UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

POSCO CO., LTD.,
Petitioner,

v.

ARCELORMITTAL,
Patent Owner.

Case IPR2025-00371
Patent 11,326,227

PETITIONER'S OPPOSITION TO PATENT OWNER'S DISCRETIONARY DENIAL BRIEF

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I. INTRODUCTION

Fintiv, *Advanced Bionics*, and *General Plastic* each favor institution. The Petition presents grounds of invalidity that are not being pursued or resolved in district court or ITC proceedings. These grounds were never substantively assessed by the Office during prosecution. And institution of a second Petition challenging the '227 Patent is appropriate in view of Patent Owner's continued assertion of an early date of invention.

II. *FINTIV* FAVORS INSTITUTION

Fintiv favors institution. No tribunal will resolve any ground based on Suehiro prior to the Board. And, although a ground including Takagi is asserted in a prior-filed petition, this Petition presents a new Takagi-based ground in response to Patent Owner's recent assertion of a date of invention predating the previously-claimed priority date. *See* § IV below.

A. Factor 1 (Possibility of Stay)

Factor 1 favors institution or is neutral. PO's district court case against VinFast is stayed. EX-1061; EX-1062. Nothing on record suggests that VinFast would not move to stay the ITC investigation if IPR is instituted, and the Board should not attempt to predict whether or how a different court will proceed.

Further, the lack of overlap between the grounds of the Petition and those

that will be resolved at the ITC weighs against discretionary denial. In cases where both parallel district court and ITC investigation are ongoing, the focus should be on "whether the patentability disputes before the ITC will resolve all or substantially all of the patentability disputes between the parties, regardless of the stay." *Apple Inc. v. Fintiv Inc.*, IPR2020-00019, Paper 11, 9 (PTAB Mar. 20, 2020) (precedential). As discussed in relation to Factor 4 below, the ITC will not resolve the grounds in this petition and, thus, cannot "resolve all or substantially all of the patentability disputes between the parties." *Id.*

B. Factor 2 (Relative Schedules)

Factor 2 favors institution or is neutral. Because the ITC cannot invalidate claims, future litigation remains even if the ITC finds the '227 Patent invalid. And because PO otherwise chose to assert the '227 Patent against only VinFast in a stayed district court proceeding and could assert it against POSCO regardless of the ITC result, future litigation over validity would necessarily follow the ITC's final determination. Because the ITC will not resolve the grounds presented in this petition and because the district court litigation between PO and VinFast is stayed, the Board's Final Written Decision will proceed trial in the only parallel proceeding that could address the Petition's grounds.

C. Factor 3: Neutral given lack of investment in litigation and ITC proceedings

Factor 3 is neutral. No investment has occurred in a lawsuit against POSCO

or in VinFast's district court case. And the Board has refused to exercise discretion in similar circumstances, even when an ITC initial determination will predate the institution decision. *Wirtgen*, IPR2018-01201, Paper 13, 10-12.

D. Factor 4: Strongly favors institution because the Petition's grounds are entirely different from those heard by the ITC and address eleven more claims

Factor 4 strongly favors institution. PO's statement that the asserted references were "used at the ITC" elides the lack of overlap between the Petition's grounds and those presented at the ITC. In fact, PO's post hearing brief addresses just two primary grounds of invalidity—Volkswagen Passat and Lachmann—and does not address grounds based on Takagi or Suehiro. EX-2014, 68-120, 137-160. Volkswagen Passat is system prior art that could not be raised in this proceeding, and Lachmann was not even submitted as an exhibit here. During ITC proceedings, Takagi and Suehiro were discussed only briefly as relating generally to the state of the art. EX-1063, 44-48; EX-1064; EX-1065. For example, of the slides presenting VinFast's invalidity case, Takagi or Suehiro were mentioned on only seven slides, in comparison to ***98*** slides presenting invalidity arguments based on Volkswagen Passat and Lachmann. EX-1063, 22, 41, 44-48, 52-90, 96-106, 111-140, 142-149, 156-165. And Takagi and Suehiro were only analyzed in isolation, not in combination with any secondary references, let alone the secondary references applied in the Petition.

To be clear, grounds based on Takagi and Suehiro are dropped from the ITC's investigation and will not be considered on the merits. The ITC judge will not have to spend resources resolving grounds based on Takagi or Suehiro, and there is no risk of inconsistent results. Finally, PO does not address that the petition covers every claim of the '227 Patent, including ***eleven*** claims not asserted at the ITC. Simply put, the claims, grounds, arguments, and evidence are not the same in the two proceedings. Given the complete lack of overlap, the ITC will not "resolve all or substantially all of the patentability disputes between the parties" and Factor 4 weighs strongly in favor of institution. *Apple Inc. v. Fintiv Inc.*, IPR2020-00019, Paper 11, 9 (PTAB Mar. 20, 2020) (precedential).

