

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.
Petitioner

v.

DH INTERNATIONAL LTD.
Patent Owner

Case No. IPR2025-00172
U.S. Patent No. 9,022,294

AUTHORIZED RESPONSE TO DIRECTOR REVIEW REQUEST

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I. INTRODUCTION

Patent Owner (“PO”) argues the Board abused its discretion by (1) failing to consider discretionary denial and (2) permitting Petitioner to cure a non-compliant translator affidavit. Neither argument has merit.

PO insists that it “could not apply” the bifurcated procedure set forth in the March 26, 2025 memorandum entitled “Interim Processes for PTAB Workload Management (“Interim Processes memo”) due to the stage of the instant proceeding when the memo issued. Request for Director Review (“Request”) (Paper 12), 2-3. PO is wrong. Its deadline to file a Preliminary Response had not yet passed when the Interim Processes memo issued, and the Interim Processes memo expressly authorized a discretionary brief under these circumstances. PO simply failed to file the authorized brief. In its Request, PO continues to ignore that it was authorized to file a brief and does not wrestle with its own failure to comply. The Director need not address the merits of PO’s belated discretionary denial arguments. PO was given an opportunity to advocate for discretionary denial under the new bifurcated process and did not. Its refusal to even acknowledge that it failed to take advantage of the authorized process provides the Director no basis to excuse PO’s waiver.

PO’s argument regarding the translator affidavit fares no better. PO argued that Petitioner’s translator affidavit was deficient because the translator confirmed accuracy to the “best of [his] knowledge” “and [did] not indicate what that

‘knowledge’ was.” Paper 12, 10-11. At institution, consistent with long-standing PTAB practice, the Board authorized Petitioner to cure the issue with an updated translator affidavit. PO insists this was error. Tellingly, PO’s Request does not identify any policy rationale to undo the PTAB’s practice, nor does it suggest that it has or will suffer prejudice from the Board permitting Petitioner cure the translator affidavit. On this record, there is no basis to disturb the PTAB’s practice of permitting parties to cure alleged problems with translator affidavits.

II. PATENT OWNER WAIVED DISCRETIONARY ARGUMENTS

The Board accorded a filing date on January 28, 2025, setting April 28, 2025 as PO’s Preliminary Response deadline. Paper 4. Before any Preliminary Response was filed, the Interim Processes memo issued on March 26, 2025. This memo clarified that “decisions on whether to institute an IPR or PGR will be bifurcated between (i) discretionary considerations and (ii) merits and other non-discretionary statutory considerations.” Interim Processes memo, 1. The memo explained that “the Director, in consultation with at least three PTAB judges, will [first] determine whether discretionary denial of institution is appropriate.” *Id.* If discretionary denial is not appropriate, a petition is then referred to the merits panel to address “the merits and other non-discretionary statutory considerations.” *Id.* “[T]o facilitate this bifurcated approach,” the Interim Processes memo authorized patent owners to file “a brief explaining *any applicable bases for discretionary denial of institution*[.]”

including “[s]ettled expectations of the parties, such as length of time the claims have been in force.” *Id.*, 2.¹ Because no preliminary response had been filed, the Interim Processes memo expressly permitted a discretionary brief here:

The processes described herein will be implemented in IPR and PGR proceedings *where the deadline for the patent owner to file a preliminary response has not yet passed*. In that situation, if the time for filing discretionary denial briefing as described herein has already elapsed, *the patent owner may submit discretionary denial briefing within one month of the date of this memorandum*.

Id., 3 (emphasis added).

PO did not submit the authorized brief, so this proceeding was referred to the merits panel on April 30, 2025:

Under the March 26, 2025, . . . Interim Processes memo[], *Patent Owner had the opportunity to file a brief requesting discretionary denial of institution*. [] *Patent Owner did not file such a brief*. Accordingly, this case is referred to a Board panel to consider the merits and non-discretionary considerations.

Paper 7, 1-2 (emphasis added).

PO’s Request continues to misread the Interim Processes memo. It argues that “this IPR could not apply the bifurcated procedure” and that the notice referring this

¹ PO’s Request incorrectly asserts that “the Interim Process Memo did not identify [the settled expectation doctrine] as a factor.” Paper 12, 7.

case to the merits panel was error. Paper 12, 2-3. PO's entire focus is on the Interim Processes memo having issued more than two months after the notice of filing date was accorded. It never discusses or even acknowledges the memo's express accommodation for patent owners, like PO, who had not yet filed a preliminary response. As the PTAB has already held (Paper 7), PO's failure to comply with the Interim Processes memo waived all discretionary bases. And PO's continued refusal to even acknowledge this failure provides the Director no basis on which to excuse PO's waiver. Accordingly, the Director should not credit PO's arguments regarding the "settled expectations" doctrine. They have been waived.²

III. THE OFFICE'S PRACTICE OF ALLOWING PARTIES TO CURE TRANSLATOR AFFIDAVITS SHOULD BE LEFT UNDISTURBED

PO argues that "the Board committed clear error by basing its decision to institute on the faulty *Suga* translation and simply assumed that the Petitioner could file a corrected translation certificate at a later date." Paper 12, 8-12. PO does not dispute that, pursuant to the Board's invitation to file a corrected translation affidavit, Petitioner did cure the issue. Instead, it takes issue with the Board having permitted Petitioner to cure the non-complaint affidavit in the first place. PO

² Had PO not waived its right to advocate for discretionary denial, Petitioner would have explained why discretionary denial is inappropriate. This includes at least that PO voluntarily dismissed the parallel litigation before this proceeding was instituted, thereby prioritizing the PTAB's review over the district court. Ex. 2003.

provides the Director no basis to engage this issue. The Board's decision is consistent with the PTAB's long-standing practice. *See* IPR2024-01230, Paper 12 at n.2, n.3 (PTAB Feb. 19, 2025) (instituting with instructions for petitioner to submit compliant translator affidavits for multiple references); IPR2020-00349, Paper 13 at 8-11 (PTAB Jul. 16, 2020) (instituting despite non-compliant translator affidavits, instructing petitioner to file compliant affidavits, and noting that institution may be revisited if issue not cured); *see also* IPR2020-01306, Paper 7 at 20 (PTAB Jan. 8, 2021) ("Even if the certification is deficient, this failure is not fatal, as the Board routinely allows a Petitioner to correct such a declaration.").

PO's Request does not identify any policy rationale to undo the PTAB's practice, nor does it suggest that it has or will suffer prejudice. Instead, it seeks to distinguish the *Hengdian* decision, claiming (1) the patent owner allegedly waived the challenge by not raising it in the preliminary response and (2) the affidavit in *Hengdian* allegedly provided increased assurances regarding the translation's validity. Paper 12, 10. PO is wrong. The Board in *Hengdian* said nothing about waiver and did not suggest that it was allowing petitioner to cure based on any elevated level of assurance in the non-compliant certificate. Instead, as here, and consistent with the PTAB's long-standing practice, the Board assumed the translation correct for purposes of assessing institution and instructed petitioner to file compliant affidavits. PO provides the Director no basis to disturb this practice.

Date: July 17, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e), the undersigned certifies that, on July 17, 2025, Petitioner's Authorized Response to Director Review Request was served on Patent Owner's counsel of record:

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