

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

CHINA CHENGDA ENGINEERING CO., LTD.
Petitioner

v.

DORIAMO LTD.
Patent Owner

U.S. Patent No. 8,591,852

Case No. IPR2023-00365

PATENT OWNER'S PRELIMINARY RESPONSE

[REDACTED]

TABLE OF CONTENTS

I. Introduction.....	1
II. The Invention of the '852 Patent is a Significant Advance that Substantially Eliminates Waste in the Solvay Process	3
A. The Inventive Process of the '852 Patent	3
B. Prosecution History	5
III. Petitioner Chengda Recognized the Invention's Benefits, [REDACTED] [REDACTED]	9
IV. By Way of Assignment, Doriamo is the Owner of the '852 Patent Rights [REDACTED]	12
V. The Petition Should Be Denied Because [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED]	
E. The Petition Fails the Certification Requirement of 37 C.F.R. § 42.104(a)	22
VI. The Petition Should Be Denied for Failing to Name the Real Party in Interest	23
A. Real Party in Interest Requirement.....	24

B. Chengda is a Wholly Owned Subsidiary of China National Chemical Engineering Co., Ltd.	26
C. If Chengda Attempts to Cure Its Deficient Petition, Then It Should Be Required to Provide Sufficient Facts to Ensure That All Real Parties in Interest are Identified.....	28
D. Chengda Should Be Required to Detail the Role of the Chinese Government	29
E. China’s National Security Law of 2015 Presents Concerns for the RPI Analysis	32
VII. The Petition Should Be Denied Because It Fails to Comply with 37 C.F.R. § 42.63	34
A. The Translations Were Not Done by A Certified or Professional Translator.....	34
B. The Exhibits are Translations of Incomplete Chinese Documents.....	36
C. Petitioner’s Declaration Does Not Establish that Certain Exhibits are “True and Correct” Copies of the Underlying References	42
VIII. CONCLUSION	44

TABLE OF AUTHORITIES

Cases

<i>Applications in Internet Time, LLC v. RPX Corp.</i> , 897 F.3d 1336 (Fed. Cir. 2018)	24, 26
<i>Atlantic Gas Light Co. v. Bennett Regulator Guards, Inc.</i> , IPR2013-00453, Paper 88 (PTAB Jan. 6, 2015)	27
<i>Blackberry Corp. v. Zipit Wireless Inc.</i> , IPR2014-01506, Paper 50 (PTAB Mar. 29, 2016)	34
<i>Copperweld Corp. v. Independence Tube Corp.</i> , 467 U.S. 752 (1984)	27
<i>Dodocase VR, Inc. v. MerchSource, LLC</i> , 767 Fed. App'x 930 (Fed. Cir. 2019)	16
<i>Ford Motor Co. v. Cruise Control Technologies LLC</i> , IPR2014-00280, Paper 17 (PTAB July 2, 2014)	36, 41
<i>General Protecht Group, Inc. v. Leviton Manufacturing Co.</i> , 651 F.3d 1355 (Fed. Cir. 2011)	16
<i>Harmonic Inc. v. Avid Technologies, Inc.</i> , 815 F.3d 1356 (Fed. Cir. 2016)	43
<i>Kannuu Pty Ltd. v. Samsung Electronics Co.</i> , 15 F.4th 1101 (Fed. Cir. 2021)	16
<i>LG Electronics, Inc. v. Bizcom Electronics, Inc.</i> , 453 F.3d 1364 (Fed. Cir. 2006)	23
<i>Mallinckrodt, Inc. v. Medipart, Inc.</i> , 976 F.2d 700 (Fed. Cir. 1992)	23
<i>McCoy v. Mitsuboshi Cutlery, Inc.</i> , 67 F.3d 917 (Fed. Cir. 1995)	23
<i>M/S Bremen v. Zapata Off-Shore Co.</i> , 407 U.S. 1 (1972).....	15, 16

<i>National Equipment Rental, Ltd. v. Szukhent</i> , 375 U.S. 311 (1964).....	15
<i>New Vision Gaming, Inc. v. SG Gaming, Inc.</i> , 996 F.3d 1378 (Fed. Cir. 2021)	15, 16
<i>Nippon Shinyaku Co. v. Sarepta Therapeutics, Inc.</i> , 25 F.4th 998 (Fed. Cir. 2021)	15
<i>Return Mail, Inc. v. U.S. Postal Service</i> , 139 S. Ct. 1853 (2019).....	31
<i>Rowland v. California Men’s Colony, Unit II Men’s Advisory Council</i> , 506 U.S. 194 (1993).....	31
<i>RPX Corp. v. Applications in Internet Time, LLC</i> , IPR2015-01750, Paper 128 (PTAB Oct. 2, 2020)	25
<i>Servicenow, Inc. v. HewlettPackard Co.</i> , IPR2015-00716, Paper 13 (PTAB Aug. 26, 2015).....	43
<i>Sirius XM Radio, Inc. v. Fraunhofer-Gesellschaft Zur Forderung Der An- gewandten Forschung E.V.</i> , IPR2018-00681, Paper 12 (PTAB Sept. 6, 2018).....	25
<i>Shenzhen Aurora Tech. Co. v. Putco, Inc.</i> , IPR2020-00670, 2020 WL 5078551 (PTAB Aug. 27, 2020).....	36, 41
<i>United States v. Cooper Corp.</i> , 312 U.S. 600 (1941).....	31
<i>United States v. United Mine Workers of America</i> , 330 U.S. 258 (1947).....	31
<i>Vermont Agency of Natural Resources v. United States ex rel. Stevens</i> , 529 U.S. 765 (2000).....	31
<i>Volkswagen Group of America, Inc. v. Arigna Technology Ltd.</i> , No. IPR2021-01263, 2022 WL 211526 (PTAB Jan. 21, 2022)	25, 29
<i>Worlds Inc. v. Bungie, Inc.</i> , 903 F.3d 1237 (Fed. Cir. 2018)	26



Zoll Lifecor Corp. v. Philips Electronics North America Corp.,
IPR2013-00606, Paper 13 (PTAB Mar. 20, 2014) 33

