

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ALIGN TECHNOLOGY, INC.,

Petitioner,

v.

DENTAL MONITORING SAS,

Patent Owner.

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Case No. IPR2024-00052

U.S. Patent No. 11,049,248

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**PATENT OWNER'S MOTION TO EXCLUDE**

Mail Stop **Patent Board**  
Patent Trial and Appeal Board  
U.S. Patent and Trademark Office  
P.O. Box 1450  
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## **I. Introduction**

Petitioner's sole ground depends on Maninis (EX1007), an article Petitioner acquired from the website arXiv.org. Paper 2, 14; EX1007. Maninis undisputedly bears no publication date establishing its status as prior art. Paper 2, 10; Paper 20, 30-42; Paper 25, 7-8. Petitioner instead argues that arXiv.org's alleged policies at the time of Maninis's submission in April 2017 indicate that Maninis would have published before the July 21, 2017 priority date of the challenged claims of U.S. Patent No. 11,049,248. Paper 20, 40-42. To establish these alleged policies, Petitioner relies on putative archival snapshots of arXiv.org from the Internet Archive (also known as "The Wayback Machine") as establishing the policies of arXiv.org as of those dates. The contents of those arXiv.org webpages should be excluded because it is inadmissible hearsay not falling within any exception under the Federal Rules of Evidence.

Petitioner did not address the substance of these exhibits in its Petition, instead pointing to a discussion by its computer science expert, Dr. Foroosh. Paper 2, 10. Dr. Foroosh repeats the hearsay from the exhibits and offers opinions characterizing arXiv.org's policies, ultimately proposing a date by which Maninis "would have been transmitted to subscribers," despite admitting he has no personal knowledge of how Maninis was treated following submission. Dr. Foroosh's anecdotal experience as an occasional user of arXiv.org does not qualify him to

offer such speculation, and he does not even purport to testify on this subject as an expert. His discussion of these exhibits is inadmissible as *inter alia* lacking foundation, improper lay opinion testimony, and improper expert testimony. For those reasons, as further described below, these exhibits and Dr. Foroosh's inadmissible testimony should be excluded.

## **II. Exhibit Objections**

**Exhibit 1022.** Petitioner identifies Exhibit 1022 as the “arXiv.org Submission Help Page” “as archived May 3, 2017.” Paper 2, 66. Petitioner relies on a table as allegedly showing that arXiv.org would, as of May 3, 2017, “publish submitted papers within about one business day of the date of submission.” EX1022, 3; EX1002, ¶56; Paper 2, 10.

Patent Owner objected to Exhibit 1022 as inadmissible hearsay in its May 3, 2024 objections. Paper 16, 12.

**Exhibits 1023 and 1026.** Petitioner identifies Exhibits 1023 and 1026 as the “arXiv.org Article Replacement Help Page” “as archived July 18, 2017” and “September 8, 2016,” respectively. Paper 2, 66. Petitioner relies on Exhibits 1023 and 1026 to suggest that Maninis was not edited between its submission and its unknown date of publication, citing them for the proposition that “[o]nce a paper is announced, it was arXiv.org's stated policy that the paper may not be modified without creating a new version.” EX1002, ¶57; Paper 2, 10; EX1023, 1 (“It is not

possible to make changes [to an arXiv.org article] without generating a new version.”); EX1026, 1 (same).

Patent Owner objected to Exhibits 1023 and 1026 as inadmissible hearsay in its May 3, 2024 objections. Paper 16, 12-13, 14-15.

**Exhibit 1025.** Petitioner identifies Exhibit 1025 as the “arXiv.org Author Search Page for Luc van Gool” “as archived July 8, 2017.” Paper 2, 66. Petitioner relies on the content of the search results “as of July 8, 2017” as indicative of Maninis’s public availability. EX1002, ¶58; Paper 2, 10.

Patent Owner objected to Exhibit 1025 as inadmissible hearsay in its May 3, 2024 objections. Paper 16, 14.

**EX1002, ¶¶53-58.** Exhibit 1002 is the Declaration of Dr. Hassan Foroosh. Petitioner relies on Dr. Foroosh’s declaration for the assertion that Maninis was published “no later than May 2, 2017, on arXiv.org.” Paper 2, 10 (citing EX1002, ¶¶53-58). Lacking any direct evidence of a publication date, Dr. Foroosh extrapolates from the April 28, 2017, submission date stamped on the Maninis reference, opining that, among other things: (1) “it was the **established policy** of arXiv.org in 2017 to publish submitted papers within about one business day of the date of submission”; (2) Maninis thus “**would have been announced** on Sunday April 30, 2017, or Monday May 1, 2017, and **would have been transmitted** to subscribers no later than Tuesday May 2, 2017”; and (3) “the version of Maninis

submitted on April 28, 2017, **would not have been changed** after its announcement (on or about April 30, 2017).” EX1002, ¶¶56-57 (emphases added). For each proposition, Dr. Foroosh cites the same hearsay exhibits Patent Owner seeks to exclude here. EX1002, ¶¶53-58 (citing EX1022, EX1023, EX1025, and EX1026).

