

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AJINOMOTO CO., INC.

Petitioner,

v.

ABTIS CO., LTD.

Patent Owner.

CASE: IPR2025-00283

U.S. PATENT NO. 11,896,675

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

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Petitioner’s Motion to Exclude (Paper 34) (the “Motion”) should be denied. Petitioner seeks to exclude evidence Patent Owner AbTis Co., Ltd. (“AbTis”) introduced with its Reply to Petitioner’s Opposition to Motion to Amend (Paper 28). Petitioner specifically seeks to exclude Exhibit 2008 (“Second Declaration of Dr. Zhaohui Sunny Zhou”) and Exhibit 2009 (“Kirmse et al., ‘Destabilisierte 2-Norbornyl’”)¹. Paper 34, 4. This evidence is relevant to this proceeding, and Petitioner has not met its burden of proving it is entitled to the extraordinary exclusionary relief it seeks. 37 C.F.R. § 42.20(c).

I. THE BOARD SHOULD NOT EXCLUDE EXHIBIT 2008

A. Petitioner Waived Its Oath-Based Challenge by Failing to Raise It in a Timely and Specific Objection

Petitioner’s Motion to Exclude Exhibit 2008 is procedurally barred. Under 37 C.F.R. § 42.64(c), a motion to exclude “may only be based on objections timely raised under paragraph (b)(1).” That limitation is strictly enforced because the entire evidentiary framework depends on timely, specific objections that give the

¹ AbTis in its Exhibit List imprecisely described Ex. 2009 as “English Translation of Kirmse et al., ‘Destabilisierte 2-Norbornyl,’” when “Edition” or “Version” would, as discussed herein, have been a better description.

proponent notice of the precise defect “with sufficient particularity to allow correction in the form of supplemental evidence.” 37 C.F.R. § 42.64(b)(1).

Here, Petitioner’s written objections (Paper 29) never identified the alleged absence of a statutory oath or penalty-of-perjury statement as a ground for objection. The objection did not cite 28 U.S.C. § 1746, 35 U.S.C. § 25, or 37 C.F.R. §§ 42.2 or 42.63—as it now does in its Motion to Exclude—nor did it assert that Exhibit 2008 failed to qualify as a legally cognizable declaration. The oath-based theory appears for the first time in Petitioner’s Motion to Exclude (Paper 34), which is too late. For that reason alone, the Motion should be denied.

i. Petitioner’s Selective Specificity in Its Written Objections Confirms the Oath Argument Was Not Preserved

Petitioner’s own objections confirm that the oath-based challenge was not preserved. When Petitioner intended to raise particular, curable defects in Exhibit 2008, it did so expressly and with specificity. For example, Petitioner identified specific paragraphs of the declaration—paragraphs 21, 37, 38, 42, 43, and 47—and asserted that they “lack any cited basis.” Petitioner likewise articulated detailed objections under FRE 702, 602, and 701, identifying the nature of the alleged deficiencies and the portions of the declaration to which those objections applied.

By contrast, Petitioner never identified the absence of an oath or perjury statement. The objection under FRE 901–902 merely recited the rule categories and

asserted a lack of “sufficient indicia” of authenticity, without identifying the particular defect now claimed to be dispositive. *See* Paper 29, 2. That omission is telling. Where Petitioner itemizes specific defects but omits a purported oath deficiency, AbTis cannot be expected to intuit that a penalty-of-perjury statement—rather than any number of other possible authentication issues—is the alleged problem. Petitioner’s selective specificity confirms that no such notice was provided here, and the oath-based argument is therefore waived.

Moreover, the cure mechanism in Section 42.64(b)(2) depends on notice of the specific deficiency to be cured. Specifically, Section 42.64(b)(2) allows a proponent to serve supplemental evidence to correct an “identified deficiency” within ten business days of a timely objection. The rule presupposes that the objection identifies what must be corrected. AbTis demonstrated diligence by serving supplemental evidence in response to other objections raised in Paper 29. Had Petitioner identified the oath issue at that time, AbTis would have cured it during the same cure window. Petitioner cannot withhold a specific objection and then later seek exclusion based on that omission.

ii. The Alleged Defect Is Technical, Non-Prejudicial, and Curable

Even if the Board were to reach the merits, exclusion would still be unwarranted. The alleged defect in Exhibit 2008 is purely technical and is not directed to the substance, reliability, or credibility of the expert’s testimony.

