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

Case IPR2024-01463
U.S. Patent No. 11,591,706

PATENT OWNER'S SUPPLEMENTAL BRIEF

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Just over one week ago, Acting Director Stewart granted Director Review, vacated a panel's institution decision, and denied institution under *Fintiv*—in part because the panel "gave too much weight to Petitioner's *Sotera* stipulation." *Motorola Solutions, Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 2-4 (P.T.A.B. Mar. 28, 2025). The Order noted that "Petitioner's stipulation does not ensure that th[is] IPR proceeding[] would be a 'true alternative' to the district court proceeding," and its stipulation did not outweigh the other factors. *Id.*, 3-4. That is precisely the case here.

Here, as in *Motorola*, Petitioner's invalidity contentions include combinations of the asserted art with other system art, "which Petitioner's stipulation is not likely to moot." *Id.*, 4; EX2010, 7-8 (listing 32 different prior art systems), 87 (identifying system art in combination with other references as allegedly rendering the '706 patent obvious). And as in *Motorola*, "[c]onsidering the *Fintiv* factors as a whole, the efficiency and integrity of the system are best served by denying review." *Motorola*, IPR2024-01205, Paper 19 at 4.

Weighing all *Fintiv* factors, the Petition should be denied and the recent Order in *Motorola* confirms that Petitioner's *Sotera* stipulation should not outweigh the other factors.

Respectfully submitted,

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/Michael D. Specht/

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CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e))

I certify that the above-captioned **PATENT OWNER'S SUPPLEMENTAL BRIEF** was served in its entirety on April 8, 2025, upon the following party via electronic mail:

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