

Paper No. _____
Filed: November 19, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ALIGN TECHNOLOGY, INC.,
Petitioner,

v.

DENTAL MONITORING, SAS,
Patent Owner.

Case No. IPR2023-01369
Patent No. 10,755,409

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

I. INTRODUCTION

As Patent Owner (PO) admits in its Motion to Exclude (“MTE,” Paper 34 at 1), Maninis (EX1007) was acquired from arXiv.org, and PO has further admitted that, as its stamp indicates, Maninis was submitted to arXiv.org for publication on April 28, 2017. *See* POR, 35. Dr. Foroosh explains in his declaration that he is familiar as a user and author who publishes on arXiv.org, that it “is an openly accessible, moderated repository for scholarly articles, covering an array of scientific fields. Authors submit their articles to arXiv.org to disseminate them freely to interested members of the public.” EX1002, ¶63.

PO does not dispute that by May 3, 2017, five days after submitting Maninis to arXiv.org, the authors of Maninis included a link on their website to Maninis’s arXiv.org page to further disseminate their paper to the scientific community, as shown in the archived webpage reproduced in EX1024. Nor does PO dispute that a version of Maninis (EX1021) with materially the same disclosure had already been published by arXiv.org prior to the April 28, 2017, submission date of EX1007. POR, 36. As explained in the petition materials, the published policies of arXiv.org at the time indicate that submitted papers are published promptly after submission and that a given version, once created, is not subsequently changed. Pet., 10-11; EX1002, ¶¶62-67; *see* EX1026 (articles publicly available about one business day after day of submission and kept permanently unchanged); EX1023 (same policy

maintained after submission of Maninis); EX1025 (detailing timeline of publication for submissions); *see also* EX1026 (author page containing link to directly download EX1007). Together, the evidence shows Maninis was published prior to July 21, 2017, the earliest claimed priority date of the '409 patent.

Patent Owner's (PO's) Motion to Exclude presents a layered collateral attack on a subset of the evidence showing Maninis's date of publication. PO argues that exhibits 1022, 1023, 1025, and 1026 lack authenticity by seeking to exclude an authenticating exhibit (EX1031) from the Internet Archive as untimely, despite clear caselaw establishing its filing with Petitioner's reply was timely. PO further argues the exhibits are hearsay, yet the exhibits are admissible as non-hearsay as well as based on multiple hearsay exceptions. Finally, PO seeks to exclude Dr. Foroosh's testimony explaining the publication of Maninis based on archived webpages showing arXiv.org's publication practices, his own contemporaneous experience publishing on arXiv.org, and further evidence substantiating Maninis's publication and dissemination to the public. None of PO's arguments justifies exclusion of Dr. Foroosh's testimony. In sum, and as explained below, PO fails to identify any sustainable basis to exclude any of the exhibits challenged in its Motion to Exclude, and it should thus be denied.

II. EX1031 IS ADMISSIBLE AND NOT UNTIMELY

EX1031 is a declaration from Nathaniel E. Frank-White, a records request

processor from the Internet Archive, authenticating four pages from the Internet Archive's Wayback Machine: the pages reproduced in EX1022, EX1023, EX1025, and EX1026. Mr. Frank-White also explains how the URLs of each of these pages indicate the archival dates of each page (each URL corresponding to the dates indicated by Dr. Foroosh in paragraphs 63-67 and on page 126 of EX1002, and as indicated in Petitioner's exhibit list), and provides copies of those pages as stored by the Wayback Machine on their respective archive dates.

PO identifies no evidentiary basis for excluding EX1031. PO's only asserted basis to exclude EX1031 is alleged untimeliness, relying on two PTAB cases from 2015 and 2016. MTE, 10-12 (citing *Toshiba Corp. v. Optical Devices, LLC*, IPR2014-01446, Paper 31 at 32 (March 9, 2016); *Standard Innovation Corp. v. Lelo, Inc.*, IPR2014-00148, Paper 42 at 6-7, 2015 WL 1906730, *4-5 (April 23, 2015)). Specifically, PO asserts that EX1031 was untimely because it was filed with Petitioner's reply. *Id.*

As an initial matter, "an allegation that evidence does not comply with 37 C.F.R. §42.23 is not a sufficient reason under the Federal Rules of Evidence for making an objection and requesting exclusion of such evidence." *Advanced Micro Devices, Inc. v. Aquila Innovations, Inc.*, IPR2019-01526, Paper 37 at 103-104 (Mar. 10, 2021) (citing *Palo Alto Networks, Inc. v. Finjan Inc.*, IPR2015-01979, Paper 62 at 66 (Mar. 15, 2017); *see also* MTE, 11 (citing 37 C.F.R §42.23 as basis

for exclusion). PO's failure to cite any Federal Rule of Evidence in its argument for exclusion of EX1031 is reason enough to reject its effort.

