

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner,

v.

MOJO MOBILITY INC.,
Patent Owner.

IPR2023-01093
Patent 11,201,500 B2

Before THOMAS L. GIANNETTI, KARA L. SZPONDOWSKI, and
DAVID COTTA, *Administrative Patent Judges*.

Opinion for the Board filed by GIANNETTI, *Administrative Patent Judge*.
Opinion Dissenting filed by SZPONDOWSKI, *Administrative Patent Judge*.

GIANNETTI, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

Samsung Electronics Co., Ltd. (“Petitioner”) filed a Petition requesting *inter partes* review of claims 2, 4, and 18 (the “challenged claims”) of U.S. Patent No. 11,201,500 B2 (Ex. 1001, the “’500 patent”). Paper 1 (“Pet.”). Mojo Mobility Inc., Patent Owner, filed a Preliminary Response. Paper 7 (“Prelim. Resp.”). With authorization, Petitioner filed a Preliminary Reply. Paper 8 (“Prelim. Reply”). Patent Owner filed a Preliminary Sur-Reply. Paper 10 (“Prelim. Sur-Reply”).

We have authority to determine whether to institute an *inter partes* review. 35 U.S.C. § 314 (2018); 37 C.F.R. § 42.4(a) (2023). The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted unless “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” However, institution of *inter partes* review is discretionary. *See Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.”). For the reasons stated below, we exercise our discretion not to institute *inter partes* review.

II. BACKGROUND

A. Related Proceedings

The parties identify the following district court proceeding involving the ’500 patent, *Mojo Mobility Inc. v. Samsung Electronics Co., Ltd.*, No. 2-22-cv-00398 (E.D. Tex.) (asserting the ’500 patent and also U.S. Patent Nos. 9,577,440, 11,292,349, 11,316,371, 7,948,208, 11,342,777, and 11,462,942). Pet. 1; Paper 5, 2. The parties also identify the following *inter*

partes review proceedings involving the '500 patent: (1) IPR2023-01091, challenging claims 1, 3, 9, 11–13, and 20 and (2) IPR2023-01092, challenging claims 23–31. Pet. 1; Paper 5, 2; Paper 3, 1–2.¹

In addition to the three separate petitions challenging the '500 patent, Petitioner has filed fifteen other petitions challenging patents related to the '500 patent. *See* Prelim Resp. 1 & n.1.² Nine of the eighteen total petitions filed by Petitioner (including this Petition) have institution decisions due in January 2024 (the “first set”). *Id.* at 18 (Case Timeline). The remaining nine (the “second set”) have institution decisions due in February 2024. *Id.*

B. Real Parties-in-Interest

Petitioner identifies the following real parties-in-interest: Samsung Electronics Co., Ltd., and Samsung Electronics America, Inc. Pet. 1. Patent Owner identifies Mojo Mobility Inc. as the real party in interest. Paper 5, 2.

¹ Consistent with the Board’s practice for handling parallel petitions, Petitioner filed a Notice Regarding Multiple Petitions (Paper 3, “Notice”). *See Consolidated Trial Practice Guide* (November 2019) (available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>). In the Notice, Petitioner states that “[t]here was no practicable way to fit the challenges in a single petition” due to the length of the claims and the “substantially different features” in the dependent claims. Notice 3. Although we have discretion to deny a parallel petition under 35 U.S.C. § 314(a), in view of our assessment of the merits, we do not reach that issue here.

² Those fifteen additional petitions are the following: (1) IPR2023-01086, (2) IPR2023-01087, (3) IPR2023-01088, (4) IPR2023-01089, (5) IPR2023-01090, (6) IPR2023-01094, (7) IPR2023-01095, (8) IPR2023-01096, (9) IPR2023-01097, (10) IPR2023-01098, (11) IPR2023-01099, (12) IPR2023-01100, (13) IPR2023-01101, (14) IPR2023-01102, and (15) IPR2023-01124.

C. The '500 Patent

The '500 patent is titled “Efficiencies and Flexibilities in Inductive (Wireless) Charging.” Ex. 1001, (54). The '500 patent relates to power supplies, power sources, and a system and method for inductive charging portable devices. *Id.* at Abstract, 2:16–18.

The '500 patent describes a typical system as including a base unit, such as a charger or power supply, which includes one or more primary coils having a planar surface and that is activated to generate a magnetic field in a direction substantially perpendicular to the planar surface to provide power to one or more receivers to power or charge one or more portable devices or batteries. *Id.* at 4:15–22. In one embodiment, the charger device includes a “Field Effect Transistor (FET) that periodically turns the current through a coil on and off.” *Id.* at 61:65–62:2. The '500 patent explains that “the power transfer efficiency is increased when a capacitor of appropriate value is placed in parallel with the FET,” and when the circuit is driven at a resonant frequency, the amount of current through the FET varies based on proximity of the primary coil to a secondary coil. *Id.* at 62:4–9.

A current sensing system can be used to sense the secondary coil being in close proximity to the primary coil. *Id.* at 62:9–11. Charging is then performed based on a closed loop design, in which the device/receiver communicates information back to the primary, and then the primary determines how much power should be sent to the receiver. *Id.* at 29:26–31.

In an exemplary embodiment, the output voltage to the load is monitored and with changes in the load condition, a chip or a Micro Controller Unit (MCU) varies the frequency or the duty cycle of the FET

driver to achieve optimum operation and controlled output voltage with a changing load. *Id.* at 32:15–19.

D. Illustrative Claims

The Petition challenges claims 2, 4, and 18, each of which depends from claim 1. Claim 1 as well as claims 2, 4, and 18, which are illustrative of the claimed subject matter are reproduced below.³

[1.a] A system for inductive powering or charging of portable devices, the system comprising:

[1.b] one or more primary coils that are substantially planar and parallel to a surface of the system for powering or charging one or more compatible portable devices including batteries and receiver units, each receiver unit including a receiver coil and a receiver circuit including a receiver rectifier circuit;

[1.c] one or more drive circuits including one or more FET drivers, FET switches, and capacitors coupled to the one or more primary coils that when operated apply an alternating electrical current to the one or more primary coils to generate a magnetic field in a direction substantially perpendicular to the plane of the one or more primary coils and the surface of the system to provide power to the one or more portable devices capable of being powered or charged by the system when present and near the one or more primary coils;

[1.d] one or more sense circuits to monitor the current through the one or more primary coils to sense communications from the one or more receiver coils; and

[1.e] one or more communication and control circuits including one or more microcontrollers coupled to the one or more drive circuits and the one or more sense circuits that detect

³ Paragraph labeling has been added based on those used by the parties.

communications through the one or more sense circuits via the one or more primary coils and control the one or more drive circuits to control the powering or charging of the one or more compatible portable devices;

[1.f] wherein the one or more communication and control circuits: operate the one or more drive circuits near a first resonant frequency of a circuit formed by a primary coil and a drive circuit and a receiver coil and a receiver circuit of a compatible portable device when nearby;

[1.g] switch the one or more primary coils at a frequency and power level sufficient to transfer power to one or more of the receiver units when near the one or more primary coils for a sufficiently long period of time to activate the one or more receiver circuits and to receive a response from the one or more receiver circuits via the one or more receiver coils which the one or more primary coils sense via the one or more sense circuits as a modulation of one or more primary coil currents;

[1.h] detect, through the one or more sense circuits, communications from the one or more receiver units through the one or more receiver coils including information corresponding to one or more voltages at one or more outputs of the one or more receiver rectifier circuits induced by the one or more primary coils and the one or more receiver coils and information associated with the one or more portable devices and/or receiver units to enable the one or more communication and control circuits to identify the one or more portable devices and/or receiver units and to determine any one or more appropriate charging or powering algorithm profiles therefor;

[1.i] for each portable device, determine the primary coil electromagnetically most aligned with the receiver coil of the portable device;

[1.j] drive the one or more FET switches associated with the most aligned one or more primary coils;

[1.k] periodically receive information corresponding to one or more output voltages or currents of the one or more

receiver rectifier circuits via the one or more primary coils and the one or more sense circuits; and

[1.1] regulate in a closed loop feedback manner the one or more output voltages or currents of the one or more receiver rectifier circuits by adjusting the frequency or duty cycle of the one or more drive circuits during the charging or powering of the one or more portable devices.

Ex. 1001, 70:14–71:20, Certificate of Correction.

2. The system of claim 1, further comprising one or more voltage regulator circuits that can change input voltages to the one or more drive circuits between two or more levels to accommodate different powers required by the portable devices.

Id. at 71:21–25.

4. The system of claim 1, wherein the one or more communication and control circuits are designed to receive from a receiver unit of a portable device identification information including one or more codes identifying the manufacturer of the portable device and/or receiver unit, a unique portable device and/or receiver ID code, a charge algorithm profile, and a power requirement of the portable device and/or receiver unit.

Id. at 71:31–38.

18. The system of claim 1, further wherein the one or more communication and control circuits use a Proportional-Integral-Derivative control technique to regulate one or more outputs of the one or more receiver rectifier circuits.

Id. at 72:35–38.

E. Prior Art and Other Evidence

The Petition relies on the following references:

Name	Reference	Publication/Issue Date	Exhibit(s)
Okada	JP 2006-141170 A	June 1, 2006	Ex. 1005
Berghegger	US 6,912,137 B2	June 28, 2005	Ex. 1006
Black	US 2006/0145660 A1	July 6, 2006	Ex. 1007
Odendaal	US 6,960,968 B2	Nov. 1, 2005	Ex. 1008
Masias	US 7,339,353 B1	Mar. 4, 2008	Ex. 1031
Kazutoshi	US 2005/0135129 A1	June 23, 2005	Ex. 1034
Calhoon	US 2005/0127868 A1	June 16, 2005	Ex. 1041

In addition, Petitioner submits the Declaration of R. Jacob Baker, Ph.D., P.E. (Ex. 1002, “Baker Decl.”).

