

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. IPR2024-00052

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

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

Mail Stop **Patent Board**
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

The Board should grant PO's motion, despite (and because of) Petitioner's distortion of the FRE and injection of a new ground of unpatentability.

1. "Challenged Exhibits" 1022, 1023, 1025, and 1026 Are Inadmissible Hearsay: Petitioner misleadingly argues that PO's motion is moot because the Challenged Exhibits are included in EX1031. Paper 35, 3. But Petitioner never cited EX1031 in its Petition or Reply for Maninis's publication date. Paper 2 (not citing EX1031); Paper 25, 7-8 (cited for the *authenticity* of the Challenged Exhibits and as support for the availability of EX1021, *not Maninis*). If PO's motion to exclude is granted, as it should be, Petitioner has cited no competent evidence as to the publication date of Maninis.¹ Petitioner's mootness claim is thus wrong.

Petitioner raises numerous other arguments. None holds up. *First*, Petitioner claims to rely on EX1025 for a non-hearsay purpose (the existence of a web link). Paper 35, 3-4. But it is undisputed that link pointed to a different version of Maninis (EX1021) and is thus not probative of Maninis's publication date. Paper 20, 41. If Petitioner asserts EX1025 somehow states which version of Maninis was linked, such a statement *is* offered for its truth and *is* inadmissible hearsay. Petitioner also argues that the other Challenged Exhibits are admissible for non-hearsay purposes. Paper 35, 4-5. But it fails to cite any such reliance in its papers. *Id.*

¹ The only other evidence comes from a wholly unqualified witness. *Infra* 3-5.

Second, Petitioner’s argument that these exhibits are admissible hearsay under Rule 803(3) misapplies the law. Paper 35, 5-8 (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. Petitioner relies on non-specific statements of what arXiv.org allegedly does **presently**, not what it intends to do with **Maninis**. *E.g.*, EX1022 (“Submissions to arXiv are normally made public on Sunday through Thursday.”); EX1026 (“It is not possible to make changes without generating a new version.”). Petitioner does not even specify which of the Challenged Exhibits allegedly describes arXiv.org’s applicable policies—they materially differ between the Challenged Exhibits—and intended conduct regarding Maninis. Paper 30, 6-7; EX1023 (post-Maninis’s submission, containing changes to EX1026, suggesting EX1026 was no longer in force). 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. The Supreme Court has expressly forbidden a backwards-looking *Hillmon* doctrine, lest there be “an end, or nearly that, to the rule against hearsay.” *Shepard*, 290 U.S. at 105-06. Thus, Rule 803(3) does not apply to this hearsay offered to prove Maninis published “**no later than May 2, 2017.**” Paper 2, 10.

Third, Petitioner improperly relies on Rule 406, which is not a hearsay exception. *E.g.*, *Callaway v. Skywest Airlines*, 2006 WL 1328089, at *4 (D. Utah Mar. 29, 2006); *New Mexico ex rel. Balderas v. Real Est. L. Ctr., P.C.*, 409 F. Supp. 3d 1122, 1162 (D.N.M. 2019). Thus, Rule 406—and all of Petitioner’s cited cases on the timing of Rule 406 evidence—is irrelevant. Paper 35, 6-8, 11. Regardless, none of the Challenged Exhibits meet Rule 406 because there is no competent evidence and no basis to believe they were consistently (or ever) followed. *See Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1568-69 (Fed. Cir. 1988) (relying on “extensive uncontroverted evidence of business practice”).

Fourth, Petitioner cannot rely on Dr. Foroosh to establish the Rule 803(6) exception. That exception applies only if certain conditions are satisfied as “shown by the testimony of the custodian or another qualified witness.” Dr. Foroosh is neither. He admitted that he has no expertise with arXiv.org, its policies, or their application, beyond observing its treatment of a few of his papers. Paper 34, 4-5; Paper 35, 8. Petitioner’s cited case, *Samsung Elecs. Co. v. Huawei Techs. Co.*, IPR2017-01487, Paper 45 (Dec. 10, 2018), is inapposite. Unlike Dr. Foroosh, the witness in *Samsung* participated in and contributed to the 3GPP webpage at issue through roles on its standard setting organization, involvement in plenary level and working group level meetings, and as the rapporteur of technical for its feasibility report. *Id.* at 17. In any event, Petitioner has failed to offer any evidence regarding

the other required elements of Rule 803(6), thereby failing to meet its burden to show admissibility. *E.g., U.S. v. Day*, 789 F.2d 1217, 1221 (6th Cir. 1986) (A proponent must prove “each element of a given hearsay exception.”).

Fifth, Rule 807 is reserved for “exceptional cases.” *E.g., Conoco Inc. v. Dep’t of Energy*, 99 F.3d 387, 392 (Fed. Cir. 1996); Paper 35, 8-10. Petitioner does not dispute the additional likelihood of uncertain delays in Maninis’s publication due to arXiv.org’s pre-publication review procedures such that the Challenged Exhibits do not reliably reflect Maninis’s treatment. Fed. R. Evid. 807; Paper 35, 8-10; Paper 20, 40-41. Moreover, Petitioner’s “corroborat[ion]” argument is circular—Dr. Foroosh’s familiarity with arXiv.org **policy** is through the Challenged Exhibits, and his speculation regarding the metadata in EX1007 is meaningless without accepting the hearsay statements in EX1022. Paper 35, 9-10. Petitioner cannot corroborate inadmissible and/or non-probative evidence with more of the same. Petitioner’s reliance on *Cisco Sys., Inc. v. Centripetal Networks, Inc.*, IPR2018-01512, Paper 32 (Mar. 19, 2020) is misplaced. In that case, the Board found Rule 807 applicable under the totality of the circumstances where the testifying witness was a senior engineer that worked on the system at issue, had firsthand company knowledge, and other personal knowledge related to the system. *Id.* at 20-25, 78-79. Dr. Foroosh comes nowhere close to this standard. *Supra* 3. Thus, Rule 807 does not apply.

2. EX1002, Paragraphs 53-58 Are Improper Opinions: Dr. Foroosh’s conclusion connecting the date EX1007 was created and the date it was published is pure speculation. Paper 35, 10-12. Petitioner does not meaningfully dispute Dr. Foroosh’s testimony is beyond his personal knowledge and expertise. Nor does his submission of a few articles to arXiv.org qualify him to opine generally on its *policies* or *practices*. Cf. *Cooler Masters Co. v. Aavid Thermalloy LLC*, IPR2019-00337, Paper 49, 30 (Japanese patent attorney on Japanese patent office procedure); *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).

3. Petitioner’s entirely new merits theory is improper: Petitioner now proposes to rely on EX1021 in place of EX1007 because they are “material[ly]” the same. Paper 35, 4 n.1. Petitioner has never addressed EX1021’s relationship to the challenged claims and cannot do so at this late stage and without analysis or citation. Its 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. There are extensive differences relevant to the Petition that preclude Petitioner’s attempted substitution. See, e.g., EX1007, 13-14 (adding 15 citations), 6 (new “Training details”), 11-12, Table 6 (adding PSPNet for semantic segmentation).

Date: January 22, 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 22, 2025, 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:

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 22, 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