

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DUKE MANUFACTURING CO.,
Petitioner,

v.

LOW TEMP INDUSTRIES, INC.,
Patent Owner.

Case IPR2021-00414
U.S. Patent No. 8,661,970

**PATENT OWNER'S REQUEST FOR REHEARING OF THE
DECISION GRANTING INSTITUTION OF *INTER PARTES* REVIEW**

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LIST OF EXHIBITS

Exhibit No.	Description
2001	Complaint, <i>Low Temp Industries, Inc. v. Duke Manufacturing Co.</i> , No. 4:20-cv-00686-MTS (E.D. Mo. May 22, 2020) (Dkt. 1)
2002	Case Management Order, <i>Low Temp Industries, Inc. v. Duke Manufacturing Co.</i> , No. 4:20-cv-00686-MTS (E.D. Mo. Oct. 19, 2020) (Dkt. 54)
2003	Memorandum in Support of LTI's Motion for Preliminary Injunction, <i>Low Temp Industries, Inc. v. Duke Manufacturing Co.</i> , No. 4:20-cv-00686-MTS (E.D. Mo. Aug. 20, 2020) (Dkt. 11)
2004	Declaration of Ben Casey in Support of LTI's Motion for Preliminary Injunction, <i>Low Temp Industries, Inc. v. Duke Manufacturing Co.</i> , No. 4:20-cv-00686-MTS (E.D. Mo. Aug. 18, 2020) (Dkt. 11-1)
2005	Declaration of Dr. J. Rhett Mayor in Support of LTI's Motion for Preliminary Injunction, <i>Low Temp Industries, Inc. v. Duke Manufacturing Co.</i> , No. 4:20-cv-00686-MTS (E.D. Mo. Aug. 20, 2020) (Dkt. 11-2)
2006	Duke's Memorandum in Opposition to LTI's Motion for Preliminary Injunction, <i>Low Temp Industries, Inc. v. Duke Manufacturing Co.</i> , No. 4:20-cv-00686-MTS (E.D. Mo. Sept. 18, 2020) (Dkt. 31)
2007	Declaration of Dr. Kelly O. Homan in Support of Duke's Memorandum in Opposition to LTI's Motion for Preliminary Injunction, <i>Low Temp Industries, Inc. v. Duke Manufacturing Co.</i> , No. 4:20-cv-00686-MTS (E.D. Mo. Sept. 18, 2020) (Dkt. 31-3)
2008	LTI's Reply in Support of its Motion for Preliminary Injunction, <i>Low Temp Industries, Inc. v. Duke Manufacturing Co.</i> , No. 4:20-cv-00686-MTS (E.D. Mo. Oct. 12, 2020) (Dkt. 48)

Exhibit No.	Description
2009	Second Declaration of Dr. J. Rhett Mayor in Support of LTI's Motion for Preliminary Injunction, <i>Low Temp Industries, Inc. v. Duke Manufacturing Co.</i> , No. 4:20-cv-00686-MTS (E.D. Mo. Oct. 12, 2020) (Dkt. 48-3)
2010	Duke's Sur-Reply in Opposition to LTI's Motion for Preliminary Injunction, <i>Low Temp Industries, Inc. v. Duke Manufacturing Co.</i> , No. 4:20-cv-00686-MTS (E.D. Mo. Mar. 12, 2021) (Dkt. 88)
2011	Supplemental Declaration of Kelly O. Homan in Support of Duke's Sur-Reply in Opposition to LTI's Motion for Preliminary Injunction, <i>Low Temp Industries, Inc. v. Duke Manufacturing Co.</i> , No. 4:20-cv-00686-MTS (E.D. Mo. Mar. 12, 2021) (Dkt. 88-14)
2012	LTI's Response to Duke's Sur-Reply in Opposition to LTI's Motion for Preliminary Injunction, <i>Low Temp Industries, Inc. v. Duke Manufacturing Co.</i> , No. 4:20-cv-00686-MTS (E.D. Mo. Apr. 2, 2021) (Dkt. 103)
2013	Third Declaration of Dr. J. Rhett Mayor in Support of LTI's Motion for Preliminary Injunction, <i>Low Temp Industries, Inc. v. Duke Manufacturing Co.</i> , No. 4:20-cv-00686-MTS (E.D. Mo. Apr. 2, 2021) (Dkt. 103, Ex. 18)
2014	Deposition of Kelly O. Homan, <i>Low Temp Industries, Inc. v. Duke Manufacturing Co.</i> , No. 4:20-cv-00686-MTS (E.D. Mo. Mar. 23, 2021)
2015	Defendant's Preliminary Invalidity Contentions and Exhibits A-I, <i>Low Temp Industries, Inc. v. Duke Manufacturing Co.</i> , No. 4:20-cv-00686-MTS (E.D. Mo. Dec. 11, 2020)
2016	Declaration of Dr. J. Rhett Mayor, dated April 22, 2021
2017	Excerpts of Demonstratives of Patent Owner Low Temp Industries, Inc. from Preliminary Injunction Hearing, <i>Low Temp Industries, Inc. v. Duke Manufacturing Co.</i> , No. 4:20-cv-00686-MTS (E.D. Mo. April 19, 2021)

