

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

IPR2025-00405
Patent 11,769,910

**REQUEST FOR DIRECTOR REVIEW OF DECISION GRANTING
INSTITUTION OF *INTER PARTES* REVIEW**

TABLE OF CONTENTS

I. INTRODUCTION1

II. LEGAL STANDARD.....4

III. ARGUMENT.....5

 1. The Petitioner Forfeited Any Challenges to Claims 20-267

 2. The Board Agreed that Petitioner Failed to Present a Reasonable Likelihood of Success Against Claims 20-269

 3. The Board Agreed that Petitioner Failed to Meet the Threshold Showing with Respect to All Challenged Claims in Grounds 4C, 5C[1], 5C[2], 6C[1], and 6C[2]11

 4. This Failure of Proof for Multiple Grounds and for All Challenges to Claims 20-26 Warrants Denial of Institution to Preserve the Resources of the Board.....11

IV. CONCLUSION14

TABLE OF AUTHORITIES

	Page(s)
CASES	
<i>Chevron Oronite Co. v. Infineum USA LP</i> , IPR2018-00923, Paper 9, 9-11 (PTAB Nov. 7, 2018)	passim
<i>Deeper, UAB v. Vexilar, Inc.</i> , IPR2018-01310, Paper 7, 41-43 (PTAB Jan. 24, 2019).....	5, 11
<i>DK Crown Holdings Inc. v. Diogenes Ltd.</i> , IPR2023-00268, Paper 14 (Feb. 21, 2024).....	4
<i>Duration Media LLC v. Rich Media Club LLC</i> , IPR2023-00953, Paper 78 (Dec. 12, 2024)	4
<i>Force MOS Tech. Co., Ltd. v. ASUSTeK Computer, Inc.</i> , Case No. 2:22-cv-00460, ECF No. 74 (E.D. Tex. April 10, 2024).....	12
<i>Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.</i> , 821 F.3d 1359 (Fed. Cir. 2016)	6
<i>Motorola Sol'ns, Inc. v. Stellar LLC</i> , IPR2024-01205, Paper 19 (PTAB March 28, 2025) (Stewart, Dir.).....	13
<i>Nokia of Am. Corp. v. Soto</i> , IPR2023-00680, Paper 18 (Jan. 4, 2024).....	4
<i>Samsung Elecs. Co., Ltd. v. Icashe, Inc.</i> , IPR2025-00639, Paper 11 (PTAB Aug. 14, 2025) (Stewart, Dir.)	3
<i>SAS Inst. Inc. v. Iancu</i> , 584 U.S. 357 (2018).....	11
<i>Uniloc 2017 LLC v. Samsung Elecs. Am., Inc.</i> , No. 2:19-cv00259-JRG-RSP, 2020 WL 1433960 (E.D. Tex. Mar. 24, 2020)	13
<i>Zhuhai CosMX Battery Co., Ltd. v. Ningde Amperex Tech. Ltd.</i> , IPR2025-00385, Decision Denying Institution, Paper No. 10 (PTAB Aug. 20, 2025)	12

STATUTES

35 U.S.C. § 314.....2, 5, 6, 9

35 U.S.C. § 325.....13

OTHER AUTHORITIES

Director Review Process, *available at*

<https://www.uspto.gov/patents/ptab/decisions/director-review-process>

(last updated Aug. 12, 2025).....4

I. INTRODUCTION

Ningde Amperex Technology Ltd. (“ATL” or “Patent Owner”) respectfully submits this Request for Director Review of the Board’s Decision Granting Institution of *Inter Partes* Review (Paper No. 12, “Institution Decision”).