Statutes

1 U.S.C. § 1 31

35 U.S.C. § 311(a) 31

35 U.S.C. § 312(a)(2)..... 2, 24

35 U.S.C. § 314(a) 2, 3, 14

35 U.S.C. § 316(e) 43

35 U.S.C. § 321(a) 31

Rules and Regulations

37 C.F.R. § 42.8 24

37 C.F.R. § 42.63 2, 3, 34

37 C.F.R. § 42.63(b) 34, 36, 39

37 C.F.R. § 42.104(a)..... 2, 14, 22, 23

Other Authorities

PTAB, *Consolidated Trial Practice Guide*, Nov. 2019 Ed. 24, 25

[REDACTED]

EXHIBIT LIST

EXHIBIT NO.	DESCRIPTION
2001	Declaration of Stephanie Mina In Support of Patent Owner Preliminary Response
2002	[REDACTED]
2003	'852 Patent Assignment
2004	[REDACTED]
2005	[REDACTED]
2006	[REDACTED]
2007	[REDACTED]
2008	[REDACTED]
2009	[REDACTED]
2010	[REDACTED]
2011	[REDACTED]
2012	[REDACTED]
2013	[REDACTED]
2014	[REDACTED]
2015	[REDACTED]
2016	[REDACTED]
2017	Printouts from Chengda's Website
2018	Wikipedia, CNCEC, https://en.wikipedia.org/wiki/China_National_Chemical_Engineering , April 10, 2023
2019	American Public University System, <i>Bilingual, Basic Or Fluent: What Are The Differences?</i> https://www.careersingovernment.com/tools/gov-talk/about-gov/education/basic-fluent-or-bilingual-what-are-the-differences/ and Same Day Translations, <i>Being Bilingual vs. Being Fluent</i> ,



	https://www.samedaytranslations.com/blog/being-bilingual-vs-being-fluent/
2020	Declaration of Dr. Basel Fathi Mohamed Abu-Sharkh
2021	
2022	
2023	
2024	Department of Defense, DOD Releases List of Additional Companies, in Accordance with Section 1237 of FY99 NDA, https://www.defense.gov/News/Releases/Release/Article/2328894/dod-releases-list-of-additional-companies-in-accordance-with-section-1237-of-fy/ , August 8, 2020
2025	Web Pages from CNCEC https://www.cccme.cn/shop/cccme0858/introduction.aspx , April 10, 2023
2026	Web Pages from Chengda's Website Listing Select Chengda Patents https://en.chengda.com/technology.aspx?cid=19&pid=20 , April 10, 2023
2027	Covington, <i>China Enacts New National Security Law</i> , July 2, 2015, https://www.cov.com/~media/files/corporate/publications/2015/06/china_passes_new_national_security_law.pdf
2028	Web Pages from CNCEC, Board of Directors – Dei Hegen https://cncec.com.cn/column/detail/dsh , April 10, 2023
2029	Dai Hegen Deputy Secretary of the Party Committee https://www.cpcic.org/Data/View/3446 , April 10, 2023
2030	Wikipedia, <i>Chinese Communist Party</i> , https://en.wikipedia.org/wiki/Chinese_Communist_Party_Committee_Secretary , April 10, 2023

I. Introduction

Petitioner Chengda's Petition for *inter partes* review should not be instituted multiple reasons. The '852 patent technology represents a significant and environmentally positive advance in soda-ash technology. The claimed process enables an integrated process to make soda ash and calcium chloride in high concentrations while substantially reducing waste from the process and minimizing the use of precious resources. In particular, it recycles wastewater and sodium chloride, combined to create fresh brine for re-use in the process. These steps are important, particularly in locations where water is scarce.

The Petition is an attempt by Petitioner to avoid abiding [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] The Petition completely ignores these facts, which requires that [REDACTED]

[REDACTED] While Petitioner's substantive positions have significant flaws, the present preliminary response focuses on fundamental procedural defects—all of which support denial of institution.

First, [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED].

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

Second, the Petition should be denied for not naming the real parties in interest. Chengda is a wholly owned subsidiary of China National Chemical Engineering Group, Co., which has been reported to be controlled by the Chinese state. The available information also indicates that at least China National Chemical Engineering Group, Co. is a real party in interest. Further, given the apparent control that the Chinese state has over certain business entities—including the right to access confidential information—there is a significant question as to whether the Chinese government is authorized to participate in an IPR proceeding. Thus, the Board should deny the Petition under 35 U.S.C. § 312(a)(2) for failure to name the real party in interest and/or under 35 U.S.C. § 314(a) pursuant to the Board’s discretion.

Third, the Petition should be denied for failing to comply with 42 C.F.R. § 42.63 for three reasons, taken alone or together. As an initial matter, the key translations of incomplete documents were not prepared by a sufficiently qualified translator, as required by § 42.63. Additionally, Petitioner failed to submit complete

[REDACTED]

documents. In several instances, the incomplete portions relied on are incomplete portions of chapters or longer texts. In one instance, Exhibit 1004 includes a single page of more than 290 pages of the underlying reference. Lastly, Petitioner's declarant failed to establish the incomplete photocopies are "true and correct" copies of the underlying references relied upon as prior art. Each of those failures is a violation of 37 C.F.R. § 42.63.

Overall, the Petition presents multiple procedural defects. Taken alone or together, these multiple procedural defects are sufficient reason for the Board to exercise its discretion under 35 U.S.C. § 314(a) and deny the Petition.

II. The Invention of the '852 Patent is a Significant Advance that Substantially Eliminates Waste in the Solvay Process

The '852 patent is a significant advance over existing Solvay processes in operation at the time of invention. While the general Solvay process is well known, there remain, to this day, significant efforts to improve the process and reduce waste. For instance, Petitioner itself purports to have invented improvements to the soda ash process. *See* Ex. 2026 (Nos. 5, 18, 26, and 34). It is simply insufficient to point to general references that might identify a general desire of decreasing waste or water use in a complicated industrial chemical process.

