

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

Petitioners,

v.

SES-IMAGOTAG GMBH,

Patent Owner.

Case No. IPR2024-00189

Patent No. 10,674,340

**PETITIONERS' OPPOSITION TO
PATENT OWNER'S MOTION TO EXCLUDE EVIDENCE**

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I. INTRODUCTION

Patent Owner's motion relies on an overly stringent (and erroneous as to the requirements of 37 CFR § 42.63(b)) reading of the procedural rules in seeking to exclude Exhibits 1013 through 1021 and 1024 through 1027 (Paper 35). However, ample precedents, including Board decisions cited by Patent Owner itself, support the admissibility of Petitioner's evidence. Patent Owner's motion should be denied.

II. EXHIBITS 1013 THROUGH 1021

First, Patent Owner seeks to exclude Exhibits 1013 through 1021 as late-filed. Paper 35, at 4-8, 10. As Petitioners explained in their December 18, 2024 email to the Board (included in Ex. 2031), Petitioners realized their mistake in relation to the late-filing, however, such late action "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 CFR § 42.5(c)(3). Indeed, the Board has excused similar late actions when the consideration of late filing is outweighed by "the benefit of having a clearer record on which to consider the merits of the issues." *See Walmart Inc. v. Caravan Canopy Int'l., Inc.*, IPR2020-01026, Paper 48 (Sep. 17, 2021), at 2.

Patent Owner cites *Sophos Ltd. v. Open Text Inc.*, IPR2023-00732, Paper 23, 13 (Nov. 2, 2023) and *Nuna Baby Essentials, Inc. v. Britax Child Safety, Inc.*, IPR2018-01683, Paper 11, 8-9 (Dec. 18, 2018) for the propositions that it is important to follow the rules and that the Board can exercise its discretion in not excusing late actions. Paper 35, at 5-6. However, in both of these cases, the Board provided the offending party with at least one more opportunity to correct the record before, faced with continued non-compliance by the party, resorting to the drastic measure of exclusion. *See Sophos Ltd.*, Paper 23, at 13 ("Despite Petitioner not filing the

webpage links as exhibits [], we gave Petitioner the opportunity to correct this error and ordered Petitioner to file late copies of these webpage links as exhibits by September 22, 2023. . . . Petitioner declined to do so.”); *Nuna Baby Essentials*, Paper 11, at 5 (“Petitioner was given an opportunity to remedy the error. . . . Had Petitioner responded within allotted time, the error would have been corrected.”).

The current case presents no such recalcitrancy as to justify exclusion. Petitioners proactively reached out to Patent Owner and to the Board in an effort to correct the record, and, unlike the offending parties in *Sophos Ltd.* and *Nuna Baby Essentials*, never willfully disregarded the Board’s instructions.

The Board has discretion under 37 CFR § 42.5(c)(3) to allow the exhibits and “has routinely allowed petitioners to correct mistakes in petition filings, including the failure to properly upload exhibits.” *Nuna Baby Essentials*, Paper 11, at 5. Contrary to Patent Owner’s assertions, such exercise of discretion here would not prejudice Patent Owner. While Patent Owner noted the issue in its Response (Paper 21, at 10 n.1), Patent Owner nowhere argued against the substance of the opinion by Petitioners’ expert formed by considering, in part, these challenged exhibits. In fact, while Petitioners’ expert considered some of these challenged exhibits in his discussion of the POSITA’s background knowledge of NFC technology and of its advantages, he referred to them in conjunction with other unchallenged exhibits such as Arntzen (Ex. 1005) and the standard ISO/IEC 14443 (filed by *Patent Owner* itself as Ex. 2008). *See* Ex. 1009, ¶¶47-49. Patent Owner never argued substantively against the existence of such background knowledge. Further, Patent Owner has always been on notice of the existence of

these exhibits (being patents and patent publications, with proper identification numbers¹).

Patent Owner further argues that these exhibits are irrelevant and duplicative. Paper 35, at 11. If they indeed were irrelevant and duplicative, then the late filing could not have prejudiced Patent Owner. In addition, the deposition testimony from Petitioners' expert does not support Patent Owner's position. In the testimony, Petitioners' expert explained that these references "added some more information to corroborate my opinion expressed in my original declaration." Ex. 2028, at 73:13-14. He further testified that he would not have cited to a document if he did not review it. *Id.* at 87:20-22. Thus, they are clearly relevant. Furthermore, these exhibits are not "duplicative" of any other exhibits. Patent Owner may mean that these exhibits are cumulative within the meanings of Fed. Rule Evid. 403, but Rule 403 does not call for an automatic exclusion of all cumulative evidence, instead, it only authorizes discretion to exclude them if their probative value is substantially outweighed by the cumulative-ness. Conclusory statements in its objection to evidence (Paper 27) aside, Patent Owner failed to address the balancing test as required by Rule 403 and its ipse dixit assertion of "duplicative"-ness is not a proper basis for exclusion.

