

**UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD**

GOOGLE LLC AND MOTOROLA MOBILITY LLC,
Petitioners,

v.

MULTIFOLD INTERNATIONAL INCORPORATED PTE. LTD.,
Patent Owner

Case No. IPR2025-00058

U.S. Patent No. 9,158,494

PATENT OWNER'S OPPOSITION TO MOTION TO EXCLUDE

Petitioners’ motion to exclude certain emails and related declaration testimony as hearsay proceeds at the outset from an incorrect premise—that the exhibits are relevant solely for the truth of the matter asserted. They are not. Rather, they are relevant for the non-hearsay purpose that the statements included therein support the veracity of the admissible testimony offered in this proceeding regarding conception and reduction to practice.

For example, Petitioners move to exclude Exhibit 2034, an email to declarant Mr. Cassar from Stanley Kurdziel, because it allegedly includes the out of court statement that “I understand that ParentChild may have been added to the framework” (Paper 37, EX2034), but Mr. Cassar’s own declaration relies on this exhibit because the statement itself is “consistent with [his] recollection that dual screen parent/child functionality was implemented on EV-1 prototypes no later than December 2010.” EX2002 at ¶30. This is a classic non-hearsay use—the fact that the email was sent on December 1, 2010, supports and *confirms* the witness’s own recollection. And Petitioners do not challenge the authenticity of that statement.

In fact, the Federal Circuit has previously found that the Board erred in excluding this type of evidence while considering conception and reduction to practice—exactly the issue here. *See REG Synthetic Fuels, LLC v. Neste Oil Oyj*, 841 F.3d 954, 964 (Fed. Cir. 2016). As the Court in *REG* explained, “[t]he act of writing and sending the email is, by itself, probative evidence on whether [the

inventor] recognized—at the time that he had written the email,” the claimed subject matter to support conception and reduction to practice. *Id.* *REG* is dispositive, and Petitioners’ motion should be denied.

Indeed, it is axiomatic that “[i]f the significance of an offered statement lies solely in the fact that it was made, no issue is raised as to the truth of anything asserted, and the statement is not hearsay.” Fed. R. Evid. 801 Advisory Comm. Notes. And, even beyond *REG*, decisions by the Board confirm that exclusion is not appropriate. For example, in *GoPro, Inc. v. Contour IP Holding LLC*, the Board declined to exclude an email (and a related declaration paragraph quoting that email) over a hearsay objection on a similar basis— because the significance of the email lay in the fact that it was sent, rendering it non-hearsay. IPR2015-01078, Paper 54 at 13-14 (P.T.A.B. Oct. 26, 2016). The Patent Owner in *GoPro* argued that the email itself was offered for the truth of the matter asserted—“namely ‘that, on or around July 20, 2009, Mr. Woodman intended to and, in fact, sent Mr. Jones copies of the GoPro Catalog for distribution at the Dealer Show.’” *Id.* The Board declined to exclude the email, finding that “the disputed statements are not offered to prove the truth of whether Mr. Woodman in fact sent catalogs by FedEx to Mr. Jones, but rather that ‘Mr. Jones was informed that catalogs were being sent to him,’ **which supports Mr. Jones’s testimony** authenticating Exhibit 1011.” *Id.* (emphasis added). And, notably, Petitioners fail to cite a single case or decision finding otherwise—

i.e., that an admittedly authentic email statement cannot be relied upon as confirmatory supporting evidence for a witness's own recollection.

Moreover, declining to exclude the qualifying non-hearsay support provided by the subject emails is also important here because exclusion would be at odds with the Federal Circuit's "rule of reason" approach to assessing evidence of conception and reduction to practice, under which "contemporaneous documentary evidence provides greater corroborative value," as opposed to bare testimony. *TransWeb, LLC v. 3M Innovative Props. Co.*, 812 F.3d 1295, 1301–02 (Fed. Cir. 2016).

Accordingly, and as is discussed below, Petitioners' motion to exclude should be denied as to the subject exhibits and declaration paragraphs.

