UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

POSCO CO. LTD.,
Petitioner,

v.

ARCELORMITTAL,
Patent Owner.

Case No. IPR2025-00371
U.S. Patent No. 11,326,227

PATENT OWNER'S RESPONSE TO PETITIONER'S BRIEF RANKING PETITIONS CHALLENGING U.S. PATENT NO. 11,326,227

TABLE OF AUTHORITIES

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Cases

Certain High-Strength Aluminum or Aluminum Alloy-Coated Steel, and Automotive Products and Automobiles Containing Same, 337-TA-1402, Order No. 6 at 2 (June 25, 2024) 5

Dental Imaging Techs. Corp. v. 3Shape A/S, No. IPR2024-00849, Paper 13 (PTAB Oct. 29, 2024) 3

S*avant Techs. LLC v. Feit Elec. Co.*, IPR2025-00260, Paper 17 (PTAB June 23, 2025) 2

Varian Med. Sys., Inc. v. Best Med. Int'l, Inc., IPR2020-00075, Paper 13 (PTAB May 1, 2020) 2

TABLE OF ABBREVIATIONS

Abbreviation	Term
'227 Patent	U.S. Patent 11,326,227 (Ex-1001)
'602 Patent	U.S. Patent No. 10,961,602
'683 Patent	U.S. Patent No. 9,708,683
'683 Patent IPR	IPR2019-01275 (Ex-1031)
Challenged Claims	Claims 1–25 of U.S. Patent No. 11,326,227
Fig.	Figure
First Petition	IPR2024-01377
IPR	*inter partes* review
ITC Investigation	*Certain High-Strength Aluminum or Aluminum Alloy-Coated Steel, and Automotive Products and Automobiles Containing Same*, Inv. No. 337-TA-1402 (ITC)
Order	Paper 16 in IPR2024-01377, Order Denying Director Review and Remanding to the Patent Trial and Appeal Board for Further Proceedings
Patent Owner	ArcelorMittal
Pet.	Petition, Paper 1
Petitioner	POSCO Co., Ltd.
POSITA	person[s] of ordinary skill in the art
PTAB	Patent Trial and Appeal Board
Pbr.	Petitioner's Brief Ranking Petitions
RPI	Real Party-In-Interest
Second Petition	IPR2025-00371

Pursuant to the Director's Order, Patent Owner responds to Petitioner's ranking of its petitions challenging the '227 Patent. Patent Owner agrees with Petitioner's ranking of Petitions as shown in the following table:

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

Pbr., 1. Since both Patent Owner and Petitioner agree, Patent Owner respectfully requests that the Board move forward with IPR2025-00371 ("Second Petition").

As to Petitioner's alternative proposal, Patent Owner disagrees with Petitioner's hybrid approach that proposes creating a new petition consisting of one set of grounds from IPR2024-01377 and one set of grounds from IPR2025-00371. Initially, Petitioner's proposal violates the Order, which permitted Petitioner to rank its *petitions*. Order, 2-3. The Order did not permit Petitioner to create a new petition by combining grounds from its various petitions. Thus, Petitioner's proposal should not be adopted because it is contrary to the Director's Order.

In addition, Petitioner cites no legal support for its hybrid approach and in fact, it is contrary to the law. According to Petitioner, its hybrid approach could be

implemented by "filing a consolidated or corrected petition." Pbr., 5. Not so.

A motion to file a corrected petition is governed by 37 C.F.R. § 42.104(c), which only permits corrections of "a clerical or typographical mistake." This does not apply here because Petitioner did not make and does not assert that it made any mistake. Because Petitioner cannot show that it meets the requirements for a motion to correct, any new petition's filing date will be *after* the one-year deadline imposed by 35 U.S.C. § 315(b) and the petition will be time-barred. *Varian Med. Sys., Inc. v. Best Med. Int'l, Inc.*, IPR2020-00075, Paper 13 at 6-7 (PTAB May 1, 2020).

A motion for consolidation is governed by 37 C.F.R. § 42.122(a), which permits the Board to "consolidate multiple proceedings." S*avant Techs. LLC v. Feit Elec. Co.*, IPR2025-00260, Paper 17 at 8 (PTAB June 23, 2025). In other words, this provision permits the Board to consolidate *petitions* related to the same patent. The Director's Order, however, expressly resolved whether the Board could consolidate Petitioner's multiple proceedings *against* Petitioner, by stating that only "one" of Petitioner's petitions should move forward. Order, 2. To the extent Petitioner proposes that consolidation permits Petitioner to selectively excerpt grounds for various petitions to create a single new petition comprising a new set of grounds, Petitioner does not cite any case or authority for such an interpretation. Indeed, allowing the Petitioner to create a new petition would, again, be barred by the one-year deadline imposed by 35 U.S.C. § 315(b).

