

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

138 EAST LCD ADVANCEMENTS LIMITED,
Patent Owner.

IPR2024-00958
U.S. Patent 8,482,638

**PETITIONER'S MOTION TO EXCLUDE PATENT OWNER'S
EXHIBITS 2001 AND 2003**

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	MOTION TO EXCLUDE AND EVIDENTIARY REQUIREMENTS	1
	A. 37 C.F.R. § 42.63(b).....	2
	B. Routine Discovery	2
III.	EXHIBITS 2001 AND 2003 SHOULD BE EXCLUDED	3
	A. Exhibits 2001 and 2003 Should be Excluded for Failure to Comply with the Board’s Rules and the Federal Rules of Evidence	4
	B. Patent Owner’s Attempts to Shift the Burden Are Unsupported	7
IV.	CONCLUSION.....	9

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Abbott Vascular, Inc. v. FlexStent, LLC</i> , IPR2019-00882, Paper 48 (PTAB Oct. 2, 2020).....	3, 5, 6
<i>Adobe Inc. v. RAH Color Techs. LLC</i> , IPR2019-00627, Paper 124 (PTAB Aug. 31, 2020).....	3, 5, 6
<i>HTC Corp. v. NFC Tech., LLC</i> , IPR2014-01198, Paper 41 (PTAB Nov. 6, 2015).....	3, 5, 6
<i>Navistar, Inc. v. Fatigue Fracture Tech. LLC</i> , IPR2018-00853, Paper 58 (PTAB Aug. 29, 2019).....	3, 5
<i>Square, Inc. v. REM Holdings 3, LLC</i> , IPR2014-00312, Paper 58 (PTAB July 7, 2015).....	7
Rules	
FRE 602	1, 2, 5, 6
FRE 801	6, 7
FRE 802	6, 7
FRE 901	1, 4, 5, 6
Regulations	
37 C.F.R. § 42.61(a).....	7
37 C.F.R. § 42.62(a).....	2, 7
37 C.F.R. § 42.63(b)	<i>passim</i>
Other Authorities	
Consolidated Trial Practice Guide (Nov. 2019)	2, 3, 5, 6

I. INTRODUCTION

The Board should exclude Patent Owner's Exhibits 2001 and 2003 under 37 C.F.R. § 42.63(b), FRE 602, FRE 901, and the Consolidated Trial Practice Guide, because the declarant of Exhibit 2003 lacks personal knowledge as to the accuracy of the alleged translation presented as Exhibit 2001. The declarant is not the translator and does not speak Japanese (the language of the source document). Indeed, the declarant's supervisor acknowledged that the declarant lacks the ability to identify errors or confirm the accuracy of the translation. Patent Owner also failed to produce this declarant for deposition, which deprived Petitioner of the opportunity to depose him on the accuracy of the translation. Moreover, the declarant's supervisor, who was produced for deposition, also does not speak Japanese (the source language), further precluding Petitioner from being able to obtain cross-examination testimony regarding the substance. Patent Owner failed to comply with 37 C.F.R. § 42.63(b) because the certification in Exhibit 2003 is not reliable and the declarant was not made available for cross-examination. Exhibit 2003 should be excluded. Without the required certification, Exhibit 2001 should also be excluded.

II. MOTION TO EXCLUDE AND EVIDENTIARY REQUIREMENTS

A Motion to Exclude must (a) identify where in the record the objection originally was made; (b) identify where in the record the evidence sought to be

excluded was relied upon by an opponent; (c) address objections to exhibits in numerical order; and (d) explain the basis and grounds for each objection.

Consolidated Trial Practice Guide¹ (“CTPG”) 79.

A. 37 C.F.R. § 42.63(b)

The Board’s rules require that, “[w]hen a party relies on a document or is required to produce a document in a language other than English, a translation of the document into English and an affidavit attesting to the accuracy of the translation must be filed with the document.” 37 C.F.R. § 42.63(b). A declarant “may testify to a matter only if evidence is introduced sufficient to support a finding that the witness has personal knowledge of the matter.” FRE 602 (emphasis added); *see* 37 C.F.R. § 42.62(a) (“**Generally.** Except as otherwise provided in this subpart, the Federal Rules of Evidence shall apply to a proceeding.”).

B. Routine Discovery

The Consolidated Trial Practice Guide identifies routine discovery for IPR proceedings as including “the cross-examination of the other side[’]s declarants,” requires that “a party presenting a witness’s testimony by affidavit should arrange

¹ *Available at*

<https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf?MURL=TrialPracticeGuideConsolidated>.

