



UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CHINA CHENGDA ENGINEERING CO., LTD.,
Petitioner,

v.

DORIAMO LTD.
Patent Owner.

Case No. IPR2023-00365
Patent 8,591,852

**PETITIONER'S PRELIMINARY REPLY
ON ALLEGED PROCEDURAL DEFECTS**

TABLE OF CONTENTS

	Page
I. The Petition Is Not Barred [REDACTED]	1
II. Patent Owner’s Assertion Regarding The Real Party In Interest Is Meritless.....	3
III. Patent Owner’s Evidentiary Objections Are Premature And Have No Merit.....	4

TABLE OF AUTHORITIES

Page(s)

CASES

<i>Bally Gaming, Inc. v. New Vision Gaming & Dev., Inc.</i> , Case No. CBM2018-00006, Paper 47 (PTAB June 19, 2019).....	1
<i>Leadertex, Inc. v. Morganton Dyeing & Finishing Corp.</i> , 67 F.3d 20 (2d. Cir. 1995)	2
<i>Par Pharm., Inc. v. Jazz Pharm., Inc.</i> , Case No. IPR2015-00546, Paper 25 (P.T.A.B. July 28, 2015)	3
<i>Rohm Semiconductor USA, LLC v. Maxpower Semiconductor Inc.</i> , Case No. IPR2020-01676, Paper 15 (PTAB Apr. 15, 2021).....	1
<i>Samsung Elecs. Am., Inc. v. Kannuu Pty Ltd.</i> , Case No. IPR2020-00738, Paper 22 (PTAB Sep. 23, 2020).....	1
<i>SharkNinja Operating LLC v. iRobot Corp.</i> , Case No. IPR2020-00734, Paper 11 (PTAB Oct. 6, 2019) (<i>Precedential</i>).....	3

STATUTES

35 U.S.C. § 314 (a)	1
35 U.S.C. § 315	3

OTHER AUTHORITIES

37 C.F.R. § 42.63	5
37 C.F.R. § 42.63 (b)	5
37 C.F.R. § 42.64	4
37 C.F.R. § 42.64 (b) (1).....	4
37 C.F.R. § 42.104 (a).....	1
37 C.F.R. § 42.104 (b)	1

I. THE PETITION IS NOT BARRED [REDACTED]

Patent Owner's ("PO's") arguments that the Board should deny the Petition because "the Petition fails the certification requirement of 37 C.F.R. § 42.104(a)," and because of [REDACTED] are legally and factually meritless.

POPR at 1. PO alleges that Petitioner owes it [REDACTED] and that the [REDACTED]

[REDACTED] POPR at 1, 14. But PO cites no legal authority that the analysis of the certification requirement of 37 C.F.R. § 42.104 (a) or discretion under 35 U.S.C. § 314(a) would encompass [REDACTED]. To the contrary, [REDACTED]

[REDACTED] E.g., *Rohm Semiconductor USA, LLC v. Maxpower Semiconductor Inc.*, Case No. IPR2020-01676, Paper 15 [REDACTED] (PTAB Apr. 15, 2021) [REDACTED]

[REDACTED] *Samsung Elecs. Am., Inc. v. Kannuu Pty Ltd.*, Case No. IPR2020-00738, Paper 22 [REDACTED] (PTAB Sep. 23, 2020); *Bally Gaming, Inc. v. New Vision Gaming & Dev., Inc.*, Case No. CBM2018-00006, Paper 47 [REDACTED] (PTAB June 19, 2019).

Moreover, [REDACTED], would not bar this Petition, and [REDACTED]. First, PO concedes that [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]¹ POPR at 10; Ex. 2002 at 1. PO further concedes the '852 Patent

[REDACTED]. POPR at 3-4. [REDACTED]

[REDACTED] is irrelevant to the '852

Patent and this IPR. Second, PO's reliance [REDACTED]

[REDACTED] is similarly without merit. *See* POPR at 1, 11, 12, 14, 17.

[REDACTED] Thus, contrary to PO's suggestion of [REDACTED]

[REDACTED] (*Id.* at 5). PO fails to explain how a dispute about

validity of a U.S. patent could [REDACTED]

¹ Emphasis added unless otherwise indicated.

² Patent Owner cited Federal Circuit caselaw purporting to support its contention. However, the [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED].