Exhibit 2034 is Admissible for a Non-Hearsay Purpose

As discussed above, Exhibit 2034 is admissible for a non-hearsay purpose—the fact that Stanley Kurdziel emailed Mr. Cassar on December 1, 2010, an email which contained the statement "I understand that ParentChild may have been added to the framework" confirms and supports Mr. Cassar's testimony that "dual screen parent/child functionality was implemented on EV-1 prototypes no later than December 2010." EX2002 at ¶30. Nor does the inclusion of the phrase "I understand" change the result, as Petitioners argue. Paper 37 at 2. That Mr. Kurdziel claimed to have an understanding that "ParentChild may have been added to the framework," on December 1, 2010, which Petitioners do not dispute, renders this

email admissible for its confirmatory non-hearsay purpose—that the words were said by Mr. Kurdziel on that date—rather than for the truth of the statement itself. EX2034.

Exhibit 2035 is Admissible for a Non-Hearsay Purpose

Exhibit 2035 is likewise admissible for the same non-hearsay purpose. That Rod Schrock emailed Mr. Cassar on January 12, 2011, indicating that he would be demoing prototypes in Europe “next week” and that the “[s]howcase system software will be Visual Multitasking(wpc)” (EX2035), again confirms and supports Mr. Cassar’s testimony that this feature was implemented in the relevant timeframe regardless of the truth of the underlying statements. Moreover, Mr. Cassar confirmed during his deposition that he “remember[ed] the meetings” referenced in this email, that “if WPC wasn't working when [Mr. Schrock] was going to these meetings, [he] would have lost [his] job.” EX1020 (Cassar Dep. Tr. at 236:4-21). Again, the fact that this email was sent with the included content—which is nowhere disputed by Petitioners—is a non-hearsay use, it confirms that Mr. Cassar is telling the truth.

Exhibit 2036 is Admissible for a Non-Hearsay Purpose

With respect to Exhibit 2036, again, both the exhibit itself and Mr. Cassar’s declaration confirm that it is admissible for the non-hearsay purpose of confirming his recollection and the veracity of his statements. Petitioners do not dispute that Exhibit 2036 is an email sent on Tuesday, January 18, 2011, from Rod Schrock

which states “[s]oon everyone will have EV2 units to evaluate our user experience” and that “[f]actory is entering higher volume EV2 builds tomorrow.” EX2036. And, as Mr. Cassar’s declaration states, these “quotes confirm [his] recollection that EV-2 prototypes were released in January 2011” and “[t]his email indicates, consistent with [his] recollection, that as of January 17, 2011, at least some project members already had working EV-2 prototypes and that more were on the way.” EX2002 at ¶41. Again, this is a non-hearsay purpose, pursuant to which exclusion should be denied. Nor is Petitioners’ claimed “second layer of hearsay” relevant to the non-hearsay purpose for which this email is admissible, that there is no dispute that Mr. Schrock made the statements in question on January 17, 2011, which confirms the veracity of Mr. Cassar’s testimony. Paper 37 at 2.

Exhibit 2037 is Admissible for a Non-Hearsay Purpose

And the same is true of Exhibit 2037. There is no dispute that Exhibit 2037 is a true and correct copy of an email Mr. Cassar received from Rod Schrock on January 25, 2011. And there is no dispute that this email states that “[t]he EV-2 units are now relatively functional smartphones.” EX2037. That this email was sent and contains the statement at issue confirms and supports Mr. Cassar and Mr. Sirpal’s testimony, which is a non-hearsay purpose sufficient to deny exclusion. That is also the express purpose for which Patent Owner relies on this exhibit in the Patent Owner response—that the statement “confirms Sanjiv Sirpal and Ron Cassar’s

recollection that, that, as of January 25, 2011, the EV-2 prototypes were functional.”

POR at 34.

Exhibit 2038 is Admissible for a Non-Hearsay Purpose

Finally, Exhibit 2038 should not be excluded, again, for the same reasons. Petitioners do not dispute that it is a true and correct copy of a January 28, 2011, email Mr. Cassar received from Rod Schrock, or that it is “discussing test and development on EV2 handsets.” EX2038, EX2002 at ¶43. And as Mr. Cassar explains this admittedly authentic email confirms his “recollection that EV-2 smartphones were manufactured in January 2011.” EX2002 at ¶43. Exclusion should thus be denied as to this email as well—the undisputed fact that it was sent with the included content renders it admissible for non-hearsay purpose that it confirms Mr. Cassar’s testimony and recollection.