F. Asserted Grounds of Unpatentability

Petitioner asserts the challenged claims are unpatentable on the following grounds:

Claims Challenged	35 U.S.C. §⁴	References
2	103	Okada, Odendaal, Berghegger, Black, Masias

⁴ Because the earliest application from which the ’500 patent claims priority was filed before March 16, 2013 (Ex. 1001, (63)), the pre-AIA (“America Invents Act”) version of § 103 applies. Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 285–88 (2011).

Claims Challenged	35 U.S.C. § ⁴	References
4	103	Okada, Odendaal, Berghegger, Black, Calhoon
18	103	Okada, Odendaal, Berghegger, Black, Kazutoshi

See Pet. 2–3.

III. REQUEST FOR DENIAL UNDER 35 U.S.C. § 314(A)

Institution of an *inter partes* review is discretionary. See 35 U.S.C. § 314(a) (authorizing institution of an *inter partes* review under particular circumstances, but not requiring institution under any circumstances); *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 273 (2016) (“[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.”); *SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1356 (2018) (“[Section] 314(a) invests the Director with discretion on the question whether to institute review” (emphasis omitted)); *Harmonic*, 815 F.3d at 1367 (Fed. Cir. 2016) (“[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.”).

Patent Owner argues that we should exercise our discretion under 35 U.S.C. § 314(a) and not institute trial, given that trial in the parallel district court litigation in the Eastern District of Texas is scheduled for August 5, 2024, and therefore is scheduled to finish over five months before the deadline for a final written decision in this case. Prelim. Resp. 18–19.

When determining whether to exercise discretion to deny institution in view of a parallel proceeding, we consider the following factors:

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.

Apple Inc. v. Fintiv, Inc., IPR2020-00019, Paper 11 at 5–6 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”). “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 the *Fintiv* factors, we take “a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review,” recognizing that “there is some overlap among these factors” and that “[s]ome facts may be relevant to more than one factor.” *Id.* at 6.

On June 21, 2022, the Director of the United States Patent and Trademark Office issued a Memorandum setting forth an “Interim Procedure for Discretionary Denials in AIA Post Grant Proceedings with Parallel District Court Litigation.” Exhibit 1064 (“Guidance Memo”). The Guidance Memo states that “to benefit the patent system and the public good, the PTAB will not rely on the *Fintiv* factors to discretionarily deny institution in view of parallel district court litigation where a petition presents compelling evidence of unpatentability.” *Id.* at 2. “Compelling, meritorious challenges are those in which the evidence, if unrebutted in trial, would plainly lead to a conclusion that one or more claims are unpatentable by a preponderance of the evidence.” *Id.* at 4.

In the analysis that follows, we first consider whether *Fintiv* factors 1–5 weigh in favor of denying institution, and, if so, we must also determine whether the Petition presents compelling merits. *See CommScope Techs. LLC v. Dali Wireless, Inc.*, IPR2022-01242, Paper 23 at 4 (PTAB Feb. 27, 2023) (precedential) (“In circumstances where . . . the Board’s analysis of *Fintiv* factors 1–5 favors denial of institution, the Board shall then assess compelling merits.”).

A. Likelihood of a Stay (Factor 1)

A district court stay of parallel litigation pending resolution of an *inter partes* review allays concerns about inefficiency and duplication of efforts, and strongly weighs against exercising our authority to deny institution. *Fintiv*, Paper 11 at 6.

Petitioner’s motion to stay the district court litigation pending in the Eastern District of Texas has not been ruled on. Prelim. Resp. 18. Patent Owner asserts that the motion to stay “will almost certainly be denied pre-institution,” because the Eastern District of Texas universally denies a motion to stay pre-institution. *Id.* (citing Ex. 2002, 1–2). Patent Owner contends that “even if instituted, the timing and advanced stage of litigation indicates that Judge Gilstrap is highly likely to deny a motion to stay.” *Id.* at 18–19 (citing *MyPort, Inc. v. Samsung Elecs. Co., Ltd.*, Case No. 2:22-CV-00114-JRG, Dkt. 73 at 4-5 (E.D. Tex. June 13, 2023); *Solas OLED Ltd. v. Samsung Display Co., Ltd.*, Case No. 2:19-CV-00152-JRG, Dkt. 133 at 3-4 (E.D. Tex. July 17, 2020); *Oyster Optics, LLC, v. Infierna Corp.*, Case No. 2:19-CV-00257-JRG, Dkt. 87 at 4-5 (E.D. Tex. July 17, 2020)).

Apple Inc. v. Fintiv, Inc., IPR2020-00019, Paper 15 at 12 PTAB May 13, 2020) (informative), cautions against speculating whether the district court would grant a stay if one were requested. Accordingly, we regard this factor is neutral.

B. Proximity of Trial Date to Projected Statutory Deadline (Factor 2)

Petitioner asserts this factor is neutral. Pet. 83–84. Based on median time-to-trial statistics for the Eastern District of Texas (19 months), Petitioner asserts that the projected trial date will be May 2024. Pet. 83 (citing Ex. 1065, 35). Petitioner argues that the fact “the FWD may come after the trial date is not dispositive,” and therefore this factor is neutral. *Id.* Patent Owner contends this factor “weighs heavily in favor of denial.” Prelim. Resp. 20–21.

Patent Owner argues that trial will occur prior to any anticipated final written decision. *Id.* at 20. Patent Owner asserts that jury selection in the parallel district court litigation has been scheduled by Judge Gilstrap for August 5, 2024, about five months before the projected statutory deadline (January 2025) for our final written decision. *Id.*; Ex. 1066.

We agree with Patent Owner’s analysis based on the schedule set by Judge Gilstrap. The fact that the time-to-trial statistics cited by Petitioner predict an even earlier trial date than that set by Judge Gilstrap merely confirms that the schedule set by the district court is credible and should be given weight. We are not persuaded by Petitioner’s argument that diligence in filing the Petition “in advance of the one-year bar date” and within four months of PO’s infringement contentions in the Texas Litigation should

weigh in favor of institution. Pet. 83–84; Prelim. Resp. 20 (timeline).⁵ We find that this factor favors exercising our discretion to deny institution.

C. Investment in the Parallel Proceeding (Factor 3)

Petitioner contends that this factor “weighs against denial” because “[t]he district court case is in the early stages.” Pet. 84. Patent Owner responds that “the district court proceeding has been pending since October of 2022” and “there is significant investment in the parallel district court proceeding.” Prelim. Resp. 21. Patent Owner explains that the “Parties have prepared and exchanged infringement and in validity contentions, presented initial disclosures, and are in the midst of substantial fact discovery,” and “by the time the Board would even issue an institution decision, claim construction will have been briefed and argued.” *Id.* Patent Owner’s timeline shows that a *Markman* hearing is scheduled for February 6, 2024, which is shortly after the expected institution decisions for this case and the eight others comprising the “first set,” and shortly before the expected institution decisions for the remaining nine cases in the “second set.” *See* Prelim. Resp. 22 (timeline); Ex. 1066, 3 (March 28, 2023, Docket Control Order).

The district court proceeding has been pending since October 2022 and has already advanced well beyond the pleadings stage. Fact discovery is

⁵ Patent Owner’s timeline shows the filing date accorded the “first set” of IPRs as July 12, 2023. Prelim. Resp. 20. That date is incorrect. The actual filing dates accorded for these cases range from June 27 to June 29, 2023. The accorded filing dates for the “second set” of IPRs shown in the timeline range from June 29 to June 30, 2023.

well underway (the deadline to “substantially complete document production” has passed, fact discovery is set to close a little more than two months after the issuance of this decision) and substantial preparation for a February 2024 *Markman* Hearing (including briefing) will be completed by January 2024. Ex. 1066 (Docket Control Order). Even more work will be invested (including the *Markman* hearing) before the institution decisions are due for the “second set” of cases. While there is still much work to be done on the district court case, we find that this factor favors exercising our discretion to deny institution.

D. Overlap of Issues (Factor 4)

1. Background

Patent Owner asserts there is “substantial overlap” between the Petition and Petitioner’s invalidity contentions in the district court litigation, which include “the same principal references,” Okada, Berghegger, and Odendaal. Prelim. Resp. 23–24 (citing Ex. 2001, 13–18). Anticipating this argument, Petitioner stipulated “that, if the IPR is instituted, Petitioner will not pursue the IPR grounds in the district court litigation.” Pet. 84–85 (citing *Sand Revolution II, LLC v. Continental Intermodal Group – Trucking LLC*, IPR2019-01393, Paper 24 at 12 (PTAB June 16, 2020) (informative)).

Patent Owner pointed to the narrowness of Petitioner’s proffered stipulation, asserting that the stipulation was insufficient to overcome concerns of “duplicative efforts” and conflicting outcomes based on the Board’s own current guidance on the *Fintiv* factors. Prelim. Resp. 23–24 (citing *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 18–19 (PTAB Dec. 1, 2020) (precedential as to § II.A)).

Petitioner replied by (1) pointing to a recent change in the claims being asserted in the district court litigation, narrowing the number of claims that are in suit, and (2) providing a new “hybrid” stipulation, “to further mitigate concerns on *Fintiv*.” Prelim. Reply 1–3. We discuss these new arguments in turn.

2. *Narrowed Claims*

As ordered by the district court, Patent Owner reduced the number of claims asserted in the district court litigation to 32. Ex. 1201. As a result, one claim challenged in the Petition (claim 4) would not be asserted in the district court litigation, and further reductions in the asserted claims have been ordered by the court. Petitioner contends that as a result, “there will be no complete overlap of claims and prior art combinations amongst the Texas Litigation and IPR proceeding(s) should any [of] Petitioner’s IPR(s) be instituted.” Prelim. Reply 2.

As the record currently stands, claims 2 and 18 in the ’500 patent will be before both the district court and the Board in this proceeding, if instituted. The other claims of the ’500 patent before the district court (independent claims 1 and 23 and dependent claim 30), would be before the Board in IPR2023-01091 and IPR2023-01092. Thus, if trial in district court proceeds as scheduled, all of the ’500 patent claims before the district court would be re-considered by the Board.