Beyond that, PO's reliance on *Toshiba* and *Standard Innovation* is misplaced. The Federal Circuit addressed this issue squarely in *VidStream LLC v. Twitter, Inc.*, 981 F.3d 1060 (Fed. Cir. 2020). In *VidStream*, patent owner challenged the publication date of a prior art reference, and petitioner filed evidence supporting a date of publication of that reference with its reply. *Id.*, 1064. The Federal Circuit held that the Board properly denied a motion to exclude filed by patent owner, because filing such evidence is a proper reply to a challenge to a publication date in a patent owner response, and because patent owner had an opportunity to respond in its sur-reply, holding that by allowing the evidence the Board was "acting appropriately...in pursuit of the correct answer." *Id.*, 1065. The Board has subsequently recognized, citing *VidStream*, that the approach in *Toshiba* is no longer appropriate, and that such reply evidence was not inadmissible as "untimely supplemental evidence." *Advanced Micro Devices*, IPR2019-01526, Paper 37 at 101-03.

Here, the POR challenged Maninis's publication date and challenged the authenticity of the exhibits demonstrating that publication date. POR, 35-26. Exhibit 1031 responds to both of these challenges, demonstrating the authenticity of each of EX1022, EX1023, EX1025, and EX1026 via a custodial declaration, as

well as independently providing the same evidence as those four documents by providing authenticated copies of each archived webpage within the exhibit itself. *See* EX1031, Ex. A. Under *VidStream* and *Advanced Micro Devices*, EX1031 is thus proper reply evidence.

PO's remaining arguments against EX1031 are directed to alleged hearsay in the underlying exhibits, not to EX1031 itself. MTE, 12. Further, to the extent PO asserts Mr. Frank-White's declaration "cannot establish any hearsay exception" (*id.*), that is wrong: EX1031 satisfies the exceptions under Fed. R. Evid. 803(6) regarding the archived content of each of EX1022, EX1023, EX1025, and EX1026, as EX1031 shows the records were made by the Internet Archive at the respective archiving times, were kept in the course of its regular activities, of the type regularly kept, and PO has shown no circumstances indicating untrustworthiness. *See also* EX1030 (providing same description of practices).

Accordingly, PO's motion to exclude EX1031 should be denied.

III. EX1022, EX1023, EX1025, AND EX1026 ARE ADMISSIBLE

PO seeks to exclude EX1022, EX1023, EX1025, and EX1026 on grounds of authenticity and hearsay. MTE, 8-10. PO's motion should be denied, as neither of PO's proposed evidentiary bases withstands scrutiny.

A. EX1022, EX1023, EX1025, and EX1026 are Authentic

Regarding authenticity, PO asserts that no testimony establishes the

“reliability and functioning of the Internet Archive,” and that no “facially recognizable date” is provided for the exhibits. MTE, 8-9. Both of these assertions are false.

To begin with, EX1031 indisputably meets these requirements, as Mr. Frank-White explains the reliable functioning of the Internet Archive’s Wayback Machine and explains how each page’s URL reflects its archiving date. EX1031. He also provides copies of each exhibit and its corresponding URL. *See id.*, Ex. A. This alone satisfies the authenticity requirements for each exhibit. *See also supra* §II. PO’s motion is silent on EX1031 when arguing EX1022, EX1023, EX1025, and EX1026 lack authenticating testimony.

Furthermore, EX1030 is another declaration from Mr. Frank-White (which PO has not moved to exclude), and which provides the same testimony regarding the regular practices of the Internet Archive and the meaning of its URLs. Each of EX1022, EX1023, EX1025, and EX1026 contains the URL from which it was printed in its header, as PO notes. *See* MTE, 3-5. The same URLs from which each page was printed were provided by Dr. Foroosh in his original declaration (EX1002, p. 126 (Appendix of Exhibits)), as well as in Petitioner’s exhibit list. *See also* EX1002, ¶¶65-67 (describing each archived page). Mr. Frank-White’s explanation of the Internet Archive’s functionality (*see* EX1030; EX1031) shows that these URLs confirm the archiving dates of EX1022, EX1023, EX1025, and

EX1026 (May 3, 2017; July 18, 2017; July 8, 2017; and Sep. 8, 2016, respectively).