A. The Inventive Process of the '852 Patent

The '852 patent issued on November 26, 2013, and has an earliest priority date of February 22, 2012. Ex. 1001. The '852 patent issued from U.S. application



no. 13/651,534, which is a continuation of non-provisional U.S. application no. 13/402,783 (“the ’783 application”), filed on February 22, 2012. *Id.* The ’852 patent is also related to PCT Application No. PCT/US2012/040906 (“the ’906 PCT application”). Ex. 2020 ¶ 16. The ’906 PCT application is also a continuation of the ’783 application.

The ’852 patent claims an integrated process of producing soda ash (sodium carbonate) and calcium chloride. The process is “a modified version of the Solvay process that recycles ammonia, sodium chloride and water to eliminate harmful waste products.” Ex. 1001, col. 1, ll. 13-15. As the ’852 patent teaches, prior “industrial plants using the Solvay process produce waste and byproducts that may result in environmental problems, such as water pollution from calcium, chloride ions, and salt (NaCl) that accumulates in fresh water streams, ponds, and lakes.” *Id.*, col. 1, ll. 30-37. “Thus, a method of producing soda ash and calcium chloride solving the aforementioned problems is desired.” *Id.*, col. 1, ll. 30-37.

The patent further describes an improved Solvay process that is more “environmentally friendly” for producing soda ash (sodium carbonate) and calcium chloride while minimizing waste and hazardous byproducts. *See id.*, Abstract. A significant benefit of the ’852 patent is that it provides an integrated process for producing soda ash and calcium chloride in which substantially all the waste is recovered and recycled. According to the patent, the prior art failed to provide specific



teachings of the combination of steps that are identified and claimed in the '852 patent. *Id.* at col. 1, ll. 30-34.

The '852 patent recycles ammonia that is used in the process. *Id.* at col. 2, ll. 39-41. That ammonia is recovered by using lime. *Id.* at col. 2, ll. 47-54. The typical Solvay process uses “slaked” lime, also called lime milk. *See, e.g.*, Ex. 1010 at 6. The '852 patent teaches that it is beneficial to use “dry” lime, or “unslaked” lime, to reduce effluent. Ex. 1001 at col. 2, ll. 50-52.

Additionally, the patented process provides waste elimination through, in part, the recycling steps. Part of that effluent-processing step is separating sodium chloride from the effluent by crystallization and centrifugation. *See id.*, col. 2, ll. 55-66. That aspect is specifically recited as a limitation in independent claims 1, 5, and 6. The sodium chloride is reused/recycled and combined with recovered water from the process to produce fresh brine. *Id.* at col. 2, ll. 61-65.

B. Prosecution History

The original claims 1-14 as filed were rejected under 35 U.S.C. § 103 as obvious in view of U.S. Patent No. 363,952 (“Frasch”) and U.S. Patent No. 4,172,017 (“Abraham”). According to the examiner, the original claims “recite[d] little beyond the basics of the Solvay process, and it is not seen the claimed process differs.” Ex. 1009 at 56. Frasch was noted as being 125 years old. *Id.* Abraham was identified as “supplementary” as just further describing the old Solvay process. *Id.*



During prosecution, an examiner interview was conducted after the original claims were rejected. The Interview Summary on February 27, 2013, provides the following.

It was argued that [the] present process was an improvement over the Solvay process, as documented by '952 [*i.e.*, Frasch]. The Office requested elucidation of detailed parameters. *ie*, specific numerical values, for purity concentrations of reactants and other conditions which would be commensurate with an unexpected or improved result. It was also suggested to focus on the recovery of NaCl from the process, perhaps in the indication of a high purity if the Solvay process is more directed to the production of the carbonate. No specific agreement of how the claims would be amended was made.

Ex. 1009 at 72.

On April 15, 2013, the Applicant filed a response to the Office Action. Claim 1 was amended in response to the prior art rejections. *Id.* at 75-76. The Applicant explained that “the present application provided a new and improved series of steps to produce the resulting products and provide recycling of the materials to reduce waste.” *Id.* at 82.

To clarify the scope of the claimed invention, the Applicant amended original claims 1 and 11 to specify the steps of the process that highlighted how the integrated process “reduce[s] waste.” *Id.* at 82. The amendments to claim 1, as an example, are shown below, with additions in underline.


Claim 1. (Currently Amended) A method of producing soda ash and calcium chloride, comprising the steps of:

providing a source of brine;

providing a source of gaseous ammonia;

ammoniating brine with gaseous ammonia to form ammoniated brine;

heating limestone to produce calcium oxide and carbon dioxide;

reacting the ammoniated brine with the carbon dioxide produced by the step of heating the limestone to produce sodium bicarbonate, ammonium chloride and a brine effluent;

calcining the sodium bicarbonate to decompose the sodium bicarbonate to produce soda ash and gaseous carbon dioxide;

reacting the calcium oxide with the ammonium chloride and brine effluent to produce calcium chloride, brine effluent, and ammonia;

recycling the ammonia to be used in the step of ammoniating the brine; and

recycling the water from the brine effluent to be used in the step of ammoniating the brine by crystallizing sodium chloride from the mixture of calcium chloride and brine effluent, separating the crystallized sodium chloride from the effluent by centrifuging the effluent. And recycling the crystallized sodium chloride;

evaporating any water remaining to produce water vapor;


recovering the produced calcium chloride;

recycling the water vapor;

wherein the crystallized sodium chloride is further for the formation
of fresh brine to continue the method;

collecting the produced calcium chloride:

separating residual salt; and

forming an approximately 77 wt% solution of calcium chloride
flakes.

Id. at 75-76 (emphasis in original). Original claim 11 was also amended. *Id.* at 78-79. Claims 15-19 were also added. *Id.* at 79-81.

On June 12, 2013, the examiner rejected the amended and new claims as obvious over the same prior art: Frascch and Abraham. *Id.* at 90. On July 9, 2013, the Applicant filed a response and made further amendments to pending claims 1, 11, and 15. The amendment (as exemplified in claim 1 below) added the following additional limitations in underline:

wherein said step of reacting the calcium oxide with the ammonium
chloride and brine effluent comprises reacting dry calcium oxide
with the ammonium chloride and brine effluent without slaking the
calcium oxide produced by heating the limestone;

...

