

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SHENZHEN SILVER STAR INTELLIGENT TECHNOLOGY CO., LTD.,
Petitioner,

v.

IROBOT CORP.,
Patent Owner.

Case IPR2018-00882
Patent 9,038,233 B2

Before WILLIAM V. SAINDON, TERRENCE W. MCMILLIN, and
AMANDA F. WIEKER, *Administrative Patent Judges*.

WIEKER, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314(a)

I. INTRODUCTION

A. Background

Shenzhen Silver Star Intelligent Technology Co., Ltd. (“Petitioner”) filed a Petition requesting an *inter partes* review of claims 1, 9, 10, 15, and 16 (“the challenged claims”) of U.S. Patent No. 9,038,233 B2 (Ex. 1001, “the ’233 patent”). Paper 3 (“Pet.”). iRobot Corp. (“Patent Owner”) filed a Preliminary Response. Paper 7 (“Prelim. Resp.”); *see also* Paper 8 (denying Petitioner’s request to file a Reply, for lack of good cause).

We have authority under 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted unless the information presented in the Petition and the Preliminary Response shows that “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314; *see also* 37 C.F.R. § 42.4(a) (“The Board institutes the trial on behalf of the Director.”).

For the reasons that follow, we do not institute an *inter partes* review of any of the challenged claims of the ’233 patent.

B. Related Proceedings

The parties identify the following matters related to the ’233 patent (Pet. 1–2; Paper 5, 2–3):

In re Certain Robotic Vacuum Cleaning Devices And Components Thereof Such As Spare Parts, Inv. No. 337-TA-1057 (USITC);

iRobot Corporation v. Hoover, Inc., et al., Case No. 1:17-cv-10647 (D. Mass.);

iRobot Corporation v. The Black & Decker Corp., et al., Case No. 1:17-cv-10648 (D. Mass.);

iRobot Corporation v. Bissell Homecare, Inc., et al., Case No. 1:17-cv-10649 (D. Mass.);

iRobot Corporation v. Bobsweep, Inc., et al., Case No. 1:17-cv-10651(D. Mass.);

iRobot Corp. v. Shenzhen Zhiyi Technology Co. Ltd., Case No. 1:17-cv-10652 (D. Mass.); and

Shenzhen Zhiyi Technology Co., Ltd. v. iRobot Corp., IPR2017-02050 (PTAB) (the “–2050 IPR”).

C. The '233 Patent

The '233 patent is titled “Autonomous Floor-Cleaning Robot” and issued on May 26, 2015, from U.S. Application No. 13/714,546, filed on December 14, 2013. Ex. 1001, (21), (22), (54). The '233 patent discloses a floor-cleaning robot. *Id.* at 1:23–24. Figure 2A of the '233 patent is reproduced below.

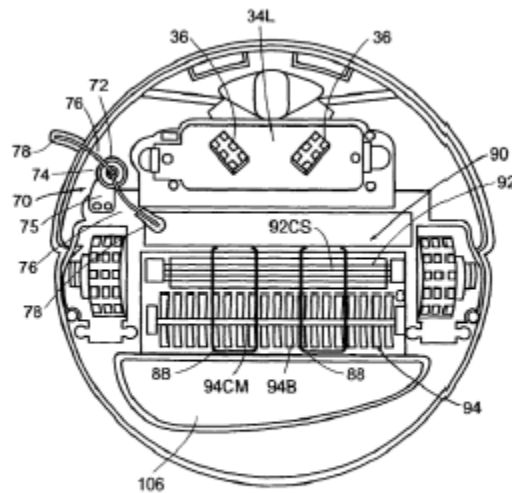


FIG. 2A

Figure 2A is a bottom plan view of an autonomous floor-cleaning robot. *Id.* at 2:47–48. The robot includes side brush assembly 70 and self-adjusting cleaning head subsystem 80 (reference numeral not depicted in Figure 2A), which includes brush assembly 90 and vacuum assembly 100 (also not depicted in Figure 2A). *Id.* at 3:34–44.

