

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SK INNOVATION CO., LTD., and
SK BATTERY AMERICA, INC.,
Petitioner,

v.

LG CHEM, LTD. and TORAY INDUSTRIES, INC.,¹
Patent Owner.

IPR2020-01036
Patent 7,709,152 B2

Before KRISTINA M. KALAN, JON B. TORNQUIST, and
JEFFREY W. ABRAHAM, *Administrative Patent Judges*.

KALAN, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314, 37 C.F.R. § 42.4

¹ The Notice of Filing Date Accorded (Paper 4) identifies Toray Battery Separator Film Co., Ltd, and Toray Industries, Inc. as Patent Owner, but does not identify LG Chem, Ltd. as Patent Owner. Patent Owner represents that LG Chem, Ltd. and Toray Industries, Inc. should be identified as Patent Owner. Paper 5, 2 (citing assignment recorded at Reel/Frame 042445/0809).

I. INTRODUCTION

SK Innovation Co., Ltd., and SK Battery America, Inc. (collectively, “Petitioner”) filed a Petition (Paper 3, “Pet.”) requesting an *inter partes* review of claims 1–3, 5–13, and 16–20 of U.S. Patent No. 7,709,152 B2 (Ex. 1001, “the ’152 patent”). LG Chem, Ltd. and Toray Industries, Inc. (collectively, “Patent Owner”) filed a Preliminary Response to the Petition (Paper 8, “Prelim. Resp.”). We authorized additional briefing on the 35 U.S.C. § 314(a) discretion to institute issue raised in the Preliminary Response. Paper 9. Petitioner filed a Reply to the Patent Owner Preliminary Response (Paper 10, “Reply”), and Patent Owner filed a Sur-Reply to Petitioner’s Reply to Patent Owner’s Preliminary Response (Paper 11, “Sur-Reply”).

To institute an *inter partes* review, we must determine that the information presented in the Petition shows “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). For the reasons discussed below, after considering the parties’ submissions and the evidence of record, we decline to institute an *inter partes* review.

A. *Related Proceedings*

The parties state that the ’152 patent is at issue in an International Trade Commission (“ITC”) investigation, Inv. No. 337-TA-1181. Pet. 66; Paper 5, 2. The parties also state that the ’152 patent is at issue in a civil action in the United States District Court for the District of Delaware (the “District Court proceeding”), *LG Chem, Ltd. v. SK Innovation Co., Ltd.*, Case No. 1:19-cv-1805 (D. Del.). Pet. 66; Paper 5, 2.

B. The '152 Patent

The '152 patent, titled “Organic/Inorganic Composite Separator Having Porous Active Coating Layer and Electrochemical Device Containing the Same,” is directed to a separator of an electrochemical device, such as a lithium battery, and an electrochemical device containing the same. Ex. 1001, code (54), 1:9–11. The separator is an organic/inorganic composite separator in which a porous active layer consisting of a mixture of an inorganic particles and binder polymer is coated onto a surface of a porous substrate. *Id.* at 2:60–65.

In the organic/inorganic separator, the porous active layer has a peeling force of 5 gf/cm, or above, so that the porous active layer has an “excellent peeling resistance, thereby solving the problem that inorganic particles in the porous active layer are extracted while assembling a charger chemical device.” *Id.* at 4:19–24. Further, the organic/inorganic composite separator shows a thermal shrinkage of 50% or below in a machine direction or in a transverse direction. *Id.* at 4:31–33. This allows the organic/inorganic composite separator to prevent an electric short circuit between a cathode and an anode. *Id.* at 4:33–34. In the organic/ inorganic composite separator coated with the porous active layer, a weight ratio of the inorganic particles and the binder polymer is in the range from 50:50 to 99:1, more preferably from 70:30 to 95:5. *Id.* at 6:48–52. According to the '152 patent, if “the weight ratio of the organic particles to the binder polymer is less than 50:50, the content of polymer is so great that the thermal stability of the organic/inorganic composite separator may not be much improved.” *Id.* at 6:52–55. Further, according to the '152 patent, if “the weight ratio exceeds 99:1, the peeling resistance of the porous active

layer may be weakened since the content of binder polymer is so small.” *Id.* at 6:59–61.

