

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ASCEND ELEMENTS, INC.

Petitioner,

v.

DUESENFELD GMBH.

Patent Owner.

Inter Partes Review No. IPR2024-00948

U.S. Patent No. 11,050,097

PATENT OWNER'S PRELIMINARY SUR-REPLY¹

¹ This paper was authorized by the Panel in its email of September 20, 2024.

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PATENT OWNER'S EXHIBIT LIST

Exhibit Number	Description
2001	Declaration of Vani Dantam in support of Patent Owner's Preliminary Response to the Petition ("Dantam Declaration")
2002	Gao Liu et al., <i>Binder Interactions in the Electrodes of the Lithium-ion Batteries</i> , TFUG Conference, February 17, 2009 ("Gao")
2003	DE 102012024876 A1 to Electro Cycling GmbH ("Electro cycling") (English)
2004	U.S. Patent No. 7,198,865 to Sloop ("Ecobat")
2005	WO 2010/149611 A1 to LiMotive Company Ltd. ("LiMotive") (English)
2006	WO 2010/149611 A1 to LiMotive Company Ltd. ("LiMotive") (German)
2007	DE 102012024876 A1 to Electro cycling GmbH ("Electro cycling") (German)
2008	Yang et al., <i>Thermal Stability of LiPF₆ Salt and Li-Ion Battery Electrolytes Containing LiPF₆</i> , Journal of Power Sources 161, 573 (2006) (Preprint) ("Yang")
2009	Gnanaraj et al., <i>A Detailed Investigation of the Thermal Reactions of LiPF₆ Solution in Organic Carbonates Using ARC and DSC</i> , Journal of the Electrochemical Society, 150(11), A1533 (2003) ("Gnanaraj")
2010	Certification of Translation of the Electro cycling Patent
2011	Certification of Translation of the Limotive Patent
2012	Duesenfeld GmbH Website – Recycling [https://www.duesenfeld.com/recycling_en.html]
2013	Ascend Elements Press Release

2014	<i>Ascend Elements, Inc. 's Answer to Complaint</i> , Case No. 1-23-cv-01194 (D. Del.)
2015	Scheduling Order in Case No. 23-1194-JFM
2016	Email from J.Stiel to J.Ploger (dated Dec. 6, 2023)(German)
2017	Email from J.Stiel to J.Ploger (dated Dec. 6, 2023)(English)
2018	Certification of Translation of Email from J.Stiel to J.Ploger (dated Dec. 6, 2023) and of Kwade, et al. (Ex. 2020, below)
2019	Christian Hanish et al., <i>Recycling von Lithium-Ionen-Batterien – das Projekt LithoRec</i> , Recycling und Rohstoffe, January 2012 (“Kwade, et al.”) (German)
2020	Christian Hanish et al., <i>Recycling von Lithium-Ionen-Batterien – das Projekt LithoRec</i> , Recycling und Rohstoffe, January 2012 (“Kwade, et al.”) (English)
2021	Yang et al., <i>Thermal Stability of LiPF₆ Salt and Li-Ion Battery Electrolytes Containing LiPF₆</i> , Journal of Power Sources 161, 573 (2006)
2022	Declaration of Steven C. Carlson in support of Patent Owner’s Preliminary Sur-Reply
2023	<i>Innovative Recycling Solutions from URT Umwelt- und Recyclingtechnik GmbH</i> , GLOBAL RECYCLING, https://global-recycling.info/archives/7090 (last visited October 7, 2024).
2024	<i>Service</i> , URT UMWELT- UND RECYCLINGTECHNIK GMBH, https://www.urt-recycling.com/seite/en/disposal/057/tn_57/Service.html (last visited October 7, 2024).

I. ASCEND MISCHARACTERIZES DUESENFELD’S ARGUMENT

Ascend’s primary challenge – and their reason for seeking a reply – is that Duesenfeld has allegedly pointed to no more than a “mere supplier/customer relationship” between Ascend and URT. *See* Reply at 1; *see also* 2024.09.17 Email to the Board (Duesenfeld’s opposition to Ascend’s request). Ascend is wrong. Duesenfeld pointed to several specific reasons that illustrate that Ascend and URT’s relationship goes *beyond* that of a standard supplier/customer relationship, including that: (1) “URT builds and supplies the accused instrumentality that is *at issue in the District Court litigation*” (emphasis added); (2) that “URT was aware of [Duesenfeld’s] . . . infringement allegations against Ascend”; (3) that “URT . . . reached out to Duesenfeld to assert prior art against the ’097 patent . . .” and did so “*less than two months* after the Complaint [against Ascend] was filed . . .” (emphasis added), and (4) that “every claim that Ascend is challenging has already been challenged by URT.” *See* POPR at 42-43. These make the Ascend/URT relationship analogous to the relationship analyzed in *Valve Corp. v. Elec. Scripting Prods., Inc.*, IPR2019-00062, Paper 11 (PTAB Apr. 2, 2019) (precedential) (“Valve”).

At bottom, Ascend would have the Board believe that URT’s efforts are mere happenstance. Reply at 1 (“Patent Owner . . . argues that the Petition should be denied because URT—an *arm’s-length supplier of equipment to Ascend*—filed a separate IPR petition . . .”) (emphasis added). But a “mere supplier/customer

relationship,” as Ascend claims exists, would not compel an (overseas) supplier to actively participate in domestic US litigation (in multiple fora) involving its customer, Ascend. Ascend’s narrative defies logic. It should be disregarded.

