

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HANSHOW AMERICA INC. AND HANSHOW
TECHNOLOGY CO., LTD.,

Petitioner,

v.

SES-IMAGOTAG INC.,

Patent Owner.

Case No. IPR2024-00189

Patent No. 10,674,340

PATENT OWNER'S MOTION TO EXCLUDE EVIDENCE

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	BACKGROUND.....	1
III.	EXHIBITS 1013 THROUGH 1021.....	4
	A. Exhibits 1013 Through 1021 Should Be Excluded Because They Were Filed More than a Year Late.....	4
	B. Exhibits 1018 Through (Original) 1021 Are Not Attested To By Someone With Knowledge And Are Not Made Under Penalty Of Perjury	8
	C. “Updated” Exhibit 1021 Is Untimely And Defective .	10
	D. The Exhibits Prejudice PO And Are Irrelevant	10
IV.	EXHIBITS 1024 THROUGH 1027.....	12

EXHIBIT LIST

Exhibit	Reference
2001	Declaration of Rajeev Surati, Ph.D., in Support of Patent Owner's Response
2002	Curriculum Vitae of Rajeev Surati, Ph.D.
2003	U.S. Patent No. 8,049,621 (the "'621 patent")
2004	U.S. Patent No. 7,949,568 (the "'568 patent")
2005	U.S. Patent No. 7,957,998 (the "'998 patent")
2006	Kumar et al., Overview of RFID Technology and Its Applications in the Food Industry, 74 J. FOOD SCIENCE 8 (2009) ("Kumar")
2007	Rohde & Schwarz, Near Field Communication (NFC) Technology and Measurements, White Paper (2011) ("Rohde")
2008	ISO/IEC 14443-2 (2010)
2009	ISO/IEC 15693-2 (2006)
2010	Alva, A seminar report on Near Field Communication, S.D.M COLLEGE OF ENGINEERING AND TECHNOLOGY, DHARWAD (2010) ("Alva")
2011	ISO/IEC 18092 (2004)
2012	ECMA-340 (2004)
2013	U.S. Pat. No. 6,002,344 ("Bandy-344")
2014	Excerpt of Meriam-Webster's Collegiate Dictionary, 11 th ed. (2014)
2015	U.S. Patent No. 8,923,893 (the "'893 patent")
2016	Edwin Bergsma, Planogram Data Requirements, Global Retail Business Solutions (2011)

Patent Owner's Motion to Exclude Evidence

Exhibit	Reference
2017	“Planograms 101: What They Are and Why They’re Important for Your Brand,” ePac (2024) (available at https://epacflexibles.com/en-gb/planograms-101-what-they-are-and-why-theyre-important-for-your-brand/) (last accessed Aug. 26, 2024)
2018	Erwin Bergsma, Analyzing your first planogram, Global Retail Business Solutions (Aug. 2015)
2019	Violino and Roberti, The History of RFID Technology, RFID J. (Jan. 16, 2005) (“Violino”) (2005)
2020	U.S. Patent Application Publication No. 2010/0190484 (the “484 publication”)
2021	U.S. Patent No. 7,809,402 (the “’402 patent”)
2022	U.S. Patent No. 7,546,948 (the “’948 patent”)
2023	Masao Ohta & Yoshiyuki Higuchi, Study on the Design of Supermarket Store Layouts: The Principle of “Sales Magnet,” 7 Int’l J. of Econ. Mgmt. Eng. 209 (2013)
2024	Deposition transcript of Dr. Emmanouil M. Tentzeris (“Tentzeris Dep. Tr.”)
2025	Opposition against European Patent 3 883 277
2026	Google translation of JP2014/222374
2027	Affidavit of Grant E. Kinsel
2028	Deposition transcript of Dr. Emmanouil M. Tentzeris (“Tentzeris Reply Dep. Tr.”) (Jan. 7, 2025)
2029	Email chain with the Board dated March 5, 2024, and May 14, 2014
2030	Email chain between J. Kaiser and H. Tan dated November 28-29, 2024
2031	Email chain with the Board dated December 18-19, 2024

I. INTRODUCTION

Pursuant to 37 C.F.R. §42.64, Patent Owner (“PO”) moves to exclude: Exhibits 1013 through 1021 (which were filed more than a year late¹) and Exhibits 1024 through 1027 (which are foreign language documents and English translations that do not comply with the Board’s rules).

