

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CUB ELECPARTS INC.,
Petitioner,

v.

ORANGE ELECTRONIC CO., LTD.,
Patent Owner.

IPR2024-00744
Patent 8,031,064 C3

Before PATRICK R. SCANLON, KEVIN C. TROCK, and
AMBER L. HAGY, *Administrative Patent Judges*.

SCANLON, *Administrative Patent Judge*.

ORDER

Denying Petitioner's Motion for Leave to Substitute Exhibits
37 C.F.R. §§ 42.5(c)(3), 42.20

With our prior authorization, CUB Elecparts Inc. (“Petitioner”) filed a Motion for Leave to Substitute Exhibits. Paper 8 (“Mot.”). Orange Electronic Co., Ltd. (“Patent Owner”) filed an Opposition to Petitioner’s Motion. Paper 11 (“Opp.”).

For the reasons discussed below, we *deny* Petitioner’s Motion without prejudice. Petitioner is authorized to file a Motion for Leave to File New Exhibits, as explained below.

I. BACKGROUND

Petitioner filed a Petition (Paper 2, “Pet.”) requesting an *inter partes* review of claims 1–19 of U.S. Patent No. 98,031,064 C3 (Ex. 1001) on April 4, 2024. Several exhibits, including Exhibits 1005 and 1009, were filed with the Petition. Exhibit 1005 is a Japanese patent publication accompanied by an English translation. Exhibit 1009 is an English translation of an invalidation opinion from the Taiwan Patent Office. Petitioner, however, did not file an affidavit attesting to the accuracy of either translation, as required by 37 C.F.R. § 42.63(b).

Patent Owner subsequently filed a Preliminary Response (Paper 6, “Prelim. Resp.”) in which Patent Owner argued that Exhibits 1005 and 1009 are inadmissible and should not be considered because the translations were not certified. Prelim. Resp. 23–24, 43–44, 56. On August 21, 2024, without explanation or leave from the Board, Petitioner filed a second version of Exhibit 1005, accompanied by an English translation and a certification attesting to the accuracy of the translation. On August 27, 2024, via an email to the Board, Patent Owner objected to the filing of Exhibit 1005 on August 21, 2024. *See* Ex. 2013, 2. Then on August 28, 2024, again without leave from the Board, Petitioner filed a third version of Exhibit 1005,

accompanied by an English translation and a certification attesting to the accuracy of the translation, and a second version of Exhibit 1009, accompanied by a certification attesting to the accuracy of that Exhibit's translation.

On August 30, 2024, the Board sent an email to the parties indicating that the multiple copies of Exhibits 1005 and 1009 filed by Petitioner rendered the record of this proceeding unclear. *See* Ex. 2013, 1. The Board indicated that it would “treat Petitioner’s filings as a request for leave to file a motion to substitute exhibits.” *Id.* The Board directed that “Petitioner shall file a motion to substitute new exhibits for the originally filed versions of Exhibits 1005 and 1009,” and “Petitioner’s motion should address why the proposed substitutions are warranted, differences between the updated exhibits and the originally filed versions of Exhibits 1005 and 1009, and which files should be expunged to provide a clear record.” *Id.* The Board also authorized Patent Owner to file an opposition to Petitioner’s motion. *Id.*

II. DISCUSSION

Petitioner requests that original Exhibit 1005 (filed April 4, 2024) be replaced with new Exhibit 1010 and original Exhibit 1009 (filed April 4, 2024) be replaced with new Exhibit 1011. Mot. 3. Petitioner asserts that Exhibit 1010 comprises the same Japanese patent publication as Exhibit 1005 and a certified English translation of the Japanese patent publication, and Exhibit 1011 comprises an English translation of the same invalidation opinion from the Taiwan Patent Office as Exhibit 1009 and includes a translation certification. *Id.* at 2. According to Petitioner, the machine translation of Exhibit 1005 and the new certified translation of Exhibit 1010

“are nearly identical,” and “[t]he translations differ only with respect to grammatical changes due to the large difference between Japanese grammar (in which the verb is positioned at the end of the sentence) and English grammar.” *Id.* at 3. Petitioner asserts that Exhibit 1011 is identical to Exhibit 1009 except for the addition of the translator’s certification of the translation. *Id.* Petitioner is requesting the substitution “to provide a more complete record.” *Id.* at 3–4.

