

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

138 EAST LCD ADVANCEMENTS LIMITED,
Patent Owner.

Case No. IPR2024-00958
U.S. Patent No. 8,482,638

**PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION TO
EXCLUDE**

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I. INTRODUCTION

The Board should deny Petitioner’s motion to exclude Patent Owner’s Exhibits 2001 and 2003.¹ Petitioner argues that the Certificate of Translation is defective because it was not signed by someone with personal knowledge of the translation (*e.g.*, the translator). But the Board has previously held that a certification under 37 C.F.R. § 42.63(b) does not need to be signed by someone with personal knowledge. *Globus Medical, Inc. v. Moskowitz Family LLC*, IPR2020-01306, Paper 7 at 20, (PTAB Jan. 8, 2021) (“Our rules require a translation, but do not require the certification to be signed by someone with personal knowledge of the translation.”). Therefore, the Certificate of Translation complies with the Board’s rules.

Patent Owner also complied with its Routine Discovery obligations by providing a representative of the translation company that Patent Owner hired, Morningside Translations (“Morningside”), for deposition. Petitioner admits that it had the opportunity to and did depose a representative from Morningside. Moreover, Petitioner does not identify any alleged error in the translation provided,

¹ EX2001 is an English translation of EX2002 (JP App. No. 2009-295202).

EX2003 is the Certification of Translation as required by 37 C.F.R. § 42.63(b).

such that its accuracy and credibility may reasonably be called into question.

Petitioner's motion should be denied.

II. EXHIBIT 2003 COMPLIES WITH THE BOARD'S RULES AND THE FEDERAL RULES OF EVIDENCE.

Petitioner's motion is premised entirely on alleged deficiencies in EX2003, the Certificate of Translation. *See* Paper 34 at 5 ("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."). Thus, Petitioner's arguments regarding EX2001 are entirely derivative of its challenges to EX2003. Petitioner does not and cannot identify any alleged error or inaccuracy in EX2001, the translation, itself. Therefore, Patent Owner's Opposition is directed to the alleged deficiencies in EX2003.

A. Exhibit 2003 Complies with 37 C.F.R. § 42.63(b), and FRE 901 Is Inapplicable.

Petitioner asserts that Exhibits 2001 and 2003 should be excluded because the Certification (EX2003) was not signed by a person with personal knowledge of the translation. Paper 34 at 5. Petitioner's argument fails because Petitioner attempts to impose a "personal knowledge" requirement on the declarant under 37 C.F.R. § 42.63(b) that is not present and conflicts with the Board's past holdings.

The Board has previously rejected Petitioner's argument that 37 C.F.R. § 42.63(b) imposes a personal knowledge requirement on a declarant signing a

Certificate of Translation. *Globus*, IPR2020-01306, Paper 7 at 20; *Xilinx, Inc. v. Good Kaisha IP Bridge 1*, IPR2017-00842, Paper 36 at 2, (PTAB Jun. 7, 2018) (“Although it may have been ideal for Mr. Sly’s certification to expressly state the basis of his personal knowledge regarding the accuracy of the translation in the certification, there is not an express requirement in the rules that he do so.”). As noted in *Globus*, under 37 C.F.R. § 1.68, a declaration may be based on “information and belief.” *Globus*, IPR2020-01306, Paper 7 at 20. Here, EX2003 states that the declaration is being made “to the best of my knowledge.” EX2003 at 1; Paper 34 at 5. In other words, EX2003 is made based on information and belief by the declarant, in compliance with 37 C.F.R. § 42.63(b). Because 37 C.F.R. § 42.63(b) does not require that EX2003 be signed by the translator or one with personal knowledge of the translation’s accuracy and EX2003 is made on information and belief as permitted by 37 C.F.R. § 1.68, EX2003 complies with 37 C.F.R. § 42.63(b).