to make the witness available for cross-examination,” and explains that this requirement “applies to witnesses employed by a party as well as experts and non-party witnesses.” CTPG 23. The Board interprets this to mean that the party proffering a declaration to support its positions is obligated to secure attendance of the declarant for deposition when requested and must make that declarant available for cross-examination. *Abbott Vascular, Inc. v. FlexStent, LLC*, IPR2019-00882, Paper 48, at 34 (PTAB Oct. 2, 2020); *Adobe Inc. v. RAH Color Techs. LLC*, IPR2019-00627, Paper 124, at 23-24 (PTAB Aug. 31, 2020); *HTC Corp. v. NFC Tech., LLC*, IPR2014-01198, Paper 41, at 4-5 (PTAB Nov. 6, 2015). When a declarant is not made available for cross-examination, the Board excludes the corresponding declarations and affidavits and, in some instances, deems the declaration inadmissible. *Abbott Vascular*, IPR2019-00882, Paper 48, at 34; *Adobe*, IPR2019-00627, Paper 124, at 23-24; *HTC*, IPR2014-01198, Paper 41, at 4-5. When a translation lacks a proper supporting declaration, the Board also excludes the corresponding translation. *Navistar, Inc. v. Fatigue Fracture Tech. LLC*, IPR2018-00853, Paper 58, at 55-56 (PTAB Aug. 29, 2019).

III. EXHIBITS 2001 AND 2003 SHOULD BE EXCLUDED

With respect to Exhibits 2001 and 2003, Patent Owner seeks to evade the Board’s rules on several levels: (1) by failing to provide a declarant with knowledge of the translation who could be questioned about its substance, (2) by

failing to produce the declarant for cross-examination, (3) by producing a replacement witness incapable of attesting to the accuracy of the translation, and (4) by attempting to shift the burden onto Petitioner to identify inaccuracies in the translation after depriving Petitioner of the opportunity to cross-examine the declarant about those exact issues.

A. Exhibits 2001 and 2003 Should be Excluded for Failure to Comply with the Board’s Rules and the Federal Rules of Evidence

Patent Owner argues that the substitute claims in its Revised Motion to Amend are entitled to priority to Japanese Patent App. No. 2009-295202 (Ex. 2002, “the priority application”). Paper 22 (“RevMTA”) 4 (July 28, 2025). Exhibit 2003 is a certificate of translation for Exhibit 2001, the purported English translation of the priority application. RevMTA 4. Petitioner objected to Exhibit 2001 for failing to comply with 37 C.F.R. § 42.63(b) because it lacked the required certification of accuracy. Paper 10 (Mar. 31, 2025). Patent Owner then filed Exhibit 2003, which fails to cure the deficiencies of Exhibit 2001. Petitioner objected to Exhibit 2003 as also failing to comply with 37 C.F.R. § 42.63(b) and FRE 901. Paper 12 (Apr. 9, 2025).

Exhibit 2003 should be excluded because it fails to comply with 37 C.F.R. § 42.63(b) and FRE 901 because the declarant does not have personal knowledge as to the accuracy of the translation—undisputably cannot testify to its accuracy—

and was not produced for deposition. Once the Board excludes Exhibit 2003, it should also exclude Exhibit 2001 for failing to comply with 37 C.F.R. § 42.63(b) because the record lacks an affidavit attesting to the accuracy of the translation. *Navistar*, IPR2018-00853, Paper 58, at 55-56.

Because the priority application is in Japanese, Patent Owner must submit a translation and an affidavit or declaration of someone with personal knowledge attesting to the accuracy of the translation. 37 C.F.R. § 42.63(b); FRE 602; FRE 901. Patent Owner was also obligated to produce that declarant for deposition. CTPG 23; *Abbott Vascular*, IPR2019-00882, Paper 48, at 31-36; *Adobe Inc.*, IPR2019-00627, Paper 124, at 23-24; *HTC Corp.*, IPR2014-01198, Paper 41, at 4-5.

The certificate of translation (Ex. 2003) is signed by Oscar Ojeda, a Project Manager for Morningside Translations, who testifies that “[t]o the best of [his] knowledge, the aforementioned documents are a true, full and accurate translation of the specified documents.” Ex. 2003. Mr. Ojeda is not the person who translated the priority application into English and is not capable of verifying the accuracy or correctness of the translation because he does not speak Japanese. Ex. 1023, 16:10-17:1. Mr. Ojeda’s supervisor confirmed that Mr. Ojeda is not able to determine if there were inaccuracies or errors in the translation or whether the translation is accurate. Ex. 1023, 16:10-17:1. Accordingly, Mr. Ojeda does not and cannot have

personal knowledge as to the accuracy of the translation in violation of the Federal Rules of Evidence and the Board's rules. FRE 602; FRE 901; 37 C.F.R. § 42.63(b).

Exhibit 2003 should also be excluded because Patent Owner disregarded its routine discovery obligations and did not produce Mr. Ojeda for a deposition. Ex. 1027, 1-2; CTPG 23; *Abbott Vascular*, IPR2019-00882, Paper 48, at 34; *Adobe Inc.*, IPR2019-00627, Paper 124, at 23-24; *HTC Corp.*, IPR2014-01198, Paper 41, at 4-5. Without an opportunity to cross-examine Mr. Ojeda, his declaration is inadmissible hearsay under FRE 801 and 802. *Adobe Inc.*, IPR2019-00627, Paper 124, at 23-24. Patent Owner also did not produce the actual translator for a deposition. *See generally* Ex. 1027. Instead, Patent Owner produced Samuel Wu, the Managing Director of Morningside Translations, who did not prepare the translation, does not speak Japanese, and cannot attest to the accuracy of the translation. Ex. 1023, 14:15-17. Nor did Mr. Wu submit a substitute declaration attesting to the accuracy on which he could be deposed. Accordingly, Mr. Wu could not testify as to the accuracy of the translation. *See generally* Ex. 1023.

