

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VIDENDUM PRODUCTION SOLUTIONS, INC.,
Petitioner,

v.

ROLIGHT LIMITED,
Patent Owner.

IPR2023-01220
Patent 10,197,257 B2

Before GRACE KARAFFA OBERMANN, JEFFREY W. ABRAHAM,
and KIMBERLY McGRAW, *Administrative Patent Judges*.

OBERMANN, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. *Background and Summary*

Videndum Production Solutions, Inc. (“Petitioner”) filed a petition for an *inter partes* review (Paper 1, “Pet.”) challenging claims 1–21 of U.S. Patent No. 10,197,257 B2 (Ex. 1001, “the ’257 patent”). Rotolight Limited (“Patent Owner”) filed a Preliminary Response. Paper 6, “Prelim. Resp.” After receiving authorization from the Board, Petitioner filed a Reply to the Preliminary Response (Paper 6) and Patent Owner filed a Sur-reply (Paper 7).

We have authority to determine whether to institute an *inter partes* review under 35 U.S.C. § 314 and 37 C.F.R. § 42.4(a). For the reasons set forth below, we do not institute an *inter partes* review of the challenged claims.

B. *Real Parties-in-Interest*

Petitioner identifies itself and Videndum PLC as real parties-in-interest. Pet. 68. Patent Owner identifies itself and Rotolight Group Ltd. as real parties-in-interest. Paper 4, 1.

C. *Related Proceedings*

The parties identify *Rotolight Limited v. Videndum PLC and Videndum Product Solutions, Inc.*, Case No. 22-928-MN-JLH (D. Del.) (“the District Court action”), in which Rotolight has asserted infringement of the ’257 patent. Pet. 69; Paper 4, 1. Patent Owner identifies three additional district court actions. Paper 4, 2 (listing those actions).

The parties indicate that Arnold & Richter Cine Technik GmbH & Co. Betriebs KG (referred to by the parties as “ARRI”) previously filed an *inter partes* review against the same claims of the ’257 patent in IPR2021-01496

(“IPR496”). Pet. 68–69; Paper 4, 2; Prelim. Resp. 22. Patent Owner identifies seven additional *inter partes* reviews. *See* Paper 4, 1–2 (listing those proceedings).

Only Patent Owner identifies as a related matter the proceeding in IPR2022-00261 (“IPR261”), in which Petitioner¹ previously filed a petition against the same claims of the same patent challenged in the instant Petition. *Compare* Pet. 68–69, with Paper 4, 1–2.

D. The '257 Patent (Ex. 1001)

The '257 patent, titled “Lighting System and Control Thereof,” issued on February 5, 2019. Ex. 1001, codes (45), (54). The '257 patent “relates to a lighting system, and the control of a lighting system, and the simulation of lighting special effects, and in particular to a lighting system for videography, broadcasting and cinematography.” *Id.* at 1:16–20.

According to the '257 patent, a typical “lighting controller called a ‘flicker box’ . . . is used to produce flickering light effects to mimic flickering light for example from a fire place, candle, electrical spark or lightening.” *Id.* at 1:21–25. But flicker boxes are “complex, costly and time consuming” to set up, and the “connection and control of multiple pieces of hardware . . . requir[e] a physical wired connection to the ‘hot’ light source desired to be controlled.” *Id.* at 1:30–35. Flicker boxes are also “incompatible with LED light sources” and “require the use of ‘hot’

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Vitec Production Solutions is listed as the Petitioner in IPR2022-00262, and The Vitec Group PLC is listed as a real party in interest. Petitioner changed its name from The Vitec Group PLC to Videndum Production Solutions, Inc. in May 2022. *See* Ex. 2003.

incandescent light sources which are energy inefficient and also pose health and safety risks to those working on set.” *Id.* at 1:39–44.

The “improved solution” the ’257 patent offers includes methods, controllers, and computer programs “for controlling a lighting device to produce user customizable lighting effect” by, among other things, “calculating a time varying lighting value based on at least one simulation parameter” and “outputting said time varying lighting value thereby to simulate a lighting effect.” *Id.* at 1:45–51, 2:61–67; 3:37–43. Figure 2 is illustrative and reproduced below.

