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Paper 46
Date: November 7, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMMSCOPE TECHNOLOGIES LLC.,
Petitioner,

v.

BELDEN INC.,
Patent Owner.

IPR2023-01061 (Patent 6,998,537 B2)
IPR2023-01062 (Patent 6,570,095 B2)[1]

Before CHRISTOPHER M. KAISER, KIMBERLY McGRAW, and SHARON FENICK, *Administrative Patent Judges.*

McGRAW, *Administrative Patent Judge*.

ORDER
Denying Petitioner's Request for Authorization
to File Supplemental Evidence
37 C.F.R. § 42.5

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[1] This Order applies to each of the listed cases. The parties are not authorized to use this caption for subsequent papers.

I. INTRODUCTION

On October 18, 2024, in each of the above proceedings, Petitioner filed a motion requesting authorization to file, as supplemental evidence, a certification attesting to the accuracy of the English language translation (Ex. 1055[2]) of "Yanagita" (Ex. 1056), a Japanese language prior art reference. Paper 44 ("Mot. For Auth."). Patent Owner filed an opposition thereto. Paper 45 ("Opp."). For the reasons set forth below, Petitioner's request is denied.

II. BACKGROUND

In both proceedings, Petitioner relies on Yanagita, a Japanese Patent Application (Ex. 1056) in its asserted grounds of unpatentability. Petitioner provided, at the time of filing its Petition, two English language translations of Yanagita, (1) a certified translation (Ex. 1012) as well as (2) another translation (Ex. 1055) from the prosecution history files of the patents challenged in these proceedings.

Patent Owner filed a motion to exclude Exhibit 1055, asserting the translation was not certified in accordance with 37 C.F.R. § 42.63(b). Paper 37 ("Mot. To Exclude"); *see also* 37 C.F.R. § 42.63(b) (stating that when a party relies on a document, "a translation of the document into English and an affidavit attesting to the accuracy of the translation must be filed with the document"). Petitioner contends that Patent Owner's motion to exclude Exhibit 1055 should be denied because Patent Owner failed to timely file any objections to evidence under Rule 42.64(b)(1). *See* Mot. for

[2] Unless otherwise indicated, we refer to papers and exhibits in IPR2023-01061. Corresponding documents have been filed in IPR2024-01062.

Auth. 2–3; *see also* 37 C.F.R. § 42.64(b)(1) (stating that if a party moves to exclude evidence, it must have first filed objections within ten business days of institution of the trial so as to allow correction in the form of supplemental evidence).

Petitioner filed the present motion to seeking authorization to file the certification as supplemental evidence as a "potential alterative resolution" to Patent Owner's motion to exclude. Mot. for Auth. 4 (citing *Norman Int'l Inc. v. Andrew J. Testamentary Trust et al.*, IPR2014-00283, Exhibit 2012, 4 and Paper 52, 13–14 (June 18, 2015)). Petitioner asserts that any purported prejudice to Patent Owner from allowing entry of the certification is either *de minimis* or the result of Patent Owner's own actions. In particular, Petitioner asserts that even if Patent Owner does not have an opportunity to depose the translator providing the certification, this is the direct result of Patent Owner's own failure to file objections. *Id.* Petitioner further asserts that any purported prejudice to Patent Owner is *de minimis* because (i) Patent Owner did not seek to depose any of the translators that provided other certifications that Petitioner filed, (ii) the certification for Exhibit 1055 comes from the same third party translation service that provided the other certifications that Petitioner filed, (iii) Patent Owner submitted Exhibit 1055 to the Patent Owner in an IDS, (iv) Exhibit 1055 is in the prosecution histories of the challenged patents, (v) Patent Owner used Exhibit 1055 in other proceedings without objection, and (vi) Patent Owner has not clearly identified anything materially inconsistent between the translations, Exhibit 1055 and Exhibit 1012. *Id.* at 4–5. Petitioner also argues that there was no need for Petitioner to have filed the certification earlier because Patent Owner did not file post-institution objections. *Id.* at 5.

Patent Owner asserts that it timely filed an objection to Exhibit 1055 in accordance with Rule 42.61(b)(1) by objecting to the exhibit in its Preliminary Response, which is within ten business days of institution. *See* Opp. 4 (asserting pre-institution objections to evidence are proper). Patent Owner further asserts that the record is closed and that allowing submission of supplemental evidence at this stage is improper, untimely, and unfairly prejudicial. Opp. 3. Patent Owner states that Petitioner, having filed certifications for other translations in this proceeding, was aware that a certification of Exhibit 1055 was required under Rule 42.63(b) and that Petitioner has not provided an explanation as to why it did not obtain a certification of Exhibit 1055 earlier. *Id.* 3–4.

Patent Owner also asserts that allowing supplementation of the record with the new certification would unfairly prejudice Patent Owner because Patent Owner cannot conduct discovery, including deposing the translator that provided the certification or retaining its own Japanese language expert to opine on the "now dueling certifications of differing translations." *Id.* at 4. Patent Owner also asserts that allowing Petitioner to introduce evidence after the record is closed would violate the Administrative Procedure Act by failing to provide Patent Owner with proper notice and opportunity to supply evidence in response. *Id.* at 5.

III. ANALYSIS

We disagree with Petitioner that allowing it to file a certification as to the accuracy of Exhibit 1055 is a suitable alterative resolution to Patent Owner's motion to exclude. Rather, we agree with Patent Owner that, in this case, it is too late for Petitioner to file supplemental evidence. This proceeding is at a very late stage. Oral argument was held on September 23,

2024. The parties dispute whether Yanagita discloses or suggests claim limitations of the challenged patents and the language of the two English translations differ from one another. *See, e.g.*, Ex. 1080, 25 (Cornelison Declaration), 25 (providing a chart comparing the language between Exhibits 1012 and 1055); *see also* Ex. 1012, 1 (stating a "large number of strands of insulated wires or pairs thereof or quad strands, or units thereof, are twisted together so as to reverse the direction of twisting thereof with given periodicity") *with* Ex. 1055, 1 (stating "a plurality of either insulated element wires or else stranded pairs or stranded quad of such, or otherwise to use so-called alternatedly stranded cable with which units of the wires are stranded in a manner so that the stranding direction is reversed at points in time within a fixed cycle").

It would be unfair to Patent Owner to allow into the record, a certification that attests to the accuracy of a document without permitting Patent Owner the opportunity to depose the certifying translator and/or introduce rebuttal evidence as to the accuracy of the translation. Petitioner's arguments that any prejudice to Patent Owner would be *de minimis* are not persuasive. Mot. for Auth. 4–5. Petitioner does not sufficiently explain why a party's choice not to depose a translator attesting to the accuracy of one particular translation means no prejudice could arise from preventing that party from deposing a different translator attesting to the accuracy of a *different* translation, even if both translators worked for the same company. Additionally, the fact that an un-certified English translation was used in one proceeding does not preclude a party from challenging the accuracy of that translation in another proceeding or change the requirements of 37 C.F.R. § 42.63(b). As such, Petitioner's request for authorization to file

supplemental evidence is denied. An Order addressing Patent Owner's Motion to Exclude will issue in due course. *See Office Consolidated Trial Practice Guide,* 79 (Nov. 2019)[3] (stating that generally, the Board waits until after the oral hearing, when it reviews the record in its entirety, to decide the merits of any motions to exclude).

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner's request for authorization to file a certification of accurate translation of Exhibit 1055 as supplemental evidence is denied.

[3] Available at www.uspto.gov/TriaPracticeGuideConsolidated.

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