Moreover, in view of the substantive differences between ITC investigations and IPR proceedings, the Board has refused to exercise discretion in similar circumstances. *3Shape*, IPR2020-00223, Paper 12, 34 n.15 ("[T]he ITC does not have the power to cancel a patent claim, even if that claim is demonstrated to be invalid. Also, the burden of proof in demonstrating that a patent claim is invalid differs between the ITC and an *inter partes* review. Finally, the ITC Investigation will not resolve all claims at issue in this proceeding").

E. Factor 5: Strongly favors institution because the parties are different

Factor 5 strongly favors institution. PO initiated ITC proceedings against VinFast, not POSCO. Yet, PO asserts, without justification, that its case against

VinFast should result in denial of POSCO's petition. Indeed, PO cites no authority justifying extension of *Fintiv* to a petition filed by an alleged supplier based on parallel customer litigation. Here, when PO filed suit against VinFast, POSCO filed this petition to protect itself. This action aligns with the purpose of the AIA to efficiently resolve validity to avoid future litigation. Denying POSCO's petition based on litigation with just one of its customers would thwart Congress' intent.

For these reasons, the Board routinely grants institution when a customer lawsuit proceeds in parallel with a supplier petition and RPI designation is a non-factor. *Dolby Labs., Inc.*, IPR2020-00661, Paper 13, 8-12 (Oct. 2020); *Applied Materials, Inc.*, IPR2021-01344, Paper 17, 28 (Feb. 2022); *Intel Corp.*, IPR2023-01145, Paper 11, 43 (Mar. 2024). As with Petitioner in the Dolby case, POSCO named its customer, VinFast, as an RPI "out of an abundance of caution" and "to avoid unnecessary litigation at the PTAB." *Dolby Labs., Inc.*, IPR2020-00661, Paper 13, 11. And it did so despite VinFast having no involvement or control over this IPR. *Applied Materials, Inc.*, IPR2021-01344, Paper 17, 28.

F. Factor 6 (Other compelling circumstances):

The merits strongly favor institution. Takagi's Table 1 and Suehiro's FIG. 13 each plainly and explicitly disclose all elements of claim 1 except for the claimed thickness, for which the Petition cites Cornette and GMW14400 (as alternatives) to straightforwardly demonstrate the obviousness of the thickness.

Cornette was successfully applied to invalidate PO's '683 patent in IPR2019-01275, and, in the POPR in related IPR2024-01377, PO was unable to formulate any arguments against Takagi's or GMW14400's teachings (the same teachings that are cited here). EX-1029; EX-1067. The Board instituted the related IPR and noted that, for the grounds including Takagi, "Petitioner accounts for the limitations recited in claims 1-25." EX-1068. Moreover, PO did not bother filing a substantive preliminary response in this proceeding, highlighting the weakness of the claims of the '227 Patent in view of the strong patentability arguments presented here. The record suggests that the Petition presents a particularly strong patentability challenge.

The settled expectations of the parties also favor institution. *See* Director's March 26, 2025 Memorandum, pg. 2. Until recently, Petitioner had a settled expectation that the '227 Patent's family was not a threat. Although the '227 Patent claims a 2006 priority date, Patent Owner delayed patenting claims with a scope at all similar to those of the '227 Patent for more than a decade. The '227 Patents' claims recite a "hot stamped coated steel product." By contrast, the first patent in this family, US 8,307,680, issued in 2012 with narrow claims directed to a "process for making a hot stamped coated steel sheet product" using specific heating, cooling, and timing parameters. EX-1066. The next patent in this family, US 9,708,683, was granted in 2017, and Petitioner was successful in invalidating

all of its claims in IPR2019-01275. EX-1029. Then, in 2020, Patent Owner was granted US 10,550,447, which like the prior '680 patent has claims directed to manufacturing processes, not finished products. EX-1069. The '227 Patent's claims are similar to those in US 10,961,602 (also the subject of ongoing IPR proceedings), which were only presented in anything resembling their final form in November 2019, ***thirteen years*** after the application's priority date. EX-1070, 585-590. And the '227 Patent issued only in May 2022.

