UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VERTIV CORPORATION,

Petitioner

v.

VALTRUS INNOVATIONS LTD.,

Patent Owner

Case No. IPR2025-00667
Patent No. 6,854,287

PATENT OWNER'S PRELIMINARY RESPONSE

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PATENT OWNER'S UPDATED EXHIBIT LIST

No.	Exhibit Description
2001	*Interim Processes for PTAB Workload Management*
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 *Cardware Inc. v. Samsung Elecs. Co., Ltd.*, 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
2022	Defendants' Invalidity and Ineligibility Contentions and Disclosures Pursuant to Patent Rule 3-3, No. 2:24-cv-00777

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2023	Guidance on USPTO's recission of "Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation"
2024	Docket Navigator Statistics for Judge Gilstrap
2025	Federal Court Statistics
2026	Email from Girgis to Berkowitz attaching Vertiv's Invalidity Contentions on behalf of DataBank dated April 1, 2025
2027	Vertiv's First Supplemental Initial and Additional Disclosures, 2:24-cv-00361
2028	DataBank's Initial and Additional Disclosures, 2:24-cv-00777
2029	TierPoint's Initial Disclosures Pursuant to Discovery Order, 2:24-cv-00777
2030	Appendix 2 to Vertiv's Preliminary Ineligibility Contentions for U.S. Patent No. 6,854,287, No. 2:24-cv-00361
2031	Appendix 2 to Ineligibility Contentions for Patent 6,854,287 served by Vertiv on behalf of DataBank
2032	Docket Navigator Report Showing Payment of Maintenance Fees for U.S. Patent 6,854,287
2033	Press Release by Vertiv, titled "*Veteran technology executive Rob Johnson to lead new standalone company following sale to Platinum Equity*, 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/
2034	Vertiv Timeline, *available* at https://www.vertiv.com/49c2fd/globalassets/images/infographics/vertiv-timeline-infographic-en-gl-2025-1.pdf
2035	Form 10-K for Emerson Electric. Co. (Filed: November 25, 2008; period: September 30, 2008)
2036	"An Introduction to Vertiv," *available at* https://www.vertiv.com/globalassets/documents/blog/vertiv-corporateoverview-pr-en-gl_174923_01.pdf
2037	Office Action dated August 21, 2009, from the prosecution history of U.S. Patent Application No. 11/670,208
2038	Application Data Sheet from the prosecution history of U.S. Patent Application No. 11/670,208
2039	Abandonment notice from the prosecution history of U.S. Patent Application No. 11/670,208

No.	Exhibit Description
2040	Information Disclosure Statement dated December 12, 2012 from prosecution history of U.S. Patent Application No. 13/540,015
2041	U.S. Patent No. 9,297,571
2042	U.S. Patent No. 6,574,104

I. INTRODUCTION

On February 26, 2025, Petitioner Vertiv Corporation ("Petitioner") filed a Petition requesting *inter partes* review of independent claim 1 and dependent claims 2-9 (the "Challenged Claims") of U.S. Patent No. 6,854,287 ("the '287 Patent"; EX1001), asserting four Grounds. Petitioner asserts that claims 1-4 and 7-9 are anticipated by U.S. Patent No. 3,384,155 ("*Newton*," Ground 1); that claims 5-6 are obvious over *Newton* and the knowledge of a POSITA (Ground 2); that claims 1-4, 7, and 9 are anticipated by U.S. Patent No. 5,317,907 ("*Shimizu*," Ground 3), and that claims 1, 3, 7, and 9 are anticipated by U.S. Patent App. Publication No. 2001/0042616 ("*Baer*," Ground 4). 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.

As explained in detail below, none of Petitioner's references disclose key elements of the Challenged Claims, and thus, do not anticipate (Grounds 1, 3 and 4) or render obvious (Ground 2) any Challenged Claim. Petitioner also 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 that any Challenged Claim is unpatentable and Patent Owner respectfully submits the Board should deny institution.

II. OVERVIEW OF THE ’287 PATENT

The ’287 Patent, titled “Cooling System,” discloses “[a] system and method for cooling a room configured to house a plurality of computer systems.” EX1001, Abstract. As the patent explains, “[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, 2:10-14. This type of cooling results in the cooling of “components that may not be operating at a level which may cause their temperatures to exceed a predetermined temperature range” which “often incur[s] greater amounts of operating expenses than may be necessary.” EX1001, 2:23-29.

To overcome these drawbacks in the prior art, the ’287 Patent discloses a novel method and system for controlling atmospheric conditions within a building. It does so, for example, by configuring a plurality of heat exchanger units to receive air from and deliver air to the room in the data center, supplying the heat exchanger

with cooling fluid, and controlling the temperature of the cooling fluid and/or the air delivery of the room in response to temperatures sensed at one or more locations in the room. EX1001, Abstract. Figure 5 of the '287 Patent illustrates a flow chart of an embodiment of this method:

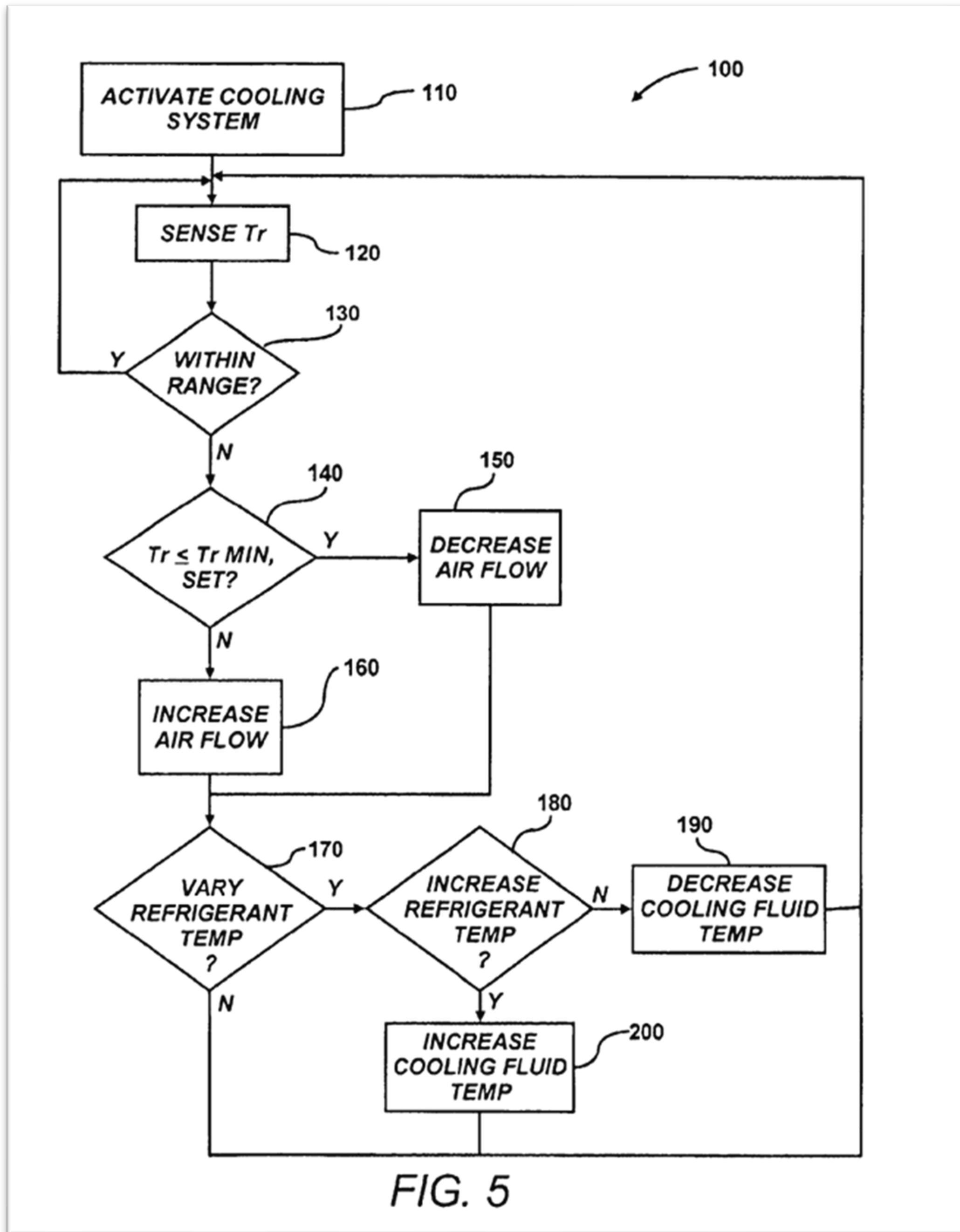


FIG. 5

EX1001, FIG. 5.

Petitioner challenges claims 1-9 of the ’287 Patent, all of which are method claims and of which claim 1 is an independent claim. Independent claim 1 recites, with labeling as added by Petitioner:

> 1[pre] A method for cooling *a room configured to house a plurality of computer systems*, said method comprising:
>
> 1[a] providing a plurality of heat exchanger units configured to receive air from *said room* and to deliver air to *said room*,
>
> 1[b] supplying said plurality of heat exchanger units with cooling fluid from an air conditioning unit;
>
> 1[c] cooling said received air through heat exchange with the cooling fluid in the plurality of heat exchanger units,
>
> 1[d] sensing temperatures at one or more locations in *said room*,
>
> 1[e] controlling at least one of the temperature of said cooling fluid and said air delivery by said plurality of heat exchanger units to *said room* in response to said sensed temperatures at said one or more locations, and
>
> 1[f] wherein the step of controlling said air delivery by said plurality of heat exchanger units comprises individually manipulating a mass flow rate of the cooling

fluid supplied to each of the plurality of heat exchanger units.

EX1001, cl. 1. Dependent claims 2-9 recite further details on these steps.

As can be seen above, the claimed structural limitation “said room” in steps 1[a], 1[d], and 1[e] all derive antecedent basis from the preamble, “[a] method for cooling *a room configured to house a plurality of computer systems*.” Consistent with the ’287 Patent—which is directed to cooling of data centers (“defined as a location, e.g., room, that houses computer systems arranged in a number of racks,” EX1001, 1:23-25)—the preamble of claim 1 recites essential structure and provides antecedent basis for the remainder of the claim. *See, e.g.*, *Shoes by Firebug LLC v. Stride Rite Children’s Grp., LLC*, 962 F.3d 1362, 1368 (Fed. Cir. 2020) (finding preamble limiting “[b]ecause the claim requires that the illumination system be housed in the textile footwear recited in the preamble, the preamble is essential to understanding the structural limitations of the illumination system.”); *Catalina Mktg. Int’l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 808 (Fed. Cir. 2002) (“In general, a preamble limits the invention if it recites essential structure or steps, or if it is necessary to give life, meaning, and vitality to the claim.”) (cleaned up).

For purposes of this Patent Owner Preliminary Response (“POPR”), Patent Owner focuses on certain dispositive issues. In particular, Patent Owner identifies

flaws in Petitioner's theories for independent claim 1, which, for purposes of this POPR, apply to each of the dependent claims 2-9.

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

A. Petitioner Fails to Show a Reasonable Likelihood of Success for Grounds 1 and 2

Petitioner asserts that *Newton* anticipates or renders obvious, in light of the knowledge of a POSITA, the Challenged Claims. Petition (Paper 1), 30, 43. In particular, Petitioner asserts in Ground 1 that *Newton* anticipates independent claim 1 and dependent claims 2-4 and 7-9. Petition (Paper 1), 30. Petitioner asserts in Ground 2 that *Newton* together with "the knowledge of a POSITA" renders obvious dependent claims 5 and 6. Petition (Paper 1), 43.

However, as demonstrated below, *Newton* does not disclose key elements of independent claim 1 and therefore does not anticipate any Challenged Claim (Ground 1). Additionally, because Petitioner only uses "the knowledge of a POSITA" to attempt to fill in gaps in *Newton* vis-à-vis dependent claims 5 and 6 and does not argue that claim 1 is obvious in Ground 2, Petition (Paper 1), 43-47, Petitioner's Ground 2 fails for the same reason as Ground 1.[1]

---

[1] That is, for Ground 2, Petitioner asserts that *Newton* combined with the knowledge of a POSITA render claims 5 and 6 obvious. Petition (Paper 1), 43. However,

Petitioner provides three exemplary failures below, each of which is dispositive of Petitioner's Grounds 1 and 2.

First, Petitioner incorrectly asserts that *Newton* discloses the claimed "room." Claim 1 of the '287 Patent requires, in relevant part:

> 1[pre] A method for cooling *a room* configured to house a plurality of computer systems, said method comprising:
>
> 1[a] providing a plurality of heat exchanger units configured to receive air from *said room* and to deliver air to *said room*,
>
> 1[d] sensing temperatures at one or more locations in *said* room,
>
> 1[e] controlling at least one of the temperature of said cooling fluid and said air delivery by said plurality of heat exchanger units to *said room* in response to said sensed temperatures at said one or more locations….

EX1001, cl. 1 (excerpted).

---

because *Newton* does not disclose certain limitations in claim 1, and Petitioner does not address such failings in Ground 2 (for dependent claims 5 and 6), Petitioner's Ground 2 fails for the same reason as Petitioner's Ground 1.

While the plain language of claim 1 requires "*a* room," with various steps occurring relative to "*said* room," Petitioner points to multiple *separate* rooms ("zones A, B, and C"), in an attempt to demonstrate that *Newton* discloses each step of, and anticipates, independent claim 1 of the '287 Patent.

