UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE PATENT TRIAL AND APPEAL BOARD

CHINA CHENGDA ENGINEERING CO., LTD. Petitioner

v.

DORIAMO LTD.
Patent Owner

U.S. Patent No. 8,591,852

Case No. IPR2023-00365

PATENT OWNER'S SUR-REPLY IN SUPPORT OF ITS PRELIMINARY PATENT OWNER RESPONSE

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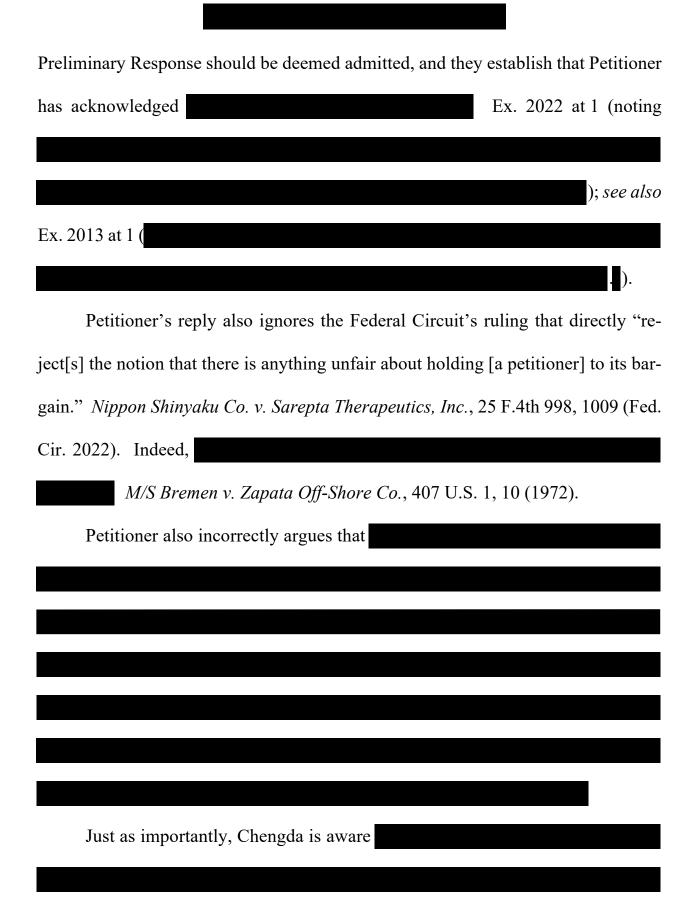
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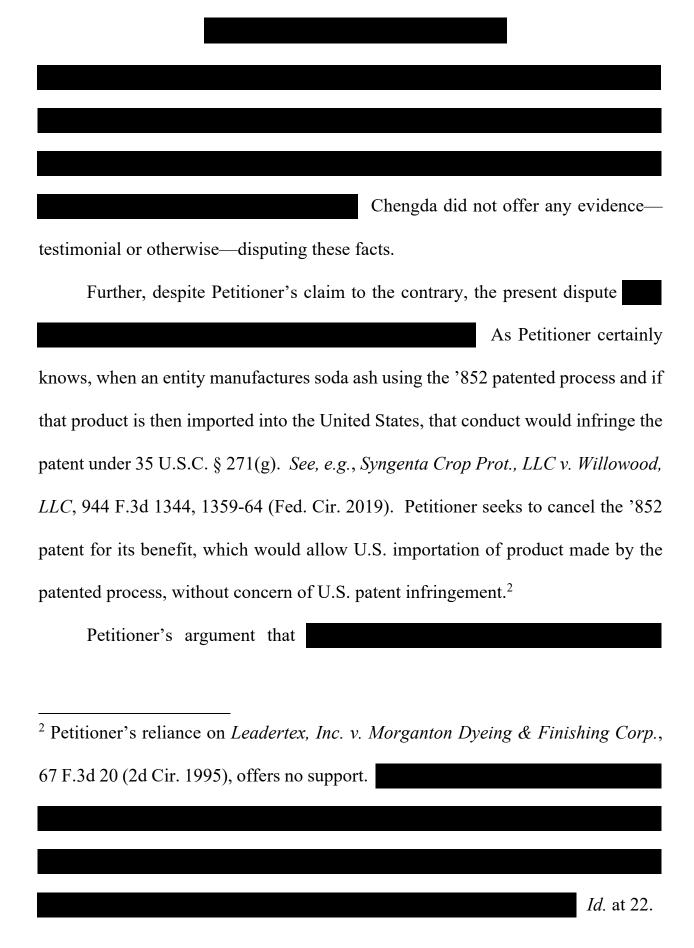
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I. The is Applicable and Should be Enforced
First, Petitioner's reply omits the fact that
On April 26, 2023, about a
week before Petitioner's Reply,
Petitioner's Reply neglects to apprise the Board
of this information. ¹
Second, Petitioner's certification
42.104(a) is not as narrow as Petitioner states. Rather, it requires a certification that
the petitioner is "not barred from requesting an inter partes review challenging
the patent claims on the grounds identified in the petition." That requirement, on its
face, covers instances where a party
Courts routinely consider whether See, e.g.,
Withrow v. Halsey, 655 F.3d 1032, 1035 (9th Cir. 2011).
Third, Petitioner offers only attorney argument in its Reply. The facts in the