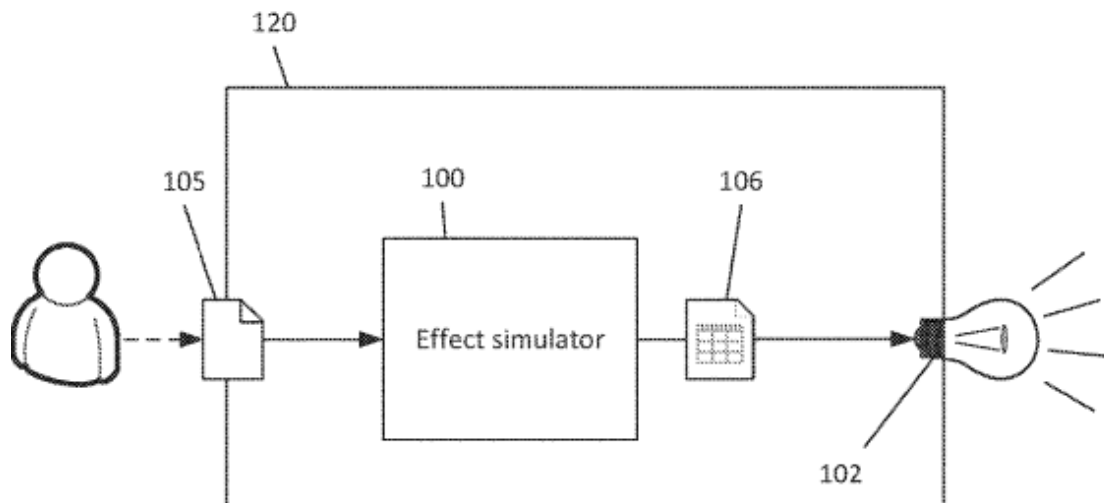


Figure 2

Figure 2 “is a schematic diagram of a further lighting system.” *Id.* at 5:25. Figure 2 shows studio lamp device 120 that includes input interface 105 and lighting effect simulator 100 which produces data 106 used to modulate light 102. *Id.* at 5:58–6:14. “In one example, the light 102 is an array of LEDs, preferably of differing colours” and a “microcontroller or other computing unit is integrated in the lamp device 120 for performing

calculations.” *Id.* at 5:60–61, 5:65–67. The ’257 patent explains that “[t]his arrangement does not require the DMX distribution hub 302, power elements 304, 306” required in a flicker box lighting system. *Id.* at 5:61–63.

Figure 6, reproduced below, illustrates a simulated lighting effect that employs an exemplary graphic user interface.

800

Light control system	
Fire effect	
Parameter	Setting
More info Fire activity	
More info Fire colour	2000K
More info Peak brightness	80%
More info Baseline brightness	40%
More info Camera frequency	60Hz
	
Colour Swing Blue	Monochrome

Figure 6

Figure 6 “is a graphic user interface [800] for user input of simulation parameters.” *Id.* at 5:32–33. According to Figure 6, the simulated effect is a fire effect. *Id.* at 8:14–16. Interface 800 allows the user to select a “fire

activity” by sliding the slider between low to high and set values for “fire colour,” “peak brightness,” “baseline brightness,” and “camera frequency.”
Id. at 8:17–21.

E. Illustrative Claim

Petitioner challenges claims 1–21 of the ’257 patent, with claims 1, 15 and 20 being the independent claims. Claim 1, reproduced below, is representative of the challenged claims.

1. A method for controlling a lighting device to produce a user customisable lighting effect, the method comprising:

calculating, using an effect simulator, a time varying lighting value based on at least one simulation parameter; wherein said at least one simulation parameter characterises a user customisable lighting effect selected from a range of different user customisable lighting effects for at least one of: videography, broadcasting, cinematography, studio filming, and location filming; wherein said at least one simulation parameter is at least one of: a random brightness; a random duration; and a random interval; said simulation parameter depending on the user customisable lighting effect being simulated; and

outputting, from said effect simulator, said time varying lighting value thereby to simulate the user customizable lighting effect.

Ex. 1001, 11:54–12:3.

F. The Asserted Unpatentability Challenges

Petitioner asserts that claims 1–21 would have been unpatentable on the following grounds:

Claims Challenged	35 U.S.C. §	Reference(s)/Basis
1–21	102 ²	Astera ³
1–21	103	Astera
1–21	102	Pohlert ⁴
1–21	103	Pohlert

Pet. 3. Petitioner also relies on declaration testimony of Mr. Woody Smith (Ex. 1003, “the Wood Declaration”) and Mr. Simon Canins (Ex. 1005). The Preliminary Response is supported by the declaration testimony of Dr. Eric Bretschneider (Ex. 2002).

