

UNITED STATES PATENT AND TRADEMARK OFFICE

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

INNOSCIENCE (ZHUHAI) TECHNOLOGY COMPANY, LTD. and
INNOSCIENCE AMERICA, INC.,
Petitioner,

v.

EFFICIENT POWER CONVERSION CORPORATION,
Patent Owner.

IPR2023-01381
Patent 8,350,294 B2

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

ORDER

Granting Patent Owner's Request for an Extension of Time
to File a Request for Director Review

Efficient Power Conversion Corporation (“Patent Owner”) moves for a 14-day extension to file a request for Director Review of the Board’s Final Written Decision (Paper 45). Paper 47.¹ Patent Owner represents in its motion that it is substituting new counsel for counsel currently of record and has since done so. Paper 47, 3; *see* Paper 48 (Patent Owner’s Updated Power of Attorney); Paper 49 (Patent Owner’s Updated Mandatory Notices). Patent Owner contends that new counsel needs sufficient time to investigate the relevant legal issues and record. Paper 47, 3. Patent Owner also argues that this *inter partes* review (“IPR”) should have been terminated under the March 24, 2025, guidance memorandum² to the Board regarding the exercise of discretion in IPRs involving parallel litigation.

Petitioner opposes the motion, arguing that a request for Director Review is now untimely and that any request for Director Review will be futile, because the March 24, 2025, guidance memorandum does not apply to this IPR. Paper 50, 1–4. Petitioner further argues that Patent Owner’s retention of new counsel does not excuse Patent Owner’s belated motion for an extension of time. *Id.* at 5.

It is undisputed that Patent Owner recently retained new counsel. *See* Papers 48, 49. It is also undisputed that Patent Owner filed its motion for an extension of time before the deadline to file a Director Review request

¹ The request for Director Review was due on April 17, 2025. With Patent Owner’s requested extension, the due date would be May 1, 2025.

² Guidance on USPTO’s rescission of “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation,” (Mar. 24, 2025), *available at* https://www.uspto.gov/sites/default/files/documents/guidance_memo_on_interim_procedure_rescission_20250324.pdf.

expired. *See* Paper 47 (filed Apr. 17, 2025). Under these circumstances, Patent Owner has shown good cause to grant an extension. Allowing an extension will permit new counsel to submit a fully developed request for Director Review after a complete investigation of the case. Petitioner is not prejudiced because it may respond to Patent Owner's Director Review request.

Given that Patent Owner's requested extension would expire tomorrow, Patent Owner's deadline to file the Director review request is extended to May 8, 2025.

Whether Patent Owner's request for Director Review ultimately will be futile is not relevant to Patent Owner's good cause showing. However, Patent Owner should address in its request for Director Review Petitioner's contention that the March 24, 2025, guidance memorandum does not apply to this IPR. Paper 50, 3.

In consideration of the foregoing, it is:

ORDERED that Patent Owner's motion for an extension of time (Paper 47) is granted; and

FURTHER ORDERED that the due date for filing a request for Director Review of the Board's Final Written Decision is extended to May 8, 2025.

IPR2023-01381
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For PETITIONER:

Lionel Lavenue
Kara Specht
Cory Bell
Forrest Jones
Chen Zang
Yi Yu
Luke MacDonald
Carlos Duarte-Guevara
FINNEGAN, HENDERSON, FARABOW,
GARRETT, & DUNNER LLP
lionel.lavenue@finnegan.com
kara.specht@finnegan.com
cory.bell@finnegan.com
forrest.jones@finnegan.com
chen.zang@finnegan.com
yi.yu@finnegan.com
luke.macdonald@finnegan.com
carlos.duarte-guevara@finnegan.com

For PATENT OWNER:

Walter Davis
Dipu Doshi
Mark Thronson
Stephen Soffen
Ameya Paradkar
Jonathan England
BLANK ROME LLP
walter.davis@blankrome.com
dipu.doshi@blankrome.com
mthronson@blankrome.com
ssoffen@blankrome.com
aparadkar@blankrome.com
jwengland@blankrome.com