The Board’s precedential *Fintiv* decision discusses the situation where a petition challenges additional claims to those challenged in district court. *See Fintiv*, IPR2020-00019, Paper 11. The Board concludes in *Fintiv* that “if a petition involves the same prior art challenges but challenges claims in

addition to those that are challenged in the district court, *it may still be inefficient to proceed* because the district court may resolve validity of enough overlapping claims to resolve key issues in the petition.” *Fintiv*, Paper 11 at 13 (emphasis added). Here, Patent Owner has stipulated not to assert infringement of any claims challenged in the Petition that have been or will be dropped from the district court action. Prelim. Sur-reply 4. This diminishes the significance of the non-overlapping claims. We determine that, as in *Fintiv*, it would be inefficient to proceed because two of the three claims in this proceeding are common to both proceedings, and Patent Owner has stipulated not to assert infringement of the additional claim in the Petition.⁶

3. *New Stipulation*

Petitioner’s original stipulation was narrower than a *Sotera* stipulation, i.e., a stipulation “not to pursue in a parallel district court proceeding the same grounds as in the petition or any grounds that could have reasonably been raised in the petition.” *See* Guidance Memo at 7, 9; *Sotera*, Paper 12 at 13–14, 18. Petitioner’s new stipulation adds to its original stipulation a provision that “if this IPR is instituted, Petitioner will not pursue an invalidity defense in the Texas Litigation with respect to the

⁶ Petitioner’s reliance (Prelim. Reply 2) on the Board’s non-precedential opinion in *Apple, Inc. v. SEVEN Networks, LLC*, IPR2020-00156, Paper 10 (PTAB June 15, 2020), is misplaced. In that case, the sole common ground involved “mutually exclusive dependent claims.” Paper 10 at 13. Here, the two independent claims (claims 1 and 23) and four dependent claims of the ’500 patent are common to both district court and IPR proceedings, and the same prior art is asserted in each proceeding.

challenged claims of the '500 patent in this Petition based on . . . *any prior art reference that forms the basis of any instituted ground.*” Prelim. Reply 2 (emphasis added).

As was the case with its original stipulation, Petitioner’s new stipulation is narrower than the *Sotera* stipulation approved in the Guidance Memo, for it does not include the prohibition against asserting grounds or references “that could have reasonably been raised in the petition.” Ex. 1064, 3. The Board’s informative *Sand Revolution* decision expressed skepticism that such “hybrid” stipulations achieve the goals of avoiding duplication and inconsistent decisions:

Petitioner *could have stipulated* that it would not pursue any ground raised or that *could have been reasonably raised* in an IPR, i.e., any ground that could be raised under §§ 102 or 103 on the basis of prior art patents or printed publications. *A broader stipulation of that nature, not at issue here, might better address concerns regarding duplicative efforts and potentially conflicting decisions in a much more substantial way.* Likewise, such a stipulation might help ensure that an IPR functions as a true alternative to litigation in relation to grounds that could be at issue in an IPR. Further still, Petitioner could have expressly waived in the district court any overlapping patentability/invalidity defenses. Doing so might have tipped this factor more conclusively in its favor.

Sand Revolution, Paper 24 at 12 n.5 (emphasis added). The Board in *Sand Revolution* accorded a stipulation not containing the “could have been reasonably raised” provision “marginal[]” weight. *Id.* at 12.

Petitioner’s stipulation does reduce somewhat the overlap relating to the challenge presented in the Petition, but not as fully as would a *Sotera* stipulation. If we were to grant institution in this and the related IPRs, the Board would reconsider five '500 patent claims whose validity was

previously tried before the district court, including the two independent claims. Thus, while the new stipulation “mitigates to some degree the concerns of duplicative efforts between the district court and the Board, as well as concerns of potentially conflicting decisions” (*Sand Revolution*, Paper 24 at 12), it does not remove them. Also, in this case, the relevant art appears to include multiple references that disclose the same basic concepts. Thus, even with Petitioner’s stipulation, Petitioner could raise substantially the same arguments in district court using prior art references that did not “form[] the basis of any instituted ground.” Although this new stipulation is somewhat broader than that in *Sand Revolution*, the concerns discussed in *Sand Revolution* remain. Accordingly, this factor weighs only slightly against discretionary denial. *See Sand Revolution*, Paper 24 at 12.

E. Identity of Parties (Factor 5)

Patent Owner asserts that denying institution is supported because the same parties are involved in both the present proceeding and the parallel district court litigation. Prelim. Resp. 24–25. Petitioner does not dispute this fact. Pet. 87.

We determine that this factor weighs in favor of a discretionary denial. *See Sotera*, Paper 12 at 19 (citing *Fintiv*, Paper 15 at 15; *Sand Revolution*, Paper 24 at 12–13).

F. Other Circumstances, Including the Merits (Factor 6)

Under *CommScope Technologies LLC v. Dali Wireless, Inc.*, if we determine that the other *Fintiv* factors favor discretionary denial, we must

also consider whether the Petition presents compelling merits. IPR2022-01242, Paper 23 at 4–5.

We take “a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review” when evaluating these factors. *Fintiv*, Paper 11 at 6. We have considered the circumstances and facts before us in view of *Fintiv* factors 1–5. As discussed above, factor 1 is neutral, factors 2, 3, and 5 weigh in favor of discretionary denial of institution, and factor 4 weighs slightly against discretionary denial. We, therefore, conclude that the evidence of record on factors 1–5 favors exercising our discretion to deny institution of an *inter partes* review.

Accordingly, following *CommScope*, where, as here, our analysis of the first five *Fintiv* factors favors denial of institution, we address the merits of the Petition to determine whether the merits are compelling.

IV. COMPELLING MERITS ANALYSIS

A. Legal Standard

As discussed *infra*, “[c]ompelling, meritorious challenges are those in which the evidence, if unrebutted in trial, would plainly lead to a conclusion that one or more claims are unpatentable by a preponderance of the evidence.” Guidance Memo at 4. The Guidance Memo does not change the statutory standard for institution under 35 U.S.C. § 314(a). Instead, a determination of compelling merits will outweigh the other *Fintiv* factors, and such challenges will be allowed to proceed even if a district court litigation is proceeding in parallel. *Id.*

B. Claim Construction

We construe claim terms only as relevant to the parties' contentions and only to the extent necessary to resolve the issues in dispute. *See Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999); *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017).

Neither party proposes claim constructions for our consideration. Petitioner reports that it "believes that no special constructions are necessary to assess whether the challenged claims are unpatentable over the asserted prior art." Pet. 5 (citing Baker Decl. ¶ 68). Patent Owner does not dispute Petitioner's position or discuss claim construction. Therefore, we determine there are no claim terms that need to be construed at this stage.

C. Level of Ordinary Skill in the Art

Petitioner contends a person of ordinary skill in the art of the '500 patent would have possessed "at least a master's degree in electrical engineering, or a similar discipline," and would have had "two or more years of experience with wireless charging systems, including, for example, inductive power transfer systems," with additional education supplementing "practical experience and vice versa." Pet. 4 (citing Baker Decl. ¶¶ 20–21).

Patent Owner does not dispute Petitioner's description of a person of ordinary skill in the art or provide its own description.

We regard Petitioner's description as consistent with the challenged patent and the prior art before us. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (prior art itself may reflect an appropriate level of skill). Thus, for the purpose of our decision, we adopt Petitioner's proposal.

D. Principles of Law

In an *inter partes* review, “the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic*, 815 F.3d at 1363 (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)); *see also* 37 C.F.R. § 42.104(b) (requiring a petition for *inter partes* review to identify how the challenged claim is to be construed and where each element of the claim is found in the prior art patents or printed publications relied upon).

A patent claim is unpatentable under 35 U.S.C. § 103 if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious to a person having ordinary skill in the art to which said subject matter pertains. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved based on underlying factual determinations including: (1) the scope and content of the prior art; (2) differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) when presented, objective evidence of nonobviousness, i.e., secondary considerations.⁷ *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). Petitioner cannot satisfy its burden of proving obviousness by employing “mere conclusory statements,” but “must instead articulate specific reasoning, based on evidence of record, to support the legal conclusion of obviousness.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d

⁷ Patent Owner does not present any objective evidence of secondary considerations as to any of the challenged claims.

1364, 1380 (Fed. Cir. 2016). A reason to combine or modify the prior art may be found explicitly or implicitly in market forces; design incentives; the “interrelated teachings of multiple patents”; “any need or problem known in the field of endeavor at the time of invention and addressed by the patent”; and the background knowledge, creativity, and common sense of the person of ordinary skill. *Perfect Web Techs., Inc. v. InfoUSA, Inc.*, 587 F.3d 1324, 1329 (Fed. Cir. 2009) (quoting *KSR*, 550 U.S. at 418–421).

E. Overview of the Prior Art

1. Okada (Ex. 1005)

Okada is a Japanese Patent Application Publication titled “Electric Power Supply System, Power Transmitting Device, and Power Receiving Device for System.” Ex. 1005, (54). Okada discloses a power supply system that supplies power to different types of receivers. *Id.* at Abstract. The system uses a common cradle having a power transmitting module including an internal coil that is supplied with a commercial voltage and a receiver having a power receiving module including an internal coil. *Id.* When a receiver such as a PDA (Personal Digital Assistant) is placed on the common cradle, magnetic coupling occurs between the coil in the receiver and the coil in the common cradle. *Id.* A voltage is induced at both ends of the coil in the receiver based on the commercial voltage supplied to the common cradle and this supplies power to the receiver. *Id.* According to Okada, after power transmission has begun, the carrier wave is periodically transmitted from the common cradle to determine whether the receiver is properly positioned and whether it is fully charged. *Id.* ¶¶ 74–76, Fig. 3.

