

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,

Petitioner,

v.

DH INTERNATIONAL LTD.,

Patent Owner.

PTAB Case No. IPR2025-00172

Patent No. 9,022,294

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

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INTRODUCTION

Petitioner's Opposition to the Motion to Exclude fails because the Petitioner did not follow the Board's Order instructing the Petitioner to file a corrected affidavit for the foreign *Suga* reference, Exhibit 1005. Instead, the Petitioner filed a new affidavit and reintroduced the *Suga* reference as Exhibit 1017. The affidavit attached to Exhibit 1017 fails to reference Exhibit 1005, and the person who signed the affidavit attached to Exhibit 1005 is different from the person who signed the affidavit attached to Exhibit 1017. Thus, the 1005 reference was, and still is, a non-compliant reference. Thus, the Board improperly instituted this IPR based on the non-compliant *Suga* reference of Exhibit 1005.

In every case cited in the Petitioner's Opposition (Paper 25), the court's stated that the Petitioner must file an affidavit in an IPR for a non-compliant reference, even if 37 C.F.R. 42.61(b) were to apply. For example, *Norman Int'l v. Andrew J. Testamentary Trust*, IPR2014-00283, Paper 52 at 14 (PTAB June 18, 2015) ("The Board agrees with Patent Owner that § 42.61(b) 'does not obviate the requirement of an affidavit attesting to the accuracy of a foreign document under § 42.63(b)'").

I. The Board's Instructions were not followed by the Petitioner

In the Institution Decision (Paper 8), this Board instructed the Petitioner to file a corrected affidavit. The Board's instructions were:

Patent Owner correctly notes the Japanese-to-English translation certification in Ex. 1005 at page 20 is non-compliant. Prelim. Resp. 3–4 (citing 37 C.F.R. § 42.63). Petitioner shall have 10 business days from the date of this Decision to file a translation “affidavit” or sworn declaration pursuant to 37 C.F.R. §§ 1.68, 42.63(b). *See Hengdian Group DMEGC Magn. Co. v. Hitachi Metals, Ltd.*, IPR2017-01312, Paper 14, 2 (PTAB Jan. 3, 2018) (“order[ing] Petitioner to file satisfactory affidavits attesting to the accuracy of the translation within ten business days of the Decision”).

ID, fn.6 at 18. The Petitioner had ten (10) business days to file a translation affidavit or sworn declaration for Exhibit 1005 to replace the non-compliant affidavit, *see* Exhibit 1005, p. 20.

In response, Petitioner filed Exhibit 1017, a new affidavit, authored by a different affiant, for the attached translation of Exhibit 1017, not a correction to the affidavit to the translation of Exhibit 1005. In this new affidavit, no reference was made to Exhibit 1005 or the Board’s Order in the filing of Exhibit 1017. Thus, Petitioner failed to file a corrected translation certificate within the required ten (10) days to correct the defect in Exhibit 1005 as ordered by the Board. Since Exhibit

1017 makes no statements about Exhibit 1005 or the Board's Order, it is classified as new matter and must be excluded from this IPR proceeding.

The Petitioner cites to *Volkswagen Group of America INC. v. Emerachem Holding LLC*, IPR2014-01555 (PTAB Mar. 16, 2015), for allowing a late-filed affidavit. In *Volkswagen*, the Board allowed correction of IPR Exhibit 1007, correcting using different versions of the same exhibit, i.e., 1007A and 1007B. New exhibit numbers were not used for the corrected exhibits. In the current IPR, a corrected exhibit cannot have a completely new exhibit number, as the Petition and Expert declaration cite to the original Exhibit 1005, and changing the exhibit number would cause confusion to anyone reviewing the IPR filings.

The Board has the authority under 37 CFR § 42.5(3) to accept a late-filed affidavit. *See* 37 CFR § 42.5(3) ("A late action will be excused on a showing of good cause or upon a Board decision that consideration on the merits would be in the interest of justice"). Here, the Petitioner did not file a corrected affidavit for Exhibit 1005 within the ten (10) day period as ordered by the Board. There is no evidence in the IPR that the Petitioner has ever filed a corrected affidavit for Exhibit 1005.

Patent Owner has been prejudiced by the Petitioner for not following the IPR rules or the Board's Order. Patent Owner has had to use word count, space in filings, and attorney time to continually identify the failings of Exhibit 1005. Further, Patent

Owner is prejudiced by having two different references, 1005 and 1017 filed at different times with different affidavits, and not knowing which one the Petitioner and Petitioner's expert is relying on (*see* Exhibit 1021 and 1022). It is the Petitioner's burden to put forth its evidence in a timely manner, not the Patent Owner's burden to decide what reference is the proper reference to address. There is no evidence in the record to support that Exhibit 1005 was corrected because the Petitioner did not provide any evidence of the connection between the foreign reference, translation, and affidavit of Exh. 1017 and the foreign reference, translation, and affidavit of 1005.

Exhibit 1005 is also not prior art because no valid affidavit for the translation in Exhibit 1005 was filed in this IPR. Thus, Petitioner's Exhibit 1017 is improper new matter that was not relied upon by the Board or Petitioner's Expert in the institution of this IPR proceeding.

II. CONCLUSION

For the above reasons, PO requests the exclusion of:

- 1) Exhibit 1005 (*Suga* reference, translation, and invalid affidavit) because inclusion violates the Patent Rules, the Board's Order, and prejudices the Patent Owner, and Exhibit 1017 because its shortcomings introduced new matter;
- 2) Exhibits 1021 and 1022 (Petitioner's Expert reports) because these papers rely on Exhibit 1005, the *Suga* reference is non-compliant and not prior art; and
- 3) Petitioner's Petition (Paper 01) and Reply (Paper 18) because these papers also rely on the non-compliant *Suga* reference that is not prior art.

Dated: March 18, 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 REPLY TO PETITIONER’S OPPOSITION TO THE 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 18, 2026

By: /s/ *Robert Hart*
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