

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMERICAN HONDA MOTOR CO., INC.,
Petitioner,

v.

INTELLECTUAL VENTURES II LLC,
Patent Owner.

Case IPR2018-00347
Patent 7,154,200 B2

Before KRISTEN L. DROESCH, JOHN A. HUDALLA, and
AMANDA F. WIEKER, *Administrative Patent Judges*.

HUDALLA, *Administrative Patent Judge*.

DECISION

Denying Institution of *Inter Partes* Review
35 U.S.C. § 314(a)

American Honda Motor Co., Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting an *inter partes* review of claims 1, 2, 4, 6, and 7 (“the challenged claims”) of U.S. Patent No. 7,154,200 B2 (Ex. 1001, “the ’200 patent”). Intellectual Ventures II LLC (“Patent Owner”) filed a Preliminary Response (Paper 5, “Prelim. Resp.”). As authorized by our

Order of May 17, 2018 (Paper 7), Petitioner filed a Reply to the Preliminary Response (Paper 8, “Pet. Reply”).

We have authority to determine whether to institute an *inter partes* review. *See* 35 U.S.C. § 314(b); 37 C.F.R. § 42.4(a). Under 35 U.S.C. § 314(a), we may not authorize an *inter partes* review unless the information 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.” For the reasons that follow, we do not institute an *inter partes* review of the challenged claims based on the asserted grounds.

I. BACKGROUND

A. *Related Proceedings*

The parties identify the following matters related to the ’200 patent (Pet. 2; Paper 4, 2–3):

Intellectual Ventures II LLC v. Aisin Seiki Co., No. 2:17-cv-13551-PDB-EAS (E.D. Mich. filed Oct. 31, 2017);

Intellectual Ventures II LLC v. Honda Motor Co., No. 2:17-cv-07680-GW-PJW (C.D. Cal. filed Oct. 20, 2017);

Intellectual Ventures II LLC v. Toyota Motor Corp., No. 2:17-cv-07681-GW-JC (C.D. Cal. filed Oct. 20, 2017);

Intellectual Ventures II v. Bayerische Motoren Werke AG, No. 2:17-cv-08870-CCC-JBC (D.N.J. filed Oct. 20, 2017);

Intellectual Ventures II LLC v. Honda Motor Co., No. 1:17-cv-00294-LPS-CJB (D. Del. filed Mar. 20, 2017);

Intellectual Ventures II LLC v. Aisin Seiki Co., No. 1:17-cv-00295-LPS-CJB (D. Del. filed Mar. 20, 2017);

Intellectual Ventures II LLC v. Bayerische Motoren Werke AG, No. 1:17-cv-00296-LPS-CJB (D. Del. filed Mar. 20, 2017);

Intellectual Ventures II LLC v. Toyota Motor Corp., No. 1:17-cv-00300-LPS-CJB (D. Del. filed Mar. 20, 2017);

Certain Thermoplastic-Encapsulated Elec. Motors, Components Thereof, and Prods. & Vehicles Containing Same, USITC Inv. No. 337-TA-1052 (filed Mar. 21, 2017); and

Certain Thermoplastic-Encapsulated Elec. Motors, Components Thereof, and Prods. & Vehicles Containing Same, USITC Inv. No. 337-TA-1073 (filed Sept. 5, 2017).

The parties also state that the '200 patent is being challenged in IPR2017-01537 ("1537 IPR") and IPR2017-01558. Pet. 2; Paper 4, 3. Petitioner here also challenged claims 1, 2, and 4–7 of the '200 patent in IPR2018-00442 ("442 IPR") (442 IPR, Paper 1) and sought joinder to the 1537 IPR (442 IPR, Paper 3). We instituted review in the 442 IPR, joined Petitioner as a party to the 1537 IPR, and terminated the 442 IPR as a separate proceeding. 442 IPR, Paper 8.

B. The '200 patent

The '200 patent is directed to a high speed motor. Ex. 1001, 1:17–18. Figures 2 and 3 of the '200 patent are reproduced below.

