

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

POSCO CO. LTD.,
Petitioner,

v.

ARCELORMITTAL,
Patent Owner.

Case No. IPR2024-01376
U.S. Patent No. 10,961,602

**PATENT OWNER'S SUPPLEMENTARY
RESPONSE RE: *FINTIV***

TABLE OF CONTENTS

	<u>Page</u>
TABLE OF ABBREVIATIONS	iii
TABLE OF EXHIBITS	iv

TABLE OF AUTHORITIES

	<u>Page(s)</u>
Cases	
<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020)	1, 4
<i>Canadian Solar Inc. v. The Solaria Corp.</i> , IPR2021-00659, Paper 14 (PTAB Sept. 30, 2021)	3
<i>Certain High-Strength Aluminum or Aluminum Alloy-Coated Steel, and Automotive Products and Automobiles Containing Same</i> , Inv. No. 337-TA-1402 (ITC)	2
<i>Garmin Int'l, Inc. v. Koninklijke Philips N.V.</i> , IPR2020-00754, Paper 11 (PTAB Oct. 27, 2020)	3
<i>Google LLC v. EcoFactor Inc.</i> , IPR2020-0946, Paper 11 (PTAB Nov. 18, 2020)	2
<i>Hewlett Packard Enter. Co. v. Q3 Networking LLC</i> , IPR2021-00754, Paper 9 (PTAB Oct. 8, 2021)	2
<i>Roku v. Universal Elecs.</i> , IPR2021-00299, Paper 9 (PTAB July 13, 2021)	3
<i>Samsung Elecs. Co. v. Evolved Wireless, LLC</i> , IPR2021-00949, Paper 8 (PTAB Nov. 29, 2021)	4
Statutes	
35 U.S.C. § 314(a)	2

TABLE OF ABBREVIATIONS

Abbreviation	Term
'602 Patent	U.S. Patent No. 10,961,602 (Ex-1001)
'683 Patent	U.S. Patent No. 9,708,683
'683 Patent IPR	IPR2019-01275 (Ex-1031)
Challenged Claims	Claims 1–30 of U.S. Patent No. 10,961,602
Fig.	Figure
IPR	<i>inter partes</i> review
Patent Owner	ArcelorMittal
Petitioner	POSCO Co., Ltd.
POSITA	person[s] of ordinary skill in the art
RPI	Real Party-In-Interest

TABLE OF EXHIBITS

Abbreviation	Term
2001	File History of U.S. Patent No. 10,961,602
2002	Order No. 7 (Procedural Order), <i>Certain High-Strength Aluminum or Aluminum Alloy-Coated Steel, and Automotive Products and Automobiles Containing Same</i> , Inv. No. 337-TA-1402 (ITC), filed April 17, 2024
2003	Excerpted Respondents' Expert Report Regarding Invalidity, <i>Certain High-Strength Aluminum or Aluminum Alloy-Coated Steel, and Automotive Products and Automobiles Containing Same</i> , Inv. No. 337-TA-1402 (ITC), filed April 17, 2024
2004	Excerpted Complainant's Expert Report Rebuttal Report Regarding Validity, <i>Certain High-Strength Aluminum or Aluminum Alloy-Coated Steel, and Automotive Products and Automobiles Containing Same</i> , Inv. No. 337-TA-1402 (ITC), filed April 17, 2024
2005	Excerpted Complainant's Pre-Hearing Brief, <i>Certain High-Strength Aluminum or Aluminum Alloy-Coated Steel, and Automotive Products and Automobiles Containing Same</i> , Inv. No. 337-TA-1402 (ITC), filed April 17, 2024
2006	Excerpted Respondents' Pre-Hearing Brief, <i>Certain High-Strength Aluminum or Aluminum Alloy-Coated Steel, and Automotive Products and Automobiles Containing Same</i> , Inv. No. 337-TA-1402 (ITC), filed April 17, 2024
2007	Excerpted Complainant's Opening Demonstrative Slides, <i>Certain High-Strength Aluminum or Aluminum Alloy-Coated Steel, and Automotive Products and Automobiles Containing Same</i> , Inv. No. 337-TA-1402 (ITC), filed April 17, 2024
2008	Excerpted Respondents' Opening Demonstrative Slides, <i>Certain High-Strength Aluminum or Aluminum Alloy-Coated Steel, and Automotive Products and Automobiles Containing Same</i> , Inv. No. 337-TA-1402 (ITC), filed April 17, 2024

