IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of:	Pascal DRILLET et al.	
U.S. Patent No.:	11,326,227	Attorney Docket No.: 58281-0003IP2
Issue Date:	May 10, 2022	
Appl. Serial No.:	17/319,306	
Filing Date:	May 13, 2021	
Title:	Coated Steel Strips, Coated Stamped Products and Methods	

Mail Stop Patent Board
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

PETITIONER'S NOTICE RANKING PETITIONS AND EXPLAINING MATERIAL DIFFERENCES BETWEEN PETITIONS FOR U.S. PATENT NO. 11,326,227

Petitioner is filing two Petitions challenging the validity of claims of U.S. Patent No. 11,326,227 ("the '227 Patent"). Pursuant to the Board's July 2019 Trial Practice Guide Update, Petitioner submits this paper to "identify: (1) a ranking of the Petitions in the order in which it wishes the Board to consider the merits…, and (2) a succinct explanation of the differences between the Petitions, why the issues addressed by the differences are material, and why the Board should exercise its discretion to institute additional petitions." TPG, 59-60.

I. Ranking of Petitions

Although Petitioner believes that both Petitions are meritorious and justified, Petitioner requests that the Board consider the Petitions in the following order:

Rank	Petition	Primary Grounds
1	IPR2024-01377	Engels Takagi, Hein, GMW14400
2	IPR2025-00371	Takagi, Cornette/GMW14400 Suehiro, Cornette/GMW14400

II. Material Differences Between the Petitions

The Board has recognized "that there may be circumstances in which more than one petition may be necessary." TPG, 59. One of the examples provided by the Board for justifying the institution of multiple petitions is a "dispute about priority date." *Id*. In these proceedings, the priority date accorded to the '227 Patent has potential for dispute. As background, the '227 Patent includes a priority

claim to multiple applications, the earliest of which was filed on October 30, 2006. However, in co-pending litigation before the International Trade Commission ("ITC"), Patent Owner has alleged an invention date of December 2005. EX-1057, 1. Patent Owner's allegation of the December 2005 invention date occurred on November 1, 2024, over six months after the April 17, 2024 filing date of Patent Owner's ITC complaint and nearly two months after the September 6, 2024 filing date of the first petition challenging the '227 Patent in IPR2024-01377. *Id.* Additionally, during IPR proceedings for U.S. Patent No. 9,708,683 (a parent to the '227 Patent), Patent Owner did not allege an earlier invention date, despite facing prior art dated after December 2005—including the same Engels reference advanced in the first petition challenging the '227 Patent. EX-1029, 6-7.

With this background, Petitioner had no reason to anticipate Patent Owner's allegation of an earlier invention date for the '227 Patent when Petitioner filed its first petition challenging the '227 Patent. Upon learning of Patent Owner's allegation, Petitioner promptly began preparation of a second petition challenging the '227 Patent that relied only on prior art that pre-dates Patent Owner's alleged December 2005 invention date and filed it in less than two months, before Patent Owner's preliminary response to the first petition challenging the '227 Patent. Thus, despite Patent Owner's delay in alleging an earlier invention date, Petitioner promptly filed its second, parallel petition challenging the '227 Patent.

Further, the petitions challenging the ’227 Patent are materially different because they rely on different prior art with different dates. Specifically, Petition 1 applies prior art (Engels, Hein) that qualifies as prior art to October 30, 2006, but does not qualify as prior art to December 2005. Accordingly, Petition 1 is valid if Patent Owner is held to a priority date of October 30, 2006 and rightfully prevented from reaching back to an invention date of December 2005. In contrast, all prior art asserted in Petition 2 qualifies as prior art to December 2005. With these material differences, two petitions are necessary to account for Patent Owner’s allegation of an earlier invention date.

For the above reasons, the present circumstance is consistent with the example in the July 2019 Trial Practice Guide Update (pg. 59), where “the Board recognizes that there may be circumstances in which more than one petition may be necessary, including, for example, … when there is a dispute about priority date requiring arguments under multiple prior art references.” Here, Petitioner contends that Patent Owner should be held to the October 30, 2006 priority date of the ’227 Patent and the references in Petition 1 qualify as prior art. But if Patent Owner attempts to rely on an earlier invention date before the Board, Petition 2 provides arguments based on prior art references that pre-date December 2005.

In view of the material differences shown above and Petitioner’s prompt filing of a second petition upon learning of Patent Owner’s alleged invention date,

the Board should exercise its discretion to institute both Petitions and consolidate their schedules. Both Petitions are necessary to show the breadth of prior art that reads on the '227 Patent's overly broad claims. The Petitions are not redundant or duplicative, and this is not a situation in which it would have been reasonable to include all challenges in a single petition, as both petitions challenge thirty claims and Petitioner had no reason to believe Patent Owner would allege an earlier invention date when it filed its first petition.

Moreover, this is not a situation where Petitioner has filed many IPR petitions against one patent or is asserting dozens of independent grounds. Rather, Petitioner has filed only two petitions, each based on two primary grounds that present strong validity challenges. Because the differences between the petitions are due to Patent Owner's allegation of an earlier invention date in co-pending litigation, institution of both petitions is justified.

Respectfully submitted,

Dated December 23, 2024

/Jeremy J. Monaldo/

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(4)(i) *et seq.* and 42.105(b), the undersigned certifies that on December 23, 2024, a complete and entire copy of this Petitioner's Notice Ranking Petitions And Explaining Material Differences Between Petitions was provided via electronic service to:

GDC-IPR-ArcelorMittal@gibsondunn.com

Pursuant to 37 CFR §§ 42.6(e)(4)(i) et seq. and 42.105(b), the undersigned certifies that on December 24, 2024, a complete and entire copy of Petitioner's Notice Ranking Petitions And Explaining Material Differences Between Petitions was provided to the Patent Owner via Fedex by serving the correspondence address of record as follows:

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