The '233 patent explains that “side brush assembly 70 is operative to entrain macroscopic and microscopic particulates outside the periphery of the housing infrastructure 20 . . . and to direct such particulates towards the self-adjusting cleaning head subsystem 80. This provides the robot 10 with the capability of cleaning surfaces adjacent to baseboards.” *Id.* at 8:28–34. A “removable dust cartridge 86 provides temporary storage for macroscopic and microscopic particulates swept up by operation of the dual-stage brush assembly 90 and microscopic particulates drawn in by the operation of the vacuum assembly 100.” *Id.* at 11:24–28.

The disclosed floor-cleaning robot also includes sensor subsystem 50, including control sensing units 52, which control normal robot operation, and emergency sensing units 54, which detect situations that could adversely affect robot operation. *Id.* at 6:58–65. For example, control sensing units include obstacle detection sensors 520D. *Id.* at 7:13–15; *see also id.* at 7:16–22 (other control sensors). Additionally, emergency sensing units 54 include cliff detectors 54CD, capable of detecting, e.g., descending stairs. *Id.* at 7:47–48, 57–61; *see also id.* at 7:49–59 (other emergency sensors).

D. Illustrative Claim

Of the challenged claims, claims 1 and 15 are independent. Claim 1 is illustrative and is reproduced below.

1. A self-propelled floor-cleaning robot comprising[:]
a housing defining a housing perimeter;
a powered primary brush assembly disposed within the housing perimeter and positioned to engage a floor surface, the primary brush assembly being configured to rotate about an axis generally parallel to the floor surface;
a cliff detector carried by the housing and configured to direct a beam toward the floor surface and to respond to a falling edge of the floor surface; and

a powered side brush extending beyond the housing perimeter and positioned to brush floor surface debris from beyond the housing perimeter, the side brush being configured to rotate about an axis generally perpendicular to the floor surface and to rotate in a direction to direct debris toward the robot along a projected direction of movement of the powered primary brush assembly, the side brush having bundles of bristles and being positioned such that the bundles of bristles pass between the cliff detector and the floor surface during a rotation of the side brush around the axis, the bundles of bristles being separated by a gap, the gap being configured to prevent occlusion of the cliff detector beam during at least part of the rotation of the side brush around the axis;

a particulate receptacle positioned to receive and collect particulates brushed from the floor surface by the primary brush assembly and the powered side brush;

an obstacle detector responsive to obstacles encountered by the robot; and

a control circuit in electrical communication with a motor drive and configured to control the motor drive to maneuver the robot about detected obstacles across the floor surface during a floor-cleaning operation.

Ex. 1001, 16:39–17:4.

E. Applied References

Petitioner relies upon the following references:

Jones, U.S. Patent No. 6,594,844 B2, filed Jan. 24, 2001, issued July 22, 2003 (Ex. 1005, “Jones”);

Lee, U.S. Patent No. 5,293,955, filed Dec. 30, 1992, issued Mar. 15, 1994 (Ex. 1006, “Lee”);

Tangenberg, U.S. Patent No. 500,976, filed Jan. 31, 1893, issued July 4, 1893 (Ex. 1007, “Tangenberg”);

Kim, U.S. Patent No. 5,534,762, filed Sept. 27, 1994, issued July 9, 1996 (Ex. 1008, “Kim”);

Douglas et al., U.S. Patent No. 5,230,543, filed Nov. 8, 1991, issued July 27, 1993 (Ex. 1009, “Douglas”);

Edgerley et al., U.S. Patent No. 6,497,421 B1, filed July 6, 1999, issued Dec. 24, 2002 (Ex. 1010, “Edgerley”);

Waldhauser et al., U.S. Patent No. 4,380,844, filed Sept. 12, 1980, issued Apr. 26, 1983 (Ex. 1011, “Waldhauser”);

Drunk et al., U.S. Patent No. 5,377,106, filed June 23, 1992, issued Dec. 27, 1994 (Ex. 1012, “Drunk”);

Kramer et al., U.S. Patent No. 6,174,008 B1, filed Oct. 13, 1999, issued Jan. 16, 2001 (Ex. 1013, “Kramer”); and

Bartsch et al., U.S. Patent No. 6,459,955 B1, filed Nov. 17, 2000, issued Oct. 1, 2002 (Ex. 1014, “Bartsch”).

