

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZHUHAI COSMX BATTERY CO., LTD.,
Petitioner

v.

NINGDE AMPEREX TECHNOLOGY LTD.,
Patent Owner

IPR2023-00586
Patent 10,833,363

**PATENT OWNER'S MOTION TO CEDE JURISDICTION FOR
CORRECTION OF INVENTORSHIP**

TABLE OF EXHIBITS

Exhibit Number	Description
2001	Declaration of Victor R. Koch, Ph.D.
2002	Curriculum Vitae of Victor R. Koch, Ph.D.
2003	Statutory Disclaimer Under 37 CFR 1.321(a) and Electronic Acknowledgment Receipt dated May 25, 2023.
2004	Dixon Valve List of Dielectric Constants available at https://dixonvalve.com/sites/default/files/documents/dielectric-constant-values_0.pdf (last accessed on May 29, 2023).
2005	“Propylene Carbonate Solvent Properties,” available at https://macro.lsu.edu/howto/solvents/Propylene%20Carbonate.htm (last accessed on May 29, 2023).
2006	Chugh <i>et al.</i> , A Combinatorial Study of Electrochemical Anion Intercalation into Graphite, <i>Mater. Res. Express</i> , 8, 085502 (2021).
2007	Akkoyun <i>et al.</i> , On the Use of an Internal Mixer to Study the Impregnation of Carbon Fillers by Organic Liquids, <i>Appl. Rheol.</i> 24, 13487 (2014).
2008	Statement by Removed Inventor, Liangzhen Xiao
2009	Statement by Removed Inventor, Qiao Zeng
2010	Statement by Existing Inventor, Kefei Wang
2011	Statement by Existing Inventor, Fei Wu
2012	Statement of Assignee Ningde Amperex Technology Limited

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Egenera, Inc. v. Cisco Systems, Inc.</i> , 972 F.3d 1367 (Fed. Cir. 2020)	5, 6
<i>Honeywell Int’l Inc. v. Arkema Inc.</i> , 939 F.3d 1345 (Fed. Cir. 2019)	<i>passim</i>
<i>Intuitive Surgical, Inc. v. Ethicon</i> , IPR2020-00050, -00051, Paper No. 13 (P.T.A.B. Feb. 26, 2020)	7
Statutes	
35 U.S.C. § 255	4, 5, 7
35 U.S.C. § 256	<i>passim</i>
Other Authorities	
37 C.F.R. § 1.324	<i>passim</i>
37 C.F.R. § 42.22	1
77 Fed. Reg. 48,776	3
MPEP § 1481.02	3

I. INTRODUCTION

Pursuant to 37 C.F.R. § 1.324 and 37 C.F.R. § 42.22, Ningde Amperex Technology LTD. (“ATL”) respectfully files this motion to request that the Board cede jurisdiction for correction of inventorship and authorize a petition to the Director for a Certificate of Correction that corrects the inventorship of the ’363 Patent. Specifically, ATL seeks to correct the inventorship of the ’363 Patent by removing Qiao Zeng and Liangzhen Xiao as inventors, leaving Kefei Wang and Fei Wu as the inventors of the ’363 Patent. The Board authorized this motion in an e-mail dated July 17, 2023.

35 U.S.C. § 256 and 37 C.F.R. § 1.324 allow a patent owner to correct an error of inventorship through a Certificate of Correction after the patent has been issued. Under 37 C.F.R. § 1.324, the Board must first cede its exclusive jurisdiction over the patent and authorize a patent owner to request a certificate of correction from the Director. A sufficient basis exists for the Board to grant this motion because Qiao Zeng and Liangzhen Xiao are incorrectly listed as inventors of the ’363 Patent. Each of Kefei Wang, Qiao Zeng, Liangzhen Xiao, Fei Wu, and ATL are prepared to submit statements confirming that they agree with the change of inventorship. ATL is also prepared to pay the fee associated with seeking a certificate of correction. Nothing further is required under 35 U.S.C. § 256 and 37 C.F.R. § 1.324. The correction of inventorship will have no effect on the patentability issues or schedule

in this *inter partes* review. As such, the Board should grant ATL permission to seek a Certificate of Correction.

II. LEGAL STANDARD

A patent owner may request that the Director correct inventorship in an issued patent through a Certificate of Correction. 35 U.S.C. § 256. The Director issued the following regulation to set the requirements for such a request:

(a) Whenever through error a person is named in an issued patent as the inventor, or an inventor is not named in an issued patent, the Director, pursuant to 35 U.S.C. 256, may, on application of all the parties and assignees, or on order of a court before which such matter is called in question, issue a certificate naming only the actual inventor or inventors.

