

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 IPR2025-00005
U.S. Patent No. 9,457,541

**PATENT OWNER'S SUR-REPLY IN SUPPORT OF
PATENT OWNER'S PRELIMINARY RESPONSE**

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PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
2001	Defendants' Motion to Stay, <i>SK nexilis Co., Ltd. v. Solus Advanced Materials Co., Ltd. et al.</i> , No. 2:23-cv-00539 (E.D. Tex. Oct. 24, 2024)
2002	Plaintiff's Opposition to Defendants' Motion to Stay, <i>SK nexilis Co., Ltd. v. Solus Advanced Materials Co., Ltd. et al.</i> , No. 2:23-cv-00539 (E.D. Tex. Nov. 7, 2024)
2003	Defendants' Reply in Support of Motion to Stay, <i>SK nexilis Co., Ltd. v. Solus Advanced Materials Co., Ltd. et al.</i> , No. 2:23-cv-00539 (E.D. Tex. Nov. 14, 2024)
2004	Plaintiff's Sur-Reply in Opposition to Defendants' Motion to Stay, <i>SK nexilis Co., Ltd. v. Solus Advanced Materials Co., Ltd. et al.</i> , No. 2:23-cv-00539 (E.D. Tex. Nov. 21, 2024)
2005	Amended Docket Control Order, <i>SK nexilis Co., Ltd. v. Solus Advanced Materials Co., Ltd. et al.</i> , No. 2:23-cv-00539 (E.D. Tex. Jan. 2, 2025)
2006	Federal Court Management Statistics (December 31, 2024)
2007	Complaint, <i>SK nexilis Co., Ltd. v. Solus Advanced Materials Co., Ltd. et al.</i> , No. 2:23-cv-00539 (E.D. Tex. Nov. 21, 2023)
2008	Results charted from DocketNavigator.com, run on January 5, 2025, for Success of Motion to Transfer Venue for Convenience Decided by Judge Rodney Gilstrap
2009	<i>Intentionally Left Blank</i>
2010	Defendants' P.R. 3-3 Invalidity Contentions, <i>SK nexilis Co., Ltd. v. Solus Advanced Materials Co., Ltd. et al.</i> , No. 2:23-cv-00539 (E.D. Tex. Aug. 23, 2024) (including Apps. A6, A7, A16)
2011	Appendix B – Secondary References Chart

Exhibit No.	Description
2012	Overview of U.S. Pat. Appl. Publ. No. 2004/0029006 to Otsuka <i>et al.</i> , accessed February 21, 2025 at: https://worldwide.espacenet.com/patent/search/family/031492129/publication/US2004029006A1?q=pn%3DUS2004029006A1
2013	June 14, 2005 Office Action in U.S. Pat. Appl. No. 10/628,264
2014	U.S. Pat. No. 5,834,140 to Wolski <i>et al.</i>
2015	Overview of U.S. Pat. Appl. Publ. No. 2009/0061326 to Hirose <i>et al.</i> , accessed February 21, 2025 at: https://worldwide.espacenet.com/patent/search/family/040288812/publication/US2009061326A1?q=pn%3DUS2009061326A1
2016	Overview of U.S. Pat. Appl. Publ. No. 2010/0038115 to Matsuda <i>et al.</i> , accessed February 21, 2025 at: https://worldwide.espacenet.com/patent/search/family/037073506/publication/US2010038115A1?q=pn%3DUS2010038115A1

I. INTRODUCTION

Other than providing a *Sotera* stipulation—which is no longer dispositive—Petitioner’s Reply adds nothing. The Board should exercise its discretion to deny institution under *Fintiv* and Section 325(d).

II. THE *FINTIV* FACTORS FAVOR DENIAL

Factor 1 is neutral: Parties agree factor 1 is neutral. POPR, 11; Reply, 1.

Factor 2 strongly favors denial: POPR, 11-14. The scheduled trial date remains nearly seven months before the projected FWD deadline of May 25, 2026. Petitioner argues the median time-to-trial increased by 1.1 months to 23.0 months, which shows “the potential for conflict between the district court case and the instant IPR proceeding is minimal.” Reply, 1. They are wrong. The POPR noted that the median time-to-trial was 23.0 months. POPR, 12. Nothing has changed. More importantly, the potential for conflict is actually very high given that even using the most favorable metric available, the estimated trial date would be mid-October 2025, which is still *before* the November 3, 2025 scheduled trial date. POPR, 12.

Factor 3 favors denial: POPR, 14-15. Petitioner does not address the significant amount of resources that have or will have been expended before institution. Rather, Petitioner argues “the instant Petition was filed within four months of PO’s amended complaint of May 15, 2024.” Reply, 1. But, the Petition

challenges only four claims, *see* Pet., 1-2, and Petitioner still provides no explanation of *how* it was diligent. POPR, 15.

