

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ASETEK DANMARK A/S,
Petitioner,

v.

COOLIT SYSTEMS, INC.,
Patent Owner.

IPR2020-00825
Patent 10,274,266 B2

Before FRANCES L. IPPOLITO, SCOTT C. MOORE, and
BRENT M. DOUGAL, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

JUDGMENT

Final Written Decision

Determining Some Challenged Claims Unpatentable

35 U.S.C. § 318(a)

Granting Patent Owner's Motion to Exclude

37 C.F.R. § 42.64

I. INTRODUCTION

Asetek Danmark A/S (“Petitioner”) filed a Petition requesting an *inter partes* review of claims 1, 2, 4, 5, 9, and 13–15 of U.S. Patent No. 10,274,266 B2 (Ex. 1001, “the ’266 Patent”). Paper 2 (“Pet.”). CoolIT Systems, Inc. (“Patent Owner”) filed a preliminary response. Paper 6. Pursuant to our authorization, Petitioner filed a reply to Patent Owner’s preliminary response (Paper 7), and Patent Owner filed a sur-reply in support of its preliminary response (Paper 10). We instituted an *inter partes* review as to all claims and grounds set forth in the Petition. Paper 12 (“Institution Decision”).

After institution, Patent Owner filed a response to the Petition (Paper 25, “Response” or “Resp.”), Petitioner filed a reply to the response (Paper 28, “Reply”), and Patent Owner filed a sur-reply (Paper 34, “Sur-Reply”). In addition, Patent Owner filed a motion to exclude (Paper 35, “Motion to Exclude”), Petitioner filed an opposition to the motion to exclude (Paper 38), and Patent Owner filed a reply in support of the motion to exclude (Paper 43). An oral hearing was held on June 22, 2021, and a transcript of the hearing is in the record. Paper 49 (“Tr.”).

We have jurisdiction under 35 U.S.C. § 6. This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a). For the reasons that follow, we determine that Petitioner has shown by a preponderance of the evidence that claims 1, 2, 4, 5, and 9 are unpatentable, but has not shown by a preponderance of the evidence that claims 13–15 are unpatentable. We also grant Patent Owner’s Motion to Exclude.

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Patent 10,274,266 B2

A. *Related Matters*

Patent Owner sued Petitioner for infringement of the '266 Patent in *Asetek Danmark A/S v. CoolIT Systems, Inc.*, Case No. 3:19-cv-00410-EMC (N.D. Cal) (the “district court case”). Pet. 106. Petitioner points out that the '266 Patent is related to issued patents U.S. 9,909,820 B2, U.S. 9,453,691 B2, and U.S. 8,746,330 B2. *Id.* at 106.

The '266 Patent, filed March 5, 2018, as U.S. Application 15/912,478, is a continuation of U.S. Patent No. 9,909,820 B2, which is a continuation of U.S. Patent No. 9,453,691 B2, which is a continuation-in-part of U.S. Patent No. 8,746,330 B2 (Ex. 1004, “the '330 Patent”). Ex. 1001, codes (21), (22), (63). The '330 Patent issued from U.S. Application No. 12/189,476, which was published as U.S. Publication No. 2009/0071625 A1. *Id.*; Ex. 1011 (“Lyon”), codes (10), (21), (43).

The '266 Patent claims priority to U.S. Provisional Application No. 61/512,379 (Ex. 1006, “the 2011 Provisional”) and U.S. Provisional Application No. 60/954,987 (Ex. 1005, “the 2007 Provisional”). Ex. 1001, code (60); *see also* Paper 6, 9.

Patent Owner points out that the “[t]he Board confirmed patentability of all challenged claims of the '330 patent . . . in a Final Written Decision following trial on the merits” in IPR2015-01276. Paper 6, 44.

On March 26, 2020, Petitioner filed a separate petition requesting *inter partes* review of claims 1, 2, 3, 5, 7, 25 of U.S. Patent No. 9,057,567 B2 (“the '567 Patent”). *See* IPR2020-00747 (“the '747 IPR”), Papers 2, 3.¹ The '567 Patent is a continuation of U.S. Application No. 10/166,657, which

¹ Petitioner also originally challenged claim 28, but Patent Owner subsequently filed a statutory disclaimer of that claim, eliminating it from the proceeding. *See* '747 IPR, Paper 42, 6.

is a continuation of U.S. Application No. 13/401,618, which is a continuation-in-part of the '330 Patent. *Id.*, Paper 2, 21. We issued a final written decision in the '747 IPR determining that Petitioner had shown by a preponderance of the evidence that all challenged claims of the '567 Patent were unpatentable. '747 IPR, Paper 42 (Sept. 30, 2021).

