

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TIANJIN SHUANGRONG PAPER PRODUCTS CO., LTD. AND
SHUANG RONG AMERICA, LLC,
Petitioner,

v.

KISS NAIL PRODUCTS, INC.,
Patent Owner.

Case IPR2016-00371
Patent 8,561,619 B1

Before JOSIAH C. COCKS and JAMES J. MAYBERRY, *Administrative
Patent Judges.*

MAYBERRY, *Administrative Patent Judge.*

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

On August 19, 2016, the Board conducted a conference call with counsel for Petitioner, Tianjin Shuangrong Paper Products Co., Ltd. and Shuang Rong America, LLC, and counsel for Patent Owner, Kiss Nail Products, Inc. Patent Owner had a court reporter transcribing the call. Petitioner requested the call seeking authorization to file a motion to file supplemental information.

Background

On December 29, 2015, Petitioner filed a Petition for *Inter Partes* Review of U.S. Patent No. 8,561,619 B1. Paper 1 (the “Petition”). Exhibit 1007 accompanied the Petition and provided an English translation of Korean patent publication 10-2006-0091440, which was provided as a Korean-language exhibit as Exhibit 1006. *See* Exs. 1006, 1007 (the “Zenon reference”). Exhibit 1007 included a Certification of Translation affidavit from Dongshen Wang, who apparently works for Expert Translation Bureau, LLC. Ex. 1007, 21. We instituted trial on two separate grounds, with both grounds including the Zenon reference. Paper 13, 28.

In a conference call on August 8, 2016, Patent Owner sought to depose Mr. Wang as part of routine discovery, which Petitioner had opposed. We granted Patent Owner’s request. Paper 19. Subsequent to our Order, the parties determined that Mr. Wang would not be available to be deposed. Petitioner seeks to file supplemental information in the form of a declaration from another party attesting to the accuracy of Mr. Wang’s translation. Mr. Kim, the new declarant, is available for deposition.

In the call of August 19, 2016, Petitioner explained that Mr. Wang is unable to travel to a location amenable to a deposition and that the

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deposition cannot be taken in China. Petitioner also indicated that Mr. Wang moved to China subsequent to providing the translation to pursue another opportunity.

Patent Owner plans to oppose any motion to submit the supplemental information and it believes that Petitioner cannot make the requisite showing under 37 C.F.R. § 42.123(b).

In consideration of the foregoing, it is hereby

ORDERED that Petitioner is authorized to file a motion to submit supplemental information under 37 C.F.R. § 42.123(b) (the “Motion”);

FURTHER ORDERED that the Motion shall be no more than 5 pages and filed no later than August 25, 2016 and, filed along with the Motion, shall be a Petitioner’s exhibit that includes the supplemental information, which will be conditionally entered pending a decision on the Motion;

FURTHER ORDERED that Patent Owner may file an opposition to the Motion (the “Opposition”), and the Opposition shall be no more than 5 pages and filed no later than August 31, 2016;

FURTHER ORDERED that no reply brief is authorized at this time; and

FURTHER ORDERED that Patent Owner is to file the transcript of the August 19, 2016 call as a Patent Owner’s exhibit.

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