¹ The Board denied Patent Owner's request to submit a declaration attesting to the undisputed fact that





The Board should therefore deny institution; otherwise,

II. Patent Owner Presented Facts That Show a Failure to Comply with the Real Party in Interest Requirement

Patent Owner's factual evidence shows the control or ability to control that implicates a Chinese state-controlled company. Congress held a hearing on this issue on March 8, 2023, with witnesses explaining, for example, "how the Chinese government sponsors, directs, and permits forced technology transfer of IP and know-how from the United States."

Identifying the real party in interest is a statutory requirement. 35 U.S.C. § 312(a)(2); 37 C.F.R. § 42.8. The requirement's purpose is broader than a potential time bar or estoppel. It also "assist[s] members of the Board in identifying potential conflicts." PTAB, *Consolidated Trial Practice Guide* at 12, Nov. 2019 Ed.

Petitioner advances an erroneous reliance on *Par Pharmaceutical, Inc. v. Jazz Pharmaceuticals, Inc.*, No. IPR2015-00546, Paper 25 at 19 (PTAB July 28, 2015). To the contrary, a parent-subsidiary relationship "weighs heavily in favor of finding

³ See https://judiciary.house.gov/committee-activity/hearings/subcommittee-courts-intellectual-property-and-internet-intellectual.

[a parent] to be a real-party-in-interest." Atl. Gas Light Co. v. Bennett Regulator Guards, Inc., IPR2013-00453, Paper 88, at 11 (PTAB Jan. 6, 2015). Here, the evidence thus far shows that CNCEC (and hence the Chinese government) has the legal ability to control Chengda's actions. See Paper 6 at 26-28. This necessarily implicates whether the Petitioner has the requisite standing to bring the IPR. See Return Mail, Inc. v. U.S. Postal Serv., 139 S. Ct. 1853, 1860 (2019). Petitioner offers no evidence and relies only on attorney argument. If the Petition is not denied, Patent Owner should be granted discovery into CNCEC's control over Petitioner. See Syngenta Crop Prot. AG v. FMC Corp., 2020 WL 5542016, at *1 (PTAB Sept. 15, 2020) (authorizing additional discovery based on "some evidence" that another RPI exists).

III. Petitioner Does Not Dispute That It Provided Incomplete Documents

Petitioner's reply misses the mark. It is incumbent on Petitioner to provide complete documents, as required by the rules. *See* 37 C.F.R. § 42.63(b). Petitioner does not once dispute that it submitted only incomplete documents, and it does not offer any excuse for its incomplete references. This alone should be sufficient to deny institution. *See Shenzhen Aurora Tech. Co. v. Putco, Inc.*, No. IPR2020-00670, 2020 WL 5078551, at *3 (PTAB Aug. 27, 2020). Nor does Petitioner dispute Patent Owner's explanation of why the omitted portions of the references are highly material. *See, e.g.*, Paper 6 at 38-41 (Ex. 1004 being one page of 290-plus pages; Ex. 1008 being only 40% of the entire document).

Date: May 12, 2023

Respectfully submitted,

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CERTIFICATION OF SERVICE ON PATENT OWNER

The undersigned hereby certifies that a copy of the foregoing PATENT OWNER'S SUR-REPLY IN SUPPORT OF ITS PRELIMINARY PATENT OWNER RESPONSE was served on May 12, 2023 via the PTAB's P-TACTS system upon the following counsel for Petitioner:

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