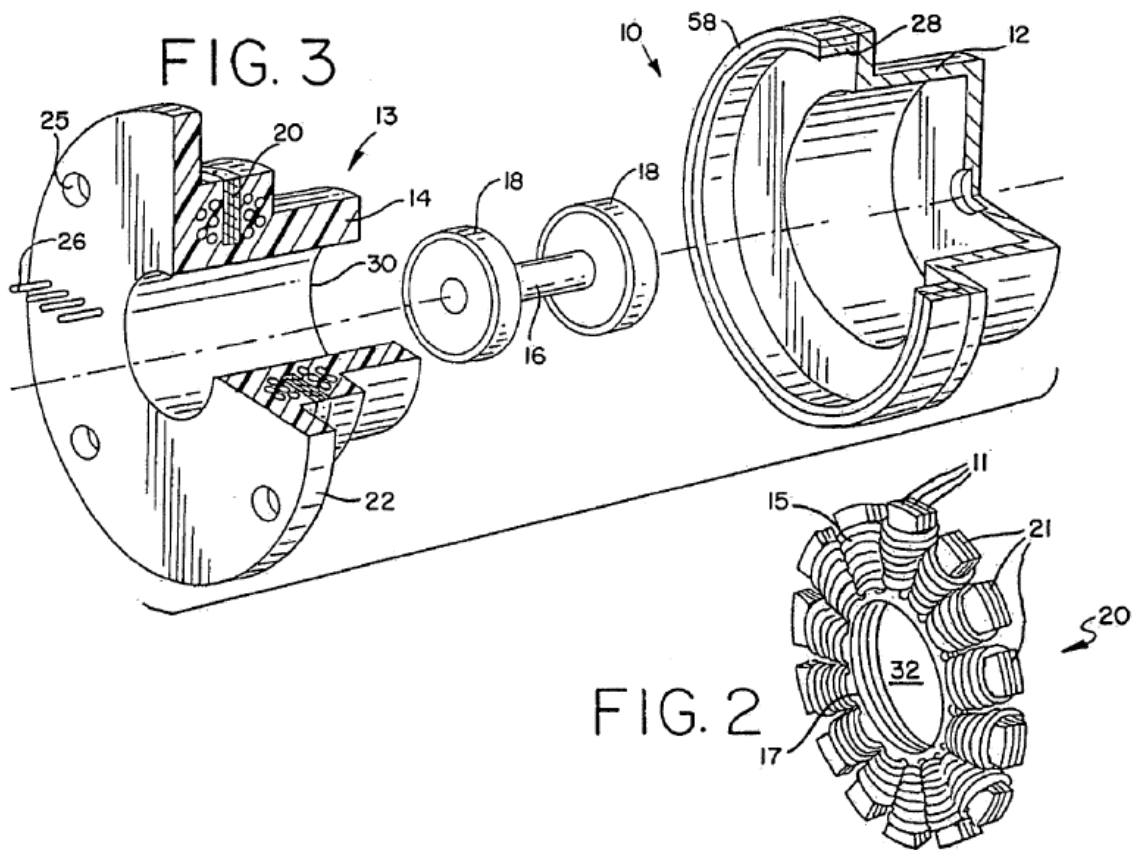


Figure 2 depicts stator 20 with conventional steel laminations 11 that form a magnetically inducible core 17 having a plurality of poles 21. *Id.* at 5:6–9. Wire windings 15 on core 17 serve as conductors, which induce or otherwise create magnetic fields in core 17 when electrical current is conducted through the conductors. *Id.* at 5:6–12.

Stator 20 is used to construct spindle motor 10, as depicted in Figure 3. *Id.* at 5:14–15. Spindle motor 10 includes hub 12, stator 20, and body 14. *Id.* at 5:15–17. Body 14 substantially encapsulates stator 20 and is preferably formed of phase change materials such as thermoplastics. *Id.* at 5:20–49. Body 14 and stator 20 together make up stator assembly 13. *Id.* at 5:17–18. Shaft 16 is connected to hub 12 and is surrounded by bearings 18, which are adjacent body 14. *Id.* at 5:50–52. Rotor/magnet 28 is fixed to the

inside of hub 12 on a flange so as to be in operable proximity to stator 20.
Id. at 5:52–54.

The phase change materials in body 14 should have a coefficient of linear thermal expansion (CLTE) such that the phase change material contracts and expands at approximately the same rate as the solid parts (such as bearings and inserts) in motor 10. *Id.* at 16:27–37.