[REDACTED]

recycling the water from the brine effluent to be used in the step of ammoniating the brine by crystallizing sodium chloride from the mixture of calcium chloride and brine effluent, separating the crystallized sodium chloride from the effluent by centrifuging the effluent, and recycling the crystallized sodium chloride;

. . .

recycling the water vapor and condensing into water;

wherein the crystallized sodium chloride is further used for the formation providing of fresh brine by combining with the condensed water to continue the method; . . .

Id. at 98-99. Similar amendments were made to pending claims 11 and 15 (later issued as claims 5 and 6). *Id.* at 79, 98-103.

On September 5, 2013, then-pending claims 1-3, 6, 11, and 15-19 were allowed in view of the amendments. *Id.* at 108-113. The patent issued on November 26, 2013, with claims 1-10. Ex. 1001 at col. 3, l. 14-col. 6, l. 21.

III. Petitioner Chengda Recognized the Invention's Benefits, [REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

IV. By Way of Assignment, Doriamo is the Owner of the '852 Patent Rights

[REDACTED]

Doriamo is the assignee of record for the '852 patent (“the '852 Patent Assignment”). Ex. 2001 ¶ 3; Ex. 2003. The '852 Patent Assignment was recorded at the United States Patent and Trademark Office on October 7, 2021, at Reel:057735 Frame: 0127. Ex. 2020 ¶ 4; Ex. 2003.

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

V. The Petition Should Be Denied Because

[REDACTED]

The PTAB should exercise its discretion pursuant to 35 U.S.C. § 314(a) and deny institution of the Petition because [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

The Petition also contains a deficient or false certification, contrary to the requirement of 37 C.F.R. § 42.104(a). In particular, the certification is deficient because [REDACTED] That is an independent reason to deny institution.

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]
[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

**E. The Petition Fails the Certification Requirement of 37 C.F.R.
§ 42.104(a)**

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

VI. The Petition Should Be Denied for Failing to Name the Real Party in Interest

The Petition should be denied because it fails to name Chengda's controlling parent corporation as a real party in interest (and possibly other real parties in interest

[REDACTED]

as well). If given an opportunity to amend its petition, Chengda must submit sufficient factual support to allow Doriamo to understand all RPIs. Further, given the apparent control that the government of China exercises over its national corporations, it is questionable whether the Board should permit an entity controlled by the Chinese government to participate in AIA proceedings, particularly when the statute does not authorize governmental agencies to do so.

A. Real Party in Interest Requirement

A petitioner must identify the “real party in interest” to the IPR petition. 35 U.S.C. § 312(a)(2); 37 C.F.R. § 42.8; *see also Applications in Internet Time, LLC v. RPX Corp.*, 897 F.3d 1336, 1351 (Fed. Cir. 2018) (“*AIT*”). The purpose of this requirement is to “assist members of the Board in identifying potential conflicts, and to assure proper application of the statutory estoppel provisions.” PTAB, *Consolidated Trial Practice Guide* at 12, Nov. 2019 Ed. Failure to accurately identify the real party in interest is a basis for the PTAB to deny the IPR petition.

“Determining whether a non-party is a ‘real party in interest’ demands a flexible approach that takes into account both equitable and practical considerations, with an eye toward determining whether the non-party is a clear beneficiary that has a pre-existing, established relationship with the petitioner.” *AIT*, 897 F.3d at 1351. One test for determining whether an unnamed entity is a real party in interest is “whether the non-party exercised control or could have exercised control over a

[REDACTED]

party's participation in a proceeding.” *Consolidated Trial Practice Guide* at 16 (emphasis added).

Factors for determining actual control or the opportunity to control include the existence of a financially controlling interest in the petitioner. *See Sirius XM Radio, Inc. v. Fraunhofer-Gesellschaft Zur Forderung Der Angewandten Forschung E.V.*, IPR2018-00681, Paper 12, at 6 (PTAB Sept. 6, 2018) (considering the unnamed party's ownership of petitioner as a factor in determining that unnamed party was a real party in interest).

Additionally, the Board has set forth factors to be considered in determining whether an unnamed party is a real party in interest, including:

- (1) the petitioner's business model, (2) the petitioner's explanation of its own interest in the IPR, (3) whether the petitioner takes the unnamed party's interests into account when determining whether to file the IPR petition, (4) the unnamed party's relationship with petitioner, (5) the unnamed party's interest in and benefit from the IPR, (6) whether the petitioner can be said to be representing that interest, (7) whether the unnamed party actually desired review of the challenged patent, (8) the relevance of any overlap in board members between the petitioner and the unnamed party, and (9) evidence of communications between the petitioner and the unnamed party.

Volkswagen Grp. of Am., Inc. v. Arigna Tech. Ltd., No. IPR2021-01263, 2022 WL 211526, at *3 (PTAB Jan. 21, 2022) (citing *RPX Corp. v. Applications in Internet*


Time, LLC, IPR2015-01750, Paper 128, at 10–11 (PTAB Oct. 2, 2020) (precedential)).

The PTAB approaches the inquiry by focusing on the “two related purposes” of the real party in interest (“RPI”) requirement set forth in the legislative history, *i.e.*, to preclude parties from getting “two bites at the apple” by: (1) ensuring that third parties who have sufficiently close relationships with IPR petitioners are bound by the outcome of instituted IPRs in final written decisions under 35 U.S.C. § 315, the IPR estoppel provision; and (2) safeguarding patent owners from having to defend their patents against belated administrative attacks by related parties via 35 U.S.C. § 315(b). *AIT*, 897 F.3d at 1350.

Petitioner bears the burden of proving that it has named all real parties in interest. *Worlds Inc. v. Bungie, Inc.*, 903 F.3d 1237, 1242 (Fed. Cir. 2018). Once a patent owner provides evidence disputing whether the petition names all real parties in interest, petitioner must prove that it did name all real parties in interest. *Id.* (holding that a petitioner’s assertions in the petition “should be accepted unless and until disputed by a patent owner”). Attorney argument is not sufficient to meet a petitioner’s burden. *Id.*

B. Chengda is a Wholly Owned Subsidiary of China National Chemical Engineering Co., Ltd.

Here, credible, publicly available evidence indicates that Chengda has failed to identify all real parties in interest. The Petition names only Chengda as the sole


real party in interest. Chengda, however, is a wholly owned subsidiary of China National Chemical Engineering Co., Ltd. (“CNCEC”), and the available information indicates that at least CNCEC is a real party in interest.

