

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SHENZHEN SILVER STAR INTELLIGENT TECHNOLOGY CO., LTD.,
Petitioner,

v.

IROBOT CORP.,
Patent Owner.

Case IPR2018-00761
Patent 7,155,308 B2

Before WILLIAM V. SAINDON, TERRENCE W. MCMILLIN, and
AMANDA F. WIEKER, *Administrative Patent Judges*.

WIEKER, *Administrative Patent Judge*, for the BOARD,
SAINDON, *Administrative Patent Judge*, CONCURRING.

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

I. INTRODUCTION

A. *Background*

Shenzhen Silver Star Intelligent Technology Co., Ltd. (“Petitioner”) filed a Petition requesting an *inter partes* review of claims 1–4, 6–8, 11, 12, 15, 19, 20, 27, 28, and 31–34 (“the challenged claims”) of U.S. Patent No. 7,155,308 B2 (Ex. 1001, “the ’308 patent”). Paper 10 (“Pet.”); *see also* Paper 1 (original Petition); Paper 9, 2 (Notice of Filing Date identifying defects). iRobot Corp. (“Patent Owner”) filed a Preliminary Response. Paper 14 (“Prelim. Resp.”).

We have authority under 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted unless the information presented in the Petition and the Preliminary Response shows that “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314; *see also* 37 C.F.R. § 42.4(a) (“The Board institutes the trial on behalf of the Director.”).

For the reasons that follow, we do not institute an *inter partes* review of any of the challenged claims of the ’308 patent.

B. *Related Proceedings*

The parties identify the following matters related to the ’308 patent (Pet. 1–2; Paper 12):

In re Certain Robotic Vacuum Cleaning Devices And Components Thereof Such As Spare Parts, Inv. No. 337-TA-1057 (USITC);

iRobot Corporation v. Hoover, Inc., et al., Case No. 1:17-cv-10647 (D. Mass.);

iRobot Corporation v. The Black & Decker Corp., et al., Case No. 1:17-cv-10648 (D. Mass.);

iRobot Corporation v. Bissell Homecare, Inc., et al., Case No. 1:17-cv-10649 (D. Mass.);

iRobot Corporation v. Bobsweep, Inc., et al., Case No. 1:17-cv-10651(D. Mass.);

iRobot Corp. v. Shenzhen Zhiyi Technology Co. Ltd. d/b/a iLife, Case No. 1:17-cv-10652 (D. Mass.); and

Shenzhen Zhiyi Technology Co., Ltd. v. iRobot Corp., IPR2017-02078 (PTAB) (the “–2078 IPR”).

C. *The ’308 Patent*

The ’308 patent is titled “Robot Obstacle Detection System” and issued on December 26, 2006, from U.S. Application No. 10/453,202, filed on June 3, 2003. Ex. 1001, (21), (22), (54).

The ’308 patent discloses “an obstacle detection system for an autonomous robot, such as an autonomous cleaning robot.” *Id.* at 1:15–17. According to the ’308 patent, existing sonar-based obstacle detection sensor subsystems were “too complex or too expensive [or] both,” while existing tactile sensors were inefficient. *Id.* at 1:42–47. As such, the ’308 patent seeks “to provide a robot obstacle detection system which is simple in design, low cost, accurate, easy to implement, and easy to calibrate . . . [and which] prevents an autonomous cleaning robot from driving off a stair or obstacle which is too high.” *Id.* at 1:51–57. Accordingly, the ’308 patent explains that these and other objects of the invention “can be effected by intersecting the field of view of a detector with the field of emission of a directed beam at a predetermined region and then detecting whether the floor or wall occupies that region.” *Id.* at 2:4–12. “If the floor does not occupy the predefined region, a stair or some other obstacle is present and the robot is directed away accordingly.” *Id.* at 2:12–19 (also discussing detection of walls).

Figures 6 and 7 of the '308 patent are reproduced below.