Petitioner's theory is premised on incorrectly equating the disclosed "zones" in *Newton* as being part of an individual "room," rather than spread across multiple *rooms*, pointing particularly to "zones A, B, and C" of Figure 1 of *Newton* and asserting those zones are part of a "single room." Petition (Paper 1), 32-33 (citing EX1007, 1:24-40, 2:71-3:3, 6:73-75; EX1002 ¶¶130-131). Petitioner's expert makes the same verbatim assertion, without any additional evidence or analysis, EX1002 ¶¶130-131, and should be afforded little to no weight. *See 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).

Regardless, *Newton* confirms that its system is directed to "a *multi-room* air conditioning installation," and that a "zone" corresponds to at least a "room" (not a portion of a room).

At the outset, *Newton* describes that its "invention relates generally to air conditioning systems, and more particularly to a piping or water distribution system for a *multi-room* air conditioning installation." EX1007, 1:21-23 (emphasis added).

Newton then continues to summarize its "invention" by equating "rooms" and "zones," describing, for example, "individual *room* units" where "some rooms" may be heated and "others" may be cooled, where "the cycling will occur often enough so that good temperature control can be maintained in all *zones*:"

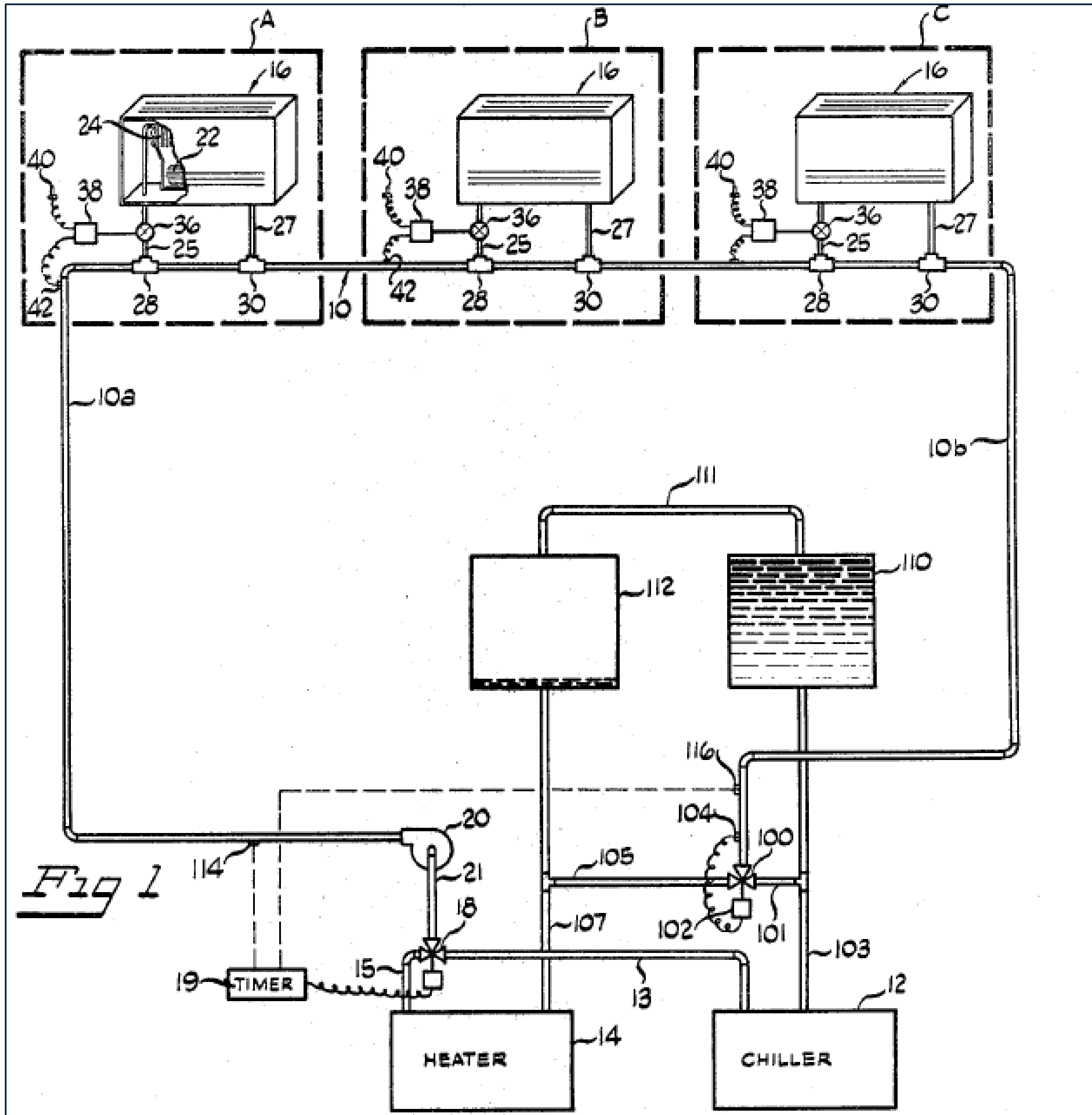
> The present invention can be characterized generally as an improved air conditioning system which uses a single conduit for distributing the water (or other heat exchange medium) to the *individual room units* and, therefore, can be regarded as a "single pipe" system. The single water supply (and return) line constitutes the major part of a complete closed circuit conduit system interconnecting all of the room units with the water heater and the water chiller. *If conditions are such that heating is required by some rooms and cooling in others, hot and cold water are circulated through the systems alternately*.
>
> If the thermostatic control for a particular unit calls for heating, the water is withdrawn from the supply line to the room unit only when hot water is being circulated; otherwise, it is bypassed. If *a room* requires cooling, the water is withdrawn by the room unit only if cold water is being circulated; otherwise, it is bypassed. *The cycling time, i.e. the ratio of the time cold water is circulated to the time that hot water is circulated; is varied in accordance with overall cooling and heating needs; and*

> *the cycling will occur often enough so that good temperature control can be maintained in all zones*.
>
> It is, therefore, a principal object of the invention to provide an improved air conditioning system having a single conduit to interconnect the water heater and chiller with the *individual room* conditioning units. An other object of the invention is to provide a low-cost air conditioning system in which the temperature in various *zones* can be individually controlled. Another object of the invention is to provide a system in which the heated or chilled water is alternately made available to the room air conditioning units during periods when *some rooms require cooling and others require heating*.

EX1007, 2:5-37 (emphasis added).