Globus is particularly instructive as it presents a nearly identical set of facts. In *Globus*, the petitioner submitted a Certificate of Translation under 37 C.F.R. § 42.63(b) signed by a “a Project Manager at Morningside IP.” *Id.* at 19. The same is true here, as Petitioner admits. EX2003; Paper 34 at 5 (“The certificate of translation (Ex. 2003) is signed by Oscar Ojeda, a Project Manager for

Morningside Translations.”). Additionally, the Certificate of Translation in *Globus* was made “to the best of [the declarant’s] knowledge.” *Globus*, IPR2020-01306, Paper 7 at 20. Again, the same is true here. EX2003; Paper 34 at 5. Finally, in *Globus*, the Board noted that the movant “d[id] not offer any argument or evidence that the translation is inaccurate, such that we should afford the translation little weight. *Globus*, IPR2020-01306, Paper 7 at 20. Again, the same is true here. *See generally*, Paper 34 (failing to raise any substantive issue with the translation provided in EX2003). Petitioner is likely to try to distinguish *Globus* based on the fact that *Globus* was an institution decision, and not based on a motion to exclude. But none of the rationale provided in *Globus* turned on the state of the proceeding. And Petitioner cannot provide any rationale as to why the requirements under § 42.63(b) would change post-institution.

Petitioner’s reliance on FRE 901 is similarly misplaced. Petitioner asserts that FRE 901 requires a declaration be made by one with personal knowledge. Paper 34 at 5. Petitioner admits, however, that the Federal Rules of Evidence apply “except as otherwise provided in this subpart.” *Id.* at 2. As noted above (and in *Globus*) 37 C.F.R. § 42.63(b) permits Certificates of Translation to be made by affidavit *or* declaration, and 37 C.F.R. § 1.68 permits declarations made before the office to be made based on information and belief. *Globus*, IPR2020-01306, Paper

7 at 20. Thus, FRE 901's personal knowledge requirement does not apply to Certificates of Translation because the Board's rules specify otherwise.

B. Patent Owner Complied with Its Routine Discovery Obligations.

Petitioner argues that Patent Owner failed to comply with its Routine Discovery obligations by failing to provide Mr. Ojeda (the declarant of EX2003) for deposition. Petitioner is incorrect.

Mr. Ojeda signed EX2003 in his capacity as a project manager at Morningside, the translation company hired by Patent Owner to translate EX2001. Patent Owner produced Mr. Wu, Mr. Ojeda's supervisor at Morningside, to testify regarding the declaration as the representative for Morningside. Petitioner accepted and conducted that deposition. Further, Petitioner did not file a motion to compel the deposition of Mr. Ojeda (or the translator), either under the rules of routine discovery or of additional discovery.

Because Patent Owner produced a representative of Morningside Translation, the company that performed the translations and signed the Certificate of Translation, Patent Owner complied with its discovery obligations.

C. Petitioner's Cited Cases Are Inapposite.

Petitioner cites several inapposite cases in support of its motion to exclude. *First*, Petitioner cites to *Abbott Vascular, Inc. v. FlexStent, LLC*, IPR2019-00882, Paper 48 at 34 (PTAB Oct. 2, 2020) for the proposition that a declarant must be

produced for deposition. Paper 34 at 3, 5, 6. As noted above, Patent Owner did make a representative of Morningside available for deposition, and Petitioner did take that deposition. Moreover, *Abbott* is factually distinct in multiple ways. In *Abbott*, the declaration at issue was not a Certificate of Translation, but a declaration relating to scientific testing. Indeed, the Board excluded the declaration, in part, due to the scientific nature of the declaration and the applicability of the expert testimony factors listed in 37 C.F.R. § 42.65. *Abbott*, IPR2019-00882, Paper 48 at 35. No such concerns are present here as neither Mr. Ojeda nor the translator performed any scientific testing. Further, in *Abbott*, the absent declarant spoke with the Patent Owner's expert, and was a participant in related district court proceedings, thereby undermining any claim that the Patent Owner could not make them available for testimony. *Abbott*, IPR2019-00882, Paper 48 at 34. Neither Mr. Ojeda nor the translator has spoken with Patent Owner, its experts, nor participated in any other proceedings. Thus, *Abbott* is inapposite.

