

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

A123 SYSTEMS, LLC,
Petitioner,

v.

LONG HUA TECHNOLOGY CO., LTD.,
Patent Owner.

IPR2022-00026
Patent 8,034,480 B2

Before CHRISTOPHER L. CRUMBLEY, KRISTINA M. KALAN, and
AVELYN M. ROSS, *Administrative Patent Judges*.

KALAN, *Administrative Patent Judge*.

DECISION

Denying Institution of *Inter Partes* Review
35 U.S.C. § 314; 37 C.F.R. § 42.107(e)

I. INTRODUCTION

A123 Systems, LLC (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting *inter partes* review of claims 1–19 of U.S. Patent No. 8,034,480 B2 (Ex. 1001, “the ’480 patent”). Long Hua Technology Co., Ltd. (“Patent Owner”) did not file a Preliminary Response to the Petition.

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

A. *Related Proceedings*

The parties identify *Long Hua Technology Co., Ltd. v. A123 Systems, LLC*, No. 1:20-cv-11887-RGS (D. Mass.) (“the District Court litigation”) as a related matter. Pet. 12; Paper 4, 2. Patent Owner represents in its Mandatory Notices that “Count II of the Complaint, which asserted the ’480 patent, was dismissed in view of Patent Owner’s statutory disclaimer of claims 1-19 of the ’480 patent filed on October 20, 2021.” Paper 4, 2; *see also* Ex. 3001 (statutory disclaimer of claims 1–19 of the ’480 patent). Petitioner also represents in its Updated Mandatory Notice that “the parties filed a Joint Stipulation of Dismissal” of the District Court litigation, in which “the parties stipulate to the dismissal with prejudice of all claims and counter-claims asserted in that action.” Paper 5, 2; *see also* Ex. 1029 (Joint Stipulation of Dismissal). The parties also identify IPR2021-00894, which regards U.S. Patent No. 7,803,484, as a related matter. Pet. 12; Paper 4, 2. As stated by Patent Owner, the petition for *inter partes* review in IPR2021-00894 was denied on October 18, 2021. Paper 4, 2.

B. Real Parties-In-Interest

Petitioner identifies itself and its parent company, Wanxiang A123 Systems Asia Co., Ltd, as real parties-in-interest. Pet. 11. Patent Owner identifies itself as the real party-in-interest. Paper 4, 2.

C. The '480 Patent

The '480 patent is titled “High Rate Capability Design of Lithium Ion Secondary Battery.” Ex. 1001, code (54). The '480 patent relates to a “lithium ion secondary battery” that “includes LiFePO_4 as a major component of the positive electrode active material.” *Id.* at code (57). In the claimed lithium ion secondary battery, “an electrode layer of the positive electrode active material on a current collector” has “a ratio of its area to its thickness (A/t) greater than $1.2 \times 10^6 \text{ mm}$, so that the layer has a reduced ion impedance.” *Id.* at 2:19–22. The claimed lithium ion secondary battery has a high rate capability, namely, “the capacity at the discharge rate of 10C is greater than 80% of the capacity at the discharge rate at 1C.” *Id.* at 2:15–17; *see also id.* at 8:34–40, Fig. 3 (illustrating the relationship between area-to-thickness ratio and discharge capability).

D. Illustrative Claim

Claims 1 and 6 are independent claims; claim 1 is representative and is reproduced below:

1. A lithium ion secondary battery comprising a positive electrode; a negative electrode; a separating film that separates the positive electrode and the negative electrode; and an electrolyte forming a lithium ion channel between the positive electrode and the negative electrode, wherein the positive electrode comprises a current collector substrate; one single tab or a plurality of tabs connected to the current collector substrate; and an electrode layer of a positive electrode material on one surface of the current collector, wherein the positive electrode

material comprises LiFePO_4 as a major component thereof, and the electrode layer of the positive electrode material has a ratio of its area to its thickness greater than about 9.31×10^5 mm, and wherein the lithium ion secondary battery has a ratio of its capacity at discharge rate of 10 C to its capacity at discharge rate of 1 C is greater than 80%.

Ex. 1001, 8:56–9:3.

E. The Asserted Grounds of Unpatentability

Petitioner contends that claims 1–19 of the '480 patent are unpatentable on the following grounds. Pet. 22–72.