C. Illustrative Claim

1. An organic/inorganic composite separator, comprising:
 - (a) a polyolefin porous substrate having pores; and
 - (b) a porous active layer containing a mixture of inorganic particles and a binder polymer, with which at least one surface of the polyolefin porous substrate is coated,wherein the porous active layer has a peeling force of 5 gf/cm or above, and a thermal shrinkage of the separator after being left alone at 150° C. for 1 hour is 50% or below in a machine direction (MD) or in a transverse direction (TD),
wherein the inorganic particles and the binder polymer are mixed in a weight ratio of 50:50 to 99:1.

Ex. 1001, 11:49–60.

D. The Asserted Grounds of Unpatentability

Petitioner asserts that claims 1–3, 5–13, and 16–20 would have been unpatentable on the following grounds:

Basis	35 U.S.C. §	Claims Challenged
Kasamatsu, ² Hatayama, ³ Yong ⁴	103	1–3, 5–13, 16–20
Yong, Hatayama	103	1–3, 5–13, 16–20
Aihara, ⁵ Tobinaga ⁶	103	1–3, 5–13, 16–20

In support of its unpatentability arguments, Petitioner relies on the declaration testimony of Dr. Thomas F. Fuller. Ex. 1009.

² PCT Application Publication No. WO 2006/061936 (Ex. 1008).

³ Japanese Patent Application Publication No. 2006/289657 (Ex. 1005).

⁴ U.S. Patent Application Publication No. 2006/0008700 A1 (Ex. 1006).

⁵ U.S. Patent Application Publication No. 2002/0102456 A1 (Ex. 1033).

⁶ U.S. Patent No. 6,949,285 B1 (Ex. 1034).

II. ANALYSIS

A. *Discretion to Institute Under 35 U.S.C. § 314(a)*

Institution of an *inter partes* review is discretionary.

The Director may not authorize an *inter partes* review to be instituted unless the Director determines that the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

35 U.S.C. § 314(a). The Supreme Court of the United States has explained that, because § 314 includes no mandate to institute review, “the agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.” *Cuozzo Speed Techs., LLC v. Lee*, 136 S.Ct. 2131, 2140 (2016); *see also Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (explaining that under § 314(a), “the PTO is permitted, but never compelled, to institute an IPR proceeding”). The Director has delegated his authority under § 314(a) to the Board. 37 C.F.R. § 42.4(a) (“The Board institutes the trial on behalf of the Director.”).

The Leahy-Smith America Invents Act was “designed to establish a more efficient and streamlined patent system that will improve patent quality and limit unnecessary and counterproductive litigation costs.” H.R. Rep. No. 112–98, pt. 1, at 40 (2011), 2011 U.S.C.C.A.N. 67, 69 (Post grant reviews were meant to be “quick and cost effective alternatives to litigation”); *see also* S. Rep. No. 110–259, at 20 (2008); Patent Trial and Appeal Board Consolidated Trial Practice Guide (“CTPG”) 56 (November 2019), *available at* <https://www.uspto.gov/TrialPracticeGuideConsolidated>. The Board recognized these goals, but also “recognize[d] the potential for abuse of the review process by repeated attacks on patents.” *General Plastic*

Co., Ltd. v. Canon Kabushiki Kaisha, IPR2016-01357, Paper 19, 16–17 (PTAB Sept. 6, 2017) (precedential).

In *NHK Spring Co., Ltd. v. Intri-Plex Technologies, Inc.*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential), the Board determined that the advanced state of a parallel proceeding is an additional factor weighing in favor of denying institution under 35 U.S.C. § 314(a). *Id.* at 19–20. In *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential), the Board articulated a list of factors that we consider in determining whether to exercise discretion to deny institution based on an advanced stage of a parallel proceeding:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board’s exercise of discretion, including the merits.

Fintiv, Paper 11, 5–6. “These factors relate to whether efficiency, fairness, and the merits support the exercise of authority to deny institution in view of an earlier trial date in the parallel proceeding.” *Id.* In evaluating these factors, we take “a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Id.* (citing CTPG 58).

