

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

SHENZHEN KEAN SILICONE PRODUCT CO., LTD.

Petitioner

v.

MR. PAUL KOH

Patent Owner

---

Patent No. 7,959,036

Issue Date: June 14, 2011

Title: Elastomeric Dispensing Container

---

**PETITIONER’S MOTION TO INCLUDE ATTESTING AFFIDAVIT OF ENGLISH TRANSLATION OF FOREIGN REFERENCE “SHU” AS SUPPLEMENTARY EVIDENCE UNDER 37 C.F.R. § 42.64(b).**

On May 13, 2017, Petitioner submitted a petition for *inter partes* review with respect to U.S. Patent No. 7,959,036 (“the 036 Patent”), including an English translation of foreign reference No. DE202004014944 (“Shu”). However, the *Shu* reference did not include an attesting affidavit with the translation required in 37 C.F.R. § 42.63(b). Petitioner now submits an affidavit in accordance with the rule.

Under 37 C.F.R. § 42.64(b), an opportunity is afforded to parties to submit supplemental evidence in response to objections to evidence submitted during a preliminary proceeding “within ten business days of the institution of the trial” (37 C.F.R. § 42.64(b)(1)) and service of the supplemental evidence “within ten business days of service of the objection” (37 C.F.R. § 42.64(b)(2)). Patent Owner’s Preliminary Response objected that the *Shu* translation was defective for lack of an attesting affidavit, but the Board has not yet issued a final decision whether to institute a trial, so it appears that Patent Owner’s objections are not ripe for review.

Nevertheless, in *Zhongshan Broad Ocean Motor Co., Ltd, et. al. v. Nidec Motor Corporation*, (CASE IPR2014-01121), the Board ruled that three Japanese references in the absence of supporting affidavits were incomplete. *See Id.* at Paper 25, Decision Denying Requests for Rehearing Under 37 C.F.R. § 42.71. The Board

stated that allowing Petitioner to file the supporting affidavits late as supplementary evidence under 37 C.F.R. § 42.64(b) would reset the filing date of the Petition more than a year after the filing of a complaint in a concurrent civil litigation on the subject patent in violation of 35 U.S.C. § 315(b):

The defect with Petitioners' Japanese documents is not that the filing of the references and translations were untimely, but that, in the absence of supporting affidavits, the translations were incomplete when filed. *Although Petitioner may be permitted to file the attesting affidavits late*, that does not entitle Petitioner to retain the filing date associated with the original incomplete references. Thus, in this case, it is not the inability to file attesting affidavits late that precludes Petitioner, but the fact that complete translations with attesting affidavits were not obtained and filed prior to the date on which institution of *inter partes* review was barred under 35 U.S.C. § 315(b). (*Id.* at 7, emphasis added).

Accordingly, the Board recognized that Petitioner should be allowed to file attesting affidavits late as supplementary evidence when the result of a new filing date would not bar institution under U.S.C. § 315(b), such as in this case where there is no pending civil litigation relating to the '036 patent. Issuing a new filing date would thus not be time-barred under U.S.C. § 315(b).

Further, Patent Owner's responsive brief already includes arguments relating to the substance of the same translation of *Shu* that is enclosed in this motion. Therefore, allowing Petitioner to file the supporting affidavit late does not prejudice Patent Owner in any way.

Dated: October 3, 2017

Respectfully submitted,

/Xiyang Zhang/

Xiyang Zhang, No. 68571

## CERTIFICATE OF SERVICE

The undersigned certifies service pursuant to 37 C.F.R. §§ 42.6(e) and 42.105(b) of the following materials:

- Motion to Include Attesting Affidavit of English Translation of Foreign Reference “Shu” as Supplementary Evidence under 37 C.F.R. § 42.64(b).
- Attesting Affidavit of English Translation of Shu reference.

on the Patent Owner by UPS, next day delivery at the correspondence address of record for the subject patent as listed on PAIR:

Melgar IP Law  
54 W 40th St.,  
New York, NY 10018  
Phone: 646-202-2900

Dated: October 10, 2017

/Xiyang Zhang/  
Xiyang Zhang  
Registration No. 68,571