C. Illustrative Claim

Of the challenged claims of the '200 patent, only claim 1 is independent. Claims 2, 4, 6, and 7 depend directly or indirectly from claim 1. Claim 1 is illustrative of the challenged claims and recites:

1. A motor comprising:
 - a) a stator substantially encapsulated within a body of thermoplastic material; and
 - b) one or more solid parts used in the motor either within or near the body;
 - c) the thermoplastic material having a coefficient of linear thermal expansion such that the thermoplastic material contracts and expands at approximately the same rate as the one or more solid parts.

Id. at 21:44–52.

D. The Prior Art

Petitioner relies on the following prior art:

Japanese Patent Application Publication No. H08-298740, published Nov. 12, 1996 (Ex. 1003, “Senju”);¹ and

¹ Senju is a Japanese-language publication that was filed with a statement attesting to the accuracy of the translation (Ex. 1003, 1), an English-

Japanese Patent Application Publication No. H04-105538,
published Apr. 7, 1992 (Ex. 1004, “Koizumi”).²

E. The Asserted Grounds

Petitioner challenges claims 1, 2, and 4–7 of the ’200 patent on the following grounds (Pet. 4):

Reference(s)	Basis	Claims Challenged
Senju	35 U.S.C. § 102(b)	1, 2, and 4
Senju and Koizumi	35 U.S.C. § 103(a)	1, 2, 4, 6, and 7

F. The 1537 IPR

The petition in the 1537 IPR challenged claims 1, 2, and 4–7 of the ’200 patent, and was filed by entities other than Petitioner³ on June 9, 2017. 1537 IPR, Paper 1. Patent Owner filed a Preliminary Response on September 19, 2017. 1537 IPR, Paper 7. We instituted an *inter partes* review of claims 1, 2, and 4–7 of the ’200 patent on December 13, 2017. 1537 IPR, Paper 10. Petitioner here was joined as a party to the 1537 IPR on April 25, 2018, on grant of Petitioner’s motion. 1537 IPR, Paper 17. Based on our Institution Decision in the 1537 IPR (1537 IPR, Paper 10) and

language translation (*id.* at 2–4), and the original Japanese-language publication (*id.* at 5–7).

² Koizumi is a Japanese-language publication that was filed with a statement attesting to the accuracy of the translation (Ex. 1004, 1), an English-language translation (*id.* at 2–9), and the original Japanese-language publication (*id.* at 10–17).

³ Aisin Seiki Co., Ltd. and Toyota Motor Corporation were the original petitioner entities in the 1537 IPR.

our recent Order (1537 IPR, Paper 18) in the wake of *SAS Institute, Inc. v. Iancu*, 138 S. Ct. 1351 (2018), the following grounds were instituted in the 1537 IPR:

Reference(s)	Basis	Claims Challenged
Koizumi	35 U.S.C. § 103(a)	1, 2, and 4–7
Takagi ⁴	35 U.S.C. § 103(a)	1, 2, and 4–7
Trago ⁵	35 U.S.C. § 103(a)	1, 2, and 4–7
Takagi and Koizumi	35 U.S.C. § 103(a)	1, 2, and 4–7
Trago and Koizumi	35 U.S.C. § 103(a)	1, 2, and 4–7

As can be seen, the claims being reviewed in the 1537 IPR are a superset of the claims challenged in the instant Petition. The 1537 IPR also includes a common reference, Koizumi.

II. ANALYSIS – DISCRETION UNDER 35 U.S.C. § 314(a)

A. *Legal Framework*

35 U.S.C. § 314(a) provides that the Director

may not authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 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.

⁴ WIPO International Patent Application Publication No. WO97/33359, published Sept. 12, 1997.

⁵ WIPO International Patent Application Publication No. WO96/31936, published Oct. 10, 1996

Section 314(a) does not require the Director to institute a review. *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.”). Rather, a decision whether to institute is within the Director’s discretion, and that discretion has been delegated to the Board. *See Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, Case IPR2016-01357 (PTAB May 4, 2016) (Paper 19) (precedential), slip op. at 15, 18–19; 37 C.F.R. § 42.4(a).

