

Zhongshan Broad Ocean Motor Co., Ltd. v. Nidec Motor Corp.: Denying Rehearing IPR2014-01121, 01122, 01123

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Takeaway: The failure to include with a petition an attesting affidavit for an English translation of a foreign reference may potentially be addressed through the submission of supplemental evidence; however, a new filing date may be assigned to the petition based on the service date of the supplemental evidence.

In its [Decision](#), the Board denied Petitioner's request for rehearing of its decision denying institution of the 01123 IPR and denying certain grounds in both the 01121 and 01122 IPRs. In particular, Petitioners sought rehearing of the Board's determination that Petitioner relied upon a reference that was defective under 37 C.F.R. § 42.63(b) – a Japanese reference filed with an English translation but without an attesting affidavit as required by the rule. Petitioner's Request for Rehearing advanced “arguments involving (1) regulations for making and responding to evidentiary objections under 37 C.F.R. § 42.64(b); (2) regulations for correction of clerical or typographical mistakes under 37 C.F.R. § 42.104(c); and (3) our discretion under 37 C.F.R. §§ 42.5(b) and (c)(3).”

The Board reviews decisions on institution for an abuse of discretion, which could occur “where the decision (1) is clearly unreasonable, arbitrary, or fanciful; (2) is based on an erroneous conclusion of law; (3) rests on clearly erroneous fact findings; or (4) involves a record that contains no evidence on which the Board could rationally base its decision.”

The Board first addressed Petitioner's argument related to evidentiary objections. Petitioner argued that the rules contemplate service of supplemental evidence upon an objection to the evidence in the Petition, and that the attesting affidavits that were later obtained constitute supplemental evidence. The Board agreed with Petitioner; however, the Board found that the later service of the attesting affidavits did not “have the curative effect Petitioner desire.” In this regard, the translation of a reference is to be filed with the document, and Petitioner's later submission would require that the Board assign a new filing date. Because the new date would be more than a year after service of the complaint in the related litigation, Petitioner would be time barred.

The Board distinguished *Toyota Motor Corp. v. American Vehicular Sciences LLC*, Case No. IPR2013-00415 (PTAB Dec. 5, 2013) (Paper 14) from the present situation. In *Toyota*, an attesting affidavit was filed with the petition but was found to be defective. “The distinction between correction of an already filed, but defective, attesting affidavit and an attempt to file a new later-obtained

attesting affidavit is fundamental.”

Turning to the argument concerning correction of clerical or typographical errors, the Board found the failure to include an attesting affidavit was not because of a “clerical mistake.” The Board also declined Petitioner’s invitation to “extend the basis for curing mistakes beyond what 37 C.F.R. § 42.104(c) explicitly authorizes.”

Finally, addressing the Board’s discretion, the Board agreed that it has discretion, “under 37 C.F.R. § 42.5(b), to waive any requirement of 37 C.F.R. Part 42, which includes the requirement in § 42.63(b) to include attesting affidavits with translations of foreign-language documents.” Petitioner also argued that the Board could excuse a late action under 37 C.F.R. § 42.5(c)(3) upon a showing of good cause. The Board noted that the defect to be excused was not one of timeliness, but that the defect resulted in incomplete translations on the filing date. Thus, while Petitioner may be allowed to file the attesting affidavits late, the Petitions were not entitled to retain their filing dates. Accordingly, the Board was not persuaded to waive the requirement of 37 C.F.R. § 42.63(b) in this case.

Zhongshan Broad Ocean Motor Co., Ltd. v. Nidec Motor Corp., IPR2014-01121, IPR2014-01122, IPR2014-01123

Paper 25: Decision Denying Requests for Rehearing

Dated: February 24, 2015

Patents: 7,626,349 B2; 7,208,895 B2; 7,312,970 B2

Before: Benjamin D.M. Wood, James A. Tartal, and Patrick M. Boucher

Written by: Boucher

Related Proceeding: *Nidec Motor Corporation v. Broad Ocean Motor LLC et al.*, Civil Action No. 4:13-CV-01895-JCH (E.D. Mo., Sept. 25, 2013)

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