B. The '266 Patent

The '266 Patent is generally directed to a fluid heat exchange system for accepting and dissipating thermal energy to cool electronic and other devices. Ex. 1001, 1:20–28.

Figure 1, reproduced below, depicts such a system.

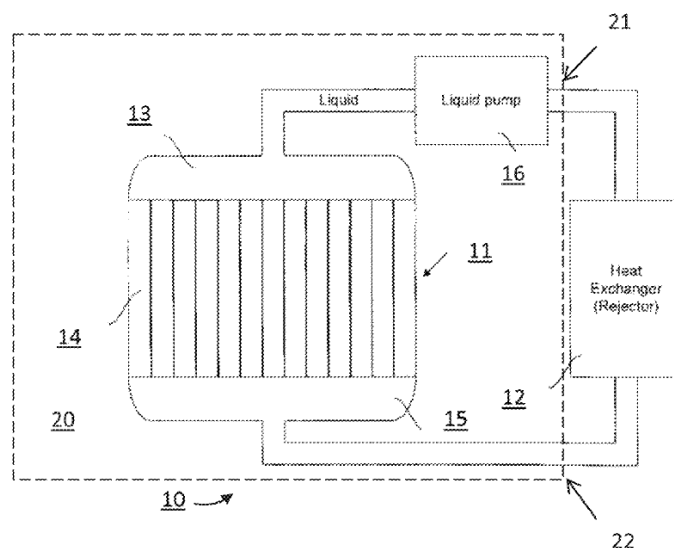


FIG. 1

Figure 1 is a diagram of a fluid circuit configured to transfer heat using a circulating liquid. Ex. 1001, 5:31–32. In Figure 1, liquid circulates through fluid circuit 10 by entering inlet 21, moving through heat exchanger 11, and exiting outlet 22. *Id.* at 6:56–67, 7:44–67. Heat exchanger 11 has manifolds 13, 15 and passages 14. *Id.* at 7:55–60.

Figure 2, reproduced below, depicts an exemplary embodiment of a heat exchanger.

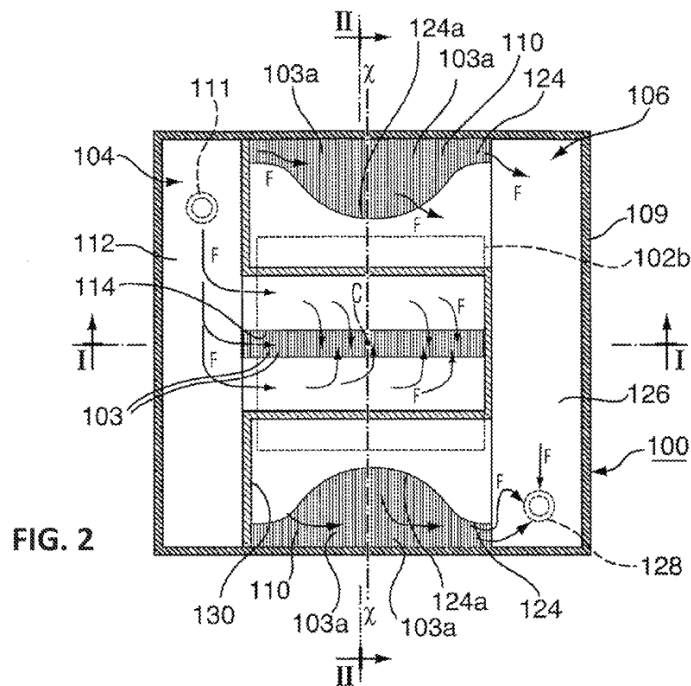


Figure 2 is a top plan view of internal components of fluid heat exchanger 100. Ex. 1001, 5:33–35. Fluid heat exchanger 100 includes housing 109, inlet port 111, fluid inlet passage 104, inlet opening 114, microchannels 103, seal 130, fluid outlet opening 124, fluid outlet passage 106, and outlet port 128. *Id.* at 8:3–9, 9:35–11:9, 12:19–22. Each microchannel 103 is defined by a recessed groove extending transversely between adjacent fins. *Id.* at 2:45–48. Heat exchanging fluid F flows in the directions indicated by the arrows. *Id.* at 11:50–53. Heat exchanging fluid F enters microchannels 103 and splits into two sub flows in opposite directions to pass outwardly from inlet opening 114 towards outlet fluid opening 124. *Id.* at 11:34–12:2.

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