

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

YITA LLC,
Petitioner,

v.

MACNEIL IP LLC,
Patent Owner.

IPR2020-01139 (Patent 8,382,186 B2)
IPR2020-01142 (Patent 8,833,834 B2)¹

Before MITCHELL G. WEATHERLY, JAMES A. WORTH,
MICHAEL L. WOODS, and ARTHUR M. PESLAK,
Administrative Patent Judges.

WOODS, *Administrative Patent Judge.*

ORDER

Granting Motion to Submit Supplemental Information
37 C.F.R. §§ 42.5, 42.123

¹ This Order applies to both proceedings. The parties are not authorized to use this heading without express permission from the Board.

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I. INTRODUCTION

On June 9, 2021, the Board authorized Patent Owner to file a motion to submit supplemental information under 37 C.F.R. § 42.123(b). Paper 32.² On June 10, 2021, Patent Owner filed its Motion to Submit Supplemental Information Pursuant to 37 C.F.R. § 42.123(b). Paper 36 (“Motion” or “Mot.”). Petitioner filed an Opposition to the Motion on June 24, 2021. Paper 41 (“Opposition” or “Opp.”).

For the reasons set forth below, we grant the Motion.

II. OUR RULES

Patent Owner bears the burden of proving that it is entitled to the requested relief. 37 C.F.R. § 42.20(c). Because Patent Owner seeks to submit supplemental information more than one-month after institution of trial, the following Rule also governs:

(b) *Late submission of supplemental information.* A party seeking to submit supplemental information more than one month after the date the trial is instituted, must request authorization to file a motion to submit the information. The motion to submit supplemental information must show why the supplemental information reasonably could not have been obtained earlier, and that consideration of the supplemental information would be in the interests-of-justice.

37 C.F.R. § 42.123(b).

Accordingly, Patent Owner bears the burden of showing (1) “why the supplemental information reasonably could not have been obtained earlier”

² The parties filed similar papers in each of IPR2020-01139 and IPR2020-01142. For purposes of this Order, IPR2020-01142 is representative and all citations are to filings in IPR2020-01142, unless otherwise noted.

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and (2) “that consideration of the supplemental information would be in the interests-of-justice.” *Id.*

III. ANALYSIS

Patent Owner seeks to submit as supplemental information Exhibits 2114, 2115, 2126–2129, and 2132–2137 (collectively, the “New Exhibits”).
Mot. 1.

Patent Owner filed its Patent Owner Response along with several exhibits on May 5, 2021. Paper 28 (“Response” or “Resp.”). Petitioner objected to eighty-seven of Patent Owner’s exhibits on May 12, 2021. Paper 29; Mot. 1. Upon reviewing Petitioner’s objections, Patent Owner “became aware of certain informalities and filing oversights” and now “seeks to submit as supplemental information” the New Exhibits, which include corrections to earlier-filed exhibits. *See* Mot. 1. Patent Owner also served the New Exhibits as supplemental evidence on either May 26, 2021, or June 2, 2021. *Id.*

a. Exhibit 2137

Patent Owner submitted a translation of a foreign patent document (“Yung”) from one of its translators, Mr. Li. Resp. viii, 40 (citing Ex. 2023); *see also* Mot. 2, 3–4. On May 25, 2021, Petitioner sought the deposition of Mr. Li. Mot. 2. The next day, on May 26, 2021, Patent Owner discovered that “Mr. Li is in China and [Mr. Li] believes he cannot lawfully give a deposition in China under Chinese Law.” *Id.*

Two days after discovering Mr. Li’s unavailability, May 28, 2021, Patent Owner informed Petitioner that Mr. Li is unavailable for deposition

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and that Patent Owner would provide a new translation from a different translator and would seek to submit the new translation as supplemental information. *Id.* On June 2, 2021, Patent Owner served the New Translation on Petitioner (Ex. 2137, “New Translation”). Mot. 2.

Patent Owner moves to have the New Translation entered as supplemental information. *See id.* at 3–8. Patent Owner submits that the New Translation could not reasonably have been obtained earlier, as Patent Owner commissioned the New Translation within a few days after learning that Mr. Li was unavailable for cross examination. *See id.* at 2, 4. Patent Owner further submits that allowing the New Translation to be entered as supplemental information would be in the interests-of-justice, as the translation “is highly relevant” to Patent Owner’s argument that a skilled artisan “would have understood Yung to teach compression molding, which impacts both grounds in the Petition” (*id.* at 4) and that “[b]ecause discovery is ongoing, Petitioner has the opportunity to depose the new translator” (*id.* at 5).

In its Opposition, Petitioner submits that Patent Owner “should have either secured Mr. Li’s availability for a deposition when obtaining his translation, or hired an available U.S.-based translator during its extensive search window.” Opp. 7 (citation omitted). Petitioner further submits that the “Board routinely denies submitting a new translation as supplemental information, particularly when it could have been submitted earlier or when a declarant is unavailable for deposition.” *Id.* at 8 (citations omitted). Petitioner argues that “[t]here is no reason a translation by an available translator could not have been reasonably obtained earlier” (*id.* at 9) and

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Patent Owner “does not establish that a new translation is in the interests-of-justice” (*id.* at 10).

We disagree with Petitioner.

As to the first prong, Patent Owner could not have reasonably submitted the information earlier. Patent Owner commissioned the New Translation on May 27, 2021, one-day after learning that Mr. Li was unavailable. *See* Mot. 2. The New Translation was promptly served on Petitioner on June 2, 2021, and Patent Owner filed its Motion on June 10, 2021. Nothing in the record supports a finding that Patent Owner should have known that one of its translators would be unavailable for cross examination under Chinese law.

As to the second prong, granting the Motion as to the New Translation is in the interests-of-justice. Patent Owner served the New Translation on Petitioner on June 2, 2021, and Patent Owner submits that the New Translation “is only nine pages (excluding figures) [and] is materially identical to the previously-filed translation that Petitioner has had since March 2, 2021, and does not change the substance of [Patent Owner’s] arguments.” Mot. 7. We agree with Patent Owner that “Petitioner has ample time to analyze the new translation and depose” the new translator, if it wishes, before the Petitioner’s reply is due. *Id.*

As to Petitioner’s argument that the “Board routinely denies submitting a new translation as supplemental information, particularly when it could have been submitted earlier or when a declarant is unavailable for deposition” (Opp. 8), we note that the Board has granted entry of a new translation as supplemental information under similar facts. *See, e.g., Quanergy Sys., Inc. v. Velodyne LiDar, Inc.*, IPR2018-00255, Paper 23

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