

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GLOBAL SHADE CORPORATION,  
Petitioner,

v.

WITH-U E-COMMERCE (SHANGHAI) CO., LTD.,  
Patent Owner.

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IPR2023-00580  
Patent 10,669,738 B2

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Before PATRICK R. SCANLON, BARRY L. GROSSMAN, and  
GEORGE R. HOSKINS, *Administrative Patent Judges*.

SCANLON, *Administrative Patent Judge*.

DECISION  
Granting Institution of *Inter Partes* Review  
*35 U.S.C. § 314*

## I. INTRODUCTION

Global Shade Corporation (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting an *inter partes* review of claims 1, 2, 4, 13, and 14 of U.S. Patent No. 10,669,738 B2 (Ex. 1001, “the ’738 patent”). With-U E-Commerce (Shanghai) Co., Ltd. (“Patent Owner”) filed a Preliminary Response (Paper 6, “Prelim. Resp.”).

We have authority to determine whether to institute an *inter partes* review. *See* 35 U.S.C. § 314 (2018); 37 C.F.R. § 42.4(a) (2021). To institute an *inter partes* review, we must determine that the information presented in the Petition shows “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(a). For the reasons explained below, we institute an *inter partes* review of claims 1, 2, 4, 13, and 14 based on the grounds set forth in the Petition.

## II. BACKGROUND

### A. *Real Parties in Interest*

Petitioner identifies itself as the real party in interest. Pet. 103. Patent Owner identifies itself as the real party in interest. Paper 4 (“Patent Owner’s Mandatory Notices”), 2.

### B. *Related Matters*

The parties identify the following proceeding as a related matter involving the ’738 patent: *With-UE-Commerce (Shanghai) Co., Ltd. v. Global Shade Corp.*, Case No. 8:22-cv-01295-JVS-JDE (C.D. Cal.). Pet. 103; Paper 4, 2.

Patent Owner also identifies the following items as related matters:

IPR2021-00365 (challenging U.S. Patent No. 10,273,710; final written decision issued July 25, 2022);

U.S. Pat. App. Ser. No. 16/012,076 (filed June 19, 2018) (now U.S. Pat. No. 10,597,897);

U.S. Pat. App. Ser. No. 16/188,273 (filed November 12, 2018) (now U.S. Pat. No. 11,299,906);

U.S. Des. Pat. App. Ser. No. 29/725,316 (filed February 24, 2020) (now U.S. Pat. No. D926,910);

U.S. Des. Pat. App. Ser. No. 29/725,318 (filed February 24, 2020) (now U.S. Pat. No. D925,687); and

U.S. Pat. App. Ser. No. 17/716,126 (filed April 8, 2022).  
Paper 4, 2.

### *C. The '738 Patent*

The '738 patent, titled “Collapsible Canopy Frame Having a Central Lock,” issued on June 2, 2020, with claims 1–14, and claims continuation-in-part priority to a U.S. national stage entry from PCT Application CN 2016/091675, filed on July 26, 2016 and now U.S. Patent No. 10,273,710. Ex. 1001, codes (45), (54), (63), 1:6–10, 10:7–12:47.

The '738 patent describes a collapsible canopy frame with at least three supporting legs and a central lock that locks the frame in an unfolded state and permits the frame to be folded when unlocked. *Id.* at 1:51–57. The canopy frame includes outer retractable units connected between adjacent supporting legs and inner retractable units connected between the supporting legs and the central lock. *Id.* at 1:57–60.

Figure 16 of the '738 patent is reproduced below.

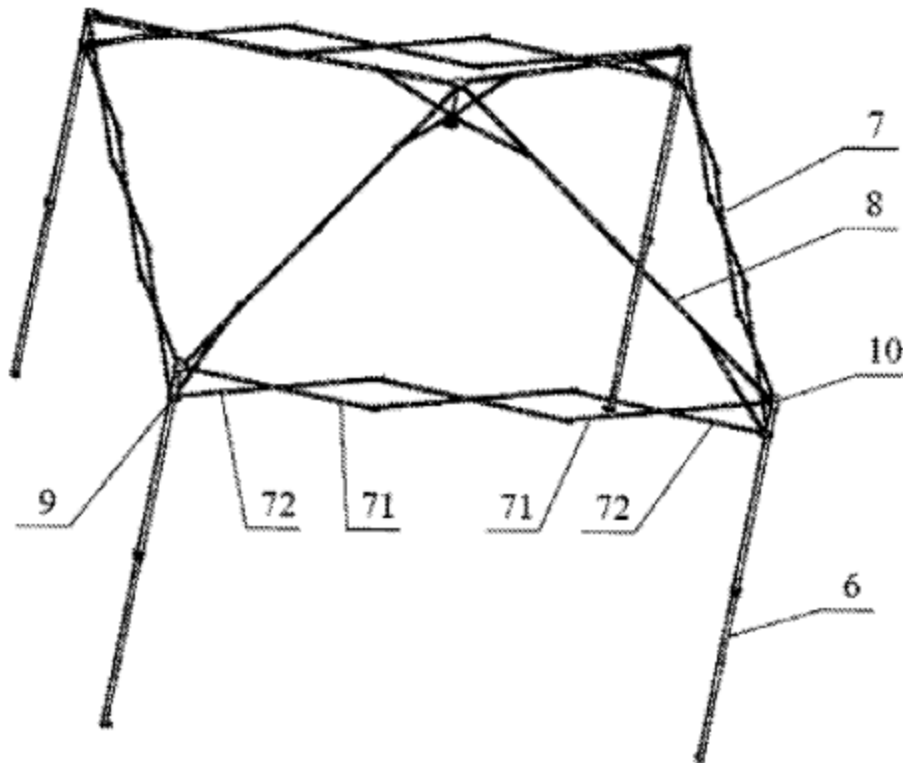


FIG 16

Figure 16 of the '738 patent depicts an example of a canopy in an unfolded state. *Id.* at 2:20–21. As shown in Figure 16, a canopy mounted with a central lock comprises four supporting legs 6, outer retractable units 7 connected between every two adjacent supporting legs 6, and inner retractable units 8 connected to each supporting leg 6. *Id.* at 3:67–4:4. Outer retractable units 7 and inner retractable units 8 form a roof frame of the canopy, and the roof frame and supporting legs 6 form a canopy frame. *Id.* at 4:4–8.

In addition, inner ends of inner retractable units 8 are connected through a central lock. *Id.* at 4:8–9. Figure 2 of the '738 patent is reproduced below.

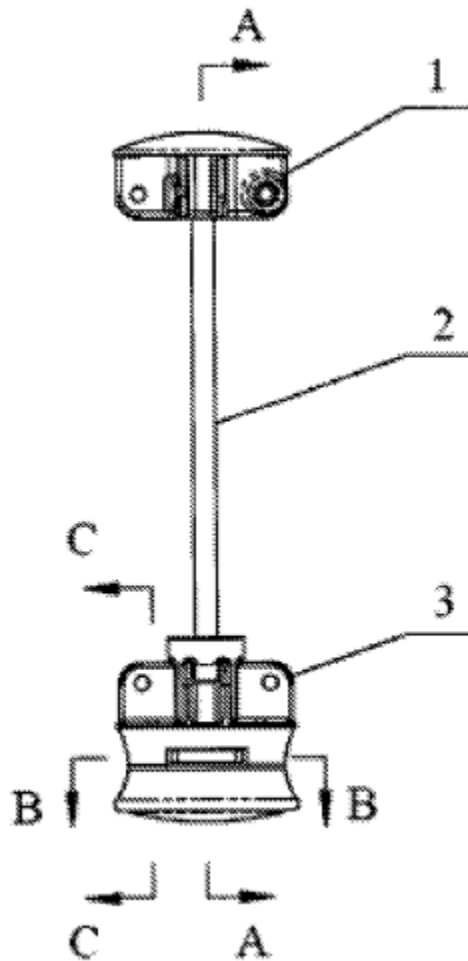


FIG. 2

Figure 2 of the '738 patent depicts an example of a canopy's central lock in a locked state. *Id.* at 2:1–2. As shown in Figure 2, the central lock includes center pole 2, whose top end is fixedly connected to center top cap 1, and whose bottom end is detachably connected to center bottom cap 3. *Id.* at 3:33–36. Figure 6 of the '738 patent is reproduced below.