(b) Any request to correct inventorship of a patent pursuant to paragraph (a) of this section must be accompanied by:

(1) A statement from each person who is being added as an inventor and each person who is currently named as an inventor either agreeing to the change of inventorship or stating that he or she has no disagreement in regard to the requested change;

(2) A statement from all assignees of the parties submitting a statement under paragraph (b)(1) of this section agreeing to the change of inventorship in the patent, which statement must comply with the requirements of § 3.73(c) of this chapter; and

(3) The fee set forth in § 1.20(b).

37 C.F.R. § 1.324 (as revised by 77 Fed. Reg. 48,776 (Aug. 14, 2012), effective Sept. 16, 2012)); *see also* MPEP § 1481.02 (explaining the applicability of the post-AIA version of the rule to “requests filed on or after Sept. 16, 2012”).

“When a patentee seeks to correct a patent that is subject to a post-issuance review proceeding, the patentee must first file a motion with the Board seeking authorization to petition the Director for a Certificate of Correction, asking the Board to temporarily cede its exclusive jurisdiction over the proceedings.” *Honeywell Int’l Inc. v. Arkema Inc.*, 939 F.3d 1345, 1348 (Fed. Cir. 2019). According to the Federal Circuit,

a patent owner subject to a post-issuance review proceeding must take three steps in order to file a petition for a Certificate of Correction: (1) seek authorization from the Board to file a motion, 37 C.F.R. § 42.20(b); (2) if authorization is granted, file a motion with the Board, asking the Board to cede its exclusive jurisdiction so that the patentee can seek a Certificate of Correction from the Director, 37 C.F.R. § 1.323; MPEP § 1485; and (3) if the motion is granted, petition the Director for a Certificate of Correction under 35 U.S.C. § 255.

Id. at 1349.

To determine whether the Board should cede its exclusive jurisdiction and allow the patent owner to seek a Certificate of Correction, the Board “‘determine[s] whether there is sufficient basis supporting [ATL’s] position that the mistake may be correctable.’” *Id.* (quoting *Plastic Dev. Grp., LLC v. Maxchief Investments, Ltd.*, No. IPR2017-00846, Paper No. 16 at 2 (P.T.A.B. Nov. 13, 2017) (analyzing the procedure for a Certificate of Correction under 35 U.S.C. § 255). The Board’s review and approval of a patent owner’s motion for leave to seek a Certificate of Correction from the Director does not involve any decision about the merits of the patent owner’s petition. *Id.* (citing *United Servs. Auto. Ass’n v. Asghari-Kamrani*, No. CBM2016-00063, Paper No. 10 at 6 (P.T.A.B. August 4, 2016)) (“After those three steps are completed, the Director—not the Board—will evaluate the merits of the patentee’s petition” and “[The Board is] not the deciding official for a request for a Certificate of Correction”).

III. ARGUMENT

ATL has followed the necessary steps to obtain a Certificate of Correction, and the Board’s approval here does not require the Board to assess or review the merits of ATL’s request. *Id.* When a patent owner seeks a Certificate of Correction for a patent that is subject to a post-issuance review proceeding, the patent owner must first request authorization from the Board to file a motion. *Honeywell*, 939 F.3d at 1349 (Fed. Cir. 2019) (citing 37 C.F.R. § 42.20(b)) (analyzing the process

for requesting a Certificate of Correction under 35 U.S.C. § 255). Once authorization has been given, the patent owner must file a motion requesting that the Board cede its exclusive jurisdiction over the patent and grant the patent owner leave to seek a Certificate of Correction from the Director. *Id.* (citing 37 C.F.R. § 42.3(a)); *see also* 37 C.F.R. §§ 1.324(d). ATL has performed the first and second *Honeywell* steps by receiving authorization from the Board and by filing this motion. *See* 939 F.3d at 1349 (citing 37 C.F.R. § 42.20). Should the Board grant this motion, ATL will then file a petition seeking a Certificate of Correction from the Director. In conjunction with that petition, ATL will provide the necessary statements from the inventors to be removed, the remaining inventors listed on the '363 Patent, and ATL. Each statement will confirm that Fei Wu and Kefei Wang should be the only listed inventors of the '363 Patent and that the removed inventors are named in error. *See* 37 C.F.R. § 1.324(b)(1)-(2); *see also* Exhibits 2008-2012. ATL is also prepared to pay the associated fee. *See id.* § 1.324(b)(3). As such, ATL is able to comply with each of the steps described in *Honeywell* to obtain a Certificate of Correction.

