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Paper 42
Date: November 22, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

MEMORYWEB, LLC,
Patent Owner.

IPR2022-00033
Patent 10,423,658 B2

Before LYNNE H. BROWNE, NORMAN H. BEAMER, and KEVIN C. TROCK, *Administrative Patent Judges.*

BROWNE, *Administrative Patent Judge.*

DECISION

Denying Patent Owner's Motion to Exclude
37 C.F.R. § 42.64(c)
Denying Patent Owner's Request on Rehearing
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Apple Inc. ("Petitioner") filed a Petition (Paper 1, "Pet.") requesting *inter partes* review of claims 1–15 (the "challenged claims") of U.S. Patent No. 10,423,658 B2 (Ex. 1001, "the '658 patent"). We determined, based on the record at that time, that the '658 patent was eligible for *inter partes* review, and instituted review on all challenged claims on the grounds presented in the Petition. Paper 12 ("Institution Decision" or "Inst. Dec.").

On May 18, 2023, we entered a Final Written Decision (Paper 39, "Decision" or "Dec.") determining, in part, that Petitioner had shown claims 1–15 of the '658 patent are unpatentable by a preponderance of the evidence. On June 16, 2023, Patent Owner timely filed a Request for Rehearing of that determination in the Decision. Paper 41 ("Patent Owner's Request" or "Req. Reh'g").

As discussed below, we agree with Patent Owner that the Decision misapprehended Patent Owner's deadline for filing objections to Exhibit 1005 and consider those objections below.

II. ANALYSIS

A. Legal Standards

The applicable requirements for a request for rehearing are set forth in 37 C.F.R. § 42.71(d), which provides:

> A party dissatisfied with a decision may file a single request for rehearing without prior authorization from the Board. The burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, a reply, or a sur-reply.

We review our Decision under an abuse of discretion standard. 37 C.F.R. § 42.71(c). An abuse of discretion may arise if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors. *Star Fruits S.N.C. v. United States*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P'ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000). "Substantial evidence is 'such relevant evidence as a reasonable mind might accept as adequate to support a conclusion.'" *OSI Pharm., LLC v. Apotex Inc.*, 939 F.3d 1375, 1381 (Fed. Cir. 2019) (quoting *Consol. Edison Co. v. N.L.R.B.*, 305 U.S. 197, 229 (1938)). "The substantial evidence standard asks 'whether a reasonable fact finder could have arrived at the agency's decision.'" *OSI Pharm.*, 939 F.3d at 1381–82 (quoting *Gartside*, 203 F.3d at 1312).

B. Motion to Exclude

Patent Owner filed a Motion to Exclude A3UM (Ex. 1005) on February 17, 2023. Paper 34. Petitioner filed an Opposition to Patent Owner's Motion to Exclude on February 24, 2023. Paper 35 ("Mot. Opp"). In the Final Written Decision, we denied the Motion to Exclude because we determined that objections to Exhibit 1005 were untimely filed. Dec. 84.

In the Request for Rehearing, Patent Owner notes that evidence objections must be filed within ten business days of the institution of trial, and that a business day is a day other than a Saturday, Sunday, or Federal Holiday within the District of Colombia. Req. Reh'g 2 (citing 37 C.F.R. §§ 42.2, 42.64(b)(1)). Patent Owner asserts that "[t]he Decision erroneously calculated the deadline for Patent Owner's evidence objections as falling on a Federal holiday based on calendar days instead of business days." *Id.* at 3.

We agree with Patent Owner that in view of the May 30, 2022, Federal holiday, Patent Owner's objections were timely filed on June 6, 2022. We therefore address Patent Owner's Motion to Exclude below.

In the Motion to Exclude, Patent Owner asserts that Exhibit 1005 is neither authenticated nor self-authenticating. Paper 34, 2. Patent Owner asserts that "Petitioner cited testimony from its expert, Dr. Terveen, and its employee, Mr. Birdsell, in an attempt to establish the authenticity of Ex. 1005," but that "neither Dr. Terveen nor Mr. Birdsell could properly authenticate Ex. 1005 as a true, correct, and complete copy of A3UM." *Id.* Specifically, Patent Owner argues that neither Dr. Terveen nor Mr. Birdsell created Exhibit 1005 and that both merely "spot-checked" the manual to evaluate its authenticity. *Id.* at 3–5.

Patent Owner asserts that "Mr. Birdsell and Dr. Terveen's testimony regarding Ex. 1005 lacks the 'factual specificity' required for proper authentication." *Id.* at 5 (citing *Xactware Sols., Inc. v. Pictometry Int'l Corp.*, IPR2016-00594, Paper 46 at 11–12 (PTAB Aug. 24, 2017)). In the Request for Rehearing, Patent Owner further asserts that "[i]t was not Patent Owner's burden to identify discrepancies between Exhibit 1005 and the A3UM HTML file set," and that "it was Petitioner's burden to demonstrate that Ex. 1005 is what Petitioner claims it is." Req. Reh'g 5 (citing Fed. R. Evid. 901; *Inductev Inc. v. Witricity Corp.*, IPR2021-01166, Mot. Opp. 53 (PTAB Dec. 20, 2022)). Patent Owner asserts that "[j]ust as one who only 'spot-checks' a deck of cards cannot know that the deck has the correct 52 cards, Dr. Terveen and Mr. Birdsell could not have known whether Exhibit 1005 is a complete and accurate copy of the HTML files." *Id.* at 4 (citing Paper 38, 2–3).

We agree with Patent Owner that it was Petitioner's burden to demonstrate that Exhibit 1005 is what Petitioner claims it is, but note that authentication is a low bar, requiring only a rational basis that the document is what it is asserted to be. *See Inductev Inc. v. Witricity Corp.*, IPR2021-01166, Paper 35 at 53 (citing *Caterpillar Inc. v. Wirtgen Am., Inc.*, IPR2018-01091, Paper 49 at 72 (Nov. 27, 2019) (quoting *United States v. Turner*, 934 F.3d 794, 798 (8th Cir. 2019))). As Petitioner points out, Mr. Birdsell testified he was the "lead writer" of the Aperture 3 User Manual and personally participated in the creation and distribution of the A3UM HTML file set. Mot. Opp. 4 (citing Ex. 1020 ¶¶ 3–4, 8–9; Ex. 2026, 32:20–33:2, 35:16–37:14, 18:15–22). We agree with Petitioner that "[g]iven Mr. Birdsell's unique depth of familiarity with A3UM and the A3UM HTML file set, he was able to satisfy himself that EX1005 was a true and correct copy of the A3UM HTML file set distributed in February of 2010 by inspecting it in the manner he described." *Id.* at 3–4.

Further, as Petitioner points out, "Dr. Terveen testified that one step he took was to compare the first 100 pages of Exhibit 1005," "one by one, . . . compar[ing] them to the corresponding pages in the user manual available on the computer," and then performing a section by section comparison of Exhibit 1005 and the A3UM HTML file set, looking at the first page or two of each section. Mot. Opp. 7 (citing Ex. 2024, 380:20–381:3).

Weighing the parties' arguments and evidence, we determine that Petitioner demonstrates sufficiently that A3UM is what Petitioner purports it to be—the Aperture 3 User Manual, describing certain features and

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