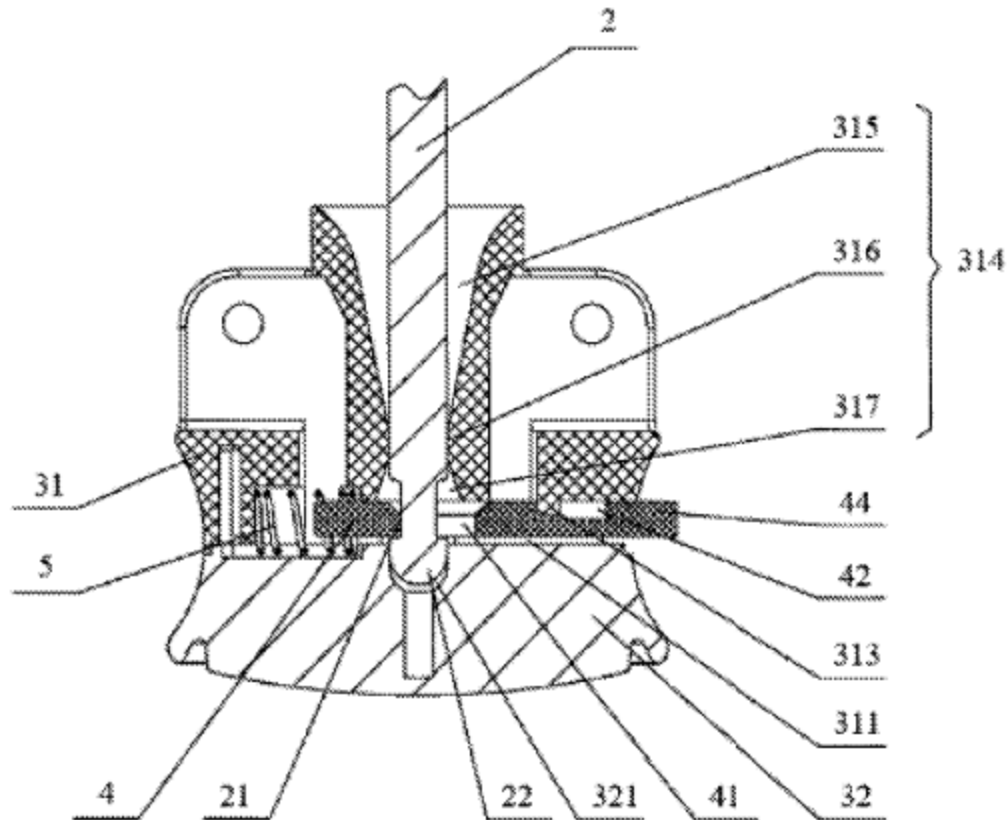


FIG. 6

Figure 6 of the '738 patent depicts the bottom portion of the central lock shown in Figure 2 in greater detail. *Id.* at 2:6–7. As shown in Figure 6, center bottom cap 3 receives locking piece 4, which can move back and forth radially with respect to center pole 2. *Id.* at 3:40–43. Locking piece 4 includes first through hole 41, through which center pole 2 may pass. *Id.* at 3:43–44. The end part of center pole 2 includes clamping groove 21 and clamp locking part 22 at the lower end of clamping groove 21. *Id.* at 3:45–47. When the central lock is in a locked state, part of an inner wall of first through hole 41 of locking piece 4 is clamped with clamping groove 21 of center pole 2, and an upper end surface of clamp locking part 22 abuts a lower end surface of locking piece 4, such that clamp locking part 22 cannot thread first through hole 41 and center pole 2 and center bottom cap 3 are in

a mutually connected state. *Id.* at 3:47–55. Spring 5 abuts locking piece 4 to force it into groove 21. *Id.* at 6:49–7:10. When the central lock is in an unlocked state, locking piece 4 moves radially with respect to center pole 2 such that the inner wall of first through hole 41 of locking piece 4 is separated from clamping groove 21, clamp locking part 22 can thread first through hole 41, and center pole 2 can be separated from center bottom cap 3. *Id.* at 3:55–63, Fig. 11.

Figure 19 of the '738 patent is reproduced below.

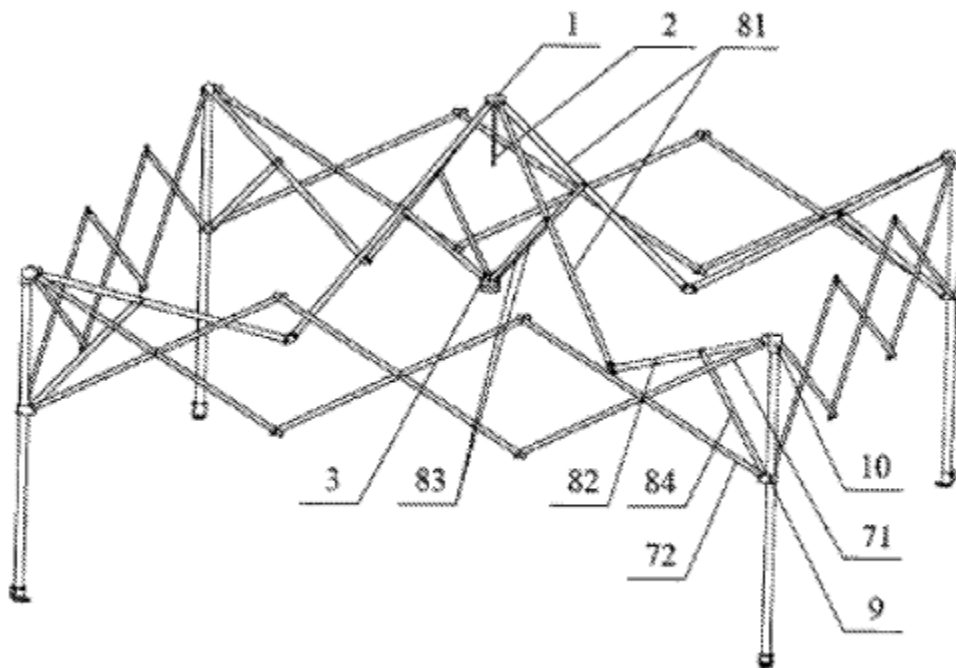


FIG. 19

Figure 19 of the '738 patent depicts an example of a canopy being folded or unfolded. *Id.* at 2:27–28. When the canopy is unfolding from a folded state, four supporting legs 6 are centered about the central lock and unfolded outwards, with outer retractable units 7 and inner retractable units 8 gradually stretching outwards. *Id.* at 4:20–24. After the canopy is unfolded, center bottom cap 3 is pushed upwards towards center pole 2, such that center pole 2 is inserted into center bottom cap 3 and clamping groove 21 is

clamped with part of the inner wall of first through hole 41. *Id.* at 4:24–30. After center bottom cap 3 has been connected with center pole 2, the unfolded state of the canopy is fixed and the entire canopy is locked. *Id.* at 4:37–39. The canopy may be folded by separating locking piece 4 from clamping groove 21 and pulling center bottom cap 3 downwards from center pole 2 to enable inner retractable units 8 to be folded towards the central lock and inner retractable units 7 to be folded inward. *Id.* at 4:49–5:5.

#### *D. Challenged Claims*

Petitioner challenges claims 1, 2, 4, 13, and 14, of which claim 1 is independent. Claim 1 is reproduced below.

1. A collapsible canopy frame, comprising:
  - A. at least three supporting legs,
  - B. a plurality of outer retractable units, each outer retractable unit connected between two adjacent supporting legs, each said outer retractable unit comprises a plurality of hinged X-shaped rod members, each X-shaped rod member comprises a first eave pipe and second eave pipe hinged to one another,
  - C. a plurality of inner retractable units comprising inner ends, each inner retractable unit connected to a supporting leg, wherein said outer retractable units and said inner retractable units form a roof of said collapsible canopy frame, and
  - D. a central lock, comprising:
    1. a center top cap,
    2. a center bottom cap,
    3. a center pole positioned between said center top cap and said center bottom cap, wherein said central lock is locked when said center pole is connected to both said center top cap and said center bottom cap, and wherein said center lock is unlocked when there is a disconnection between said center bottom cap and said center pole, wherein said central lock locks said

collapsible canopy frame in an unfolded state when said central lock is locked and permits said collapsible canopy frame to be folded into a folded state when said central lock is unlocked, wherein said inner ends of said inner retractable units are connected through said central lock.

Ex. 1001, 10:7–35.

