

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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APPLE INC.,

Petitioner,

v.

DH INTERNATIONAL LTD.,

Patent Owner.

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PTAB Case No. IPR2025-00172

Patent No. 9,022,294

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**PATENT OWNER'S MOTION TO EXCLUDE**  
37 C.F.R. §§ 42.62 & 42.64(c)

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## **I. INTRODUCTION**

Patent Owner (PO) moves to exclude evidence and filings based upon objections filed on July 8, 2025 (Paper 11) and December 15, 2025 (Paper 19). Specifically, PO moves to exclude Petitioner's Petition (paper 1), Reply (paper 18), Expert Declaration (Exhibit 1004), Japanese Patent No. 2003110751 ("*Suga*") (Exhibit 1005), *Suga* reference second filing (Exhibit 1017), and Expert Reply Declaration (Exhibit 1021), along with Exhibit 1004, 1005, 1017, 1021, and 1022.

Previously, PO objected to the Petitioner's reliance on the non-prior art *Suga* reference, Exhibit 1005, for failing to meet the particularity requirement of 35 C.F.R. § 42.63; and the fact that the Board based its institution of this IPR on non-prior art. Also, PO objected to the introduction of Exhibit 1017 when it was not relied upon in the Petition, Reply, Expert Declarations, or the Institution Decision. PO also objected to Exhibit 1022 based on a lack of foundation and reliance by the Petitioner's Supplemental Expert Declaration (*see* Exhibit 1021) reliance on Exhibit 1022.

## **II. Petitioner's reliance on non-prior art *Suga* reference Exhibit 1015.**

Previously, PO objected to Exhibit 1004 and 1017, *Suga* reference and associated declaration, in the objections filed on July 8, 2025 (Paper 11) and December 15, 2025 (Paper 19). Federal regulations requires 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. The language of this regulation is not permissive. The specific language requires that evidence “**must be filed with the document.**”

*Suga* (Exhibit 1005) was filed on October 1, 2001, and published on April 11, 2003, and is in Japanese. *See* Petition, p.10; Exhibit 1005, Exhibit 1017. *Suga* is a Japanese patent written in Japanese and requires a translation along with an affidavit attesting to the accuracy of the translation. The actual English translation document originally filed with the Petition has a date of July 29, 2024 (*see* Exhibit 1005, 20); and Andrew Raia, a Project Manager in the translation company, only provides an affidavit attesting “[t]o the best of my knowledge, the aforementioned documents are a true, full and accurate translation of the specified documents.” Exhibit 1005, 20.

In an IPR timing matters. A replacement, rather than a corrected affidavit, must be filed before institution for a reference to be considered by the Board for institution. Any other finding improperly makes the statutory phrase “must be filed with the document” part of regulation 37 C.F.R. § 42.63 meaningless.

Here, the affidavit of Andrew Raia failed to attest to the accuracy of the translation. Petitioner filed a replacement affidavit signed by a different person and Andrew Raia’s affidavit was not corrected. A new affidavit filed after institution

establishes that the Board improperly instituted an IPR having a single ground based on an unsubstantiated non-prior art reference. Also, another problem presented by the replacement affidavit filed by an individual other than Andrew Raia is considered new matter in the IPR proceeding introduced after the filing of the Petition.

In the Decision to Institute (DI), the Board noted in footnote 6, that “Patent Owner correctly notes the Japanese-to-English translation certification of Ex. 1005 at page 20 is non-compliant.” DI, p.18, fn. 6. The Board gave Petitioner ten (10) business days from the date of the DI to file a translation “affidavit” or sworn declaration” pursuant to 37 C.F.R. §§ 1.68, 42.63(b). The Board cited *Hengdian Group DMEGC Magn. Co. v. Hitachi Metals, Ltd.*, IPR2017-01312, Paper 14, at 2 (PTAB Jan. 3, 2018) (“order[ing] Petitioner to file satisfactory affidavits attesting to the accuracy of the translation within 10 business days of the Decision”).

The Board allowed Petitioner to address only the non-compliant affidavit and make it compliant. Petitioner filed a replacement affidavit and reference (Exhibit 1017), which is new matter. The fact that the translation with the replacement affidavit, Exhibit 1017, does not reference Exhibit 1005 further supports that Exhibit 1005, relied on by the Board in its institution decision (paper 44), is improperly relied upon, unsubstantiated prior art. There is no evidence in the IPR that Exhibit 1005 is prior art because it fails to comply with 37 C.F.R. § 42.63.