The Board’s Institution Decision should be vacated and reversed because the Board failed to acknowledge or address Patent Owner’s request to deny the Petition because it would not be an efficient use of resources for the Board to institute, even after the Board agreed that Petitioner forfeited any challenge to claims 20-26 by failing to raise a *prima facie* challenge to those claims in its Petition and agreed that the Petition failed to demonstrate a reasonable likelihood of success at all for *multiple* other grounds. *See, e.g., Chevron Oronite Co. v. Infineum USA LP*, IPR2018-00923, Paper 9, 9-11 (PTAB Nov. 7, 2018) (informative); Patent Owner’s Preliminary Response (Paper No. 9, “POPR”) at 59.

The Office’s resources are further strained because jury selection in the underlying district court case remains set for July 6, 2026, which is well over a month *before* the scheduled FWD in this proceeding (and roughly 4 months before the scheduled FWD in two other IPRs, if instituted). Worse, jury selection and trial are even more likely to go forward before the FWD because the Board has now denied institution of one of the other five patents asserted in the underlying district court proceeding, ensuring the district court is even less likely to grant a stay. Altogether,

these new facts underscore that it would not be an efficient use of resources for the Office to continue with IPR in these matters.

The Board's Institution Decision has now confirmed that at least *ten* of the Petition's grounds are fatally flawed, for multiple reasons.

First, the Board confirmed that the Petition fails to show a reasonable likelihood of success with respect to Grounds 4C, 5C[1], 5C[2], 6C[1], and 6C[2]:¹ “[W]e agree with Patent Owner that Petitioner fails to demonstrate that it meets the threshold showing under 35 U.S.C. § 314(a) for institution of trial with respect to Grounds 4C, 5C, and 6C.” Institution Decision at 91.

Second, the Board confirmed that Grounds 1A, 1B, 1C[1], 1C[2], 4A, and 4C all fail to raise a reasonable likelihood of success for claims 20-26 due to a failure to set forth any *prima facie* ground for an element of independent claim 20: “Patent Owner’s argument is persuasive on this point on this preliminary record as Petitioner

¹ The Petition purports to identify 15 grounds, but several of its alleged grounds, including at least 1C, 2C, 3C, 5C, and 6C, include alternative/optional combinations of references that increase the number of grounds raised. *See* Paper No. 8 at 51 n.8 (explaining multiple grounds raised in each of 1C, 2C, and 3C), Institution Decision at 7-8 (listing multiple alternative combinations of prior art references in, *inter alia*, Grounds 5C and 6C); Corrected Petition at 12-13.

has not sufficiently shown that Zeng teaches or suggests an electrolyte comprising fluoroethylene carbonate.” *Id.* at 39. “We note that neither Ground 1A nor Ground 1B in the Petition directly address claim 20 or the fluoroethylene carbonate recited in claim 20, but not elsewhere.” *Id.* at 61-62; *see also id.* at 39, 62, 72, 88 (finding no threshold showing was met for challenged claims 20-26 under *any* ground).

Because the Board has already determined that the Petition did not raise a *prima facie* case of unpatentability for claims 20-26 for Grounds 1A, 1B, 1C[1], 1C[2], 4A, and 4C, and that Grounds 4C, 5C[1], 5C[2], 6C[1], and 6C[2] fail to meet the threshold showing for *all* of their respective challenged claims, the Board erred in not addressing Patent Owner’s argument that institution would not be an efficient use of the Board’s resources under *Chevron Oronite*. Paper No. 9 (“POPR”) at 59.

Further, Patent Owner further respectfully requests the Director reconsider her earlier Decision declining to apply discretionary denial, at least because of two changed circumstances. First, as of the date of that Decision, the Board had not yet made a factual determination about the Petition’s failure to address all elements of claims 20-26, but now they have made that determination, and also determined multiple other grounds in the Petition lack merit. Second, another IPR directed to a different patent in the underlying litigation has now been denied institution, ensuring a jury trial is even more likely to proceed at the district court prior to the FWD in this proceeding. In that jury trial, Petitioner intends to raise against the 910 Patent

the same art at issue in this proceeding together with unpublished system prior art. *See Samsung Elecs. Co., Ltd. v. Icashe, Inc.*, IPR2025-00639, Paper 11 at 2 (PTAB Aug. 14, 2025) (Stewart, Dir.) (explaining that it would be an inefficient use of Board resources to refer a subset of patents to the Board when other patents had already been denied institution). The certainty of duplicative effort between both tribunals strongly favors denying institution of this review, in addition to the other reasons detailed in Paper No. 8.

