

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 REPLY TO PETITIONER'S OPPOSITION TO
PATENT OWNER'S MOTION TO EXCLUDE**

I. INTRODUCTION

Petitioner's Opposition (Paper 35) primarily argues that the Aperture 3 User Manual ("A3UM") submitted as Ex. 1005 is authentic because the Aperture 3 DVD it was purportedly created from existed in 2010. The Aperture 3 DVD's existence in 2010 is a red herring and avoids the relevant inquiry, which is whether the evidence establishes that Ex. 1005 is what Petitioner claims it is. FED. R. EVID. 901. Petitioner offers no testimony from the unknown individual(s) who purportedly created Ex. 1005 from an Aperture 3 DVD; instead, Petitioner merely relies on testimony from its expert and employee who "spot-checked" only a fraction of the content in Ex. 1005. Because neither of these witnesses created Ex. 1005 and merely checked unknown portions of the 1,122-page PDF, it is impossible for them to definitively say that Ex. 1005 is a true and correct copy of A3UM.

II. ARGUMENT

Petitioner argues that Ex. 1005 is authentic because Patent Owner has not submitted evidence proving that Ex. 1005 is not authentic. But this argument improperly flips the parties' burdens: because Ex. 1005 is not self-authenticating, Petitioner "must produce evidence sufficient to support a finding that . . . [Ex. 1005] is what the proponent claims it is." *See* FED. R. EVID. 901; *Inductev Inc. v. Witricity Corp.*, No. IPR2021-01166, Paper 35 at 53 (PTAB Dec. 20, 2022) ("Petitioner bears the burden to authenticate" the exhibit). Instead of identifying sufficient evidence,

Petitioner argues “Patent Owner’s motion is based on nothing more than *unsubstantiated speculation* that the PDF that is EX1005 *might* not be a complete copy of the A3UM HTML file set.” Opp., 3 (emphasis in original). To the contrary, Petitioner’s testimony concerning Ex. 1005’s purported authenticity amounts to unsubstantiated speculation because neither witness has sufficient personal knowledge to say that it is authentic.

A. Petitioner’s Witnesses Cannot Authenticate Ex. 1005

Petitioner does not dispute Dr. Terveen and Mr. Birdsell merely “spot-checked” Ex. 1005. Opp., 5, 7-8. Nor does Petitioner dispute that neither Dr. Terveen nor Mr. Birdsell created Ex. 1005. Opp., 14. Instead, Petitioner argues that Ex. 1005 is authenticated because (i) Mr. Birdsell “was able to satisfy himself” (Opp., 4) and (ii) Dr. Terveen was “pretty satisfied” (*Id.*, 7) that Ex. 1005 is a true and correct copy of A3UM. The witnesses’ personal satisfaction does not establish that Ex. 1005 is what the Petitioner claims it is.

Petitioner argues that its failure to proffer testimony from whoever purportedly created Ex. 1005 from over 700 HTML files is “irrelevant.” Opp., 14. But because neither Mr. Birdsell nor Dr. Terveen created Ex. 1005, neither can know that Ex. 1005 is a true and correct copy of the 700+ HTML files unless they checked Ex. 1005 against all of the HTML files. Just as when one who only “spot-checks” half of a deck of cards cannot be sure that the deck has the correct 52 cards, Dr.

Terveen and Mr. Birdsell cannot know whether Ex. 1005 is a complete copy of the HTML files. If Ex. 1005 were in fact a true and correct copy of all of the HTML files, Petitioner could have easily resolved the issue by proffering testimony from the individual(s) who created it, but Petitioner curiously chose not to do so.

Petitioner's reliance on *Mylan Pharm. Inc. v. Regeneron Pharm. Inc.* is misplaced. Opp., 3 (citing IPR2021-00881, Paper 94 at 48 (PTAB Nov. 9, 2022)). There, the authenticating witness "***personally collected the documents*** addressed in her declaration." *Id.* (emphasis added). Petitioner offers no testimony from the unknown individual(s) who personally collected the documents comprising Ex. 1005. *See* Ex. 1091. *See Inductev Inc. v. Witricity Corp.*, No. IPR2021-01166, Paper 35 at 12 (PTAB Dec. 20, 2022) (authenticating witness "personally identified and retrieved" the documents she relied on in her declaration); *Ericsson Inc. v. Intell. Ventures I LLC*, No. IPR2014-01149, Paper 68 at 12-13 (PTAB Dec. 9, 2015) (authenticating witness testified that "the exhibit was obtained from a place where such a document is expected to be found").

Petitioner's claim that Patent Owner "dissuaded Mr. Birdsell from taking steps to further authenticate Ex. 1005" during his deposition is disingenuous. Opp., 5. That Mr. Birdsell offered to compare Ex. 1005 to the headings in Ex. 2010 for the first time during his deposition only underscores that he did not perform even this basic comparison before summarily declaring that Ex. 1005 was authentic. Petitioner

failed to ask Mr. Birdsell to perform this comparison in his original declaration, on re-direct during deposition, or in a supplemental declaration. Opp., 5. And, even if he had performed such a comparison between Ex. 1005 and a mere Internet Archive table of contents, that still would not prove that the contents of Ex. 1005 are accurate.

B. Petitioner Did Not Identify or Authenticate the DVD Purportedly Used to Create Ex. 1005

Petitioner does not identify the Aperture 3 DVD that was purportedly used to create Ex. 1005, let alone establish that this DVD was authentic. *See* Opp., 3-4, 6. Dr. Terveen testified that he received two Aperture 3 DVDs – one from Petitioner and another from Petitioner’s counsel, who purchased it from a third party. Ex. 1003, ¶ 74; Ex. 2023, 54:10-16. Mr. Birdsell also received a DVD but could not “speak to the chain of custody” of that DVD. Ex. 2026, 41:22-25. Because neither Dr. Terveen nor Mr. Birdsell created Ex. 1005, this suggests that a fourth DVD was used by the unknown individual(s) who created Ex. 1005. Petitioner failed to identify what DVD was used to create Ex. 1005 or establish that this unknown DVD was authentic. *See* Opp., 3-4, 6. Petitioner therefore failed to establish that Ex. 1005 is authentic for this additional reason. *Xactware Sols., Inc. v. Pictometry Int’l Corp.*, IPR2016-00594, Paper 46 at 13 (PTAB Aug. 24, 2017) (exhibit excluded because “Petitioner provide[d] no indication of the source of the document”).

C. Ex. 1005 is Not Admissible Under Rule 901(b)(4)

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