Exhibit No.	Description
2018	Intentionally skipped
2019	Order Granting Preliminary Injunction, <i>Low Temp Industries, Inc. v. Duke Manufacturing Co.</i> , No. 4:20-cv-00686-MTS (E.D. Mo. June 25, 2021) (Dkt. 143)

Emphasis added throughout unless otherwise indicated

Patent Owner Low Temp Industries, Inc. respectfully requests rehearing and Precedential Opinion Panel review of the Board’s decision instituting IPR. Paper 12.

I. STATEMENT OF RELIEF REQUESTED

The district court issued a preliminary injunction order finding Petitioner’s invalidity contentions unlikely to succeed on the merits. The district court did so after full discovery on validity, receiving thousands of pages of briefing and evidence, and conducting a hearing in which it heard live testimony from the parties and their experts. The district court has *already heard and decided the same validity issues* on a full evidentiary record. And after the benefit of hearing testimony on a full record, the Court decided that Petitioner’s invalidity case lacks merit.

This case presents an issue of exceptional importance—whether the Board should institute an IPR where the district court has already heard and decided the same invalidity issues between the same parties and institution would guarantee duplication of effort between tribunals. The Board’s institution decision places no weight on the enormous investment in the parallel proceeding that has already occurred. The Board instead places heavy weight on a purported stipulation not to pursue the same validity challenges in district court. The Board misapprehended or overlooked the fact that the stipulation cannot mitigate duplication and the possibility of conflicting decisions because *Petitioner has already presented and lost on its validity challenges* in district court. The stipulation was filed *after*

Petitioner presented the grounds to the district court, and to make matters worse, reserves the right to continue relying on the IPR grounds for the preliminary injunction proceedings. Ex. 1129 at 3. This expressly permits further duplication of effort. In fact, mere hours after the institution decision issued, Petitioner appealed the district court's injunction, thereby guaranteeing duplicate parallel proceedings in the Federal Circuit. Ex. 1132. And to top it off, *today*, Petitioner moved the court to amend its invalidity contentions to rely on "the commercial embodiment of the Finegan prior art patent," making it abundantly clear Petitioner intends to continue pursuing the same invalidity grounds in district court. *Low Temp Indus., Inc. v. Duke Mfg. Co.*, No. 4:20-cv-00686-MTS, D.I. 157, at 3 (E.D. Mo. July 23, 2021) ("*LTP*").

The institution decision also conflicts with the Board's own prior decisions and represents an unreasonable judgment in weighing the *Fintiv* factors. The Board has exercised its discretion to deny institution in similar cases where a district court has granted a preliminary injunction. *E-One, Inc. v. Oshkosh Corp.*, IPR2019-00162, Paper 16 (PTAB June 5, 2019); Paper 7 at 19-20. The Board even cited the *E-One* decision favorably in *Fintiv. Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, at 10 (PTAB May 13, 2020) (precedential) (noting that institution denied where district court issued preliminary injunction order after finding petitioner's invalidity contentions unlikely to succeed on the merits). Institution of this IPR is contrary to these decisions, and thus a precedential decision is warranted to resolve this conflict

and promote certainty and consistency in the exercise of the Board’s discretion.

The importance of the question whether to institute IPR where an Article III court has already issued validity findings and an injunction cannot be overstated. IPR proceedings were not created to provide a second bite at the apple or an opportunity for the PTAB to second-guess rulings by the judiciary. IPRs are supposed to be a more efficient *alternative*. But IPR cannot serve as an alternative here, where the court has already heard and ruled on the validity issues. The efficiency and integrity of the patent system are best served by denying institution.