G. The Asserted Prior Art

Petitioner asserts the same prior art references previously advanced by ARRI in IPR496. We provide an overview of those references below.

1. Astera (Ex. 1004)

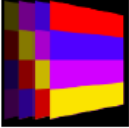
Astera is a user manual for the AX10 Spotmax—a programmable, customizable lighting apparatus that includes an array of light emitting diodes (“LEDs”). Ex. 1004, 7. The AX10 can be controlled in several ways—(1) Astera’s ARC 1 infrared remote, (2) the AsteraApp, (3) by CRMS wireless DMX, (4) or a control panel. *Id.* at 9–11. The Astera

² The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284 (2011), amended 35 U.S.C. § 102, effective March 16, 2013. Given that the application from which the ’257 patent issued was filed after this date (Ex. 1001, code (22)), the current versions of §§ 102 and 103 apply.

³ Astera LED Technology GmbH, AX10 SPOTMAX™ User Manual, dated May 7, 2015 (Ex. 1004, “Astera”), but alleged by Petitioner to have a publication date of June, 2015. *See* Pet. 36 (Petitioner’s information pertaining to earliest publication date).

⁴ Pohlert et al., US 2012/0257374 A1, published Feb. 23, 2012 (Ex. 1006, “Pohlert”).

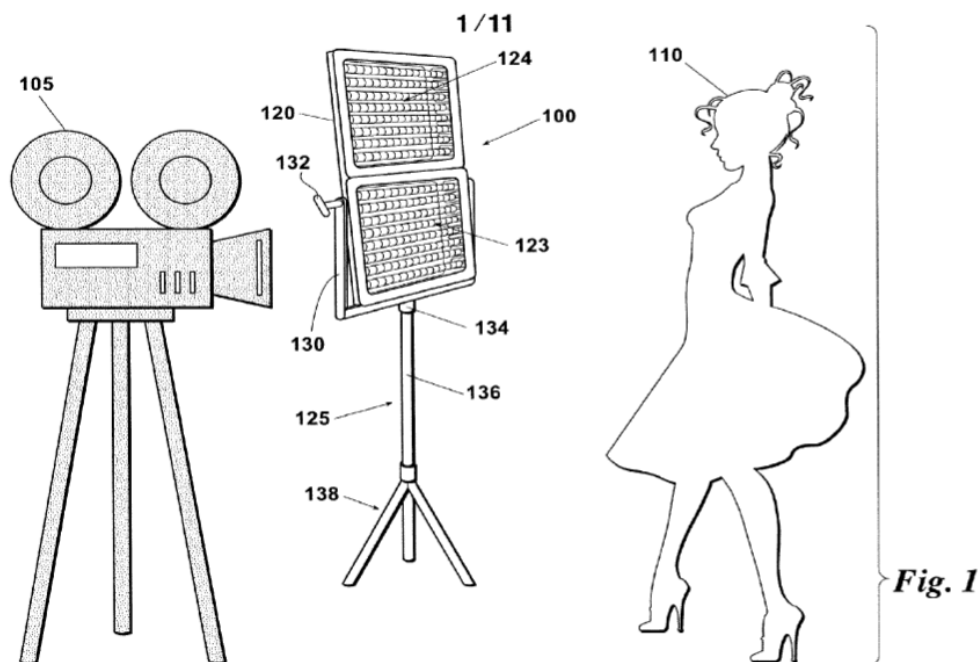
lighting control system “can display static colors or replay a number of predefined effect patterns with a customizable color palette.” *Id.* at 24. Exemplary effects are shown in the figure accompanying section 7.7 of Astera and reproduced below:

	A static color is displayed. There are also options that show two, three or four static colors at a time. The Flow-Set is then divided into several parts of equal length: 
	Fading colors. The four defined colors are displayed one after the other. The setup fade is applied between them. Again, the Flow-Set can be split in up to four segments.
	From both sides of a Flow-Set, the color changes position by position from C1 to C2. Once the whole Set is C2, it changes back to C1 in the same way.
	The color of the Flow-Set changes position by position. After all positions show the same color, a new cycle is started.
	Several variations of running lights are available.
	The Fire effect shows a random flickering effect. The background color and the color of the flickering effect can be adjusted.
	The rainbow effect shows a color change through all colors. Only its speed can be adjusted.
	Chaser effects provide an efficient means to create dancefloor lighting. The static chaser exchanges the color of the lights according to the tapped-in beat. The colors are randomly chosen. The effect can be adjusted to show up to 4 different colors at a time.
	The Moving Chasers overlay the static chaser by a second movement of the four displayed colors over the available positions of a Flow-Set. This gets mostly interesting of the Moving Strobe is chosen. Then, only some of the positions strobe and they are moving. So the strobe effect moves over the Flow-Set.
	When using the Chaser With Background, additionally a color can be selected that is mostly used, the background color.