Moreover, Mr. Wu ***admitted*** that Mr. Ojeda was unable to testify to the accuracy of the translation and thus ***admitted*** that he could not answer questions as to accuracy if asked. Ex. 1016, 20:2-21:1. Patent Owner's gamesmanship to (1) put forth a declarant who Patent Owner knew could not testify to the translation's accuracy, (2) refuse Petitioner the opportunity to ask the testifying declarant about

the translation's accuracy, and (3) put forth another deponent who admitted that the original declarant could not testify to the translation's accuracy and could not himself address any questions as to the translation's accuracy renders the rules meaningless in this context.

Neither Mr. Ojeda's nor Mr. Wu's representations that the translations are accurate are based on statements by the actual translator. But even if they were, the translator's statements are inadmissible hearsay under FRE 801 and 802 and Mr. Ojeda and Mr. Wu cannot rely on them in this proceeding. 37 C.F.R. § 42.62(a).

Exhibit 2003 should be excluded.

Because Patent Owner failed to provide a declaration or affidavit of someone with personal knowledge reliably attesting to the accuracy of Exhibit 2001, Exhibit 2001 should also be excluded. 37 C.F.R. §§ 42.61(a), 42.63(b). *See Square, Inc. v. REM Holdings 3, LLC*, IPR2014-00312, Paper No. 58, at 33-36 (PTAB July 7, 2015) (excluding an exhibit because translation was not accompanied by an affidavit as required by 37 C.F.R. § 42.63(b)).

B. Patent Owner's Attempts to Shift the Burden Are Unsupported

Patent Owner alleges, contrary to the Board's rules, Petitioner bore a burden to identify inaccuracies in the translations both *before* the declarants would be made available for deposition and also *after* Patent Owner denied Petitioner the opportunity to question the declarant about such inaccuracies. *See* RevMTA 24;

Ex. 1027. Patent Owner improperly attempts to burden-shift to Petitioner by alleging that Petitioner must identify inaccuracies in the translation even though Patent Owner bears the burden of accuracy under the FRE and the Board's rules. *See id.* The purpose of producing the witness for cross-examination is so Petitioner can ask questions about the accuracy of the translation. Petitioner was deprived of this opportunity because the replacement deponent **admitted** that he does not speak Japanese and cannot answer such questions and **admitted** that the original declarant could not either. Ex. 1023, 14:15-17, 16:10-17:1.

Patent Owner's gamesmanship in (1) putting forth a declarant who Patent Owner **knew** could not testify to the translation's accuracy, (2) refusing Petitioner the opportunity to ask the testifying declarant about the translation's accuracy, (3) putting forth another deponent who admitted that the original declarant could not testify to the translation's accuracy and could not himself address any questions as to the translation's accuracy, and (4) **then** alleging that Petitioner—after being denied the opportunity to question the declarant about the translation's accuracy as **required** by the Board's rules—should have undertaken some other procedure not required by the Board's rules, effectively renders the rules meaningless.

Accordingly, Exhibits 2001 and 2003 must be excluded.

IV. CONCLUSION

For the foregoing reasons, the Board should exclude Patent Owner's Exhibits 2001 and 2003.

Respectfully submitted,

Dated: October 13, 2025

/Kevin D. Rodkey/

Kevin D. Rodkey
Backup Counsel for Petitioner
Reg. No. 65,506

CERTIFICATE OF COMPLIANCE

The undersigned hereby certifies that the foregoing **Petitioner's Motion to Excludes Patent Owner's Exhibits 2001 and 2003** contains 15 pages or less, excluding those portions identified in 37 C.F.R. § 42.24(b), as measured by the word-processing system used to prepare this paper.

Dated: October 13, 2025

/Kevin D. Rodkey/
Kevin D. Rodkey
Backup Counsel for Petitioner
Reg. No. 65,506

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **Petitioner's Motion to Exclude** was served on October 13, 2025, via email directed to counsel of record for the Patent Owner at the following:

Cyrus A. Morton
CMorton@RobinsKaplan.com

Samuel J. LaRoque
SLaRoque@RobinsKaplan.com

Aaron R. Fahrenkrog
AFahrenkrog@RobinsKaplan.com

Emily J. Tremblay
ETremblay@RobinsKaplan.com

William R. Jones
WJones@RobinsKaplan.com

Derrick J. Carman
DCarman@RobinsKaplan.com

Dated: October 13, 2025

/Lisa C. Hines/

Lisa C. Hines
Case Manager
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, LLP