II. LEGAL STANDARD

The Director may review institution decisions “presenting (a) an abuse of discretion, (b) important issues of law or policy, (c) erroneous findings of material fact, or (d) erroneous conclusions of law.” Director Review Process § 2(B); 37 C.F.R. § 42.75. “Both discretionary and merits-based issues may be raised, subject to limitations (a)–(d) above.” Director Review Process § 2(B). “The Director Review process provides a mechanism to correct errors at the institution stage, for example, to avoid unnecessary trials for patent owners.” *Id.*

“An abuse of discretion is found if [a] decision: (1) is clearly unreasonable, arbitrary, or fanciful; (2) is based on an erroneous conclusion of law; (3) rests on clearly erroneous fact finding; or (4) involves a record that contains no evidence on which the Board could rationally base its decision.” Director Review has been granted, for example, when the Board misstates or misapplies the law. *See, e.g.*,

Duration Media LLC v. Rich Media Club LLC, IPR2023-00953, Paper 78 at 8 (Dec. 12, 2024) (vacating Board decision that conflated analysis of enablement and obviousness). Abuse of discretion also includes failing to adequately address arguments that have been raised in the underlying briefing. *See Nokia of Am. Corp. v. Soto*, IPR2023-00680, Paper 18 (Jan. 4, 2024) (vacating decision denying institution), Paper 30 at 7, 15 (Dec. 3, 2024) (same). Relying on certain prior art embodiments or evidence instead of the ones actually presented in the Petition constitutes legal error that the Director may reverse. *See, e.g., DK Crown Holdings Inc. v. Diogenes Ltd.*, IPR2023-00268, Paper 14 at 2, 23–24 (Feb. 21, 2024).

The Board regularly denies institution under § 314(a) when instituting trial would not be an efficient use of the Board’s time and resources—for example, where Petitioner fails to present a reasonable likelihood of prevailing with respect to a subset of grounds or challenged claims. *See, e.g., Chevron Oronite Co.*, Paper 9, 9-11 (informative); *Deeper, UAB v. Vexilar, Inc.*, IPR2018-01310, Paper 7, 41-43 (PTAB Jan. 24, 2019) (informative).

III. ARGUMENT

The Board should decline to institute in the interest of efficiency. The Board has now confirmed that the Corrected Petition raises (at least) *ten* flawed grounds. Each challenged claim is the subject of at least six different grounds, properly counted. Pet. at 12-13. Importantly, the Board found that *all six challenges* to claims

20-26 (including Grounds 1A, 1B, 1C[1], 1C[2], 4A, and 4C) fail to demonstrate a reasonable likelihood of success. These claims constitute one-third of the challenged claims, and institution would require the Board to waste valuable time and resources addressing a large number of grounds and combinations, including meritless ones.

Petitioner suggests that they intend to request Board authorization to “correct” their Petition’s omissions of any argument with respect to claim element [20.7]. Paper No. 10 at 36. Such a request would be improper. The Board's Consolidated Trial Practice Guide (“TPG”) states that, “Petitioner may not submit new evidence or argument in reply that it could have presented earlier, e.g. to make out a *prima facie* case of unpatentability. . . . [A] reply . . . that raises a new issue or belatedly presents evidence may not be considered.” TPG at 73-74. The Federal Circuit has upheld Board decisions excluding attempts to introduce new arguments that should have been part of the initial Petition. *See, e.g., Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369-70 (Fed. Cir. 2016).

