner began by asserting that withdrawal of the Petition is warranted in the instant proceeding because, as shown by the outcome of the related proceeding in IPR660, the Board "is not equipped to handle misrepresentations" allegedly advanced by Patent Owner. Petitioner also asserted that it was denied adequate briefing in IPR660 on issues surrounding the Board's decision to exercise its discretion to deny review under 35 U.S.C. § 325(d). *See* IPR660, Paper 15 (decision denying institution, entered April 20, 2021).

Patent Owner opposed Petitioner's request, given the Board is poised to adjudicate the matter (in fact, pre-institution briefing by the parties is complete) and the relief requested by Petitioner may unfairly prejudice Patent Owner. Specifically, Patent Owner argued that the relief requested may prejudice Patent Owner's interest because withdrawal of the instant Petition will not prevent Petitioner from filing one or more subsequent petitions challenging the patent at issue.

There was some discussion about whether a statement Petitioner made in the email to the Board was binding on Petitioner. *See* Ex. 3001, 1 ("If its

motion is granted, Petitioner confirms that it does not intend to file any subsequent petitions with the Board challenging U.S. Patent No. 10,703,949.”). The Board asked Patent Owner whether it would oppose an order memorializing Petitioner’s representation that it will not file any other petition in this forum seeking review of the patent at issue. Patent Owner stated that it would not oppose such an order.

The panel conferred privately after placing counsel on a brief hold. The Board then resumed the teleconference and requested that Petitioner clarify, and identify a basis for, its view that the Board is “not equipped to handle misrepresentations” Patent Owner allegedly advanced. In response, Petitioner began to argue the merits of the patentability challenges raised in IPR660, an endeavor the Board halted because the panel in IPR660 did not reach the merits of any challenge, but rather, entered a discretionary denial under 35 U.S.C. § 325(d). *See* IPR660, Paper 15.

Regarding Petitioner’s argument that it was denied a fair opportunity to address the issues surrounding the discretionary denial in IPR660, the Board observed that Petitioner could have requested, but did not request, permission to file a reply brief in IPR660 to raise any arguments bearing on those issues.² The Board further observed that Petitioner had at its disposal, but declined to exercise, the options of requesting rehearing by the panel or review by the Precedential Opinion Panel of the decision denying institution in IPR660.

² Petitioner did request to file a pre-institution reply brief, but only to address “Patent Owner’s Preliminary Response to show that cyclopentane is neither a refrigerant nor a gas.” IPR660, Ex. 3001, 7. The Board granted that request. IPR660, Paper 13.

The Board informed the parties that the panel had conferred and decided to dismiss the instant Petition based on the circumstances presented. The Board further advised the parties that our order would include, based on Petitioner's representations, a prohibition that Petitioner shall not file in this forum any other petition requesting review of U.S. Patent No. 10,703,949 B2. Upon further questioning, Petitioner expressly affirmed that it willingly agrees to abide by that prohibition. Given that agreement, the Board determined that any prejudice to Patent Owner based on dismissal of the instant Petition is minimal or nil.

The Board interprets Petitioner's request to withdraw the Petition as a request for voluntary dismissal prior to institution. This Decision does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

ORDER

Accordingly, it is

ORDERED that the Petition is *dismissed*; and

FURTHER ORDERED that Petitioner shall not file in this forum any other petition requesting review of U.S. Patent No. 10,703,949 B2.

PGR2021-00008
Patent 10,703,949 B2

FOR PETITIONER:

Edward M. Roney IV
Robert Goozner
Jon R. Trembath
MICHAEL BEST & FRIEDRICH LLP
emroney@michaelbest.com
robert.goozner2@gmail.com
jrtrembath@michaelbest.com

FOR PATENT OWNER:

Jason M. Perilla
THOMAS | HORSTEMEYER, LLP
jason.perilla@thomashorstemeyer.com