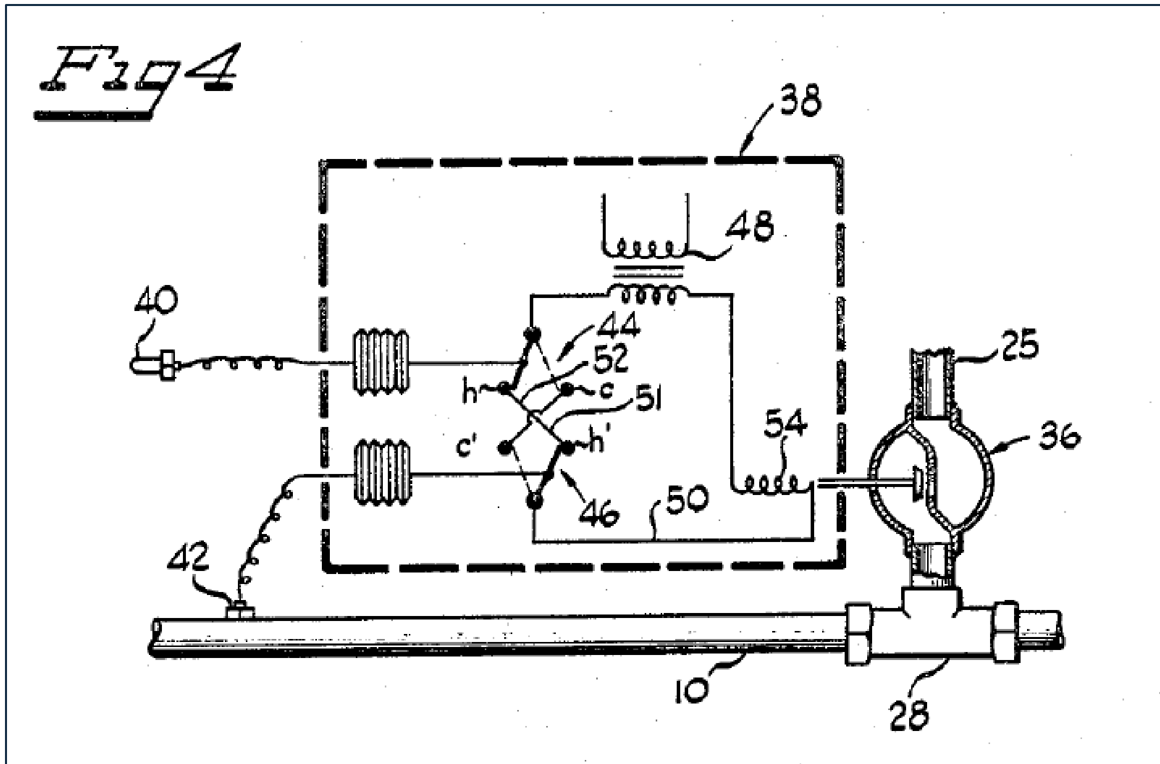
A review of the Figures and "detailed description" of *Newton* further supports that each disclosed "zone" corresponds to at least a separate "room." This can be seen by reviewing Figures 1 and 4 and *Newton*'s corresponding disclosure.

Newton discloses, in Figure 1, reproduced below, "a plurality of *room* air conditioning units 16, which are respectively located in zones A, B, and C to be conditioned," where "the room units and zones illustrated in FIGURE 1 are merely representative of a large number of such units and zones in a typical *multi-room* installation." EX1007, 2:58-3:3 (emphasis added). *Newton* further discloses and depicts its "single pipe" system, with main water supply and return conduit 10:



EX1007, FIG. 1 (annotated).

Figure 4 of *Newton* provides further details concerning certain aspects of Figure 1, and in particular, as can be seen in Figure 4, reproduced below, further detail of "valve control 38 for room units 16." EX1007, 3:40-41.



EX1007, FIG. 4.

Importantly, the corresponding description of Figure 4 in *Newton* discloses that the switches (44, 46) open/close based on "[t]he temperature *within the room*," EX1007, 3:40-65, indicating that each zone is a room (not a part of a room, as Petitioner asserts).

Lastly, while *Newton* discloses that a "zone" is at least a room, it further discloses that zones may include "more than one room:" the air conditioning units "may also supply *more than one room* within a particular zone by having branch ducts opening into different rooms with a single heat exchange coil positioned upstream from the outlets." EX1007, 6:60-64. This is also consistent with *Newton's* background describing that the air conditioning systems can be used to individually

control temperature in "each room (or at least a small group of rooms)": "[a]ir conditioning systems used in multi-room buildings such as office buildings, high-rise apartments, hotels, and similar structures are optimally designed so that the temperature in *each room (or at least a small group of rooms)* can be independently controlled." EX1007, 1:24-28 (emphasis added). But, *Newton* never discloses the inverse (*i.e.*, that multiple zones are within a single room). Nor would it make any sense, given *Newton*'s purpose of cooling a room (or group of rooms) in a multi-room installation, in contrast to the '287 Patent, which focuses on cooling data centers and explains the significant technical difficulties of cooling different areas within the same room. EX1001, 2:15-29.

Second, Petitioner has failed to show that *Newton* (filed in 1966 and issued in 1968) discloses the claimed "room configured to house a *plurality of computer systems*."[2] Petitioner's entire argument consists of asserting that *Newton*'s general reference to undefined "office equipment" (in the 1960s) would be understood to correspond to the claimed "plurality of computer systems:"

> If the preamble is limiting, Newton discloses the preamble in relation to its disclosures of methods of using air conditioning systems for buildings such as office buildings having "interior zones, where the thermal loads

[2] As explained in Section II, above, the preamble is limiting.

> are due almost entirely to lighting, office equipment and people, [which] may require cooling all year long." Ex. 1007, 1:21-40. A POSITA reviewing Newton in the timeframe of the '287 patent priority date would understand the reference to "office equipment" generating "thermal loads" as including computer systems. Additionally, a POSITA would understand that the components and operating principles of the type of air conditioning system disclosed in Newton are applicable to cool any type of room that requires cooling, including rooms that house computer systems. Thus, Newton discloses limitation 1[pre]. Ex. 1002 ¶129.

Petition (Paper 1), 31.

Importantly, Petitioner provides no evidentiary support for its leap from *Newton*'s generic mention of "office equipment" to the claimed "plurality of computer systems." Nor does its expert, who simply repeats verbatim—without any additional evidence or analysis—the unsupported assertion from the Petition. EX1002 ¶¶128-129. Such copy-and-paste conclusory assertions should be afforded little to no weight. *See Xerox*, IPR2022-00624, Paper 9, 15.

There is simply *no* evidence that a POSITA reviewing *Newton* (filed in 1966 and issued in 1968) would have understood that *Newton*'s reference to "office equipment" meant that *Newton* itself discloses the claimed "plurality of computer systems." This is critical, as Petitioner chose to present an *anticipation* ground,

which requires Petitioner to show that *Newton* discloses all claim limitations within its four corners. *See, e.g.*, *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008) ("[T]he prior art reference — in order to anticipate under 35 U.S.C. §102 — must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements arranged as in the claim.") (cleaned up); *Intelligent Wellhead Sys., Inc. v. Downing Wellhead Equip., LLC*, IPR2024-00583, Paper 9, 16-18 (PTAB Sept. 12, 2024) (denying institution where Petitioner failed to show that allegedly anticipatory reference disclosed all claim limitations); *Qualcomm Inc. v. Network Sys. Techs., LLC*, IPR2024-00355, Paper 9, 45-47 (PTAB June 17, 2024) (same).