Pet. 6–7. Petitioner also relies upon the Declaration of Dr. Shaoming Zhang (Ex. 1015).

F. Asserted Grounds of Unpatentability

Petitioner challenges the patentability of claims 1, 9, 10, 15, and 16 of the ’233 patent based on the following grounds. Pet. 7.

References	Basis	Claim(s) Challenged
Lee, Tangenberg, and Kim	§ 103	1, 10, 11, 15, and 16
Lee, Tangenberg, Kim, and Douglas	§ 103	10
Lee, Tangenberg, Kim, and Edgerley	§ 103	9
Waldhauser, Drunk, and Tangenberg	§ 103	1, 15, and 16
Bartsch, Drunk, Tangenberg, and Kim	§ 103	1, 11, 15, and 16
Bartsch, Drunk, Tangenberg, Kim, and Kramer	§ 103	10

II. DISCUSSION

A. Discretion under 35 U.S.C. § 314(a)

The filing date accorded to the Petition is April 2, 2018. Paper 4, 1. The Petition is the first filed by Petitioner challenging claims of the ’233 patent. Pet. 1; Prelim. Resp. 15.

Patent Owner contends that we should exercise our discretion to deny institution of this Petition under, *inter alia*, 35 U.S.C. § 314(a). Patent Owner argues that this Petition follows an unsuccessful petition filed in the –2050 IPR, which was filed on September 5, 2017, by Shenzhen Zhiyi Technology Co., Ltd., a different petitioner. Prelim. Resp. 14–15; Pet. 2.

Petitioner does not address § 314(a) in its Petition, but identifies the –2050 IPR as a related proceeding directed to the ’233 patent. Pet. 2.¹

1. Legal Framework

35 U.S.C. § 314(a) provides that:

The Director [of the USPTO] may not authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

Section 314(a) does not require the Director to institute an *inter partes* review. *See Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.”). Rather, a decision whether to institute is within the Director’s discretion, and that discretion has been delegated to the Board. *See* 37 C.F.R. § 42.4(a); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131,

¹ After Patent Owner filed its Preliminary Response, Petitioner sought to file a reply brief addressing *General Plastic*. *See* Paper 8. However, as we explained during a conference call, “Petitioner’s failure to foresee the applicability of § 314(a) does not demonstrate good cause [to file a reply brief]” because “Petitioner should have been aware that []§ 314(a) . . . [would] be at issue.” *Id.* at 4; *see also* 37 C.F.R. § 42.108(c) (“A petitioner may seek leave to file a reply to the preliminary response Any such request must make a showing of good cause.”).

2140 (2016) (“[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.”).

In a precedential decision in *General Plastic Industries Co., Ltd. v. Canon Kabushiki Kaisha*, the Board articulated a non-exhaustive list of factors to be considered in evaluating whether to exercise discretion, under 35 U.S.C. § 314(a), to deny a petition that challenges a patent that was previously challenged before the Board. These factors are:

1. whether the same petitioner previously filed a petition directed to the same claims of the same patent;
2. whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it;
3. whether at the time of filing of the second petition the petitioner already received the patent owner’s preliminary response to the first petition or received the Board’s decision on whether to institute review in the first petition;
4. the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition;
5. whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent;
6. the finite resources of the Board; and
7. the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.

