

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

138 EAST LCD ADVANCEMENTS LIMITED,
Patent Owner.

IPR2024-00960
U.S. Patent 7,486,807

**PETITIONER'S REPLY IN SUPPORT OF ITS MOTION TO EXCLUDE
PATENT OWNER'S EXHIBITS 2004 AND 2005**

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	ROUTINE DISCOVERY REQUIRES PRODUCING THE DECLARANT FOR DEPOSITION.....	1
III.	PATENT OWNER’S CASE LAW IS NOT APPLICABLE	3
IV.	WHEN EXHIBIT 2005 IS EXCLUDED, EXHIBIT 2004 MUST ALSO BE EXCLUDED	5
V.	CONCLUSION.....	5

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Abbott Vascular, Inc. v. FlexStent, LLC</i> , IPR2019-00882, Paper 48 (PTAB Oct. 2, 2020).....	2
<i>Adobe Inc. v. RAH Color Techs. LLC</i> , IPR2019-00627, Paper 124 (PTAB Aug. 31, 2020).....	2
<i>Globus Medical, Inc. v. Moskowitz Family LLC</i> , IPR2020-01306, Paper 7 (PTAB Jan. 8, 2021)	3, 4
<i>HTC Corp. v. NFC Tech., LLC</i> , IPR2014-01198, Paper 41 (PTAB Nov. 6, 2015).....	2
<i>Navistar, Inc. v. Fatigue Fracture Tech. LLC</i> , IPR2018-00853, Paper 58 (PTAB Aug. 29, 2019).....	5
<i>Square, Inc. v. REM Holdings 3, LLC</i> , IPR2014-00312, Paper 58 (PTAB July 7, 2015).....	5
<i>Xilinx, Inc. v. Godo Kaisha IP Bridge 1</i> , IPR2017-00842, Paper 36 (PTAB June 7, 2018)	4, 5
Rules	
FRE 602	4, 5
FRE 901	3, 4, 5
Regulations	
37 C.F.R. § 42.62(a)	4
37 C.F.R. § 42.63(b)	3, 4, 5
Other Authorities	
Consolidated Trial Practice Guide (Nov. 2019)	1, 3

I. INTRODUCTION

Exhibits 2004 and 2005 should be excluded for failing to comply with the Board's rules. Patent Owner does not provide any post-institution authority for its propositions that (1) a declarant does not need to have personal knowledge as to the accuracy of a translation; (2) a declarant can be withheld from cross-examination and a replacement witness who lacks the ability to testify about the translation can be substituted; and (3) if a translation certification is excluded, that the uncertified translation can remain in the record.

II. ROUTINE DISCOVERY REQUIRES PRODUCING THE DECLARANT FOR DEPOSITION

The Board routinely strikes declarations when the declarant is not made available for cross-examination. Paper 28, Motion to Exclude, 2-3 ("Motion"). Patent Owner cites no authority holding otherwise.

The Consolidated Trial Practice Guide ("CTPG")¹ specifies that post-institution routine discovery includes "the cross-examination of the other side[']s declarants" and requires that "a party presenting a witness's testimony by affidavit should arrange to *make the witness available* for cross-examination." CTPG 23 (emphasis added). Patent Owner does not dispute that it must make the witness

¹ Available at <https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf?MURL=TrialPracticeGuideConsolidated>.

available for cross-examination when a declaration or affidavit is submitted. *See generally* Opp. Instead, Patent Owner incorrectly argues Petitioner’s case law² should not apply because in those cases no witness was produced for deposition, whereas here Patent Owner produced a representative from Morningside, who admitted he could not testify to the translation’s accuracy. Opp., 5-7. Patent Owner cites no authority that producing a different witness from the same company who cannot testify to the matters at issue satisfies the Board’s rules. Mr. Wu admitted he could not testify to the accuracy of the translation because he does not speak Japanese and did not prepare the translation. Ex. 1016, 14:15-17, 18:3-18. Therefore, Mr. Wu ***was wholly incapable*** of verifying the translation’s accuracy or answering any questions relating to translation issues, which is the purpose of the declaration and subsequent cross-examination.

Patent Owner improperly attempts to flip the burden by arguing that Petitioner “does not identify any alleged error in the translation provided, such that its accuracy and credibility may reasonably called into question.” Opp. 1-2. But Patent Owner denied Petitioner the opportunity to do so. The purpose of producing

² *Abbott Vascular, Inc. v. FlexStent, LLC*, IPR2019-00882, Paper 48 at 34 (Oct. 2, 2020); *Adobe Inc. v. RAH Color Techs. LLC*, IPR2019-00627, Paper 124 at 23-24 (Aug. 31, 2020); *HTC Corp. v. NFC Tech., LLC*, IPR2014-001198 (Nov. 6, 2015).

the witness for cross-examination is so Petitioner can ask such questions. 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. 1016, 14:15-17, 18:3-18, 20:2-21:1.