Third, Petitioner asserts that *Newton* discloses the claimed "method for cooling *a room configured to house a plurality of computer systems*,"[3] but properly construed, there is no dispute that *Newton* does not.

The '287 Patent is directed to cooling systems for data centers, and consistently (and exclusively) discloses its invention in the context of data centers. To begin, the '287 Patent defines a data center and explains the computer systems arranged within (*e.g.*, using "standard racks"):

> *A data center may be defined as a location, e.g., room, that houses computer systems arranged in a number of racks.*

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[3] Again, as explained in Section II, above, the preamble is limiting.

> A standard rack may be defined as an Electronics Industry Association (EIA) enclosure, 78 in. (2 meters) wide, 24 in. (0.61 meter) wide and 30 in. (0.76 meter) deep. Standard racks may be configured to house a number of computer systems, e.g., about forty (40) systems, with future configurations of racks being designed to accommodate up to eighty (80) systems. The computer systems typically include a number of components, e.g., one or more of printed circuit boards (PCBs), mass storage devices, power supplies, processors, micro-controllers, semi-conductor devices, and the like, that may dissipate relatively significant amounts of heat during the operation of the respective components. For example, a typical computer system comprising multiple microprocessors may dissipate approximately 250 W of power. Thus, a rack containing forty (40) computer systems of this-type may dissipate approximately 10 KW of power.

EX1001, 1:23-41 (emphasis added). The ’287 Patent further describes “conventional data centers” and certain problems that exist in the cooling of such data centers and the racks configured to house the computer systems, including problems with “[c]onventional data center air conditioning units [that] do not vary their cooling fluid output based on the distributed needs of the data center.” EX1001, 1:42-2:39; *see also* Section II (above) (overview of the ’287 Patent).

Against this backdrop, the ’287 Patent discloses as part of its Summary of the Invention, “a method *for cooling a room configured to house a plurality of computer systems*,” EX1001, 2:33-35 (*i.e.*, as also found in 1[pre] in claim 1). The patent further describes its system in the context of the room configured to house multiple computer systems as being a data center. EX1001, 4:8-24, 12:51-59, 13:12-49.

Moreover, the scope and interpretation of “a room configured to house a plurality of computer systems” corresponding to a data center is further bolstered by the patent applications incorporated by reference into the ’287 Patent, all of which are directed to data centers and likewise disclose that a data center corresponds to a room configured to house a plurality of computer systems. *See* EX1001, 1:7-17, 7:14-20; *see also* EX2042, 1:5-28 (describing data centers, including similar definition as in the ’287 Patent: “A data center may be defined as a location, e.g., room, that houses numerous printed circuit (PC) electronic systems arranged in a number of racks.”), 1:29-2:12 (background on “conventional data centers” and problems in same).[4]

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[4] EX2042 corresponds to U.S. Patent App. Ser. No. 09/970,707, incorporated by reference into the ’287 Patent. *See* EX1001, 4:14-18, 7:30-32.

Accordingly, in view of the specification, Patent Owner respectfully submits that "a room configured to house a plurality of computer systems" should be construed to be a data center.

In contrast, *Newton* discloses "multi-room buildings such as office buildings, high-rise apartments, hotels, and similar structures are optimally designed so that the temperature in each room (or at least a small group of rooms) can be independently controlled." EX1007, 1:24-28. There is never any mention of a data center, or a room with a plurality of computer systems, in *Newton*.

Accordingly, Petitioner has failed to demonstrate a reasonable likelihood of success for either Ground 1 or 2 for at least three reasons.

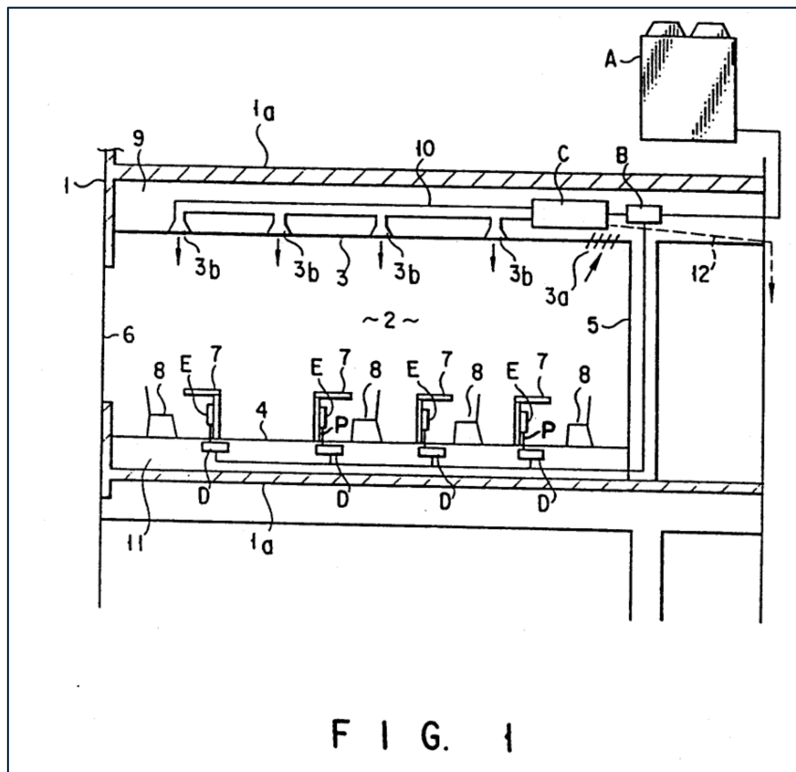
B. Petitioner Fails to Show a Reasonable Likelihood of Success for Ground 3

Petitioner's Ground 3 asserts that *Shimizu* anticipates challenged claims 1-4, 7, and 9 of the '287 Patent. Petition (Paper 1), 47. However, as demonstrated below, the system of *Shimizu* does not disclose the claimed "*a room configured to house a plurality of computer systems*," (namely a data center, *see* Section III.A, above), as required by independent claim 1 of the '287 Patent.

Indeed, Petitioner concedes that *Shimizu* does not disclose a data center, and instead simply discloses cooling "the internal space of a room of a building containing desks 7 and chairs 8." Petition (Paper 1), 48; *see also* EX1002 ¶¶199-200 (expert making same verbatim assertions).

A review of the Figures and "detailed description" of *Shimizu* further supports that *Shimizu* does not disclose a data center. This can be seen in Figure 1 and *Shimizu*'s corresponding disclosure.