In *Hengdian Group DMEGC Magn. Co. v. Hitachi Metals, Ltd.*, IPR2017-01312, Paper 14 at 2 (PTAB Jan. 3, 2018) that is cited in Petitioner’s Reply (Reply, pp. 1-2), the issue was the late filing of an “updated” affidavit. The Institution Decision in IPR2017-01312 in footnote 2, indicated that “the translator certificate does not warn the translator “that willful false statements and the like are punishable by fine or imprisonment, or both.” Petitioner cites to the *Hengdian* IPR for support that an affidavit can be corrected, which is true; unfortunately for the Petitioner, its attempt at correction failed the requirement set forth in 37 C.F.R. § 42.63 for consideration by the Board in the institution of the IPR.

The issue in *Hengdian* was not the person who signed the certificate as in the current IPR, but the specific language used in the affidavit. *See Hengdian Group DMEGC Magn. Co. v. Hitachi Metals, Ltd.*, IPR2017-01312, DI, Paper 7, p. 6. In *Hengdian*, the translator certificate (i.e., affidavit) was signed by “Toyu Yazaki” and stated, “I declare under penalty of perjury under the laws of United States that the foregoing is true and correct.” IPR2017-01312, Ex. 1006, p1. The Board has some assurance from Toyu Yazaki, that the originally filed translation was accurate and if called to testify, would testify to the same. Most importantly, Toyu Yazaki signed the corrected translation certificate. *Hengdian Group DMEGC Magn. Co. v. Hitachi Metals, Ltd.*, IPR2017-01312, Ex. 1027, at 1 (PTAB Jan. 3, 2018).

Unlike *Hengdian*, the issue before this Board is that the *Suga* reference included a certificate signed by someone who could not testify that it was an accurate translation. The “corrected” certificate was signed by a different person and submitted after the IPR was instituted. Therefore, the Board improperly relied on a reference that was not established as prior art at the time of the Institution Decision; and since a certificate from a person who could testify to the validity of the translation was not submitted with the petition, the certificate carries no weight because it did not meet the requirements of 37 C.F.R. §§ 1.68, 42.63(b).

The differences between *Hengdian* and this IPR are shown in the table below.

|                                                                                                 | <i>Hengdian</i><br>IPR2017-01312 | Apple IPR<br>IPR2025-00172  |
|-------------------------------------------------------------------------------------------------|----------------------------------|-----------------------------|
| Foreign Reference:                                                                              | 63-33505 Japanese Patent         | 2003-110751 Japanese Patent |
| Original Translation Certificate:                                                               | Ex. 1006                         | Ex. 1005                    |
| Is the original translation certificate compliant with the required language for the affidavit? | NO                               | NO                          |
| Original Translation Certificate Signer:                                                        | Toyu Yazaki                      | Andrew Raia                 |
| Indication of personal knowledge of the accuracy of translation?                                | YES                              | NO                          |
| Corrected Translation Certificate:                                                              | Ex. 1027                         | Ex. 1017                    |
| Corrected Translation Certificate Signer:                                                       | Toyu Yazaki                      | Frank McGee                 |
| Affidavits signed by the same person?                                                           | YES                              | NO                          |

Here, the current fact pattern differs from *Hengdian*, where a corrected certificate was filed to include additional language by the person who could testify to the accuracy of the original translation. Patent Owner acknowledges that the Board made the proper decision in *Hengdian*, as the person who signed the original certificate, if called to testify, the affiant could testify to its accuracy as of the Petition's filing date. Here, however, the Petitioner filed a replacement certificate signed by a different person that includes the required language. The replacement certificate contained in Exhibit 1017 had its own translation that did not refer to the Exhibit relied upon by the Board in its Institution Decision. Petitioner improperly called its filing of Exhibit 1017 a correction in their Reply, rather than a replacement certificate. *See Reply*, p. 1.

The Petitioner makes the statement that “Nothing in 37 C.F.R. § 42.63(b) requires that a noncompliant affidavit be ‘corrected’ by the same declarant.” *Reply*, p 2. In general, that may be true, but the timing in the IPR results in a reference required in the single ground not being prior art that can be relied upon for institution. Further, the person signing must have personal knowledge of the document's accuracy. *See 37 C.F.R. § 42.63(b)*. According to the original affidavit relied upon by the Board institution of the IPR, Mr. Andrew Raia did not have personal knowledge of the translation's accuracy; he only stated that “[t]o the best of my knowledge.” *See Exhibit 1005*, p.20.