In *General Plastic Industries Co. v. Canon Kabushiki Kaisha*, the Board set forth a non-exhaustive list of factors to consider in evaluating whether to exercise discretion, under § 314(a), to deny a petition challenging a patent previously challenged before the Board. Those factors include:

1. whether the same petitioner previously filed a petition directed to the same claims of the same patent;
2. whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it;
3. whether at the time of filing of the second petition the petitioner already received the patent owner’s preliminary response to the first petition or received the Board’s decision on whether to institute review in the first petition;
4. the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition;
5. whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent;
6. the finite resources of the Board; and
7. the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.

General Plastic, slip op. at 16 (citing *NVIDIA Corp. v. Samsung Elec. Co.*, Case IPR2016-00134 (PTAB May 4, 2016) (Paper 9)). These factors are “a non-exhaustive list” and “additional factors may arise in other cases for consideration, where appropriate.” *Id.* at 7, 8. For example, where a subsequent petition is filed by a different petitioner, the Board has taken into account the following additional considerations, which may be relevant to determining whether to exercise discretion based on § 314(a):

1. potential prejudice to the subsequent petitioner if institution is denied and the pending instituted proceedings involving the first petitioner are terminated; and
2. whether multiple petitions filed against same patent is a direct result of Patent Owner’s litigation activity.

See Lowes Cos. Inc., v. Nichia Corp., Case IPR2017-02011, slip op. 19 (PTAB March 12, 2018) (Paper 13) (“Denial of the Petition in part would prejudice the Petitioner in this proceeding should the Vizio Petitions be resolved by settlement.”); *Samsung Elecs. Amer., Inc. v. Uniloc Luxembourg S.A.*, Case IPR2017-01797, slip op. 33–34 (PTAB Feb. 6, 2018) (Paper 8) (recognizing the purpose of the availability of *inter partes* review to parties accused of infringement, and finding Patent Owner’s complaint about multiple petitions filed to challenge the same patent unpersuasive “when the volume appears to be the direct result of its own litigation activity”).

B. Discussion

We now consider all of the factors enumerated above.

1. General Plastic Factor 1

The first *General Plastic* factor asks “whether the same petitioner previously filed a petition directed to the same claims of the same patent.” We first consider whether the “same claims” are being challenged. The petition in the 442 IPR challenged all claims that are being challenged in the instant petition, and Petitioner was joined to the 1537 IPR, which also challenged all claims that are being challenged in the instant petition. Accordingly, the 442 IPR and 1537 IPR petitions are “directed to the same claims of the same patent.”

We next consider “whether the same petitioner previously filed” the 442 IPR and 1537 IPR petitions. Chronologically, this Petition—filed on December 21, 2017—is the first petition filed by Petitioner against the ’200 patent. Pet. Reply 1; Ex. 1019. However, Patent Owner characterizes the 1537 IPR petition—filed on June 9, 2017, by Aisin Seiki Co., Ltd. and Toyota Motor Corporation—as being “earlier-filed” such that we should treat the instant Petition as a follow-on petition. Prelim. Resp. 6–7, 9. Patent Owner emphasizes that, even though the earlier-filed 1537 IPR petition was filed by different entities, Petitioner nonetheless sought to join the earlier-filed 1537 IPR as a party, so Petitioner “voluntarily accepted the full benefits and burdens of being a petitioner in the earlier-filed and instituted petition.” *Id.* at 6–7.

Petitioner argues the instant Petition is not a follow-on petition because Petitioner filed the instant petition on December 21, 2017, which

was before the January 12, 2018, filing date of the 442 IPR petition with which Petitioner requested joinder to the 1537 IPR. Pet. Reply 1; Ex. 1019. As such, Petitioner contends the *General Plastic* factors do not apply. Pet. Reply 1. Petitioner also contends that it “is not a petitioner” in the 1537 IPR, so the “instant Petition should not be barred based on Toyota’s/ Aisin’s decision to file an IPR, or their independent knowledge and conduct in preparing and filing their earlier petition.” *Id.*

