

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE  
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

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INERGY TECHNOLOGY, INC.,  
Petitioner,

v.

FORCE MOS TECHNOLOGY CO., LTD.,  
Patent Owner.

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IPR2024-00094  
Patent 7,812,409 B2

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Before COKE MORGAN STEWART, *Acting Under Secretary of  
Commerce for Intellectual Property and Acting Director of the United States  
Patent and Trademark Office.*

ORDER  
Authorizing Additional Evidence and Briefing

Force MOS Technology Co., Ltd. (“Patent Owner”) filed a request for Director Review of the Final Written Decision (“Decision”) in the above-captioned case, and Inergy Technology, Inc. (“Petitioner”) filed an authorized response to the request. *See* Paper 38 (“DR Request”); Paper 39. Patent Owner argues that Director Review should be granted because a district court and jury already determined that claim 1 of the challenged patent is not invalid when Petitioner’s real party-in-interest, ASUSTeK Computer, Inc., presented the same prior art and invalidity grounds in the district court proceeding.<sup>1</sup> DR Request 1, 9–10. According to Patent Owner, the Board should not have instituted *inter partes* review under *Fintiv*,<sup>2</sup> in view of the district court litigation. Alternatively, Patent Owner seeks a new final written decision confirming patentability of all challenged claims. *Id.* at 2.

Petitioner responds that Patent Owner’s DR Request is not compliant with the Director Review process because Patent Owner introduces new evidence and raises institution issues at the final written decision stage of the proceeding. Paper 39, 1–4. As to the merits of the Board’s Decision, Petitioner argues that the Board’s decision is sound. *Id.* at 4–5.

Patent Owner’s request to reconsider the Board’s institution decision and to terminate the proceeding because the Board should have denied

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<sup>1</sup> After the Board’s Decision, but prior to filing the DR Request, Patent Owner requested leave to supplement the record to file documents from the district court litigation, including the jury verdict, a redacted version of the trial transcript, the district court’s findings of fact and conclusions of law, and the final judgment. *See* Ex. 3101. That request was denied. *Id.*

<sup>2</sup> *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (Mar. 20, 2020) (precedential).

institution will not be considered at this time given the timing of Patent Owner's notice of the jury verdict.

As to Patent Owner's alternative request to reconsider the Final Written Decision, additional information is necessary to determine whether Director Review is appropriate. Patent Owner raises the February 2025 jury verdict and the district court's June 2025 findings of fact and conclusions of law in its DR Request. DR Request 9–10. The Board did not assess the jury's determination or the district court's relevant findings because, as Patent Owner explains, Patent Owner requested leave to file certain documents and evidence from the district court proceeding after the Board issued its Decision. *Id.* at 4 n.1. Although Patent Owner should have brought the jury verdict to the Board's attention immediately after the verdict was entered,<sup>3</sup> it is important for the Board to consider a district court's prior validity determination when adjudicating the patentability of the same or substantially the same claims.

In view of the foregoing, the parties are ordered to jointly submit, as a single exhibit with a table of contents or index, relevant excerpts from the record of the district court proceeding, including trial transcripts, the jury verdict, and the district court's findings of fact and conclusions of law. Each party also is authorized to file a ten-page brief explaining the similarities and differences between the arguments and evidence presented in the district court and the arguments and evidence presented in this proceeding. The

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<sup>3</sup> The district court issued its findings of fact and conclusions of law after the Board's Decision, and Patent Owner notified the Office of the court's opinion shortly after the opinion issued and before Patent Owner filed its DR Request.

exhibit of relevant excerpts and additional briefing shall be filed within thirty days of the date of this Order.

Accordingly, it is:

ORDERED that the parties shall jointly submit an exhibit of relevant excerpts from the related district court proceeding that includes a table of contents or index;

FURTHER ORDERED that Patent Owner and Petitioner are each authorized to file a ten-page brief as set forth above; and

FURTHER ORDERED that the exhibit of relevant excerpts and the parties' briefs shall be filed within thirty days of the date of this Order.

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