UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

POSCO CO. LTD.,
Petitioner,

v.

ARCELORMITTAL,
Patent Owner.

Case No. IPR2024-01377
U.S. Patent No. 11,326,227

PATENT OWNER'S PRELIMINARY SUR-REPLY TO PETITIONER'S REPLY

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Abbreviation	Term
'227 Patent	U.S. Patent 11,326,227
'602 Patent	U.S. Patent No. 10,961,602
'683 Patent	U.S. Patent No. 9,708,683
'683 Patent IPR	IPR2019-01275 (Ex-1031)
Challenged Claims	Claims 1–25 of U.S. Patent No. 11,326,227
Fig.	Figure
IPR	*inter partes* review
Patent Owner	ArcelorMittal
Petitioner	POSCO Co., Ltd.
POSITA	person[s] of ordinary skill in the art

TABLE OF EXHIBITS

Abbreviation	Term
2001	File History of U.S. Patent No. 10,961,602

I. PETITIONER'S PRELIMINARY REPLY FURTHER CONFIRMS THE BOARD SHOULD DENY INSTITUTION UNDER § 325(D)

Petitioner's Reply fails to show that *Advanced Bionics*'s two-part test is not satisfied and therefore, the Board should deny institution under § 325(d). As to part one of that test, Petitioner's Reply concedes that all seven references in Petitioner's Grounds were before the Patent Office and thus, that step is clearly satisfied. *See generally* Reply, 1-5. As to part two of that test, Petitioner's new arguments in reply still do not show that the Patent Office materially erred during prosecution of the '227 Patent and thus, part two is also satisfied. To obscure this, Petitioner mischaracterizes arguments made during prosecution and also omits key parts of the prosecution of the '227 Patent, '602 Patent and related '683 Patent. But reviewing the full history behind Petitioner's arguments shows that the Patent Office did not materially err.

Grounds 1A-1G (Engels): Petitioner's arguments about the Patent Office's consideration of Engels narrowly focuses on selected portions of the prosecution history to the exclusion of other important portions. Reply, 1-2. Engels was disclosed to the Patent Office at least *three* different times during the prosecution histories of the related '602 and '683 Patents. It was disclosed twice during the prosecution of the '602 Patent and once during the '683 Patent IPR. Petitioner's Reply, however, focuses only on the disclosure of Engels during the prosecution of

the '227 Patent, ignores the disclosures of Engels during the '602 Patent prosecution, and minimizes and mischaracterizes the disclosure during the '683 Patent IPR.

First, Petitioner omits that Engels was submitted two times to the Patent Office during the prosecution of the '602 Patent. Notably, on July 8, 2019, the applicants disclosed Engels a second time in a supplemental Information Disclosure Statement (IDS). Ex-2001, 723-24. This supplemental IDS had only 31 references. And, as part of that submission, the applicants also expressly informed the Examiner of the '683 Patent IPR, which also used Engels as a reference, as explained below. EX-2001, 726. On July 10, 2020, the Examiner reviewed this information. EX-2001, 914-922, 936. When the Examiner reviewed Engels the second time, the Examiner knew the scope of the claims and then even issued a final office action rejecting the pending claims. Simply put, Petitioner failed to consider and address the full prosecution history of the related patents.

For this reason, Petitioner's citations to *Samsung Elecs.* and *Tokyo Ohka Kogyo Co.* are distinguishable. Reply, 3. Unlike *Samsung Elecs*. and *Tokyo Ohka*, here, the Examiner considered Engels during the prosecution of related patents and in conjunction with a much smaller number of references: an IDS containing just 31 references and the '683 Patent IPR where it was just one of seven references.

Second, Petitioner's Reply tries to minimize the '683 Patent IPR by arguing, inaccurately, that it has little relevance to the Board's 325(d) analysis. Reply, 2. But

Petitioner's Reply lacks any legal citation and indeed, contradicts the law. Section 325(d) expressly allows the Board to deny institution because of arguments "previously [] presented to the [Patent and Trademark] Office." 35 U.S.C. § 325(d). The plain text of Section 325(d) allows for the consideration of relevant arguments made to the Patent Office and is not limited to arguments made solely to an examiner involving the specific patent at issue. Consistent with that, the Board has routinely considered the file histories of related patents. POPR, 7; *see also II-VI, Inc. v. Soto*, IPR2021-01359, Paper 10, 18-19 (PTAB Feb. 15, 2022).