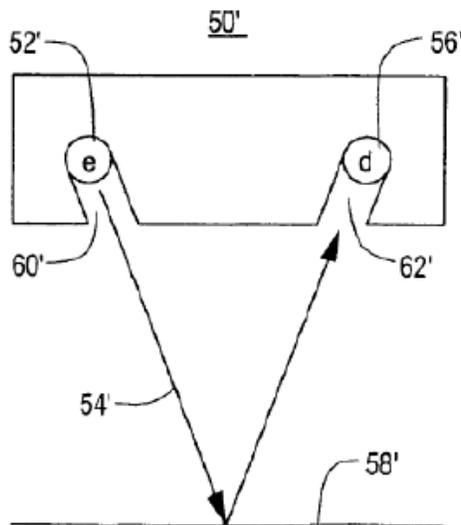


FIG. 6

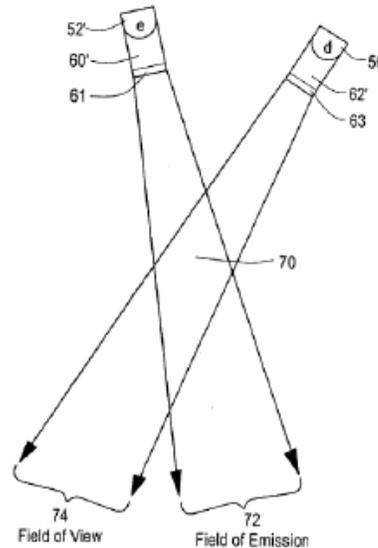


FIG. 7

Figure 6 is a schematic view showing a preferred sensor subsystem, and Figure 7 is a schematic view showing the fields of emission and detection of that subsystem. Ex. 1001, 3:65–4:3. As shown, the disclosed sensor subsystem 50' includes emitter 52' and detector 56', wherein emitter 52' directs beam 54' toward surface 58', which may be a wall or a floor. *Id.* at 5:53–61, 6:15–22. The '308 patent explains:

In this way, the region 70, FIG. 7[,] in which the field of emission of emitter 52' as shown at 72 and the field of view of detector of 56' as shown at 74 intersect is finite. . . . The infrared energy directed at the floor decreases rapidly as the sensor-to-floor distance increases while the infrared energy received by the detector changes linearly with surface reflectivity. . . .

The sensor subsystem is calibrated such that when floor or surface 58' . . . is the “normal” or expected distance with respect to the robot, there is a full or a nearly full overlap between the field of emission of the emitter and the field of view of the detector as shown. When the floor or surface is too far away such that the robot can not successfully traverse an obstacle, there is no or only a minimal overlap As the robot approaches a cliff,

the overlap decreases until the reflected intensity is below [a] preset threshold. This triggers cliff avoidance behavior.

Id. at 6:18–48; *see also id.* at Figs. 8–11 (depicting overlap). In such a circumstance, the '308 patent explains that the system “simply redirect[s] the robot” to avoid the cliff. *Id.* at 6:60–61; *see also id.* at 2:12–14, 3:7–13, 3:22–23, 7:37–39, 8:20–23, 8:27–33.

Similarly, in a wall detection mode, the system “modulates the emitter and detects signals from the detector as before, step 170, FIG. 17 until a reflection is detected, step 172.” *Id.* at 8:24–26, Fig. 17. When a reflection is detected, “[a] wall is then next to the robot and the controlling circuitry causes the robot to turn away from the wall, step 174 and then turn back, step 176 until a reflection (the wall) is again detected, step 178.” *Id.* at 8:27–31, Fig. 17. The '308 patent explains that “[b]y continuously decreasing the radius of curvature of the robot, step 180, the path of the robot along the wall in the wall following mode is made smoother.” *Id.* at 8:31–33; *see also id.* at 2:14–19, 3:23–25, 7:1–3, 7:37–39.

D. Illustrative Claim

Of the challenged claims, claims 1 and 19 are independent. Claim 1 is illustrative and is reproduced below.

1. A sensor subsystem for an autonomous robot which rides on a surface, the sensor subsystem comprising:
 - an optical emitter which emits a directed optical beam having a defined field of emission;
 - a photon detector having a defined field of view which intersects the field of emission of the emitter at a region; and
 - a circuit in communication with the detector providing an output when an object is not present in the region thereby redirecting the autonomous robot.

Ex. 1001, 12:62–13:3.

