

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SOLUS ADVANCED MATERIALS CO., LTD.,
Petitioner,

v.

SK NEXILIS CO., LTD.,
Patent Owner.

IPR2024-01460
Patent 10,480,090 B2

Before JOHN G. NEW, JO-ANNE M. KOKOSKI, and
JON B. TORNQUIST, *Administrative Patent Judges*.

TORNQUIST, *Administrative Patent Judge*.

DECISION
Denying Petitioner's Request for Rehearing
of Decision Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Solus Advanced Materials Co. (“Petitioner”) filed a Request for Rehearing (Paper 15, “Req.” or “Request”) of our Decision (Paper 14, “Dec.”) discretionarily denying institution of *inter partes* review of claims 1–11 of U.S. Patent No. 10,480,090 B2 (Ex. 1001, “the ’090 patent”) in the above-identified proceeding.

In the Decision, we denied the Petition (Paper 2) after a holistic review of the six factors outlined in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5–16 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”); Dec. 31–32. Of particular note, we determined that the Petition “presents, at best, a close call on the merits,” which, when viewed in combination with the other *Fintiv* factors, including a trial date that would occur roughly six months before a final written decision would issue in this proceeding, counseled in favor of discretionary denial. Dec. 31–32. Petitioner contends our conclusion with respect to the merits and the expected trial date were erroneous and, therefore, the *Fintiv* factors, when considered as a whole, counsel against discretionary denial. Req. 2, 6.

For the reasons that follow, Petitioner’s Request is denied.

II. STANDARD OF REVIEW

When rehearing a decision on institution, we do not review the merits of the decision *de novo*, but instead review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion may be determined “if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors.” *Arnold Partnership v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004) (citing *In re*

Gartside, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000)). The party requesting rehearing has the burden to show that the decision should be modified.

37 C.F.R. § 42.71(d). Additionally, the request for rehearing “must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.” *Id.*

III. ANALYSIS

A. *Expected Trial Date*

Trial with respect to the ’090 patent in the Eastern District of Texas is scheduled to begin November 3, 2025. Paper 8, 10 (citing Ex. 2005, 1). Had we instituted *inter partes* review, the final written decision in this case would have been due on or before April 23, 2026, roughly 6 months *after* the start of trial in the district court. *Id.* And, even if the median time-to-trial statistics of the Eastern District of Texas are used (21.9 months), Patent Owner contends that the predicted trial date would still be mid-September 2025, earlier than the scheduled trial date. *Id.* at 11 (citing Ex. 2006, 35; Ex. 2007, 33 (complaint filed November 21, 2023)).

In its reply to the preliminary response, Petitioner asserted that the median time-to-trial statistics had since increased from 21.9 months to 23.0 months. Paper 9, 1. Patent Owner responded that the cited statistics would place the start of trial in mid-October, “*still before* the November 3, 2025 scheduled trial date” and roughly 6 months before a final written decision would issue in this proceeding. Paper 10, 1 (citing Ex. 2005, 1).

In its supplemental briefing, and relying on Patent Owner’s own briefing, Petitioner asserts that the revised median time-to-trial statistics demonstrate that the final written decision “would follow trial by ***less than 1***

month.” Paper 13, 1 (citing Paper 12, 1). In the Decision, we noted that the evidence presented by Patent Owner only demonstrates that the scheduled *trial date* (November 3, 2025) would follow the *predicted trial date* calculated using the median time-to-trial statistics (mid-October) by less than 1 month. Dec. 16 n.11. In either situation, the final written decision (April 23, 2026) would issue roughly 6 months after the start of trial. *Id.* at 16.

In its Request, Petitioner summarily maintains, without explanation or calculations, that the final written decision “would follow median time-to-trial statistics by less than 1 month.” Req. 6 n.3. Given the absence of any detailed explanation from Petitioner as to how it arrived at that conclusion, however, we are not persuaded that we misapprehended or overlooked the proximity of the trial date to the projected final written decision date.

B. *Fintiv* Analysis

The Request asks that we reconsider our analysis of the *Fintiv* factors and, in particular, our determination that the information presented in the Petition did not establish a particularly strong challenge with respect to the proposed combinations of Shinozaki,¹ Sano,² or Dobashi.³

In IPR2024-01463, the Board found—with respect to essentially identical operative facts regarding *Fintiv* factors 1–5—that discretionary denial was not appropriate. *Solus Advanced Materials Co. v. SK Nexilis Co.*, IPR2024-01463, Paper 14 (PTAB April 25, 2025). This conclusion was reached primarily because the panel found that the petition presented “a

¹ US 2013/0108922 A1, published May 2, 2013. Ex. 1004 (“Shinozaki”).

² US 2006/0191798 A1, published August 31, 2006. Ex. 1008 (“Sano”).

³ US 2009/0047539 A1, published February 19, 2009. Ex. 1007 (“Dobashi”).

particularly strong patentability challenge.” *Id.* at 18. This decision was reversed by the Director on rehearing, with the Director determining that a strong merits challenge did “not outweigh the other [*Fintiv*] factors.” *Solus Advanced Materials Co. v. SK Nexilis Co.*, IPR2024-01463, Paper 20 at 2 (Director PTAB July 2, 2025). Although we disagree with Petitioner that we misapprehended or overlooked any arguments in the Petition with respect to the strength of the merits challenge, given that *Fintiv* factors 1–5 are essentially identical between IPR2024-01463 and this proceeding, even if we were to agree with Petitioner that the Petition presented a particularly strong merits challenge, discretionarily denial would still be appropriate in view of the Director’s decision in IPR2024-01463.

IV. CONCLUSION

We reviewed and considered the arguments in Petitioner’s Request, and conclude that Petitioner does not carry its burden of demonstrating that we abused our discretion in denying institution of *inter partes* review of the challenged claims of the ’090 patent. 37 C.F.R. § 42.71(d).

V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner’s Request for Rehearing is *denied*.

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Patent 10,480,090 B2

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