Specifically, Chengda identifies itself on its own website as “a wholly-owned subsidiary of China National Chemical Engineering Co. Ltd.” Ex. 2017. Of course, parent corporations, by definition, have a financially controlling interest in subsidiaries. *See, e.g., Copperweld Corp. v. Independence Tube Corp.*, 467 U.S. 752, 771-72 (1984) (“In reality a parent and a wholly owned subsidiary always have a ‘unity of purpose or common design.’ They share a common purpose whether or not the parent keeps a tight rein over the subsidiary; the parent may assert full control at any moment if the subsidiary fails to act in the parent’s best interests.”). Accordingly, a parent-subsidary relationship alone “weighs heavily in favor of finding [a parent] to be a real-party-in-interest.” *Atlantic Gas Light Co. v. Bennett Regulator Guards, Inc.*, IPR2013-00453, Paper 88, at 11 (PTAB Jan. 6, 2015).

Based on what can be gleaned from public sources, several other of the relevant factors weigh in favor of concluding that CNCEC is a real party in interest. For instance, CNCEC will certainly and “benefit from the IPR,” as its wholly owned subsidiary would be free of any liability for infringing the patent if Chengda’s IPR were successful. The public information (from CNCEC’s website) also indicates that CNCEC is “a share holding company sponsored principally by China National

Chemical Engineering Group Corporation in combination with Shen Hua Group Corporation Limited and Sinochem Corporation.” Ex. 2025 at 1. The available information also indicates that China National Chemical Engineering Group Corporation “is a large comprehensive corporation directly administered by the State Council of China.” *Id.* Thus, the limited publicly available information about “petitioner’s business model” indicates a closely controlled business model, further suggesting that Petitioner has failed to identify all real parties in interest.

This information is more than enough to overcome Chengda’s initial assertion that it has named all real parties in interest. *See* Pet. 1. The evidence presented is certain more that “some evidence” that “tends to show that a particular third party should be named a real party in interest.” *See Worlds*, 903 F.3d at 1242. Furthermore, given the current lack of access to more information about Chengda, CNCEC, and other related entities, the evidence presented here is certainly sufficient to doubt the accuracy of Chengda’s contention and to require Chengda to provide evidence that might support its ultimate burden of persuasion.

**C. If Chengda Attempts to Cure Its Deficient Petition, Then It
Should Be Required to Provide Sufficient Facts to Ensure That
All Real Parties in Interest are Identified**

If Chengda seeks to add additional real parties in interest, the PTAB should require Chengda to provide sufficient organizational details and facts relating to all such parties. The PTAB should further require Chengda to identify and describe any

[REDACTED]

control that additional parties may have over the Agreement between Patent Owner and Petitioner or over this IPR.

Specifically, Chengda should be required to provide information and facts about the relevant real-party-in-interest factors. *See Volkswagen Grp.*, 2022 WL 211526, at *3. Highly relevant information will include, but not be limited to, facts about: Chengda’s and CNCEC’s respective business models; whether Chengda takes CNCEC’s interests into account when determining whether to file the Petition; the relevance of any overlap in board members between Chengda, CNCEC, and other related entities; and any evidence of communications between Chengda and the relevant unnamed parties.

D. Chengda Should Be Required to Detail the Role of the Chinese Government

Furthermore, while the public information is somewhat opaque, there is credible evidence that Chengda is subject to at least some control by the Chinese state. It has been reported that Chengda is a subsidiary of China National Chemical Engineering Group Corp. (“CNCEC”). Ex. 2018. The latter is, according to reports, and even its own website, an entity that is owned by the Chinese state and is supervised by State-owned Assets Supervision and Administration Commission of the State



Council.³ *See also* Ex. 2025 (“China National Chemical Engineering Corporation is a large comprehensive corporation directly administered by the State Council of China.”). Chengda, being wholly owned by CNCEC, may thus also be administered or controlled in part by the State Council.

Moreover, the Board of Directors of CNCEC includes Chairman Dai Hegen. Ex. 2028. Mr. Hegen, as reported, served as deputy secretary of the Party Committee. Ex. 2029 (“Since 2001, he has successively served as deputy general manager, deputy secretary of the Party committee”). Based on public information, the Committee Secretary is a significant leadership role in the Chinese Communist Party. *See, e.g.*, Ex. 2030 (describing the role of the Committee Secretary).

Based on this information, if the Board were to provide Chengda with an opportunity to correct its deficient petition, then the Board should require Chengda to submit sufficient verifiable facts that would enable the Board and Patent Owner the ability to assess where the control lies. That information should further include any information as to whether CNCEC has any control of the present IPR.

Furthermore, the fact that a foreign government (China) apparently exercises control over Petitioner and/or its parent entities raises an important question of

³ The U.S. Department of State has previously identified CNCEC as a “Communist Chinese military company.” *See* Ex. 2024.



whether a foreign state is authorized by statute to file an AIA petition. The AIA permits only “‘a person’ other than the patent owner” to file with the Office a petition to institute a post-grant review or *inter partes* review of an issued patent. *Return Mail, Inc. v. U.S. Postal Serv.*, 139 S. Ct. 1853, 1860 (2019) (quoting 35 U.S.C. §§ 311(a), 321(a)). While broad, the authorization to file an IPR is not extended without limit to any entity.

The Dictionary Act has since 1947 provided the definition of “person” that courts use “[i]n determining the meaning of any Act of Congress, unless the context indicates otherwise.” 1 U.S.C. § 1; *see Rowland v. Cal. Men’s Colony, Unit II Men’s Advisory Council*, 506 U.S. 194, 199–200 (1993). The Act provides that the word “person” “include[s] corporations, companies, associations, firms, partnerships, societies, and joint stock companies, as well as individuals.” 1 U.S.C. § 1. That definition of “person” notably omits any term that could include a governmental entity. *See United States v. United Mine Workers of Am.*, 330 U.S. 258, 275 (1947) (reasoning that Congress’s express inclusion of partnerships and corporations in 1 U.S.C. § 1 implies that Congress did not intend to include the federal government).

