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Entered: 16 March 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VOLKSWAGEN GROUP OF AMERICA, INC.,
Petitioner,

v.

EMERACHEM HOLDINGS, LLC,
Patent Owner.

Case IPR2014-01555 (Patent 5,451,558)
Case IPR2014-01556 (Patent 5,953,911)
Case IPR2014-01558 (Patent 5,599,758)

Before FRED E. McKELVEY, JAMES T. MOORE, and
SHERIDAN K. SNEDDEN, *Administrative Patent Judges*.

McKELVEY, *Administrative Patent Judge*.

DECISION
Motions to Submit Corrected Translations
37 C.F.R. § 42.63(b)

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I. Introduction

At the time the Petitions in the above-identified IPRs were filed, Petitioner did not properly file verified translations of Japanese language prior art relied upon in support of the Petitions.

When a document is in a foreign language, and a party intends to rely on the document, the party should submit as a single exhibit (1) a copy of the document in the foreign language, (2) a translation of the document into English and (3) an affidavit attesting to the accuracy of the translation.

37 C.F.R. § 42.63(b). Compliance with § 42.63(b) is mandatory. *Cf. Stevens v. Tamai*, 366 F.3d 1325 (Fed. Cir. 2004) (applying the counterpart interference translation rule 37 C.F.R. § 41.154(b) worded essentially the same as § 42.63(b)).

The affidavit may be in the form of a declaration with an appropriate 18 U.S.C. § 1001 warning. 37 C.F.R. § 1.68.

Translations of the foreign language documents filed by Petitioner did not comply with the necessary requirements.

There came a time when the Patent Owner raised concerns with respect to the foreign language documents.

Following a conference, Judge James T. Moore authorized Petitioner to file a motion to submit corrected exhibits.

Petitioner thereafter filed:

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(1) Petitioner's Motion to Submit a Corrected Exhibit and Maintain Filing Date pursuant to 37 C.F.R. § 41.104(c).
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(2) Petitioner's Motion to File a Verified English Translation of Takeshima et al. PCT Patent Application Publication No. WO 93/07363 A1 (Ex. 1004). IPR2014-01555, Paper 13.

(3) Petitioner's Motion to Submit Two Corrected Exhibits and Maintain Filing Date pursuant to 37 C.F.R. § 42.104(c).
IPR2014-01556, Paper 8.

(4) Petitioner's Motion to Submit a Corrected Exhibit and Maintain Filing Date pursuant to 37 C.F.R. § 42.104(c).
IPR2014-01558, Paper 8.

Patent Owner responded:

(5) Patent Owner's Opposition to Motion to Submit a Corrected Exhibit. IPR2014-01555, Paper 10.

(6) Patent Owner's Opposition to Petitioner's Motion to File a Verified English Translation of Takeshima et al. PCT Patent Application Publication No. WO 93/07363 A1 (Ex. 1004).
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(7) Patent Owner's Opposition to Motion to Submit Corrected Exhibits. IPR2014-01556, Paper 10.

(8) Patent Owner's Opposition to Motion to Submit a Corrected Exhibit. IPR2014-01558, Paper 10.

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In each IPR, Petitioner also filed a declaration of Steven F. Meyer, lead counsel for Petitioner in each involved IPR. IPR2014-01555, Ex. 1014; IPR2014-01556, Ex. 1016; and IPR2014-01558, Ex. 1017.

The declarations explain at great lengths why proper translations inadvertently were not filed with the Petitions.

II. Analysis

We have reviewed the arguments pro and con as presented in the motions and oppositions.

Petitioner maintains that a “clerical mistake” occurred when improper translations were filed. *See, e.g.*, IPR2014-01556, Paper 8, p. 4, 2d full paragraph. Patent Owner disagrees. *See, e.g.*, IPR2014-01556, Paper 10, p. 1 (“On its face, relief under 37 C.F.R. § 42.104(c) is limited to the correction of ‘a clerical or typographical mistake’ in order to maintain the filing date of the petition. However, Petitioner has not established that type of error exists with regard to the translation certificates.”).

