

Filed on behalf of: Zhuhai CosMX Battery Co., Ltd.

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.

Case No. IPR2023-00586

Patent No. 10,833,363

**PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION TO
CEDE JURISDICTION FOR CORRECTION OF INVENTORSHIP¹**

¹ This Opposition was authorized by the Board's July 17, 2023, email (Exhibit 1034).

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EXHIBIT LIST

Exhibit	Description
1001	U.S. Patent No. 10,833,363
1002	File History for U.S. Patent No. 10,833,363
1003	Declaration of Dr. Menahem Anderman dated February 23, 2023
1004	Chinese Patent No. 106848381 (“Hong”)
1005	Translation of Chinese Patent No. 106848381 (“Hong”)
1006	U.S. Patent Pub. No. 2017/0084956 (“Zhuang”)
1007	U.S. Patent No. 6,544,685 (“Kim ’685”)
1008	U.S. Patent Pub. No. 2017/0069934 (“Kim ’934”)
1009	U.S. Patent Pub. No. 2007/0172736 (“Fujikawa”)
1010	Material Safety Data Sheet for Adiponitrile (ADN)
1011	Material Safety Data Sheet for Diethyl Carbonate (DEC)
1012	Material Safety Data Sheet for Ethylene Glycol Bis(propionitrile) Ether (DENE)
1013	Material Safety Data Sheet for Ethylene Sulfate (DTD)
1014	Material Safety Data Sheet for Ethylene Carbonate (EC)
1015	Material Safety Data Sheet for Fluoroethylene Carbonate (FEC)
1016	Material Safety Data Sheet for 1,3,6-Hexane Tricarbonitrile (HTCN)
1017	Material Safety Data Sheet for Lithium Hexafluorophosphate (LiPF ₆)

Exhibit	Description
1018	Material Safety Data Sheet for Lithium bis(trifluoromethanesulfonyl)imide (LiTFSI)
1019	Material Safety Data Sheet for Propylene Carbonate (PC)
1020	Material Safety Data Sheet for Propyl Propionate (PP)
1021	Material Safety Data Sheet for 1,3-Propane Sultone (PS)
1022	Material Safety Data Sheet for Succinonitrile (SN)
1023	Material Safety Data Sheet for Propanephosphonic Acid Anhydride (T3P)
1024	Material Safety Data Sheet for Vinylethylene Carbonate (VEC)
1025	Seward, et al., “The Dielectric Constants of Ethylene Carbonate and of Solutions of Ethylene Carbonate in Water, Methanol, Benzene and Propylene Carbonate,” <i>J. Phys. Chem.</i> , 62:1, 127-128 (1958)
1026	Declaration of Kelley Hayes Greenhill dated February 23, 2023
1027	ACS Common Organic Solvents Table of Properties
1028	ATL’s Infringement Contentions regarding the ’363 patent in <i>Ningde Amperex Tech. Ltd. v. Zhuhai CosMX Battery Co., Ltd.</i> , Civ. No. 2:22-cv-00232-JRG (E.D. Tex.)
1029	Docket Control Order in <i>Ningde Amperex Tech. Ltd. v. Zhuhai CosMX Battery Co., Ltd.</i> , Civ. No. 2:22-cv-00232-JRG (E.D. Tex.)
1030	United States District Court Judicial Caseload Profile
1031	ATL’s Amended Complaint filed in <i>Ningde Amperex Tech. Ltd. v. Zhuhai CosMX Battery Co., Ltd.</i> , Civ. No. 2:22-cv-00232-JRG (E.D. Tex.)
1032	ATL’s Complaint filed in <i>Ningde Amperex Tech. Ltd. v. Zhuhai CosMX Battery Co., Ltd.</i> , Civ. No. 2:22-cv-00232-JRG (E.D. Tex.)

Exhibit	Description
1033	June 7, 2023, E-mail from Patent Trial and Appeal Board in IPR2023-00586
1034	July 17, 2023, E-mail from Patent Trial and Appeal Board in IPR2023-00586
1035	July 13, 2023, Email string between counsel, C. Douglas and A. Hartmann
1036	ATL's Responses to CosMX's Third Set of Interrogatories in Ningde Ampere Tech. Ltd. v. Zhuhai CosMX Battery Co., Ltd., Civ. No. 2:22-cv-00232-JRG (E.D. Tex.), dated May 31, 2023

I. Introduction

Patent Owner ATL's motion requests the Board cede jurisdiction over the '363 Patent and authorize a petition to correct the inventorship. Paper 12 (Motion) at 1. Petitioner CosMX lacks sufficient information to oppose ATL's request but submits that the request is untimely. For the third time, ATL fails to adequately specify its basis for correcting the inventorship of the '363 Patent. Indeed, ATL offers the Board no basis at all, only a conclusion—"Qiao Zeng and Liangzhen Xiao are incorrectly listed as inventors." *Id.* at 6.