Second, Petitioner relies on *Adobe Inc. v. RAH Color Techs. LLC*, IPR2019-00627, Paper 124 at 23-24 (PTAB Aug. 31, 2020) for the same proposition as *Abbott*. Paper 34 at 3, 5, 6. *Adobe* is equally unavailing. In *Adobe*, the petitioner relied on a declaration to authenticate certain references and substantiate their date of publication. That witness, however, refused to appear for deposition. *Adobe*,

IPR2019-00627, Paper 124 at 18. Here, Patent Owner made Mr. Wu, a representative of Morningside, available for deposition, and Petitioner conducted that deposition. Thus, *Adobe* is inapposite.

Third, Petitioner relies on *HTC Corp. v. NFC Tech., LLC*, IPR2014-01198, Paper 41 at 4-5 (PTAB Nov. 6, 2015) for the same propositions as *Abbott* and *Adobe*. Paper 34 at 3, 5, 6. *HTC* is equally unavailing. In *HTC*, the petitioner relied on a declaration to support an earlier conception date of the challenged patent. That witness, however, refused to appear for deposition. *HTC*, IPR2014-01198, Paper 41 at 2. Here, Patent Owner made Mr. Wu, a representative of Morningside Translations, available for deposition, and Petitioner conducted that deposition. Thus, *HTC* is inapposite.

Fourth, Petitioner relies on *Navistar, Inc. v. Fatigue Fracture Tech. LLC*, IPR2018-00853, Paper 58 at 55-56 (PTAB Aug. 29, 2019) for the proposition that a translation without a corresponding certification may be stricken. Paper 34 at 3, 5. In *Navistar*, the patent owner submitted foreign language documents as exhibits, but failed to submit **any** translations of those documents. *Navistar*, IPR2018-00853, Paper 58 at 55-56. Here, Patent Owner submitted both an English language translation (EX2001), as well as a Certificate of Translation (EX2003). Thus, *Navistar* is inapposite.

Fifth, Petitioner relies on *Square, Inc. v. REM Holdings 3, LLC*, IPR2014-00312, Paper 58 at 33-36 (PTAB July 7, 2015) for the proposition that a translation may be excluded when not accompanied by an affidavit as required by 37 C.F.R. § 42.63(b). Paper 34 at 7. In *Square*, the petitioner submitted a *computer* translation of a foreign language document. *Square*, IPR2014-00312, Paper 58 at 35. The petitioner in *Square* did not, however, submit an affidavit of *any* kind in support of the translation, and thus the translation was excluded. *Id.* Here, Patent Owner submitted the required Certification of Translation. EX2003. Accordingly, *Square* is inapposite.

D. Patent Owner Is Not Attempting to Shift the Burden.

Petitioner accused Patent Owner of attempting to shift the burden to Petitioner to identify inaccuracies in the translation. Paper 34 at 7. Petitioner is incorrect. As explained in *Globus*, where, as here, a declarant makes a statement based on information and belief, that statement goes to the weight of the evidence, not its admissibility. *Globus*, IPR2020-01306, Paper 7 at 20 (“the certification uses the phrase “[t]o the best of my knowledge,” suggesting that the affiant is making the statement on information and belief, this statement goes to the weight of the evidence.”). Moreover, as the movant, Petitioner bears the burden on its motion to exclude. 37 C.F.R. § 42.20(c); *Shaw Industries Grp., Inc. v. Automated Creel Sys.*,

Inc., IPR2013-00132 and IPR2013-00584, Paper 44, 44 (PTAB Jul. 24, 2014).

Petitioner could have had its own translation of EX2002 performed, but it chose not to. *EcoWater Sys. LLC v. Culligan Int’l Co.*, IPR2013-00155, Paper 10, 2 (PTAB Aug. 30, 2013) (“If Patent Owner believes that translation to be incorrect, Patent Owner should file its own translation and affidavit and include an explanation in its response. *See* 37 C.F.R. § 42.63(b).”). It also could have asked Mr. Wu about Morningside’s processes and procedures for vetting translators, assigning projects, and ensuring the accuracy of translations. But Petitioner chose to do none of these things. Instead, Petitioner rests its motion on a meritless interpretation of the Board’s Rules.

III. CONCLUSION

For the foregoing reasons, the Board should deny Petitioner’s Motion to Exclude Patent Owner’s Exhibits 2001 and 2003.

Date: October 21, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

I certify that on October 21, 2025, a copy of PATENT OWNER'S
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