2. Berghegger (Ex. 1006)

Berghegger is a U.S. Patent titled “Inductive Contactless Power Transmitter.” Ex. 1006, (54). Berghegger discloses an inductive contactless power transmitter having a primary side including a first inductor, a secondary side which includes an inductor that can be coupled to the inductor on the primary side, and a detection means for determining a power demand of the load on the secondary side. *Id.* at Abstract. Berghegger discloses that the inductor on the primary side can be supplemented with a capacitor to obtain a serial resonant circuit that improves the power transmission from the primary side to the secondary side. *Id.* at 2:58–61. Berghegger explains that the inductor on the secondary side is magnetically coupled to the inductor on the primary side, and an AC voltage supplied by the inductor on the secondary side is rectified and supplied to a load, which can include batteries so that the power required by the batteries decreases with an increasing load, in that the power required by load R is variable in time. *Id.* at 6:8–15.

3. Black (Ex. 1007)

Black is a U.S. Patent Application Publication titled “Method and Apparatus for Near Field Communications.” Ex. 1007, (54). Black discloses inductively charging a battery having a multimode near field transceiver that is operable in a passive mode to provide information and active mode to exchange information. *Id.* at Abstract. In an exemplary embodiment, battery 100 comprises a charging coupler 108 that “inductively couples the charging circuit 110 of the battery 100 to an inductive charger 120 via a charger charging coupler 122,” and communications coupler 112 is

coupled to the transceiver of the battery 106. *Id.* ¶ 15. Black explains that when a battery “is placed in range of the inductive charger, communications between the battery and the charger may take place and inductive charging can occur.” *Id.* ¶ 19. According to Black, “[i]f the battery has the capacity to provide power, more information may be transmitted to the charger 120, such as the type of device the battery 100 is coupled to, encryption information, battery characteristics or charging profile.” *Id.* ¶ 21.

4. *Odendaal (Ex. 1008)*

Odendaal is a U.S. Patent titled “Planar Resonator for Wireless Power Transfer.” Ex. 1008, (54). Odendaal discloses coils arranged in spirals “on opposite sides of each other” to form a wireless connection, “so that a battery of a cellphone could be charged without physical wires connecting the cellphone to a charger.” *Id.* at 1:64–67. Odendaal’s coils are spiral-shaped conductors that are “integrated into a planar (flat/thin) structure.” *Id.* at 3:3–5.

5. *Masias (Ex. 1031)*

Masias is a U.S. Patent titled “Power System for Managing Power from Multiple Power Sources.” Ex. 1031, (54). Masias relates to a power system capable of managing power received from multiple power sources and distributing power for use by multiple devices. *Id.* at 1:6–8. Masias discloses that power distribution apparatus 10 includes energy management system (EMS) 50 having first/second battery inlets (12/13), AC and DC external power source inlets (14/15), and outlets 70/71, and that EMS 50 manages “allocation of power from one or more power sources connected at

the inlets,” and also manages “the supply of power to a plurality of outlets at multiple and customizable voltage levels.” *Id.* at 4:5–13.

6. *Kazutoshi (Ex. 1034)*

Kazutoshi is a U.S. Patent Application Publication titled “Contactless Power Supply System.” Ex. 1034, (54) Kazutoshi’s contactless power supply system imposes “continuous control on current in inductive wires, even when circuit load varies.” *Id.* ¶ 5. Kazutoshi discloses using power supply device 21 to provide power to portable object (cart 3) through inductive wires 19, where power is induced on a signal pickup coil 20A used to operate a load (motor 15) in the portable object. *Id.* ¶ 29. According to Kazutoshi, power supply device 21 includes a controller 61, power detection circuit 62, current detection circuit 63, duty computing circuit 64, and pulse driving circuit 65, wherein duty computing circuit 64 “employs the output current of the current detection circuit 63 as a reference, evaluates the duty of the square wave driving the transistor 52 in the current alternator 43,” and provides an output signal to pulse generating circuit 65 to drive transistor 52 and inductive wires 19 to power cart 3. *Id.* ¶¶ 38, 43.

7. *Calhoon (Ex. 1041)*

Calhoon is a U.S. Patent Application Publication titled “Inductive Battery Charger.” Ex. 1041, (54). Calhoon relates to an inductive charging system that transfers energy by inductively coupling a source coil on a power source to a receiver coil for a battery charger portion. *Id.* ¶ 22. Calhoon describes obtaining an ID/serial number of a power receiver, e.g., battery charger assembly 304 or battery pack 350 and wirelessly communicating that information to a power source (e.g., inductive charging

source 302). *Id.* ¶¶ 34, 47. A controller in battery charger 304 may include data, “such as a battery charger ID number, serial number, manufacturer’s name,” used “for novel power operations.” *Id.* ¶¶ 42, 47.

F. Obviousness of Independent Claim 1

Independent claim 1 of the ’500 patent is not challenged in this Petition. *See* IPR2023-01091, Paper 1 (petition challenging claim 1). Because each of claims 2, 4, and 18 challenged in this Petition depends from claim 1, Petitioner initially addresses claim 1 before presenting its challenges to claims 2, 4, and 18. Pet. 6–63. Specifically, Petitioner asserts that claim 1 would have been obvious over Okada, Odendaal, Berghegger, and Black, and presents an analysis of those references in relation to claim 1. *Id.*; Baker Decl. ¶¶ 111–219; *see also* IPR2023-01091, Paper 1, 6–63 (Ground 1). Petitioner also argues that a person of ordinary skill would have been motivated to combine these references. *See, e.g.*, Pet. 18–22.

Referring to the Guidance Memo, Patent Owner argues in response that finding compelling merits is a “high standard” that requires “evidence [that], if unrebutted in trial, would plainly lead to a conclusion that one or more claims are unpatentable by a preponderance of the evidence.” Prelim. Resp. 25. Patent Owner argues that the Petition’s reliance on “at least *five* references in each ground,” and “is unclear at best in some instances and nearly impossible to follow in others.” *Id.* at 2. As an example, Patent Owner argues that Petitioner’s analysis of the closed-loop feedback limitation “is a single paragraph that cites to numerous other sections of the Petition and other exhibits without any specificity.” *Id.* at 3.

Patent Owner contends also that “the Petition fails to establish how to combine the several cited references to arrive at the claimed subject matter.” *Id.* at 4. Patent Owner asserts also that “Petitioner fails to demonstrate that Okada teaches closed-loop feedback control as claimed,” and relies on “a conclusory string citation to Berghegger and other sections of the Petition” to address Okada’s shortcomings. *Id.* at 4–5. Patent Owner contends also that “Petitioner fails to demonstrate how the proposed Okada/Odendaal combination would provide the claimed ‘planar coil(s).’” *Id.* at 5.

1. Combining References and Lack of Particularity

Patent Owner argues that Petitioner’s challenges are based on combinations of “at least *four* references.” Prelim. Resp. 27; *see also supra*, Section II.F (showing five references combined in each of Petitioner’s challenges). Patent Owner asserts that “[t]here are multiple reasons that teach away from this combination, make it not obvious to a [person of ordinary skill] to combine, and that a [person of ordinary skill] would not have had a reasonable expectation of success.” Prelim. Resp. 27. Patent Owner contends also that “any discussion [in the Petition] on using combinations is limited to discrete claim elements (and not the motivation regarding the actual references themselves), resulting in a hunt through string cites and multiple paragraphs in the Petition and Declarations in an attempt to identify the possible motivation to combine the references.” *Id.* at 29. These arguments will be discussed more fully in the sections that follow.

2. Periodically Receive Information Limitation

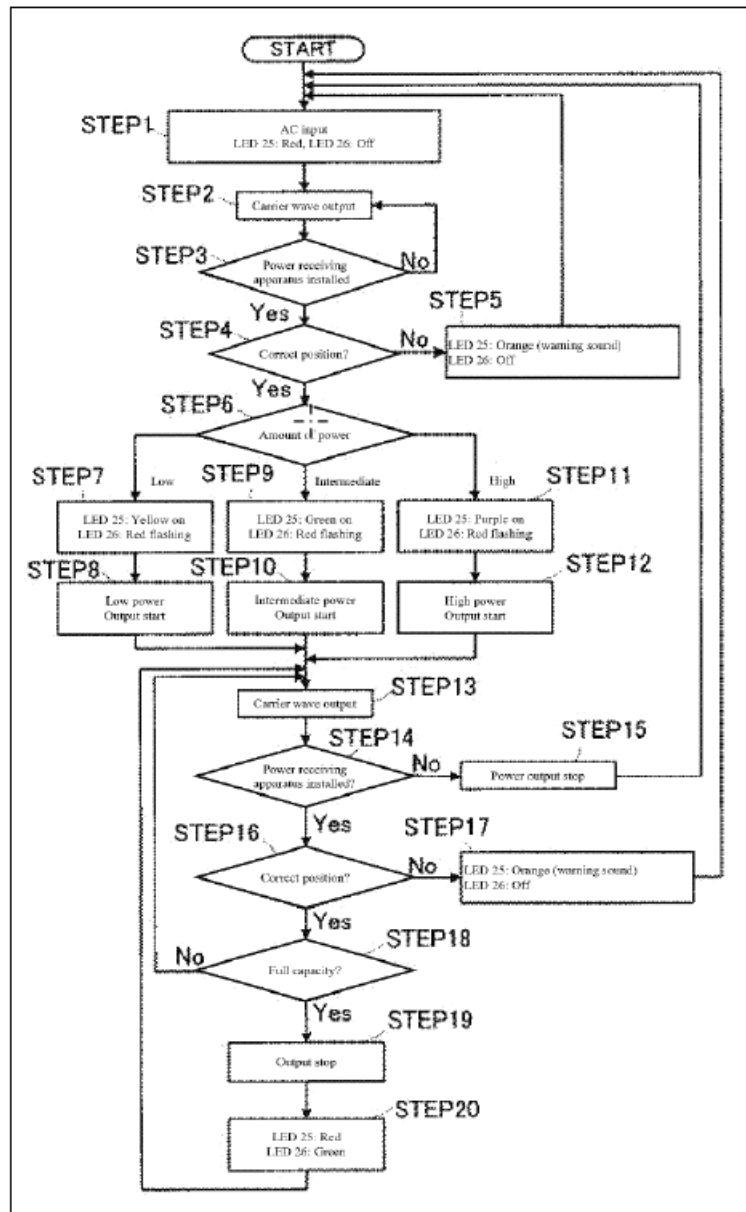
Claim element [1.k] recites that the communication and control circuits “periodically receive information corresponding to one or more output voltages or currents of the one or more receiver rectifier circuits via the one or more primary coils and the one or more sense circuits.” Pet. 60. Related claim element [1.l] recites that the communication and control circuits “regulate in a closed loop feedback manner the one or more output voltages or currents of the one or more receiver rectifier circuits by adjusting the frequency or duty cycle of the one or more drive circuits during the charging or powering of the one or more portable devices.” *Id.* at 63 (*see* further discussion of this element immediately following).