In our view, Petitioner’s arguments elevate form over substance, as our discretion under § 314(a) is not limited to situations where the same party files multiple petitions. The *General Plastic* factors are “a formulation of relevant considerations that permit the Board to assess the potential impacts on both the efficiency of the *inter partes* review process and the fundamental fairness of the process for all parties.” *General Plastic*, slip op. at 18. The factors are not rigid guideposts applicable only to factual scenarios identical to that in *General Plastic*. *See id.* (“[T]he factors set forth above, at the very least, serve to act as a baseline of factors to be considered in our future evaluation of follow-on petitions.”). On the facts of this case, wherein Petitioner requested joinder with an earlier-filed proceeding, the issue of whether Petitioner itself previously filed an earlier petition is one consideration among many, but is not dispositive. We find it useful to consider the link between the instant Petition and the petitions in the 442 IPR and the 1537 IPR as we evaluate this factor.

In the circumstances before us, Petitioner sought joinder to the earlier-filed 1537 IPR, which we granted. 1537 IPR, Paper 17. Thus, contrary to Petitioner’s argument, Petitioner *is* now a petitioner in the 1537 IPR. *Id.* at 8 (“Honda’s Motion for Joinder with Case IPR2017-01537 is granted, and

Honda is joined *as a party*.”) (emphasis added). Moreover, although the 442 IPR petition and joinder request may have come after this Petition was filed, the parties and the Board must contend with the 1537 IPR, to which Petitioner is a party, which covers the same patent and claims, and which is much farther along in the schedule of the *inter partes* review proceeding. In other words, despite Petitioner’s arguments, the record before us demonstrates that Petitioner is a petitioner entity in the earlier-filed 1537 IPR proceeding, which concerns the same patent and the same claims as challenged here.

Petitioner requested and successfully obtained joinder to the 1537 IPR, which necessarily changed the posture of this case.⁶ 442 IPR, Paper 3. In addition, the fact that Petitioner filed the 442 IPR petition and its request for joinder to the 1537 IPR a mere 21 days after the instant Petition does not substantively change the fact that both cases were filed by Petitioner and deal with the same claims of the same patent. Petitioner could have included all of its challenges in one petition and declined to file a request for joinder, but it did not do so. At the same time, we recognize that our rules permit the filing of a petition for *inter partes* review within one year of being served with a complaint for infringement, and Petitioner’s

⁶ We do not agree with Petitioner (Pet. Reply 1–2) that Patent Owner engaged in “gamesmanship” by “cho[osing] to not oppose joinder and to file its preliminary response in [the 442 IPR] two months early to manufacture a timeline to make its contorted *General Plastic* argument.” We see Patent Owner’s response to be an appropriate response Petitioner might have expected when filing two relatively contemporaneous IPR petitions against the same claims. Moreover, we view Patent Owner’s response as furthering the Board’s goal of providing a speedy resolution to each proceeding. 37 C.F.R. § 42.1(b).

filing of the present Petition is permissible under our rules. *See* 35 U.S.C. § 315(b).

We determine that Petitioner’s tactical choices do not deprive the Board of its ability to exercise discretion in determining whether to institute trial for claims identical to those at issue in a pending proceeding to which Petitioner is a party. Accordingly, this factor weighs moderately against institution.

2. *General Plastic Factor 2*

The second factor asks whether, at the time of filing the petition in the 1537 IPR, Petitioner knew or should have known of the references asserted in this Petition, i.e., Senju and Koizumi.

Patent Owner contends Petitioner “undoubtedly knew or should have known about Koizumi at the time Toyota filed the earlier-filed petition because Toyota filed Koizumi with the [1537 IPR] petition.” Prelim. Resp. 10. Patent Owner states that it “sued [Petitioner] for patent infringement on March 20, 2017 and filed an ITC complaint against [Petitioner] on March 21, 2017, the same days that [Patent Owner] sued and filed an ITC complaint against the original petitioners of the [1537 IPR, i.e., Toyota and Aisin Seiki].” *Id.* at 13–14. As such, Patent Owner suggests that Petitioner either shared information with the petitioner entities in the 1537 IPR, or else at least had reason to monitor related litigation and conduct prior art searches as of March 2017. *Id.* Patent Owner further contends that Petitioner knew or should have known about Senju because “a reasonably diligent search easily would have found Senju.” *Id.* at 10–12. Patent Owner additionally contends we “should charge [Petitioner] with the

knowledge that the earlier petitioners had or should have had at the time they filed the June 9, 2017 [1537 IPR] petition.” *Id.* at 13. Petitioner argues that it “is a separate entity from petitioners in [the 1537] IPR and their knowledge should not be imputed to [Petitioner]” here. Pet. Reply 3.

