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 BRIEF RANKING PETITIONS CHALLENGING U.S. PATENT NO. 11,326,227

Pursuant to the Director's Order of July 23, 2025 in IPR2024-01377 (Paper 16), Petitioner provides the following ranking of its petitions challenging U.S. Patent No. 11,326,227 ("the '227 Patent"):

Rank	PTAB Case No.	Challenged Claims	Asserted Prior Art	Filing Date
1	IPR2025-00371 ("Second Petition")	1-25	Takagi, Cornette, Laurent Vaissiere, GMW14400, Suehiro	December 23, 2024
2	IPR2024-01377 ("First Petition")	1-25	Engels, Cornette, Takagi, Hein, Vaissiere, Laurent, GMW14400	September 6, 2024

Petitioner ranks its Second Petition ahead of its First Petition to ensure the Board's consideration of the merits of at least one of the Petitions.

Petitioner appreciates the Director's decision that the Board's resources are well-spent on the challenges developed against the '227 Patent, but that two Petitions challenging the same patent are disfavored. Paper 16; IPR2025-00371, Paper 10. As an alternative, therefore, Petitioner respectfully requests that the Director and the Board allow a hybrid approach that Petitioner believes is fairest to both parties and best serves the public under the circumstances. Specifically, Petitioner requests that the Director exercise her discretion under 35 U.S.C.

§315(d) to consolidate IPR2024-01377 and IPR2025-00371, and institute trial on a combination of Grounds 1A-1F from the First Petition (IPR2024-01377) and Grounds 1A-1F from the Second Petition (IPR2025-00371). In this hybrid approach, Petitioner would drop Grounds 2A-2C from IPR2024-01377 and Grounds 2A-2H from IPR2025-00371. A revised table of grounds would be:

Ground	Claims	Basis (§103)
Grounds from IPR2024-01377		
1A-102	1-2, 4-5, 7, 18, 24-25	§102 – Engels
1A-103	1-2, 4-7, 9-10, 13-15, 18-25	§103 – Engels
1B	8, 11-14, 24-25	§103 – Engels, Cornette
1C	3, 8-11, 18-23	§103 – Engels, Takagi
1D	15-17	§103 – Engels, Hein
1E	15	§103 – Engels, Vaissiere
1F	16-17	§103 – Engels, Laurent
Renumbered Grounds from IPR2025-00371		
2A ~~1A~~	1-15, 18-25	Takagi, Cornette
2B ~~1B~~	16-17	Takagi, Cornette, Laurent
2C ~~1C~~	15	Takagi, Cornette, Vaissiere
2D ~~1D~~	1-11, 15-25	Takagi, GMW14400
2E ~~1E~~	16-17	Takagi, GMW14400, Laurent
2F ~~1F~~	15	Takagi, GMW14400, Vaissiere

The hybrid approach would provide the Office the opportunity to decide the patentability of the ’227 Patent based on grounds addressing different potential priority dates. The Board’s Trial Practice Guide states that two petitions

challenging one patent may be necessary when a "dispute about priority date" exists. Consolidated Trial Practice Guide, 59 (November 2019). Moreover, the public would gain the benefit not only of having the patentability of the '227 Patent's claims decided in a manner consistent with the judgment in the prior Office proceeding, but also of having the priority date issue settled so that Patent Owner may not take inconsistent positions in future Office proceedings. *See* IPR2025-00371, Paper 10 (stating that "[i]t is an appropriate use of Office resources to provide consistency and predictability to the public, and to ensure that a patent applicant or owner does not take action inconsistent with the judgment in a prior Office proceeding").

And, in the hybrid approach, Patent Owner would only face the content of one petition, not two. In fact, the hybrid approach would not add any additional prior art beyond that which was presented in the First Petition—it merely adjusts the second ground to replace Hein, which is not prior to December 2005, with Cornette, which is prior art to December 2005 and was already asserted against dependent claims in other grounds pursued in the First Petition. Thus, the hybrid approach places limited burden on Patent Owner because Patent Owner would not have to address prior art beyond that presented in the First Petition and would face similar grounds to those presented in the First Petition.

Further, the hybrid approach is fair because Patent Owner delayed its

allegation of an earlier invention date. Specifically, Patent Owner never alleged an earlier invention date during IPR proceedings for U.S. Patent No. 9,708,683 (a parent to the ’227 Patent) despite facing prior art dated ***after*** December 2005—including the same Engels reference advanced in the First Petition challenging the ’227 Patent. EX-1029 (from IPR2025-00371), 6-7. Only ***after*** the Board’s FWD of unpatentability in that IPR did Patent Owner allege that it was entitled to the December 2005 invention date. Indeed, this allegation first occurred over ***six months*** after Patent Owner’s ITC complaint and nearly ***two months*** after the First Petition’s filing date. EX-1057 (from IPR2025-00371), 1.

With this background, Petitioner had no reason to anticipate Patent Owner’s allegation of an earlier invention date when Petitioner filed its First Petition. Upon learning of Patent Owner’s allegation, Petitioner promptly began preparation of the Second Petition challenging the ’227 Patent on prior art that pre-dates Patent Owner’s alleged December 2005 invention date. Petitioner acted expeditiously, filing the Second Petition in less than two months and before Patent Owner’s preliminary response to the First Petition.

For the above reasons, the hybrid approach, which allows two grounds that address different priority dates while dropping the other grounds, is consistent with the November 2019 Trial Practice Guide Update (pg. 59) and the Director’s guidance that “multiple parallel petitions challenging the same patent are

disfavored." Paper 16 (IPR2024-01377). Indeed, the hybrid approach would have Petitioner dropping 2 of 4 primary challenges, which is the same result as if Petitioner dropped 1 of its 2 petitions that each advanced 2 distinct grounds.

As to logistics for Petitioner's proposed hybrid approach, Petitioner respectfully proposes filing a consolidated or corrected petition in IPR2025-00371 that presents only the proposed combination of grounds without any substantive changes to those grounds. The exhibit numbers used between IPR2024-01377 and IPR2025-00371 are generally consistent and Petitioner can readily correct any overlap/issues (e.g., with Ex. 1003, the expert declaration), again without substantive changes. In this regard, the consolidated version of IPR2025-00371 can proceed with a clear record. And, because no substantive changes would be made and because Patent Owner has already responded to the first set of proposed grounds, Patent Owner would not have an undue burden from the administrative work needed to create a clear record.

For these reasons, Petitioner requests consideration of the hybrid approach outlined above. As started, Petitioner appreciates the dedication of Board resources to assess Petitioner's challenges and requests that IPR2025-00371 move forward as instituted to the extent that the proposed hybrid approach is deemed impracticable or inappropriate.

Respectfully submitted,

Dated August 4, 2025

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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 August 4, 2025, a complete and entire copy of this "Petitioner's Brief Ranking Petitions Challenging U.S. Patent No. 11,326,227" was provided by email to the Patent Owner by serving the correspondence address of record as follows:

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