Patent Owner also argues that the late filing of Exhibits 1019 and 1021, translations of Japanese patent documents, prejudiced Patent Owner because it had no chance to review the translations and could not determine any changes or discrepancies in the translations. Paper 35, at

¹ Patent Owner argues that identifying Ex. 1013 as "U.S. Patent App. Pub. No. 2012/059741 A1" instead of using "the correct number" of "2012/0059741" prejudices Patent Owner in that such "misnumber[ing]" prevents Patent Owner from "know[ing] for certain what the correct reference was." Paper 35, at 11 n.4. Petitioners respectfully submit that a variation in the number of leading zeroes is unlikely to have such a drastic effect. In addition, Petitioners' expert only referred to this reference as showing the existence of NFC standards such as ISO/IEC 14443. Ex. 1009, ¶46. Patent Owner itself filed such standards as Exhibits 2008 and 2009.

12. However, Petitioners' expert testified that there was no change between the versions he reviewed and the filed versions. Ex. 2028, at 82:11-13. Further, the translations were filed on the same date of the Petition (November 14, 2023) in the companion case 2024-00190 (concerning the same patent and between the same parties) as Exhibits 1008 and 1004, respectively. Therefore, Patent Owner had notice of these translations and opportunity to review them. In addition, Patent Owner never argued substantively against the opinion formed by Petitioners' expert regarding these two exhibits, namely, POSITA's background knowledge of the use of RFID for precise indoor location finding (Ex. 1009, ¶51) or of an electronic shelf label possessing two communication sections controlled by a same CPU (Ex. 1009, ¶148). Patent Owner has not shown prejudice from the late filing of these translations.

Accordingly, Petitioners respectfully ask the Board, in consideration of the interests of justice that would be better served by having a clearer record, and also in consideration of the lack of prejudice to Patent Owner, to exercise its discretion under 37 CFR § 42.5(c)(3) in Petitioners' favor and excuse the late filing of Exhibits 1013-1021.

III. UPDATED EXHIBIT 1021

Patent Owner further seeks to exclude updated Exhibit 1021 as untimely and defective. Paper 35, at 10. The original Exhibit 1021 carried an affidavit that Petitioners recognized as unsatisfactory, however, despite Petitioners' best efforts to reach the translation service provider, Petitioners were unable to obtain an updated affidavit by December 2, 2024. In a good faith effort to correct the record as best as they could, Petitioners filed the original Exhibit 1021 with the rest of the late-filed exhibits. On the next day, after obtaining the updated affidavit, Petitioners promptly filed the updated Exhibit 1021.

For the same reasons as discussed above for Exhibits 1013 through 1021, Petitioners respectfully ask the Board to exercise its discretion under 37 CFR § 42.5(c)(3) in Petitioners' favor and excuse the late filing of the updated Exhibit 1021. Further, even if the Board decides that the particular filing method for the updated Exhibit 1021 (reusing the same exhibit number) is unsatisfactory, Petitioners respectfully ask the Board to grant Petitioners another chance to file this exhibit in a correct fashion, as the Board did for the offending party in *Zodias Pool Sys., Inc. v. Aqua Prods., Inc.* (a case cited by Patent Owner itself). See IPR2013-00159, Paper 40, 5 (Feb. 26, 2014) (expunging the incorrectly filed exhibits but authorizing the offending party to refile after correction).

IV. THE AFFIDAVITS ACCOMPANYING EXHIBITS 1018, 1019, AND 1024 THROUGH 1027

Patent Owner further seeks to exclude Exhibits 1018, 1019 and Exhibits 1024 through 1027 on the allegation that Exhibits 1019, 1025 and 1027 have defective affidavits. Paper 35, at 8-10, 12-132. However, Patent Owner fails to identify any authority for its positions that the affidavits required by 37 CFR § 42.63(b) must be signed by someone who identifies himself to be a translator or as an individual who can translate the language, or that the affidavits cannot disclaim responsibility for error or negligence. See Paper 35, at 9, 12.

² Patent Owner also seeks to exclude Exhibits 1020 through original 1021 with the same arguments it set forth regarding the affidavit accompanying the original Exhibit 1021. Paper 35, at 8-10. However, Patent Owner's argument regarding these exhibits is moot, because it, by refraining from challenging the updated Exhibit 1021 on this ground, apparently tacitly acknowledges that the affidavit accompanying the updated Exhibit 1021 is compliant with the rules.

37 CFR § 42.63(b) requires “an affidavit attesting to the accuracy of the translation.” The relevant statutes and regulations require that “[t]he declarant [] set forth in the body of the declaration that all statements made of the declarant's own knowledge are true and that all statements made on information and belief are believed to be true” under penalty of perjury. 37 CFR § 1.68; see also 28 U.S.C. § 1746. The requirements alleged by Patent Owner are found nowhere in the statutes and regulations.