This failure to present a *prima facie* case for a substantial portion of the challenged claims, together with meritless challenges to *all* challenged claims with respect to Grounds 4C, 5C[1], 5C[2], 6C[1], and 6C[2], underscores the inefficiency of instituting trial. The Board’s obligation is not only to assess whether *some* ground meets the threshold for review under § 314(a), but to also determine whether proceeding with trial as to *all* grounds and challenged claims is a prudent use of its

valuable resources. The Board failed to make such a determination here.

Where, as here, the Board determines that a significant subset of grounds have not shown any reasonable likelihood of success at all, and that *no* ground meets the threshold showing with respect to a third of the challenged claims, the Board should have exercised its discretion to deny institution. This principle is well-established in PTAB precedent and further aligns with the Director's guidance favoring denial when institution would result in unnecessary and duplicative expenditure of time and effort, since the same prior art is also being asserted at the district court, which will reach trial before the FWD here.

1. The Petitioner Forfeited Any Challenges to Claims 20-26

Petitioner relied on multiple summary tables and purported to incorporate by reference other sections of the Petition. In Petitioner's haste, it included no arguments specific to claim element [20.7]. The summary table of its evidence explaining where the Petition explains that Zeng allegedly "discloses or suggests claims 12 and 16-26" is *notably missing claim 20* and each of its elements. Pet. 29-30; Ex. 2015 ¶ 124. Claim 20 requires, *inter alia*, "wherein the electrolyte further comprises 1,3-propanesultone *and fluoroethylene carbonate*; wherein, based on the total weight of the electrolyte, a weight percentage of the 1,3-propanesultone is not less than 0.1 wt %, and not greater than 3 wt %" Ex. 1001, 37:3-7 (emphasis added); Ex. 2015 ¶ 121. Petitioner collectively refers to these limitations as element [20.7].

Pet., xiii; Ex. 2015 ¶ 121. *None* of the Challenged Claims 1-6, 12, or 16-19 (whose earlier analysis the Petitioner exclusively relies on) recite “fluoroethylene carbonate” (Ex. 1001, 34:17-36:48; Ex. 2015 ¶ 122), and the Petition failed to otherwise present any argument that element [20.7] is met by Zeng.

This failure infects each of Petitioner’s Zeng-based grounds that purport to challenge claims 20-26 (Grounds 1A, 1B, 1C[1], and 1C[2]).

The Petition contains the same infirmities with respect to the Zhou-based grounds that purport to challenge claims 20-26, Grounds 4A and 4C. Petitioner chose to provide a summary table with respect to any application of Zhou to Claim 20 in Ground 4A. Pet. 68-69. With respect to element [20.7], the summary table recites “Sections XIII.B.8 ([1.7]), XIII.D.1 ([3.1])” as the source of the alleged “reasoning.” *Id.* Significantly, neither element [1.7] nor element [3.1] address the requirement of “fluoroethylene carbonate” in element [20.7]. Ex. 2015 ¶ 230. Accordingly, Petitioner forfeited any challenge to claim 20 and claims 21-26 which depend therefrom. *Id.* ¶¶ 227-228.

Accordingly, Petitioner has forfeited any challenge of claim 20-26. Petitioner contended that this was a mere clerical error in a table, but it was more than that—the Petition and Dr. Lucht’s declaration both lack *any argument* explaining how claim element [20.7] is allegedly met by the prior art.

2. The Board Agreed that Petitioner Failed to Present a Reasonable Likelihood of Success Against Claims 20-26

The Board's Institution Decision confirmed that at least six of the Petition's grounds are fatally flawed due to a failure to set forth any *prima facie* ground for claim element [20.7] of independent claim 20 (and, as a result, dependent claims 21-26). The Board's findings with respect to these grounds is below.

Patent Owner argues that, because the summary table of evidence contains no mention of claim 20, *Petitioner forfeits any challenge of claim 20 and its dependent claims* over Zeng. Prelim. Resp. 20–21. *Patent Owner's argument is persuasive on this point* on this preliminary record as Petitioner has not sufficiently shown that Zeng teaches or suggests an electrolyte comprising fluoroethylene carbonate.