Thus, although the presumption is not a “hard and fast rule of exclusion,” *United States v. Cooper Corp.*, 312 U. S. 600, 604–05 (1941), “it may be disregarded only upon some affirmative showing of statutory intent to the contrary,” *Vt. Agency of Nat. Res. v. United States ex rel. Stevens*, 529 U.S. 765, 781 (2000). It would



indeed be an odd outcome if Congress had established an administrative patent cancellation system that does not permit federal agencies to challenge U.S. patents but would simultaneously permit foreign national governments to challenge U.S. patents.

In sum, if the Chinese government does have some degree of control over Chengda and/or its parent corporation, Chengda should be required to disclose the relevant information. It further demonstrates Chengda's failure to name all real parties in interest.

E. China's National Security Law of 2015 Presents Concerns for the RPI Analysis

Another point of concern is the National Security Law of the People's Republic of China. *See generally* Ex. 2027. Issued on July 1, 2015, the National Security Law is a Chinese law made up of seven sections containing 84 articles. People's Republic of China ("PRC") authorities say that the law can protect national security of the PRC effectively and the media controlled by the authority praise the law, while some analysts argue that the authorities can restrict Chinese people's freedom with this law. *Id.* at 1.

As summarized by the law firm Covington, parts of the law "impose[] broad obligations on citizens and corporations to assist and cooperate with the government" under the guise of "protecting national security." *Id.* at 2 (describing the obligations of citizens and corporations under Article 80). Obligations under the law



include, for example, “reporting information on activities that may damage national security, protecting and providing (to the authorities) evidence on activities that may damage national security, protecting national secrets, and providing data, information, and technological support or assistance to security agencies, law enforcement agencies, and the military.” *Id.* “Citizens and corporations also have an obligation to cooperate with security agencies when such agencies are carrying out national security work.” *Id.*

These provisions of the National Security Law raise legitimate questions about Chengda’s ability to participate in the IPR and abide by the terms of a Protective Order. The implications here are significant and are further reasons warranting denial of the Petition.

* * *

In short, because Chengda failed to identify its parent company CNCEC and other possible real parties in interest, the petition should be denied. *See, e.g., Zoll Lifecor Corp. v. Philips Elecs. N. Am. Corp.*, IPR2013-00606, Paper 13, at 12 (PTAB Mar. 20, 2014) (denying institution because parent company that exercised control of the petitioner was not identified). If Chengda seeks to add parties, it should be ordered to provide organizational details of all parties, as well as any control over the contract between (1) the inventor/Patent Owner and Chengda or (2) over this IPR.

VII. The Petition Should Be Denied Because It Fails to Comply with 37 C.F.R. § 42.63

The Petition should be denied for failing to comply with 42 C.F.R. § 42.63 for three reasons, taken alone or together. First, the key translations were not prepared by a sufficiently qualified translator. Second, Petitioner failed to submit complete documents that are the relied-upon Exhibits. Third, Petitioner's declarants fail to establish the incomplete photocopies are "true and correct" copies of the underlying references relied upon as prior art.

A. The Translations Were Not Done by A Certified or Professional Translator

Another reason to deny the Petition is because the verifications submitted with the translations do not establish the completeness and accuracy of the translations. For instance, the information in the verification raises questions as to the qualifications of the Chinese-located translator.

Rule 42.63(b) requires, for all translations, that "an affidavit attesting to the accuracy of the translation must be filed with the document." To satisfy the Board rules, the translator of the submitted exhibit must be a sufficiently qualified translator. *See, e.g., Blackberry Corp. v. Zipit Wireless Inc.*, IPR2014-01506, Paper 50 at 8-11 (PTAB Mar. 29, 2016) (denying petition because translations were done by an expert, translating Hebrew, and were not certified translations).

Here, the translations do not include a verification by a sufficiently qualified translator, such as a professional or certified translator. All the Chinese translations

[REDACTED]

were prepared by an individual named “Wenli Zhang.” *See, e.g.*, Ex. 1003 at 40. The verifications do not state that Wenli Zhang is a professional or certified translator. Instead, the verifications offer that Wenli Zhang is “*conversant* with the Chinese and English languages.” *Id.* (emphasis added). Merely being “conversant” in a language is a far-cry from being qualified to act as a competent translator, especially for the purpose of canceling duly issued U.S. patent claims.

As the Board is aware, the degrees of language proficiency vary widely. At the lower end is a “basic” understanding of a foreign language. Also on the lower end of the proficiency scale is “conversant,” which is usually referred to as an “intermediate level of language.” Ex. 2019. Someone “conversant” in Chinese will have “greater formality and less familiarity compared to a native and fluent speaker.” *Id.* Further, “conversant” reading and writing skills “may not be at the same level.” *Id.*

Beyond this intermediate level are “fluent” and “native speaker.” One would expect that a competent translator of complex technical documents would at least be to the level of being fluent in the language translated. Here, however, Chengda offers only a translator self-identified as “conversant,” *i.e.*, “intermediate level.” Accordingly, based on the verification, Wenli Zhang has not certified to be a sufficiently competent translator, and therefore the offered translations are deficient under 37 C.F.R. § 42.63.



B. The Exhibits are Translations of Incomplete Chinese Documents

The Petition should be denied also because Chengda's prior art arguments rely on translations of incomplete Chinese-language documents. All asserted grounds in the Petition rely on the incomplete Chinese-language documents, and therefore all grounds rely on defective documents.

A petitioner must provide a complete translation of "the document." 37 C.F.R. § 42.63(b). Under the rule, "[w]hen a party relies on a document or is required to produce a document in a language other than English, a translation of *the document* into English and an affidavit attesting to the accuracy of the translation must be filed with the document." 37 C.F.R. § 42.63(b) (emphasis added). Thus, the entire document must be provided.