II. PATENT OWNER’S ASSERTION REGARDING THE REAL PARTY IN INTEREST IS MERITLESS

PO argues that “the Petition should be denied for not naming the real parties in interest” (POPR at 2) and asserts that Petitioner’s parent company, CNCEC, should be listed as a real party in interest (“RPI”) (*id.* at 27). PO’s arguments are both procedurally wrong and substantively incorrect. Procedurally, it is well established that the Board need not consider whether Petitioner has named all RPIs when “it would not create a time bar or estoppel under 35 U.S.C. § 315.” *SharkNinja Operating LLC v. iRobot Corp.*, Case No. IPR2020-00734, Paper 11 at 18-20 (PTAB Oct. 6, 2019) (*Precedential*). Here, the subject patent has not been asserted in any court and there is no pertinent statutory time bar to any party. Thus, the Board need not consider whether CNCEC must be named as an RPI at the current stage. On the merits, PO’s sole basis for naming CNCEC as an RPI is that CNCEC is the parent company of Petitioner. But a mere parent-subsidary relationship is insufficient to establish that the parent corporation is an RPI. *Par Pharm., Inc. v. Jazz Pharm., Inc.*, Case No. IPR2015-00546, Paper 25 at 19 (P.T.A.B. July 28, 2015). Petitioner

represents its own interest in this IPR proceeding, and PO fails to provide any evidence that Petitioner takes CNCEC's interests into account when determining whether to file the IPR or that CNCEC has any specific interest in and benefit from the IPR. Tellingly, PO at no point argues or suggests that CNCEC is an interested party, or involved in any way [REDACTED].

Because CNCEC is not an RPI, PO's allegation that the Chinese government is somehow involved in this IPR proceeding is even more remote. The Chinese government is not a Petitioner, rendering PO's question "whether a foreign state is authorized by statute to file an AIA petition" both irrelevant and transparently xenophobic. POPR at 31. Nor does China's National Security Law "raise legitimate questions about Chengda's ability to participate in the IPR and abide by the terms of a Protective Order" (*id.* at 33) because Counsel for PO admit that the information subject to the Protective Order is "confidential to both Chengda and Doriamo" and Chengda "is in possession of the documents." Ex. 1017 at 1.

III. PATENT OWNER'S EVIDENTIARY OBJECTIONS ARE PREMATURE AND HAVE NO MERIT

37 C.F.R. § 42.64 dictates the procedure for evidentiary objections—"[a]ny objection to evidence submitted during a preliminary proceeding must be filed *within ten business days of the institution of the trial.*" 37 C.F.R. § 42.64 (b) (1). Thus, it is improper for PO to raise objections to evidence in the POPR. Since PO raised the objections now, however, Petitioner responds briefly on the merits below.

PO argues that “the translations do not include a verification by a sufficiently qualified translator” and took issue with the verification statement that the affiant is “conversant with the Chinese and English languages.” POPR at 34-35. But PO’s argument ignores other parts of the verification and what the Rule requires. 37 C.F.R. § 42.63 merely requires “an affidavit attesting to the accuracy of the translation.” 37 C.F.R. § 42.63 (b). The translator attested, under penalty of perjury, that the translation was “true and correct.” *See, e.g.*, Ex. 1003 at 40. The translator also declared that he was “conversant with the Chinese and English languages” and was “a competent translator.” *Id.* Nothing more is required under the Rule.

PO complains that the prior-art documents are incomplete. POPR at 36. But 37 C.F.R. § 42.63 only requires “a translation of the document,” not a translation of the *entire* document required by PO. Neither of the cases cited by PO supports such unreasonable requirements to translate an entire book.

As to Dr. Hall-Ellis’s declaration, PO fails to cite any law that requires a declarant to “inspect[], view[], handle[], or [have] access to the actual hard copies of the references.” POPR at 43. Dr. Hall-Ellis’s declaration is sufficient to show that the exhibits are true and correct copies of the underlying book references. If any doubts remain, PO can depose Dr. Hall-Ellis after institution of the petition.

Date: May 5, 2023

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e) and 42.205(a), this is to certify that I caused to be served a true and correct copy of the foregoing “PETITIONER’S PRELIMINARY REPLY ON ALLEGED PROCEDURAL DEFECTS” via the PTAB’s P-TACTS system and sent via email as detailed below.

Date of service: May 5, 2023

Documents served: PETITIONER’S PRELIMINARY REPLY ON ALLEGED PROCEDURAL DEFECTS

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Date of service: May 12, 2023

Documents served: public version of PETITIONER’S PRELIMINARY REPLY ON ALLEGED PROCEDURAL DEFECTS

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