Shimizu discloses, in Figure 1, reproduced below, "a room 2" that is "provided on each floor of a building 1" containing "[a] large number of desks 7 and chairs 8" which are "on the floor 4." EX1008, 3:48-55. *Shimizu* further explains that "[p]ersonal air-conditioning unites E are respectively attached to the desks 7" and are "used for separately air-conditioning spaces around the desks 7." EX1008, 3:65-68.



EX1008, FIG. 1.

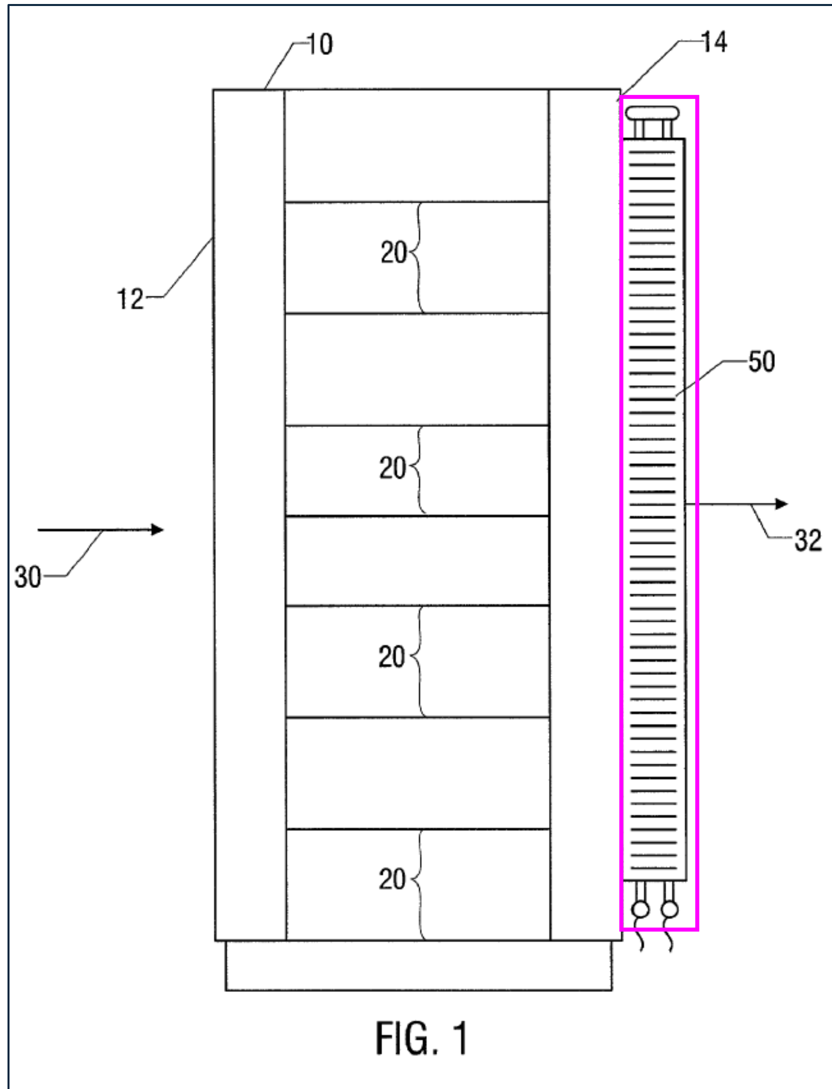
As discussed above, *see* Section III.A, the ’287 Patent discloses and claims a method for cooling a data center. In contrast, *Shimizu* discloses a method for cooling “desks” in an office. EX1008, 3:50-55. There is no mention of a data center in *Shimizu.*

Thus, because *Shimizu* does not disclose all limitations of independent claim 1, Petitioner cannot meet its burden of proving anticipation of independent claim 1or any of the dependent claims. Petitioner has thus failed to show a reasonable likelihood of success for any Challenged Claim in its Ground 3.

C. Petitioner Fails to Show a Reasonable Likelihood of Success for Ground 4

Petitioner’s Ground 4 asserts that claims 1, 3, 7, and 9 are anticipated by *Baer.* Petition (Paper 1), 60. However, as demonstrated below, *Baer* does not disclose “providing a plurality of heat exchanger units configured to receive air from said room and to deliver air to said room,” required by step 1[a] of claim 1 of the ’287 Patent, let alone “supplying said plurality of heat exchanger units with cooling fluid from an air conditioning unit” as required by step 1[b]. Petition (Paper 1), 61-62

First, Petitioner asserts that *Baer* discloses claim step 1[a], “providing *a plurality of heat exchanger units* configured to receive air from said room and to deliver air to *said room*,” pointing to only a single “heat exchanger 50” in Figure 1 (reproduced below), with coloring added to show the **single heat exchanger**. Petition (Paper 1), 61-63 (citing EX1008 [sic: EX1011], [0021]).



EX1011, FIG. 1 (annotated).

Indeed, Petitioner concedes that only a single heat exchanger 50 is disclosed, but then asserts that "[a] POSITA would have recognized that a typical computer room contains multiple rack enclosures," that "Baer indicates that its disclosures addresses a need 'to install additional localized cooling for *enclosures* containing electronic equipment that will remove the heat generated by the electronic equipment from the room….'" Petition (Paper 1), 62 (quoting EX1008 [sic:

EX1011], [0003]; ellipses and emphasis added by Petitioner). According to Petitioner, "[t]herefore, Baer discloses providing multiple heat exchangers, each associated with one of multiple rack enclosures within a room, and each operating to receive warm air from the room and to return cooled air to the room." Petition (Paper 1), 62 (citing EX1008 [sic: EX1011], [0004]-[0005]; [0008]-[0010], [0022]-[0023], [0030]). Its expert makes the same assertion, *verbatim*, without any additional evidence or analysis, EX1002 ¶260, and like above, should be afforded little to no weight. *See Xerox*, IPR2022-00624, Paper 9, 15.

But what may be "typical" or an alleged "need" does not demonstrate that *Baer* itself discloses "providing *a plurality of heat exchanger units* configured to receive air from said room and to deliver air to *said room*." Nor does Petitioner pointing to the *background* in *Baer* (EX1011, [0003]) demonstrate that *Baer* discloses in its later embodiments the required plurality. This alone shows that Petitioner has failed to meet its burden to show that *Baer* discloses each step of, and therefore *anticipates*, independent claim 1, as Petitioner asserts in its Ground 4. *See Intelligent Wellhead*, IPR2024-00583, Paper 9, 16-18 (denying institution where Petitioner failed to show that allegedly anticipatory reference disclosed all claim limitations and where "the combinability of these embodiments is not readily apparent"); *Qualcomm*, IPR2024-00355, Paper 9, 45-47 (denying institution where

allegedly anticipatory reference did not disclose all claim limitations); *see also, e.g.*, *Net MoneyIN*, 545 F.3d at 1369.