Patent Owner appears to argue that failure to conform with its alleged requirements negates the personal knowledge of the signer. Paper 35, at 8. However, Patent Owner has not identified any authority for this position. In addition, language employed in these affidavits, such as “[t]his is to certify that the attached documents in the English language with the above title are a true and accurate translation” and “[t]his translation was performed and edited by a Chinese to English professional translator” (Ex. 1027, at 1), clearly shows personal knowledge of the signer.

The Board has rejected arguments similar to those of Patent Owner in *Uber Technologies, Inc. v. X One, Inc.*, IPR2017-01264, Paper 48, 35-37 (October 12, 2018). In *Uber Technologies*, the petitioner filed various translations each preceded by an affidavit containing language such as “I, [declarant], hereby certify that [the document] is, to the best of my knowledge and belief, a true and accurate translation from [source language] into English” and further identifying a different translator than the declarant. E.g. IPR2017-01264, Ex. 1010, at 1. The patent owner in *Uber Technologies*, like Patent Owner here, argued that the affidavits were deficient. IPR2017-01264, Paper 48, at 35. The Board, however, correctly pointed out that “Rule 42.63 does not specify which individuals may provide such an affidavit.” *Id.* at 36. The Board further held that “[e]vidence to prove personal knowledge may consist of the witness’s own testimony” and that “these statements [in the affidavits], which are made on the letterhead of the translation company, contain sufficient

indicia to support the admissibility of the affidavit because they specifically identify the document translated, the languages the document is translated to and from, the person that translated the documents, and the purported experience of that translator.” *Id.* In addition, the Board held that “[i]n this context, lack of personal knowledge in making an averment. . . pertains to credibility of the witness, not inadmissibility of evidence as hearsay.” *Id.* at 37. Accordingly, the Board refused to exclude the challenged evidence on the basis of the declarant’s identity. *Id.* at 36-37.3

The current case is no different. The challenged affidavits contain sufficient indicia to support the admissibility, and the identity of the declarant is not a proper basis for excluding the evidence. Patent Owner’s arguments should be rejected.

In addition, Patent Owner failed to “identify the grounds for the objection with sufficient particularity to allow correction in the form of supplemental evidence” as required by 37 CFR § 42.64(b)(1), and thereby forfeited this objection. See *Abbott Diabetes Care Inc. f/k/a TheraSense, Inc. v. DexCom, Inc.*, IPR2022-00922, Paper 42, 31-32 (Nov. 2, 2023). Patent Owner generally objected to each of the relevant exhibits “because the declaration does not appear to be signed by someone with personal knowledge and is thus irrelevant and not admissible (F.R.E. 401, 402) or its probative value is substantially outweighed by other considerations under F.R.E. 403, including unfair prejudice, confusion of the issues, and waste of time.” See e.g. Paper 27, at 13-14. However, this language does not identify Patent Owner’s grounds for the objection with sufficient particularity because it does not state or even hint at Patent Owner’s position that an affidavit not

³ While the affidavits in *Uber Technologies*, unlike the ones that Patent Owners are challenging now, omitted the required penalty of perjury language, the Board also refused to exclude the evidence on that ground, because the Board found that this deficiency was remedied by the later filing of compliant affidavits. IPR2017-01264, Paper 48, at 37-38.

signed by the translator (or someone who can translate the language) or containing a disclaimer would not be considered “signed by someone with personal knowledge.” Petitioners would not know, based on such boilerplate language, how to make any correction (if indeed needed) in the form of supplemental evidence. See *Abbott Diabetes Care Inc.*, Paper 42, at 31 (“Petitioner’s boilerplate objection is woefully insufficient to show that Petitioner objected with sufficiently particularity to allow correction in the form of supplemental information, as our Rule requires.”).

Furthermore, even if the Board would find that a differently worded affidavit or an affidavit signed by a different person would be preferable, Petitioners respectfully ask the Board, in consideration of Petitioner’s good faith effort to comply with the affidavit requirement of 37 CFR § 42.63(b), to exercise its discretion under 37 CFR § 42.5(b) and allow Petitioners to correct the filings, as the Board has done in this case (Paper 11, at 14). See also *Liquidia Technologies, Inc. v. United Therapeutics Corporation*, IPR2020-00770, Paper 45, 58 (October 8, 2021) (refusing to exclude purported translation unaccompanied by any affidavit); *Uber Technologies*, Paper 48, at 37-38 (finding that a late filing of compliant affidavits remedied alleged deficiencies in the original ones).

V. CONCLUSION

For at least the above reasons, Petitioners respectfully ask the Board to deny Patent Owner’s Motion to Exclude Evidence.

Dated: February 3, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

In accordance with 37 C.F.R. § 42.6(e), the undersigned certifies that true copies of the **PETITIONERS' OPPOSITION TO PATENT OWNER'S MOTION TO EXCLUDE EVIDENCE** was served electronically on February 3, 2025, in its entirety on the following counsel of record for Patent Owner:

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