For reasons which follow, we decline to analyze the motion on the basis of any “clerical” error.

Central to the efficient administration of IPR cases is our “Policy” and “Conduct of the proceeding” rules.

The “policy” rule provides that Part 42 of 37 C.F.R. “shall be construed to secure the just, speedy and inexpensive resolution of every proceeding.” 37 C.F.R. § 42.1(b).

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The “conduct of proceeding” rule provides that “[t]he Board may waive or suspend a requirement of . . . [part] 42 and may place condition on the waiver or suspension.” 37 C.F.R. § 42.5(b).

The “conduct of proceeding” rule also provides that the Board may accept a paper filed out-of-time “upon a Board decision that consideration on the merits would be in the interests of justice.” 37 C.F.R. § 42.5(c)(3).

Also relevant is 35 U.S.C. § 26 which authorizes the Director to provisionally accept “a defective execution, provided a properly executed document is submitted within such times as may be prescribed.” *See In re Bennett*, 766 F.2d 524 (Fed. Cir. 1985) (en banc) (applying § 26 to permit a corrected reissue oath to be filed after a two-year statutory deadline); *Dietzel v. Commissioner*, 1976 WL 21207, 200 USPQ 665 (D. D.C. 1976); and *Neergaard v. Dann*, 1976 WL 21031, 198 USPQ 525 (D. D.C. 1976).

Properly verified translations were timely submitted in response to orders entered by Judge McKelvey. *See, e.g.*, IPR2014-01555, Paper 14.

The “main events” in an IPR are (1) a merits decision as to whether to institute an *inter partes* review trial, and (2) if a trial is instituted, a merits final written decision.

Procedural “side shows” not affecting the merits, such as a patent owner’s disagreement prior to the time a preliminary response is due over improperly verified translations result in unnecessary expenses on the part of the parties and burden the Board.

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The improper translation issue which arose in this case would best have been settled by a stipulation of the parties to allow submission of corrected verified translations.

No credible prejudice to Patent Owner has been called to our attention and none is remotely apparent.

Patent Owner had translations (albeit technically improperly verified translations) in time to prepare a Preliminary Response.

Moreover, when a Preliminary Response was ultimately filed, Patent Owner elected not to address the merits of the anticipation and obviousness issues raised in the Petitions.

There is no allegation that any translation is not a correct translation.

Today in separate orders we have entered decisions instituting an *inter partes* review trials in each of the three IPRs identified above, as well as related IPR2014-01554 and IPR2014-01557.

We grant the motions to accept the verified translations.

To the extent that there has been any “technical” violation of any rule, the requirements of that rule are waived. 37 C.F.R. § 42.5(b).

To the extent that any verified translation was filed out of time, we find that it is in the interests of justice to consider on the merits the anticipation and obviousness issued raised in the Petitions.

To the extent that any verification was not in proper form, we accept substitute verifications in proper form. 35 U.S.C. § 26.

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In the future our hope is that the parties and the Board will not have to consider motions to correct technical mistakes that can be resolved by way of a stipulation.

Inadvertent mistakes generally not affecting the merits of a case can happen, and should be worked out amicably.

The considerable time spent by the parties and the Board in considering the translation issues in these IPRs should not have been necessary.

Attorneys should be able to recognize submissions of documents that “technically” do not comply with the rules, but which cause no prejudice such that a stipulation to file a corrected document saves all involved time, expense, and other resources—resources which are better directed to the merits of issues before this Board.

III. Order

Upon consideration of the motions and oppositions, and for the reasons given, it is

ORDERED that the motions are *granted*.

FURTHER ORDERED that Petitioner is authorized to file corrected exhibits.

FURTHER ORDERED that the filing date of the three involved IPRs remain unchanged.

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