Factor 4 favors institution: In view of Petitioner’s *Sotera* stipulation, factor 4 favors institution. However, the Office’s June 21, 2022 *Fintiv* Memo has been rescinded, and a *Sotera* stipulation is no longer itself dispositive but must be considered as part of the holistic analysis under *Fintiv*. *See* Guidance on USPTO’s rescission of “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation” (March 24, 2025) (“*Fintiv* Guidance”) at 2-3. Where, as here, the other *Fintiv* factors favor denial, Petitioner’s *Sotera* stipulation does not outweigh these other factors. *See, e.g., Cisco Sys., Inc. v. Estech Sys., Inc.*, IPR2021-00333, Paper 12 at 12-13 (P.T.A.B. July 7, 2021) (denying institution even with *Sotera* stipulation; distinguishing *Sotera*, noting that in *Sotera* the trial date factor was neutral and the investment factor weighed against denial).

In fact, “Petitioner’s stipulation does not ensure that th[is] IPR proceeding[] would be a ‘true alternative’ to the district court proceeding.” *Motorola Solutions, Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 3-4 (P.T.A.B. Mar. 28, 2025) (on Director review; vacating panel’s institution decision and denying under *Fintiv*). 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), 34 (identifying system art in combination with other references as allegedly rendering the ’541 patent obvious).

Factor 5 favors denial: Petitioner contends factor 5 is neutral. Reply, 2. But Board precedent makes clear that when the parties are the same, factor 5 favors denial. *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 19 (P.T.A.B. Dec. 1, 2020) (precedential as to § II.A).

Factor 6 favors denial: Petitioner contends factor 6 favors institution. Reply, 2-3. But Petitioner has not shown the merits are compelling, *see* POPR, 17-18, and even if they had “compelling merits alone is not dispositive in making the [*Fintiv*] assessment.” *Fintiv* Guidance, 3. Here, Petitioner has failed even to establish a reasonable likelihood of prevailing, POPR, 32-48, even when relying on art and arguments that have been presented previously to the Office. POPR, 18-25. But even if the Board determines otherwise, factor 6 is simply neutral. *See Sotera*, IPR2020-01019, Paper 12 at 20 (where Petitioner had demonstrated a reasonable likelihood that it would prevail, “this factor [did] not weigh for or against denying institution in this case.”).

III. § 325(D) FAVORS DENIAL

In its Reply, Petitioner only substantively addresses the *Advanced Bionics* factors for Ground 3. Reply, 3-4. In particular, Petitioner makes two arguments for

why the art cited in Ground 3 is not the same or substantially the same as the art considered by the Office during prosecution.

First, Petitioner argues that Ground 3 includes three items that raise distinct factual and legal issues not previously before the Office—(1) calculated TC ratios from Hirose, (2) Hara’s weight deviation disclosures, and (3) Otsuka’s tensile strength disclosures. Reply, 3. These three items do not raise new issues. The fact that the Petition provided TC ratio calculations is not relevant for determining whether the Office considered Hirose during prosecution. The entirety of Hirose’s disclosure, including FIGs. 11A and 11B cited by Petitioner, was directly in front of the Examiner. Further, as discussed on pages 23-25 of the POPR, Hara’s weight deviation and Otsuka’s tensile strength disclosures are entirely cumulative to art and arguments considered during prosecution. Nothing in Petitioner’s Reply establishes otherwise.

Second, Petitioner argues that Hara “bolsters the teachings of Hirose in the combinations as set forth by providing express disclosures regarding the prevention of wrinkle formation.” Reply, 4. Not true. Petitioner overstates what Hara discloses. Hara only mentions wrinkles once, in passing, in paragraph [0008]. Hara does not teach how to design a copper foil to prevent wrinkle formation, much less does Hara teach that weight deviation has any particular effect on wrinkle formation.

Petitioner's art and arguments are the same or substantially similar to the art and arguments expressly considered and overcame during prosecution. And Petitioner fails to establish that the Office erred during prosecution. This warrants denial under §325(d) in the present case. *See Ecto World, LLC v. RAI Strategic Holdings, Inc.*, IPR2024-01280, Paper 10 at 11-12 (P.T.A.B. Mar. 6, 2025) (denying institution where Board found that Petitioner "failed to address the second prong of *Advanced Bionics*, much less show that the Examiner erred in a manner material to patentability.").

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing **PATENT OWNER'S
SUR-REPLY IN SUPPORT OF PATENT OWNER'S PRELIMINARY
RESPONSE** was served electronically via e-mail on March 31, 2025, in its
entirety on the following counsel of record for Petitioner:

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