*E. Asserted Grounds of Unpatentability*

Petitioner contends that the challenged claims are unpatentable based on the following grounds:

| Claim(s) Challenged | 35 U.S.C. § | References/Basis                          |
|---------------------|-------------|-------------------------------------------|
| 1, 2, 4, 14         | 103         | Rousselle, <sup>1</sup> Tsai <sup>2</sup> |
| 4, 13, 14           | 103         | Rousselle, Tsai, Ohnishi <sup>3</sup>     |

Pet. 8. Petitioner relies on the Declaration of Jeffrey L. Stein, Ph.D. (Ex. 1002) to support its challenges.

III. ANALYSIS

*A. Level of Ordinary Skill in the Art*

In determining whether an invention would have been obvious at the time it was made, 35 U.S.C. § 103 requires us to resolve the level of ordinary skill in the pertinent art at the time of the invention. *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). The person of ordinary skill in the art is a hypothetical person who is presumed to have known the relevant art at the time of the invention. *In re GPAC, Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995). Factors that may be considered in determining the level of ordinary skill in the art include, but are not limited to, the types of problems encountered in the art, the sophistication of the technology, and educational

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<sup>1</sup> US 6,345,639 B2, issued Feb. 12, 2002 (Ex. 1003).

<sup>2</sup> UK 2 321 913 A, published Aug. 12, 1998 (Ex. 1005).

<sup>3</sup> US 8,066,300 B2, issued Nov. 29, 2011 (Ex. 1006).

level of active workers in the field. *Id.* In a given case, one or more factors may predominate. *Id.*

Relying on the testimony of Dr. Stein, Petitioner alleges a person having ordinary skill in the art “would have had at least a bachelor’s degree in the mechanical arts, or a related discipline, and at least two years of experience in the design and/or analysis of mechanical devices, fabricated frames, and/or kinematic linkages,” and asserts that “[a]dditional work experience could serve as a substitute for a formal degree and vice versa.” Pet. 7 (citing Ex. 1002 ¶¶ 25–28).

Patent Owner contends that a person having ordinary skill in the art “would have had a Bachelor’s degree in mechanical engineering and two years of relevant experience.” Prelim. Resp. 3. Patent Owner adds that “[a] recipient of other academic degrees may qualify as a person of ordinary skill if they have taken coursework or have experience in a pertinent technology,” and “[a]dditional education could offset less work experience; additional work experience could offset less education or coursework.” *Id.*

Although not identical, the parties’ definitions are substantially similar. Accordingly, for purposes of this Decision, we determine that no express finding is necessary, and that the level of ordinary skill in the art is reflected by the prior art of record. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001). We note, however, that our obviousness analysis in this Decision would not differ if we adopted either Petitioner’s or Patent Owner’s definition.

### *B. Claim Construction*

In *inter partes* reviews, the Board interprets claim language using the district-court-type standard, as described in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc). *See* 37 C.F.R. § 42.100(b). Under that

standard, we generally give claim terms their ordinary and customary meaning, as would be understood by a person of ordinary skill in the art at the time of the invention, in light of the language of the claims, the specification, and the prosecution history. *See Phillips*, 415 F.3d at 1313–14. Although extrinsic evidence, when available, may also be useful when construing claim terms under this standard, extrinsic evidence should be considered in the context of the intrinsic evidence. *See id.* at 1317–19.

Petitioner asserts construction is unnecessary and does not propose any term for construction. Pet. 7 (citing *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co. Ltd.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017)). Patent Owner does not discuss claim construction or propose any term for construction in its Preliminary Response.

On the present record, we do not discern a need to construe explicitly any claim language because doing so would have no effect on our analyses below of Petitioner’s asserted grounds and will not assist in resolving the present controversy between the parties. *See Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019) (“The Board is required to construe ‘only those terms that . . . are in controversy, and only to the extent necessary to resolve the controversy.’”)(quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)).

### *C. Discretion Under 35 U.S.C. § 325(d)*

#### *1. Applicable Framework*

Section 325(d) of Title 35 of the United States Code provides, in relevant part: “In determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to

the Office.” The Board uses a two-part framework for evaluating arguments under § 325(d):

- (1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and
- (2) if either condition of first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.

*Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential) (“*Advanced Bionics*”).

In applying the two-part framework, we consider several non-exclusive factors from *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (PTAB Dec. 15, 2017) (precedential as to § III.C.5, first paragraph) (“*Becton, Dickinson*”), which provide “useful insight into how to apply the framework.” *Advanced Bionics*, Paper 6 at 9. The *Becton, Dickinson* factors are:

- (a) the similarities and material differences between the asserted art and the prior art involved during examination;
- (b) the cumulative nature of the asserted art and the prior art evaluated during examination;
- (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection;
- (d) the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art;
- (e) whether Petitioner has pointed out sufficiently how the examiner erred in its evaluation of the asserted prior art; and

(f) the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments.

*Becton, Dickinson*, Paper 8 at 17–18. If, after review of factors (a), (b), and (d), we determine that the same or substantially the same art or arguments previously were presented to the Office, we then review factors (c), (e), and (f), which relate to whether the petitioner demonstrates that the Office erred in a manner material to the patentability of the challenged claims. *Advanced Bionics*, Paper 6 at 10.

## 2. Analysis

### a) Part One of the Advanced Bionics framework

Petitioner argues that we should not exercise our discretion to deny institution under § 325(d) because the Petition presents new art and arguments. Pet. 102. In particular, Petitioner argues that Tsai was not before the Examiner and clearly discloses the limitations regarding the X-shaped outer retractable units that the applicant argued were not taught by the references applied by the Examiner. *Id.*

Patent Owner argues that we should exercise our discretion and deny institution under § 325(d). Prelim. Resp. 30–39. First, Patent Owner argues that, during examination of the application that issued as the '738 patent, Rousselle was listed on a Notice of References Cited included with a non-final office action dated September 26, 2019. *Id.* at 33–34 (citing Ex. 2001, 10). Patent Owner also argues that Rousselle is listed in the References Cited section of the '738 patent. *Id.* at 34 (citing Ex. 1001, code (56)). Thus, Patent Owner contends that Rousselle was presented previously to the Office. *Id.*

Next, Patent Owner argues that Tsai is cumulative of U.S. Pat. Pub. No. 2015/0308147 to Lee (Exhibit 2003) and U.S. Pat. No. 6,929,017 to Byun (Exhibit 2004), two references applied by the Examiner in an Office Action dated September 28, 2018. *Id.* at 35 (citing Ex. 2002). Patent Owner asserts that in the Office Action, the Examiner found that Lee taught “[o]uter retractable members comprised of X-members,” and that Byun taught “X shaped retractable units.” *Id.* at 35–36 (citing Ex. 2002, 6–7; Ex. 2003, Fig. 1; Ex. 2004, Fig. 1A). Patent Owner adds that Petitioner now cites Tsai’s Figures 1 and 10 as showing the same features. *Id.* at 36 (citing Pet. 17). Thus, in Patent Owner’s view, “the Office previously was presented with multiple references cited for exactly the limitation for which [the] Petition now offers Tsai,” and as such, “the Tsai reference is merely cumulative of the references already considered by the Examiner.” *Id.* at 37. Based on these assertions, Patent Owner contends that discretionary denial is appropriate under *Becton, Dickinson* factor (b). *Id.*

We agree with Patent Owner that Rousselle was presented previously to the Office. Turning to Tsai, we agree that there are similarities between Tsai’s outer retractable units (i.e., scissors-type linkages 2) and the X-shaped retractable units taught by Lee and Byun. *Compare* Ex. 1005, Figs. 1, 10, *with* Ex. 2003, Fig. 1, *and* Ex. 2004, Fig. 1A. There are also material differences, however, under *Becton, Dickinson* factor (a). Namely, the Examiner determined that both Lee and Byun disclosed the claimed central lock. Ex. 2002, 6–7. Tsai, however, discloses that its canopy supporting rods 3 are pivotally secured to head 7 and does not disclose a central lock. Ex. 1005, 7:15–17, Fig. 1. Petitioner thus relies on Rousselle, not Tsai, for teaching the claimed central lock. Pet. 33–48.

In view of these material differences, we are not persuaded that Tsai is cumulative of Lee or Byun.

Regarding *Becton, Dickinson* factor (d), which is “the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art,” we again note that Petitioner relies on Rousselle for teaching the claimed central lock in the combination of Rousselle and Tsai. Pet. 33–48. We are not directed to any evidence that the Examiner considered combining the teachings of Lee or Byun with Rousselle in the same manner that Petitioner proposes combining Rousselle and Tsai. Indeed, it is unlikely that the Examiner would have considered combining Lee or Byun with Rousselle given the finding that Lee and Byun disclosed the claimed central lock. Accordingly, we determine that there is little or no overlap between the manner in which Petitioner relies on the prior art and the positions taken by the Examiner during examination.