Petitioner relies on the Okada-Odendaal-Berghegger-Black combination to meet this “periodically receive” limitation. *Id.* at 60 (citing Baker Decl. ¶¶ 213–217). Petitioner relies on the disclosure in Okada that after transmission of power has begun, a “periodically transmitted” carrier wave indicates whether the PDA being charged is properly positioned and whether it has been fully charged. *Id.* In addition, Petitioner contends that in “modified” Okada, “a [person of ordinary skill] would have understood that power consumption information corresponds to the output voltage or current of the receiver rectifier circuit . . . because such information is used . . . to determine the level of power for charging the portable device.” *Id.* at 62 (emphases and internal quotation marks omitted).

Patent Owner responds that “the Petition is inadequate and incorrect” as to this limitation. Prelim. Resp. 36. Patent Owner explains, “the Petition points to Okada’s ‘power consumption information’ supposedly as ‘information corresponding to one or more output voltages or currents of the

one or more receiver rectifier circuits.”” *Id.* Patent Owner continues, “Okada is clear as to what the ‘power consumption information’ is; it is not an output voltage or a current of the receiver rectifier circuit. Rather, the ‘power consumption information’ is a code indicating one of three levels of power—high, intermediate, or low—that the receiver communicates once at the beginning of the charging process to the transmitter and indicates the power level the portable device is capable of being charged.” *Id.* Patent Owner explains further that Okada’s “power consumption information” is transmitted only once, at the beginning of the charging process, not periodically, is a static number stored in the receiver in advance, and does not correspond to dynamic receiver rectifier circuit output voltage. *Id.* at 36–37.

In support of this argument, Patent Owner presents Okada’s Figure 3:



Prelim. Resp. 39. Figure 3 above is a flowchart showing the operations carried out in Okada between power transmitting module 10 in Figure 2 and power receiving module 40. *Id.* at 38.⁸

⁸ Petitioner provides an annotated version of this figure in connection with its analysis of this limitation. *See* Pet. 61.

Patent Owner describes the steps in Okada's process. Prelim. Resp. 38–40. In step 3, a carrier wave is used to determine whether a device capable of receiving power is mounted on the cradle. *Id.* at 39. In step 6, if a device capable of receiving power is detected and mounted correctly (Steps 3–4), the receiver transmits and the transmitter receives a “power consumption information” code provided by the device being charged included in the information signal demodulated by the power amount evaluating circuit. *Id.* In steps 7–12, the transmitter adjusts the power transmission output to one of three levels (high, intermediate, or low) by a one-time selection of primary-side coil windings. *Id.* at 39–40. In steps 13–17, after transmission has begun, the carrier wave is periodically applied to determine whether the device has been removed from the cradle. *Id.* at 40. In steps 18–20, Okada's receiver sends a signal to the transmitter that the battery is fully charged. *Id.*

We agree with Patent Owner that the Petition does not present compelling evidence that Okada, alone or in combination with the other references cited by Petitioner, teaches or suggests claim limitation [1.k]. The operation described by Okada and relied on by Petitioner does not “periodically receive information corresponding to one or more output voltages or currents of the one or more receiver rectifier circuits via the one or more primary coils and the one or more sense circuits,” as recited in the claim. Nor does it “regulate in a closed loop manner the output voltage or current of the receiver rectifier circuit during the charging or powering of the portable device,” as recited in claim element [1.l]. Instead, the output current in Okada is determined in steps 6–12 of the flowchart in Figure 3, above, where the receiver transmits and the transmitter receives power

consumption information derived from a code stored on the device being charged. Prelim. Resp. 39–40; Ex. 1005 ¶¶ 69–73. The transmitter adjusts the power to one of three levels, a one-time selection that remains for the duration of the charging. Prelim. Resp. 39. We agree with Patent Owner that in Okada, “there is no periodic receipt of power information of any type, let alone information corresponding to the output voltage or current of the receiver rectifier circuit.” *Id.* at 40 (emphasis omitted).

Petitioner contends that “as explained, the received responsive information in the modified Okada system would have included e.g., ‘power consumption information.’” Pet. 62. First, it is not clear what Petitioner defines the “modified Okada system.” Petitioner’s rote citation to all ten previous claim analysis sections of its Petition (over 50 pages) does not assist us. *See* Pet. 61 (citing §§ IX.A.1(a)–(j)). Next, the citation to Okada (Ex. 1005 ¶¶ 74–76) relates to Steps 13–20 of the process described above. *See* discussion of Figure 3, *infra*. These steps do not relate to the adjustment of output power to match load requirements, but instead describe whether the device has been removed from the cradle or fully charged. *See* Prelim. Resp. 40. We do not find this argument compelling evidence that this limitation is met.

Finally, Petitioner’s one-sentence argument that the “periodically received information” in Okada “would have also included power demand information” similar to Berghegger (Pet. 61–62), is an acknowledgement that Okada itself is insufficient. Petitioner’s rationale for “modifying” Okada also lacks particularity and is also insufficient. Petitioner’s string citation (without page cites or further explanation) to four prior sections of its Petition relating to other claim limitations does not remedy this

insufficiency. *Id.* at 62 (citing §§ IX.A.1(g)–IX.A.1(j) of the Petition).⁹ We further discuss the Petition’s failure to provide compelling evidence of a motivation to “modify” Okada in the following section.

3. Regulate in a Closed-Loop Feedback Limitation

As noted in the previous section, claim element [1.1] recites that the communication and control circuits “regulate in a closed loop feedback manner the one or more output voltages or currents of the one or more receiver rectifier circuits by adjusting the frequency or duty cycle of the one or more drive circuits during the charging or powering of the one or more portable devices.” Pet. 63. Petitioner relies on the Okada-Odendaal-Berghegger-Black combination to meet this “closed-loop feedback” limitation. *Id.* (citing Baker Decl. ¶¶ 218–219).

The entirety of Petitioner’s discussion of this limitation is contained in one paragraph as follows:

The analysis above demonstrates how/why a POSITA would have configured the Okada-Odendaal-Berghegger system to implement a closed-loop feedback control process where the “one or more communication and control circuits” (§§IX.A.1(e)-(f)) use device information received from PRM40 to control the disclosed “drive circuit(s)” during charging/powering by adjusting the frequency and/or duty cycle of the waveform applied to primary coil(s) 19 based on load variation information. (§§IX.A.1(c), 1(e), (g).) Also, for reasons explained for limitations 1(h) and 1(k), in the Okada-Odendaal-Berghegger-Black system, the load variation would have been measured as a

⁹ The testimony of Dr. Baker cited by Petitioner similarly refers back to ten sections of his previous testimony relating to other limitations, without page citations. Baker Decl. ¶ 216 (citing Sections IX.A.1(a)-(j)).

voltage at the output of the receiver rectifier in PRM40, which is fed back to PTM10 with the power demand information for adjusting the frequency and/or duty cycle of the “drive circuit(s)” during charging/powering of the portable device. (*Id.*; §§IX.A.1(h), IX.A.1(k); Ex. 1006, 4:58-59, 5:65-6:29.) Accordingly, for the reasons explained (see §§IX.A.1(a)-(b), IX.A.1(d)-(g), IX.A.1(i)-(j)), the Okada-Odendaal-Berghegger-Black combination discloses/suggests limitation 1(l). (Ex. 1002, ¶219.)

Id. at 63–64 (emphasis omitted).

Patent Owner responds by quoting the paragraph above and asserting that “[t]he entirety of the Petition’s analysis of this claim is a *single paragraph* that cites to numerous other sections of the Petition and other exhibits without any specificity.” Prelim. Resp. 32. Patent Owner points to numerous other examples of lack of particularity in the Petition. *Id.* at 29–31. Patent Owner argues (and we agree) that “any discussion [in the Petition] on using combinations is limited to discrete claim elements (and not the motivation regarding the actual references themselves), resulting in a hunt through string cites and multiple paragraphs in the Petition and Declarations in an attempt to identify the possible motivation to combine the references.” *Id.* at 29.

Our *Consolidated Trial Practice Guide* (Nov. 2019)¹⁰ provides the following guidance on presenting cases and warns against lack of focus:

Although parties are given wide latitude in how they present their cases, the Board’s experience is that the presentation of an overwhelming number of issues tends to detract from the argument being presented, and can otherwise cause meritorious

¹⁰ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

issues to be missed or discounted. *Thus, parties should avoid submitting a repository of all the information that a judge could possibly consider, and instead focus on concise, well-organized, easy-to-follow arguments supported by readily identifiable evidence of record.*

Id. at 39 (emphasis added). Petitioner has failed to follow this guidance throughout its presentation. As a consequence, we find it difficult to discern compelling evidence in Petitioner’s argument for why Okada should be modified to provide closed-loop operation.