In its Opposition, Patent Owner argues that late filings are allowed only upon a showing of good cause or where consideration on the merits would be in the interests of justice, but Petitioner fails to offer an explanation for its request to replace original Exhibits 1005 and 1009 with new Exhibits 1010 and 1011. Opp. 1 (citing 37 C.F.R. § 42.5(c)(3); Mot. 2 21; Ex. 2013). Patent Owner argues that there is not good cause for the requested substitution, asserting that “Petitioner fails to explain why its original exhibit Ex-1005 was improperly filed as an unauthenticated and uncertified machine translation, in plain violation of the rules. Nor does Petitioner allege that it could not have complied with the Board’s rules when filing the Petition.” *Id.* (citations omitted). Patent Owner also argues that Petitioner’s assertion that it “is requesting the substitution in order to provide a more complete record” does not establish that the requested substitution is in the interests of justice. *Id.* (citing Mot. 3–4).

Furthermore, Patent Owner argues that, instead of completing or clarifying the record, Petitioner’s request has the opposite effect of further complicating the record. *Id.* at 2. For instance, Patent Owner contends that the Motion does not indicate clearly whether the several versions of Exhibits 1005 and 1009 are to be expunged. *Id.* Patent Owner also contends that the

requested substitution would create inconsistencies in the record; specifically, “the Petition and Patent Owner’s Preliminary Response both cite to Ex-1005 and Ex-1009, and do not cite to the later Ex-1010 and Ex-1011,” and “[b]oth papers also quote passages from the original Ex-1005, which are not reflected verbatim in the replacement Ex-1010.” *Id.* (citing Ex. 1005 ¶ 34; Ex. 1010 ¶ 34; Prelim. Resp. 56–57; Pet. 51).

We find Patent Owner’s arguments persuasive. Petitioner does not establish adequately good cause for the proposed substitution, nor does Petitioner explain adequately why the proposed substitution would be in the interests of justice. *See* Mot. 1–4; 37 C.F.R. § 42.5(c)(3). Petitioner merely states that the proposed substitution would “provide a more complete record” but does not address in detail why the substitution is warranted, as directed by the Board in its email of August 30, 2024. Mot. 3–4; Ex. 2013, 1. In addition, Petitioner’s assertions of large differences in Japanese and English grammar (*see* Mot. 3) do not justify sufficiently the variances between the originally-filed translation of Exhibit 1005 and the translation of new Exhibit 1010.

More troubling are the contradictions in the record the proposed substitution would create. As Patent Owner notes, the Petition and the Preliminary Response both cite to Exhibits 1005 and 1009, but not Exhibits 1010 and 1011. *See* Opp. 2. Replacing Exhibits 1005 and 1009 with Exhibits 1010 and 1011, respectively, would thus badly muddle the record.

For these reasons, Petitioner’s Motion is denied. We note, however, that Petitioner indicates that “[i]n the alternative, as the current translator has indicated that the original translation is technically accurate, Petitioner can provide a certification for the originally-filed machine translation regarding

its accuracy if this is more acceptable to the Board and in order to minimize any potential prejudice to the Patent Owner.” Mot. 3. Under these circumstances, we are persuaded that it is in the interests of justice for the Board to have such a certification of the translation included with original Exhibit 1005 (filed April 4, 2024), as well as a certification of the translation of original Exhibit 1009 (filed April 4, 2024), because such certifications are relevant to Petitioner’s assertions that the challenged claims are unpatentable.

We thus authorize Petitioner to file a Motion for Leave to File New Exhibits. This new Motion should request authorization to file: (1) a new exhibit (presumably to be identified as Exhibit 1012) comprising an affidavit attesting to the accuracy of the translation included with original Exhibit 1005 (filed April 4, 2024); and (2) another new exhibit (presumably to be identified as Exhibit 1013) comprising an affidavit attesting to the accuracy of the translation of original Exhibit 1009 (filed April 4, 2024). Petitioner should file the proposed new Exhibits with the new Motion. The new Motion should also address whether the versions of Exhibit 1005 filed on August 21, 2024, and August 28, 2024, the version of Exhibit 1009 filed on August 28, 2024, and Exhibits 1010 and 1011 should be expunged. Petitioner shall provide its reasoning if maintaining that any of these Exhibits should not be expunged. The new Motion is limited to four pages and is due within five business days of the date of this Order.

Patent Owner is authorized to file an Opposition to Petitioner’s new Motion. The Opposition is limited to four pages and is due within five business days of the new Motion being filed.

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner's Motion for Leave to Substitute Exhibits is *denied*;

FURTHER ORDERED that Petitioner is authorized to file a four-page Motion for Leave to File New Exhibits, as described above, within five business days of the date of this Order; and

FURTHER ORDERED that Patent Owner is authorized to file a four-page Opposition to Petitioner's Motion for Leave to File New Exhibits within five business days of Petitioner's Motion for Leave to File New Exhibits being filed.

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