For the above reasons, we determine that Tsai is not the same or substantially the same as Lee or Byun under *Becton, Dickinson* factors (a), (b), and (d), and, therefore, Petitioner’s art and arguments are not the same or substantially the same as the art and arguments previously presented to the Office.

*b) Part Two of the Advanced Bionics framework*

Although we determine, under *Advanced Bionics* part 1, that the Examiner did not consider the same or substantially the same prior art and arguments as Petitioner presents, we nevertheless address whether the Examiner erred under *Advanced Bionics* part 2 for completeness.

Patent Owner argues that Petitioner has not demonstrated error by the Office because Petitioner’s only assertion of error is a conclusory argument

that is factually incorrect. Prelim. Resp. 38–39 (citing Pet. 102). Petitioner argues:

To the extent [Patent Owner] argues Tsai is cumulative of another reference before the Examiner, then the Examiner erred in not applying that reference against the claims. As discussed above, Tsai (and therefore any reference cumulative of Tsai) discloses the x-shaped outer retractable unit limitation, and a [person of ordinary skill in the art] would have been motivated to combine it with other references such as Rousselle to arrive at the claimed subject matter.

Pet. 102 n.7. Patent Owner contends that the Examiner did apply the references that Tsai is cumulative of (Lee and Byun) by using those references to reject the claims in the Office Action dated September 28, 2018. Prelim. Resp. 39 (citing Ex. 2002).

In the cited Office Action, however, the Examiner rejected the claims as being anticipated by both Lee and Byun. Ex. 2002, 6–7. The Examiner did not combine Lee’s or Byun’s teachings of outer retractable units with Rousselle’s teaching of a central lock in the same manner that Petitioner proposes combining Rousselle and Tsai. *Id.* We understand Petitioner’s argument to be that the Examiner erred by not combining any purportedly cumulative reference with Rousselle in the manner that the Petition proposes combining Rousselle and Tsai. *See* Pet. 102 n.7. Thus, to the extent that either of Lee or Byun is cumulative of Tsai, we agree that the Examiner erred by not combining either one of these references with Rousselle.

*c) Conclusion*

For the above reasons, we find that neither part of the *Advanced Bionics* framework is satisfied, and we do not exercise our discretion under § 325(d) to deny institution in this proceeding.

*D. Discretion Under 35 U.S.C. § 314(a)*

Institution of an *inter partes* review is discretionary. *See* 35 U.S.C. § 314(a) (authorizing institution of an *inter partes* review under particular circumstances, but not requiring institution under any circumstances); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016) (“[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.”); *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1356 (2018) (“[Section] 314(a) invests the Director with discretion on the question whether to institute review . . . .” (emphasis omitted)); *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.”).

We consider an advanced state of a parallel district court proceeding as a “factor that weighs in favor of denying the Petition under § 314(a).” *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 at 20 (PTAB Sept. 12, 2018) (precedential). Specifically, we consider an early trial date as part of a “balanced assessment of all relevant circumstances in the case, including the merits.” Consolidated Trial Practice Guide November 2019 (“TPG”)<sup>4</sup> at 58. As part of this balanced assessment, we consider the following factors:

1. whether the court granted a stay or evidence exists that one may be granted if this proceeding is instituted;
2. proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;

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<sup>4</sup> Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board's exercise of discretion, including the merits.

*Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5–6 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”). We address each factor below.

*1. Factor 1: whether the court granted a stay or evidence exists that one may be granted if this proceeding is instituted*

Petitioner argues that it will move for a stay in the co-pending litigation, and the district court “grants motions to stay pending IPR where, as here, ‘there is more work ahead of the parties and the Court than behind’; the stay ‘will simplify the issues in question and the trial of the case’; and there is no undue prejudice.” Pet. 98–99 (quoting *Polaris PowerLED Techs., LLC v. LG Elecs., Inc.*, No. SACV-20-00125-JVS(DFMx), 2020 WL 6064964, at \*2–\*3 (C.D. Cal. Aug. 26, 2020)). Thus, Petitioner argues that the likelihood of a stay is high and this factor weighs against discretionary denial. *Id.* at 99.

In its Preliminary Response, Patent Owner indicates that the stay was subsequently granted.<sup>5</sup> Prelim. Resp. 40. The stay was granted in response to “the Parties’ Joint Stipulation to Withdraw Plaintiff’s Opposition to Defendant Global Shade Corporation’s Motion to Stay and to Stay the Action Pending *Inter Partes* Review.” Ex. 3001, 2. The co-pending litigation is stayed pending final resolution of this proceeding, including any appeals therefrom. *Id.*

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<sup>5</sup> A copy of the stay has been added to the record as Exhibit 3001.

In view of the stay granted in the co-pending litigation, this factor weighs strongly against exercising our discretion to deny institution.

2. *Factor 2: proximity of the court's trial date to the Board's projected statutory deadline for a final written decision*

Petitioner indicates that the district court has set a trial date of April 30, 2024, which is approximately four months before a final written decision would issue in this proceeding. Pet. 99. Patent Owner does not address this factor directly. *See* Prelim. Resp. 40–41.

The stay granted by the district court, however, stays the co-pending litigation pending final resolution of this proceeding, including any appeals therefrom. Ex. 3001, 2. As such, it is very unlikely that a trial would begin before a final written decision would issue in this proceeding.

Based on the record before us, this factor weighs strongly against exercising our discretion to deny institution.

3. *Factor 3: investment in the parallel proceeding by the court and the parties*

If, at the time of the institution decision, the district court has issued substantive orders related to the challenged patent, such as a claim construction order, this fact weighs in favor of denial. *See Fintiv*, Paper 11 at 9–10. On the other hand, if the district court has not issued such orders, this fact weighs against discretionary denial. *Id.* at 10.

Petitioner argues that Patent Owner

filed its complaint in the co-pending litigation on July 12, 2022, and served its infringement contentions on January 9, 2023. Aside from those contentions, the parties have invested very little in the co-pending litigation. Fact discovery remains in its infancy; [Patent Owner] only recently served its first set of formal discovery requests on February 7, 2023[,] no depositions have been taken, and few documents have been exchanged. The

parties have not briefed claim construction. No expert reports have been served.

Pet. 100. Patent Owner does not address this factor directly. *See* Prelim. Resp. 40–41.

Based on the record before us, this factor weighs against exercising our discretion to deny institution.

*4. Factor 4: overlap between issues raised in the petition and in the parallel proceeding*

Petitioner argues that “[i]f this IPR is instituted and the co-pending litigation is stayed, Petitioner could not pursue in the co-pending litigation any invalidity ground raised or that could have been reasonably raised in this IPR.” Pet. 100 (citing *California Inst. of Tech. v. Broadcom Ltd.*, 25 F.4th 976 (Fed. Cir. 2022)). Patent Owner does not address this factor directly. *See* Prelim. Resp. 40–41.

As noted above, the stay granted by the district court stays the co-pending litigation pending final resolution of this proceeding, including any appeals therefrom. Ex. 3001, 2. Accordingly, statutory estoppel under 35 U.S.C. § 315(e)(2) would prevent Petitioner from asserting in the co-pending litigation that any one of challenged claims 1, 2, 4, 13, and 14 is invalid on any ground that Petitioner raised or reasonably could have raised in this proceeding. Furthermore, we are not directed to any evidence showing overlap. *See* Prelim. Resp. 40–41. As such, we find this factor weighs strongly against exercising our discretion to deny institution.

*5. Factor 5: whether the petitioner and the defendant in the parallel proceeding are the same party*

Petitioner concedes that the parties for this proceeding and the district court proceeding are the same, but argues that this factor is neutral because it is unlikely that the co-pending litigation will go to trial before a final written

decision is entered in this proceeding in view of the stay. Pet. 101 (citing *Google LLC v. Jawbone Innovations, LLC*, IPR2019-01393, Paper 24 at 11–12 (PTAB June 16, 2020)). Patent Owner does not address this factor directly. *See* Prelim. Resp. 40–41.

Based on the record before us, we agree with Petitioner that this factor is neutral.

6. *Factor 6: other circumstances that impact the Board’s exercise of discretion, including the merits*

The factors considered in the exercise of discretion are part of a balanced assessment of all the relevant circumstances in the case, including the merits. *Fintiv*, Paper 11 at 14. For example, if the merits of a ground raised in the petition seem particularly strong on the preliminary record, this fact has favored institution. *Id.* at 14–15. By contrast, if the merits of the grounds raised in the petition are a closer call, then that fact has favored denying institution when other factors favoring denial are present. *Id.* at 15.