After trying to downplay the relevance of the '683 Patent IPR, Petitioner argues that, in any event, the '683 Patent IPR included no discussion of the teachings for which Petitioner uses Engels in this proceeding (i.e., for Engels's layers and coating thickness being greater than 30 μm). Reply, 2. But this also is not so. The '683 Patent IPR petition discussed Engels and even excerpted Figure 5, the same Figure that Petitioner relies on and refers to repeatedly as the basis of the Petition in this proceeding. EX-1031, 25, 76-77 (showing Figure 5). The '683 Patent IPR describes how Engels allegedly is "composed of a succession of coating layers" and has a coating thickness that is "approximately 40 μm thick"—again the same alleged disclosure of elements that Petitioner relies on now. *Compare id., with* Pet., 21-22. Petitioner also re-argues again in Reply as in the Petition (and again inaccurately) that the Examiner's failure to issue a rejection involving Engels somehow means

that the Examiner erred. Reply, 4; Pet., 86-87. But simply because an Examiner did not use a reference in a rejection does not mean the Examiner erred. POPR, 5-6.

Advanced Bionics also requires the Petitioner to demonstrate what additional evidence exists in the Petition that warrants reconsideration. POPR, 7-8. Petitioner's Reply still fails to explain what additional evidence exists. Instead, Petitioner argues the Board should not deny institution under 325(d) by mischaracterizing Patent Owner's argument against Engels as "requir[ing] a narrow interpretation of the claimed superficial layer." Reply, 4. Patent Owner advanced no narrowing interpretation; Patent Owner explained how Petitioner's interpretation of "superficial" layer is *inconsistent* with its mapping of Engels. POPR, 11-15. Indeed, Petitioner's Reply does not dispute that the measurements in Engels' Table for phase number five do not correspond to a layer that is at the surface in Engels's Figure 5. Petitioner also suggests that Patent Owner is relying on an "undisclosed" phase. Reply, 4. This also is not so. Patent Owner noted that Engels's disclosures and Petitioner's view of the claims are inconsistent and irreconcilable. POPR, 11-15. Petitioner cannot avoid this by ignoring that the measurements in Engels' Table clearly show that Engels did not view Phase 5 as extending to the surface. *Id*.

Grounds 2A-2C (Takagi): Petitioner does not dispute that Takagi was discussed during the prosecution of the '602 and '683 Patents. Reply, 2-3; POPR, 7. Nevertheless, Petitioner seeks to undermine this discussion because, during the

prosecution of the '602 Patent, the applicants, not the Examiner, initially discussed Takagi. Reply, 2-3. The *Advanced Bionics* analysis does not turn on who initially discusses a reference. The proper analysis here turns on whether the reference was before the Patent Office (and here it was). *Microsoft Corp. v. AlmondNet, Inc.*, IPR2022-01319, Paper 9, 11 (PTAB Jan. 30, 2023). More importantly, Petitioner overlooks *why* the applicants discussed Takagi. During the prosecution of the '683 Patent, the Examiner issued a final rejection involving Takagi which was reversed by the Board. Ex-2001, 912-13; *POSCO v. ArcelorMittal.*, IPR2019-01275, Ex-1002, 197-211, 437-442 (PTAB June 28, 2019). Petitioner also argues that Takagi was not "considered" in combination with Hein or GMW14400. Reply, 4. Petitioner has no evidence that the Examiner did not consider these references in combination; all three references were before the Examiner, and Petitioner never explains why the Examiner's decision not to combine these references is erroneous. POPR, 5-8.

