

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SOLVAY USA INC.,
Petitioner,

v.

WORLDSOURCE ENTERPRISES, LLC, ECO AGRO RESOURCES LLC,
and ECO WORLD GROUP LLC
Patent Owner.

PGR2019-00046
Patent 10,221,108 B2

Before KRISTINA M. KALAN, JEFFREY W. ABRAHAM, and
SHELDON M. McGEE, *Administrative Patent Judges*.

McGEE, *Administrative Patent Judge*.

ORDER

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

On April 26, 2019, Petitioner filed its Petition in this proceeding, along with Exhibit 1006. Exhibit 1006 is an English translation of Chinese Patent CN101200400B (“the CN400 patent”). The certification of Exhibit 1006 purports to be “a true and accurate translation from Chinese to English” of the CN400 patent. Ex. 1006, 11.¹

A post-grant review of U.S. Patent No. 10,221,108 B2 (“the ’108 patent”) was instituted on August 13, 2019 and an oral hearing was held on May 14, 2020. Paper 7, 2; Paper 8, 7.

On May 13, 2020, the eve of the oral hearing, the Board received an email from Patent Owner’s counsel requesting a conference call to seek authorization to file a motion to object and a motion for additional discovery with respect to the translation and translator’s affidavit filed by Petitioner as Exhibit 1006. The email indicated that Petitioner opposed Patent Owner’s request to file the motions and opposed a conference call. Ex. 3001.

Instead of conducting a conference call with the parties, the Board permitted the parties to address this issue during the oral hearing on May 14, 2020. During the hearing, Patent Owner’s counsel indicated that he recently consulted the “LinkedIn” social media webpage for the affiant of Exhibit 1006, and observed that the affiant does not identify any level of proficiency in the Chinese language on that webpage. Patent Owner stated that it wishes to conduct additional discovery in this proceeding to determine whether the affiant personally translated what is before us as Exhibit 1006, and furthermore wishes to file a motion to object to Exhibit 1006.

¹ Petitioner filed the Chinese language version of Chinese Patent CN101200400B as Exhibit 1018 on April 26, 2019. Pet. 21.

Petitioner stated that it opposes Patent Owner's request for leave to file motions to object and for additional discovery. For support, Petitioner noted that an objection to evidence that is submitted in a preliminary proceeding—such as Exhibit 1006 in this post-grant review proceeding—must “be filed within ten business days of the institution of trial.” *See* 37 C.F.R. § 42.64(b)(1). Petitioner stated that because Patent Owner's request to object to Exhibit 1006 was made so late in this proceeding, it should be viewed by the Board as waived.

We have considered the parties' arguments presented during the oral hearing, and authorize Patent Owner to file a combined motion to object to Exhibit 1006 and for additional discovery. Patent Owner shall set forth the circumstances leading up to its discovery of the affiant's LinkedIn page, and shall further address the “good cause” and “interest of justice” standards set forth in our rules regarding late action and additional discovery. *See* 37 C.F.R. §§ 42.5(c)(3), 42.224(a). Due to the late stage of this proceeding, we stress that time is of the essence. Therefore, Patent Owner's motion is limited to the issues identified during oral argument and may not exceed five pages. Patent Owner's motion must be filed within five business days of the date of this Order.

We also authorize Petitioner to file an opposition to Patent Owner's motion. Petitioner's opposition also may not exceed five pages and must be filed within five business days of the date Patent Owner files its motion.

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Accordingly, it is:

ORDERED that Patent Owner is authorized to file a combined motion to object to Exhibit 1006 and for additional discovery;

FURTHER ORDERED that Patent Owner's motion shall not exceed five pages, and shall be filed no later than May 29, 2020;

FURTHER ORDERED that Petitioner is authorized to file an opposition to Patent Owner's motion; and

FURTHER ORDERED that Petitioner's opposition shall not exceed five pages, and shall be filed no later than five business days after the date Patent Owner files its motion.

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