The Patent Office's rescission of the 2022 Guidance Memorandum provides yet another reason to deny institution of the Petition. Under *Fintiv*, the Board should exercise its discretion to deny institution given the late stage of the parallel ITC Investigation involving the '602 Patent and the same prior art references. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020). In *Fintiv*, the Patent Owner requested that the Board exercise discretion to deny institution because of the advanced stage of the parallel district court litigation presenting the same issues. *Id.* at 2. Furthermore, trial in the district court had been set for later that same year. *Id.* In considering whether to deny institution, the Board took a holistic view of "whether efficiency and integrity of the system are best served by denying or instituting review" and enumerated the following factors:

1. whether the court granted a stay or evidence exists that one may be granted if a 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;
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.

Id. Considering the *Fintiv* factors, the efficiency and integrity of the patent system would be best served by denying institution of the Petition here.

Background: Patent Owner and the Real Party-In-Interest (RPI) are currently addressing the validity of the '602 Patent in a parallel ITC Investigation. *See Certain High-Strength Aluminum or Aluminum Alloy-Coated Steel, and Automotive Products and Automobiles Containing Same*, Inv. No. 337-TA-1402 (ITC), filed April 17, 2024. See Ex. 2003; Ex. 2004; Ex. 2005; Ex. 2006; Ex. 2007; Ex. 2008. The hearing for the ITC Investigation started on March 3, 2025. Ex. 2002. The deadline for the initial determination is June 23, 2025 and the target date for the Investigation is October 23, 2025. *Id.*

Discretionary Denial under 35 U.S.C. § 314(a): As detailed below, the *Fintiv* factors favor discretionary denial.

Factor 1 (Possibility of Stay): Factor 1 heavily favors discretionary denial as RPI never requested a stay of the ITC Investigation. *Hewlett Packard Enter. Co. v. Q3 Networking LLC*, IPR2021-00754, Paper 9 at 8–9 (PTAB Oct. 8, 2021). A stay is also unlikely at the late stage of the ITC Investigation, where the evidentiary hearing will end on March 7, 2025. *Google LLC v. EcoFactor Inc.*, IPR2020-0946, Paper 11 at 9–10 (PTAB Nov. 18, 2020); Ex. 2002.

Factor 2 (Relative Schedules): Factor 2 also heavily favors discretionary denial. The evidentiary hearing for the ITC Investigation started on March 3, 2025 and will end on March 7, 2025, and the target date for completion of the ITC Investigation is October 23, 2025. Ex. 2002. On the other hand, the statutory

deadline for the Board's final written decision is March 24, 2026, which is more than five months after the October 23, 2025 target date for the ITC's final determination. *Garmin Int'l, Inc. v. Koninklijke Philips N.V.*, IPR2020-00754, Paper 11 at 12 (PTAB Oct. 27, 2020) (factor 2 weighs against institution when target date pre-dated Board's final written decision by four months).

Factor 3 (Investment in Parallel Litigation): Factor 3 heavily favors discretionary denial as the parties have progressed through fact and expert discovery and will complete the evidentiary hearing on March 7, 2025. *Canadian Solar Inc. v. The Solaria Corp.*, IPR2021-00659, Paper 14 at 10–12 (PTAB Sept. 30, 2021).

