

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE UNITED
STATES PATENT AND TRADEMARK OFFICE

SOLUS ADVANCED MATERIALS CO., LTD.,
Petitioner,

v.

SK NEXILIS CO., LTD.,
Patent Owner.

IPR2024-01463
Patent 11,591,706 B2

Before COKE MORGAN STEWART, *Acting Under Secretary of
Commerce for Intellectual Property and Acting Director of the United States
Patent and Trademark Office.*

ORDER

Granting Director Review, Vacating the Decision Granting Institution,
and Denying Institution of *Inter Partes* Review

SK Nexilis Co., Ltd. (“Patent Owner”) filed a request for Director Review of the Decision granting institution (“Decision,” Paper 14) and Solus Advanced Materials Co., Ltd. (“Petitioner”) filed an authorized response. *See* Paper 17 (“DR Request”), Paper 19. In its request, Patent Owner argues that the Board erred in its fact-findings as to *Fintiv*¹ factors 3, 4, and 6—investment in the parallel proceeding, overlap between issues raised in the petition and the parallel proceeding, and the strength of the petition’s merits, respectively. *See* DR Request 1–15. In particular, Patent Owner argues that the Board improperly found the merits of the Petition were so strong as to outweigh the other factors, particularly given the investment in the parallel proceeding. *See id.* at 3–13.

Petitioner responds that the Board properly found the merits of one ground in the petition was particularly strong, that there was not a perfect overlap between the issues raised in the petition and the parallel proceeding, and the *Markman* hearing had only just taken place. *See* Paper 19, 1–5.

The trial date in the parallel proceeding is set for approximately six months before the final written decision, and there has been a significant amount of investment in the parallel proceeding. Under *Fintiv*’s holistic assessment, the merits of the Petition here do not outweigh the other factors. An analysis of all the circumstances indicates that the efficiency and integrity of the system are best served by denying institution.

Accordingly, it is:

ORDERED that Director Review is granted;

¹ *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5–6 (PTAB Mar. 20, 2020) (precedential).

FURTHER ORDERED that the Board's Decision granting institution of *inter partes* review (Paper 14) is vacated; and

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

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