

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MERCEDES-BENZ USA, LLC,

Petitioner,

v.

DAEDALUS PRIME LLC,

Patent Owner.

Case No.: IPR2023-01344

U.S. Patent No. 9,575,895

PATENT OWNER'S MOTION TO EXCLUDE

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I. INTRODUCTION

Pursuant to 37 C.F.R. §§ 42.62(a) and 42.64(c), Patent Owner, Daedalus Prime LLC, respectfully moves to exclude exhibit 1019 submitted by Petitioner, MB USA, in support of Petitioner's Reply to Patent Owner's Response.

II. STATEMENT OF MATERIAL FACTS

In Patent Owner's Response, filed May 28, 2024, Patent Owner noted that the Xu reference, Ex. 1005, failed to qualify as prior art to the '895 patent because it had not been shown to have been disseminated or otherwise made available prior to the invention claimed in the '895 patent. POR at 25 *et seq.* With its Reply filed Sep. 11, 2024, MB USA submitted Ex. 1019, purporting to be a webpage that is a "Copyright Record of 2011 NORCHIP with the U.S. Copyright Office." Reply at iii, 14. No authenticating declaration or other evidence was submitted with Ex. 1019. Accordingly, Patent Owner timely filed objections to Ex. 1019 on Sep. 16, 2024. MB USA did not submit any supplemental evidence in response to Patent Owner's objections.

III. ARGUMENT

The Board should exclude Ex. 1019 as containing inadmissible hearsay and as not having been properly authenticated.

The Federal Rules of Evidence (FRE) apply to this proceeding. 37 C.F.R. § 42.62(a). Only relevant evidence is admissible, unless its “probative value is substantially outweighed by the danger of unfair prejudice,” in which case it may be excluded. FRE 403. In addition, statements not made while testifying at the current trial or hearing offered to prove the truth of the matter asserted are inadmissible unless an exception justifies admission. FRE 801–803. Lastly, to authenticate an item of evidence, “the proponent must produce evidence sufficient to support a finding that the item is what the proponent claims it is.” FRE 901.

Exhibit 1019 is alleged to be a copyright record of the Xu reference from the U.S. Copyright Office. Reply at 14. At best, however, the exhibit appears to be a printout of a webpage. However, as there are no identifying criteria showing a website from which this page was obtained or when, and no accompanying declaration attesting to its origin or the circumstances of its production it cannot be determined with any certainty when, how, or from where this exhibit was produced. The exhibit itself purports to state that a work entitled “2011 NORCHIP (11EX5488),” which is said to be a “book” having 221 pages, was published “2011-12-22.” Ex. 1013. Notably, the Xu reference, Ex. 1005, is *not* entitled “2011 NORCHIP,” bears no indicators

that correspond to “11EX5488,” is not a “book,” and does not even reference the 2011 NORCHIP conference in any way.

Insofar as Ex. 1019 is being offered to prove the truth of the alleged public availability of Xu by way of a publication date, it is an out-of-court statement offered to prove the truth of a matter asserted therein and, as such, is hearsay. Accordingly, it should be excluded. *See* FRE 801, 802. There is no applicable exception.

Furthermore, as there has been no attempt to authenticate Exhibit 1019, it lacks any circumstantial guarantees of trustworthiness sufficient to permit admissibility under FRE 807. While a hearsay statement may be admitted “if it has circumstantial guarantees of trustworthiness, is offered as evidence of a material fact, is more probative on the point for which it is offered than any other evidence the proponent can obtain through reasonable efforts, and if admitting it will serve the interests of justice,” *SAP America, Inc. v. Lakshmi Arunachalam*, IPR2013-00194, Paper 67, slip op. at 36 (PTAB Sept. 18, 2014,); FRE 807(a)), these considerations do not favor admission in this instance. First, there are no circumstantial guarantees of trustworthiness because the nature of the evidence precludes any connection between the Xu reference itself and the copyright record which Ex. 1019 purports to be. The title of the work is different, there is no author name set

forth on Ex. 1019, and the Xu reference is not a “book” for which the copyright record purports to establish a publication date.¹ Second, there has been no testimony of a custodian of records or anyone else attesting to the manner in which Ex. 1019 was produced or of the way in which its contents were generated. The Board should require the proponent of such evidence to do more than print a page of a website, as this approach deprives the opposing party of any meaningful ability to cross examine a declarant or otherwise test the veracity of the proffered hearsay statements. The residual exception therefore should not rescue this evidence.

Exhibit 1019 has not been properly authenticated. A website printout is not self-authenticating. FRE 902. To authenticate websites, the proponent of the evidence must present testimony from a witness with personal knowledge of the website at issue that the document is what it is claimed to be. FRE 901; *see also EMC Corp. v. Personalweb Techs., LLC*, IPR2013-

¹ Not even Mr. MacPherson, a Director of the IEEE’s Governance & Policy Development Board, says he obtained a copy of Xu as part of a “book.” Instead, he states he obtained a copy of the Xu article (well after the filing date of the ’895 patent) through the IEEE Xplore website. Ex. 1013 at ¶ 9.

00084, Paper 64, slip op. at 45 (PTAB May 15, 2014). To do so, a witness authenticating electronic evidence must “provide factual specificity about the process by which the electronically stored information is created, acquired, maintained, and preserved without alteration or change, or the process by which it is produced if the result of system or process that does so.” *Loraine v. Markel Am. Ins. Co.*, 241 F.R.D. 534, 545 (D. Md. 2007). MB USA does not even attempt to meet this standard and instead provides nothing, not even a declaration of counsel that would attempt to establish the means by which Ex. 1019 was obtained. Accordingly, Ex. 1019 should be excluded.

IV. CONCLUSION

Petitioner has offered hearsay and unauthenticated evidence, Ex. 1019, in an attempt to prove a publication date of the Xu reference. Patent Owner timely filed its evidentiary objections, and Petitioner failed to cure the deficiencies in its evidence. Ex. 1019 should therefore be excluded as inadmissible under the Federal Rules of Evidence

Respectfully submitted,

Dated: November 13, 2024

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing:

PATENT OWNER'S MOTION TO EXCLUDE

was served on November 13, 2024, by filing this document through the PTAB P-TACTS System as well as by delivering a copy via email directed to the attorneys of record for the Petitioner at the following addresses:

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The parties have agreed to electronic service in this proceeding.

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