Factor 4 (Extent of Overlap): Factor 4 heavily favors discretionary denial. RPI asserted the same prior art references at the ITC. *Compare* Ex. 2003 (referencing Engels, Cornette, Laurent, Takagi, Hein, and GMW14400 as prior art); Ex. 2006 (same references); Ex. 2008 (referencing Engels, Cornette, Takagi as prior art) *with* *POSCO Co. Ltd. v. ArcelorMittal*, IPR2024-01377, Paper 1 at 38–86 (PTAB Sept. 6, 2021) (referencing Engles, Cornette, Laurent, Takagi, Hein, and GMW14400 as prior art). For example, RPI's expert report asserts the same invalidity grounds being asserted in the Petition. *See* Ex. 2003. Although after the parties completed expert discovery, RPI belatedly revised some of its invalidity grounds and dropped one secondary reference (Nishibata), that does not change the exact overlap that existed in the ITC Investigation. *See Roku v. Universal Elecs.*,

IPR2021-00299, Paper 9 at 15–16 (PTAB July 13, 2021). And even in its pre-hearing brief and opening demonstrative slides, a substantial overlap still exists: RPI continues to discuss Engels, Cornette, Laurent, Takagi, Hein, and GMW14400, including asserting invalidity grounds based on Engels and Takagi. *See* Ex. 2006; Ex. 2008. As a result, an exact overlap existed, and a substantial overlap continues to exist, meaning Factor 4 weighs heavily in favor of discretionary denial.

Factor 5 (Parties): Factor 5 weighs in favor of discretionary denial as both Patent Owner and RPI are parties to the ITC Investigation. *Fintiv*, IPR2020-00019, Paper 11 at 15 (“Because the petitioner and the defendant in the parallel proceeding are the same party, this factor weighs in favor of discretionary denial.”).

Factor 6 (Other compelling circumstances): Factor 6 also weighs in favor of denying institution, as the merits of the Petition are weak. As set forth in Patent Owner’s Preliminary Response and Patent Owner’s Preliminary Sur-Reply, the Petition does not meet the “reasonable likelihood” standard for institution, much less the much higher “compelling merits” standard. *See Samsung Elecs. Co. v. Evolved Wireless, LLC*, IPR2021-00949, Paper 8 at 17–20 (PTAB Nov. 29, 2021).

Conclusion: Accordingly, all six *Fintiv* factors support denying institution.

DATED: March 6, 2025

Respectfully Submitted,

/ Brian M. Buroker /

Brian M. Buroker (Reg. No. 39,125)
GIBSON, DUNN & CRUTCHER LLP

Patent Owner's Supplementary Response
U.S. Patent No. 10,961,602

1700 M St. NW
Washington, D.C. 20036
Phone: (202) 955-8500
Fax: (202) 467-0539
Email: bburoker@gibsondunn.com

Benjamin Hershkowitz (Reg. No. 41,833)
Gibson, Dunn & Crutcher LLP
200 Park Avenue
New York, NY 10166
Phone: (212) 351-4000
Email: bhershkowitz@gibsondunn.com

Mark Reiter (Reg No. 35,785)
Gibson, Dunn & Crutcher LLP
2001 Ross Avenue Suite 2100
Dallas, TX 75201
Phone: (214) 698-3400
Email: mreiter@gibsondunn.com

Allen Kathir
(pro hac vice forthcoming)
Gibson, Dunn & Crutcher LLP
200 Park Avenue
New York, NY 10166
Phone: (212) 351-4000
Email: akathir@gibsondunn.com

Counsel for Patent Owner

CERTIFICATE OF SERVICE

The undersigned certifies service pursuant to 37 C.F.R. § 42.6 of a copy of this Patent Owner's Preliminary Sur-Reply upon Petitioner by email on March 6, 2025, to the following email addresses of record:

IPR58281-0002IP1@fr.com

DATED: March 6, 2025

By: /Brian M. Buroker/

Brian M. Buroker (Reg. No. 39,125)
GIBSON, DUNN & CRUTCHER LLP
1700 M St. NW
Washington, D.C. 20036
Phone: (202) 955-8500
Fax: (202) 467-0539
Email: bburoker@gibsondunn.com

Counsel for Patent Owner