II. ASCEND AND URT’S RELATIONSHIP IS SIGNIFICANT

Ascend cedes that discretionary denial under *General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (PTAB Sep. 6, 2017) (“General Plastic”) is appropriate in situations where different petitioners have a “significant relationship[]” with one another. *See* Reply at 1. The dispute, then, is whether or not URT and Ascend’s relationship is “significant” under *Valve* and its progeny. It is.

Duesenfeld has drawn the analogy between this case and *Valve* already in its POPR. *See* POPR 42-43. URT is not just a supplier to Ascend; rather, URT assisted in ***building Ascend’s plant***, and as such URT is significantly involved in its operation. *See, e.g.*, Exs. 2023 (“URT is building several plants in . . . the USA.”); 2024 (*e.g.*, “continuous maintenance”). Ascend attempts to distinguish this by claiming that, in *Valve*, the supplier and customer both (1) used the same expert and (2) that one “had access to the Board’s institution decision in the [first] IPR before filing the [second] Petition” Reply at 2 (internal quotations omitted). But *Valve* does not require such rigidity. Rather, “when different petitioners challenge the same patent, . . . [the Board] consider[s] ***any relationship*** between those petitioners when

weighing the *General Plastic* factors.” *Valve* at 2 (emphasis added). Thus, while it is certainly the case that the close relationship, as well as the unfairness to Duesenfeld in defending two IPRs challenging the same claims from two related parties, would be even ***more apparent*** had Ascend and URT used the same expert and/or waited until one petition was ruled on before filing, the parties’ relationship is still such that that which the Board found concerning in *Valve* is applicable here.

The non-precedential and non-informative cases that Ascend introduces in its Reply do not counsel otherwise. In *Nokia of Am. Corp. v. General Access Sols., Ltd.*, (“Nokia”), the Board noted its concern that “Patent Owner does not direct our attention to ***any evidence*** indicating the substance of [the relationship between allegedly related petitioner]” (emphasis added). IPR2024-00461, Paper 13 at 17-18 (PTAB June 14, 2024). Duesenfeld, unlike the Patent Owner in *Nokia*, has identified evidence indicating that URT and Ascend have a significant relationship with each other. Likewise, in *Streck, Inc. v. Ravgen, Inc.* (“Streck”), the Board noted concern for the fact that the only evidence Patent Owner offered to support their claim that the relationship between the two petitioners was significant was that one petitioner “provided some experimental or testing assistance to” the other petitioner, but that such testing only “ostensibly related to how Streck’s tubes are designed and work, ***not invalidity issues.***” IPR2021-01577, Paper 20 at 17-18 (PTAB Apr. 22, 2022) (emphasis added). Once more, this is not the case here. A mere two months after

Duesenfeld filed suit against Ascend for patent infringement, it was **URT** that reached out to Duesenfeld to assert **invalidity-based** positions against the '097 patent, presumably on behalf of its customer, Ascend. *See* Ex. 2017. It is URT that helped build Ascend's plant. Ex. 2023. It is URT that helps operate that plant. Ex. 2024. And it is URT that filed their petition first. Ascend and URT's relationship is thus more than a standard supplier/customer relationship; it is "significant".

Ascend fails to inform the Board of decisions which support Duesenfeld's analysis. For example, in *Ericsson Inc. v. Uniloc 2017, LLC* ("Ericsson"), the Board determined that even where "absent this petition, no such relationship, on the record before us, existed" between the two petitioners that were alleged to have a significant relationship, the second petitioner nevertheless "implicitly created such a relationship by using the prior petitioners' work as a menu and picking and choosing from their work product." IPR2019-01550, Paper 8 at 11-12 (P.T.A.B. Mar. 17, 2020). In sum, the mere fact that the second petitioner had the benefit of reviewing the first petitioner's petition (and arguments therein) was enough to find the relationship "significant." URT and Ascend's relationship is certainly as, and indeed more, significant than the relationship between the petitioners in *Ericsson*.

Further, in *United Fire Protection Corp. v. Engineered Corrosion Solutions, LLC* ("United Fire Protection") the Board denied institution under *General Plastic without finding* that the two petitioners **were related at all**. Rather, the Board

determined that the fact that the second petitioner had the benefit of access to substantive arguments and pleadings in the prior petition, in combination with the fact that the two petitions both advanced significantly similar issues and arguments, was itself enough to deny institution. IPR2018-00991, Paper 10 at 12-18. Again, URT and Ascend's relationship is more significant than in *United Fire Protection*.

III. ASCEND'S OTHER ARGUMENTS ARE LIKEWISE UNAVAILING

Second factor: Ascend argues this factor should not apply to "two different petitioners filing two separate petitions." Reply at 4. Ascend is incorrect. The Board has applied factor 2 in precisely this scenario. *Valve* at 11 (finding *Georgia Pacific* Factor 2 weighed against institution); *Ericsson* at 12 (same).

Third factor: Ascend is correct that this factor weighs in favor of discretionary denial if Ascend was able to "road-map[]" their petition from URT's petition. Ascend had sufficient time (three weeks) to tailor its petition in light of the earlier URT petition and likely did. This is road-mapping. *Ericsson* at 11-12.

Fourth, Fifth, Sixth, and Seventh factors: Ascend's arguments regarding these factors amount to nothing more than a series of self-serving and conclusory statements. They need no further response. Duesenfeld rests on its POPR.

IV. CONCLUSION

For the foregoing reasons, Duesenfeld reaffirms its request that the Petition be denied.

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U.S. Pat. No. 11,050,097

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Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on October 7, 2024, a copy of this Patent Owner's Preliminary Sur-Reply, including all accompanying attachments, appendices, and exhibits, has been served in its entirety via e-mail on Attorneys for Petitioner at the following e-mail addresses:

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