As previously described, Patent Owner has asserted the '152 patent against Petitioner in both the District Court proceeding and an ITC proceeding. Pet. 66; Paper 5, 2. The District Court proceeding has been stayed pending resolution of the ITC proceeding. Pet. 4; Prelim. Resp. 5. Petitioner contends that the related ITC proceeding is not a basis for exercising discretion to deny institution of *inter partes* review under 35 U.S.C. § 314(a), and, thus, the *Fintiv* factors are either inapplicable, or they weigh against discretionary denial. Pet. 4; Reply 1–2. Patent Owner contends the advanced stage of the related ITC proceeding presents a particularly strong case for exercising discretion to deny institution of *inter partes* review under 35 U.S.C. § 314(a). Prelim. Resp. 3–4; Sur-Reply 1–2. In our analysis below, we address each of the *Fintiv* factors in turn.

1. First Fintiv Factor: Existence or Likelihood of Stay

Patent Owner contends that this factor weighs in favor of denial. Prelim. Resp. 5. Notwithstanding the existence of a stay in the District Court proceeding, Patent Owner contends that the existence of the ITC proceeding warrants denial of institution, because Petitioner has not requested a stay of the ITC proceeding, and even if it were requested, a stay is disfavored and would likely not be granted. *Id.* at 5–6. Patent Owner argues that granting institution of the present *inter partes* review proceeding, in light of the existence of the related ITC proceeding, would create “an opportunity for irreconcilable validity decisions . . . on disparate tracks to the same reviewing court,” which would be a “costly, time-consuming and wasteful” result. *Id.* at 6–7. Patent Owner further contends the Board stated in *Fintiv* that the existence of a related ITC proceeding can weigh in favor of discretionary denial even in light of the existence of a stay in a related district court proceeding. *Id.* at 7 (citing *Fintiv*, Paper 11, 8–9).

Petitioner contends this factor weighs in favor of institution, because the related District Court proceeding has been stayed. Reply 2. Petitioner also argues that the related ITC proceeding is not duplicative, because the ITC does not have the authority to invalidate a patent, unlike a district court. *Id.* Petitioner further contends that Patent Owner’s reliance on the Board’s decision in *Fintiv* is misplaced, because *Fintiv*’s statement that “it is difficult to maintain a district court proceeding on patent claims determined to be invalid at the ITC” is mere dicta. *Id.* at 3.

In its Sur-Reply, Patent Owner contends that the Board in *Fintiv* explicitly stated “an earlier ITC trial date may favor exercising authority to deny institution.” Sur-Reply 2–3 (citing *Fintiv*, Paper 11 at 8–9). Patent Owner further contends that *Fintiv* is precedential in its entirety, binding from start to finish, and that Petitioner’s argument that portions of *Fintiv* are mere dicta is incorrect. *Id.* at 3.

In *Fintiv*, the Board stated:

One particular situation in which stays arise frequently is during a parallel district court *and* ITC investigation involving the challenged patent. In such cases, the district court litigation is often stayed under 28 U.S.C. § 1659 pending the resolution of the ITC investigation. Regardless, *even though the Office and the district court would not be bound by the ITC’s decision, an earlier ITC trial date may favor exercising authority to deny institution under NHK if the ITC is going to decide the same or substantially similar issues to those presented in the petition.* The parties should indicate whether there is a parallel district court case that is ongoing or stayed under 28 U.S.C. § 1659 pending the resolution of the ITC investigation. *We recognize that ITC final invalidity determinations do not have preclusive effect, but, as a practical matter, it is difficult to maintain a district court proceeding on patent claims determined to be invalid at the ITC.* Accordingly, the parties should also indicate whether the patentability disputes before the ITC will resolve all

or substantially all of the patentability disputes between the parties, regardless of the stay.

Fintiv, Paper 11, 8–9 (emphasis added) (footnote omitted).

Thus, *Fintiv* expressly addresses ITC investigations, and the Board has considered ITC investigations in weighing whether or not to exercise its discretion under 35 U.S.C. § 314. See *Garmin Int’l, Inc. v. Koninklijke Philips N.V.*, IPR2020-00754, Paper 11 (PTAB Oct. 27, 2020) (exercising discretion to deny institution under § 314(a) in view of an ITC proceeding); *Comcast Cable Commc’ns, LLC v. Rovi Guides, Inc.*, IPR2020-00800, Paper 10 (PTAB Oct. 22, 2020) (exercising discretion to deny institution under § 314(a) in view of an ITC proceeding). Accordingly, we consider the ITC investigation relevant to our consideration of the *Fintiv* factors.