Here, Patent Owner argues that the asserted grounds are not strong and should be denied on the merits. Prelim. Resp. 40. Petitioner, on the other hand, argues that the merits of its arguments are strong. Pet. 101.

For the reasons discussed below regarding Petitioner’s obviousness challenges, we determine that Petitioner’s challenges based on § 103 are at least reasonably strong. For example, the current record shows that the combination of Rousselle and Tsai discloses each limitation of challenged claim 1. *See infra* § III.E. Furthermore, for the reasons discussed above, we disagree with Patent Owner’s assertion (Prelim. Resp. 40) that there is a strong case for discretionary denial under § 325(d). Accordingly, this factor weighs against exercising discretion to deny institution.

## 7. Conclusion

We have considered the circumstances and facts before us in view of the *Fintiv* factors. Because our analysis is fact-driven, no single factor is determinative of whether we exercise our discretion to deny institution under § 314(a). We take “a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review” when evaluating these factors. *Fintiv*, Paper 11 at 6. Evaluating all of the factors on this record, we determine that the circumstances presented here do not support exercising our discretion under § 314(a) to deny institution of *inter partes* review.

### *E. Asserted Obviousness Based on Rousselle and Tsai*

Petitioner asserts that claims 1, 2, 4, and 14 are unpatentable under 35 U.S.C. § 103 based on Rousselle and Tsai. Pet. 9–73. Patent Owner provides arguments addressing this asserted ground of unpatentability. Prelim. Resp. 3–22.

#### *1. Rousselle*

Rousselle, titled “Collapsible Shelter/Tent with Frame Locking Mechanism,” “relates to collapsible shelters and tents having sheet material walls supported by a collapsible frame.” Ex. 1003, code (54), 1:14–18.

Figure 1(A) of Rousselle is reproduced below.

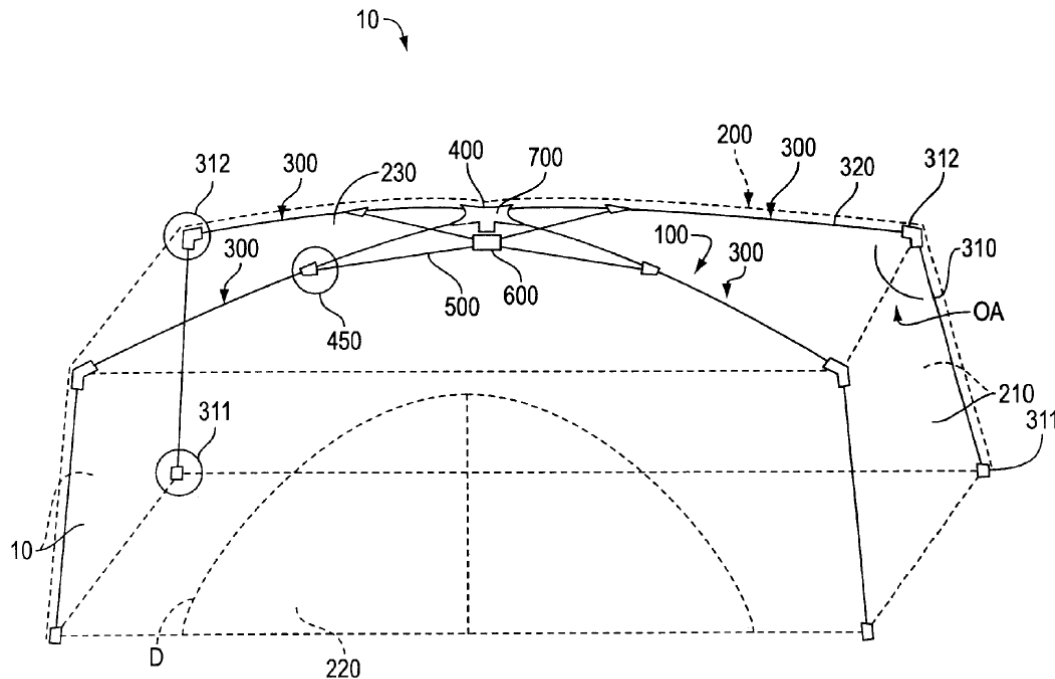


FIG. 1(A)

Figure 1(A) of Rousselle depicts an example of a collapsible shelter/tent in an erected state. *Id.* at 6:29–30. As shown in Figure 1A, shelter/tent 10 includes collapsible frame 100 that supports sheet-material cover 200. *Id.* at 6:30–32. Sheet material cover 200 includes sides 210 and ceiling 230, and collapsible frame 100 has four supporting legs 300 pivotally attached to upper clevis 400. *Id.* at 6:44–46, 6:54–56. Rousselle describes that “[a]lthough four legs are preferred, the frame can have only three legs or can have five or more legs.” *Id.* at 6:56–58. Each leg 300 includes leg tube 310 extending from tent foot 311 to hinge 312 and band bar 320 extending from hinge 312 to upper clevis 400. *Id.* at 6:58–61. Each leg 300 also includes hinge 450 that pivotally supports an outer end of center tube 500, while an inner end of center tube 500 is pivotally connected to lower clevis 600. *Id.* at 6:61–64. Upper and lower devices 400 and 600 may be locked together via locking mechanism 700. *Id.* at 6:66–67.

Figure 1(D) of Rousselle is reproduced below.

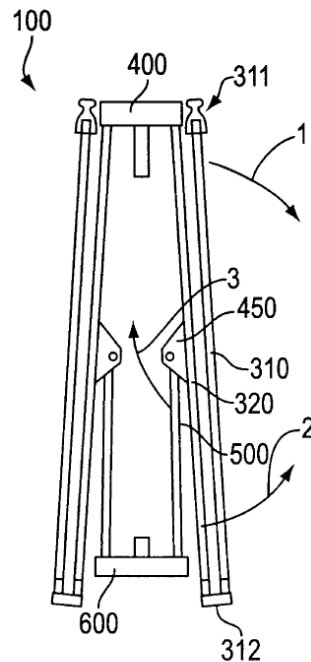


FIG. 1(D)

Figure 1(D) of Rousselle depicts an example of a shelter/tent in a collapsed state. *Id.* at 4:1–3. In order to erect a shelter/tent from such a collapsed state, a user may begin by moving leg tubes 310 downward in the direction of arrow 1 and raising band bars 320 upward in the direction of arrow 2. *Id.* at 13:5–9. Rousselle describes that this action causes center tubes 500 to elevate in the direction of arrow 3, and as center tubes 500 approach a horizontal position, their outer ends push against cover 200, causing legs 300 to flex. *Id.* at 13:9–15. After center tubes 500 are lifted past approximately the horizontal axis, lower clevis 600 is forced upward towards the upper clevis 400. *Id.* at 13:26–29. The outward force of center tubes 500 also creates pressure further forcing leg tube 310 in the direction of arrow 1 and hinge 312 to its fully opened state, as shown in Figure 1(A). *Id.* at 13:16–21.

Rousselle also describes that once lower clevis 600 has been moved upward a certain distance, the user can place one hand under lower clevis

600 and the other above upper clevis 400 and push the clevises together such that locking mechanism 700 can lock the clevises together. *Id.* at 13:22–26.

## 2. Tsai

Tsai, titled “Shelter frame with scissors-type linkage,” “relates . . . to shelters including collapsible frames.” Ex. 1005, code (54), 1:4–6. More specifically, Tsai describes “a shelter frame with a canopy support including . . . support rods” that “provides a greater support area than many prior canopy supports, which results in an aesthetically pleasing shelter canopy that is less likely to sag.” *Id.* at 4:13–22; *see also id.* at 3:17–19.

Figure 1 of Tsai is reproduced below.