Finally, in addressing Section 325(d) in the Petition, Petitioner did not explain the specific evidence that warranted reconsideration of the Examiner's decision and appeared to, impermissibly, rely on its Petition in general. Pet., 86-87; POPR, 7-8. Petitioner's Reply now specifically points to pages 61-65 of its Petition for why reconsideration is warranted and faults Patent Owner for not addressing this argument. Reply, 4-5. Yet, Patent Owner could not have addressed a Section 325(d) argument that was not previously raised. Nevertheless, Petitioner's nascent

argument—that three different references would be combined based on "experimentation"—does not show that reconsideration is warranted. Pet., 64. The Examiner reasonably could have concluded that there was not a rationale for combining disparate references, and Petitioner's argument does not suggest otherwise. *Advanced Bionics*, IPR2019-01469, Paper 6, 9 ("If reasonable minds can disagree regarding the purported treatment of the art or arguments, it cannot be said that the Office erred in a manner material to patentability. At bottom, this framework reflects a commitment to defer to previous Office evaluations of the evidence of record unless material error is shown.").

II. GMW14400 WAS NOT PUBLICLY AVAILABLE BEFORE THE CRITICAL DATE

Petitioner's Reply does not fix its failure to show that GMW14400 was publicly available before the patent's filing date of October 30, 2006. GMW14400 was allegedly published in November 2005, and so, Petitioner needed to provide evidence showing GMW14400 was publicly available between that date and October 30, 2006. Ex-1027, 23. Instead of doing that, Petitioner relied on Internet Archive screenshots of webpages from 2003. POPR, 21-24. Screenshots from 2003 do not provide information about what was on those websites after November 2005, or how those websites functioned after November 2005. *Id*. Petitioner's alleged evidence is from the wrong year and insufficient to show public availability. *Id*.

Nevertheless, Petitioner argues that the Board should still institute because

institution requires only a "reasonable likelihood" that GMW14400 was publicly available before the critical date. Reply, 8. Even the "reasonable likelihood" standard requires more than what was set forth in the Petition. Before institution, "a petitioner is required to present evidence and arguments sufficient to show that it is reasonably likely that it will prevail in showing the unpatentability of the challenged claims." *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29, 13 (PTAB Dec. 20, 2019) (precedential). "[T]he petition must identify, with particularity, evidence sufficient to establish a reasonable likelihood that the reference was publicly accessible before the critical date." *Id*. "'There is no presumption in favor of finding that a reference is a 'printed publication.'" *Id*., 16. Here, Petitioner's evidence does not provide *any* information about whether GMW14400 was publicly available after its alleged publication date, because Petitioner only provided evidence about webpages from 2003, without providing any information about what was *later* on those webpages *after* GMW14400's alleged publication date. *AT&T Mobility LLC v. Daingean Techs. Ltd.*, IPR2024-00644, Paper 9, 12-13 (PTAB Oct. 10, 2024) (denying institution because "no evidence" that prior art reference was accessible "during [relevant] time frame").[1]

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[1] Petitioner's cases are distinguishable because none involves finding public availability using evidence from the wrong time frame; Petitioner has not cited any case where an IPR was instituted when it was shown the evidence of public availability was from the wrong time frame.

Petitioner's alleged evidence of public availability is also based on unfounded speculation. Petitioner's assertion that IHS's standards database was "indexed and searchable" is not based on evidence from someone with knowledge—it is instead based on a librarian who speculates about the functionality of a website from 2003 based on Internet Archive screenshots. Reply, 6 (citing Ex-1027); POPR, 21-22.[2]

Finally, the Reply cobbles together disparate statements in an attempt to show that a POSITA would have known about IHS. Reply, 6-7. For example, the Reply attempts to rely on Dr. Miles for public availability even though he never discusses IHS, its website, the Munford declaration, or the public availability of GMW14400. *See* Ex-1003. The Reply also tries to rely on statements about standards, Reply, 7, but these relate to technical standards generally, and say nothing about whether an interested person would have known to look at IHS specifically for GMW14400. Finally, there is also no evidence that a POSITA would have known about the specific URLs in the Petition. POPR, 19-21. Thus, Petitioner has not shown that GMW14400 was publicly available.

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[2] Petitioner attempts to shift the burden of proof to Patent Owner. Reply, 8 (arguing Patent Owner has not shown a difference between the 2003 and 2005 websites). In an IPR, the Petitioner always bears the burden of proof. *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016).

DATED: January 28, 2024

Respectfully Submitted,

/ 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

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 January 28, 2024, to the following email addresses of record:

IPR58281-0003IP1@fr.com

DATED: January 28, 2024

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