E. Applied References

Petitioner relies upon the following references:

H.R. Everett, *Sensors for Mobile Robots Theory and Application* (A K Peters, 1995) (Ex. 1005, “Everett”);

Carl G. Öhman, International Application Publication WO 93/03399, filed Aug. 7, 1992, published Feb. 18, 1993 (Ex. 1006, “Öhman”);

Joseph L. Jones and Anita M. Flynn., *Mobile Robots: Inspiration to Implementation* (A K Peters, 1993) (Ex. 1007, “Jones”);

Norman H. Schiller, U.S. Patent No. 5,245,177, filed Oct. 24, 1991, issued Sept. 14, 1993 (Ex. 1014, “Schiller”); and

Guy B. Immega et al., U.S. Patent No. 5,726,443, filed Jan. 18, 1996, issued Mar. 10, 1998 (Ex. 1015, “Immega”).

Pet. 9. Petitioner also relies upon the Declaration of Dr. Hagen Schempf (Ex. 1013).

F. Asserted Grounds of Unpatentability

Petitioner challenges the patentability of claims 1–4, 6–8, 11, 12, 15, 19, 20, 27, 28, and 31–34 of the ’308 patent based on the following twelve grounds. Pet. 10.

Reference(s)	Basis	Claim(s) Challenged
Everett	§ 102	1, 2, 6, 8, 15, 19, 27, 28, and 32–34
Everett and Jones	§ 103	3, 4, 7, and 15
Everett and Schiller	§ 103	11
Everett and Immega	§ 103	11, 12, and 20
Öhman	§ 102	1, 2, 6–8, 19, 27, 31, 32, and 34
Öhman and Everett	§ 103	1, 15, 28, and 33
Öhman and Jones	§ 103	3, 4, 7, and 15
Öhman, Everett, and Jones	§ 103	3, 4, 7, and 15
Öhman and Schiller	§ 103	11

Reference(s)	Basis	Claim(s) Challenged
Öhman, Everett, and Schiller	§ 103	11
Öhman and Immega	§ 103	11, 12, and 20
Öhman, Everett, and Immega	§ 103	11, 12, and 20

II. DISCUSSION

A. Discretion under 35 U.S.C. § 314(a)

The filing date accorded to the Petition is March 8, 2018. Paper 9, 1. The Petition is the first filed by Petitioner, challenging claims of the '308 patent. Prelim. Resp. 23.

Patent Owner argues that this “Petition follows a previously unsuccessful challenge to the '308 patent in the First Petition in IPR2017-02078” (the “–2078 Petition”), which was filed on September 8, 2017, by Shenzhen Zhiyi Technology Co., Ltd., a different petitioner. *Id.* at 8; Pet. 2. Patent Owner contends that we should exercise our discretion to deny institution of the Petition under 35 U.S.C. § 314(a).

Petitioner does not address § 314(a) in its Petition, but identifies the –2078 IPR as a related proceeding directed to the '308 patent. Pet. 2.

1. Legal Framework

35 U.S.C. § 314(a) provides that:

The Director [of the USPTO] 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.

Section 314(a) does not require the Director to institute an *inter partes* 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 37 C.F.R. § 42.4(a); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016) (“[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.”).

In a precedential decision in *General Plastic Industries Co., Ltd. v. Canon Kabushiki Kaisha*, the Board articulated a non-exhaustive list of factors to be considered in evaluating whether to exercise discretion, under 35 U.S.C. § 314(a), to deny a petition that challenges a patent that was previously challenged before the Board. These factors are:

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.

Gen. Plastic, Case IPR2017-01357, Paper 19 (PTAB Sept. 6, 2017)

(Section II.B.4.i designated as precedential on Oct. 17, 2017), 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 16, 18.

2. Application of the General Plastic Factors

Factor 1

The first *General Plastic* factor queries “whether the same petitioner previously filed a petition directed to the same claims of the same patent.” *Gen. Plastic*, slip op. at 16.

The instant Petition and the –2078 Petition both challenge claims of the ’308 patent. Pet. 2. Dependent claims 4, 6, 8, 15, 27, and 31–33 are challenged in the instant Petition, but were not challenged in the –2078 Petition. *Compare* Pet. 9, *with* –2078 Petition, Paper 8, 6. Accordingly, the petitions are directed to *some* of “the same claims of the same patent.”