Objections to Petitioners’ evidence were timely raised in PO’s Evidentiary Objections filed December 9, 2024 (Paper 27).

II. BACKGROUND

Petitioners filed their Petition and Exhibits 1001 through 1009 on November 14, 2023. *See* Paper 1 (“Pet.”). As explained in PO’s Preliminary Response (Paper 10, (“POPR”)) on February 28, 2024, Exhibit 1003 was filed with a deficient declaration that was not signed by an individual with personal knowledge and did not include the statutorily required statement under penalty of perjury. POPR, 10-11 (citing 37 C.F.R. §42.2 and 37 C.F.R. §1.68). A week later, on March 5, Petitioners requested to file a corrected Exhibit 1003, and Board responded on May 14 that it

¹ Further, Exhibits 1019, 1021, 1025, and 1027 are translations of foreign patents, and the affidavits accompanying the translations do not comply with 37 C.F.R. §42.63(b). This also renders the original foreign language documents irrelevant (Exhibits 1018, 1020, 1024, and 1026).

Patent Owner's Motion to Exclude Evidence

would “address this issue in due course.” Ex-2029, 1. In the Decision Granting Institution, the Board conditionally exercised its “discretion to waive requirements under 37 C.F.R. Part 42.” Paper 11 (“DI”), 14 (May 20, 2024). The Board noted, however, that the error was “not typographical” and the “declaration failed to comply with [the] rules.” *Id.* Petitioner filed a corrected exhibit on May 21, 2024. Thus, following the Board’s decision to institute trial, Petitioners were plainly on notice of the Board’s requirements for declarations accompanying translations.

On September 6, 2024, PO filed its Patent Owner Response. Paper 21 (“POR”). PO noted that “Petitioners and/or their expert identify several background references that were not submitted as exhibits” and that “[a]ny reliance on unsubmitted references is improper” under §42.63(a). *Id.*, 10 n.1; *see also* Ex-2001 ¶¶5, 54. At 10:30 P.M. MT on Thanksgiving Day, Petitioners asked PO to agree to the filing of nine new exhibits in this proceeding. Ex-2030, 1-2. PO responded the next day, stating that it was unsure what Petitioners were asking it to agree to, but that PO could not agree to Petitioners submitting evidence into the record over a year after Petitioners admittedly knew about such evidence, and particularly without having seen Petitioners’ Reply in this proceeding. *Id.*, 1.

On December 2, 2024, Petitioners filed their Reply (Paper 26) along with exhibits including the nine new exhibits referenced in their Thanksgiving Day email (Exhibits 1013 through 1021). Petitioner did not request Board authorization prior

Patent Owner's Motion to Exclude Evidence

to filing these exhibits. These exhibits were not cited in the Reply—either by the name of the underlying document or by the exhibit number. The underlying document numbers were only cited in Petitioners' expert's original declaration (Ex-1009), which was filed on November 14, 2023, over a year earlier.

Also on December 2, 2024, Petitioners filed two foreign language patents and accompanying translations (Exhibits 1024 through 1027).

On December 3, 2024, without requesting authorization, Petitioners filed "Updated Exhibit 1021," reusing the same exhibit number.

PO timely objected to Exhibits 1013 through 1021 (including "updated" Exhibit 1021) and Exhibits 1024 through 1027 on December 9, 2024. Paper 27.

On December 18, 2024, two weeks after filing the Reply, Petitioners emailed the Board and requested that the Board "authorize the late filing of Exhibits 1013 through 1021 [including updated exhibit 1021]." Ex-2031, 3-4. The Board responded that if PO "subsequently files a Motion to Exclude, we will rule on such a Motion at an appropriate time." *Id.*, 1.

Petitioners rely on Exhibits 1013 through 1021 to support their expert's opinion that a POSITA would have modified the prior art to use near field communication

("NFC").² Petitioners do not cite the references or exhibits in their papers directly; rather they rely on Exhibits 1013 through 1021 only by citing to several paragraphs in their expert's declaration, including the Background section of his declaration, that refer to the exhibits by patent or publication number. Petitioners also appear to rely on Exhibits 1013 through 1021 in their Reply by alluding to "*other* references cited by its expert for certain NFC advantages." Reply, 25 (emphasis in original).