Specifically with regard to the first *Fintiv* factor, Petitioner has not requested a stay of the ITC investigation, and we agree with Patent Owner that a stay of the ITC investigation is unlikely given that the hearing in the ITC investigation is scheduled to begin on December 10, 2020. The pending stay in the District Court proceeding does not change the fact that the ITC investigation is likely to proceed as scheduled. For these reasons, we determine that this factor weighs against institution.

2. *Second Fintiv Factor: Proximity of Anticipated Trial Date and Statutory Deadline for Final Written Decision*

Patent Owner contends this factor also weighs in favor of denial, because in the ITC proceeding: (1) a two-day hearing is scheduled for December 10–11, 2020; (2) the ITC’s presiding Administrative Law Judge will issue an Initial Determination by March 19, 2021; and (3) the Commission will provide a Final Determination by July 19, 2021—roughly five months before the Board’s projected Final Written Decision on

December 10, 2021 in the present proceeding. Prelim. Resp. 8. Patent Owner further contends the facts of the present proceeding compare favorably to both *NHK* and *Fintiv*, where the Board ultimately denied institution. *Id.* at 9 (citing *NHK*, Paper 8, 20; *Fintiv*, Paper 15, 13). Patent Owner also contends that other Board panels have determined this factor favors denial where, as in this case, a parallel proceeding was running ahead of the Board by five to six months. *Id.* at 9–10.

Petitioner contends this factor favors institution, because the decisions cited by Patent Owner to suggest that the proximity of an evidentiary hearing of a related ITC proceeding weighs in favor of denial are inapposite. Reply 4. Petitioner argues that these decisions all pertain to trials in district court, which, unlike the ITC, has the power to invalidate a patent and to bind the parties across all other tribunals. *Id.* Petitioner further contends: “Finding that this factor weighs in favor of denial would effectively prevent ITC litigants from pursuing IPR” because of the ITC’s average 18-month pendency. *Id.*

In its Sur-Reply, Patent Owner contests Petitioner’s assertion that “[f]inding that this factor weighs in favor of denial would effectively prevent ITC litigants from pursuing IPR,” because this factor is not dispositive in isolation. Patent Owner also argues that a *Fintiv* analysis “takes a *holistic* view of whether efficiency and integrity of the system are best served by denying or instituting review.” Sur-Reply 5 (citing *Fintiv*, Paper 11, 6).

The current ITC schedule has an evidentiary hearing set for December 10, 2020, the due date for this Decision on Institution. The record shows that, if *inter partes* review were instituted in the present proceeding, a final written decision would be due approximately five months after the ITC is scheduled to issue its Final Determination. Ex. 2008, 5. Given the

considerable overlap in claims, prior art, and arguments, as described below, institution would create the potential for the ITC proceeding and the present proceeding to arrive at inconsistent results spaced months apart. These facts weigh against instituting this proceeding.

We disagree with Petitioner that finding this factor favors denial will “effectively preclude ITC litigants from pursuing IPR.” Reply 4. As Patent Owner points out, this one factor is not dispositive. Rather, we consider this factor in connection with several other factors in determining whether to exercise our discretion under § 314(a). As to the Board decisions Petitioner cites, those decisions are not precedential, and pre-date the Board’s precedential *Fintiv* decision, which is binding on us.

Thus, we determine that the second *Fintiv* factor weighs against institution.

3. *Third Fintiv Factor: Investment in Parallel Proceeding*

Patent Owner contends this factor favors denial, because the ITC has already resolved claim construction in its proceeding. Prelim. Resp. 10. Additionally, according to Patent Owner, by the time of institution of the present proceeding, the parties “will have already expended the overwhelming majority of total resources dedicated to the investigation,” because “the parties will have finalized contentions and expert reports on validity, filed summary determination motions and pre-hearing briefs, presented direct witness testimony through witness statements, and prepared witnesses for cross-examination at the remote hearing.” *Id.*; *see also* Sur-Reply 6.

Petitioner contends this factor weighs in favor of institution, because “there are no claim construction disputes for the Board to resolve that would duplicate efforts in the ITC” and, thus, the parties’ claim construction

disputes “have no bearing on the relative expenditure of resources.”

Reply 4.