Institution Decision at 39.

Regarding Ground 2B, Patent Owner relies on arguments made disputing Zeng alone or in combination with Matsuoka. Prelim. Resp. 43. Petitioner incorporates its arguments regarding 1A and 1B. Pet. 43. *Patent Owner argues that Petitioner forfeits any challenge to claims 20–26* because Petitioner's summary table incorporated by reference fails to address claim 20. *We note that neither Ground 1A nor Ground*

1B in the Petition directly address claim 20 or the fluoroethylene carbonate recited in claim 20, but not elsewhere.

Id. at 61-62.

Unlike in the Zeng-based Grounds, for the Zhou-based Grounds Petitioner directs us to its briefing related to each of claim elements [20.pre] through [20.7]. *See* [Pet.] at 69. ***Patent Owner contends that none of the cited evidence is sufficient to teach fluoroethylene carbonate, as recited in claim 20, therefore Petitioner forfeits any challenge to claims 20–26.*** Prelim. Resp. 56.

. . . Petitioner meets the threshold showing under 35 U.S.C. § 314(a) for institution of trial with respect to at least ***claims 1–6, 12, and 16–19.***

Id. at 88.

Therefore, with respect to every Ground challenging claims 20-26 (Grounds 1A, 1B, 1C[1], 1C[2], 4A, and 4C), the Board only found a reasonable likelihood of success with respect to claims 1-6, 12, and 16-19. *Id.* at 39-40, 61-62, 72, 88. For each such ground, therefore, the Board either explicitly (or implicitly by omission) found that Petitioner failed to meet the threshold showing for institution of trial with respect to claims 20-26.

3. The Board Agreed that Petitioner Failed to Meet the Threshold Showing with Respect to All Challenged Claims in Grounds 4C, 5C[1], 5C[2], 6C[1], and 6C[2]

The Board also confirmed that the Petition failed to raise a reasonable likelihood of success with respect to Grounds 4C (claims 1-6, 12, and 16-26), 5C[1] and 5C[2] (claims 13-14), and 6C[1] and 6C[2] (claim 15). Institution Decision at 91. The Grounds described as 5C and 6C in the Corrected Petition each include two separate grounds because each optionally includes Kim as an additional reference. *Id.* at 8; Pet. at 13.

4. This Failure of Proof for Multiple Grounds and for All Challenges to Claims 20-26 Warrants Denial of Institution to Preserve the Resources of the Board

Patent Owner previously submitted a request for discretionary denial, which the Director denied together with four other requests. Nevertheless, the Director has authorized the Board to consider discretionary denial where the petition presents an insufficient number of challenges that meet the reasonable likelihood standard indicating that institution is an inefficient use of resources, as explained in *Chevron Oronite* and *Deeper*. Interim Director Discretionary Process § I.F.

The Board erred by not considering or addressing this efficiency argument that was raised in Patent Owner's Preliminary Response. One third of all challenged claims, and ten of the raised grounds, were fatally flawed from the filing of the Petition. Now that the Board has instituted review, it must address *all* grounds and

all claims, even though all six challenges of claims 20-26 fail to demonstrate a reasonable likelihood of success and five grounds fail to demonstrate a reasonable likelihood of success at all. *See SAS Inst. Inc. v. Iancu*, 584 U.S. 357, 367 (2018). The large subset of meritless claim challenges and grounds justifies applying discretion to decline institution under *Chevron Oronite* and *Deeper*.

The justification for denial in pursuit of efficiency only increases in light of the other factors that the Director previously determined favor applying the Director's discretion to deny review, even in light of the issue date of the '910 Patent, which cannot by itself overcome all the other factors that favor denial of institution. Patent Owner respectfully requests that the Director revisit the Decision Denying Patent Owner's Request for Discretionary Denial, including in below of the following changed circumstances.²

First, the Board has now denied institution with respect to one of the other patents asserted in the same underlying district court case³ (with more denials in

² Interim Director Discretionary Process § V.C (“If the Director issues a decision determining that discretionary denial is not appropriate, a party should file a single request for . . . Director Review after the Board panel issues its decision.”).