Instead of addressing any legal basis for its request, Petitioner makes several arguments that ignore its intentional and strategic choice to assert one specific set of grounds in the First Petition and a different set of grounds in the Second Petition, three months later. At any time before Patent Owner filed its Preliminary Response, the Board issued its Institution Decision, or the one-year deadline expired, Petitioner could have moved to change or file new petitions; it did not. Rather, Petitioner waited until Patent Owner provided its Patent Owner Response to the First Petition *and* responded to Petitioner's same invalidity references in the parallel ITC Investigation through expert reports, pre-hearing briefing, the evidentiary hearing, and post-hearing briefing, and only then sought to change the contents of its petitions. *Cf. Dental Imaging Techs. Corp. v. 3Shape A/S*, No. IPR2024-00849, Paper 13 at 21 (PTAB Oct. 29, 2024) (disapproving of scenarios where "Petitioner had the potential to benefit from the Preliminary Response and Institution Decision resulting from the first petition"). Petitioner's failure to address its intentional and strategic conduct is fatal to any request for hybrid approach.

Finally, Petitioner asserts a series of arguments. Petitioner argues that its hybrid approach should be adopted so the patentability of the claims could be "decided in a manner consistent with the judgment" in the '683 Patent IPR. Pbr., 3. But Petitioner omits that the Patent Office and Examiner already did this because they had the prior '683 Patent IPR decision before the '227 Patent was allowed; in

fact, the '227 Patent was expressly prosecuted, examined, and allowed with full knowledge of and consistent with the decision in the '683 Patent IPR. Ex. 1002, 105-06 ("Applicants respectfully advise the Examiner that some of the references were cited in [IPR2019-01275] of [the '683 Patent] . . . and is a parent of the present application. The final decision of the [PTAB] issue[d] on January 5, 2021 and is listed on the accompanying Forms . . . and has been previously submitted.").

Petitioner also argues that the Patent Office should decide the priority date to prevent Patent Owner from allegedly taking inconsistent positions about their priority date. Pbr., 3. But aside from generic speculation, Petitioner identifies no specifics and points to no evidence that Patent Owner will or can take inconsistent positions regarding the priority date.

Petitioner next argues, erroneously, that Patent Owner would face no additional burden because the newly created petition "merely adjusts" one reference. Pbr., 3. Petitioner's proposal, however, would not simply adjust one reference in the First Petition but instead, it would replace three existing grounds in the First Petition with six new grounds, combinations, and motivations to combine.

As a fallback, Petitioner appeals to "fair[ness]" and argues its hybrid approach should be adopted by mischaracterizing the earlier '683 Patent IPR. Pbr., 3-4. According to Petitioner, Patent Owner should have disclosed an earlier priority date in that proceeding. But in the '683 Patent IPR, seven grounds were asserted and

only the seventh ground involved a secondary reference (Engels) that post-dated the filing date. Ex. 1029, 6-7. The Board's final written decision addressed only the grounds one to three, five, and six. *Id.*, 51. Thus, there was no need to address the priority date during the '683 Patent IPR, because the priority date was immaterial to the outcome. In fact, Petitioner does not assert that an earlier priority date would have changed the outcome of the '683 Patent IPR in any way.

Petitioner also argues that Patent Owner "delayed" disclosing its priority date for over six months after filing its ITC complaint. Pbr., 3-4. But Patent Owner disclosed its priority date in accordance with the procedural schedule. Indeed, RPI and Patent Owner *jointly* proposed the schedule for that Investigation and the parties followed that schedule. *Certain High-Strength Aluminum or Aluminum Alloy-Coated Steel, and Automotive Products and Automobiles Containing Same*, 337-TA-1402, Order No. 6 at 2 (June 25, 2024) (ordering parties to agree and submit via email "a proposed Procedural Schedule"). There was no delay.

In sum, Petitioner has not explained why it failed to file a petition with its hybrid set of grounds before the one-year statutory bar. Instead, Petitioner intentionally and strategically chose to file two petitions asserting numerous grounds (duplicative of what RPI asserted at the ITC), and only after being required by the Director to select one petition, now seeks to have a do-over to create a new one. Petitioner's hybrid approach should be rejected.

DATED: August 14, 2025

Respectfully Submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies service pursuant to 37 C.F.R. § 42.120 of a copy of this Patent Owner's Response to Petitioner's Brief Ranking Petitions upon Petitioner by email on August 14, 2025, to the following email addresses of record:

IPR58281-0003IP2@fr.com

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