The ITC and the parties have already made substantial investments in the related ITC proceeding, in the form of addressing claim construction and completing fact discovery, and, in view of the hearing scheduled for December 10, 2020, will have invested even more resources by the time we issue this Decision. *See* Ex. 2008, 4–5; Ex. 2011 (Markman order indicating claim construction is complete in ITC proceeding); Prelim. Resp. 10; Reply 4; Sur-Reply 6. We are not persuaded by Petitioner’s arguments that the parties’ claim construction disputes have no bearing on the relative expenditure of resources; rather, the investment in the ITC proceeding, including preparation for the upcoming hearing, is extensive, and it appears that “thousands of pages of contentions and expert reports on validity” have already been exchanged in the ITC proceeding. Reply 4; Sur-Reply 6. Thus, we determine that the third *Fintiv* factor weighs against institution.

4. *Fourth Fintiv Factor: Overlap Between Issues Raised in Petition and in Parallel Proceeding*

Patent Owner contends this factor favors denial. Prelim. Resp. 11–12. More particularly, Patent Owner contends there is extensive overlap between the validity issues raised in the Petition and in the related ITC proceeding, because the prior art references and combinations advanced in Grounds 1–3 of the Petition are nearly an identical subset of those advanced in the related ITC proceeding. *Id.* at 11; *see* Sur-Reply 6–8. More specifically, Patent Owner contends nearly all challenged claims are both asserted and alleged invalid in the related ITC proceeding, with dependent claims 6, 10, and 13 being the only unasserted claims challenged in the present proceeding. Prelim. Resp. 11. Patent Owner also argues that Petitioner increased the

overlap between the validity issues raised in this proceeding and the related ITC proceeding by expressly incorporating the Petition into the related ITC proceeding. *Id.* at 11–12.

Petitioner contends this factor weighs in favor of institution, in that there is not complete overlap between the present proceeding and the related ITC proceeding. Reply 5. More specifically, Petitioner contends the related ITC proceeding’s invalidity determination “affects only whether the ITC will issue an exclusion order and is not binding in any other forum,” and the burden of proof to show invalidity is a “clear and convincing” standard in the related ITC proceeding as compared to the “preponderance of the evidence” standard of the present proceeding. *Id.* at 5–6. Petitioner further contends that, of the seventeen claims Petitioner has challenged, four claims (*i.e.*, claims 6, 9, 10, and 13) are no longer at issue in the related ITC proceeding. *Id.* at 6, 6 n.2.

In its Sur-Reply, Patent Owner notes that Petitioner does not identify any “material differences that distinguish the challenged unasserted claims from those at issue in the ITC investigation.” Sur-Reply 7. Nevertheless, Patent Owner stipulates, contingent upon our denial of institution here, that “any Challenged Claim presented for the district court trial will not extend beyond those addressed in the ITC’s Final Determination for Investigation No. 337-TA-1181.” Sur-Reply 7–8 (internal footnotes omitted). Patent Owner contends that this contingent stipulation further strengthens its arguments that this factor favors denying institution. Sur-Reply 8.

With regard to this fourth *Fintiv* factor, if a petition “includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding,” this fact has favored denial because “concerns of inefficiency and the possibility of conflicting decisions [are]

particularly strong.” *Fintiv*, Paper 11, 12. Here, the statutory grounds, arguments, prior art evidence, and challenged claims at issue in the present proceeding are substantially the same as a subset of statutory grounds, arguments, prior art evidence, and challenged claims at issue in the related ITC proceeding. Prelim. Resp. 11–12; Reply 5–6; *compare* Pet. 16 with Ex. 2012, 93–94, 97, 101–102. We recognize that there is not complete overlap between the claims challenged in the Petition and those at issue in the ITC investigation, with claims 6, 9, 10, and 13 being challenged in this proceeding but not asserted in the ITC.⁷ We agree with Patent Owner, however, that the ITC investigation will necessarily address validity issues relating to base claim 1, and therefore the “foundational validity issues will be addressed at the ITC.” Prelim. Resp. 11–12. Even though Petitioner contests Patent Owner’s assertion that Petitioner’s “case against the unasserted claims simply piggybacks on prior analysis addressing the asserted claims” (Prelim. Resp. 12), Petitioner does not address the substance of those analyses (Reply 6), or argue that they result in the Petition including materially different grounds, arguments, and/or evidence than those presented in the ITC investigation. *Fintiv*, Paper 11, 11–12. Additionally, Patent Owner’s stipulation that it will not present for the

