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Paper 13
Entered: November 12, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

ECOFACTOR INC.,
Patent Owner.

IPR2021-00982
Patent 10,612,983 B2

Before WESLEY B. DERRICK, JEFFREY W. ABRAHAM, and SCOTT B. HOWARD, *Administrative Patent Judges*.

ABRAHAM, *Administrative Patent Judge*.

ORDER
Vacating Decision Denying Institution of *Inter Partes* Review
37 C.F.R. §42.5

Google LLC ("Petitioner") filed a Petition (Paper 2, "Pet.") requesting *inter partes* review of claims 1–7 and 10–30 of U.S. Patent No. 10,612,983 B2 (Ex. 1001, "the '983 patent"). EcoFactor Inc. ("Patent Owner") filed a Preliminary Response to the Petition (Paper 10, "Prelim. Resp.").

In its Preliminary Response, Patent Owner argued that we should exercise discretion under 35 U.S.C. § 314 and deny institution because the '983 patent is the subject of a pending ITC proceeding that is at an advanced stage and involves the same parties, overlapping claims, overlapping invalidity theories, and overlapping prior art. Prelim. Resp. 1 (citing *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) ("*Fintiv*")). Petitioner argued that the evaluation of the factors set forth in *Fintiv* demonstrates we should not exercise discretion to deny institution of *inter partes* review. Pet. 84–86.

On November 9, 2021, having evaluated all of the *Fintiv* factors based on the arguments and evidence of record at that time, in the exercise of the Director's discretion under 35 U.S.C. § 314(a), we issued a Decision Denying Instituion of *Inter Partes* Review. Paper 12.

After we issued the Decision, we became aware of an email sent to the PTAB Trials mailbox on November 8, 2021, indicating that Patent Owner filed a motion to terminate the ITC proceeding with respect to the '983 patent. Ex. 3002. In the email, Petitioner requested authorization to file the motion as an exhibit, and indicated that Patent Owner did not oppose the request. Ex. 3002.

Because the information in the November 8, 2021, email impacts our analysis of the *Fintiv* factors, we vacate the Decision Denying Institution of *Inter Partes* Review. The panel will issue a new decision addressing

Petitioner's request for *inter partes* review of claims 1–7 and 10–30 of the '983 patent in due course.

In consideration of the foregoing, it is hereby

ORDERED that the Decision Denying Institution of *Inter Partes* Review (Paper 12) is *vacated*; and

FURTHER ORDERED that Petitioner is authorized to file Patent Owner's motion to terminate ITC Investigation No. 337-TA-1258 with respect to the '983 patent as an exhibit in this proceeding.

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