Despite being afforded an opportunity to address this *General Plastic* factor, Petitioner has not presented any evidence demonstrating when Petitioner knew of the prior art asserted in the instant Petition. Although Petitioner was not involved with the 1537 IPR at the time of its filing, Petitioner may well have been monitoring litigation involving the ’200 patent based on Patent Owner’s filing of earlier complaints against Petitioner, and the original petitioning entities in the 1537 IPR, in March 2017. *See* Ex. 1019; Paper 4, 3 (identifying ITC Inv. No. 337-TA-1052 as a related matter, wherein the docket of that investigation includes a complaint filed March 21, 2017, which names as respondents, *inter alia*, Aisin Seiki Co., Ltd., American Honda Motor Co., Inc., and Toyota Motor Corp.). Such monitoring would have apprised Petitioner of the Koizumi reference, which is common between the 1537 IPR and the instant Petition. Thus, we accord this factor low weight against institution.

3. *General Plastic Factor 3*

The third *General Plastic* factor asks whether Petitioner had already received Patent Owner’s preliminary response or our institution decision in the 1537 IPR prior to filing the present Petition. The Board explained the relevance of this factor in *General Plastic*:

[F]actor 3 is directed to Petitioner’s potential benefit from receiving and having the opportunity to study Patent Owner’s Preliminary Response, as well as our institution decisions on

the first-filed petitions, prior to its filing of follow-on petitions. As discussed in our Decisions Denying Institution, we are concerned here by the shifts in the prior art asserted and the related arguments in follow-on petitions. Multiple, staggered petitions challenging the same patent and same claims raise the potential for abuse. The absence of any restrictions on follow-on petitions would allow petitioners the opportunity to strategically stage their prior art and arguments in multiple petitions, using our decisions as a roadmap, until a ground is found that results in the grant of review. All other factors aside, this is unfair to patent owners and is an inefficient use of the *inter partes* review process and other post-grant review processes.

General Plastic, slip op. at 17–18 (internal citation and footnote omitted). Petitioner here had the benefit of both Patent Owner’s Preliminary Response and our Institution Decision from the 1537 IPR when filing the instant Petition. *See* Ex. 1019. Our review of Petitioner’s citations to Koizumi in the Senju-Koizumi obviousness ground reveals that they mimic positions from the Koizumi obviousness ground in the 1537 IPR. *Compare* Pet. 46–54, *with* 1537 IPR, Paper 1, 17–28. As such, we agree with Patent Owner that Petitioner appears to have used “the Board’s institution decision in the earlier-filed IPR as a roadmap to improve [Petitioner’s] position in this Petition.” Prelim. Resp. 15. Petitioner, thus, had the benefit of seeing Patent Owner’s initial position and our Decision on Institution in the 1537 IPR in preparing the present Petition. The third *General Plastic* factor weighs strongly against institution.

4. *General Plastic* Factor 4

The fourth *General Plastic* factor asks us to consider the length of time that elapsed between the time Petitioner learned of Senju and Koizumi

and the filing of the present Petition. Patent Owner argues Petitioner knew or should have known of Koizumi as of the time that the 1537 IPR was filed, i.e., June 9, 2017. Prelim. Resp. 16. Patent Owner acknowledges, however, that the record does not indicate when Petitioner learned of Senju. *Id.* Petitioner does not address this factor in its Reply.

As discussed above regarding Factor 2, the record does not establish when Petitioner learned of the asserted prior art. As such, we cannot determine, with any certainty, the length of time that elapsed between when Petitioner learned of the asserted prior art and the filing of the instant Petition. Given the absence of specific information in the record on this issue, we determine that this factor is neutral.