Therefore, for ***over fourteen years*** after the filing of the first application in this family, Petitioner operated under the justified expectation that Patent Owner's claims in this family would be either (i) narrowly directed to manufacturing details or (ii) highly vulnerable to invalidation based on prior art. Patent Owner, by contrast, can claim no such settled expectation: the "length of time the claims have been in force" (*see* Director's March 26, 2025 Memorandum) is only three years due to Patent Owner's delay in introducing the challenged claims. And Patent Owner further seeks to upend Petitioner's settled expectations by waiting until eighteen years after the 2006 priority date to assert an earlier date of invention. Petitioner should be given the opportunity to challenge the '227 Patent's claims to maintain its settled expectation with respect to this patent family.

Finally, although Patent Owner asserts that *Fintiv* Factor 6 mediates against institution because "this is the *second* petition filed against the '227 Patent," Patent

Owner ignores the critical reasoning behind the filing of this Petition: Patent Owner's late assertion of an early date of invention, which would preclude the grounds of the prior petition. As discussed in more detail below in §IV, Petitioner filed this Petition shortly after Patent Owner first asserted a December 2005 date of invention and prior to the filing of a POPR in the prior petition. Institution of the present Petition is necessary in order to ensure that a challenge to the '227 Patent is evaluated on the merits. These circumstances mediate in favor of institution.

III. DENIAL UNDER §325(D) IS NOT WARRANTED

A. The aspects of the prior art cited against the independent claims were not discussed or applied during prosecution

The record is silent as to the specific prior art teachings cited in the Petition. Only a single rejection was issued during examination of the '227 Patent, and that rejection cited Laurent and Cornette, which are applied in the Petition only against dependent claims. EX-1002, 199-205.

For prior art applied against the independent claims, Patent Owner overstates the extent to which Takagi, Suehiro, and GMW14400 were substantively considered. Suehiro and GMW14400 were merely cited in an IDS but not discussed or applied in any rejection. EX-1002, 72, 99. Indeed, these references were listed in a set of IDSs that cited ***190*** references, such that Suehiro and GMW14400 were considered by the Examiner with ***188*** other references. EX-

1002, 70-103. Such limited evaluation does not warrant §325(d) denial.

Moreover, in the '683 Patent IPR, Cornette was successfully applied against the challenged claims, and the Board accepted Petitioner's arguments that Cornette taught a coating thickness greater than 30 micrometers – the claim feature for which Cornette is cited against the independent claims in this Petition. EX-1029, 40-41. And that discussion was before the Board, not the Examiner. A ***successful*** challenge to a ***different*** patent before a ***different*** entity, in which the arguments now made by Petitioner were ***accepted***, has little relevance to §325(d)'s inquiry of whether the same prior art/arguments were previously presented to the Office and overcome.

The record also is silent as to the teachings for which Takagi is cited against the independent claims. During examination of the related '602 Patent, Patent Owner, ***not the Examiner***, independently raised Takagi to argue that Takagi failed to teach a coating thickness greater than 30 μm. EX-1070, 566-567, 591-592. Takagi's coating thickness was also the focus of discussion during prosecution of the '683 Patent. But the Petition cites Takagi for its teachings of layer compositions, not for a coating thickness, which is taught by GMW14400 or Cornette in combination with Takagi—a combination not discussed or applied. Patent Owner does not contend that the portions of Takagi's teachings applied here were ever noted or discussed prior to the present Petition.

B. The Examiner erred by failing to consider the cited teachings of the prior art and the Petition presents additional evidence

The second part of the *Advanced Bionics* framework is not satisfied when the prosecution history provides little insight into the examiner's evaluation of prior art and the petitioner demonstrates a reasonable likelihood of success. In *Samsung Electronics Co. Ltd. v. Evolved Wireless LLC*, the examiner's evaluation was not "well developed" or was "silent," so the petition's showing was "sufficient to establish that the Examiner erred because Petitioner has shown that the Examiner overlooked the particular combination of the [prior art references], which were among the hundreds of references listed on the IDS." IPR2021-00943, Pap. 9, 12 (PTAB Dec. 1, 2021); *see also Tokyo Ohka Kogyo Co. Ltd. v. Fujifilm Elec. Materials USA Inc.*, PGR2022-00010, Pap. 9, 8-9 (PTAB 2022).

Here, the prosecution history similarly provides little or no insight on the aspects of the prior art that the Petition applies against the independent claims. Discussion of Takagi during prosecution of the '683 Patent was focused on Takagi's coating thickness, features for which the current Petition relies on Cornette or GMW14400 in combination with Takagi. Petition, 11-20, 53-54. Takagi was not previously considered in combination with Cornette or GMW14400. And Patent Owner does not dispute that Suehiro was never previously discussed or applied throughout the '227 Patent family.