Petitioners rely on Exhibits 1024 through 1027 in their Reply regarding NFC antenna design to support their argument that Bandy's antenna is compatible with NFC. Reply, 20-21 (citing Ex-1032, ¶¶22-37, including Exhibits 1025 and 1027 cited in paragraphs 26 and 34).

III. EXHIBITS 1013 THROUGH 1021

A. Exhibits 1013 Through 1021 Should Be Excluded Because They Were Filed More than a Year Late

All evidence relied on in an IPR "must be filed in the form of an exhibit." 37 C.F.R. §42.63(a). Petitioners are required to file an exhibit "with the first document

² See, e.g., Pet. 5 (citing Ex-1009, ¶¶46-49), 19 (citing Ex-1009, ¶¶69-70), 28 (citing Ex-1009, ¶¶46-53, 93), 39 (citing Ex-1009, ¶113), 47 (citing Ex-1009, ¶135), 56 (citing Ex-1009, ¶162), 67 (citing Ex-1009, ¶188), 71 (citing Ex-1009, ¶195), 78 (citing Ex-1009, ¶¶211-12), 87, (citing Ex-1009, ¶240), 92 (citing Ex-1009, ¶¶247-49).

Patent Owner's Motion to Exclude Evidence

in which it is cited except as the Board may otherwise order.” 37 C.F.R. §42.6(c).

“The importance of following the Board’s rules with regard to filing exhibits cannot be overstated. Filing documents as exhibits serves at least two important functions. First, exhibits present evidence that...is not subject to change or removal because it is stored in the Office’s electronic filing system.” *Sophos Ltd. v. Open Text Inc.*, IPR2023-00732, Paper 23, 13 (Nov. 2, 2023). A second reason “is to provide public access to the record of the case.” *Id.*, 14.

Here, Petitioners have not complied with the Board’s rules. As explained above, Petitioners waited until a year after filing the Petition (and almost three months after the POR, which specifically noted this issue) to ask PO to agree to Petitioners submitting “references named in Prof. Tentzeris’s Declaration (Ex. 1009) as new exhibitions.” Ex-2030, 1-2. Then, instead of conferring with PO and contacting the Board to request authorization to file a motion to submit supplemental information, Petitioners unilaterally filed these exhibits with their Reply. Two weeks later, having failed to ask for permission, Petitioners then asked the Board for forgiveness. Ex-2031, 3-4.

The Board should exclude Exhibits 1013 through 1021 based on Petitioners’ lengthy and unexplained delay. *See Nuna Baby Essentials, Inc. v. Britax Child Safety, Inc.*, IPR2018-01683, Paper 11, 8-9 (Dec. 18, 2018) (denying petitioner’s motion to excuse late filing because “Petitioner has not established good cause to excuse the

late filing or that consideration on the merits would be in the interests of justice” and expunging the late filed exhibits); *Sophos*, IPR2023-00732, Paper 23, 19.

Petitioners were required to request authorization to file a motion to submit the exhibits because the supplemental information was submitted more than thirty days after trial was instituted. 37 C.F.R. §42.123(b). Furthermore, Petitioners were required to “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.” *Id.* A late action, such as a filing of an exhibit, “will be excused on a showing of good cause or upon a Board decision that consideration on the merits would be in the interests of justice.” 37 C.F.R. §42.5(c)(3). Petitioners do not proffer good cause to excuse their untimely filings, nor could they. Ex-2031, 3-4. Instead, Petitioners make excuses flatly contradicting the record that “due to inadvertence (including multiple same-day filings, e.g., Exhibits 1018, 1019, 1020, 1021 were filed on the same date of the Petition in a separate proceeding by Petitioner, IPR2024-00190), Petitioner failed to file them in accordance with the requirements of 37 CFR 42.6(c).” *Id.*, 3. First, this explanation does not address all the exhibits because Exhibits 1013 through 1017 were not filed in IPR2024-00190. Second, even considering these specific exhibits, Exhibit 1019 includes an updated certification dated November 27, 2024, and Exhibit 1021 (updated) includes an updated certification dated December 3, 2024. Thus, these exhibits were not filed in their

current form with the petition in IPR2024-00190 (filed Nov. 14, 2023). And third, Petitioners provided no explanation for why they waited one year.