The reliability of the Internet Archive's Wayback Machine to show dates of publication cannot reasonably be questioned. Indeed, the Federal Circuit has approvingly noted that multiple district courts have taken judicial notice of Internet Archive, because its archived webpages constituted "facts that can be accurately and readily determined from sources whose accuracy cannot reasonably be questioned." *Valve Corp. v. Ironburg Inventions Ltd.*, 8 F.4th 1364, 1374 (Fed. Cir. 2021) (quoting *Erickson v. Neb. Mach. Co.*, No. 15-CV-01147-JD, 2015 WL 4089849, at *1 n.1 (N.D. Cal. July 6, 2015) and stating, "We agree.").

Accordingly, each of EX1022, EX1023, EX1025, and EX1026 is authentic.

B. EX1022, EX1023, EX1025, and EX1026 are not Inadmissible Hearsay

PO argues that EX1022, EX1023, EX1025, and EX1026 are hearsay not subject to any exception. Regarding the exhibits themselves (i.e., copies of archived webpages generated and maintained by Internet Archive), they are admissible at least under the business records exception (Fed. R. Evid. 803(6)) based at least on the declarations of Mr. Frank-White, as discussed in §§II and III.A. PO's arguments are not focused on this aspect, but rather on the statements contained within the exhibits. However, as explained below, the statements in

these exhibits are not hearsay, or to the extent they are hearsay, they are nonetheless admissible under hearsay exceptions, as described at least in Rules 803(3), 803(6), and 807.

First, PO's hearsay arguments are not applicable to EX1025. PO argues Align relies on statements in the four exhibits "as establishing arXiv.org's actual policies as of [their] putative archival dates." MTE, 10. But Align does not rely on EX1025 to demonstrate arXiv.org's publication policy. *See, e.g.*, Pet., 11; Reply, 6; EX1002, ¶67. EX1025 is a page showing the arXiv.org publications of Dr. Luc van Gool, one of Maninis's authors. As Dr. Foroosh explained, the archived page includes a link both to Maninis's abstract page (<https://arxiv.org/abs/1701.04658>), and a link to directly download EX1007 (<https://arxiv.org/pdf/1701.04658>). There is no statement in EX1025 relied on for the matter asserted; rather, the existence of the archived page shown in EX1025 shows that POSAs were provided with a link from which to directly download EX1007 prior to the '409 patent's earliest claimed priority date.¹ This shows that Maninis was available to POSAs at the

¹ PO only disputes which version of Maninis (EX1007 or EX1021) the link provided. However, as PO does not dispute, the two contain materially identical disclosure. Pet., 11 (noting material identity of disclosure); EX1002, ¶62; POR, 36; Sur-Reply, 7. Where a document contains the same material disclosure as a prior

time. EX1025 is not hearsay, and PO's argument that it is relied on to establish arXiv.org's policies is misplaced.

EX1022, EX1023, and EX1026 are also admissible for non-hearsay purposes. These exhibits collectively show the policies that were communicated to authors by arXiv.org, explaining how its publication process would work, and in particular indicating that submitted papers would be published according to a defined schedule, putting their publication within about one business day of submission. It is undisputed that Maninis's authors submitted EX1007 to arXiv.org on April 28, 2017. EX1022, EX1023, and EX1026 support the inference that the authors made that submission in order to cause Maninis to be published according to those policies and that they reasonably expected publication within about a business day. This supports the further conclusion that such publication did occur as scheduled, and certainly prior to the '409 patent's earliest claimed priority date. *See also Catalan v. GMAC Mortg. Corp.*, 629 F.3d 676, 694 (7th Cir. 2011) (written statements describing bank's intentions admissible as non-hearsay).

These exhibits are also admissible for the truth of the matter asserted, under

art version of the document, that suffices to show that the document is also prior art, notwithstanding minor, non-material differences. *Valve*, 8 F.4th at 1370-71 (citing Fed. R. Evid. 901(b)(3)).

at least the hearsay exceptions of Fed. R. Evid. 803(3), 803(6), and 807.