Because Patent Owner failed to produce the declarant for cross-examination, Exhibit 2005 should be struck.

III. PATENT OWNER'S CASE LAW IS NOT APPLICABLE

Patent Owner, citing *Globus Medical, Inc. v. Moskowitz Family LLC*, incorrectly argues that 37 C.F.R. §42.63(b) does not require a declarant to have personal knowledge and FRE 901's personal knowledge requirement does not apply to Certificates of Translation in PTAB proceedings. Paper 32, Opposition, 1, 3-4 (citing IPR2020-01306, Paper 7 (Jan. 8, 2021)). Neither argument is supported by *Globus* at this stage of the proceeding.

Globus is an institution decision and does not address requirements *post*-institution and at final written decision. *See Globus*, IPR2020-01306, Paper 7. The *Globus* decision was based only “on the current [pre-institution] record.” *Globus*, IPR2020-01306, Paper 7 at 20. Notably, that decision comes *before* objections are filed or cross-examination is taken. CTPG 22-23, 78-80. *Globus*, therefore, did not include any objections or motions to exclude because it could not. *Globus*, IPR2020-01306, Paper 7 at 20; CTPG 22-23, 78-80. The Board also did not

address the Federal Rules of Evidence for a deficient declaration, which apply to Board proceedings. FRE 901, 602; 37 C.F.R. § 42.62(a). It therefore makes sense that *Globus* took the declaration and translation at face value at institution. Indeed, *Globus* noted that any defect could be cured post-institution. *Globus*, IPR2020-01306, Paper 7 at 20. *Globus* did not create a precedent that FRE 901 and FRE 602 do not apply to certificates of translation. This proceeding, however, is post-institution. Petitioner timely objected under the Board’s rules and FRE. Paper 18. Patent Owner did not cure the objection. Petitioner was then denied the opportunity to cross examine the declarant and the “substitute” declarant admitted he could not testify to the accuracy of the translation. *See Motion. Globus* does not apply.

Xilinx, Inc. v. Godo Kaisha IP Bridge I is also distinguishable. IPR2017-00842, Paper 36 (June 7, 2018). Patent Owner cites *Xilinx* for the proposition that 37 C.F.R § 42.63(b) does not include a personal knowledge requirement, but the declarant in *Xilinx* **had personal knowledge** because he was the **translator**. Opp., 2-3; *Xilinx*, IPR2017-00842, Paper 36 at 6 n.6, 9-10. In *Xilinx*, the parties disputed whether the declaration’s wording was sufficient under 37 C.F.R § 42.63(b), not whether the declarant had personal knowledge. *Id.* at 3-6. The wording is not a dispute here—rather the declarant and substitute witness were not capable of attesting to the accuracy as required. And, contrary to Patent Owner’s position, *Xilinx* analyzed whether the evidence satisfied FRE 901 and noted that the

declarant's testimony was unchallenged because the other party did not request cross-examination. *Id.* at 7-8 (addressing whether the translation is what it purports to be as required under FRE 901.). The *Xilinx* declarant was competent to make the declaration; but here, the declarant was not the translator and does not speak Japanese, and Petitioner did attempt to cross-examine, but the witness admitted he was not competent to answer questions about the translation. *See generally* Motion.

Exhibit 2005 should be excluded for failing to comply with 37 C.F.R. § 42.63(b), FRE 901, and FRE 602.

IV. WHEN EXHIBIT 2005 IS EXCLUDED, EXHIBIT 2004 MUST ALSO BE EXCLUDED

Patent Owner fails to meaningfully contest that, if Exhibit 2005, the declaration, is excluded there is no declaration attesting to the accuracy of the translation (Ex. 2004), and the translation therefore fails to comply with 37 C.F.R. § 42.63(b) and must also be excluded. Opp., 4, 7. Instead, Patent Owner argues that *Navistar, Inc. v. Fatigue Fracture Tech. LLC* and *Square, Inc. v. REM Holdings 3, LLC*, are inapposite because an affidavit or declaration was not provided in those cases. *Id.* at 7-8. *Navistar* and *Square* are both examples of the Board excluding a translation when it was not accompanied by a proper declaration. *See* Motion, 3-4, 7. The same is true here and Exhibit 2004 must be excluded.

V. CONCLUSION

The Board should exclude Patent Owner's Exhibits 2004 and 2005.

Respectfully submitted,

Dated: September 29, 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 Reply in Support of Its Motion to Exclude Patent Owner's Exhibits 2004 and 2005** contains 5 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: September 29, 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 Reply in Support of its Motion to Exclude Patent Owner's Exhibits 2004 and 2005** was served on September 29, 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: September 29, 2025

/Lisa C. Hines/

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