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To: [Jakopin, David A.](#); [Trials](#)
Cc: [Michael Neustel](#); Scott.McKeown@WolfGreenfield.com; [Monte Bond](#); darien@imperiumpw.com; Lester@imperiumpw.com
Subject: RE: Omega Liner Co. v. Buergofol GmbH (IPR2023-01372) ('882)- Patent Owner seeking authorization to submit certified translations of previously submitted exhibits
Date: Thursday, January 16, 2025 3:04:48 PM

Counsel,

The Board will issue an order in due course that addresses the outstanding matters raised in the email below.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Jakopin, David A. <david.jakopin@pillsburylaw.com>
Sent: Thursday, January 16, 2025 1:08 PM
To: Trials <Trials@USPTO.GOV>
Cc: Michael Neustel <michael@neustel.com>; Scott.McKeown@WolfGreenfield.com; Monte Bond <monte@neustel.com>; darien@imperiumpw.com; Lester@imperiumpw.com
Subject: Omega Liner Co. v. Buergofol GmbH (IPR2023-01372) ('882)- Patent Owner seeking authorization to submit certified translations of previously submitted exhibits

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Dear Honorable Board,

I am counsel for Patent Owner Buergofol GmbH in the above-captioned IPR matter. Patent Owner respectfully requests the Board's authorization to file a Motion to Correct and file certified translations of Exhibits 2036, 2037, 2038, and 2039 (the "Exhibits"). Patent Owner has conferred with Petitioner regarding submission of certified translations of the Exhibits, and the following represents the parties' respective positions.

Patent Owner's Position:

As initially filed, the Exhibits consisted of machine translations of German language emails.

As indicated in Patent Owner's Opposition, the Exhibits were recently discovered, and the fact that they were machine translations did not become apparent to Patent Owner until after the documents were uploaded and filed. Patent Owner confirmed the following day on January 8, 2025 that the Exhibits were indeed machine translations, and immediately arranged for certified translations of those Exhibits. Patent Owner has now obtained the certified translations of the Exhibits in question and kindly requests the Board's authorization for their submission.

The substance and meaning of the machine translations and certified translations of the

Exhibits is unchanged. Some small grammatical changes have been made in the certified translations that do not affect meaning. Below is a table with comparisons of the machine translations with the certified translations.

Exhibit Number	Machine Translation	Certified Translation
EX2036, pg. 2	"He speaks of incidents in the form of tears. Do we have any complaints?"	"He says there have been tearing incidents. Have we had any complaints?"
EX2037, pg. 1	"The you don't know this (see below) yet?"	"Then you haven't even heard about this yet (see below)?"
EX2038, pg. 1	"informed of the 'blanket complaints' about film tears when removing"	"informed of 'general complaints' about film tears when removing"
EX2039, pg. 3	"However, the film must not separate too well because it could fall onto the very hot UV lamp after the compressed air is released and catch fire"	"It is also important, however, for the film to not separate too well because after the compressed air is released, the film could fall onto the very hot UV lamp and catch fire"

The Board's rules and precedent support authorization to file the certified translations. For example, 37 C.F.R. § 42.64(b)(1) gives a party a chance to cure deficient evidence within 5 business days of an objection. *Toyota Motor Corp. v. American Vehicular Sciences, LLC*, IPR2013-00421, Paper 15 at 23 (P.T.A.B. Jan 13, 2014) as shown in the following quotation: "*Patent Owner contends that Petitioner did not submit an affidavit or declaration, as required by the Board's rules, to authenticate properly its submitted translation of Ashauer. We agree. Within ten business days of institution of trial, Patent Owner must file an objection to evidence to evidence under 37 C.F.R. §42.64(b)(1), and within ten business days of filing that objection, Petitioner may file supplemental evidence under 37 C.F.R. 42.64(b)(2) to cure any deficiency.*"

Further, there have been multiple issued orders addressing this issue and authorizing the submission of certified translations. *See e.g., Volkswagen Grp. Of Am. v. Emerachem Holdings, LLC*, IPR2014-01556, Paper 18 at 7 (P.T.A.B. Mar. 16, 2015) (granting a Motion to Correct three missing Certificates of Accuracy and two missing translations because it would not prejudice the opposing party and admonishing the opposing party for focusing on the technical imperfections of the substantially sufficient translations and refusal to stipulate to a waiver of the requirements without Board involvement); *and Lumentum Holdings, Inc. v. Capella Photonics, Inc.*, IPR2015-00739, Paper 38 at 3-5 (P.T.A.B. Mar. 4, 2015) (precedential) (stating in parenthetical "that the requirements of 35 U.S.C. § 312(a) are not jurisdictional and may be cured).

Petitioner's Position:

Petitioner takes no position on PO's request. Also, for clarity of the record, Petitioner did not and will not oppose PO's first Motion to Substitute (Paper 76) filed earlier this week (albeit without the Board's authorization).

Respectfully submitted,

David A. Jakopin | Partner

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