Rather than relying on good cause, Petitioners cite 37 C.F.R. §42.5(c)(3) and *Walmart Inc. v. Caravan Canopy Int'l, Inc.*, IPR2020-01026, Paper 48, 2 (Sept. 17, 2021), asking the Board to find that “consideration [of the exhibits] on the merits would be in the interests of justice.” Ex-2031, 3. But *Walmart* is distinguishable. Unlike the petitioner in *Walmart* (IPR2020-01026, Paper 48, 2), Petitioners here never requested authorization to file the exhibits, much less the “updated” version of Exhibit 1021. Instead, Petitioners filed the exhibits out of time without notifying the Board or PO, clearly contrary to the rules.

Petitioners also incorrectly stated in their email that “although Patent Owner has objected to these exhibits, it did not challenge the substantive use by Petitioner[s'] expert of them, either in its Preliminary Response or in its Response...” Ex-2031, 3. That is not correct because PO's Response expressly noted this issue. POR, 10 n.1.

Petitioners do not explain their one-year delay in addressing this issue after filing the Petition and the three-month delay after PO raised it in its Response. When filing an IPR, “the responsibilities of [Petitioners'] counsel include reviewing documents uploaded during this proceeding and, if necessary, notifying the Board of a mistake, inconsistency, or error in a timely manner.” *Conmed Corp. v. Bonutti*

Skeletal Innov. LLC, IPR2013-00624, Paper 18, 8 (Feb. 21, 2014). Even a cursory review of the file (before or after PO's Response) would have alerted counsel for Petitioners that the exhibits were not on file. *See Nuna Baby Essentials*, IPR2018-01683, Paper 11, 7 (denying petitioner's motion to excuse late filing in part because petitioner was on notice of the error).

B. Exhibits 1018 Through (Original) 1021 Are Not Attested To By Someone With Knowledge And Are Not Made Under Penalty Of Perjury

With respect to documents that are not in English, 37 C.F.R. §42.63(b) requires "a translation of the document into English" and that "an affidavit attesting to the accuracy of the translation [] be filed with the document." The "Certification of Translation" included with Exhibits 1019 and (original) 1021 does not satisfy 37 C.F.R. §42.63(b), and noncompliance with the rules renders the translations inadmissible. 37 C.F.R. §42.61(a).

Specifically, the declarations do not appear to be signed by someone with personal knowledge and original Exhibit 1021 does not include the required statement under penalty of perjury. *See* 37 C.F.R. §42.2 (defining "affidavit" as "affidavit or declaration under §1.68 of this chapter. A...declaration under 28 U.S.C. 1746 may be used as an affidavit."); 37 C.F.R. §1.68 ("Declaration in lieu of oath" requires "the declarant is on the same document, warned that willful false statements and the like are punishable by fine or imprisonment, or both"); 28 U.S.C. §1746 (An

unsworn declaration can be used for an affidavit if the statement is “subscribed by [the author], as true under penalty of perjury....”).

Exhibits 1019 and (original) 1021 (and Exhibits 1018 and 1020)³ should be excluded because the “affidavits” are defective. Regarding Exhibit 1019, the declarant states that the “translation was performed and edited by a Japanese to English professional translator.” However, the declarant does not identify himself as the translator or as an individual who can translate Japanese to English. Thus, the declarant certifying Exhibit 1019 is a “true and accurate translation, and has the same meaning as the text of the [Exhibit 1018],” is meaningless, especially because he makes this certification “to the best of my knowledge and belief.” Moreover, the certification in Exhibit 1019 expressly disclaims responsibility for “error or negligence in translation or transcription.”

Regarding (original) Exhibit 1021, the declarant does not swear to the required statement under penalty of perjury at all. The declarant further does not identify the translator and makes the same “knowledge and belief” certification.

Without the required affidavit attesting to the accuracy of the translation, PO and the Board are left guessing as to the substance of the foreign language document.

³ Without the required translations the original language documents are irrelevant. Consolidated Trial Practice Guide, 24 (November 2019).

Moreover, the error was *again* “not typographical” and the “declaration[s] failed to comply with [the] rules.” *See* DI, 14.

C. “Updated” Exhibit 1021 Is Untimely And Defective

Despite having more than a year to obtain a proper affidavit, Petitioners filed original Exhibit 1021 with a clearly defective affidavit. *See* §III.B, *supra*. In an attempt to rectify their mistake, Petitioners filed “updated” Exhibit 1021 on December 3, 2024, the day after filing their Reply, without requesting authorization. Petitioners’ repeated flaunting of the rules should not be condoned.