An error in inventorship comprises a sufficient basis that supports ATL's position that the mistake in inventorship in the '363 Patent is correctable. “Error [in 35 U.S.C. § 256] is simply the incorrect listing of inventors.” *Egenera, Inc. v. Cisco Systems, Inc.*, 972 F.3d 1367, 1377 (Fed. Cir. 2020). The Federal Circuit also noted that this type of request for inventorship correction under § 256 is merely a

“matter of formality.” *Id.* at 1379. Here, Qiao Zeng and Liangzhen Xiao are incorrectly listed as inventors of the ’363 Patent. This error can be remedied through a Certificate of Correction issued pursuant to 35 U.S.C. § 256 and 37 C.F.R. § 1.324. *See id.* at 1376–79 (“§ 256 is a savings provision, functioning to prevent invalidation when correction is available.”). ATL also confirms that the requested correction of inventorship will have no effect on the patentability issues or trial schedule if the certificate of correction is issued during the pendency of any trial that might be instituted in this proceeding. There is also no suggestion by Petitioner that the incorrect listing of additional inventors offered ATL any procedural or other advantage in prosecution or that this correction offers any procedural advantage in this proceeding.

By demonstrating that an error in inventorship exists, and that all the inventors and the assignee agree with the corrected listing of inventors, ATL has shown that a sufficient basis exists to support ATL’s position that the error in inventorship may be correctable. Therefore, the Board should grant ATL’s motion. *See Honeywell*, 939 F.3d at 1349 (citing *Plastic Dev. Grp.*, Paper No. 16 at 2).

Petitioner takes no position “on the correctness of [ATL’s] request to correct inventorship, nor on the manner in which ATL propose[s] to do so.” The Board has recognized that non-opposition like this leads to “the logical conclusion that Patent Owner has shown a sufficient basis in support of its position and that the matter

should be considered by the appropriate official charged with answering the question, namely, the Director.” *Intuitive Surgical, Inc. v. Ethicon*, IPR2020-00050, -00051, Paper No. 13 at 4 (P.T.A.B. Feb. 26, 2020) (granting a motion for leave to file a petition for a Certificate of Correction under 35 U.S.C. § 255).

If Petitioner does nonetheless oppose, any arguments by Petitioner regarding whether 35 U.S.C. § 256 and 37 CFR § 1.324 are the correct procedure for seeking this relief is contradicted by the case law cited herein, which confirms that the Board should grant the Motion and allow the Director to review the merits of the petition. *See id.*

Petitioner may also argue that the correction of inventors may be procedurally improper by importing a timing requirement into the statute. Specifically, Petitioner may argue that ATL’s current request was prompted by the recent cancellation of claims 13-16 of the ’363 Patent, not an error pre-issuance. Such an argument not only mischaracterize the bases for ATL’s request, but is also inapposite. Contrary to Petitioner’s characterization, the statutory language contains no timing limitation, but expressly allows for correction by patent owner “[w]hen~~ever~~ through error a person is named in an issued patent as the inventor” 35 U.S.C. § 256 (emphasis added).

For the Board to find sufficient basis to grant a motion for leave to file a petition for a Certificate of Correction under 35 U.S.C. § 256 and 37 C.F.R. § 1.324,

all that is required is error in inventorship. ATL has demonstrated that such an error exists and that it can be corrected by the Director.

IV. CONCLUSION

ATL therefore respectfully requests that the Board grant this motion in view of the authority outlined in *Honeywell* and cede its jurisdiction over the '363 Patent so that ATL can file its petition for a Certificate of Correction from the Director to correct the error of inventorship of the '363 Patent pursuant to 37 C.F.R. § 1.324. *See Honeywell*, 939 F.3d at 1349 (citing *Plastic Dev. Grp.*, Paper No. 16 at 2).

Dated: July 31, 2023

Respectfully submitted,

/ Christopher TL Douglas /
Christopher TL Douglas, Reg. No. 56,950

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §42.6(e), the undersigned hereby certifies that a copy of the foregoing **PATENT OWNER'S MOTION TO CEDE JURISDICTION FOR CORRECTION OF INVENTORSHIP AND CITED EXHIBITS** were served by filing this document through the P-TACTS System as well as delivering a true and correct copy by electronic mail on CosMX's lead and backup counsel at the following email addresses (as agreed by counsel for CosMX):

Michele C. Bosch (michele.bosch@finnegan.com)

Joshua L. Goldberg (joshua.goldberg@finnegan.com)

Anthony A. Hartmann (anthony.hartmann@finnegan.com)

Daniel F. Klodowski (daniel.klodowski@finnegan.com)

A Grace Mills (gracie.mills@finnegan.com)

Dated: July 31, 2023

Respectfully submitted,

/ Christopher TL Douglas /
Christopher TL Douglas, Reg. No. 56,950