Dr. Foroosh further opines regarding the nature of arXiv.org’s publication practices, asserting that arXiv.org’s “method of publishing their papers [] **reliably** establishes a date of publication” and that “arXiv.org **consistently** publishes submitted documents to the interested scientific community **promptly** after submission.” *Id.*, ¶54 (emphases added).

Dr. Foroosh also opines that a link to Maninis’s abstract and direct download pages would have been returned in a search for one of the Maninis authors “**as of** July 8, 2017,” citing EX1025 as “**archived** July 8, 2017,” without further explanation. *Id.*, ¶58 (emphases added).

Dr. Foroosh thus arrives at the conclusion that “Maninis was available openly to general public and **disseminated** to the scientific community prior to July 21, 2017.” *Id.* (emphasis added).

Dr. Foroosh is Petitioner’s computer science expert and has no expertise relevant to the evaluation of Maninis’s publication date. EX1002, ¶¶1-13; EX1003. Dr. Foroosh confirmed in deposition that he has never worked for arXiv.org; has never been an arXiv.org article reviewer; does not know the identity of the

administrators of arXiv.org in April 2017; and has no personal knowledge of how Maninis was treated by arXiv.org. EX2048, 231:14-22, 232:16-20, 233:18-21, 234:6-24. Dr. Foroosh’s only knowledge of arXiv.org policies in 2017 comes from his limited experience as an occasional user and author. EX1002, ¶54; EX2048, 233:10-16. Dr. Foroosh does not purport to have any personal knowledge of Exhibits 1022, 1023, 1025, or 1026 or of the archival dates he attributes to those exhibits. *Id.*, ¶¶53-58.

Patent Owner objected to the testimony in Paragraphs 53-58 of Exhibit 1002 as hearsay, improper lay opinion, improper expert testimony, and as lacking personal knowledge. Paper 16, 1-4.

### **III. Argument**

#### **A. Exhibits 1022, 1023, 1025, and 1026 Are Inadmissible Hearsay**

Petitioner relies on the truth of the out-of-court statements in Exhibits 1022, 1023, 1025, and 1026, and they should be excluded as inadmissible hearsay.

Hearsay is not admissible unless it is subject to an exception. Fed. R. Evid. 802. It is beyond dispute that the statements on which Petitioner relies from Exhibits 1022, 1023, 1025, and 1026 were not made “at the current trial or hearing”—the statements by arXiv.org appear in archival webpage exhibits, not in a qualifying declaration. It is also beyond dispute that the statements are offered “to prove the truth of the matter asserted in the statement[s].” See Fed. R. Evid.

801(c). Petitioner and its expert depend on the statements regarding arXiv.org's alleged policies as establishing arXiv.org's actual policies as of those putative archival dates. *Supra*, §II. The statements are offered for no other reason; if the substance of the statements in these exhibits is not true, the statements would have no relevance, and Petitioner and its expert would lack any basis for its conclusions regarding arXiv.org's treatment of Maninis. Thus, the statements in Exhibits 1022, 1023, 1025, and 1026 are hearsay, they are inadmissible, and they should be excluded. *E.g., Standard Innovation Corp. v. Lelo, Inc.*, IPR2014-00148, Paper 42, 2015 WL 1906730, \*6-8 (P.T.A.B. Apr. 23, 2015).

**B. The Board Should Exclude Exhibit 1002, ¶¶53-58 as Lacking Foundation and as Improper Opinion Testimony**

Dr. Foroosh lacks sufficient knowledge and/or perception to rationally support the opinions he draws regarding Maninis's publication and the practices of arXiv.org. The Board should exclude his testimony on these issues.

“If a witness is not testifying as an expert, testimony in the form of an opinion is limited to one that is ... rationally based on the witness's perception.” Fed. R. Evid. 701(a). In particular, a “witness may testify to a matter only if evidence is introduced sufficient to support a finding that the witness has personal knowledge of the matter. Evidence to prove personal knowledge may consist of the witness's own testimony.” Fed. R. Evid. 602. Here, Dr. Foroosh admits that he has no

personal knowledge regarding the conclusions he draws concerning Maninis's publication date. *Supra*, §II. Nor does Dr. Foroosh's occasional and anecdotal experience provide a sufficient basis for his opinions regarding the "consisten[cy]," "reliab[ility]," or "prompt[ness]" of arXiv.org's publication practices, particularly as applied to a specific reference (*i.e.*, Maninis). *Supra*, §II. His testimony is thus inadmissible as lacking foundation and as improper lay opinion testimony. *C.f. Dish Network L.L.C. v. Dragon Intellectual Property, LLC*, IPR2015-00499, Paper 7 (P.T.A.B. July 17, 2015) (professor's testimony lacked personal knowledge regarding public availability of alleged prior art thesis and was insufficient evidence of university library practices).