Dr. Zhou signed the second declaration, stood behind its contents, and was available for cross-examination. Petitioner does not allege fabrication, surprise, or substantive unreliability. Upon learning of the oath issue for the first time in Petitioner's Motion to Exclude, AbTis acted promptly by obtaining a corrected, fully sworn declaration and seeking leave under 37 C.F.R. § 42.5(b). The corrected declaration does not alter or expand any opinion; it merely cures a non-substantive formal defect. The Board granted AbTis leave to file its Motion to Submit Supplemental Evidence, which is being filed concurrently herewith, and subject to the Board's resolution of that motion, AbTis submits the corrected declaration as Exhibit 2012 to this Opposition in accordance with the Board's rules governing motions to exclude. *See* Patent Trial and Appeal Board, *Consolidated Trial Practice Guide* 78 (Nov. 2019) ("Supplemental evidence is not filed at the time of the objection, but simply served, and is filed only in support of an opposition to a motion to exclude.").

PTAB decisions confirm that exclusion is a disfavored remedy for technical defects in expert declarations even in circumstances far more serious than those presented here. For example, in *Liquidia Technologies, Inc. v. United Therapeutics Corp.*, IPR2020-00770, Paper 45 at 57-58 (P.T.A.B. Oct. 8, 2021), the Board addressed an unsworn expert declaration and sharply criticized the petitioner's conduct after it submitted a declaration lacking a statutory oath, failed to seek

authorization to correct the defect, and later attempted to “fix[]” the issue by filing a new declaration eleven months after the related petition and without Board authorization. The Board rejected that attempt as improper “self-help,” gave the corrected declaration no weight because the “[p]etitioner [did] not explain how a declaration executed eleven months after can support the Petition,” and expressed concern that the petitioner had disregarded the PTAB’s procedural rules. *Id.* at 57.

Despite those significant procedural failures, the Board nevertheless declined to exclude the original declaration, expressly finding that the patent owner had suffered no undue prejudice. *See id.* at 58. In other words, even where a party’s handling of an unsworn declaration was procedurally improper and drew sharp rebuke from the Board, exclusion was still denied. *See id.*

That decision underscores the governing principle applicable here: exclusion is not automatic, nor favored, for oath-related defects, especially where the defect is technical, the testimony has had the opportunity to be tested through cross-examination, and no prejudice has been shown. The circumstances here are far less severe. Unlike the conduct criticized in *Liquidia*, AbTis acted promptly and transparently upon learning of the issue, obtained a fully sworn declaration, served the correct declaration on Petitioner, and sought to address the matter through the Board’s procedures rather than ignoring them. *See Patent Owner’s Motion for Leave to Submit Supplemental Evidence* (filed concurrently herewith). If exclusion was

unwarranted in a case involving unauthorized filings and substantial delay (see *Liquidia*, IPR2020-00770, Paper 45), it is plainly unwarranted here.

iii. No Prejudice and No Basis for Exclusion

Finally, Petitioner has not demonstrated prejudice. Petitioner has not suggested that Exhibit 2008 is inaccurate, misleading, or unreliable. Excluding the declaration would serve no evidentiary purpose and would instead reward Petitioner's failure to comply with the specificity requirements of § 42.64(b)(1).

Absent undue prejudice, exclusion would be inconsistent with the Board's discretion and its preference to decide cases on a complete evidentiary record. Accordingly, the Board should deny the Motion.