In addition, Petitioners have reused the exhibit number 1021 in filing the “updated” exhibit, and Petitioners did not properly serve the exhibit on PO, thus confusing the record and prejudicing PO. 37 C.F.R. §§42.6(d), (e)(4). For this reason alone, the Board should exclude “updated” Exhibit 1021. *See Zodias Pool Sys., Inc. v. Aqua Prods., Inc.*, IPR2013-00159, Paper 40, 5 (Feb. 26, 2014) (expunging a corrected declaration because of the “lack of authorization before Patent Owner’s filing” of the exhibit); *LG Elecs. Inc. v. 3G Licensing S.A.*, IPR2018-00559, Paper 10, 1-2 (July 17, 2018) (expunging amended declaration filed without authorization and with a previously used exhibit number).

D. The Exhibits Prejudice PO And Are Irrelevant

As explained above, Petitioners have not once cited to Exhibits 1013 through 1021 in any paper. Although Petitioners’ expert may have referenced the underlying

Patent Owner's Motion to Exclude Evidence

patents and patent application publications by patent or publication number in his declaration accompanying the Petition (Ex-1009, ¶¶46-51, 148), PO is still prejudiced by Petitioners not making the exhibits available at the time of filing the Petition. For example, Petitioners' expert misnumbered "U.S. Patent App. Pub. No. 2012/059741."⁴ And four of the unfiled exhibits are foreign patents with purported translations. But none of these references were filed until Petitioners' Reply. Thus, PO was prejudiced by not having access to Exhibits 1013 through 1021, including translated foreign patents and the misnumbered publication, until after PO's Response was due. Even so, Petitioners' expert further testified in deposition that the exhibits were irrelevant and duplicative. Ex-2028, 73:3-74:8, 77:23-25, 79:15-21. Withheld, irrelevant, and duplicative exhibits should be excluded (and expunged) from this proceeding.

⁴ The reference is still misnumbered in the Reply and Ex-1032. Reply, "Exhibit List"; Ex-1032, 3. Without the correct publication number, PO had no way to know for certain what the correct reference was. PO's expert guessed that the correct number was 2012/0059741, (Ex-2001, ¶5 n.1), but PO's expert's correct supposition does not excuse the prejudice caused to PO by not having access to the exhibits upon which Petitioners relied.

Petitioners' expert also testified that he did not review Exhibit 1019 (and presumably 1021), but rather he reviewed "unofficial" translations that he no longer has. Ex-2028, 79:15-21. PO has therefore been prejudiced, in particular, by Exhibits 1019 and 1021 since they are in a foreign language and the translations were not made available to PO. PO had no chance to review the unofficial or official translations before filing its Response to determine any changes or discrepancies in the documents. *Sophos*, IPR2023-00732, Paper 23, 13-14 ("Changes in the evidence like this call into question the reliability of that evidence.").

For the above further reasons, the Board should exclude and expunge Exhibits 1013 through 1021 because they are irrelevant and prejudice PO.

IV. EXHIBITS 1024 THROUGH 1027

As with Exhibit 1019, Exhibits 1025 and 1027 have defective affidavits. First, the declarant is not identified as the translator, and she has not attested that she is qualified to translate from Chinese to English. Thus, the declarant certifying that each of Exhibits 1025 and 1027 is a "true and accurate translation, and has the same meaning as the text of the [exhibit]," is meaningless, especially because she makes this certification "to the best of my knowledge and belief." Second, the certification expressly disclaims liability for responsibility for "error or negligence in translation or transcription." Thus, for the reasons stated above in Section III.B, the Board

Patent Owner's Motion to Exclude Evidence
should exclude Exhibits 1025 and 1027 and the original foreign language patent
(Exhibits 1024 and 1026).

January 27, 2025

Respectfully submitted,

By: / Jessica C. Kaiser /

Jessica C. Kaiser

Reg. No. 58,937

Lead Counsel for Patent Owner

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that on January 27, 2025, a copy of **PATENT OWNER'S MOTION TO EXCLUDE EVIDENCE** was served upon the below-listed counsel by electronic mail:

Hao Tan
haotan@archlakelaw.com

Shen Wang
shenwang@archlakelaw.com

Christopher J. Fahy
christopher@archlakelaw.com

Dated: January 27, 2025

By: / Jessica C. Kaiser /
Jessica C. Kaiser
Reg. No. 58,937
Lead Counsel for Patent Owner