This figure describes ten effects of the Astera lighting system, including static color, fading colors, a color change from both sets a of a flow-set, a flow-set where the color changes in each position, running lights, fire effect, a rainbow effect, chaser effects, moving chasers, and a chaser effect with a background color. *Id.* at 28. For example, “[t]he fire effect shows a random flickering effect [where] [t]he background color and the color of the flickering effect can be adjusted,” and “[t]he rainbow effect shows a color change through all colors” and “[o]nly its speed can be adjusted.” *Id.* Effect parameters—such as speed, crossfade, stroboscope, and brightness—may be adjusted and “may be saved back to the main screen by pressing the save button.” *Id.* at 27.

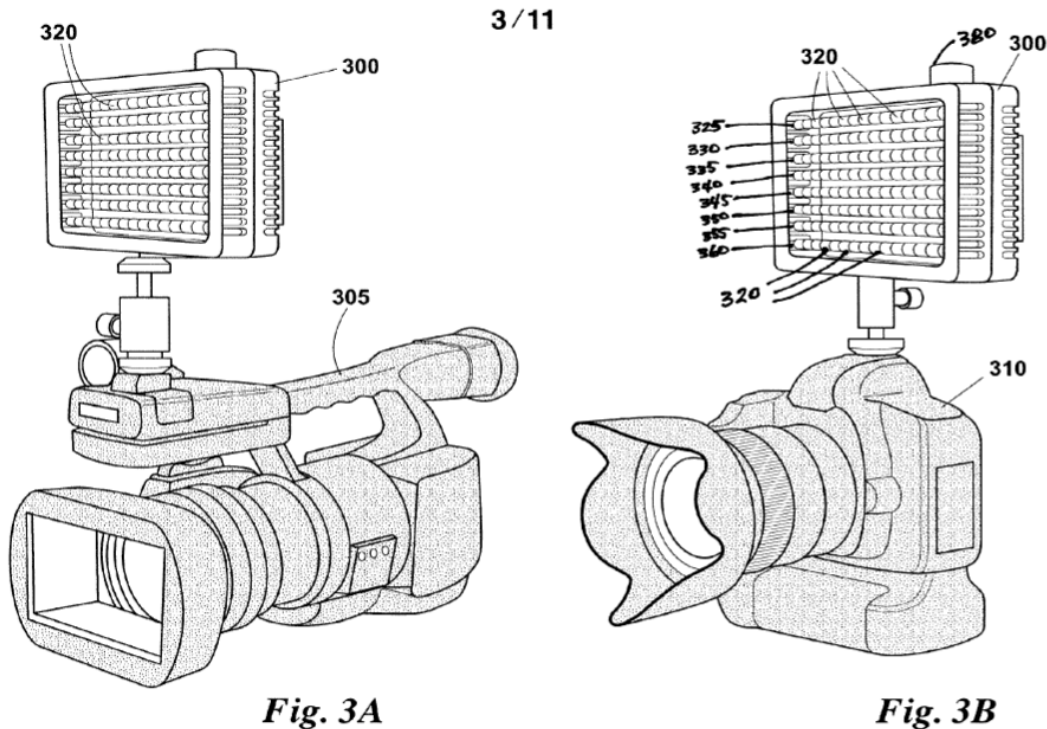
2. Overview of Pohlert (Ex. 1006)

Pohlert is directed to “lighting apparatus and systems as may be used in photography, film, television, and other applications.” Ex. 1006 ¶ 3. Pohlert explains that its lighting apparatus included an effects generator. *Id.* ¶ 18. One embodiment of Pohlert’s lighting apparatus is reproduced below.