Nor are Dr. Foroosh's opinions admissible as expert testimony. A witness must be "qualified as an expert by knowledge, skill, experience, training, or education" in order to "testify in the form of an opinion or otherwise." Fed. R. Evid. 702. In addition, the proponent of expert testimony must demonstrate how "the expert's scientific, technical, or other specialized knowledge will help the trier of fact to understand the evidence or to determine a fact in issue; the testimony is based on sufficient facts or data; the testimony is the product of reliable principles and methods; and the expert's opinion reflects a reliable application of the principles and methods to the facts of the case." *Id.* Only if an expert is qualified, may he "base

an opinion on facts or data in the case that the expert has been made aware of or personally observed.” Fed. R. Evid. 703.

Here, Petitioner has not shown that Dr. Foroosh is an expert in the policies of arXiv.org or in their likely application to Maninis. Dr. Foroosh confirmed that he has no “specialized knowledge” regarding arXiv.org, only anecdotal experience. *Supra*, §II. Even if qualified, his opinions regarding Maninis’s publication date are not the result of any disclosed principle or methodology—it is pure speculation based on his acceptance of the hearsay in Exhibits 1022, 1023, 1025, and 1026. Dr. Foroosh’s testimony is thus also inadmissible as improper expert testimony.

To the extent that Dr. Foroosh’s testimony simply repeats hearsay in the underlying exhibits, it is inadmissible for the same reason as above. *Supra*, §III.A.

#### **IV. Conclusion**

The statements in Exhibits 1022, 1023, 1025, and 1026 concerning arXiv.org’s alleged policies are hearsay, and Petitioner has no evidence that could establish an exception. That Petitioner chose to include its analysis of this evidence in the declaration of its computer-science expert Dr. Foroosh (EX1002, ¶¶53-58) rather than in the Petition is irrelevant—the statements are still hearsay when Dr. Foroosh repeats them. Nor does his declaration convert them into admissible expert or lay opinion testimony. Dr. Foroosh lacks any personal knowledge that would support his speculation about the nature of arXiv.org’s practices or how they were

applied to Maninis, and he does not have any specialized expertise and does not identify or apply any reliable methodology that would allow him to address those subjects as an expert.

For the foregoing reasons, Patent Owner respectfully requests that the Board exclude Exhibits 1022, 1023, 1025, and 1026, and paragraphs 53 through 58 of Exhibit 1002.

Date: January 8, 2025

Respectfully submitted,

By: /Charlotte Jacobsen/  
Charlotte Jacobsen (Reg. No. 80,455)  
Joshua Krevitt (Admitted *Pro Hac Vice*)  
Gibson, Dunn & Crutcher LLP  
200 Park Avenue  
New York, NY 10166-0193  
Tel: 212-351-3961  
Tel: 212-351-2490  
CJacobsen@gibsondunn.com  
JKrevitt@gibsondunn.com

Jaysen S. Chung (Reg. No. 68,199)  
Gibson, Dunn & Crutcher LLP  
555 Mission Street, Suite 3000  
San Francisco, CA 94105-0921  
Tel: 415-393-8271  
Fax: 415-374-8405  
Email: JSChung@gibsondunn.com

Andrew Blythe (Reg. No. 75,014)  
Gibson, Dunn & Crutcher LLP  
3161 Michelson Drive  
Irvine, CA 92612-4412  
Tel: 949-451-3926  
Fax: 949-475-4630  
Email: ABlythe@gibsondunn.com

*Counsel for Patent Owner*

**Certificate of Service**

Pursuant to 37 C.F.R. §§ 42.6(e), the undersigned certifies that on January 8, 2025, a complete copy of **PATENT OWNER'S 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:

Matthew A. Argenti (Reg. No. 61,836)  
WILSON SONSINI GOODRICH & ROSATI  
650 Page Mill Road  
Palo Alto, CA 94303  
Tel: 650-354-4154  
Fax: 866-947-7329  
Email: margenti@wsgr.com

Michael T. Rosato (Reg. No. 52,182)  
Patrick Medley (Reg. No. 74,735)  
WILSON SONSINI GOODRICH & ROSATI  
701 Fifth Avenue, Suite 5100  
Seattle, WA 98104-7036  
Tel.: 206-883-2529  
Tel.: 206-883-2593  
Fax: 866-947-7329  
Email: mrosato@wsgr.com  
Email: pmedley@wsgr.com

Date: January 8, 2025

Respectfully submitted,

By: /Charlotte Jacobsen/  
Charlotte Jacobsen (Reg. No. 80,455)  
Joshua Krevitt (Admitted *Pro Hac Vice*)  
Gibson, Dunn & Crutcher LLP  
200 Park Avenue  
New York, NY 10166-0193  
Tel: 212-351-3961  
Tel: 212-351-2490  
CJacobsen@gibsondunn.com  
JKrevitt@gibsondunn.com

Jaysen S. Chung (Reg. No. 68,199)  
Gibson, Dunn & Crutcher LLP  
555 Mission Street, Suite 3000  
San Francisco, CA 94105-0921  
Tel: 415-393-8271  
Fax: 415-374-8405  
Email: JSChung@gibsondunn.com

Andrew Blythe (Reg. No. 75,014)  
Gibson, Dunn & Crutcher LLP  
3161 Michelson Drive  
Irvine, CA 92612-4412  
Tel: 949-451-3926  
Fax: 949-475-4630  
Email: ABlythe@gibsondunn.com

*Counsel for Patent Owner*