II. LEGAL STANDARDS

A party dissatisfied with a decision may file a request for rehearing 37 C.F.R. § 42.71(d). The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed. *Id.* The Board reviews such requests for an abuse of discretion. *Id.*

III. THE BOARD MISAPPREHENDED OR OVERLOOKED THE PRELIMINARY INJUNCTION IN ITS *FINTIV* ANALYSIS.

A. The District Court Has Already Heard and Rejected Petitioner’s Invalidation Case, and Petitioner’s Stipulation is Ineffective to Avoid Duplication and Potentially Conflicting Decisions.

The AIA’s objective is “to provide an effective and efficient *alternative* to district court litigation.” *NHK Spring Co., Ltd. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8, at 20 (PTAB Sept. 12, 2018) (precedential). The Board must take “a

holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Fintiv*, Paper 11, at 5-6. This serves “to minimize the duplication of work by two tribunals.” *Id.* at 5. Institution here defeats these goals.

Duke raised the same validity issues in district court that it has raised to the Board, and the district court has already issued findings on those validity challenges. As was explained in the Preliminary Response (Paper 6, at 7-9, 19-21) and Sur-Reply (Paper 10 at 4), and is not disputed by Petitioner, the parties and court have invested enormous effort in resolving the validity issues in the parallel litigation. In advance of the preliminary injunction hearing, the parties conducted full discovery on the same invalidity arguments that Duke raises here in its Petition. *Id.* The parties exchanged infringement and invalidity contentions, completed review and production of documents, exchanged expert reports on infringement and validity, and took fact and expert depositions. *Id.* The parties also filed five rounds of briefing, with most of the briefing focused on the merits of Petitioner’s invalidity contentions. Exs. 2003, 2006, 2008, 2010, 2012. The court then held a full bench trial on LTI’s preliminary injunction motion, which included live testimony from the parties’ CEOs regarding secondary considerations and experts, including Kelly Homan, Duke’s expert in this proceeding. Ex. 1130.

On June 25, 2021, the district court entered a detailed, forty-page Memorandum and Order granting LTI’s motion for preliminary injunction. Ex.

2019.¹ The district court first detailed Duke’s blatant copying. *Id.* at 5-7.

The evidence before the Court paints a clear picture of what happened here. Without first consulting its lawyers regarding the validity of the Asserted Patents, Duke decided to copy the QuickSwitch because it wanted a foothold in the HCF marketplace from which it could challenge LTI as the only market player.

Id. at 7. The court then construed the claims and turned to the merits of Duke’s invalidity challenge. *Id.* at 8-29. After the benefit of hearing live testimony from the parties and their experts on a full record, “the Court finds that the infringed claims are not obvious” for three reasons. *Id.* at 20.

First, there are significant and meaningful differences between the Asserted Patents and Finegan. Second, the clear evidence of copying and commercial success serves as persuasive, objective evidence of nonobviousness. And third, Duke improperly relied on the statements of Howell Ben Shackelford, the inventor of the Asserted Patents, in arguing a person skilled in the art would have the motivation to create the Asserted Patents.

Id. at 20-21. The Court detailed its reasoning and the evidence supporting its findings, concluding “that Duke has failed to raise a substantial question as to the Asserted Patents’ validity.” *Id.* at 21-29, 38-39. Petitioner filed a notice of appeal

¹ The preliminary injunction issued after the parties completed preliminary briefing, but was filed with the Board before the Institution Decision. Ex. 2019.

immediately after the Board issued the Institution Decision. Ex. 1132.

The Board misapprehended or overlooked the inevitable and extensive duplication with the district court proceedings and potential for conflicting decisions that will result if this IPR is instituted. The district court has *already heard the same validity issues* on a full evidentiary record and decided Petitioner's invalidity case lacks merit. Nothing can change that. This IPR would just retread the same ground already walked by the district court (and do so in parallel with the Federal Circuit).

