

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

U.S. Patent No. 10,755,409

**PATENT OWNER'S REPLY IN SUPPORT OF ITS
MOTION TO EXCLUDE**

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Patent Trial and Appeal Board
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Petitioner's opposition spends more pages arguing whether Maninis is prior art than both its Petition and Reply combined. The Board should disregard this improper extra briefing as unresponsive to the present motion. PTAB Trial Practice Guide 2019, 79. Petitioner's opposition otherwise fails as demonstrated below.

1. Exhibits 1022, 1023, 1025, and 1026 Lack Authenticity: Petitioner points to EX1030 as supplemental evidence establishing the "regular practices of the Internet Archive." Paper 35, 6-7. But EX1030 does not address the exhibits in question and thus does not confirm that they are the "true and accurate" result of any such practices. EX1030, 1. No other declarant has addressed the origin of Exhibits 1022, 1023, 1025, or 1026, and they are not self-authenticating. FRE 902.

Petitioner Also Cannot Rely on EX1031 for Authenticity. Petitioner argues that Patent Owner fails to identify a Federal Rule of Evidence to exclude EX1031. Paper 35, 3-4. Petitioner misses the point. EX1031 serves only to address authenticity, and it is undisputed that EX1031 was not timely served as supplemental evidence in response to Patent Owner's authenticity objections to Exhibits 1022, 1023, 1025, and 1026. Paper 34, 7-8. Had Petitioner not filed EX1031 in Reply, it would have no way to raise it now. 37 C.F.R. 42.64(b)(2); PTAB Trial Practice Guide 2019, 79. Petitioner cannot circumvent the rules by filing its untimely supplemental evidence and claiming it supports the merits. *E.g.*, *Standard Innovation Corp. v. Lelo, Inc.*, IPR2014-00148, 2015 WL 1906730, *4-5

(P.T.A.B. Apr. 23, 2015). EX1031 does not address the merits; it relates only to admissibility. Petitioner further implies that *Vidstream* created a new rule. Paper 35, 4. Not so. *Vidstream* addressed a reply submission of **substantive evidence** supporting the prior art status of a ground reference, not evidence supporting the **admissibility** of previously filed exhibits. *Vidstream LLC v. Twitter, Inc.*, 981 F.3d 1060, 1064-65 (Fed. Cir. 2020); Paper 35, 4. *Standard* drew precisely that distinction in excluding evidence supporting admissibility. 2015 WL 1906730, *4.

2. Exhibits 1022, 1023, 1025, and 1026 Are Hearsay: Petitioner raises numerous arguments. None holds up. First, Petitioner argues that Exhibits 1030 and 1031 provide custodial testimony satisfying FRE 803(6). Paper 35, 5, 7. However, FRE 803(6) provides a hearsay exception only if certain conditions are satisfied as “shown by the testimony of the custodian or another qualified witness.” Exhibits 1030 and 1031 are declarations from a custodian of the Internet Archive, **not of arXiv.org**, and contain no information regarding the latter. Even if competent to address the Internet Archive’s record of the “condition” of the arXiv.org website (*i.e.*, its appearance on the date archived), they do not—and cannot—address the statements **by arXiv.org** in the underlying webpages. Those statements are hearsay; no “qualified witness” addresses arXiv.org’s statements.

Second, Petitioner further argues that it does not rely on EX1025 for the truth of any matter, but instead to show the existence of a web link contained therein.

Paper 35, 8-9. But it is undisputed that the link also points to a different version of Maninis entirely (EX1021) and is thus not probative of the timing of Maninis's publication (EX1007). Paper 19, 36. To the extent that Petitioner asserts that EX1025 somehow states which version was linked, such a statement *is* offered for its truth and is thus inadmissible hearsay. Petitioner similarly argues that Exhibits 1022, 1023, and 1026 are admissible for non-hearsay purposes. *Id.*, 9. But Petitioner fails to cite anywhere it has relied on them for such purposes. *Id.*