Moreover, a review of *Baer*—including the portions cited by Petitioner—confirms that it discloses only a *single* heat exchanger. In fact, *Baer* never uses "heat exchangers" (plural) in any sense; it *always* discloses only a single "heat exchanger" in a room (using the term "heat exchanger" (singular) nearly 80 times in its specification and claims). *See generally* EX1011.

Baer discloses, in its "Summary of the Invention," that "[t]he principle of operation of the present system is as follows:"

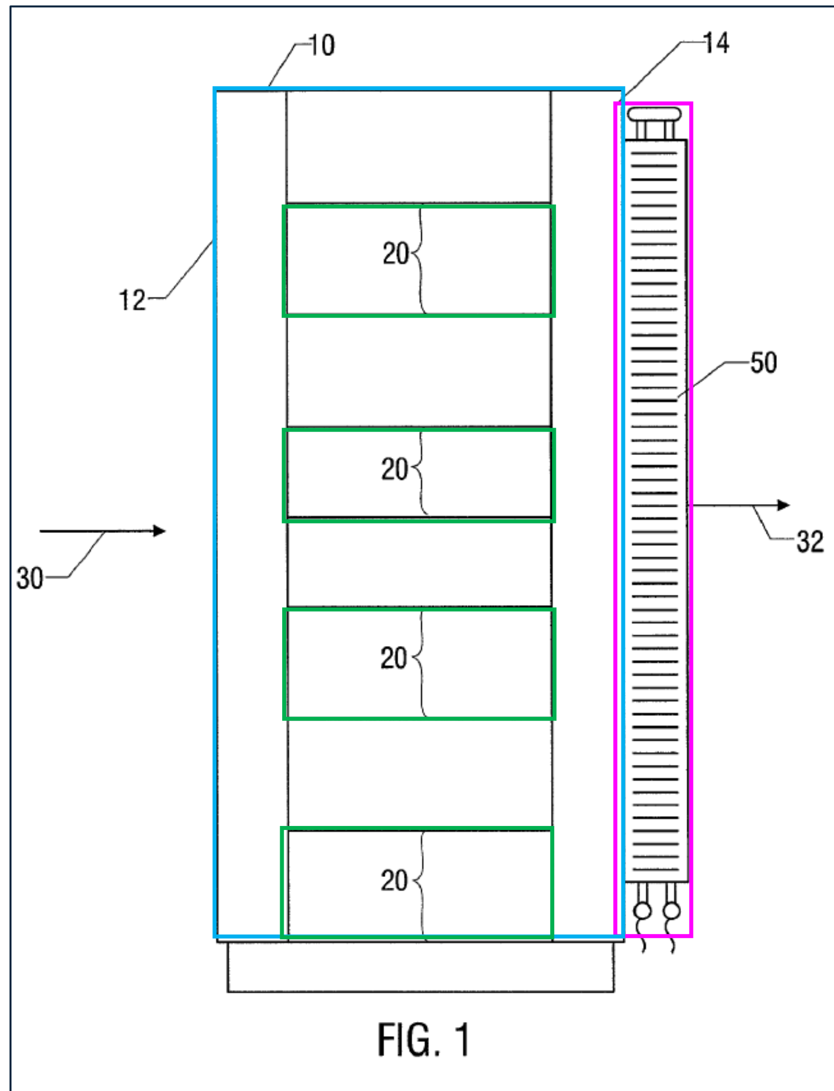
> Air from the computer room at the ambient temperature and humidity is taken into the enclosure and heated by the electronic equipment. The air is then expelled through *a heat exchanger*, which cools the air back to the ambient temperature. The exiting air is cooled using an external source of chilled water, glycol or a suitable dielectric fluid, which is typically readily available in commercial installations. By returning the air exiting the enclosure to the ambient temperature in the room, the load on the room air conditioning is reduced or eliminated. Furthermore, the cooling fluid provides a more efficient heat transfer medium for removing heat from the room than the room air, as would be the case with a conventional prior art cooling system.

EX1011, [0005] (emphasis added).

Baer further discloses various "aspect[s] of the present invention," again focusing only on a single heat exchanger. EX1011, [0006]-[0007] ("The cooling system includes *a heat exchanger* attached to the enclosure. The room air enters the enclosure and absorbs heat from the equipment in the enclosure. *The heat exchanger* absorbs heat from the air and returns the air to the room at substantially the same ambient conditions of the ambient air in the room.") (emphasis added), [0007] ("[T]here is provided a mechanism for moving air from the enclosure, through *the heat exchanger*, and back into the room.") (emphasis added).

Baer then provides, in Figure 1 (reproduced below), "[a]n apparatus in accordance with the present invention." EX1011, [0021]. In Figure 1, *Baer* discloses a single "**[r]ack enclosure 10**" with multiple "**[m]ounting racks 20**" that "hold various computer and electronic equipment." EX1011, [0021]. This apparatus functions by "draw[ing] air 30 from the room, through the front 12 of enclosure 10." EX1011, [0021]. "The air passes over the electronic equipment mounted in racks 20 and absorbs the heat generated by the electronics." EX1011, [0021]. "The air 32 flows out the back 14 of enclosure 10 and back into the computer room." EX1011, [0021]. To accomplish this, *Baer* discloses precisely one **heat exchanger 50** that "is mounted on the rear 40 of **rack enclosure 10**," where "air 30 is drawn from the room through the front 30 of rack enclosure 10," and "[a]s discussed above, . . . [t]he air

passes over the electronic equipment mounted in racks 20 and through **heat exchanger 50**." EX1011, [0023]. According to Baer, "**[h]eat exchanger 50** absorbs the heat added to the air by the electronic equipment, thereby eliminating the additional heat load to the room air conditioning system." EX1011, [0023].



EX1011, FIG. 1 (annotated).

Baer further discloses that, "[t]o present a neutral heat load to the computer room air conditioning system, the heat exchanger must absorb all of the heat added

to the air, thereby reducing its temperature to the 75 degrees ambient temperature of the computer room." EX1011, [0024]; *see also, e.g.*, FIG. 2 (depicting single heat exchanger 50), [0027]-[0029] (detailing single heat exchanger 50).

In sum: there is simply no disclosure of "a plurality of heat exchanging units" in *Baer*, as required by independent claim 1 of the '287 Patent. To the contrary, *Baer* discloses only a single heat exchanger and thus Petitioner has failed to show a reasonable likelihood of success that any Challenged Claim is anticipated by *Baer.*

Second, even if *Baer* discloses "a plurality of heat exchanger units" (it does not, as explained in this Section above), Petitioner's Ground 4 still fails because *Baer* does not disclose "supplying *said plurality of heat exchanger units* with cooling fluid from *an air conditioning unit*," as required by step 1[b] of claim 1 of the '287 Patent.