Rule 803(3) provides an exception to the hearsay rule for statements that show, *inter alia*, a person's plan or intent. It has been long established that such statements are admissible to show that such a person acted according to that plan or intent. *E.g.*, *Mutual Life Ins. Co. v. Hillman*, 145 U.S. 285, 295-96 (1892); *see also, e.g.*, *Packgen v. Berry Plastics Corp.*, 847 F.3d 80, 90-91 (1st Cir. 2017) (statements by refineries of plans to purchase products when needed admissible under 803(3)); *Catalan*, 629 F.3d at 694 (written statements describing bank's intentions admissible under 803(3)).

Together, EX1022, EX1023, and EX1026 express the intentions or plans of arXiv.org to make each submitted paper available and to keep those papers available to the public continuously, at times after about one business day of submission. Each of these intentions or plans was expressed prior to the '409 patent's earliest claimed priority date of July 21, 2017, and they support a finding that Maninis was in fact made publicly accessible prior to that date. *See also* Fed. R. Evid. 406 ("Evidence of a person's habit or an organization's routine practice may be admitted to prove that on a particular occasion the person or organization acted in accordance with the habit or routine practice. The court may admit this evidence regardless of whether it is corroborated or whether there was an eyewitness."); *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1569

(Fed. Cir. 1988) (“Evidence of routine business practice can be sufficient to prove that a reference was made accessible before a critical date.”).

PO also asserts that the 803(6) exception is not met (MTE, 12); however, this overlooks the testimony of Dr. Foroosh, who explained how arXiv.org operated based on his own experience using the site, including uploading multiple papers to the site in May of 2017. EX1002, ¶¶62-67. There is no requirement of custodian testimony from an employee of the record-keeper; it suffices under Rules 803(6) and 902(11) that a person understand the system used. *Samsung Elecs. Co. v. Huawei Techs. Co.*, IPR2017-01487, Paper 45 at 17-20 (Dec. 10, 2018) (admitting webpages and testimony regarding same to prove prior art publication).

Moreover, to the extent any of EX1022, EX1023, EX1025, and EX1026 are found to be hearsay not subject to a hearsay exception, they are admissible under the residual hearsay rule. Fed. R. Evid. 807. Under Rule 807, a statement is admissible notwithstanding a hearsay objection, even if the exceptions under Rules 803 and 804 do not apply, if it has “sufficient guarantees of trustworthiness” after considering “the totality of circumstances under which it was made and evidence, if any, corroborating the statement,” and if it is more probative for the point on which it is offered than other evidence obtained through reasonable efforts.

These exhibits demonstrate the publicly-announced policies of arXiv.org of the mechanical process by which it published of submitted papers. Given that

Maninis was undisputedly submitted for publication according to those policies on April 28, 2017, these archived statements are more probative than other reasonably available evidence regarding what the policies at the time were, since they are direct, contemporaneous, public statements of those policies by arXiv.org itself.

Further evidence also corroborates the statements. Dr. Foroosh describes arXiv.org's publication practices based on his personal experience, which confirms the policies described in these exhibits were being regularly followed. EX1002, ¶¶62-67. Furthermore, Dr. Foroosh explained that the metadata in Maninis indicate it was created and last modified on April 30, 2017, matching the timeline for the article's publication. EX1002, ¶66. In particular, the metadata is visible in a copy of Maninis downloaded from arXiv.org, in the properties window when opened in a PDF reader. EX1029, ¶3. The inclusion of a link on the authors' webpage (EX1024) and the presence of a download link in EX1025 further corroborate Maninis's publication under arXiv.org's policies, as they indicate that third parties, as well as the authors of Maninis, were being directed to the site and would have an opportunity to notice and correct any failure to publish Maninis as intended.

Accordingly, EX1022, EX1023, EX1025, and EX1026 are admissible as non-hearsay or under at least the exceptions of Rules 803(3), 803(6), and 807, and PO's Motion to Exclude these exhibits should thus be denied.

IV. PARAGRAPHS 62-67 OF EX1002 ARE ADMISSIBLE

PO asserts that Dr. Foroosh's testimony in EX1002, ¶¶62-67 is improper lay or expert testimony and that it lacks foundation. Each of these arguments fails.

Regarding foundation, PO attacks Dr. Foroosh's reliance on EX1022, EX1023, EX1025, and EX1026 (MTE, 14-15), but as discussed above in §III, each of these exhibits is admissible, and each provides proper foundation for Dr. Foroosh's discussion of them in EX1002, ¶¶62-67.