Id., Fig. 1. Figure 1 “illustrates one environment in which the instant invention might be utilized.” *Id.* ¶ 26. Figure 1 depicts video camera 105, e.g., a motion picture camera, and light panel assembly 100 on stand 125 facing toward subject 110. *Id.* ¶¶ 52–53. Light panel assembly 100 may include multiple light panel sections 123 and 124. *Id.* ¶ 53. The light panels include an arrangement of lamp elements which may be light emitting diodes (“LEDs”), light emitting electrochemical cells (“LECs”), or any other artificial light source. *Id.* ¶¶ 46, 55, 51. Light frame 120 and twisting handle 132 allow light panel assembly to rotate and tilt to provide directional lighting. *Id.* ¶ 53.

Another embodiment is illustrated in Figures 3A and 3B, shown below.



Id., Figs. 3A, 3B. Figures 3A and 3B “contain illustrations of different approaches to mounting a preferred embodiment of the instant invention on video and still cameras, respectively. *Id.* ¶ 28. Figures 3A and 3B show that

“lighting device [300] might be directly mounted on a camera as opposed to being stand-mounted” as in Figure 1. *Id.* ¶ 55. Figure 3A (left) shows an example of light elements or lamps, collectively 320, mounted on video camera 305 and Figure 3B (right) shows lighting device 320 mounted on still camera 310. *Id.* Light segments 325, 330, 335, 340, 350, 355, 360 and additional unnumbered light segments combine to make a panel array of light elements or lamps 320. *Id.* ¶¶ 55–57, 59. Each individual light segment or groups of segments can be controlled to generate lighting effects. *Id.* ¶¶ 60–64.

Pohlert further describes a user interface to allow for operation of switches and adjustment of controls. For example, Pohlert describes “[a] manual interface 530 is provided to allow operation of the switches 522 according to manual selection. The manual interface 530 may include a master power switch 531, switch controls 532, and, optionally, an effects selector 533.” *Id.* ¶ 59; *see also id.* Figs. 5A, 5B (illustrating switch controls and effects selector).

II. WHETHER TO INSTITUTE *INTER PARTES* REVIEW

Patent Owner argues we should exercise our discretion to deny institution under 35 U.S.C. § 314 and 37 C.F.R. § 42.108(a), citing and discussing the factors in *General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16 (PTAB Sept. 6, 2017) (precedential as to § II.B.4.i). Prelim. Resp. 22–36. Petitioner asserts that discretionary denial is not warranted. Pet. 67–69; Reply 1–3.

A. Background

As noted above, the '257 patent was the subject of two earlier IPR proceedings, one filed by ARRI in IPR496 on Sept. 3, 2021, and another filed by Petitioner in IPR261 on Dec. 3, 2021. Prelim. Resp. 22.

In IPR496, ARRI challenged claims 1–21 of the '257 patent based on the same prior art references that Petitioner asserts here, namely, Astera and Pohlert. Ex. 2004, 3–4. On March 16, 2022, the Board instituted proceedings in the IPR496. Ex. 1007. IPR496 proceeded through briefing and oral hearings, but the Board terminated the proceedings (before a final written decision issued) on January 30, 2023, at the request of the parties after they filed a settlement agreement. Ex. 1011.

Three months after ARRI filed its petition in the IPR496, Petitioner filed a petition (Petitioner's "first Petition") in the IPR261, challenging claims 1–21 of the '257 patent based on Morgan⁵ in view of Julio⁶ (that is, different art than that asserted by ARRI in the IPR496). Ex. 2005, 4. The Board denied institution on June 8, 2022, stating Petitioner had failed to show a reasonable likelihood that it would prevail on the merits. IPR261, Paper 8 at 26.

On July 17, 2023, over a year after Petitioner's first petition challenging the '257 patent was denied and six months after the parties in the IPR496 filed their joint motion to terminate the proceedings in view of settlement, Petitioner filed the present Petition (Petitioner's "second Petition"), again seeking to challenging claims 1–22 of the '257 patent.

⁵ US 8,938,468 B2, issued Jan. 20, 2015. *See* Ex. 2005, 11.

⁶ US Pub. No. 2010/0264852, published Oct. 21, 2010. *See* Ex. 2005, 12.

B. General Plastic Factors

The Board’s decision in *General Plastic* articulates 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.

General Plastic, Paper 19 at 9–10.

C. Assessment of the Factors

1. Factor One

Under the first *General Plastic* factor, we consider “whether the same petitioner previously filed a petition directed to the same claims of the same patent.” *General Plastic*, Paper 19 at 16. The instant Petition is the second petition Petitioner has filed challenging claims 1–21 of the ’257 patent.