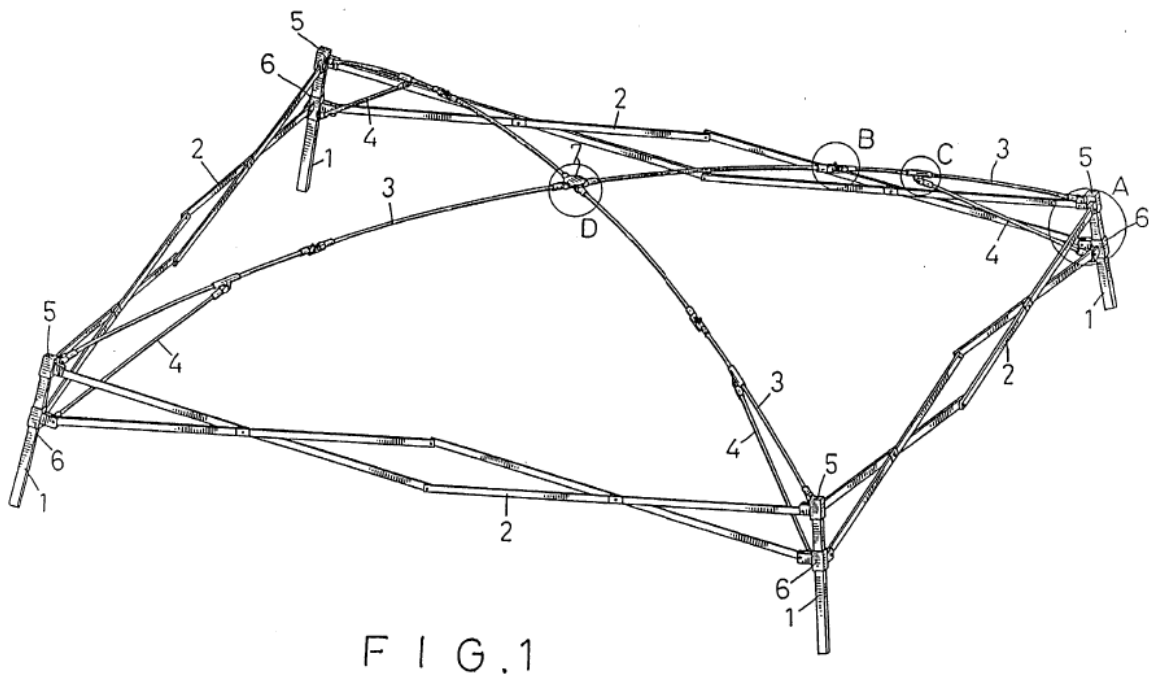


Figure 1 of Tsai depicts a collapsible shelter frame according to one embodiment. *Id.* at 5:16–17. As shown in Figure 1, the shelter frame includes a canopy support and a lower frame member that includes four upwardly extending poles 1 connected to one another by four pairs of scissors-type (or x-type) linkages 2. *See id.* at 7:4–10. Each scissors-type

linkage 2 is pivotally secured to another linkage and to one of the poles 1.  
*Id.* at 7:10–12.

Figure 20 of Tsai is reproduced below.

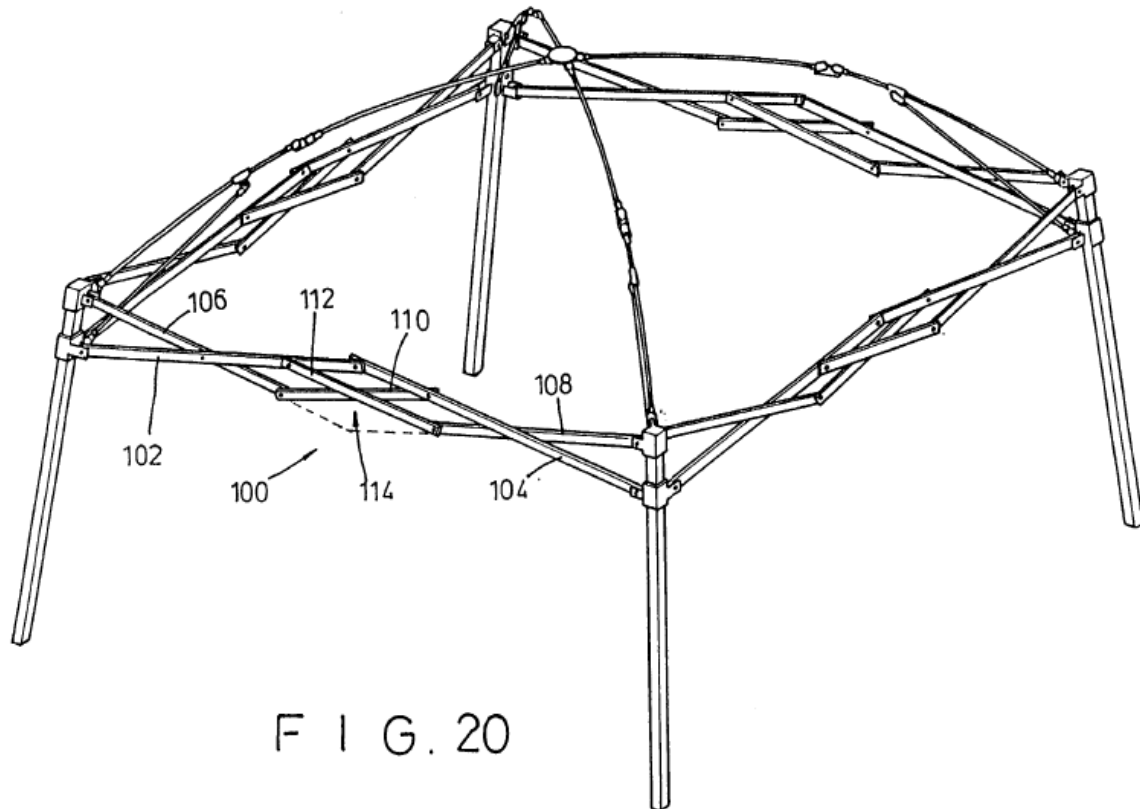


Figure 20 of Tsai depicts a shelter frame according to another embodiment. As shown in Figure 20, “[o]ne or all of the scissors-type linkage pairs shown in FIGURE[] 1 . . . may be replaced by a linkage assembly 100.” *Id.* at 9:29–32. Linkage assembly 100 includes structural members 102 and 104 pivotally secured to one another and to respective sliding connectors 6. *Id.* at 9:32–35. Structural members 106 and 108 are secured to respective fixed connectors 5, and structural members 102–108 form two scissors-type linkages and operate in a scissor-like manner. *Id.* at 9:35–10:4. To eliminate the relatively low connection point associated with the structure shown in Figure 1 (shown in dashed lines in Figure 20), linkage assembly 100 also includes a linking device comprised of linking members 110

and 112. *Id.* at 10:4–8. “Linking member 110 extends from the free end of structural member 106 to structural member 104 and linking member 112 extends from the free end of structural member 108 to structural member 102.” *Id.* at 10:8–12. According to Tsai, this results in a shelter frame with more headroom at point 114 midway between the poles—often the location of the entrance to the shelter. *Id.* at 10:12–15.

Tsai also describes that its shelter frame may be readily assembled, erected (or unfolded) for use and folded for storage and transport. Figure 21 of Tsai is illustrative and is reproduced below.

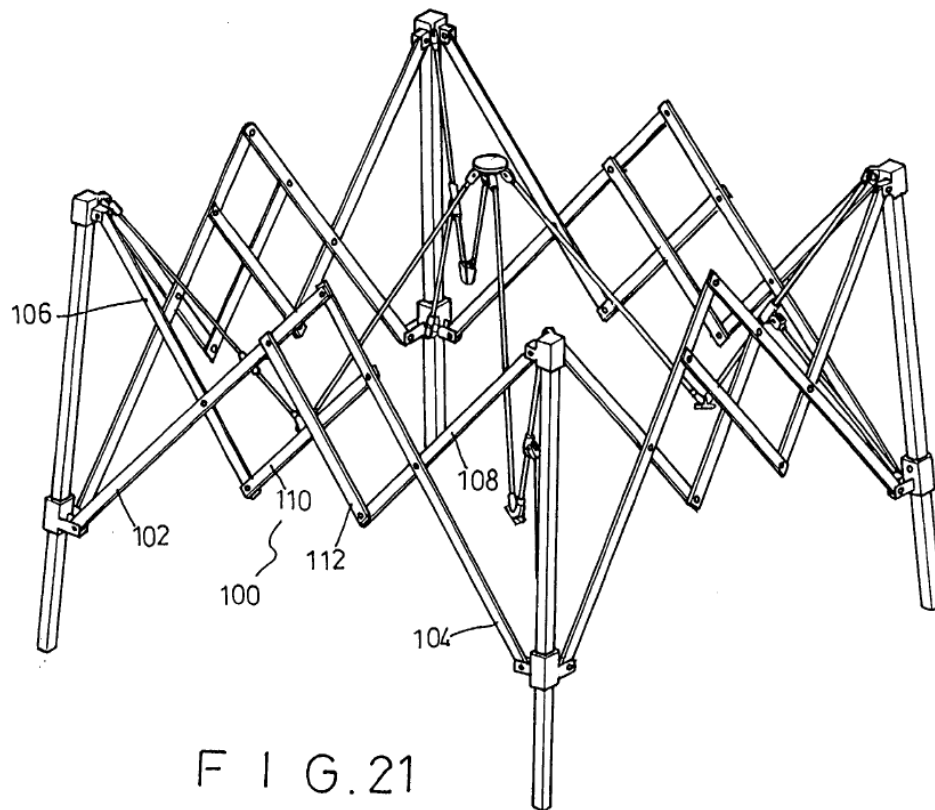


Figure 21 of Tsai depicts a view of the embodiment shown in Figure 20 in a partially folded orientation. *Id.* at 6:25–27.