Third, Petitioner's argument that these exhibits are admissible as hearsay under Rule 803(3) misapplies the law. Paper 35, 10 (citing *Mutual Life Ins. Co. v. Hillmon*, 145 U.S. 285, 295-96 (1892)). *Hillmon*, including as codified in Rule 803(3), applies only to statements of *future* conduct. *Shepard v. United States*, 290 U.S. 96, 105-06 (1933); Fed. R. Evid. 803(3) Notes of Committee on the Judiciary, House Report No. 93-650 (recognizing connection to *Hillmon* as limited to "statements of intent by a declarant admissible only to prove ... future conduct"). Petitioner relies on statements of what arXiv.org allegedly does *presently*, not what it intends to do in the future. *E.g.*, EX1022 ("Submissions to arXiv are normally made public on Sunday through Thursday"); EX1023 ("It is not possible to make changes without generating a new version"); EX1026 (same). Even if the publication timing table at the end of EX1022 were read as a statement of future conduct, it is a statement that was made as of its alleged archival date of **May 3**,

2017, five days **after** Maninis was submitted. Rule 803(3) thus does apply to admit this hearsay to prove Maninis published “**no later than May 2, 2017.**” Paper 2, 10.

Fourth, Rule 406 is irrelevant to whether the challenged exhibits are hearsay. Paper 35, 10. Regardless, none of the exhibits suffice to establish routine business practice. *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1568-69 (Fed. Cir. 1988) (relying on “extensive uncontroverted evidence of business practice”).

Fifth, Petitioner cannot admit these hearsay statements under Rule 807, which is reserved for “exceptional cases.” *E.g., Conoco Inc. v. Dep’t of Energy*, 99 F.3d 387, 392 (Fed. Cir. 1996); Paper 35, 11-12. Petitioner calls arXiv.org’s process “mechanical” but does not dispute that papers are subject to review prior to publication. Paper 35, 11; Paper 19, 36. Moreover, Petitioner’s “corroborat[ion]” argument is circular—Dr. Foroosh’s only familiarity with arXiv.org **policy** is through these exhibits, and his speculation regarding the metadata in EX1007 is meaningless without accepting the hearsay statements in EX1022. Paper 35, 12. Petitioner cannot corroborate inadmissible and/or non-probative evidence with more of the same.

3. EX1001, Paragraphs 62-67 Are Improper Opinions: Dr. Foroosh’s conclusion connecting the date EX1007 was created and the date that arXiv.org published it is pure speculation. Paper 35, 13. Petitioner does not meaningfully dispute that Dr. Foroosh’s testimony is beyond his personal knowledge and

expertise. Dr. Foroosh’s submission of a handful of his own articles to arXiv.org does not qualify him to opine generally on arXiv.org’s **policies** or **practices**. Cf. *Cooler Masters Co. v. Aavid Thermalloy LLC*, IPR2019-00337, Paper 49, 30 (Japanese patent attorney addressing Japanese patent office procedure); c.f. *Yumukoglu v. Provident Life & Acc. Ins. Co.*, 131 F. Supp. 2d 1215, 1227-28 (D.N.M. 2001) (limited observation inadmissible to show routine practice).

4. Petitioner’s entirely new merits theory is improper. Petitioner now proposes that the Board can rely on EX1021 in place of EX1007 because they are “material[ly]” the same. Paper 35, 8-9 n.1. Petitioner has never demonstrated how EX1021 relates to the challenged claims and cannot do so at this late stage and without analysis or citation. Petitioner’s reliance on *Valve Corp. v. Ironburg Inventions Ltd.*, 8 F.4th 1364 (Fed. Cir. 2021), is misplaced. *Valve* involved authentication of a “virtually identical” copy of an article already established as prior art. *Id.*, 1370-71. EX1021 and EX1007 are different **versions**, not **copies** of an article. Even casual comparison reveals that there are extensive differences relevant to the Petition that preclude authenticating EX1007 as the same publication as EX1021. See, e.g., EX1007, 13-14 (15 more citations than EX1021), 6 (adding paragraph on “Training details”), 11-12, Table 6 (adding PSPNet for semantic segmentation). Dr. Foroosh’s conclusory opinion that those differences are “minor” is irrelevant, and Petitioner’s new argument fails. EX1002, ¶31.

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Certificate of Service

Pursuant to 37 C.F.R. §§ 42.6(e), the undersigned certifies that on November 26, 2024, a complete copy of **PATENT OWNER'S REPLY IN SUPPORT OF ITS MOTION TO EXCLUDE** was served via electronic mail on the following counsel of record for Petitioner at the email addresses: mrosato@wsgr.com, margenti@wsgr.com, and pmedley@wsgr.com, as indicated in the Petition for electronic service to the following Petitioner counsel:

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