Finally, cases cited by Patent Owner are distinguishable. POPR, 10-11. The

decision in *Microsoft Corp. v. AlmondNet, Inc.* was based primarily on the petitioner's lack of "further explanation" on how the art was "not substantively considered during the prosecution." *Microsoft Corp. v. AlmondNet, Inc.*, IPR2022-01319, Paper 9 at 11 (Jan. 30, 2023). Similarly, denial of institution in *Ivantis, Inc. v. Sight Scis., Inc.* was based on petitioner failing to "specifically address the material-error prong of the *Advanced Bionics* framework." *Ivantis, Inc. v. Sight Scis., Inc.*, IPR2022-01540, Paper 14 at 13 (PTAB Mar. 22, 2023). But Petitioner both here and in the Petition has noted the specific aspects of the references that the Examiner failed to consider, giving rise to material error. Petition, 90-91.

IV. INSTITUTION SHOULD BE GRANTED IN VIEW OF A DISPUTE ABOUT PRIORITY DATE

Institution of this second Petition challenging the '227 patent should be granted in accordance with the Consolidated Trial Practice Guide's ("CTPG") guidance that "more than one petition may be necessary…when there is a dispute about priority date requiring arguments under multiple prior art references." CTPG, 59.

A. Summary of priority dispute

The challenge in IPR2024-01377 relies heavily on Engels and Hein, two §102(a) references that were publicly available as of May 9, 2006, in comparison to the claimed October 30, 2006 priority date of the '227 patent. However, for the first time on November 1, 2024, about two months after the filing of the petition in

IPR2024-01377 – and eighteen years after the filing date of the first application in this family – PO asserted a December 2005 priority date based on an earlier conception and reduction to practice. PO continues to assert the earlier date of invention in both the ITC proceedings and the prior IPR. EX-1072, 18-23; EX-1077, 2 . The present Petition responds to this earlier date by asserting new grounds that do not rely on Engels or Hein.

B. Petitioner's prior reliance on the October 30, 2006 priority date was justified

Despite ample prior opportunities to claim an earlier date of invention when it would have been beneficial to PO, PO failed to do so until November 1, 2024, the ***final deadline*** to supplement burden contentions in the ITC proceedings, nearly two months after the filing date of IPR2024-01377. EX-1073; EX-1074. Up until this late date, Petitioner had no reason to believe that PO might allege an earlier date of conception.

Indeed, Engels was also cited as §102(a) prior art in IPR 2019-01275, in which all claims in the '683 patent were successfully challenged. EX-1031, 7-9. PO's subsequent POR included detailed arguments on the ***merits*** of a proposed combination of Cornette-Engels, but did ***not*** seek to disqualify Engels as prior art, despite the clear benefit to be gained from doing so. EX-1071, 69-71. PO's substantive arguments against specific features of Engels would have been unnecessary had PO simply established the alleged December 2005 date. And PO

elsewhere referred explicitly to the October 30, 2006 date in attempts to disqualify another document as a prior publication. EX-1071, 47-48.

C. Petitioner timely filed the Petition in response to Patent Owner's assertion of an early date of invention

After remaining silent on this issue through the entirety of IPR 2019-01275, PO asserted the December 2005 on November 1, 2024, nearly two months after the September 6, 2024 filing of the earlier petition in IPR2024-01377. From that date, Petitioner worked diligently to prepare and file the present Petition on December 23, 2024, prior to PO's preliminary response to the first petition.

D. Analysis under *General Plastic*

An analysis under *General Plastic* confirms that discretionary denial is not appropriate. *General Plastic Indus. Co. v. Canon Kabushiki Kaisa*, IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017).

Factors 1 and 2 (favor grant):

Should PO successfully establish the December 2005 invention date, the present Petition will be the sole challenge to be evaluated on the merits. The Board has held that, when a first petition was not resolved on the merits, "[a]llowing Petitioner the opportunity to pursue a decision on the merits [by instituting a follow-on petition]…best balances the desires to improve patent quality and patent-system efficiency against the potential for abuse." *Intel Corp. v. VLSI Tech. LLC*, IPR2022-00366, Paper 14 (June 8, 2022), 9– 10.

"*General Plastic* factor 1 must be read in conjunction with factors 2 and 3. Where the first-filed petition under factor 1 was discretionarily denied or otherwise was not evaluated on the merits, factors 1–3 only weigh in favor of discretionary denial when there are 'road-mapping' concerns under factor 3 or other concerns under factor 2." *Code200, UAB v. Bright Data, Ltd*., IPR2022-00861, Paper 18 (Aug. 23, 2022). Given the lack of road-mapping allegations and PO's delayed claim of the December 2005 priority date, the Petition should be instituted so that its challenges can be evaluated on the merits.