The Board has denied institutions when a petitioner submits only partial documents in support of a petition. For instance, in *Shenzhen Aurora Technology Co. v. Putco, Inc.*, No. IPR2020-00670, 2020 WL 5078551, at *3 (PTAB Aug. 27, 2020), the Board denied institution in part because a reference was a translation of an incomplete document and not properly certified. Similarly, in *Ford Motor Co. v. Cruise Control Technologies LLC*, IPR2014-00280, Paper 17 at 6-7 (PTAB July 2, 2014), the Board determined that partial translations did not meet the requirements of Rule 42.63(b) but waived the requirements in that particular instance.



Here, several exhibits are deficient because they are not complete and are only translations of partial excerpts of the underlying references. These include Exhibits 1003 (Fu); Ex. 1004 (Xi); Ex. 1006 (Hou); Ex. 1008 (Soda Technology). These translations of selected portions of the references impact every Ground in the Petition and violate the Board regulations.

First, Petitioner failed to provide a complete copy of its primary reference Fu. The Petition relies on Fu for both its Ground I and Ground II arguments. Fu is a Chinese reference titled “Practical Inorganic Chemical Technology.” Ex. 1003 at 41. It appears to be a survey text compiled by many different editors. *Id.* at 45. It does not appear to be peer-reviewed.

Importantly, Petitioner chose to submit only excerpts (and translations of the excerpts) of the Fu reference. Specifically, Petitioner submitted only a portion of Chapter 7. The Table of Contents notes that Chapter 7 is directed to “the Soda Industry.” Ex. 1003 at 47. The complete chapter runs from pages 251-307 (a total of 57 pages), including an “Overview” at the beginning and “Reviewing Exercises” at the end. *Id.*

Petitioner only provided excerpts from Chapter 7.2 and even that limited section is incomplete. Chapter 7.2 includes pages 254-286. *Id.* at 47. Yet Petitioner only included pages 254-284. *Id.* at 50-80. All told, Petitioner omitted approximately 40% of the pages the excerpted Chapter 7.2.



Equally problematic is Petitioner's decision to exclude the "references cited" portion for Fu, as well as the other exhibits (detailed below). When a person of ordinary skill in the art reads a prior art reference, it is important to consider the "cited references" or other supporting material.

Here, Petitioner chose to submit photocopies that expressly omit the supporting references or appendices. *See* Exs. 1003 at 47; 1004 at 18; 1005 at 1008 at 23; and Ex. 1013 at 12. For instance, the underlying Fu reference apparently includes a "Reviewing Exercises" section for each chapter, but the photocopy exhibit excludes those relevant portions. *See* Ex. 1003 at 47. Similarly, the underlying book for Exhibit 1008 apparently includes a section titled "References" at the end of each chapter, but Exhibit 1008 itself excludes that section. *See* Ex. 1008 at 28. Exhibit 1013 omits the Appendix. Ex 1013 at 12.

By omitting the "references cited" portion, Petitioner provides an incomplete document that hinders Patent Owner's ability to evaluate the full meaning of the cited text. This is yet another reason why Petitioner's translations of partial documents are deficient and why the Petition should be denied.

Similar deficiencies are seen in Exhibit 1004 (Xi), another significantly incomplete document. Xi includes a translation of a single page from the underlying Chinese-language chapter. Chapter V.3. "I. Sodium Carbonate" is identified as having 5 pages (221-225). Ex. 1004 at 15. Petitioner, however, only submitted a single

[REDACTED]

translated page of text. Ex. 1004 at 19 (p. 225). Petitioner omitted 80% of the selected chapter.

Exhibit 1006 (Hou) similarly fails to comply with Rule 42.63(b). Exhibit 1006 appears to be a photocopy of part of a book titled “The Selected Works of Hou Debang.” The exhibit as filed provides no information about “Hou Debang.” While the book itself appears to be over 350 pages long, the filed exhibit includes only two pages of the text. *See* Ex. 1006 at 15-16 (pages 162 and 163).

Exhibit 1006’s incompleteness is illustrated, in part, by the first and last lines of the translated text. Specifically, the first page of the exhibit shows that the translation begins mid-sentence:

162 Selected Works of Hou Debang

the loss, 25% or more of the salt was wasted. As a result, the existing alkali plants adopting ammonia-soda process all have the cheapest and most abundant supply of raw salt. In this case, it is often uneconomical to recover salt from waste liquor of distillation.

Ex. 1006 at 15. There is no indication about what is meant by the “the loss” and “25% or more of the salt was wasted.” The reader is left guessing.

Similarly, the last line of Exhibit 1006 appears to end cryptically mid-sentence:

concentrated in an evaporator to 40 °Be'. Now, the content of CaCl₂ in the solution reaches about 50%. The precipitated salt is filtered out, and the calcium chloride solution is put into a jar with a stirrer, and ammonia gas is introduced...



Id. at 16.⁴ The incomplete document offers no insight about where the “ammonia gas is introduced.” Ammonia, of course, is used in the improved Solvay process, as claimed in the ’852 patent. *See, e.g.*, Ex. 1 at col. 3, ll. 15-20. Based on the exhibit’s incompleteness, it is not possible to fairly determine what relevant information is omitted from Exhibit 1006.

Moreover, a review of the translated table of contents identifies other portions of the reference that may have relevant information but that were omitted from the partial translation. For instance, the chapter titled “Alkali and Chlorine Products” consists of 49 pages of potentially relevant information. *Id.* at 13 (pp. 140-189). Similarly, two additional chapters, “Brine Refining by Ammonia Process” (7 pages) and an “Alkali Production (Excerpt)” portion (47 pages) are likely to have information probative of a full understanding of the cited references. *Id.* By submitting cherry-picked portions and omitting others that appear relevant, Petitioner provides an incomplete document that hinders Patent Owner’s ability to evaluate the full meaning of the cited text. This is yet another reason why the translation is defective.

⁴ Note also that this portion of the translation excerpt reads “concentrated in an evaporator to 40 °Be’.” It is not clear what the term “°Be” refers to.



Petitioner's Exhibit 1008 is another incomplete document. The exhibit is a translation of selected excerpts from an 891-page book written in Chinese and apparently titled "Soda Ash." The submitted exhibit is only four pages (pages 402-405) from the entire book. Ex. 1008 at 34-37. Given the title of this text, a partial translation of only four self-selected pages of a single chapter cannot comply with the Board's rule for a complete "document."

