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

Denying Patent Owner's Combined Motion for Additional Discovery and Late-Filed Objection to Exhibit 1006

37 C.F.R. §§ 42.5(c)(3), 42.224(a)

INTRODUCTION

We instituted a post-grant review of U.S. Patent No. 10,221,108 B2 ("the '108 patent") on August 13, 2019 and held an oral hearing on May 14, 2020. Paper 7, 2.

On the eve of the oral hearing, May 13, 2020, 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 of Chinese Patent No. 101200400B ("the CN400 patent"), and the translator's affidavit filed by Petitioner in this proceeding on April 26, 2019 as Exhibit 1006. Ex. 3001. The email indicated that Petitioner opposed Patent Owner's request for us to authorize the motions and opposed a conference call. *Id.*

Rather than conduct a conference call with the parties, the Board permitted the parties to address this issue during the oral hearing on May 14, 2020. After hearing arguments from both Patent Owner and Petitioner, we authorized Patent Owner to file a combined motion for additional discovery and objection to Exhibit 1006. Paper 39. Patent Owner timely filed its Motion. Paper 40 ("motion" or "Mot."). Petitioner timely opposed. Paper 41 ("opposition" or "Opp.").

In its motion, Patent Owner asserts that a previous translation of the CN400 patent "had been filed by a third-party in opposition" to an application in the chain of priority of the '108 patent at issue in this proceeding, and is in the record of this proceeding as Exhibit 2006. Mot. 1 (citing Ex. 2006, 444–473). Patent Owner asserts that the machine translation of CN400 contained within Exhibit 2006 is different than the translation filed as Exhibit 1006. *Id.* Patent Owner represents that, between

May 2, 2020 and the morning of May 4, 2020, Patent Owner's counsel was preparing for the oral hearing scheduled for May 14, 2020. *Id.* at 1–2. Patent Owner's counsel states that, during the preparation for oral hearing, he "performed a search using the Google search engine on Kayla Garcia and Transperfect," i.e., the affiant identified in Exhibit 1006, and the company for which she appears to work, respectively. *Id.* at 2; Ex. 1006, 11. Patent Owner's counsel asserts that he "cannot recall if he had ever performed an internet search before for Ms. Garcia or, if so, the parameters of such a search." Mot. 2. Based on Patent Owner's internet search for Kayla Garcia and Transperfect, Patent Owner's counsel "sent an email to Petitioner's counsel with a PDF of Ms. Garcia's LinkedIn Page, and noted that Ms. Garcia does not appear to have any Chinese language skills." *Id.*

Patent Owner contends that a properly authenticated affidavit attesting to the accuracy of a translation under the Federal Rules of Evidence must be signed by the actual translator, and asserts that "[c]ourts have consistently held that a translation must be accompanied by a certification by the actual translator of the document." Mot. 3 (citing *Jack v. Trans World Airlines, Inc.*, 854 F. Supp. 654, 659 (N.D. Cal. 1994), *Townsend Eng'g Co. v. HiTec Co.*, 1 USPQ2d 1987, 1988 (N.D. Ill. 1986), *Xavier v. Belfor USA Grp., Inc.*, 2008 WL 4862533 (E.D. La. Sept. 23, 2008)).

Patent Owner asserts that Ms. Garcia's LinkedIn page "tends to show 'beyond speculation that something useful will be uncovered'" because "there is strong evidence that shows Ms. Garcia did not translate the document at issue." Mot. 4–5 (citing *Garmin Int'l Inc. v. Cuozzo Speed Techs., LLC*, IPR2012-00001, Paper 20, 2–3 (PTAB Feb. 14, 2013). Thus, Patent Owner asserts that good cause exists to seek "additional discovery to

depose Ms. Garcia to determine if she translated Exhibit 1006 and her qualifications to do so." Mot. 5. Patent Owner states "[t]he information gained from the discovery would be useful, as it goes to the admissibility and reliability of the translation filed," asserts that Patent Owner is unable to generate equivalent information by other means, and that the additional discovery would not be burdensome. *Id.*

For the reasons that follow, we deny Patent Owner's combined motion for additional discovery and objection to Exhibit 1006.

DISCUSSION

Motion for Additional Discovery

In a post-grant review, a "good cause" standard is applied to motions for additional discovery. 37 C.F.R. § 42.224; *Bloomberg Inc. v. Markets-Alert Pty Ltd.*, CBM2013-00005, Paper 32 (PTAB May 29, 2013) (precedential). To determine whether good cause for the additional discovery sought by the moving party has been shown, we weigh the following factors:

1) *More Than A Possibility And Mere Allegation*—

> The mere possibility of finding something useful, and mere allegation that something useful will be found, are insufficient to establish a good cause showing. "Useful" means favorable in substantive value to a contention of the party moving for discovery. A good cause showing requires the moving party to provide a specific factual reason for expecting reasonably that the discovery will be "useful."

2) *Litigation Positions And Underlying Basis*—

> Asking for the other party's litigation positions and the underlying basis for those positions is insufficient to demonstrate that the additional discovery is necessary for good cause. The

> Board has established rules for the presentation of arguments and evidence. There is a proper time and place for each party to make its presentation. A party may not attempt to alter the Board's trial procedures under the pretext of discovery.

3) *Ability to Generate Equivalent Information By Other Means*—

> A party should not seek information that reasonably can be generated without a discovery request.

4) *Easily Understandable Instructions*—

> Instructions and questions should be easily understandable. For example, ten pages of complex instructions for answering questions is prima facie unclear. Such instructions are counter-productive and tend to undermine the responder's ability to answer efficiently, accurately, and confidently.

5) *Requests Not Overly Burdensome To Answer*—

> Requests should not be overly burdensome to answer, given the expedited nature of a post-grant review. The burden includes financial burden, burden on human resources, and burden on meeting the time schedule of the trial. Requests should be sensible and responsibly tailored according to a genuine need.

Bloomberg Inc., CBM2013-00005, Paper 32, 5.

Factor 1: More Than a Possibility and Mere Allegation

Based on our review of Patent Owner's motion and its oral arguments related to the additional discovery it now seeks, we are unpersuaded that Patent Owner, as the moving party, has provided a specific factual reason for expecting reasonably that the additional discovery would be useful, i.e., "favorable in substantive value to a contention of the party moving for discovery."

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