

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ENERGY SOLUTION, LTD.,
Petitioner,

v.

MOLECULAR REBAR DESIGN LLC,
Patent Owner.

Case IPR2024-01013
Patent 10,153,483

PETITIONER'S REPLY TO
PATENT OWNER'S PRELIMINARY RESPONSE

Petitioner's diligence in quickly filing this IPR Petition and the Petition's strong merits outweigh other applicable *Fintiv* factors and favor institution.

I. §314(a) – *Fintiv* Factors Favor Institution

Factor 1 is neutral: As Patent Owner ("PO") acknowledges, the Court in the parallel litigation noted that "refiling [of the motion to stay] shall be permitted within fourteen (14) days following PTAB's institution decision regarding the last of the Asserted Patents to be acted upon the PTAB." MRD-2001, 3. Indeed, in EDTX, motions for stays are routinely granted where all asserted claims are under PTAB review. *See AGIS Software Dev. LLC v. Google LLC*, No. 2:19-cv-361, 2021 WL 465424, at *3 (E.D. Tex. Feb. 9, 2021) ("[W]here the PTAB has instituted IPR proceedings . . . this Court has likewise routinely stayed cases[.]").

Factor 2 is neutral: As PO acknowledges, the district court trial in EDTX and a Final Written Decision in this IPR proceeding is at best scheduled to occur "at nearly the same time." POPR, 28. Further in view of EDTX's growing backlog of cases and Petitioner's offered stipulation, the potential for conflict between the district court case the instant IPR proceeding is minimal.

Factor 3 favors institution: PO's assertion that the parties are "*beginning* to commit substantial resources to the parallel proceedings" can be said of any case in which discovery has commenced. POPR, 29 (emphasis added). However, the majority of the discovery the parties have engaged in relates to Petitioner's motion

to transfer the case to N.D. Cal. Indeed, the only deposition that has occurred so far related to this motion to transfer. The parties are still negotiating on the scope of accused products in the case, and have not yet “commit[ted] substantial resources” to merits-based discovery yet. Fact discovery does not close for another eight months—in July 2025. *See* MRD-2002. Petitioner filed its IPR petition within a week of filing its answer—this case could hardly be in an earlier stage.

Factor 4 favors institution: PO contends that the Petitioner’s stipulation to not seek resolution in the district court of the same grounds presented in this Petition “*does nothing* to narrow the case for the court.” POPR, 30 (emphasis added).

While a *Sotera*-type stipulation would entirely foreclose the possibility of discretionary denial, a *Sand Revolution*-type stipulation as here nevertheless continues to mitigate concerns of duplicative efforts and weigh against denial. *See Samsung Elecs. v. Staton Techiya, LLC*, IPR2022-00281-13, 8 (PTAB July 15, 2022). Ultimately, Petitioner’s stipulation paired with its great diligence in filing this Petition within mere months of the service of complaint greatly mitigate any concerns regarding duplicative efforts between the district court and the PTAB.

Factor 5 is neutral: As noted in the Petition, parties in the litigation are the same.

Factor 6 favors institution: PO’s assertion that “Petitioner does not present a compelling invalidity challenge” (POPR, 32) ignores the robust disclosures of the references in the Petition’s two advanced obviousness grounds. Indeed, the

strength of the cited art, and the Petition’s explanation of its applicability to the Challenged Claims, belies PO’s position.

First, PO’s argument that “Petitioner’s primary reference lacks at least three express claim elements” (POPR, 32) is fundamentally flawed and legally irrelevant. By conflating the distinct requirements of anticipation and obviousness, PO misinterprets the basis of the Petition’s unpatentability grounds.

Obviousness—the position advanced in the Petition—allows multiple references to be combined to reach the elements of the Challenged Claims, whereas anticipation requires reliance on only a single reference. This approach is deliberate: in an obviousness analysis, it is not necessary for any single reference to disclose every claim element. Instead, the focus is on whether the combined teachings render the claimed invention obvious. And this is what has been demonstrated by the Petition’s advancement of the obviousness grounds: the Challenged Claims are obvious over Ohata-Kavan-Gong/Liu and Ohata-Kavan-Ichinose, which necessarily is an acknowledgement that each individual reference, alone, does not reach all elements of the claims.