### 3. Independent Claim 1

Petitioner contends that the proposed combination of Rousselle and Tsai discloses the limitations of claim 1. Pet. 12–48. To support its

arguments, Petitioner identifies certain passages in the cited references and explains the significance of each passage with respect to the corresponding claim limitation. *Id.* Petitioner also articulates reasons to combine the relied-upon aspects of Rousselle and Tsai with a reasonable expectation of success. *Id.* at 20–22, 28–29, 34–37. Patent Owner argues that (1) Petitioner fails to properly address limitation [D][3][iii] of claim 1 (“wherein said central lock locks said collapsible canopy frame in an unfolded state when said central lock is locked and permits said collapsible canopy frame to be folded into a folded state when said central lock is unlocked”) (Prelim. Resp. 7–11); and (2) Petitioner’s proposed combination of Rousselle and Tsai would be inoperable (*id.* at 12–22).

We have reviewed Petitioner’s contentions with respect to the limitations of claim 1, and for the reasons discussed below, we determine that the Petition shows a reasonable likelihood that Petitioner would prevail with respect to the contention that claim 1 would have been obvious based on Rousselle and Tsai. *See* Pet. 12–48. We address Patent Owner’s arguments below.

*a) Limitation [D][3][iii]*

As noted above, limitation [D][3][iii] recites “wherein said central lock locks said collapsible canopy frame in an unfolded state when said central lock is locked and permits said collapsible canopy frame to be folded into a folded state when said central lock is unlocked.” Ex. 1001, 10:29–33. For this limitation, Petitioner argues that Rousselle discloses that, when its canopy is in the unfolded state, the central lock is engaged with “the upper and lower [devices] . . . securely locked together via the locking mechanism 700,” such that “the frame is securely locked via the locking mechanism 700.” Pet. 45–46 (quoting Ex. 1003, 13:5–41; citing Ex. 1002 ¶ 123).

Petitioner also argues that when Rousselle’s central lock is unlocked, the frame can be returned to the collapsed or folded state depicted in Figure 1(D). *Id.* at 46 (citing Ex. 1003, 13:5–8, Fig. 1(D); Ex. 1002 ¶ 125).

Petitioner thus contends that Rousselle discloses limitation [D][3][iii]. *Id.* (citing Ex. 1002 ¶¶ 122–125).

Patent Owner argues that “Limitation [D][3][iii] requires **all of the collapsible canopy frame (including each of the claimed limitations [A]–[D])** in the collapsed/fold state.” Prelim. Resp. 8. Patent Owner then argues that Petitioner solely relies on Figure 1(D) of Rousselle, but this Figure does not disclose that *all elements* of the collapsible frame are in the folded state because Rousselle does not teach or suggest outer retractable units in the collapsed state. *Id.* at 8–9.

This argument is not persuasive. First, we disagree with Patent Owner’s suggestion that limitation [D][3][iii] requires that *all* of the claimed frame elements individually assume a folded or collapsed state. Rather, the claim language merely states that the collapsible canopy frame is permitted to be *folded into a folded state* when the central lock is unlocked. This claim language does not define the folded state or specify that each claimed element—in particular, the outer retractable units—must be folded or collapsed.

Second, this argument focuses too much on Rousselle alone and does not address the proposed combination sufficiently. *See In re Keller*, 642 F.2d 413, 426 (CCPA 1981) (“[O]ne cannot show non-obviousness by attacking references individually where . . . the rejections are based on combinations of references.”). Although the section addressing limitation [D][3][iii] only discusses Rousselle (Pet. 45–46), it is clear that the Petition relies on the combination of Rousselle and Tsai as rendering claim 1

unpatentable (*see generally id.* at 12–48). In particular, as noted by Patent Owner (*see* Prelim. Resp. 9), Petitioner relies on Tsai for teaching outer retractable units (Pet. 14–20). Indeed, Petitioner argues that Tsai’s outer retractable units are designed to extend and retract with respect to the supporting legs. *Id.* at 16–17 (citing Ex. 1002 ¶ 66; Ex. 1005, Figs. 1, 10). Petitioner also asserts that the combination of Rousselle and Tsai would include outer retractable units. *Id.* at 20–22; *see also id.* at 34–37 (arguing alternatively that one of ordinary skill in the art would have been motivated to combine Rousselle’s central lock with Tsai’s canopy frame that includes supporting legs, inner retractable units, and outer retractable units).

On this record, we are not persuaded that Petitioner’s assertion that Rousselle discloses limitation [D][3][iii] is intended to disregard the relied-upon teachings of Tsai vis-à-vis limitation [D][3][iii] or to suggest that the outer retractable units in the combination would not be folded.

Patent Owner also argues that even when taking Tsai into account, the proposed combination would still be deficient because the resulting structure would not be permitted to fold based on Rousselle’s central lock. Prelim. Resp. 10. Specifically, Patent Owner argues that “Petitioner asserts that one of skill would have been motivated to include Tsai’s outer retractable units in Rousselle’s canopy to improve the stability of the structure” but overlooks “that Tsai further teaches that in the stable orientation ‘the sliding connectors 6 will be locked in place by the locking assemblies 10.’” *Id.* at 10–11 (citing Pet. 21; Ex. 1005, 8:5–8, 10:34–11:1). Thus, according to Patent Owner, “the combination proposed by Petitioner would necessarily include locks on each leg and would not be permitted to fold based only on the central lock.” *Id.* at 11.

We are not persuaded by this argument because it is not commensurate in scope with the claim. Claim 1 employs the open-ended language “comprising,” and thus does not preclude additional elements such as locking assemblies on the supporting legs. *See Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501 (Fed. Cir. 1997) (discussing “open ended” claim terms, such as “comprising”). More specifically, claim 1 only requires that the collapsible canopy frame is permitted to be folded into a folded state when the central lock is unlocked and does not preclude needing to unlock other locks for the central lock to permit folding.

In addition, Patent Owner mischaracterizes Petitioner’s proposed combination. Namely, Petitioner’s proposed combination would not retain Tsai’s locking assemblies 10 as asserted by Patent Owner. Instead, Petitioner proposes *replacing* Tsai’s locking assemblies 10 with Rousselle’s central lock. Pet. 36 (citing Ex. 1002 ¶ 103).

For the above reasons, we do not find Patent Owner’s arguments persuasive. Instead, at this stage of the proceeding and on the current record, we determine that Petitioner has made a sufficient showing that the proposed combination of Rousselle and Tsai discloses limitation [D][3][iii].

*b) Alleged Inoperability of the Rousselle-Tsai Combination*

Patent Owner argues that the proposed combination of Rousselle and Tsai would be inoperable for the intended function of a collapsible canopy. Prelim. Resp. 12. For instance, Patent Owner contends that Petitioner cites Rousselle’s Figure 1(D) as teaching the collapsible canopy frame being folded into a folded state, but adding Tsai’s outer retractable units would prevent Rousselle’s frame from achieving the folded configuration of Figure 1(D). *Id.* at 14. Patent Owner argues that Figure 1(D) depicts that

the leg tubes 310 (identified by Petitioner as the supporting legs, Pet. 12–13) extend from feet 311 to hinge 312. Ex. 1003, Fig. 1(D). Importantly, in the folded configuration, the leg tubes 310 pivot 180 degrees on the hinge 312 such that the feet 311 are at the top of the folded device. The result of this transition is depicted in Figure 1(D) in which the feet 311 are proximate to element 400 (identified by Petitioner as the center **top** cap, Pet. 37–39). Further, Rousselle teaches, and Figure 1(D) shows, that when the device is to be unfolded and the canopy erected, the leg tube 310 must rotate downward following arrow 1. *Id.* at 13:5–21, Fig. 1(D).