Gen. Plastic, Case IPR2017-01357, Paper 19 (PTAB Sept. 6, 2017) (Section II.B.4.i designated as precedential on Oct. 17, 2017), slip op. at 16 (citing *NVIDIA Corp. v. Samsung Elec. Co.*, Case IPR2016-00134 (PTAB May 4, 2016) (Paper 9)). These factors are “a non-exhaustive list” and

“additional factors may arise in other cases for consideration, where appropriate.” *Id.* at 16, 18. With that in mind, we weigh an additional factor:

8. the extent to which the petitioner and any prior petitioner(s) were similarly situated defendants or otherwise realized a similar-in-time hazard regarding the challenged patent. *Shenzhen Silver Star Intelligent Technology Co., Ltd. v. iRobot Corp.*, IPR2018-00761, Paper 15, 18 (PTAB Sept. 5, 2018) (Saindon, concurring).

2. Application of the General Plastic Factors

Factor 1

The first *General Plastic* factor queries “whether the same petitioner previously filed a petition directed to the same claims of the same patent.” *Gen. Plastic*, slip op. at 16.

The instant Petition and the –2050 Petition both challenge claims of the ’233 patent. Pet. 2. Dependent claim 9 is challenged in the instant Petition, but was not challenged in the –2050 Petition. *Compare* Pet. 6–7, with –2050 IPR, Paper 1, 4. Accordingly, the petitions are directed to *some* of “the same claims of the same patent.”

Additionally, Patent Owner admits that “the instant Petitioner is different—in name—from the earlier petitioner” in the –2050 IPR. Prelim. Resp. 15. However, according to Patent Owner, Petitioner is “similarly situated to the previous petitioner” because both “were served with complaints alleging infringement of the ’233 patent at substantially the same time, and were codefendants [in ITC Inv. No. 337-TA-1057 (the “ITC Investigation”)] and likely members of a joint defense group.” *Id.*; *see also* Pet. 1–2.

Under our statute, 35 U.S.C. § 315(b), Petitioner is permitted to file a petition for *inter partes* review within one year of being served with a complaint for infringement, and Petitioner's filing of the instant Petition conforms with § 315(b). *See* Exs. 1003, 1004.

As Patent Owner notes, however, Petitioner and the entity that filed the –2050 Petition are co-respondents in the ITC Investigation. *See* Ex. 1003, 11 (identifying Petitioner and Shenzhen ZhiYi Technology Co., Ltd. as proposed respondents); Prelim. Resp. 15; Pet. 1–2 (identifying ITC and district court complaints filed by Patent Owner on April 17 and 18, 2017 against Petitioner and the –2050 petitioner). Although this commonality suggests that Petitioner may have known of its co-respondents' actions at the PTAB, i.e., the filing of the –2050 Petition, and may have had incentives to monitor those proceedings and to work with the –2050 petitioner, that does not mean that Petitioner “previously filed a petition directed to the same claims of the same patent.”

Thus, we determine that Factor 1 weighs *in favor of institution*.

Factor 2

The second *General Plastic* factor queries “whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it.” *Gen. Plastic*, slip op. at 16.

Patent Owner argues that “Petitioner was co-defendant with the first petitioner at the International Trade Commission (‘ITC’); thus, the prior art asserted in the instant Petition should have been known at the time of the first petition.” Prelim. Resp. 18.

Patent Owner’s conclusory argument does not demonstrate that Petitioner knew, or should have known, of the presently-asserted prior art when the –2050 Petition was filed, merely because Petitioner was a co-defendant with the –2050 IPR petitioner. Although Patent Owner may be correct that Petitioner may have known of some of the presently-asserted prior art at that time, e.g., the presently-asserted Tangenberg reference was submitted in the –2050 IPR, it has not been shown by evidence of record.