At a minimum, the available record is insufficient for the Board to act in its gate-keeper role. Accordingly, CosMX respectfully requests the Board deny ATL's motion as premature to allow a more complete record to develop in the parallel district court litigation and then be submitted to the Board for consideration. In the alternative, CosMX respectfully requests the Board order ATL to include a copy of the motion briefing and exhibits with its petition to the Director to enable appropriate consideration.

II. Argument

35 U.S.C. § 256 states that:

Whenever through error a person is named in an issued patent as the inventor ... the Director may, on application of all the parties and assignees, with proof of the facts and

such other requirements as may be imposed, issue a certificate correcting such error.

(emphasis added). The M.P.E.P. comments that “[w]hile 35 U.S.C. 256 was amended to remove the requirement that the error was made ‘without deceptive intention,’ practitioners still have a duty to conduct a reasonable inquiry to name the actual inventors in a patent application.” M.P.E.P. §1481.02.

The Federal Circuit in *Honeywell Int’l Inc. v. Arkema Inc.*, 939 F.3d 1345 (Fed. Cir. 2019) found that when the Board is asked to cede its jurisdiction to correct a patent pursuant to Section 256, it is appropriate for the Board “to ‘determine whether there is *sufficient basis* supporting Patent Owner’s position that the mistake *may be correctable*.’” *Id.* at 1349 (emphasis in original) (quoting *Plastic Dev. Grp., LLC v. Maxchief Invests., Ltd.*, No. IPR2017-00846, Paper No. 16 at 2 (PTAB Nov. 13, 2017)). In other words, not all alleged errors in inventorship are necessarily correctable. *See e.g., Cummins-Allison Corp. v. SBM Co., Ltd.*, No. 9:07CV196, 2009 U.S. Dist. LEXIS 106111 at *10 (E.D. Tex. Nov. 13, 2009) (denying patent owner’s motion as “inventors’ testimony was not sufficiently corroborated”), *rev’d in-part on other grounds*, 484 Fed. Appx 499 (Fed. Cir. 2012). Consistent with Section 256 and its gate-keeper role specified in *Honeywell*, the Board instructed ATL when authorizing ATL’s motion that:

The motion should set forth Patent Owner's *basis for correcting inventorship*, the specific order requested, the Board's authority to grant such an order, and the effect of any such certificate should it be issued during the pendency of any trial that might be instituted in this proceeding.

Exhibit 1034 (emphasis added).

The Federal Circuit has “recognized a presumption that the inventors on an issued patent are correctly named, so misjoinder of inventors must be proven by clear and convincing evidence.” *Trovan, Ltd. V. Sokymat SA*, No. 99-1747, 99-1488, 2000 U.S. App. LEXIS 22901 at *7 (Fed. Cir. Sept. 8, 2000) (citing *Hess v. Advanced Cardiovascular Sys., Inc.*, 106 F.3d 976, 979-80 (Fed. Cir. 1997)). And yet, as to the Board's first requirement (“Patent Owner's basis for correcting inventorship”), ATL's motion does not offer clear and convincing evidence. Rather, it circularly states that “[h]ere, Qiao Zeng and Liangzhen Xiao are incorrectly listed as inventors.” Paper 12 at 6. ATL's conclusory statement fails to provide sufficient information for the Board to decide whether there is sufficient basis supporting ATL's position that this supposed mistake may be correctable.

ATL's proffered inventor statements offer the Board no further enlightenment. Each inventor simply states their agreement to ATL's proposed change of inventorship after reviewing only claims 1 to 12. *See* Exhibits 2009 to 2011. None

offers any additional facts concerning the basis for making ATL's proposed correction to inventorship of the '363 Patent, let alone any explanation as to why this change is warranted. Such facts are certainly within the possession of ATL.

Importantly, these inventor statements appear to be inconsistent with the known inventorship facts in the present record. In particular, each inventor signed a declaration under oath on or before December 16, 2018, saying they "believe that I am the original inventor or an original joint inventor of a claimed invention in the application." Exhibit 1002 at 67-70. In contrast to the recently proffered inventor statements, these inventor declarations were contemporaneous with the work that led to the claims of the '363 Patent. ATL made no attempt to correct that inventorship under 37 C.F.R. § 1.48 prior to issuance of the '363 Patent when the facts remained fresh in the minds of those with knowledge. *See* Exhibit 1002. Nor do the inventors repudiate their prior declarations in their proffered statements. *See* Exhibits 2009 to 2011.