Prelim. Resp. 15. In other words, when unfolding Rousselle’s frame, leg tubes 310 and feet 311 must move from pointing upward with feet 311 being proximate to top cap 400 to pointing downward with feet 311 being the lowest point of the frame. *Id.* at 16. But according to Patent Owner, adding Tsai’s outer retractable units to Rousselle’s frame would render the resulting structure inoperable. *Id.* at 17. Specifically, Patent Owner argues that adding Tsai’s outer retractable units to Rousselle’s frame would require several attachment points for the outer retractable units to each leg tube 310, such that leg tubes 310 would not be capable of pivoting 180 degrees about hinge 312. *Id.* at 17–18 (citing Ex. 1003, Figs. 1(D), 19).

We agree with Patent Owner’s characterization of Rousselle’s Figure 1(D), which is reproduced above (*see supra* § III.E.1). Thus, at this stage of the proceeding, Patent Owner’s argument appears to have some merit based on the current record before us. This argument, however, does not account for Petitioner’s proposed alternative modification. That is, Petitioner argues that, as an alternative to adding Tsai’s outer retractable units to Rousselle’s canopy frame, one of ordinary skill in the art would have been motivated to combine Rousselle’s central lock with Tsai’s canopy frame that includes supporting legs, inner retractable units, and outer

retractable units. Pet. 34–35 (citing Ex. 1002 ¶¶ 101–108). Petitioner asserts that one of ordinary skill in the art would have modified Tsai’s canopy by including Rousselle’s hinges 450 and center tubes 500 to connect Tsai’s inner retractable units with the top and bottom of Rousselle’s central lock. *Id.* at 37 (citing Ex. 1002 ¶ 108).

According to Petitioner, one of ordinary skill in the art would have been motivated to make this modification because Rousselle discloses the benefits of a central lock over Tsai’s individual leg locking system, such as making the canopy easier and more convenient for a single user to operate. *Id.* at 35–36 (citing Ex. 1002 ¶¶ 102–103; Ex. 1003, 3:38–47; Ex. 1005, 4:29–5:5, 8:5–33, Figs. 1, 2, 18, 19). Petitioner also argues that the proposed modification is the simple addition of one known element to another known element to obtain predictable results and uses a known technique to improve a similar device and yield predictable results. *Id.* at 36–37 (citing Ex. 1002 ¶¶ 105–107; *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007)).

At this stage of the proceeding, we are persuaded that Petitioner’s alternative rationale and evidence are sufficient to show that a person of ordinary skill in the art would have modified Tsai’s canopy frame to include the central lock taught by Rousselle.

*c) The Remaining Aspects of Petitioner’s Contentions*

Patent Owner does not offer any arguments specifically addressing the remaining limitations of claim 1. *See generally* Prelim. Resp. We have reviewed Petitioner’s contentions with respect to the remaining limitations of claim 1 and determine that the Petition provides a sufficient showing, at this stage of the proceeding, that the proposed combination of Rousselle and Tsai satisfies each limitation. *See* Pet. 12–45, 47–48.

*d) Conclusion*

For the above reasons, we determine, based on the current record, that the Petition shows a reasonable likelihood that Petitioner would prevail in demonstrating that claim 1 is unpatentable over Rousselle and Tsai.

*4. Dependent Claims 2, 4, and 14*

Claims 2, 4, and 14 depend from claim 1. Because Petitioner has demonstrated a reasonable likelihood of success in proving that at least one claim of the '738 patent is unpatentable, we institute on all grounds and all claims raised in the Petition. *See SAS*, 138 S. Ct. at 1354, 1359–60; *see also PGS Geophysical AS v. Iancu*, 891 F.3d 1354, 1360 (Fed. Cir. 2018) (interpreting 35 U.S.C. § 314 to require “a simple yes-or-no institution choice respecting a petition, embracing all challenges included in the petition”); 37 C.F.R. § 42.108(a) (“When instituting inter partes review, the Board will authorize the review to proceed on all of the challenged claims and on all grounds of unpatentability asserted for each claim.”). Therefore, it is not necessary for us to assess every claim challenged by Petitioner.

Nevertheless, we note that Petitioner provides reasonable and detailed explanations, supported with the testimony of Dr. Stein, indicating where the references teach or suggest the limitations of claims 2, 4, and 14. Pet. 49–73. We have reviewed Petitioner’s contentions with respect to these claims and determine that the information presented in the Petition establishes that there is a reasonable likelihood that Petitioner would prevail in its assertion that claims 2, 4, and 14 are unpatentable over the combination of Rousselle and Tsai.

*F. Asserted Obviousness Based on Rousselle, Tsai, and Ohnishi*

Petitioner also challenges claims 4, 13, and 14, which depend from claim 1, as unpatentable under 35 U.S.C. § 103 based on the combination of Rousselle, Tsai, and Ohnishi. Pet. 74–90.

Petitioner relies on Ohnishi as disclosing a central lock having center pole 63 that is clamped by locking piece 65, 67. *Id.* at 74 (citing Ex. 1006, 7:18–8:19, Figs. 9–11). Petitioner also provides reasons, supported with the testimony of Dr. Stein, for why it would have been obvious to one of ordinary skill in the art to combine Ohnishi’s locking piece with Rousselle’s lock, and thereby replace Rousselle’s locking piece, with a reasonable expectation of success. *Id.* at 81–83 (citing Ex. 1002 ¶¶ 193–198).

Petitioner also provides analysis purporting to show where certain limitations of claims 4, 13, and 14 are disclosed by the combination of Rousselle, Tsai, and Ohnishi. *Id.* at 75–81, 83–90.

Patent Owner argues that this ground is deficient for the same reasons discussed in connection with the first ground, and Ohnishi “does not relate to canopies and thus does not and cannot remedy any of the deficiencies with the structures of Rousselle and Tsai or provide any insight into how the proposed structural combination could be operable.” Prelim. Resp. 23–24. However, we find Patent Owner’s arguments regarding the first ground unpersuasive for the reasons discussed above.

On the current record, we find Petitioner’s contentions sufficiently persuasive at this stage of the proceeding. Furthermore, because Petitioner has demonstrated a reasonable likelihood of success in proving that at least one claim of the ’738 patent is unpatentable (*see supra* § III.E.), we include these grounds in the instituted *inter partes* review. *See SAS*, 138 S. Ct. at 1354, 1359–60; *PGS Geophysical*, 891 F.3d at 1360; 37 C.F.R. § 42.108(a).

### *G. Collateral Estoppel*

Relying on the final written decision that has been issued in IPR2021-00365 (Ex. 1016), Petitioner asserts that the doctrine of collateral estoppel “compels a finding that at least claims 1 and 4 of the ’738 patent are invalid as obvious.” Pet. 90. Petitioner provides a table comparing claims 1 and 4 of the ’738 patent to the corresponding claims of U.S. Patent No. 10,273,710, the patent challenged in IPR2021-00365. *Id.* at 91–93. According to Petitioner, the differences between the claims of the two patents are not substantive and do not materially affect the invalidity determination, and therefore the issues of patentability in the two proceedings are identical. *Id.* at 94–96.

Patent Owner argues that collateral estoppel should not be applied because the issues are not the same. Prelim. Resp. 27. For instance, Patent Owner argues that “the presence of additional claim limitations that were not previously addressed demonstrates the existence of a different question/issue.” *Id.* (citing *Rimfrost AS v. Aker Biomarine Antarctic AS*, IPR2020-01534, Paper 25 at 14–19 (PTAB May 18, 2022)).

In light of our determination above, that Petitioner has established a reasonable likelihood that it would prevail in showing that the combination of Rousselle and Tsai would have rendered the subject matter of the challenged claims obvious, we need not also determine, at this time, whether Patent Owner should be estopped from contesting Petitioner’s challenge. The parties are welcome to address this issue in the briefing that follows institution.

### IV. CONCLUSION

After considering the evidence and arguments of record, we determine that Petitioner has demonstrated a reasonable likelihood of success with

respect to at least one of the challenged claims. Accordingly, an *inter partes* review of all of the claims and all of the grounds presented in the Petition is hereby instituted. *See SAS*, 138 S. Ct. at 1354, 1359–60; *PGS Geophysical*, 891 F.3d at 1360; 37 C.F.R. § 42.108(a).

At this stage of the proceeding, the Board has not made a final determination as to the patentability of any challenged claims or any underlying factual or legal issues. The final determination will be based on the record as developed during the *inter partes* review.

#### V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review of claims 1, 2, 4, 13, and 14 of the '738 patent is instituted with respect to all grounds set forth in the Petition; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4(b), *inter partes* review of the '738 patent shall commence on the entry date of this Order, and notice is hereby given of the institution of a trial.

IPR2023-00580  
Patent 10,669,738 B2

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