

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SUMITOMO ELECTRIC INDUSTRIES, LTD.,  
Petitioner,

v.

UNITED TECHNOLOGIES CORPORATION,  
Patent Owner.

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Case IPR2017-00966  
Patent 9,166,243 B2

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Before CHRISTOPHER L. CRUMBLEY and JON B. TORNQUIST,  
*Administrative Patent Judges.*

CRUMBLEY, *Administrative Patent Judge.*

ORDER  
Conduct of the Proceeding  
*37 C.F.R. § 42.5(a)*

At the request of Patent Owner United Technologies Corporation (“UTC”), the Board held a conference call in this matter on March 23, 2018. UTC requested the call to seek authorization to file a motion to submit supplemental information under 37 C.F.R. § 42.123(b). In particular, UTC

desires to file a declaration from David Baldwin, a translator, regarding the proper translation of a Japanese-language reference (“JP228,” Ex. 1003) that forms the basis of the patentability challenges at issue in this *inter partes* review. Petitioner Sumitomo Electric Industries (“SEI”) opposed the request.

Counsel for UTC explained that the translation of JP228 only came into dispute upon the filing of SEI’s Reply, which was accompanied by the Supplemental Declaration of James Yaegashi (Ex. 1066). In the Supplemental Declaration, UTC alleges, Mr. Yaegashi altered his prior translation of JP228 (Ex. 1004), in particular his interpretation of whether a voltage potential expressed at column 3, line 19 of JP228 is positive or negative. UTC asks that the declaration of Mr. Baldwin be entered into the record to address this change.

During the call, it became apparent that the parties had not sufficiently met and conferred prior to contacting the Board, because UTC had not provided SEI with the proposed declaration by Mr. Baldwin. The panel asked the parties to continue to confer and see if agreement could be reached to enter the Baldwin declaration into the record without need for a motion for supplemental information. The parties were also advised that, in the absence of an agreement, the Board would consider permitting UTC to file a short sur-reply with the Baldwin declaration, with the possibility of a responsive paper from SEI.

On March 26, 2018, UTC provided an update to the Board via an e-mail, a copy of which has been entered into the record as Exhibit 3001. As set forth in the e-mail, the parties appear to have reached agreement as to the

filing of the Baldwin declaration without the need for further briefing,<sup>1</sup> and both counsel propose to address the issue at oral argument. The Board appreciates the parties' efforts to find common ground on this issue, and will permit the Baldwin declaration to be addressed at oral argument.

One remaining issue remains unresolved. As set forth in the e-mail, UTC proposes to include with the Baldwin declaration an Exhibit A, which is a translation of JP228 that Mr. Baldwin prepared in November 2016, before the filing of SEI's Petition for *inter partes* review. SEI objects to entering this pre-existing translation into the record, because it "was never previously disclosed to Petitioner, is not of record in this IPR, and was not a part of Patent Owner's requested motion to supplement." *Id.* UTC argues that the pre-existing translation is probative of Mr. Baldwin's credibility, because it was prepared independently of the *inter partes* review and before the dispute over Mr. Yaegashi's translation arose. *Id.*

We agree with UTC that the pre-existing Baldwin translation is probative of Mr. Baldwin's credibility, and may be useful to the Board in resolving the dispute over the change in Mr. Yaegashi's translation. But SEI's objection to the late nature of Mr. Baldwin's translation, of which UTC has been in possession for over a year, also has merit. We consider it improper to admit the pre-existing Baldwin translation as independent evidence of the proper translation of JP228; if UTC had desired the Board to consider the Baldwin translation on its own, it could have been submitted earlier in the proceeding and SEI would have had the opportunity to fully explore and contest the translation. We will permit UTC, however, to file

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<sup>1</sup> UTC's e-mail conveys SEI's position that "no further briefing or papers should be filed on this issue." Ex. 3001.

the translation as Exhibit A, solely for the limited purpose of establishing Mr. Baldwin's credibility and resolving the dispute over Mr. Yaegashi's translation. The Board will not consider the Baldwin translation as independent evidence of the proper translation of JP228 on issues beyond the change in Mr. Yaegashi's translation.<sup>2</sup>

In light of the foregoing, it is

ORDERED that Patent Owner is authorized to enter into the record the declaration of David Baldwin, as agreed to by the parties;

FURTHER ORDERED that the Baldwin declaration may be accompanied by an Exhibit A that will be considered by the Board only for the limited purpose set forth above; and

FURTHER ORDERED that no further briefing is authorized, but the parties may address the Baldwin declaration at oral argument.

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<sup>2</sup> In its email to the Board, UTC agrees with this limited approach, stating that “[b]eyond [the voltage potential] point, UTC is not attempting to initiate a dispute as to the appropriate translation.” Ex. 3001.

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