Further, Petitioner did not even file a complete chapter or section of a chapter. The entire subsection is seven pages long. *Id.* at 28 (Chapter XVI, Section III, I.). Yet Petitioner only submitted four pages. Thus, only about 40% of the selected subsection was not provided.

The incomplete documents infect all grounds presented in the Petition. In particular, Ground I relies primarily on the Fu reference, in combination with Xi or Hou. Pet. at 15-50. Ground II relies on the Fu and Hou references as well. *Id.* at 51-73. Reliance on translations of incomplete documents violates the PTAB Rules, which requires translations of "documents." *Shenzhen*, 2020 WL 5078551, at *3; *Ford Motor Co.*, Paper 17 at 6-7. This is particularly troublesome given the practical impediment to access Chinese-library documents, which is apparently where the references were located.

**C. Petitioner’s Declaration Does Not Establish that Certain Exhibits
are “True and Correct” Copies of the Underlying References**

The Petition also fails to adequately establish that the foreign-language exhibits are, in fact, true and correct copies of the underlying book references. The supporting declaration offering such an attestation makes it clear that the declarant did not make the copies and never compared the copies to the actual books—and that the declarant lacks the personal knowledge needed to authenticate the copies.

Petitioner submitted the declaration of Dr. Sylvia Hall-Ellis as an attempt to show that the photocopies shown in Exhibits 1003, 1004, 1006, and 1008 are “true and correct” copies of the underlying book references. *See, e.g.*, Ex. 1005 at 27-39. For instance, Dr. Hall-Ellis states that “Exhibit 1003 is “complete; no pages are missing, and the text on each page appears to flow seamlessly from one page to the next; further there are no visible alterations to the document.” *Id.* at 27. Dr. Hall-Ellis repeats similar assertions for Exhibits 1004, 1006, and 1008.

Dr. Hall-Ellis lacks personal knowledge to make such assertions, however. Based on her declaration, it is apparent that Dr. Hall-Ellis did not have access to the underlying textbook and never compared the photocopies to the book. Dr. Hall-Ellis acknowledges that each photocopy exhibit “was obtained from Tsinghua University Library [in China] under my instruction,” Ex. 1005 at 27, meaning that she did not make the photocopies. Her declaration does not say that she inspected the actual books. This combined with the fact that Dr. Hall-Ellis is in the United States leads



to the only reasonable conclusion: She apparently never inspected, viewed, handled, or had access to the actual hard copies of the references. Thus, Dr. Hall-Ellis lacks the personal knowledge to swear under oath that the photocopies shown as Exhibits 1003, 1004, 1006, and 1008 are in fact “true and correct” copies of obscure textbooks that exist apparently only in China.

It cannot be a patent owner’s burden and obligation to track down the underlying books, located in China, to determine whether the copies are, in fact, true and correct. That is Petitioner’s obligation. *See* 35 U.S.C. § 316(e); *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (“In an [inter partes review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.”). Petitioner’s failure to satisfy this basic obligation is yet another reason to deny the Petition. *See, e.g., Servicenow, Inc. v. HewlettPackard Co.*, IPR2015-00716, Paper 13 at 14-15 (PTAB Aug. 26, 2015) (denying petition for failure to authentic certain prior art from Wayback Machine).

* * *

In short, the reliance on the incomplete excerpts of Chinese-language references, translated by a Chinese-based individual who is not a sufficiently qualified translator, do not comply with the requirements of the PTAB’s rules. These references impact every Ground set forth in the Petition, and for that reason, the Petition should be denied.



VIII. CONCLUSION

For the foregoing reasons, the Board should deny institution. Patent Owner reserves all rights to supplement its positions, as well as to address substantive issues and arguments, in the event that the IPR is instituted.

Date: April 11, 2023

Respectfully submitted,

/Matthew J. Dowd/

Matthew J. Dowd
Reg. No. 47,534
Robert J. Scheffel
Reg. No. 43,090
Dowd Scheffel PLLC
1717 Pennsylvania Avenue, NW
Suite 1025
Washington, D.C. 20006
T: (202) 559-9175
F: (202) 204-5877
mdowd@dowdscheffel.com
rscheffel@dowdscheffel.com

Joshua Goldberg
Reg. No. 44,126
Nath, Goldberg & Meyer
112 S. West Street
Alexandria, VA 22314
T: (703) 548-6284
F: (703) 683-8396
jgoldberg@nathlaw.com

*Counsel for Patent Owner
Doriamo Ltd.*

CERTIFICATE OF COMPLIANCE

I hereby certify that Patent Owner's Preliminary Response complies with the word-length limitation of 37 C.F.R. § 42.24(d). This Preliminary Response contains 9,816 words, excluding the portions set forth in 37 C.F.R. § 42.24(a)(1). The word count was generated using the word count feature in Microsoft Word.

/Matthew J. Dowd/

Matthew J. Dowd

Reg. No. 47,534

Dowd Scheffel PLLC

1717 Pennsylvania Avenue, NW

Suite 1025

Washington, D.C. 20006

T: (202) 559-9175

F: (202) 204-5877

mdowd@dowdscheffel.com

Counsel for Patent Owner

Doriamo Ltd.

CERTIFICATION OF SERVICE ON PATENT OWNER

The undersigned hereby certifies that a copy of the foregoing PATENT OWNER'S PRELIMINARY STATEMENT was served on April 11, 2023 via electronic mail upon the following counsel for Petitioner:

Eliot D. Williams
eliot.williams@bakcrbotts.com

Jennifer C. Tempesta
jennifer.tempesta@bakerbotts.com

Frank Zhu
frank.zhu@bakerbotts.com

Boyang Zhang
boyang.zhang@bakerbotts.com

/Matthew J. Dowd/
Matthew J. Dowd
Reg. No. 47,534
Dowd Scheffel PLLC
1717 Pennsylvania Avenue, NW
Suite 1025
Washington, D.C. 20006
T: (202) 559-9175
F: (202) 204-5877
mdowd@dowdscheffel.com

*Counsel for Patent Owner
Doriamo Ltd.*