Additionally, Patent Owner admits that “the instant Petitioner is different—in name—from the earlier petitioner” in the –2078 Petition. Prelim. Resp. 23. However, according to Patent Owner, Petitioner is “similarly situated to the previous petitioner” because both “were served with complaints alleging infringement of the ’308 patent at substantially the same time, and were codefendants [in ITC Inv. No. 337-TA-1057 (the “ITC Investigation”)] and likely members of a joint defense group.” *Id.*

Under our statute, 35 U.S.C. § 315(b), Petitioner is permitted to file a petition for *inter partes* review within one year of being served with a complaint for infringement, and Petitioner’s filing of the instant Petition conforms with § 315(b). *See* Exs. 1003, 1004.

As Patent Owner notes, however, Petitioner and the entity that filed the –2078 Petition are co-respondents in the ITC Investigation. *See* Ex. 2012, 11 (identifying Petitioner and Shenzhen ZhiYi Technology Co., Ltd. as proposed respondents); Prelim. Resp. 23; Pet. 1–2 (identifying ITC and district court complaints filed against Petitioner and –2078 petitioner by Patent Owner on April 17 and 18, 2017); *see infra* pages 15–18 (concurrence). Although this commonality suggests that Petitioner may have known of its co-respondents’ actions at the PTAB, i.e., the filing of the –2078 Petition, and may have had incentives to monitor those proceedings and to work with the –2078 petitioner, that does not mean that Petitioner “previously filed a petition directed to the same claims of the same patent.”

Thus, we determine that Factor 1 weighs *in favor of institution*.

Factor 2

The second *General Plastic* factor queries “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.” *Gen. Plastic*, slip op. at 16.

Patent Owner argues that, in the ITC Investigation, Petitioner filed its invalidity contentions—identifying four of the five references asserted in the instant Petition—on September 29, 2017. Prelim. Resp. 14 (citing Ex. 2009); Ex. 2009, 4–8 (identifying all asserted references except Immega). According to Patent Owner, because the contentions were filed only three weeks *after* the –2078 Petition was filed, it is likely that Petitioner knew of the references at the time the –2078 Petition was filed. Prelim. Resp. 15.

The evidence of record clearly demonstrates that Petitioner knew of the majority of the references asserted in this Petition at least as of September 29, 2017, when invalidity contentions were filed in the ITC Investigation. *See Ex. 2009, 4–8.* However, the evidence does not establish definitively that Petitioner knew, or should have known, of the presently-asserted prior art on September 8, 2017, when the –2078 Petition was filed. Although Patent Owner may be correct that Petitioner may have known of the asserted prior art at that time, it has not been shown by evidence of record.

Thus, we determine that Factor 2 weighs *slightly against institution.*

Factor 3

The third *General Plastic* factor queries “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.” *Gen. Plastic*, slip op. at 16. 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. . . . 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 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.

Id. at 17–18 (internal citation and footnote omitted).

The instant Petition was filed on March 8, 2018. At that time, Petitioner had access to Patent Owner's Preliminary Response in the –2078 IPR, which was filed on December 14, 2017. Thus, the timing of Petitioner's filing in this case raises the potential for abuse, because Petitioner had ample opportunity (almost three months) to study the arguments raised by Patent Owner regarding the commonly challenged claims of the '308 patent.

Indeed, it appears that Petitioner took advantage of “the opportunity to strategically stage their prior art and arguments,” to account for positions taken by Patent Owner in its Preliminary Response in the –2078 IPR. *Gen. Plastic*, slip op. at 17–18. For example, in the –2078 IPR, Patent Owner argued that the petitioner improperly construed “re-direct” as including merely stopping a robot, rather than changing its direction of travel. –2078 IPR, Paper 7, 6–11. In this proceeding, Petitioner appears to preempt this argument by contending that the prior art teaches or suggests stopping the robot *and* changing the robot's direction of travel. *See, e.g.*, Pet. 17 (arguing that Everett discloses that “drive motors [are] immediately disabled,” as well as a different routine in which the robot “alter[s] course to avoid impact”), 27 (arguing that a person of skill in the art would understand Everett to disclose that the robot “continue[s] running to complete its job,” and to avoid stairs), 46 (arguing that Öhman discloses that the robot “stops and reverses direction”); *see* –2078 IPR, Paper 8, 7–9 (agreeing with Patent Owner's claim construction), 14–17 (finding that the prior art did not disclose re-directing the robot, as properly construed). These contentions suggest that Petitioner was aware of, and relied upon, Patent Owner's previous filing in preparing this Petition.