Second, PO’s assertion that the Petitioner’s grounds rest on mere “possibilities and assumptions on how the cited art might be combined” (POPR, 32) disregards the extensive, corroborated explanations for the Ohata-Kavan-Gong/Liu and Ohata-Kavan-Ichinose combinations that are provided in the

Petition. Indeed, the Petition includes an entire section dedicated to detailing each combination, and another explaining multiple reasons why a POSITA would have pursued the combination and expected success in doing so. *See, e.g.*, Petition, 17-30. In particular, the Petition presented *four* distinct reasons motivating the oxidation of nanotubes in the combinations for both grounds and numerous reasons motivating the use of specific compositions of electrode active material, all bolstered by expert corroboration. *See, e.g., id.*, 21-30. While PO attempts to rebut some of these motivations (*see* POPR, 12-24), its positions lack any evidentiary support, and thus are wholly insufficient to counter the Petition's robust rationales that underpin the Ohata-Kavan-Gong/Liu and Ohata-Kavan-Ichinoise combinations.

Overall, PO's assertions that "Petitioner does not present a compelling invalidity challenge" do not withstand scrutiny. POPR, 32. The strength of the two independent, detailed obviousness grounds, bolstered by extensive argument, expert testimony, and evidentiary support, weighs in favor of institution.

II. §325(d) – *Advanced Bionics* Test Favors Institution

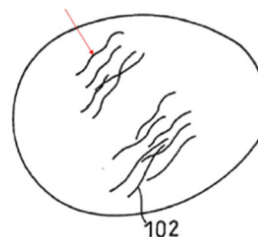
The first prong of the *Advanced Bionics* framework concerns whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office. There is no dispute that the references relied upon in the Petition are different from

the art presented to the Office during prosecution. *See* POPR, 38-39.

The invalidity grounds presented in the Petition are also substantively distinct from those considered by the Examiner during prosecution, and these distinctions were addressed in detail in the Petition. *See, e.g.*, Petition, 6-7. For example, while the “Board agreed with Appellants’ explanation that Li failed to teach ‘discrete, non-agglomerated, and exfoliated carbon nanotubes’ because ‘one cannot even ascertain two ends of even a single nanotube due to the agglomeration and entanglement of the nanotubes,’” (*id.*, 6.), the Petition explained in detail, for instance, how the “unraveled” nanotubes of Ohata are

indeed discrete, non-agglomerated, and exfoliated (see right). Petition, 36; Ohata, Fig. 1(b). Despite that detailed discussion of the vast difference

“discrete, non-agglomerated, and exfoliated carbon nanotubes”



between Li and Ohata, PO nevertheless characterizes these grounds as “rel[ying] on substantially the same art” and contends that the “Board already found...Li suffered from similar deficiencies [as] Ohata.” POPR, 38-39. PO grossly oversimplifies and conveniently ignores the details of the prosecution history and the grounds advanced in the Petition. The challenges raised in the Petition meaningfully differ and are not in any way cumulative to those considered by the Examiner. Instead, the combinations advanced in the Petition demand different factual determinations that were neither asked nor answered during prosecution.

Date: November 8, 2024

/W. Karl Renner/

W. Karl Renner, Reg. No. 41,265

Timothy Riffe, Reg. No. 43,881

Hyun Jin In, Reg. No. 70,014

Gretchen A. DeVries, Reg. No. 72,505

Fish & Richardson P.C.

60 South Sixth Street, Suite 3200

Minneapolis, MN 55402

T: 202-783-5070

F: 877-769-7945

Counsel for Petitioner

CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(4)(i) *et seq.* and 42.105(b), the undersigned certifies that on November 8, 2024, a complete and entire copy of this Petitioner's Reply to Patent Owner's Preliminary Response was provided by email, to the Patent Owner, by serving the correspondence address of record as follows:

Gregory L. Porter
Steven L. Wood
Hunton Andrews Kurth LLP
600 Travis St., Suite 4200
Houston, TX 77002

Email: gregporter@HuntonAK.com
swood@HuntonAK.com

/Hoi Cheung/
Hoi Cheung
Fish & Richardson P.C.
60 South Sixth Street, Suite 3200
Minneapolis, MN 55402
(202) 626-7733