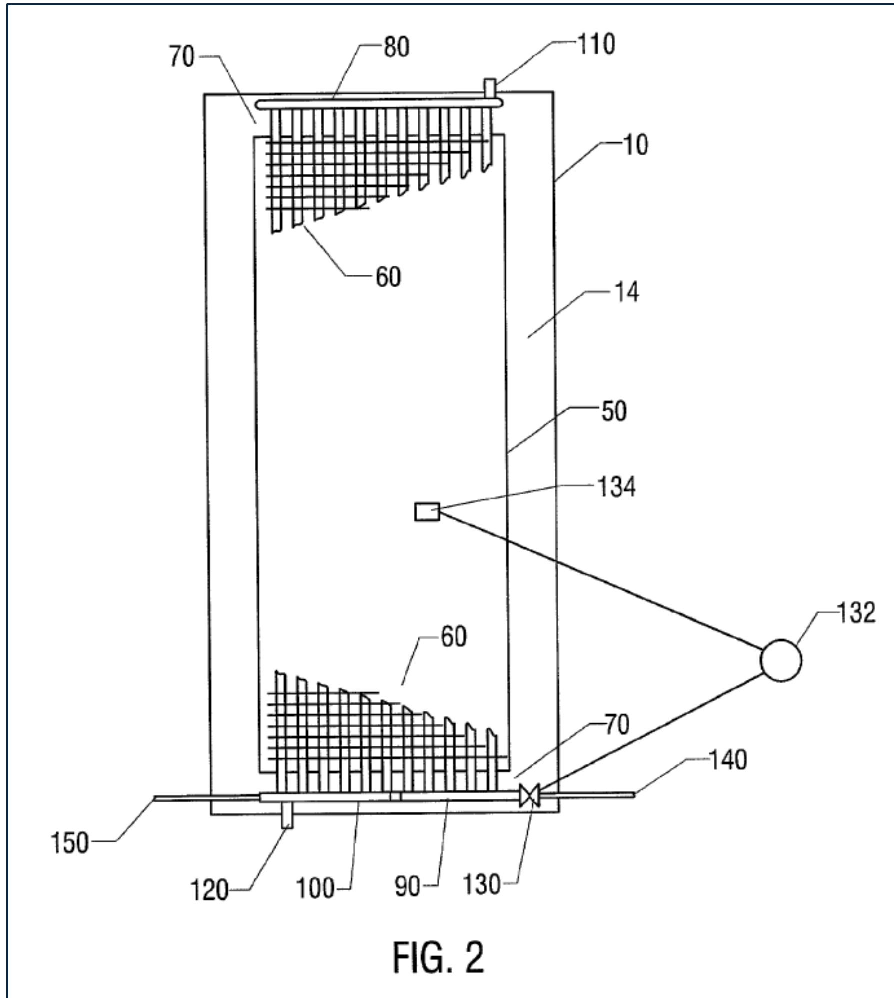
While Petitioner asserts that step 1[b] is disclosed by *Baer*, Petitioner *never* explains how or where *Baer* discloses that the alleged "plurality of heat exchanger units" is supplied "with cooling fluid from *an* air conditioning unit." *See* Petition (Paper 1), 62-64. Instead, Petitioner points to the *single* heat exchanger 50 in *Baer*, and asserts that such heat exchanger 50 is supplied with cooling fluid. Petition (Paper 1), 62-64. The closest Petitioner appears to come is its conclusory and unsupported assertion that "[a] POSITA would have understood the described cooling flow circulation to apply to the heat exchangers mounted to other rack enclosures in the computer room as well, each receiving cooling fluid from the external cooling source

and returning it to the external cooling source after absorbing heat from the air." Petition (Paper 1), 64 (citing EX1002 ¶265). Its expert once again makes the same copy-and-paste assertion, without any additional support or analysis. EX1002 ¶265; *see also Xerox*, IPR2022-00624, Paper 9, 15.

Moreover, a review of *Baer* likewise confirms there is no actual disclosure of "supplying *said plurality of heat exchanger units* with cooling fluid from *an air conditioning unit*." Indeed, even assuming that there are multiple heat exchanger units in *Baer* (again, there are not), there is no disclosure that these multiple heat exchanger units are supplied with cooling fluid from the same air conditioning unit or that any of the alleged heat exchanger units are connected in any way (let alone to an air conditioning unit).

As discussed above in this Section (regarding step 1[a]), *Baer* discloses a single heat exchanger unit 50. *Baer* provides further details of heat exchanger 50 in Figure 2, reproduced below. EX1011, [0027]-[0029]. *Baer* discloses that "chilled cooling fluid passes upward through cooling tubes 70," which fluid "absorbs heat from the air." EX1011, [0028]. "The cooling fluid then reaches top header 80 at the top of the heat exchanger and returns downward through another set of cooling tubes 70," where the "fluid absorbs additional heat from the airflow across the electronic components and reaches the outlet header 100 located at the bottom of heat exchanger 50." EX1011, [0028]. "The cooling fluid, now heated is returned through

fluid return 150" and "[t]he cooling fluid flows to *an external cooling source* that rejects the heat absorbed by the fluid *outside the computer room*." EX1011, [0028] (emphasis added). This "external cooling source" outside of the room "may be a chiller or second heat exchanger." EX1011, [0028].



EX1011, FIG. 2.

Importantly, however, there is no disclosure in *Baer*—nor does Petitioner point to any—of multiple heat exchangers being supplied by this "external cooling source" or even how any alleged multiple heat exchangers would be connected to

the same "source." Rather, *Baer* only discloses a one-to-one ratio: a single "heat exchanger" connected to a single "external cooling source."

Thus, *Baer* also does not disclose the claim step 1[b], "supplying *said plurality of heat exchanger units* with cooling fluid from *an air conditioning unit*," and Petitioner's anticipation Ground 4 fails for a second reason. *See, e.g.*, *Intelligent Wellhead*, IPR2024-00583, Paper 9, 16-18; *Qualcomm*, IPR2024-00355, Paper 9, 45-47; *Net MoneyIN*, 545 F.3d at 1369.

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 (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 '287 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)[5]. In both cases, Patent Owner has asserted that Petitioner's customers directly infringe claims from the '287 Patent, and both DataBank and TierPoint have asserted defenses and

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[5] 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.

counterclaims alleging that the ’287 Patent is invalid and not infringed. EX2004, 10, 16-17; EX2005, 7-8, 14-15.

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 (serving “[o]n

behalf of Tierpoint and DataBank" invalidity contentions including "Attachments: 2025-04-01 – Vertiv's Invalidity Contentions – Cover Pleading.pdf"); *see also* EX2022 (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), 73, 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 Strathyclyde*, IPR2019-00588, Paper 24,[6] 9 (PTAB Sept. 30, 2019) (finding that a

[6] Public version available at Paper 28.

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."[7] Respectfully, these decisions are both

[7] 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 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.

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

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 7,083 words, excluding the parts of the paper exempted by 37 C.F.R. §42.24(a).

Dated: July 14, 2025

Respectfully submitted,

/Patrick Colsher/

Patrick Colsher (Reg. No. 74,955)
Counsel for Patent Owner

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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