Thus, we determine that Factor 3 weighs *strongly against institution*.

Factors 4 and 5

The fourth *General Plastic* factor considers “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,” and the fifth *General Plastic* factor queries “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.” *Gen. Plastic*, slip op. at 16.

As discussed above regarding Factor 2, the record establishes that Petitioner was aware of four of the five references asserted in the instant Petition on September 29, 2017. Prelim. Resp. 14 (citing Ex. 2009), 21–22.¹ Thus, Petitioner knew of the majority of the asserted art for at least five and a half months before filing this Petition. Petitioner does not provide any explanation related to the timing of its Petition, which weighs against institution. To the extent a reasonable explanation exists for Petitioner’s delay, it was incumbent upon Petitioner to identify those circumstances to the Board.

Thus, we determine that Factor 4 weighs *strongly against institution*, and Factor 5 weighs *moderately against institution*.

¹ The record does not indicate when Petitioner became aware of the Immega reference, which is relied upon in conjunction with grounds directed to dependent claims 11, 12, and 20.

Factors 6 and 7

The sixth *General Plastic* factor considers “the finite resources of the Board.” *Gen. Plastic*, slip op. at 16. The seventh *General Plastic* factor considers “the requirement . . . to issue a final determination not later than 1 year after the date on which the Director notices institution of review.” *Gen. Plastic*, slip op. at 16.

Patent Owner argues that the Petition presents “an excessive number [i.e., twelve] of overlapping and redundant grounds,” which would strain Board resources. Prelim. Resp. 17–18. Patent Owner also contends that the Petition will be more difficult to review in one year than “a typical Petition.” *Id.*

We know of no reason why this proceeding would tax unduly the resources of the Board, or why we could not meet the requirement of 35 U.S.C. § 316(a)(11) to issue a final determination within one year after institution. Accordingly, we determine that these factors are *neutral* to the analysis.

Summary

As detailed herein, we have considered the factors enumerated in *General Plastic*, in determining whether to exercise our discretion under 35 U.S.C. § 314(a). In summary, we determine that:

- i. two factors weigh strongly *against* institution (Factors 3, 4);
- ii. one factor weighs moderately *against* institution (Factor 5);
- iii. one factor weighs slightly *against* institution (Factor 2);
- iv. two factors are *neutral* (Factors 6 and 7); and
- v. one factor weighs *in favor* of institution (Factor 1).

IPR2018-00761
Patent 7,155,308 B2

Considering these factors as a whole, and on this record, we determine that it is appropriate to exercise our discretion under 35 U.S.C. § 314(a) to deny institution of an *inter partes* review of the challenged claims of the '308 patent.

III. CONCLUSION

For the foregoing reasons, we exercise our discretion to deny institution of an *inter partes* review, pursuant to 35 U.S.C. § 314.

IV. ORDER

Upon consideration of the record before us, it is:

ORDERED that the Petition is *denied* as to all challenged claims, and no trial is instituted.

IPR2018-00761
Patent 7,155,308 B2

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SHENZHEN SILVER STAR INTELLIGENT TECHNOLOGY CO., LTD.,
Petitioner,

v.

IROBOT CORP.,
Patent Owner.

Case IPR2018-00761
Patent 7,155,308 B2

Before WILLIAM V. SAINDON, TERRENCE W. MCMILLIN, and
AMANDA F. WIEKER, *Administrative Patent Judges*.

SAINDON, *Administrative Patent Judge*, CONCURRING:

I join fully the analysis and outcome articulated by my colleagues above. I write separately to highlight that our above analysis of the *General Plastic* factors shows a need for an additional factor more specifically directed to the situation at hand.

If one were to synthesize our analysis of the facts of this case and their application to the *General Plastic* factors, one could come to the following conclusion:

Given petitions filed by two or more similarly situated defendants, there is a rebuttable

presumption that a later-filed petition will be denied under General Plastic if that later-filed petition is filed after an earlier-filed petition has received a preliminary response or a decision on institution.