The Board relies heavily on Petitioner's district court stipulation as "obviate[ing] any concerns of duplicative efforts between the district court and the Board." Paper 12 at 13-14. This is flatly incorrect. The Board failed to appreciate that Petitioner's stipulation is critically different from the one in *Sotera* because it carves out and reserves the right to continue relying on the IPR grounds. Paper 10 at 4-5; Ex. 1129 at 3. Rather than avoiding duplication, it expressly provides for it. The Board further misapprehends or overlooks the fact that, regardless of a stipulation, duplication is unavoidable because the district court has already received evidence, held a full evidentiary hearing, and issued a substantive ruling on the IPR grounds. As LTI explained in its Sur-Reply (Paper 10, at 4-5), the stipulation does not cure the duplication that has already occurred. That ship sailed when Petitioner unsuccessfully relied on the same invalidity case to try to avoid the preliminary injunction. Petitioner pursued those grounds in the district court, and after losing, is

pursuing them through appeal of the preliminary injunction to the Federal Circuit. And remarkably, Petitioner is now attempting to pursue them again in district court via “the commercial embodiment of the Finegan prior art patent.” In short, duplication has occurred and will continue despite the stipulation.

B. When Correctly Assessing the Impact of the Preliminary Injunction, the *Fintiv* Factors Weigh Against Institution.

The Board failed to appreciate or overlooked the inevitable duplication and possibility of conflicting decisions that would result from institution. It also was misled as to the true nature of Petitioner’s stipulation, which does not—and cannot—avoid this duplication. When the court’s preliminary injunction is properly assessed, the *Fintiv* factors favor denying institution.

1. Factor 1: Existence or likelihood of a stay.

The Board found this factor neutral because it would not speculate on whether the district court would stay the case. Paper 12 at 9. The Board’s decision misses the point. A stay is only relevant if it would allay concerns about inefficiency and duplication of efforts, and here it would not. The court has already considered the issues presented in the Petition, so regardless whether the court stays the case, it would be inefficient and unfair to require LTI to defend the validity of its patents for a second time. Moreover, Petitioner has now appealed to the Federal Circuit, which guarantees parallel proceedings on the same issues will proceed regardless of whether the court enters a stay. The Board misapprehended or overlooked the

duplication that has already occurred, and also did not have the benefit of weighing Petitioner’s appeal—and guaranteed ongoing duplicative proceedings that will result—when issuing the Institution Decision. This factor weighs against institution.

2. Factor 2: Proximity of the trial date to the Board’s projected statutory deadline.

Under *Fintiv*, this factor weighs against institution if “the court’s trial date is earlier than the projected statutory deadline.” *Fintiv*, Paper 11, at 9. This factor favored discretionary denial in *Fintiv* because trial was set to begin two months before the projected statutory deadline. *Id.* at 11-12. Likewise, in *E-One*, the Board denied institution where trial was set one month before the projected statutory deadline. *E-One*, Paper 16, at 6. This case is the same as *Fintiv* and *E-One*. Trial is scheduled about a month before a final decision from the Board would be due. Paper 6 at 16. Under *Fintiv*, this factor favors denying institution. Yet, the Board found this factor neutral because, even though trial would happen first, it is “around the same time” and “the efficiency and fairness concerns that underlie the *Fintiv* analysis are not particularly strong.” Paper 12 at 9-10. This makes no sense. The exact same inefficiency and unfairness will occur without regard to whether the trial happens one, two, or more months before the FWD deadline. And importantly, the Board erred by giving no weight to the preliminary injunction proceedings that have already occurred, as the work on these issues has already been done. The same concerns regarding duplication of efforts arise from these preliminary proceedings,

yet the Board misapprehended or overlooked the implication of such proceedings.

Precedential Opinion Panel review would promote certainty and consistency across decision makers on this oft-recurring and important question. A precedential opinion would clarify how to evaluate the proximity of trial and final written decision dates and the weight to give preliminary injunction proceedings.

3. Factor 3: Investment in parallel proceeding.

The Board misapprehended the enormous investment of the parties in the district court. The parties exchanged invalidity and infringement contentions, completed document production, exchanged expert reports, took fact and expert depositions, completed claim construction briefing, and filed thousands of pages of preliminary injunction briefing and evidence. Paper 6 at 19-22; Exs. 2003, 2006, 2008, 2010, 2012. The Board also overlooked and misapprehended the extensive investment of resources by the district court. The court conducted a full day trial, receiving argument, live fact witness testimony, and live expert testimony on validity. Ex. 1130. The court issued a forty-page substantive ruling on the merits, finding that the Asserted Patents are not obvious. Ex. 2019 at 20-29. Subsequently, it held a bond hearing and issued orders related to the injunction and bond. The court has devoted substantial time and energy to analyze and resolve the validity issues presented here. The Board failed to credit these investments in its *Fintiv* analysis.

