

U.S. Patent No. 10,423,658
Patent Owner's Motion to Exclude
IPR2022-00033

Paper No. _____

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.

Petitioner

v.

MEMORYWEB, LLC

Patent Owner

Patent No. 10,423,658

Inter Partes Review No. IPR2022-00033

PATENT OWNER'S MOTION TO EXCLUDE

I. INTRODUCTION

Pursuant to 37 C.F.R. §§ 42.62 and 42.64 and the Federal Rules of Evidence, Patent Owner moves to exclude Exhibit 1005, purportedly a copy of the Aperture 3 User Manual (“A3UM”), relied on by Apple Inc. (“Petitioner”). As detailed below, Petitioner has not, and cannot, properly authenticate Exhibit 1005 as a true and correct copy of A3UM publicly available as of February 2010. Petitioner submitted the declarations of its employee, Mr. Birdsell, and its expert, Dr. Terveen, to authenticate Ex. 1005 as a true and correct copy of A3UM. *See* Exhibits 1020 and 1003. However, neither witness possessed the personal knowledge required to authenticate it as an admissible exhibit. *See* FED. R. EVID. 901 and 902; Ex. 2026, 20:5-6; 41:11-16; 41:22-25; Ex. 2023 57:10-59:3; 61:9-62:19. Patent Owner timely objected to these exhibits pursuant to 37 C.F.R. § 42.46(b)(1) in Patent Owner's Evidence Objections (Papers 14 and 27), served on June 6, 2022 and January 3, 2023, respectively.

II. ARGUMENT

A party may move to exclude evidence based on the Federal Rules of Evidence. *See* 37 C.F.R. § 42.62 (“[T]he Federal Rules of Evidence shall apply to a proceeding.”).

A. Exhibit 1005 Should be Excluded Under FED. R. EVID. 901-902

Exhibit 1005 purports to be a copy of A3UM, which Petitioner relies on as alleged prior art. However, as discussed below, Exhibit 1005 is neither authenticated nor self-authenticating. *See* FED. R. EVID. 902.

To authenticate a document, “the proponent must produce evidence sufficient to support a finding that the item is what the proponent claims it is.” FED. R. EVID. 901(a). A witness with knowledge can authenticate an electronically stored document; however, the witness “must ‘provide factual specificity about the process by which the electronically stored information is created, acquired, maintained, and preserved without alteration or change.’” *Xactware Sols., Inc. v. Pictometry Int’l Corp.*, IPR2016-00594, Paper 46 at 11-12 (PTAB Aug. 24, 2017) (citations omitted). In this case, Petitioner cited testimony from its expert, Dr. Terveen, and its employee, Mr. Birdsell, in an attempt to establish the authenticity of Ex. 1005. Petition, 13-14; Ex. 1003, ¶74; Ex. 1020, ¶4. However, as discussed below, neither Dr. Terveen nor Mr. Birdsell could properly authenticate Ex. 1005 as a true, correct, and complete copy of A3UM. Ex. 1005 is therefore inadmissible. *TRW Automotive U.S. LLC v. Magna Electronics Inc.*, IPR2014-01348 Paper 25 at 12 (PTAB January 15, 2016) (excluding alleged prior art publication on grounds that Petitioner did not provide sufficient evidence of the exhibit’s authenticity).

In his declaration, Mr. Birdsell stated that he reviewed Ex. 1005—which spans over 1,122 pages—and “confirm[ed] it is an accurate copy of the Aperture 3 User Manual that was distributed with the initial version of the Aperture 3 product.” Ex. 1020, ¶ 4. However, during his deposition, Mr. Birdsell admitted he did not personally create Ex. 1005. Ex. 2026, 20:5-6. Instead, the sole basis for his statement that Ex. 1005 is an “accurate copy” of A3UM is having “spot-checked it against the files that were on the disk and in the app.” Ex. 2026, 41:11-16. When asked about the DVD he used for his spot-check, Mr. Birdsell admitted that he could not “speak to the chain of custody” of that DVD. *Id.*, 41:22-25. Given that he did not create Ex. 1005 and only “spot-checked” it, Mr. Birdsell cannot know whether Ex. 1005 is an accurate copy of A3UM. Mr. Birdsell cannot provide the “factual specificity” regarding how Ex. 1005, or the DVD used to create Ex. 1005, was “created, acquired, maintained, and preserved without alteration or change. *Xactware Sols.*, IPR2016-00594, Paper 46 at 11-12.

Petitioner's reliance on Dr. Terveen to authenticate Ex. 1005 similarly fails. Dr. Terveen stated in his declaration that “A3UM (EX1005) is a true and accurate copy of the underlying HTML files containing the Aperture 3 User Manual.” Ex. 1003, ¶ 74. However, when asked about how Ex. 1005 was created, it became clear that Dr. Terveen had no knowledge regarding the creation of Ex. 1005. Ex. 2023,

57:10-59:3. When asked whether he created Ex. 1005, Dr. Terveen stated he did not. *Id.* 57:17-18. Dr. Terveen was then asked “[w]ho created that PDF,” to which Dr. Terveen replied “[c]ounsel, someone – someone of Apple’s attorneys.” *Id.*, 57:19-21. When asked who specifically created Ex. 1005, Dr. Terveen repeatedly answered “I don’t know who created it.” *Id.*, 58:12-4; 58:15-20. Notably, Dr. Terveen admitted that it was Petitioner’s counsel who “represented to [him] that [Ex. 1005] was ... a PDF that contained all of the HTML files that comprised the user manual.” *Id.*, 59:4-10.

Like Mr. Birdsell, Dr. Terveen merely “spot-checked” unidentified portions of Ex. 1005 against the HTML files found after installing Aperture 3 until he was “pretty satisfied” that Ex. 1005 was an accurate copy of A3UM. *Id.*, 61:9-62:12. Specifically, when asked whether he compared the entirety of Ex. 1005 with the HTML files found after installing Aperture 3, Dr. Terveen admitted that he “did not check all 1122 pages, but [he] spot-checked a whole lot of them.” *Id.*, 61:9-17. Dr. Terveen glaringly did not provide any statement regarding which pages he “spot-checked” and whether the pages he “spot-checked” were the pages he relied on in forming his opinion. Dr. Terveen also did not run a simple comparison software to compare the contents of Ex. 1005 with the HTML file from the Aperture 3 installation DVD. *Id.*, 62:13-19.

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