5. *General Plastic Factor 5*

As to the fifth *General Plastic* factor, “whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent,” Patent Owner argues that Petitioner does not explain the 6-month delay between the 1537 IPR petition and the instant Petition. Prelim. Resp. 17–18. Petitioner argues that it did not delay in filing the instant Petition, particularly because it “filed its Petition less than two months after being served with [Patent Owner’s] operative complaint” in the underlying litigation. Pet. Reply 3 (citing Ex. 1019).

Although Patent Owner’s “operative complaint” was served two months before the instant Petition was filed, Patent Owner served an earlier, defective district court complaint on Petitioner in March 2017. *See* Ex. 1019. Patent Owner also filed an ITC complaint in March 2017 against

Petitioner here and the original petitioner entities from the 1537 IPR. *See* Paper 4, 3. Both of these actions occurred three months before the filing date of the 1537 IPR petition and nine months before the instant Petition was filed. These facts, along with the earlier filing of the 1537 IPR petition itself, suggest that Petitioner could have filed the instant Petition earlier. Petitioner does not provide an explanation as to whether it began work on its Petition in March 2017, and whether it could have filed its Petition earlier in time. Notwithstanding, Petitioner is correct that it was well within its rights to file the instant Petition within two months of the operative complaint. Balancing these facts, we consider the fifth *General Plastic* factor to be neutral.

6. *General Plastic Factor 6*

As to the sixth *General Plastic* factor, “the finite resources of the Board,” we note that “multiple, staggered petition filings, such as those here, are an inefficient use of the *inter partes* review process and the Board’s resources.” *General Plastic*, slip op. at 21. Petitioner’s use of two separate petitions, i.e., the 442 IPR petition and the instant Petition, against the same claims results in some inefficiency for the Board. We agree with Patent Owner (Prelim. Resp. 18) that this slightly favors denial of the Petition, and we accord it low weight.

7. *General Plastic Factor 7*

The last *General Plastic* factor pertains to the requirement under 35 U.S.C. § 316(a)(11) that we must issue a final determination within one year of institution. We know of no reason why we could not meet this

requirement. Accordingly, this factor favors institution, and we accord it low weight.

8. *First Additional Factor*

We now consider the two additional factors enumerated above. The first additional factor is the potential prejudice to Petitioner if institution of the instant Petition is denied, and if the 1537 IPR is terminated. Petitioner is also a petitioner in the 1537 IPR, albeit in an understudy role. In our joinder Order, we specifically stated that “the roles of the remaining parties in the proceeding may be reevaluated” in the event that the 1537 IPR is terminated as to the other petitioner entities. 1537 IPR, Paper 17, 7. Thus, Petitioner would still be able to proceed against the challenged claims in the 1537 IPR even if the other petitioner entities were to withdraw from the 1537 IPR. Thus, we consider any potential prejudice to Petitioner to be low, which weighs moderately against institution.

9. *Second Additional Factor*

Finally, we consider Patent Owner’s litigation activity. As shown above, Patent Owner has sought to enforce the ’200 patent in multiple actions. *See supra* § I.A. This has resulted in multiple IPR petitions. *See id.* Notwithstanding, Petitioner chose to multiply these proceedings by filing two different petitions against the same claims of the ’200 patent. On balance, we view this factor as slightly favoring institution.

10. *Conclusion Regarding General Plastic and Additional Factors*

We have considered the *General Plastic* factors and two additional factors. We determine that several factors weigh against institution, including some factors that moderately or strongly weigh against institution. Ultimately, we are swayed by the fact that Petitioner chose to file two separate petitions, and the Petition in this case overlaps the other insofar as it relies on the same reference, Koizumi, in a similar way. Petitioner is also a joined party in the 1537 IPR, where it can continue its challenge of the same claims challenged in the instant Petition. On this record, we exercise our discretion to deny institution of an *inter partes* review of the challenged claims of the '200 patent.

III. CONCLUSION

We have considered the factors set forth above and conclude that they weigh against institution. Accordingly, we exercise our discretion under 35 U.S.C. § 314(a) to deny institution of an *inter partes* review of claims 1, 2, 4, 6, and 7 of the '200 patent based on the asserted grounds.

IV. ORDER

Accordingly, it is:

ORDERED that the Petition is denied as to all challenged claims of the '200 patent.

IPR2018-00347
Patent 7,154,200 B2

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