³ *Zhuhai CosMX Battery Co., Ltd. v. Ningde Ampere Tech. Ltd.*, IPR2025-00385, Decision Denying Institution, Paper No. 10 (PTAB Aug. 20, 2025).

other IPRs anticipated by Patent Owner) and now agrees that Petitioner failed to raise a *prima facie* case for claims 20-26 of the '910 Patent here, ensuring that a district court trial (together with its duplicated effort) is certain to occur without any stay.⁴ Jury selection in the underlying district court case remains set for July 6, 2026, which is well over a month *before* the scheduled FWD in this IPR, and roughly 4 months before the hypothetical FWDs in IPR2025-00524 and IPR2025-00722 (directed to other patents at issue in the underlying litigation).

Second, Petitioner's *Sotera* stipulation cannot outweigh the multiple other grounds favoring denial where Petitioner continues to assert the primary prior art

⁴ See, e.g., *Force MOS Tech. Co., Ltd. v. ASUSTeK Computer, Inc.*, Case No. 2:22-cv-00460, ECF No. 74, (E.D. Tex. April 10, 2024) (stating the Court “has a consistent practice of denying motions to stay when the PTAB has yet to institute post-grant proceedings” as to all asserted patents and denying motion to stay *with* prejudice where *one* patent was not subject to IPR review because “the IPRs cannot simplify the issues to the extent necessary to justify a stay” and “the Court still has a case to try regardless of the outcome of the IPRs.”) (citing *Uniloc 2017 LLC v. Samsung Elecs. Am., Inc.*, No. 2:19-cv00259-JRG-RSP, 2020 WL 1433960, at *6 (E.D. Tex. Mar. 24, 2020) (denying stay request because even if all remaining IPRs succeeded, at least some asserted claims “would remain live in this case”)).

references (and most of the secondary references) in *combination* with unpublished system prior art references against the '910 Patent in the underlying district court litigation, which is likely to reach a verdict before any FWD. Paper No. 8 at 31-35; *Motorola Sol'ns, Inc. v. Stellar LLC*, IPR2024-01205, Paper 19 (Order Granting Director Review, Vacating the Decision Granting Institution, and Denying Institution of *Inter Partes* Review) at 3-4 (PTAB March 28, 2025) (Stewart, Dir.).

IV. CONCLUSION

Patent Owner respectfully requests that the Director vacate and reverse the Board's Decision Granting Institution and instead deny institution pursuant to her discretion under § 314 and §325.

Dated: August 26, 2025

Respectfully submitted,

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

CERTIFICATION UNDER 37 C.F.R. §42.24

Pursuant to 37 C.F.R. §42.24(d), I certify that this motion complies with the page limits of 37 C.F.R. §42.24(a)(1)(v) because it contains 14 pages.

Dated: August 26, 2025

By: Christopher TL Douglas /
Christopher TL Douglas

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §42.6(e), the undersigned hereby certifies that a true and correct copy of the above-captioned **REQUEST FOR DIRECTOR REVIEW OF DECISION GRANTING INSTITUTION OF *INTER PARTES* REVIEW** was served in its entirety on August 26, 2025 via filing through the Patent Trial and Appeal Case Tracking System (P-TACTS) and electronic mail on the following counsel of record for Petitioner:

James D. Stein
james.stein@leehayes.com

Kevin Yao
kevin.yao@leehayes.com

Jason D. Eisenberg
jasone-PTAB@sternekessler.com

Jason Fitzsimmons
jfitzsimmons-PTAB@sternekessler.com

COSMX-PTAB@leehayes.com

PTAB@sternekessler.com

Date: August 26, 2025

By: / Christopher TL Douglas /
Christopher TL Douglas