Under *Fintiv*, “if, at the time of the institution decision, the district court has

issued substantive orders related to the patent at issue in this petition, this fact favors denial.” *Fintiv*, Paper 11, at 9-10. *Fintiv* cites *E-One* where the “district court issued [a] preliminary injunction order after finding petitioner’s invalidity contentions unlikely to succeed on the merits.” *Fintiv*, Paper 11, at 10 n.16 (citing *E-One*, Paper 16, at 8, 13, 20). The court here likewise issued a preliminary injunction after finding Petitioner’s invalidity contentions unlikely to succeed on the merits. Ex. 2019.

Fintiv unmistakably requires this factor to weigh in favor of discretionary denial. Indeed, even Petitioner was forced to concede that factor 3 weighs in favor of discretionary denial. Paper 9 at 4. Yet, the Board weighed this factor against discretionary denial, or at least neutral. Paper 12 at 13. Minimizing the extensive investment already made, the Board found that “much work remains in the district court case as it relates to invalidity.” *Id.* at 11. Not so. The parties completed fact and expert discovery on validity issues, briefed those issues to the district court, and presented live testimony and argument. The court issued a lengthy, reasoned ruling rejecting Petitioner’s invalidity arguments. Ex. 2019, 20-29. If the Board were to institute IPR, the tremendous investment to date would be duplicated. In this case, IPR cannot serve as an efficient alternative as Congress intended.

The Board also speculates that “the landscape regarding validity will change as the case proceeds in the district court.” Paper 12 at 11. This is as remarkable as it sounds. Petitioner has already presented and lost on its invalidity challenges in

district court. Yet the Board reasons that Petitioner should get a second chance before the Board on the same grounds while it shifts the “landscape” on validity at the district court. Petitioner had its opportunity on its invalidity grounds before the district court and can maintain its position going forward. IPR is not supposed to provide a second chance. The integrity of the system demands denial.

Finally, the Board points to “the absence of final determinations on validity issues by the district court.” Paper 12 at 13. There is no such requirement in the Board’s precedent. To the contrary, *Fintiv* specifically identifies a preliminary injunction ruling finding invalidity contentions unlikely to succeed as a factor favoring discretionary denial. *Fintiv*, Paper 11 at 10 n.16. Rehearing is required to correct this clear misapprehension of the Board’s precedent.

4. Factor 4: Overlap between issues raised in Petition and parallel proceeding.

There is no dispute that Petitioner presented the same invalidity arguments it raises here in district court. Paper 10 at 4-5. Petitioner filed its stipulation with the court only *after* presenting its invalidity arguments and evidence in a full evidentiary hearing in the district court. *Id.* Moreover, the stipulation expressly “reserves the right to continue to rely upon the *inter partes* reviews and the grounds asserted within the *inter partes* review petitions” in district court. Ex. 1129 at 3. Now that Petitioner has appealed the court’s preliminary injunction ruling, duplication continues on the same grounds in the Federal Circuit. Ex. 1132. Further, Petitioner

is attempting to pursue them again in district court via “the commercial embodiment of the Finegan prior art patent.” *LTI* at 3. Petitioner’s stipulation is too little and too late to mitigate concerns about overlap here. *Cf. Supercell OY v. Gree, Inc.*, IPR2020-01628, Paper 9, at 13 (PTAB Feb. 17, 2021) (“Petitioner’s stipulation does not address effectively concerns about duplicative efforts and potentially conflicting decisions because the stipulation may have no effect until the parties complete nearly all work on these issues in the parallel proceeding....”)

Petitioner’s stipulation is gamesmanship at its worst. Petitioner presented its invalidity case to the district court, and after losing, filed a stipulation that does not even apply to the invalidity case actually presented to the district court. Compounding its gamesmanship, Petitioner misled the Board to believe that it had filed a *Sotera*-type stipulation. Paper 12 at 13 (citing *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 18-19 (PTAB Dec. 1, 2020)). Indeed, Petitioner told the Board that it had filed an unequivocal stipulation that it “will not pursue in [the district court]” any ground “that was raised or could have been reasonably raised in an IPR.” Paper 9 at 4. Petitioner did not tell the Board, however, that it had expressly carved out the IPR grounds from the stipulation or that it planned to continue to assert Finegan through an embodiment. The Board misapprehended the true nature of Petitioner’s stipulation, instead block quoting Petitioner’s self-serving description of the stipulation that omitted any mention of the reservation of rights.