The proffered inventor statements also appear to be inconsistent with the evidence that is being developed in the parallel district court litigation. Days after ATL filed its statutory disclaimer of claims 13 to 16 (Exhibit 2003), ATL served on CosMX a sworn, non-confidential Interrogatory response explaining that:

The inventors of the '363 Patent, Kefei Wang, Qiao Zeng,
Liangzhen Xiao, and Fei Wu, conceived and reduced to

practice of the inventions in the '363 Patent at least by September 21, 2018, when Chinese application no. 201811108529.X was filed, which establishes priority for all claims of the '363 Patent at least as early as this date.

Exhibit 1036 at 5. “Conception is the touchstone of inventorship, the completion of the mental part of invention.” *Burroughs Wellcome Co. v. Barr Labs., Inc.*, 40 F.3d 1223, 1227-28 (Fed. Cir. 1994).

Furthermore, it is CosMX’s understanding that inventors Qiao Zeng and Liangzhen Xiao, whom ATL seeks to remove from the '363 Patent, provided deposition testimony in June 2023 that is relevant to the inventorship issue. ATL sealed that testimony as confidential under the Protective Order of the parallel district court litigation and has not offered to provide that information to the Board or the Director. *See* Paper 12.

ATL’s evasiveness regarding its basis for correcting inventorship predates this motion. When ATL sought CosMX’s position on its proposed motion, CosMX twice asked whether ATL was “asserting that there was an error in inventorship in the patent as issued or following the disclaimer of claims 13-16?” and received the non-answer, “that in view of claims 1-12 of the ‘363 patent, Qiao Zeng and Liangzhen Xiao are erroneously listed as inventors.” Exhibit 1035. Since ATL’s response did not provide any clarity, CosMX could take no position on the correctness of ATL’s

request to ask the Board to cede jurisdiction and, thus, notified ATL it would not oppose its request for authorization from the Board. *Id.*² ATL's motion provides no clarity, despite the express requirement of Section 256 and the Board's order to ATL to reveal its basis to correct inventorship.

In light of the lack of a factual record and sufficient basis, whether not disclosed or not yet developed, CosMX respectfully submits that it would be most appropriate for the Board to deny, and if not at least defer, ruling on ATL's motion to allow the factual record to be developed in the parallel district court litigation and be submitted to the Board. There can be no disagreement that district courts are an appropriate venue for addressing inventorship disputes. *See Checkpoint Sys., Inc. v. All-Tag Sec. S.A.*, 412 F.3d 1331, 1338 (Fed. Cir. 2005) ("However, 'if a patentee can demonstrate that inventorship can be corrected as provided by [35 U.S.C. § 256], a district court must order correction of the patent, thus saving it from being rendered

² ATL asserts that "[t]he 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.'" Paper 12 at 6-7 (quoting *Intuitive Surgical, Inc. v. Ethicon, LLC*, IPR2020-00050, -00051, Paper No. 13 at 4 (PTAB Feb. 26, 2020)). The Petitioner in *Intuitive Surgical*, however, "disagree[d] with Patent Owner" and the Board "considered the parties' differing views of the matter presented." *Id.*

invalid.”) (quoting *Pannu v. Iolab Corp.*, 155 F.3d 1344, 1350 (Fed. Cir. 1998)). Moreover, denial would avoid duplication of efforts and conserve the Office’s resources, particularly given that inventorship is an issue that ATL admits will have no bearing on any trial that might be instituted in this proceeding. Paper 12 at 6. With a further developed record of facts before it, the Board could assess whether “there is sufficient basis supporting Patent Owner’s position that the mistake may be correctable” to warrant ceding its jurisdiction and the Director can likewise assess whether the merits of ATL’s petition permit correction of the inventorship.

III. Conclusion

For the foregoing reasons, CosMX respectfully requests the Board deny, if not defer, as premature ATL’s Motion so as to allow the inventorship record to be developed in the parallel district court litigation and then provided to the Board. In the alternative, CosMX respectfully requests the Board order ATL to include a copy of the complete motion briefing and exhibits with its submission to the Director so that the Director is made aware of the above-mentioned circumstances and can conduct an appropriate investigation, if deemed warranted.

Respectfully submitted,

Date: August 14, 2023

By: / Michele C. Bosch /
Michele C. Bosch, Reg. No. 40,524

CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing **Petitioner's Opposition to Patent Owner's Motion to Cede Jurisdiction for Correction of Inventorship and Exhibits 1034 to 1036** were served via email on August 14, 2023, in their entirety on the following:

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Patent Owner has consented to service by email.

Dated: August 14, 2023

By: /Mark A. Rosenberger/
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