Nor are Petitioners’ citations to other portions of Mr. Cassar’s declaration any different. Paragraphs 45-46 simply provide additional context for Exhibit 2038, while Paragraph 47 and 48 again expressly confirm that Mr. Cassar is relying on this exhibit for a non-hearsay purpose—because it was “consistent with [his] recollection that, starting in February 2011, numerous employees and contractors at various facilities were ‘extensive[ly] testing’ the system reliability of the EV-2 prototypes” (EX2002 at ¶47) and “consistent with [his] recollection that significant, continuous

testing and development was taking place throughout the first quarter of 2011”

EX2002 at ¶48. Accordingly, exclusion should be denied.

Exhibit 2001 and Exhibits 2002 Do Not Contain Inadmissible Hearsay

As is explained above, each of Exhibit 2034 through 2038 are admissible non-hearsay because the fact that they were sent with the included statements confirms Mr. Cassar and Mr. Sirpal’s testimony. Mr. Cassar and Mr. Sirpal’s declarations make the same clear—repeatedly explaining that the statements are “consistent” with their recollection. *See, e.g.*, EX2002 at ¶48 (stating that Exhibit 2038 was “consistent with [Mr. Cassar’s] recollection that significant, continuous testing and development was taking place throughout the first quarter of 2011.”); EX2001 at ¶82 (stating that Exhibit 2037 was consistent with Mr. Sirpal’s “rec[ollection] that EX2037 (Rod Schrock’s January 25, 2011 email) triggered a new phase of the Imerj project.”).¹ Accordingly, Petitioners’ motion to exclude should be denied on this basis as well.

¹ The other challenged paragraphs are either similarly situated or simply provide context for the cited exhibits. EX2002 at ¶30 (“This is consistent with my

CONCLUSION

Accordingly, for the foregoing reasons, Patent Owner respectfully requests that Petitioners' motion to exclude be denied in its entirety.

recollection that dual screen parent/child functionality was implemented on EV 1 prototypes no later than December 2010.”), ¶31-32 (providing context), ¶33 (explaining that “[w]e would not have showcased WPC capabilities (e.g., gesture functionality) for the phone, email, browser, and calendar apps at a demo for potential customers and partners if these features were not functioning for their intended purpose,” which confirms Mr. Cassar’s testimony), ¶34 (providing context), ¶35 (explaining how matters not shown in the email are confirmed by the sending of the email), ¶40 (“This confirms my recollection . . .”), ¶41 (email “consistent with my recollection”), ¶42 (providing context and confirming testimony), ¶43 (email “consistent with my recollection”), ¶44 (confirming testimony), ¶45-46 (providing context), and ¶47 (email “consistent with my recollection”); EX2001 at ¶38 (email “confirms my recollection”).

Dated: February 6, 2026

Respectfully submitted,

/s/Robert S. Pickens

James T. Carmichael (Reg. No. 45,306)
Stephen T. Schreiner (Reg. No. 43,097)
CARMICHAEL IP, PLLC
8607 Westwood Center Drive, Suite 270
Tysons, VA 22182
Tel: (703) 646-9255
Tel: (703) 646-9254
jim@carmichaelip.com
schreiner@carmichaelip.com

Robert S. Pickens (Pro Hac Vice)
KASOWITZ LLP
1633 Broadway
New York, NY 10019
Tel: (212) 506-1718
rpickens@kasowitz.com

Counsel for Patent Owner

CERTIFICATE OF SERVICE

I hereby certify that on February 6, 2026, I caused a true and correct copy of the foregoing Patent Owner's Opposition To Motion To Exclude to be served on the following counsel for Petitioners by electronic mail to the following email addresses:

Service for Google:

Naveen Modi, Joseph E. Palys, Daniel Zeilberger, Howard Herr,
Quadeer Ahmed, and David Valente
Paul Hastings LLP
2050 M Street, N.W.
Washington, D.C. 20036
Email: naveenmodi@paulhastings.com
Email: josephpalys@paulhastings.com
Email: danielzeilberger@paulhastings.com
Email: quadeerahmed@paulhastings.com
Email: davidvalente@paulhastings.com
Email: PH-Google-Multifold-IPR@paulhastings.com

Service for Motorola:

Orrick, Herrington & Sutcliffe LLP
2050 Main Street, Suite 1100
Irvine, CA 92614
Email: TVPPTABDocket@orrick.com
Email: 0CHPTABDocket@orrick.com

/s/Robert S. Pickens

Robert S. Pickens (Pro Hac Vice)
KASOWITZ LLP
1633 Broadway
New York, NY 10019
Tel: (212) 506-1718
rpickens@kasowitz.com

Counsel for Patent Owner