II. THE BOARD SHOULD NOT EXCLUDE EXHIBIT 2009

A. Exhibit 2009 Is a Published English-Language Journal Article, Not an Unverified Party Translation And Should Not Be Excluded

Petitioner's challenge to Exhibit 2009 is premised on a fundamental factual error. Exhibit 2009 is not a party-created translation of a foreign-language document. Rather, it is an officially published English-language edition of a peer-reviewed scientific journal article: "Angewandte Chemie International Edition in English, Vol. 24, Issue 1." See Ex. 2009, 1-2 (distinguishing between "*Angew. Chem. Int. Ed. Engl.* 24 1985) No. 1" and "**German version:** *Angew. Chem.* 97(1985) 51" (emphases added)). These editions are separately published and have independent volume numbering. Specifically, Volume 24, Issue 1 (e.g., Ex. 2009)

corresponds to the English edition's own volume count. Accordingly, Exhibit 2009 is properly understood as an English-language journal publication, no different in kind from any other English scientific article routinely relied upon in *inter partes* review proceedings. Because Exhibit 2009 is itself an English-language publication, the requirements of 37 C.F.R. § 42.63(b) and FRE 902(3) do not apply, and exclusion is unwarranted.

i. Section 42.63(b) Applies Only to Party-Created Translations

Section 42.63(b) applies where “a party relies on a document or is required to produce a document in a language other than English” and therefore must attest to the accuracy of that translation. 37 C.F.R. § 42.63(b). That rule exists to address accuracy concerns where a party itself converts foreign-language text into English for the record. Those concerns are not present here. AbTis did not prepare, commission, or submit an uncertified translation of a German article. Instead, AbTis submitted a published English-language edition of the article itself. The fact that a German-language edition of the same work also exists does not convert the English edition into a “translation” within the meaning of § 42.63(b). Accepting Petitioner's position would lead to an untenable result: any English-language journal article could be excluded merely because a non-English version also exists somewhere in the world. That is not, and cannot be, the rule.

Petitioner's reliance on FRE 902(3) fares no better. FRE 902 concerns authentication of foreign public documents. As discussed above, Exhibit 2009 is not offered as a foreign-language document requiring foreign certification; it is an English-language edition of a journal article submitted in ordinary course. FRE 902(3) does not impose certification requirements on English-language publications simply because a foreign language counterpart exists.

ii. AbTis Acted Reasonably and in Good Faith by Relying on the English Edition

AbTis's reliance on the English-language edition further underscores why exclusion would be inappropriate. Petitioner itself relied on the **German-language** publication (Ex. 1057), but did not provide AbTis or the Board with any translation or an English-language version. Rather than engaging in unnecessary procedural disputes or expending resources on objections that would have been easily curable, AbTis and its expert located and relied upon the official English-language edition of the publication, issued as part of the journal's routine international dissemination.

The English-language edition is a reputable, peer-reviewed scientific publication, and it is at least as reliable—if not more so for an English-language adjudicatory forum—than a party-supplied translation of a German article. AbTis's approach ensured that the Board had direct access to the disclosed scientific content in English without risk of translation error or interpretive dispute.

Nothing in the PTAB's rules requires a party to object to a foreign-language reference when the same publication is available in an official English edition. Petitioner cannot plausibly claim prejudice where AbTis relied on the journal's authoritative English publication rather than contesting issues that, from AbTis's perspective, were more cleanly resolved by reliance on the English edition itself.

iii. The Substance of Exhibit 2009 Controls, Not AbTis's Reference to a "Translation"

At most, AbTis's reference to Exhibit 2009, in its Exhibit List, as a "translation" reflects imprecise nomenclature, not a substantive evidentiary flaw. PTAB practice looks to substance over labels, and the substance here is clear: Exhibit 2009 is a publicly disseminated English-language scientific publication.

Critically, Petitioner does not allege any inaccuracy, mistranslation, or discrepancy between the English and German editions. Nor does Petitioner contend that Exhibit 2009 misrepresents or distorts the disclosed science. In the absence of any such showing, exclusion would elevate form over substance and conflict with the Board's strong preference to resolve patentability issues on a complete and reliable record.

III. CONCLUSION

AbTis respectfully requests that the Board deny Petitioner's Motion to Exclude Exhibit 2008 and Exhibit 2009.

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Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on April 24, 2026, a true and correct copy of the foregoing was caused to be served on the following counsel of record for Petitioner by electronic mail at the following address:

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