Petitioner admits that the corrected affidavit is signed by the translator, who can attest to the accuracy of the *Suga* translation attached to Exhibit 1017. However, Exhibit 1017 makes no mention of Exhibit 1005, which the Board relied on for institution. *See* Reply, p.1. That results in an admission that the original signed affidavit was from a person who did not perform the *Suga* translation or was unable to attest to its accuracy.

The Board improperly relied on a reference (Exhibit 1005) that was not prior art when it made its decision to institute this proceeding. Thus, the institution decision must be vacated, and the IPR dismissed. Further, Exhibit 1017 is not simply a correction of an erroneous affidavit, but rather improper new matter introduced in this IPR after the Petition was filed. As such, Exhibit 1017 must be excluded.

Exclusion of Exhibit 1005 is also required from this IPR since it cannot be relied upon as non-prior art. Exhibit 1005 is the only reference used in the only ground in this IPR, thus the Petition in this IPR should also be excluded along with Petitioner's Reply that also relied on Exhibit 1005.

### **III. Petitioner's Exhibit 1022 Lacks Foundation**

PO objected to Exhibit 1022 for lack of foundation, Fed. Rule Evid. 401 and 403. *See* Paper 19. Exhibit 1022 is a screen capture of an interface that displays a copyright notice for the software being used. Still, the data accessed by the interface does not indicate a version or copyright for the information being accessed by the

software. The graphic image of a book cover accessed by the software does not indicate the copyright of the material being accessed. Also, there is no indication that the software was publicly available. There is no indication of the book's copyright when accessed by the software. It could possibly be old software accessing a recently published book. Furthermore, the software-generated Exhibit 1022 was relied on by Petitioner's Supplemental Expert Declaration in Exhibit 1021 and is not a printed publication or patent.

Petitioner, in response to the objection, submitted copies of pages from an actual book on December 30, 2025, and labeled them with the same exhibit number, Exhibit 1022. Petitioner's supplemental expert declaration (Exhibit 1021) did not rely on the actual book pages that were sent to PO on December 30, 2025, as supplemental evidence, as the filed Exhibit 1022 was from software and not the actual book. The field Exhibit 1022 relied on by Petitioner's expert in his supplemental Declaration (Exhibit 1021) relies on evidence that lacks a foundation as required under the Federal Rules of Evidence. Exhibit 1022 lacks a foundation, and the updated Exhibit 1022 mailed to PO was not relied upon by Petitioner's expert in his Supplemental Declaration Exhibit 1021. Exhibits 1021 and 1022 must be excluded for these reasons.

#### **IV. CONCLUSION**

For the above reasons, PO requests the exclusion of the following evidence:

- 1) Exhibits 1004, 1005, 1017, 1021, and 1022 because Exhibit 1005 (*Suga*) and its associated translation were not supported by an affidavit attesting to the accuracy of the translation; and Petitioner did not file a corrected affidavit, but instead filed a replacement affidavit, which does not fix Petitioner's problem, but instead presents new matter. Further, Petitioner's Expert declarations, Exhibit 1004 and 1021, relied on *Suga* as unsubstantiated potential prior art which happens to be the only reference used in the only ground in the IPR. Also, Exhibit 1022 lacks a foundation because there is no evidence as of the copyright or date the evidence was publicly available.
- 2) Petitioner's Petition and Reply because Exhibit 1005 (*Suga*) is improper prior art in which institution of this IPR could be based upon. The Petition and Reply rely on non-prior art *Suga*, Exhibit 1005, as the only ground supporting institution of this IPR.

Dated: March 4, 2026

Respectfully Submitted

By: /s/ *Robert Hart*

Robert Hart (Reg. No. 35,185)  
Counsel for Patent Owner

**CERTIFICATE OF SERVICE**

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies Patent Owner DH International Ltd. served this **PATENT OWNER'S MOTION TO EXCLUDE** on the counsel of record for Apple Inc. by filing this document through the P-TACTS, as well as delivering a copy via electronic mail to the following:

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Date: March 4, 2026

By: /s/ /Robert Hart/  
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