Pet. 1; Ex. 2005, 2. Accordingly, we determine that the first *General Plastic* factor weighs in favor of denying institution.

2. *Factor Two*

Under the second *General Plastic* factor, we consider “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.” *General Plastic*, Paper 19 at 16. Here, there is no dispute that at the time Petitioner filed the first petition in IPR261, Petitioner knew of the prior art that it now asserts in its second Petition. In its first petition, Petitioner listed IPR496 as a related matter. Ex. 2005, 1 (“The following currently pending matters relate to the challenged ’257 Patent: IPR2021–01496.”). As noted above, the petition in IPR496 relied on Astera and Pohlert, which is the same art Petitioner now relies upon in its present, second Petition. Ex. 2004, 3–4. Accordingly, Petitioner knew of this prior art, which Petitioner now asserts in its present, second Petition, when Petitioner filed its first petition.

Thus, we determine that the second *General Plastic* factor weighs in favor of denying institution.

3. *Factor Three*

Under the third *General Plastic* factor, we consider “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.” *General Plastic*, Paper 19 at 16.

Petitioner filed the present, second Petition on July 17, 2023. By that date, Petitioner had already received Patent Owner’s Preliminary Response to its first petition filed in IPR261 (*see* IPR261, Paper 7, (entered March 14,

2022)) as well as the Board’s Decision Denying Institution in that prior proceeding (*see* IPR261, Paper 8 (entered June 8, 2022)). In addition, as of July 17, 2023, in the related IPR496 involving the same prior art that Petitioner now asserts in its second Petition, the public record included the Board’s Decision on Institution (*see* IPR496, Paper 8 (entered March 16, 2022)), Patent Owner’s Response (*see* IPR496, Paper 21 (entered June 17, 2022)), Patent Owner’s Sur-reply (*see* IPR496, Paper 31 (entered October 21, 2022)), and the Oral Hearing Transcript (*see* IPR496, Paper 37 (entered December 28, 2022)).

Petitioner argues that this *General Plastic* factor favors institution because it is intended to prevent “roadmapping” – and Patent Owner cannot argue that Petitioner used its first petition in the IPR261 as a roadmap for its present second Petition because “the two petitions use different prior art, present different invalidity arguments, and Petitioner did not modify the Instant Petition in light of the decision on the [first petition].” Reply 1 (quotation omitted). Petitioner’s argument is unavailing, as it is based on a very narrow definition of “roadmapping” that requires both petitions to rely on the same art and invalidity arguments. *Id.* The Board, however, previously explained:

[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, until a ground is found that results in the grant of review. 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.

General Plastic, Paper 19 at 17–18 (internal citation and footnote omitted).

Here, Petitioner was able to use the Board’s decision denying institution in IPR261 to learn that the art and arguments asserted in the first petition were insufficient for institution, which led Petitioner to find a different ground that would “result[] in the grant of review.” *Id.* In that regard, contrary to Petitioner’s assertion, Petitioner did modify the second petition in light of the institution decision in the first petition. *See* Reply 1.

Moreover, as Patent Owner correctly notes, Petitioner was able to monitor the developments in the related IPR496 and use that information in preparing the Petition in this proceeding. Prelim. Resp. 27–30. The evidence of record thus shows that Petitioner was in a position to use the Board’s previous decisions regarding challenges to the ’257 patent as a roadmap—to avoid certain grounds and find others—for its second petition.

Based on the foregoing, we determine that the third *General Plastic* factor weighs in favor of denying institution.

4. *Factors Four and Five*

Under the fourth and fifth *General Plastics* factors, we consider “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 “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.” *General Plastic*, Paper 19 at 16.

The evidence of record shows that Petitioner had knowledge of the prior art now asserted in its present, second Petition (that is, Astera and

Pohlert) at least by December 3, 2021, when Petitioner filed its first petition. Ex. 2005, 1 (identifying as a related matter IPR496, which involved challenges based on Astera and Pohlert). Petitioner filed its second Petition, asserting that same art, on July 17, 2023. Thus, at a minimum, over one year and seven months elapsed between the time Petitioner had knowledge of the prior art asserted in the second Petition and the filing of the second Petition.