Factor 3 (favors grant):

This Petition was filed prior to PO's filing of a preliminary response in the first petition. PO's discussion of the ITC proceeding in conjunction with *General Plastic* Factor 3 is mistaken, as the *General Plastic* analysis is confined specifically to the status of the first petition. The status of the ITC proceeding is irrelevant to evaluation of the *General Plastic* factors.

Factor 4 (favors grant):

This Petition was filed less than two months after PO first asserted a December 2005 date of invention, alerting Petitioner to the need for alternative art in a second IPR challenge.

Factor 5 (favors grant):

The background discussed above demonstrates that the present Petition was timely filed in response to Patent Owner's assertion of an early date of invention. PO "surprisingly advanced" a December 2005 date of invention ***after*** the filing of the first Petition and after failing to advance the December 2005 date through the entirety of the related IPR against the '683 patent. *General Plastic*, 11. The dispute over the priority date of the '227 patent necessitated the filing of a further challenge. As a result of diligent effort, this Petition followed less than two months later, despite its incorporation of a new primary reference, Suehiro, that was not cited in the first petition.

Patent Owner continues to argue for the December 2005 date in the ITC proceedings. EX-1072, 18-23. Indeed, in its POPR in the prior IPR, Patent Owner stated that "the claims of the '227 Patent have an earlier critical date" and "reserve[d] the right to argue for an earlier critical date if this Petition is instituted." EX-1067, 2. Therefore, the priority dispute is ongoing, and the present Petition may represent the only opportunity for a challenge to the '227 patent to be determined on the merits.

Institution of a second petition under these circumstances would conform to both the CTPG – which specifically notes "a dispute about priority date" as an example of a circumstance that might "require[e] arguments under multiple prior art references" – and prior Board decisions. *See Medtronic, Inc. v. Teleflex Innovs.*

S.A.R.L, IPR2020-00130, Paper 20 at 11–13 (PTAB June 26, 2020) (granting institution in a ***third*** concurrent IPR because "we may determine that [a document relied on in a prior petition] does not qualify as prior art"); *NRG Energy, Inc. v. Midwest Energy Emissions Corp.*, IPR2020-00926, Paper 19 at 25–26 (PTAB Oct. 26, 2020) (granting institution because the "existence of different priority date arguments and different prior art references…invokes the Consolidated Trial Practice Guide statement [cited above]").

PO asks that the Board deny institution against the guidance of the CTPG. The sole authority PO cites in support of this position, *Louisiana-Pacific Co. v. Huber Engineered Wood LLC*, relates to an entirely different circumstance in which a first petition included an "anticipatory reference" that was not at serious risk of disqualification. *Louisiana-Pacific*, IPR2020-00609, Paper 12, 9-10 (PTAB August 20, 2020). In the present case, all of the prior petition's grounds would be invalidated should PO successfully advance the date of invention that they have asserted in the ITC proceedings. As such, institution of the present Petition is warranted in order to ensure efficient review of the '227 patent on the merits.

Factors 6 and 7 (favor grant):

The Director's March 26, 2025 Memorandum affirmed the CTPG as guiding discretionary denial considerations in the context of PTAB workload management. Consistent with the CTPG, institution should be granted in view of the dispute over

priority date. The March 26 Memorandum also affirmed evaluation of the "settled expectations of the parties," a consideration which favors institution as discussed in reference to *Fintiv* Factor 6 above.

Moreover, the substantive overlap between the present challenge and that of the prior petition means that institution would not overly burden the Board. Takagi is employed as a primary reference in grounds of both petitions, such that consideration of the Takagi grounds in this Petition would in large part follow from the Board's analysis of the prior petition (to the extent the prior petition is substantively evaluated at all, in view of Patent Owner's assertion of the December 2005 priority date). And most secondary references are also shared between the two IPR proceedings, further reducing the burden on the Board.

V. CONCLUSION

Petitioner therefore requests that the Director find discretionary denial to be inappropriate and assign the Petition to a merits panel for review.

Respectfully submitted,

Dated: May 28, 2025

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CERTIFICATION UNDER 37 CFR § 42.24

Under the provisions of 37 CFR § 42.24, the undersigned hereby certifies that the word count for the foregoing Petitioner's Opposition to Patent Owner's Discretionary Denial Brief totals 3865 words, which is less than the 14,000 allowed under 37 CFR § 42.24.

Dated: May 28, 2025

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(1) and 42.6(e)(4)(iii), the undersigned certifies that on May 28, 2025, a complete and entire copy of this Petitioner's Opposition to Patent Owner's Discretionary Denial Brief and associated exhibits are provided via email to the Patent Owner via electronic mail on Patent Owner's lead and backup counsel listed below at the following email address:

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