Patent Owner characterizes Petitioner’s reliance on Berghegger for its teaching of closed-loop operation as “an ambiguous attempt.” Prelim. Resp. 43. Patent Owner asserts that Okada is an open-loop system using three power levels established at the beginning of the process. *Id.* Patent Owner asserts that Okada’s receiver is designed to self-regulate the open-loop charging process, and that does not suggest changing to a closed-loop system. *Id.* Patent Owner asserts that Okada’s drive circuit is “not designed for any adjustment of its frequency or duty cycle,” as required by claim 1. *Id.* Patent Owner explains that instead, “Okada teaches choosing one of three power levels through the use of a multi-tapped primary side coil.” *Id.*

Pertinent to Petitioner’s presentation and its arguments for “modifying” Okada, the Supreme Court has warned against “slipping into use of hindsight.” *KSR*, 550 U.S. at 421 (quoting *Graham*, 383 U.S. at 36). In this regard, the Federal Circuit has said that “combinations that change the basic principles under which the [prior art] was designed to operate, . . . may fail to support a conclusion of obviousness.” *Plas-Pak Indus., Inc. v. Sulzer Mixpac AG*, 600 Fed. Appx. 755, 758 (Fed. Cir. 2015) (quoting *In re Ratti*, 46 CCPA 976, 270 F.2d 810, 813 (1959), *In re Gordon*, 733 F.2d 900,

902 (Fed.Cir.1984))(internal quotation marks and cites omitted)(alterations in original).

Petitioner has failed to provide compelling evidence of a motivation to modify Okada. Petitioner has presented us with only a one-paragraph explanation. Pet. 63. Instead of directly stating reasons for making the modifications to Okada, this one paragraph refers us to eleven prior sections of the Petition encompassing over 40 pages. Dr. Baker’s testimony, which largely duplicates the Petition, similarly lacks focus and deprives us of a fair opportunity to assess the basis for his testimony. Testimony from Dr. Baker duplicates this one paragraph from the Petition, almost word for word, with no further explanation. *See Baker Decl.* ¶¶ 218–219 (referring to 15 previous sections of his declaration). This presentation is contrary to our guidance that “parties should avoid submitting a repository of all the information that a judge could possibly consider, and instead focus on concise, well-organized, easy-to-follow arguments supported by readily identifiable evidence of record.” *See supra*. It does not constitute compelling evidence.

On the other hand, Patent Owner has provided us with persuasive reasons why a person of ordinary skill would not have been motivated to abandon Okada’s open-loop three-tap helical coil configuration and replace it with a closed-loop system such as that described in Berghegger. Prelim. Resp. 43–44. Patent Owner makes the point that Okada’s drive circuits are not designed for adjustment of its frequency or duty cycle. *Id.* As discussed *supra*, Okada’s drive circuit is designed for choosing one of three power levels through the use of a multi-tapped primary side coil. *Id.*; Ex. 1005 ¶¶ 69–76, Fig. 3. In contrast, Petitioner describes Berghegger as “a closed-

loop feedback arrangement, where a drive circuit adjusts the oscillating frequency.” Pet. 28. Patent Owner presents a persuasive argument that altering this aspect of Okada would change Okada’s basic operating principles, so much so that a person of ordinary skill would not be motivated to attempt the change. *Id.* at 41–42. For the reasons given, we are not persuaded that Petitioner presents a compelling reason to modify Okada for closed-loop operation in the manner suggested by Dr. Baker.

4. *Planar Primary Coils Limitation*

Claim element [1.b] recites “one or more primary coils that are substantially planar and parallel to a surface of the system for powering or charging one or more compatible portable devices including batteries and receiver units, each receiver unit including a receiver coil and a receiver circuit including a receiver rectifier circuit.” Pet. 14. For this “planar primary coils” limitation, Petitioner relies on Odendaal combined with Okada. *Id.*¹¹ Petitioner contends that “*Odendaal* discloses known use of planar-type inductor coils in an inductive power transfer system, for, e.g., charging a cellphone battery.” *Id.* at 19–20 (citing Ex. 1008, Figs. 1A, 1B, 2A, 2C, 8E, 1:58–2:43). According to Petitioner, “*Odendaal* discloses that the spiral coils ‘are preferably integrated into a planar (flat/thin) structure’ . . . and may conform to the housing surface to facilitate charging a device ‘in close proximity.’” *Id.* at 20–21 (citing Ex. 1008, 2:29–44, 3:3–5).

¹¹ Petitioner admits that Okada “does not expressly state that ‘the primary coils . . . are substantially planar and parallel to a surface of the system,’” as the claim recites. Pet. 18 (emphasis omitted).

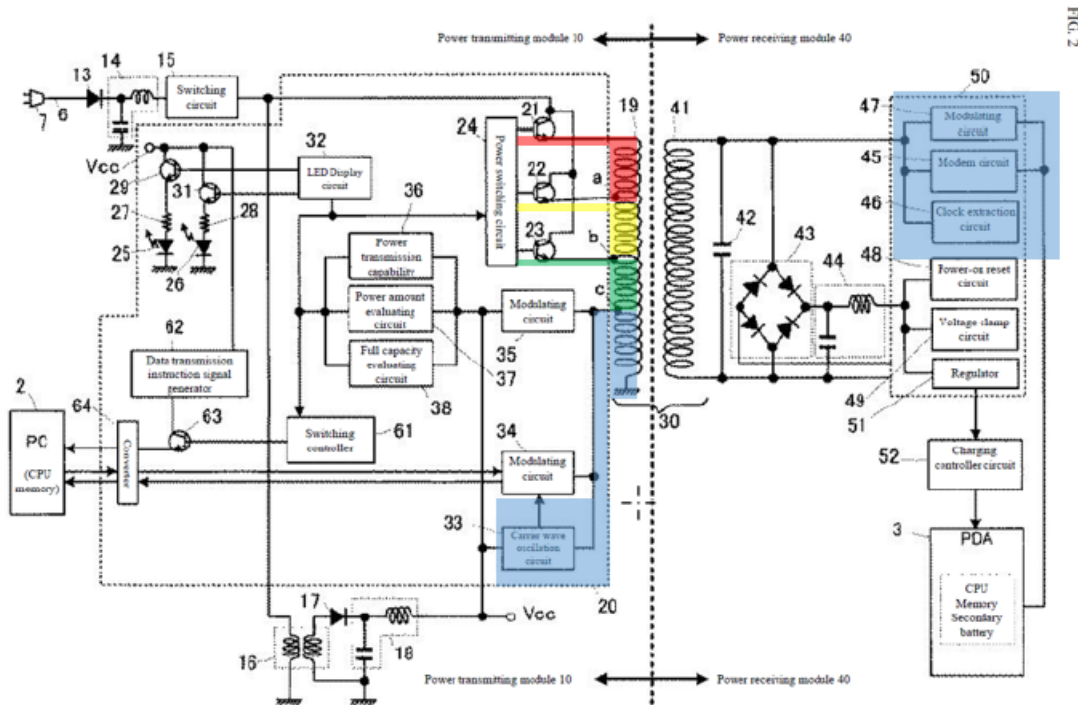
According to Dr. Baker, “[a] person of ordinary skill would have understood that such arrangements disclose coils that are parallel to a system’s surface.” Baker Decl. ¶ 139.

Petitioner asserts that in light of Odendaal’s teachings, an ordinary artisan would have been motivated “to modify the *Okada* system to use ‘primary coils’ that are ‘substantially planar and parallel to a surface of the system’ (and complemented such a design with corresponding planar secondary coil(s) in the portable device) to expand/complement applications compatible with those contemplated by *Okada* to use thin(n)er unit(s)/device(s).” Pet. 21 (citing Baker Decl. ¶ 140) (emphasis omitted). According to Petitioner, the proposed modification would “reduce the volume the coil(s) occupy, device size/weight, and expanded/enhanced applications of *Okada* (e.g., pads, tables, cellphone(s), etc.),” as well “reduc[ing] the distance between primary/secondary coils (promoting close proximity coupling . . . for improving power transmission efficiency, reducing energy waste, and shortening charging time.” *Id.* (citing Baker Decl. ¶ 140; Ex. 1005, ¶¶ 33, 34, 66–68, 112, 116–146, Figs. 1, 4(a), 4(b), 9, 10–16; Ex. 1036, 24:19–22).

Patent Owner responds that replacing *Okada*’s multi-tap solenoid coil with Odendaal’s planar coil would “fundamentally change the manner of operation of the device” and would not have been obvious to a person of ordinary skill. Prelim. Resp. 44–45 (citing *Plas-Pak Indus., Inc.*, 600 Fed. Appx. at 758; *see also In re Ratti*, 270 F.2d at 813). Patent Owner asserts that “neither Odendaal nor the Petition provides any disclosure of a multi-tap planar coil.” *Id.* at 45. Patent Owner continues, “[s]uch a replacement

would create a number of issues that would be difficult or impossible for a [person of ordinary skill] to solve.” *Id.*

We agree with Patent Owner that Petitioner has failed to provide compelling evidence that a person of ordinary skill would have substituted planar coils for Okada’s multi-tapped solenoid coils. Patent Owner is correct that “Okada has deliberately taken advantage of the benefits of solenoid coils for a number of reasons.” *Id.* at 46. Patent Owner illustrates this with a color-coded version of Figure 2 from Okada, following.