However, Petitioner admits that the presently-asserted references to Jones, Lee, Allen, and Bartsch were considered by the Examiner during prosecution of the application that issued as the ’233 patent, and are listed on the ’233 patent itself. Pet. 5; Ex. 1001, (56). Thus, Petitioner should have known of these references at least as of August 8, 2017, when Petitioner responded to the ITC complaint, asserting the invalidity of the ’233 patent. Ex. 2013, 37. The evidence of record does not demonstrate when Petitioner learned of the remaining six references.

Thus, we determine that Factor 2 weighs *slightly against institution*.

Factor 3

The third *General Plastic* factor queries “whether at the time of filing of the second petition the petitioner already received the patent owner’s preliminary response to the first petition or received the Board’s decision on whether to institute review in the first petition.” *Gen. Plastic*, slip op. at 16. The Board explained the relevance of this factor in *General Plastic*:

[F]actor 3 is directed to Petitioner’s potential benefit from receiving and having the opportunity to study Patent Owner’s Preliminary Response, as well as our institution decisions on the first-filed petitions, prior to its filing of follow-on petitions. . . .

Multiple, staggered petitions challenging the same patent and same claims raise the potential for abuse. The absence of any restrictions on follow-on petitions would allow petitioners the opportunity to strategically stage their prior art and arguments in multiple petitions, using our decisions as a roadmap All other factors aside, this is unfair to patent owners and is an inefficient use of the *inter partes* review process and other post-grant review processes.

Id. at 17–18 (internal citation and footnote omitted).

The instant Petition was filed on April 2, 2018. At that time, Petitioner had access to Patent Owner’s Preliminary Response in the –2050 IPR (filed December 14, 2017), and to the Board’s Decision denying institution of that petition (filed March 12, 2018). Thus, the timing of Petitioner’s filing in this case raises the potential for abuse, because Petitioner had ample opportunity to study the arguments raised by Patent Owner, and the Board’s findings and conclusions of law, regarding the commonly challenged claims of the ’233 patent. See Prelim. Resp. 16.

Thus, we determine that Factor 3 weighs *strongly against institution*.

Factors 4 and 5

The fourth *General Plastic* factor considers “the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition,” and the fifth *General Plastic* factor queries “whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent.” *Gen. Plastic*, slip op. at 16.

As discussed above regarding Factor 2, the record establishes that Petitioner should have been aware of at least four of the ten references

asserted in the instant Petition at least as of August 8, 2017, when Petitioner responded to the ITC complaint, asserting the invalidity of the '233 patent. Ex. 2013, 37. Thus, Petitioner should have known of several of the asserted references for approximately eight months before filing this Petition. Petitioner does not provide any explanation related to the timing of its Petition. To the extent a reasonable explanation exists for Petitioner's delay, it was incumbent upon Petitioner to identify those circumstances to the Board. See Prelim. Resp. 15; Paper 8.

Thus, we determine that Factor 4 weighs *strongly against institution*, and Factor 5 weighs *moderately against institution*.

Factor 6

The sixth *General Plastic* factor considers “the finite resources of the Board.” *Gen. Plastic*, slip op. at 16.

Patent Owner argues that the Petition presents “a relatively large number of grounds,” which would strain Board resources. Prelim. Resp. 18–19. Patent Owner also argues that the Petition presents arguments that are substantially the same as those already considered and found unpersuasive by the Patent Office, both during examination and during the –2050 IPR. *Id.* at 2–14 (considered by the Office); *see also id.* at 20–21 (discussing proceedings before the ITC).

In this circumstance, we agree with Patent Owner that it would not be an efficient use of the Board's finite resources to consider the grounds presented in the instant Petition. In the –2050 IPR, the Board considered an asserted ground of unpatentability under 35 U.S.C § 103, based upon the combined teachings of Bisset and Tangenberg. –2050 IPR, Paper 8, 6. The

Board exercised its discretion to deny institution under 35 U.S.C. § 325(d) because, during prosecution, the Examiner had considered extensively the Bisset reference, and because “the applied prior art to Tangenberg, and the arguments presented regarding its application to the claimed subject matter, are substantially the same as that regarding Lee and Yonkers, previously presented to the Office” and considered by the Examiner. *Id.* at 8–11.