⁷ Petitioner contacted the Board by email on November 24, 2020, to inform us that the claims at issue in the ITC investigation have been narrowed further, leaving only 7 claims that are at issue both here and in the ITC, with the remaining claims [i.e., 6–13, 17–18, claim 4 not being challenged in this proceeding] being challenged only in the present proceeding. Ex. 3001. Because both parties briefed *Fintiv* factor 4 in reliance on the original claim overlap, we use those arguments in our analysis, but we note that the outcome of our analysis would be no different with the present 7-claim overlap.

district court trial any claims challenged in the Petition but not addressed in the ITC's final determination further minimizes "concerns of inefficiency and the possibility of conflicting decisions." *Fintiv*, Paper 11 at 11.

In view of the foregoing, we determine that the fourth *Fintiv* factor weighs against institution.

5. *Fifth Fintiv Factor: Whether Petitioner and Parallel Proceeding Defendant Are Same*

The parties do not dispute that the same parties involved in the present proceeding are also involved in the ITC proceeding. Prelim. Resp. 13 ("The parties to this proceeding before the Board are the same as the ITC investigation."); Sur-Reply 8; *see generally* Reply. Thus, this factor weighs against institution.

6. *Sixth Fintiv Factor: Other Circumstances (Including Merits)*

Patent Owner contends this factor favors denial. As contended by Patent Owner, the Board should deny institution of the Petition because it is "deeply flawed on the merits." Prelim. Resp. 13. Patent Owner further contends "other circumstances compel the same result, including the continuing opportunity for [Petitioner] to utilize [Patent Owner's] arguments in the [related ITC proceeding] as a roadmap for navigating this proceeding." *Id.*

Petitioner contends this factor weighs in favor of institution, because Petitioner has presented meritorious grounds for institution. Reply 7. Petitioner further disputes Patent Owner's contention that Petitioner unfairly gained a "roadmap" from Patent Owner's preliminary validity contentions, noting that the "roadmap" concern the Board expressed relating to follow-on petitions is not applicable here. *Id.* at 7–8 (citing *General Plastic*).

Patent Owner contends that the “Board should not condone” Petitioner initiating “a delayed IPR with recycled prior art arguments” before the Board, in which “errors and insights revealed in the more mature ITC investigation can be addressed and leveraged.” Sur-Reply 8–9.

Petitioner presents three obviousness grounds based on combinations of five references; the grounds allege that numerous aspects of the challenged claims (e.g., battery separators, need and means to control peel strength and thermal shrinkage, suitable inorganic particle to binder ratios) were known, and there would have been reason to combine these elements of the relied-upon references with a reasonable expectation of success. *See generally* Pet. Patent Owner counters that Petitioner has failed to explain how to achieve its proposed modifications and combinations, and that Petitioner’s references fail to meet certain limitations of the challenged claims. *See generally* PO Resp. We determine that the parties have not identified particular strengths or weaknesses that in our view would tip the balance either for or against discretionary denial when considered as part of a balanced assessment of the *Fintiv* factors in this case. *See Fintiv*, Paper 11, 14–15. We further agree with Petitioner that Patent Owner’s “roadmap” argument is derived from the *General Plastic* factors, which concern multiple petitions filed by the same petitioner, and which are generally not applicable in the case of a related proceeding. *See* Reply 7–8. Accordingly, we are not persuaded that this particular argument weighs in favor of denying institution.

Thus, we determine that the facts underlying this sixth *Fintiv* factor are neutral.

7. *Conclusion on the Factors*

We determine that *Fintiv* factors one, two, three, four, and five weigh against institution. We determine that *Fintiv* factor six is neutral. No factor in our analysis weighs in favor of institution. Thus, we determine that the *Fintiv* factors, on balance, weigh in favor of discretionary denial of the proceeding. For these reasons, we exercise our discretion to deny institution under § 314(a).

III. CONCLUSION

For the reasons set forth above, we determine that the factors and circumstances, on balance, weigh in favor of discretionary denial of the proceeding. Accordingly, we exercise our discretion to deny institution under 35 U.S.C. § 314(a).

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is *denied* and no trial is instituted.

IPR2020-01036
Patent 7,709,152 B2

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