Prelim. Resp. 46. Figure 2 of Okada is a block diagram illustrating the electrical configuration of the common charger cradle 4 equipped with power transmitting module 10 and the PDA device being charged equipped with the power receiving module 40. Ex. 1005 ¶ 37. As described by Patent Owner, Okada uses the blue portion of the coil—from tap “c”—to send a communication carrier wave, receive an information signal from the

secondary side coil, and detect whether the secondary side coil is properly aligned with the primary side coil. Prelim. Resp. 47; Ex. 1005 ¶¶ 50, 56–57, Fig. 2. Once the system has determined a degree of alignment between the primary side coil and the secondary side coil and determined the receiver’s required power level (low, intermediate, or high), one of three different sections of the primary side coil is enabled using different taps (starting at red, yellow, or green and continuing to ground) and connected to switching circuit 15 to provide power to charge the portable device. *Id.* at 48. Patent Owner explains that “Okada relies only on the blue portion of the coil to determine whether the device is ‘correctly placed,’ but then uses a larger portion of the primary side coil for charging (from red, yellow, or green to ground).” *Id.*

As described *supra*, in Okada, the power level is selected by the receiver based upon a code stored in the device being charged and the tap on the primary side coil selected as a result. *See* Section IV.F.2. The Petition does not explain, given that this deliberate deployment of tapped solenoids as central to Okada’s operation, why or how a person of ordinary skill would have substituted for them a flat coil. Petitioner provides no explanation of how a tapped planar coil might be implemented, or how alignment might be achieved with such a coil. *See* Prelim. Resp. 49–55.

5. *Substantially Perpendicular Magnetic Field Limitation*

Claim element [1.c] recites one or more drive circuits “that when operated apply an alternating electrical current to the one or more primary coils to generate a magnetic field in a direction substantially perpendicular to the plane of the one or more primary coils and the surface of the system.”

Pet. 32. Petitioner relies on the Okada-Odendaal-Berghegger combination to meet this “perpendicular magnetic field” limitation. *Id.* (citing Ex. Baker Decl. ¶¶ 163–168; Pet. 6–32). Petitioner contends that “[a person of ordinary skill] would have also understood that the ac signal applied to the primary coils in the modified Okada system would have generated a ‘substantially perpendicular’ ‘magnetic field’ as claimed, given such a field would have been the natural result of activating the primary coil to inductively transfer power as described by Okada, Odendaal, and Berghegger.” *Id.* at 33 (emphasis omitted). Petitioner continues, “a person of ordinary skill] would have understood planar primary coils in the Okada-Berghegger-Odendaal system would have likewise generated a magnetic field that was substantially perpendicular to the plane of coils 19 and system surface, as known in the art.” *Id.* at 34 (emphases omitted).

To support its first argument, Petitioner presents a figure from Nakamura (Ex. 1019, Fig. 2B), which is not included in any ground in the Petition. This figure shows a U-shaped core configuration not shown in Okada. Pet. 33. Petitioner does not explain sufficiently how this figure from Nakamura supports its argument based on Okada.

Petitioner’s other arguments are based on “modified” Okada in light of Berghegger and Odendaal. These arguments assume incorporation of a planar primary coil in Okada. *See* Pet. 18–22. For reasons given in our previous discussions, we found no compelling evidence in the Petition that a person of ordinary skill would have made the proposed “modifications” to Okada, including the changes necessary to implement flat planar coils of Odendaal. *See supra*, Section IV.F.4. Therefore, we are not persuaded by Petitioner’s arguments based on the “modified” Okada system.

6. *Conclusion*

As discussed above, “[c]ompelling, meritorious challenges are those in which the evidence, if unrebutted in trial, would plainly lead to a conclusion that one or more claims are unpatentable by a preponderance of the evidence.” Guidance Memo, 4. For the reasons given, Petitioner’s arguments and evidence do not present a “compelling, meritorious challenge.”

G. Obviousness of Dependent Claims 2, 4, and 18

Each of these challenged claims depends from claim 1, and therefore, each incorporates the contested claim elements discussed in Section IV.F, *supra*. For its challenge to each of these dependent claims, Petitioner relies on its analysis of claim 1 for the common elements. *See, e.g.*, Pet. 64 (Petitioner’s analysis of claim 2 referring back to its analysis of claim 1 at Section IX.A.1 of the Petition). For the additional limitations of the dependent claims, Petitioner relies on Okada, Odendaal, Berghegger, and Black in combination with various other references. *See* Pet. 64–81.

Because each of these claims depends from claim 1, and for each, Petitioner’s challenge relies on its analysis of claim 1, Petitioner’s challenges to these claims are not compelling for the reasons explained above for claim 1.

H. Balancing the Fintiv Factors

We have considered the circumstances and facts before us in view of the *Fintiv* factors. As discussed above, we have determined that factors 1–5 weigh in favor of discretionary denial of institution. Moreover, we have

further determined that the Petition does not show compelling evidence of unpatentability under factor 6. We therefore conclude that the evidence of record favors exercising our discretion to deny institution of an *inter partes* review.

V. CONCLUSION

Upon consideration of the Petition, Preliminary Response, Preliminary Reply, Preliminary Sur-reply, and the accompanying evidence, we exercise our discretion under 35 U.S.C. § 314(a) to deny institution of an *inter partes* review challenging claims 2, 4, and 18 of the '500 patent.

VI. ORDER

For the foregoing reasons, it is hereby:

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner,

v.

MOJO MOBILITY INC.,
Patent Owner.

IPR2023-01093
Patent 11,201,500 B2

SZPONDOWSKI, *Administrative Patent Judge*, dissenting.

I disagree with the conclusion that we should exercise discretion to deny institution under 35 U.S.C. § 314(a), based upon the analysis of the discretionary denial factors articulated in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5–6 (PTAB Mar. 20, 2020) (precedential) (hereafter “*Fintiv*”). I analyze and weigh the *Fintiv* factors as follows.

Factor 1: Whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted

“A district court stay of the litigation pending resolution of the PTAB trial allays concerns about inefficiency and duplication of efforts.” *Fintiv*,

Paper 11 at 6. Petitioner has filed a motion for a stay in the district court litigation, which has not been ruled upon. Prelim. Resp. 18.

Petitioner contends that this factor is neutral, “as there has been no actual denial of a stay.” Reply 3; *see also* Pet. 83. Patent Owner argues that this factor weighs heavily in favor of discretionary denial because the motion “will almost certainly be denied pre-institution” given the “timing and advanced stage of litigation.” Prelim. Resp. 18; *see also* Sur-reply 1.

I decline to speculate based on the record in this case whether the district court will grant a stay. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 12 (PTAB May 13, 2020) (informative) (“*Fintiv IP*”). Therefore, I determine that this factor is neutral.

Factor 2: proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision

Under the second *Fintiv* factor, I consider the “proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision.” *Fintiv*, Paper 11 at 6. The district court has scheduled an August 5, 2024 trial date. Ex. 1066, 1 (Docket Control Order). Petitioner also provides median time-to-trial data from the Eastern District of Texas, which reflects that a median case would start in approximately May 2024. Pet. 83 (citing Ex. 1065, 35); *see* Guidance Memo 8 (“Parties may present evidence regarding the most recent statistics on median time-to-trial for civil actions in the district court in which the parallel litigation resides.”).

Petitioner argues that it is not dispositive if the trial date comes before the final written decision date, and that the Board has also considered other factors, such as diligence in filing the petition, a stipulation, investment in

the litigation, and the merits. Pet. 83–84. Therefore, Petitioner contends this factor is neutral or weighs against discretionary denial. Reply 4; Pet. 83.

Patent Owner argues that the trial date is five to six months prior to the earliest expected date for a final written decision and, therefore, this factor weighs heavily in favor discretionary denial. Prelim. Resp. 20–21; *see also* Sur-reply 1–2.

The latest date for issuance of a final written decision in this proceeding is in January 2025, one year after a decision instituting an *inter partes* review. 35 U.S.C. §§ 314(c), 316(a)(11); *see also* 37 C.F.R. § 42.100(c). We “generally take courts’ trial schedules at face value absent some strong evidence to the contrary.” *See Fintiv II*, Paper 15 at 13. However, the Director has cautioned the Board that “scheduled trial dates are unreliable and often change.” Guidance Memo 8. Therefore, the Director instructed the Board to consider additional supporting factors regarding trial dates, such as median time-to-trial statistics. *Id.* at 8–9. If the underlying litigation begins trial after the median amount of time to trial, it would occur in approximately May 2024. Therefore, because the trial in the district court litigation is scheduled to begin five months before our deadline to reach a final written decision, and considering the median time-to-trial statistics, this factor weighs in favor of discretionary denial. *Fintiv*, Paper 11 at 9. However, the Director cautions that “when other relevant factors weigh against exercising discretion to deny institution or are neutral, the proximity to trial should not alone outweigh all of those other factors.” *Id.* at 8. Accordingly, in accordance with the Director’s Memo, I must consider the remaining factors below.

Factor 3: investment in the parallel proceeding by the court and the parties

Petitioner argues that this factor weighs against denial because the district court litigation is in the early stages. Pet. 84. Petitioner contends that “[f]act discovery is in its infancy,” “the parties have not engaged in expert discovery,” “[t]he parties have not yet identified terms for construction,” and that there have not been any substantive orders. *Id.*; Reply 4–5. Petitioner also argues that the Petition was diligently filed within four months of Patent Owner’s infringement contentions being served in the district court litigation. Reply 5.

Patent Owner argues that “the district court proceeding has been pending since October 2022,” and the parties “have prepared and exchanged infringement and invalidity contentions, presented initial disclosures, and are in the midst of substantial fact discovery.” Prelim. Resp. 21; *see also* Sur-reply 2. Additionally, Patent Owner argues that claim construction will have been briefed and argued by the time of the institution decision. Prelim. Resp. 21; *see also id.* at 22 (district court litigation timeline). Patent Owner also argues that “Petitioner did not file its Petitions expeditiously” because “Petitioner waited many months after the district court complaint was filed to submit its Petitions.” Prelim. Resp. 22. Therefore, Patent Owner argues that this factor “greatly weighs in favor of denying institution.” *Id.*

I have considered Patent Owner’s position, but it appears that considerable effort remains to be completed. Fact discovery is ongoing, expert discovery has not yet begun, claim construction is ongoing with a claim construction hearing scheduled for February 6, 2024, and dispositive motions are due April 29, 2024. Ex. 1066, 3. At this stage, there is no claim

construction order, and no evidence in the record that the district court has issued any substantive orders relating to the '500 patent. *See Fintiv*, Paper 11 at 10 (“If, at the time of the institution decision, the district court has not issued orders related to the patent at issue in the petition, this fact weighs against exercising discretion to deny institution.”). Moreover, there is no evidence in the record that the district court will construe any terms in the '500 patent, and it is unclear from the present record how much investment has been made with respect to invalidity of the '500 patent, in particular.