The concept behind this is that, all things being equal, if two or more co-defendants are sued around the same time, they should, within reason, file their petitions around the same time; it is generally unfair for one defendant to wait for a “test case” to go through the *inter partes* review process by another defendant before filing their own petition. This strongly evokes aspects of existing Factors 3 (filing timing) and 5 (adequacy of explanation), upon which we largely base our decision. Factor 4 (knowledge of prior art timing) weighs toward denial in this case, but misses the true issue here, which is the nature of the petitioners’ status as similarly situated co-defendants, charged with infringement of the ’308 patent at or about the same time, more than the identity of the prior art. *See* Ex. 2012; Pet. 1–2. Although we discussed the facts surrounding the nature of the two petitioners in Factor 1 (same petitioner), that factor is focused not on the connection between the petitioners but rather on the binary fact of whether they are the same. However, that relationship weighs particularly heavy in our analysis of Factor 3 and our ultimate outcome.

I propose that an additional factor would be useful to provide guidance and emphasis on how strongly filing timing issues may dictate the outcome when there are similarly situated defendants. Those defendants, even without coordination, could be gaining an unfair advantage by the tactical filing of petitions. I do not find it in the interests of fairness or of the Board’s highly burdened resources to entertain such petitions, outside a

reasonable and sufficient explanation.² Accordingly, I propose the following new factor:

8. the extent to which the petitioner and any prior petitioner(s) were similarly situated defendants or otherwise realized a similar-in-time hazard regarding the challenged patent.

Primarily, this new factor would help magnify the relative importance of Factor 3 (timing of filings) in instances where filings follow a pattern that may represent a tactic we do not wish to encourage. To be clear, not all petitions filed after a preliminary response or a decision on institution should be denied. There are legitimate reasons why a petition may be filed after those events.³ Further, it is expected that some parties may take longer than others to prepare and file petitions; similarly situated defendants cannot be expected to always file petitions at or about the same time.⁴ The context must be considered, and petitioners are encouraged to explain timing

² I recognize that the time bar of 35 U.S.C. § 315(b) is the primary mechanism for enforcement in similarly situated defendant cases. However, I understand the statute to provide a hard ceiling, which we are free to lower as fairness dictates under our general authority not to institute a petition that may be otherwise instituted, under § 314(a). *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016) (“[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.”); *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.”).

³ Examples may be cases where there is a substantive change in the underlying litigation stance (e.g., new claims asserted) or where a patent owner files infringement suits over time and later-filed petitions are filed by later-sued defendants.

⁴ For example, staffing and monetary concerns, or availability of experts, may affect how long it takes a petitioner to file a petition.

differences relative to the filing of previous petitions by similarly situated defendants (*see, e.g.*, Factor 5). There is no intention here to propose a bright-line rule, which would only serve to invite gamesmanship.

As the new factor would be applied to this case, both Petitioner and the prior petitioner in the –2078 IPR are similarly situated defendants because they both had a reason to seek *inter partes* review at or around the same time, when Patent Owner asserted, at or around the same time, that they infringe the ’308 patent. Pet. 1–2 (identifying ITC and district court complaints filed against Petitioner and the –2078 petitioner by Patent Owner on April 17 and 18, 2017); Prelim. Resp. 23; Ex. 2012 (ITC Investigation complaint against both petitioners); Ex. 1004 (district court complaint against Petitioner). But Petitioner waited to file its Petition until after having ample time to consider and tailor its Petition in response to how the Patent Owner responded to the earlier petition, and provides no curative explanation for doing so. An analysis under the *General Plastic* factors should tend to result in a denial of such petitions, because absent explanation, we have no other conclusion to make but that the second petition was filed at the time it was filed solely for the tactical reason of using the first petition as a test case. Our decision above puts parties on notice that such tactics may result in denials under *General Plastic*. It is my belief that the factor proposed above will provide more clearly an indication that the Board intends to scrutinize closely, and that parties should draw our attention to, relevant information regarding related litigation that provides a context for the filings before us.

IPR2018-00761
Patent 7,155,308 B2

PETITIONER:

Shen Wang
Hao Tan
ARCH & LAKE LLP
shenwang@archlakelaw.com
haotan@archlakelaw.com

PATENT OWNER:

W. Karl Renner
Jeremy J. Monaldo
Nicholas Stephens
FISH & RICHARDSON P.C.
axf-ptab@fr.com
jjm@fr.com
nstephens@fr.com

Tonya S. Drake
tdrake@irobot.com