

EX 1018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ASCEND ELEMENTS, INC.,
Petitioner,

v.

DUESENFELD GMBH,
Patent Owner.

IPR2024-00948
Patent 11,050,097 B2

Before MEREDITH C. PETRAVICK, CHRISTOPHER M. KAISER, and
KEVIN W. CHERRY, *Administrative Patent Judges*.

KAISER, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314, 37 C.F.R. § 42.4

I. INTRODUCTION

A. Background and Summary

Ascend Elements, Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 1–3, 7–10, 12, 13, and 19 (“the challenged claims”) of U.S. Patent No. 11,050,097 B2 (Ex. 1001, “the ’097 patent”). Duesenfeld GmbH (“Patent Owner”) filed a Preliminary Response (Paper 6, “Prelim. Resp.”). With our authorization, Petitioner filed a Reply to Patent Owner’s Preliminary Response (Paper 7, “Prelim. Reply”), and Patent Owner filed a Preliminary Sur-Reply (Paper 9, “Prelim. Sur-Reply”).

We have authority, acting on the designation of the Director, to determine whether to institute an *inter partes* review under 35 U.S.C. § 314 and 37 C.F.R. § 42.4(a). *Inter partes* review may not be instituted unless “the information presented in the petition filed under [35 U.S.C.] section 311 and any response filed under [35 U.S.C.] section 313 shows that 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) (2018). “When instituting *inter partes* review, the Board will authorize the review to proceed on all of the challenged claims and on all grounds of unpatentability asserted for each claim.” 37 C.F.R. § 42.108(a) (2023).

For the reasons set forth below, upon considering the briefing and the evidence of record, we determine that the information presented in the Petition establishes a reasonable likelihood that Petitioner will prevail with respect to at least one of the challenged claims, and we institute *inter partes* review of all the challenged claims based on all the grounds identified in the Petition.

B. Real Parties-in-Interest

Petitioner identifies Ascend Elements, Inc. as the real party-in-interest. Pet. 60. Patent Owner identifies Duesenfeld GmbH as the real party-in-interest. Paper 4, 1.

C. Related Matters

The parties identify the following related court proceeding: *Duesenfeld GmbH v. Ascend Elements, Inc.*, Case No. 1-23-cv-01194 (D. Del.). Pet. 60; Paper 4, 1. In addition, the parties note that the '097 patent is also being challenged concurrently in IPR2024-00887. Pet. 60; Paper 4, 1.

D. The '097 Patent

The '097 patent is titled “Method for the Treatment of Used Batteries, in Particular Rechargeable Batteries, and Battery Processing Installation” and issued on June 29, 2021. Ex. 1001, codes (45), (54). It is directed to “[a] method . . . for the treatment of used batteries, in particular lithium batteries.” *Id.* at code (57).

The '097 patent describes several prior-art methods of processing used batteries and discusses the disadvantages of each method. *Id.* at 1:25–50. “The invention [of the '097 patent] aims to reduce” these disadvantages. *Id.* at 1:54–55. To do so, the '097 patent describes

a method for the treatment of used batteries, in particular used lithium batteries, such as lithium[-]ion batteries, with the steps (a) comminuting the batteries such that comminuted material is obtained, (b) inactivating of the comminuted material such that an inactive comminuted material is obtained, and (c) filling a transport container with the inactive comminuted material.

Id. at 1:8–15. It also describes

a battery processing installation for the treatment of used batteries, in particular for the treatment of used lithium batteries with (a) a comminuting device for comminuting the batteries

such that comminuted material is obtained, (b) an inactivation device for inactivating the comminuted material and (c) a filling device for filling a transport container with the inactivated comminuted material.

Id. at 1:16–23.

According to the '097 patent, “the inactivation occurs . . . by way of drying the comminuted material.” *Id.* at 1:57–58. By doing this, “the amount of electrolyte that can be obtained from the comminuted material . . . is such that an electrochemical reaction is no longer possible, or only to a negligibly small extent.” *Id.* at 1:63–66. “In addition, no flammable or explosive gas phase forms above the battery fragments, as the organic carbonates of the electrolyte have been removed.” *Id.* at 1:66–2:2. This renders the comminuted material “largely inert,” so that it “can be transported safely, especially if it is packed under vacuum.” *Id.* at 2:2–2:4.

E. Illustrative Claims

Petitioner challenges claims 1–3, 7–10, 12, 13, and 19 of the '097 patent. Claims 1 and 12 are independent and illustrative; they are reproduced below.

1. A method for the treatment of used batteries, comprising the steps:
 - (a) comminuting the batteries such that comminuted material is obtained;
 - (b) inactivating the comminuted material such that an inactivated comminuted material is obtained, wherein the inactivating step is performed during or after the comminuting step; and
 - (c) filling a transport container with the inactivated comminuted material;wherein the inactivating step is performed by drying the comminuted material, and

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