Paper 12 at 14 (quoting Paper 9 at 4). The Board also overlooked the key point that no stipulation could cure duplication that has already occurred. Paper 10 at 5.

The overlap between the Petition and invalidity case already considered by the court and ongoing in the Federal Circuit weighs strongly *against* institution. The Board was misled by Petitioner to apply *Sotera* and find this factor weighs strongly in the other direction. Paper 12 at 14. Rehearing is needed to correct the erroneous analysis of this factor, which was effectively dispositive in the Board's analysis.

5. Factor 5: Whether the petitioner and defendant in the parallel proceeding are the same.

The Board rightly found that this factor favors denying institution because the parties are the same in both proceedings. Paper 12 at 14-15. The inefficiency and unfairness of a duplicate parallel proceeding between the *same parties* is entitled to heavy weight in the required holistic analysis.

6. Factor 6: Other circumstances, including the merits.

Finegan does not teach LTI's invention. The Examiner made this finding (Paper 6 at 25-33), which the Board entirely overlooked in its analysis of this factor. The district court further issued a detailed, forty-page Memorandum and Order in which it found that Petitioner is not likely to succeed on the merits. Ex. 2019, 8-29. Importantly, the court issued its ruling after receiving five rounds of briefing, thousands of pages of evidence, and hearing *live testimony* from the parties and their experts. The court concluded "that Duke has failed to raise a substantial question as

to the Asserted Patents’ validity” and was not likely to succeed on the merits. *Id.* at 21-29, 38-39. After receiving a full record, the court found “that the differences between Finegan and the Asserted Patents in purpose, design, and function are significant enough that Finegan did not make the infringed claims obvious at the time of their creation.” *Id.* at 23. The court further found that Duke’s intentional copying (shown in Duke’s own documents) and LTI’s commercial success—secondary considerations that Duke was aware of but failed to address in the Petition—“weigh heavily in favor of a finding of nonobviousness.” *Id.* at 24-26. And, the court found that Duke’s hindsight reasoning—the same hindsight Duke relied upon in the Petition—was insufficient to raise a substantial question as to the validity of the claims of the Asserted Patents. *Id.* at 26-29.

Remarkably, the Board completely failed to address the district court’s findings on the merits in the Institution Decision, even though the court considered the same validity issues on virtually the same standard—likelihood of success on the merits—with the benefit of a full evidentiary record. 157 Cong. Rec. S1375 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl) (explaining standard for institution is akin to district court’s preliminary injunction standard). It is fundamentally unfair to Patent Owner for the Board to ignore reasoned findings from a district court that apply directly to Petitioner’s invalidity grounds. Petitioner is not likely to succeed for the same reasons the court found. And the overarching point remains: IPR is not

meant to provide Petitioner a second chance. The district court's findings on the merits must be considered and strongly support denial of institution.

IV. THE BOARD MISAPPREHENDED THE BOARD'S PRECEDENT IN ITS § 325(D) ANALYSIS

Finegan was already presented to the Patent Office, and the Examiner found that it does not teach a single module with multiple adjacent thermally isolated wells and a control system that allows heating and cooling of each well regardless of the temperature of adjacent wells. Paper 6 at 25-26. The Board misapprehended the *Advanced Bionics* framework by refusing to consider these findings from prosecution of a related application. Paper 12 at 19. *Advanced Bionics* extends to art previously presented to the office in related proceedings and is not limited to prosecution of the patent at issue. *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020). The Board has previously extended its § 325(d) analysis to allowance of a child application over prior art raised in the Petition. *Live Nation Entm't, Inc. v. Complete Entm't Res. B.V.*, PGR2017-00038, Paper 11, at 13-18 (PTAB Jan. 16, 2018). The Board errs by refusing to do so here. Precedential Opinion Panel review is warranted to prevent inconsistency between panels on this important question.

V. CONCLUSION

LTI respectfully requests that a rehearing be granted and institution denied.

Dated: July 23, 2021

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing **PATENT OWNER'S REQUEST FOR REHEARING OF THE DECISION GRANTING INSTITUTION OF *INTER PARTES* REVIEW** was served by email on the date below to the following:

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Dated: July 23, 2021

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