Further, given the number of claims asserted against Petitioner across seven patents in the district court litigation, as well as the length of some of the claims,¹² I also find that Petitioner was diligent in filing the Petition, which was filed within four months of service of infringement contentions, and approximately eight months after the Complaint was filed. *See Exs. 1018, 1022, 2003; see Fintiv*, Paper 11 at 10 (stating that “it is often reasonable for a petitioner to wait to file its petition until it learns which claims are being asserted against it in the parallel proceeding.”).

On balance, given the level of investment by the parties and the district court, as well as Petitioner’s diligence in filing its Petition, I find that this factor weighs against exercising discretion to deny institution.

¹² *See* Section I.D, above, setting forth claim 1 of the '500 patent.

Factor 4: overlap between issues raised in the petition and in the parallel proceeding

This factor evaluates “concerns of inefficiency and the possibility of conflicting decisions” when substantially identical prior art arguments are submitted in both the district court and the *inter partes* review proceedings. *Fintiv*, Paper 11 at 12. In particular, “if the petition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel processing, this fact has favored denial.” *Id.* (citing *Next Caller, Inc. et al. v. Trust ID, Inc. et al.*, IPR2019-00963, Paper 8 at 11–12 (PTAB Oct. 28, 2019) (same grounds asserted in both cases); *ZTE (USA) Inc. v. Fractus, S.A.*, IPR2018-01451, Paper 12 at 20 (PTAB Feb. 19, 2019) (same prior art and identical evidence and arguments in both cases)).

Petitioner argues that this factor weighs against discretionary denial. Pet. 84; Reply 1–3. Petitioner has submitted a stipulation that “if this IPR is instituted, Petitioner will not pursue an invalidity defense in the Texas Litigation with respect to the challenged claims of the ’500 patent in this Petition based on (i) any of the same instituted grounds or (ii) any prior art reference that forms the basis of any instituted ground.” Reply 2. Further, Petitioner submitted evidence that Patent Owner narrowed the number of asserted claims in the district court litigation to thirty-two claims from the seven asserted patents, and is required by mid-February 2024 to further reduce that number to no more than a total of sixteen claims from the seven asserted patents. *Id.* at 1 (citing Exs. 1201, 1202). Petitioner argues that currently, claim 4 in this Petition will not be addressed in the district court litigation. *Id.*; see Ex. 1201.

Patent Owner argues that Petitioner’s stipulation “does not eliminate the substantial overlap with the district court case.” Sur-reply 2. Patent Owner argues that “institution of the IPR petitions would result in published prior art invalidity assertions being before both the district court and the PTAB.” *Id.* at 3. Patent Owner also argues that Petitioner’s reliance on the reduction of claims accused of infringement in the district court litigation is a “diversion” because “Petitioner continues to seek to challenge the patents on published prior art validity grounds before both the district court and the PTAB.” *Id.* at 3–5. Patent Owner, too, provides a stipulation that it will “not seek to resurrect or make new infringement claims as to any claims in this IPR petition which have been or will be removed from Patent Owner’s infringement case in the district court case per the district court focusing order, against Samsung or its products.” *Id.* at 4.

Petitioner’s stipulation is broader than the stipulation in *Sand Revolution* and narrower than the stipulation in *Sotera*. *Sand Revolution II, LLC, v. Continental Intermodal Group – Trucking LLC*, IPR2019-01393, Paper 24, 12 (PTAB June 16, 2020) (informative) (“Petitioner will not pursue the same grounds in the district court litigation”); *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12, 19 (PTAB Dec. 1, 2020) (precedential as to § II.A) (Petitioner stipulates not to pursue “any ground raised or that could have been reasonably raised”). Although Petitioner’s stipulation is not as strong as the stipulation in *Sotera*,¹³ a *Sotera* stipulation

¹³ The Guidance Memo provides that “[c]onsistent with *Sotera Wireless, Inc.*, the PTAB will not discretionarily deny institution in view of parallel district court litigation where a petitioner presents a stipulation not to pursue in a parallel proceeding the same grounds or any grounds that could have

obviates the need for any *Fintiv* factor weighing. I decline to hold the fact that Petitioner did not file a *Sotera* stipulation against Petitioner in an analysis that only occurs when a *Sotera* stipulation is not filed.

Further, by stipulating not to pursue the challenged claims of the '500 patent based on (1) any instituted grounds and (2) any prior art reference that forms the basis of any instituted ground (i.e., Okada, Odendaal, Berghegger, Black, Masias, Calhoon, Kazutoshi) Petitioner has effectively removed any potential issue overlap with the district court litigation. In other words, the patentability issues addressed in this proceeding (i.e., relating to the grounds presented and/or prior art challenges) will not be addressed in the district court litigation. This is highly relevant to this factor, because when both *NHK* and *Fintiv* discussed prevention of duplication, it was with respect to duplication of the parties' and courts' work with respect to the specific grounds of invalidity common in both proceedings. *NHK Spring Co. Ltd. V. Intri-Plex Techs. Inc.*, IPR2018-00752, Paper 8 at 20 (PTAB 2018) (precedential) (additionally denying institution under 35 U.S.C. § 314(a) where "Petitioner asserts the same prior art and arguments" in the district court trial, implicating an "inefficient use of Board resources"); *Fintiv*, Paper 11 at 12 ("if the petition includes materially different grounds, arguments, and/or evidence . . . this fact has tended to weigh against exercising discretion to deny institution"). In the present case, Petitioner's stipulation serves to limit it to "materially different grounds, argument, and/or evidence" in the district court versus this proceeding, which *Fintiv* instructs

reasonably been raised before the PTAB." Guidance Memo, 3 (footnote omitted).

us to “weigh against exercising discretion to deny institution.” In addition, the lack of overlap is further supported because at most, only claims 1, 2, 18, 23, and 30 from the ’500 patent¹⁴ will be addressed in the district court litigation. *See* Reply 1.

Patent Owner’s stipulation does not persuade me otherwise; Patent Owner has already been ordered by the district court to narrow the asserted claims. *See* Ex. 1202, 1–2. I do not see any significance to Patent Owner’s stipulation not to resurrect claims that have already been withdrawn from the district court litigation. Indeed, it is unlikely that this would even be permitted by the district court. *See Id.* at 2 (“the patent claimant shall serve a Final Election of Asserted Claims, which shall identify no more than five asserted claims per patent *from among the ten previously identified claims* and no more than a total of 16 claims”) (emphasis added).

Thus, I determine this factor weighs against exercising discretion to deny institution.

¹⁴ Claims 1, 3, 9, 11–13, and 20 are challenged in IPR2023-01091 and claims 23–31 are challenged in IPR2023-01092. Therefore, out of the 19 challenged claims of the ’500 patent, at present only five will be addressed in the district court litigation, and that number may be further reduced. *See* Ex. 1202.

Factor 5: whether the petitioner and the defendant are the same in the parallel proceeding

The parties in this proceeding are identical to the parties in the related district court litigation. Therefore, this factor weighs in favor of exercising discretion to deny institution.

Factor 6: other circumstances that impact the Board's exercise of discretion, including the merits

Under this factor, I consider “other circumstances that impact the Board’s exercise of discretion, including the merits.” *Fintiv*, Paper 11 at 6. For example, if the merits of a ground raised in the petition seem particularly strong on the preliminary record, this fact has favored institution. *Fintiv* 14–15. By contrast, if the merits of the grounds raised in the petition are a closer call, then that fact has favored denying institution when other factors favoring denial are present. *Id.* at 15.

The Guidance Memo states that:

Where the information presented at the institution stage is merely sufficient to meet the statutory institution threshold, the PTAB has the authority, where warranted to exercise discretion to deny institution in view of the other *Fintiv* factors. In contrast, where the PTAB determines the information presented at the institution stage presents a compelling unpatentability challenge, that determination alone demonstrates that the PTAB should not discretionarily deny institution under *Fintiv*.

Guidance Memo 4–5. The application of the Guidance Memo is further guided by the precedential decisions in *OpenSky Indus., LLC v. VLSI Tech. LLC*, IPR2021-01064, Paper 102, 49–50 (Oct. 4, 2022) (precedential) and *CommScope Techs. LLC v. Dali Wireless, Inc.*, IPR2022-01242, Paper 23

(Feb. 27, 2023) (precedential). We are instructed to consider compelling merits under the sixth *Fintiv* factor only after a determination that the first five *Fintiv* factors favor discretionary denial. *CommScope*, Paper 23 at 4–5.

On balance, I determine that *Fintiv* factors 1–5 do not favor discretionary denial. Specifically, I determine that Petitioner’s stipulation, reasonable diligence in filing the Petition, and the limited extent of the parties’ and district court’s investment in the district court litigation outweigh the projected trial date. *See* Guidance Memo 8 (“[W]hen analyzing the proximity of the court’s trial date under factor two of *Fintiv*, when other relevant factors weigh against exercising discretion to deny institution or are neutral, the proximity to trial should not alone outweigh all of those other factors.”). As a result, I need not decide whether Petitioner presents a compelling unpatentability challenge. *See CommScope*, Paper 23 at 4–5.

Conclusion on Discretionary Denial Under § 314(a)

As discussed above, I have considered the circumstances and facts in view of the *Fintiv* factors. My analysis is fact driven and no single factor is determinative under § 314(a). Based on the circumstances presented, I determine that, as a whole, the factors weigh against exercising discretion to deny institution of the Petition. Therefore, I would not exercise discretion to deny institution under § 314(a), and, respectfully, dissent.

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