Namely, the petitioner in the –2050 IPR relied upon Tangenberg as teaching the “powered side brush” limitations in substantially the same manner as the Examiner had relied upon references to Lee and Yonkers. *Id.* at 9–11 (explaining that the Examiner ultimately concluded that Lee and Yonkers did not render obvious the “powered side brush” limitations, as amended).

In this Petition, Petitioner also relies upon Tangenberg in much the same way as the petitioner in the –2050 IPR had, and in much the same way the Examiner had considered Lee and Yonkers. For each asserted ground, Petitioner relies upon Tangenberg as teaching the “powered side brush” limitations. *See, e.g.*, Pet. 21–24, 48–52, 67–71. As in the –2050 IPR, Petitioner here does not explain why we should revisit the Examiner’s determination to allow the claims over prior art to Lee and Yonkers, which the Board has already determined to be substantially the same as Tangenberg. *See* –2050 IPR, Paper 8, 11. In other words, we see little effective difference between the present grounds based upon Tangenberg (with or without Lee), the Bisset-Tangenberg ground from the –2050 IPR, and the Bisset-Lee or Bisset-Lee-Yonkers rejections from prior prosecution. Each of these proposed prior art combinations asked the Office to consider whether it would have been obvious to modify a robotic vacuum having cliff detection sensors to include side brushes having gaps between bundles of

bristles, wherein the gaps are specifically configured to avoid occluding those sensors.² In those combinations, the reference teaching a side brush (whether Lee, Yonkers, or Tangenberg) simply teaches a side brush (the side brushes disclosed by Yonkers and Tangenberg also including bundles of bristles separated by a gap)—occlusion of sensors was not a concern.³ Thus, the Examiner in the original prosecution already considered whether it would have been obvious to add side brushes that do not occlude a sensor (e.g., those of Lee and Yonkers) to a position that would serve to occlude the sensors, but for the presence of the gap between the bristles, and allowed the claims after consideration of that issue. We have determined already in the –2050 IPR that we would not revisit that specific determination on

² See, e.g., Ex. 1002, 458–459 (noting that Applicant argued non-obviousness over Bisset-Lee-Yonkers by arguing that “there is no discernible reason, from these references or general knowledge, to configure the resulting robot to have the side [brush] positioned such that the bundles of bristles pass between the cliff detector and the floor during a rotation of the side brush. Rather, the side brush would be placed at a position where no sensor is occluded, as neither Lee nor Bisset teaches occluding a sensor. A [POSITA] would therefore have no motivation to configure the side brush bristles in bundles separated by a gap to prevent occlusion of the cliff detector beam during at least a portion of a rotation of the side brush, as recited by the claims”), *id.* at 445 (noting that the Examiner found similar arguments persuasive in an interview); *id.* at 47 (noting the Examiner subsequently allowed the claims); –2050 IPR, Paper 8, 10 (our prior decision characterizing that petition as using Tangenberg in the Bisset-Tangenberg combination in effectively the same manner the Examiner considered Lee and Yonkers in the Bisset-Lee-Yonkers combination).

³ See Ex. 1006, Figs. 9 & 10 (noting that the Lee device has brushes 13 below distance-measuring sensors 23); Ex. 1007, Figs. 1 & 2 (noting that Tangenberg is mechanically powered by wheel O and has no sensors); U.S. Patent No. 3,978,539 (issued to Yonkers on Sept. 7, 1976, also disclosing a mechanically powered sweeper that has no sensors).

effectively the same prior art and arguments, and Petitioner here merely asks us to revisit it again without providing adequate reasoning why.

Accordingly, we determine that it would not be an efficient use of Board resources to consider the challenges presented in the Petition, in light of previous and substantially similar proceedings before the Patent Office. We determine that this factor weighs *strongly against institution*.