Patent Owner argues that Petitioner fails to provide an adequate explanation for waiting one year and seven months between filing its two petitions challenging the claims of the '257 patent. Prelim. Resp. 31–34. In particular, Patent Owner asserts that Petitioner knew of the prior art asserted in the instant Petition well before Petitioner filed its first petition and provides no explanation for its failure to include that art in the challenges raised in IPR261. *Id.* at 31, 33. Patent Owner also argues that, after Petitioner's first petition was denied by the Board in IPR261, Petitioner had every opportunity to file a copy-cat petition and motion for joinder in IPR496 to serve as a backup or understudy in the event of a settlement between ARRI and Patent Owner. *Id.* at 32–33. Patent Owner also argues that Petitioner “waited until near to the very last day to file the” instant Petition “before it became time-barred under 35 U.S.C. § 315(b).” *Id.* at 32.

Petitioner argues that this factor favors institution because the first petition was filed and terminated before Patent Owner filed suit against Petitioner in district court. Reply 1–2. Petitioner also argues that it “had no obligation to file” the instant Petition sooner than it did. *Id.* at 2.

Although Petitioner is correct that it was not obligated under 35 U.S.C. § 315(b) to file this Petition sooner, that does not constitute an adequate explanation as to why it waited until July 17, 2023 to file this

second Petition based on prior art references it was aware of one year and seven months earlier. Petitioner provides no evidence or argument directed toward showing why it did not assert these prior art references in its first petition. Additionally, the fact that Petitioner filed its first petition *before* Patent Owner filed suit against Petitioner undermines Petitioner's argument that the time elapsed between the filing dates of the two petitions somehow was related to the date of the complaint in the District Court action. *See id.* at 1–2.

In view of the foregoing, we agree with Patent Owner that Petitioner fails to provide an adequate explanation for the time elapsed between the filing of Petitioner's first and second petitions directed to the same claims of the '257 patent. In view of this lengthy delay, coupled with the lack of an adequate explanation for the delay, we determine that the fourth and fifth *General Plastic* factors weigh in favor of denying institution.

5. *Factors Six and Seven*

Under the sixth and seventh *General Plastic* factors, we consider “the finite resources of the Board” and “the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than [one] year after the date on which the Director notices institution of review.” *General Plastic*, Paper 19 at 16. The sixth and seventh factors are efficiency considerations. *See id.* at 16–17; *see also* Consolidated Trial Practice Guide 56 (Nov. 2019) (“CTPG”), <https://go.usa.gov/xpvPF> (citing *General Plastic*, Paper 19 at 16–18) (noting that the Director's discretion under § 314(a) is informed by 35 U.S.C. § 316(b), which requires “the efficient administration of the Office, and the ability of the Office to timely complete proceedings instituted under this chapter”).

We determine that the sixth and seventh *General Plastic* factors weigh against institution. In general, having multiple petitions challenging the same patent, especially when not filed at or around the same time as in this case, is inefficient and tends to waste resources. Here, Petitioner waited over one year and seven months to file its second Petition based on art that it was aware of when it filed its first petition. This serial and repetitive attack implicates the efficiency concerns underpinning *General Plastic*, and, thus, favors denying institution.

Petitioner argues that these factors favor institution because, in IPR496, “[t]he Board already found a likelihood that the ’257 patent may be invalid based on the same grounds raised in the Instant Petition.” Reply 2. That argument fails to address the concerns of efficiency and wasted resources at the Board. At the time the parties to IPR496 filed their motion to terminate based on settlement, the trial was nearly complete as the matter had been fully briefed and oral argument had already been held. All that remained was for the Board to issue its final written decision. A decision instituting an *inter partes* review on the instant Petition would require the Board to start another proceeding from the very beginning, based on the same grounds previously raised in IPR496, resulting in the Board’s and Patent Owner’s duplication of much of the efforts exerted in that proceeding.

Based on the foregoing, we determine that the sixth and seventh *General Plastic* factors weigh in favor of denying institution.

D. Summary

As discussed above, the evidence of record shows that all of the *General Plastic* factors weigh against institution. Although no single factor is dispositive, the evidence and circumstances as a whole weigh strongly in

favor of denying institution in this case. As a result, we determine that it is appropriate to exercise our discretion under § 314(a) to deny institution.

III. CONCLUSION

For the forgoing reasons, we exercise our discretion under § 314(a) to deny institution of an *inter partes* review.

IV. ORDER

For the reasons given, it is:

ORDERED that, pursuant to 35 U.S.C. § 314, the Petition is denied, and no *inter partes* review is instituted.

IPR2023-01220
Patent 10,197,257 B2

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