PO also seeks to exclude Dr. Foroosh's testimony as improper expert testimony. However, Dr. Foroosh's expertise provides foundation for all expert testimony offered. For example, in paragraph 66, Dr. Foroosh discusses how the metadata of the Maninis paper corroborate its date of creation and last modification as April 30, 2017. EX1002, ¶66. EX1029, served as supplemental evidence in response to PO's objections, provides further details substantiating the basis for Dr. Foroosh's testimony on this point. EX1029, ¶3. PO does not and cannot argue that Dr. Foroosh lacks expertise as a computer scientist to analyze a file's metadata.

Regarding Dr. Foroosh's own personal knowledge of arXiv.org's practices, PO seeks to cabin such testimony to expert testimony under Rules 702 and 703. However, Dr. Foroosh clearly explains that he is describing his personal experience as a user of arXiv.org at and about the time that Maninis was published. See EX1002, ¶63 (familiar with processes practiced by arXiv.org and submitted

multiple papers in May 2017), 64-67 (other routine practices consistent with personal experience). Under Rule 406, evidence of “an organization’s routine practice” is admissible as evidence that it acted in accordance with that practice, “regardless of whether it is corroborated or whether there was an eyewitness.” Fed. R. Evid. 406. There is no expert qualification requirement to provide such routine practice. *See also* Fed. R. Evid 701 (opinion testimony admissible if rationally based on perception and helpful to determine fact in issue); *Cooler Masters Co. v. Aavid Thermalloy LLC*, IPR2019-00337, Paper 49 at 30, 37-38 (testimony of routine practice of Japanese Patent Office sufficient to establish publication).

Regardless, Dr. Foroosh has explained how he obtained via experience any specialized knowledge he relied on in describing arXiv.org’s publication practice at the time. *See, e.g.*, EX1002, ¶63. At minimum, Dr. Foroosh’s experience in disseminating papers via arXiv.org provides him with “specialized knowledge” to help determine facts in issue, and his discussion in ¶¶62-67 bases his opinions on sufficient facts or data, applied reliably to the facts of the case. Fed. R. Evid. 702.

PO’s reliance (MTE, 13-14) on *Dish Network L.L.C. v. Dragon Intellectual Prop. LLC*, IPR2015-00499, Paper 7, is also misplaced. In *Dish Network*, the Board found a professor’s testimony did not show that the “indexing and cataloging” practices of a library were sufficient to enable POSAs to locate a thesis. *Id.*, 10-11. Here, the ability of POSAs to locate Maninis is not in question; it

was published online, and its dissemination via the Internet is demonstrated by multiple exhibits captured by the Wayback Machine. *See, e.g.*, EX1024 (authors' academic webpage); EX1026 (direct download link). By contrast, Dr. Foroosh's personal knowledge and experience with arXiv.org corroborates its manner of publication, confirming the date on which Maninis was publicly available for download. *See* EX1002, ¶¶62-67. Dr. Foroosh's personal experience as an author who published papers on arXiv.org is admissible evidence of the practices followed by arXiv.org when Maninis was submitted for publication. *See id.*

Accordingly, PO's Motion to Exclude EX1002, ¶¶63-67 should be denied.

V. CONCLUSION

None of PO's arguments justify exclusion of any of exhibits 1022, 1023, 1025, 1026, 1031, or paragraphs 62-67 of exhibit 1002. Petitioner has sufficiently authenticated each challenged exhibit and PO's objection to the timeliness of EX1031 is unfounded. PO's hearsay arguments also fail, as each challenged exhibit is admissible as either non-hearsay or under an applicable exception. Finally, PO's arguments against Dr. Foroosh's testimony in paragraphs 62-67 of EX1002 are based on PO's faulty challenges to exhibits 1022, 1023, 1025, 1026, fail to properly address Dr. Foroosh's expertise, and misapply standards for testimony showing routine practice of organizations. Accordingly, PO's Motion to Exclude should be *denied*.

Respectfully submitted,

Dated: November 19, 2024

/ Matthew A. Argenti /

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CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing Petitioner's Opposition to Patent Owner's Motion to Exclude and Exhibit 1029 were served on November 19, 2024, at the following electronic service addresses:

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Respectfully submitted,

Dated: November 19, 2024

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