Ground	Reference(s)	Basis ¹	Claims Challenged
1	Ito ²	§ 102	1, 3, 5–9, 11, 13, 17–19
2	Ito, Gozdz, ³ General Common Knowledge	§ 103	1–19
3	Hisamitsu ⁴	§ 102	1–19
4	Hisamitsu, Desilvestro, ⁵ Gozdz, Saito ⁶	§ 103	1–19

¹ The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), amended 35 U.S.C. §§ 102, 103. Because the '480 patent has an effective filing date prior to the effective date of the applicable AIA amendments, we refer to the pre-AIA versions of §§ 102, 103.

² JP Pub. No. 2002-117832, published April 19, 2002 (Ex. 1024). Petitioner provides a certified English translation of Ito as part of Ex. 1024.

³ US Pub. No. 2005/0233219 A1 (Ex. 1003).

⁴ JP Pub. No. 2005-174691, published June 30, 2005 (Ex. 1002). Petitioner provides a certified English translation of Hisamitsu as part of Ex. 1002.

⁵ WO Pub. No. WO 2005/018038 A2 (Ex. 1017).

⁶ US Pub. No. 2005/0132562 A1 (Ex. 1016).

In support of its unpatentability arguments, Petitioner relies on the declaration of Dr. Peter Khalifah. Ex. 1023. Petitioner also relies on the declaration of Dr. Khalifah that was filed in IPR2021-00894. Ex. 1013.

II. ANALYSIS

A “patent owner may file a statutory disclaimer under 35 U.S.C. [§] 253(a) in compliance with § 1.321(a) of this chapter, disclaiming one or more claims in the patent. No *inter partes* review will be instituted based on disclaimed claims.” 37 C.F.R. § 42.107(e) (2019).

A disclaimer under 35 U.S.C. § 253(a) is “considered as part of the original patent” as of the date on which it is “recorded” in the U.S. Patent and Trademark Office (“Office”). 35 U.S.C. § 253(a). For a disclaimer to be “recorded” in the Office, the document filed by the patent owner must:

- (1) Be signed by the patentee, or an attorney or agent of record;
 - (2) Identify the patent and complete claim or claims, or term being disclaimed. A disclaimer which is not a disclaimer of a complete claim or claims, or term will be refused recordation;
 - (3) State the present extent of patentee’s ownership interest in the patent; and
 - (4) Be accompanied by the fee set forth in [37 C.F.R.] § 1.20(d).
- 37 C.F.R. § 1.321(a); *see also Vectra Fitness, Inc. v. TNWK Corp.*, 162 F.3d 1379, 1382 (Fed. Cir. 1998) (holding that a § 253 disclaimer is “recorded” on the date that the Office receives a disclaimer meeting the requirements of 37 C.F.R. § 1.321(a), and that no further action is required in the Office for a disclaimer to be “recorded”).

Here, Patent Owner filed a statutory disclaimer of claims 1–19 of the ’480 patent. Ex. 3001. Based on our review of Exhibit 3001 and Office

public records, we conclude that a disclaimer of claims 1–19 of the ’480 patent under 35 U.S.C. § 253(a) has been recorded in the Office as of October 20, 2021. Based on the information in the public record, we find that the disclaimer complies with the above-listed requirements of 37 C.F.R. § 1.321(a).

Because all challenged claims 1–19 have been disclaimed under 35 U.S.C. § 253(a), in compliance with 37 C.F.R. § 1.321(a), no *inter partes* review is instituted in this proceeding. 37 C.F.R. § 42.107(e); *General Electric Co. v. United Techs. Corp.*, IPR2017-00491, Paper 9 (PTAB July 6, 2017) (precedential) (declining to institute *inter partes* review when all challenged claims were disclaimed under 35 U.S.C. § 253(a)).

III. CONCLUSION

For the reasons set forth above, we *deny* the Petition and do not institute *inter partes* review.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is *denied* and no *inter partes* review is instituted.

FOR PETITIONER:

Barbara Ann McCoy
John Russell
Kia Freeman
MCCOY RUSSELL LLP
mccoy@mccrus.com
john@mccrus.com
kfreeman@mccarter.com

FOR PATENT OWNER:

Hsuanyeh Chang, PhD
Stephen Y. Chow
HSUANYEH LAW GROUP PC
hsuanyeh@hsuanyeh.com
stephen.y.chow@hsuanyeh.com