Factor 7

The seventh *General Plastic* factor considers “the requirement . . . to issue a final determination not later than 1 year after the date on which the Director notices institution of review.” *Gen. Plastic*, slip op. at 16.

Patent Owner argues that the Petition is “larger than [a] typical filing” and would “strain Board resources to timely address each of the myriad issues in the Petition.” Prelim. Resp. 18–19.

We know of no reason why we could not meet the requirement of 35 U.S.C. § 316(a)(11) to issue a final determination within one year after institution. Accordingly, we determine that this factor is *neutral* to the analysis.

Proposed Factor 8

We adopt the eighth factor considered in a prior *Shenzhen Silver Star* case, “the extent to which the petitioner and any prior petitioner(s) were similarly situated defendants or otherwise realized a similar-in-time hazard regarding the challenged patent.” *Shenzhen Silver Star*, IPR2018-00761, Paper 15, 18 (Saindon, concurring); *see also id.* at 16–19 (explaining the reasons for proposed adoption of the factor). The purpose of proposed

Factor 8 is to discourage tactical filing of petitions over time by parties that faced the same threat at the same time.⁴ Factor 8 favors Patent Owner because Petitioner and the –2050 petitioner were co-respondents in the ITC litigation. See Ex. 1003, 11. Accordingly, Petitioner and the –2050 petitioner both faced a similar-in-time hazard regarding the ’233 patent, yet Petitioner waited until after our Decision on Institution in the –2050 IPR to file this Petition. Absent mitigating explanation, of which we have none, this suggests an attempt to secure tactical advantage by waiting for the petitioner in the –2050 IPR to file a “test case.” Factor 8 weighs against tactical filing of petitions. Thus, proposed Factor 8 favors Patent Owner.

Summary

As detailed herein, we have considered the factors enumerated in *General Plastic*, in determining whether to exercise our discretion under 35 U.S.C. § 314(a). In summary, we determine that:

- i. three factors weigh strongly *against* institution (Factors 3, 4, 6);
- ii. one factor weighs moderately *against* institution (Factor 5);
- iii. one factor weighs slightly *against* institution (Factor 2);

⁴ As acknowledged and explained in more detail in IPR2018-00761, proposed Factor 8 does not preclude non-tactical filing situations where a later-filing petitioner files later due to circumstances outside that petitioner’s control, for example having been charged with infringement later in time, a change in the nature of the infringement charge (e.g., claims identified for the first time), availability of key personnel required for preparation of the petition, or unusually early filing of the earlier-filing petition. *Shenzhen Silver Star*, IPR2018-00761, Paper 15, 18–19 (Saindon, concurring) (“There are legitimate reasons why a petition may be filed after [a preliminary response or a decision on institution].”).

- iv. one proposed factor weighs *against* institution (Proposed Factor 8);
- v. one factor is *neutral* (Factor 7); and
- vi. one factor weighs *in favor* of institution (Factor 1).

Considering these factors as a whole, and on this record, we determine that it is appropriate to exercise our discretion under 35 U.S.C. § 314(a) to deny institution of an *inter partes* review of the challenged claims of the '233 patent.

III. CONCLUSION

For the foregoing reasons, we exercise our discretion to deny institution of an *inter partes* review, pursuant to 35 U.S.C. § 314.

IV. ORDER

Upon consideration of the record before us, it is:

ORDERED that the Petition is *denied* as to all challenged claims, and no trial is instituted.

IPR2018-00882
Patent 9,038,233 B2

PETITIONER:

Shen Wang
shenwang@archlakelaw.com

Hao Tan
haotan@archlakelaw.com

PATENT OWNER:

Walter Renner
axf-ptab@fr.com

Robert Devoto
devoto@fr.com

Hyun Jin In
in@fr.com

Tonya Drake
tdrake@irobot.com