

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

IRIUSRISK, INC.,
Petitioner

v.

THREATMODELER SOFTWARE INC.,
Patent Owner

IPR2023-00656

U.S. Patent No. 10,713,366

**PETITIONER’S OBJECTIONS TO PATENT OWNER’S EVIDENCE
PURSUANT TO 37 C.F.R. § 42.64(b)(1)**

Petitioner IriusRisk, Inc. (“Petitioner”) objects under the Federal Rules of Evidence to the admissibility of Exhibits 2003-2009, which Patent Owner Threatmodeler Software Inc. (“PO”) filed with its Patent Owner Response (Paper No. 19) on January 12, 2024. 37 C.F.R. §42.64(b)(1).

Petitioner timely objects within the allowed five business days of service of Exhibits 2003-2009. Petitioner files and serves PO with these objections to provide notice that Petitioner may move to exclude one or more of Exhibits 2003-2009 under 37 C.F.R. § 42.64(c).

I. Exhibit 2003

FRE 401, 402, 403: Petitioner objects to Exhibit 2003 as irrelevant, misleading, or confusing, and its probative value, if any, is outweighed by prejudice. PO cites this exhibit in connection with the definition of risk (*see* POR at p. 23) but has failed to establish relevance of the material to the alleged patentability of the Challenged Claims.

FRE 801, 802, 901, 1002, 1003: Petitioner objects to Exhibit 2003 for lacking authentication, lacking foundation, for containing hearsay, and/or causing undue prejudice. For example, PO has neither authenticated this exhibit, nor laid for the foundation for any hearsay exception.

II. Exhibit 2004

FRE 401, 402, 403: Petitioner objects to Exhibit 2004 as irrelevant, misleading, or confusing, and its probative value, if any, is outweighed by prejudice. PO cites this exhibit in connection with the definition of threats (*see* POR at p. 21) but has failed to establish relevance of the material to the alleged patentability of the Challenged Claims. For example, Mr. Hurlbut explained that threat modeling experts were not utilizing or applying the information outlined by NIST. EX-2002, 35:22-36:10.

FRE 801, 802, 901, 1002, 1003: Petitioner objects to Exhibit 2004 for lacking authentication, lacking foundation, for containing hearsay, and/or causing undue prejudice. For example, PO has neither authenticated this exhibit, nor laid for the foundation for any hearsay exception.

III. Exhibit 2005

FRE 401, 402, 403: Petitioner objects to Exhibit 2005 as irrelevant, misleading, or confusing, and its probative value, if any, is outweighed by prejudice. PO cites this exhibit in connection with the definition of threats and risks (*see* POR at p. 23) but has failed to establish relevance of the material to the alleged patentability of the Challenged Claims. For example, Mr. Hurlbut explained as his deposition that Exhibit 2005 is irrelevant to threat modeling. *See*

EX-2002, 43:10-44:22 (“[Exhibit 2005] looks at threats slightly different than most other threat modeling resources.”).

FRE 801, 802, 901, 1002, 1003: Petitioner objects to Exhibit 2005 for lacking authentication, lacking foundation, for containing hearsay, and/or causing undue prejudice. For example, PO has neither authenticated this exhibit, nor laid for the foundation for any hearsay exception.

IV. Exhibit 2006

FRE 401, 402, 403: Petitioner objects to Exhibit 2006 as irrelevant, misleading, or confusing, and its probative value, if any, is outweighed by prejudice. PO cites this exhibit in connection with the definition of threats and risks (*see* POR at p. 22) but has failed to establish relevance of the material to the alleged patentability of the Challenged Claims. For example, Mr. Hurlbut explained that threat modeling experts were not utilizing or applying the information outlined by NIST. EX-2002, 35:22-36:10.

FRE 801, 802, 901, 1002, 1003: Petitioner objects to Exhibit 2006 for lacking authentication, lacking foundation, for containing hearsay, and/or causing undue prejudice. For example, PO has neither authenticated this exhibit, nor laid for the foundation for any hearsay exception.

V. Exhibit 2007

FRE 401, 402, 403: Petitioner objects to Exhibit 2007 as irrelevant, misleading, or confusing, and its probative value, if any, is outweighed by prejudice. PO cites this exhibit in connection with the definition of threats and risks (*see* POR at p. 22) but has failed to establish relevance of the material to the alleged patentability of the Challenged Claims.

FRE 801, 802, 901, 1002, 1003: Petitioner objects to Exhibit 2007 for lacking authentication, lacking foundation, for containing hearsay, and/or causing undue prejudice. For example, PO has neither authenticated this exhibit, nor laid for the foundation for any hearsay exception.

VI. Exhibit 2008

FRE 401, 402, 403: Petitioner objects to Exhibit 2007 as irrelevant, misleading, or confusing, and its probative value, if any, is outweighed by prejudice. PO cites this exhibit in connection with the definition of threats and risks (*see* POR at p. 23-24) but has failed to establish relevance of the material to the alleged patentability of the Challenged Claims. For example, PO acknowledges that EX-2008 “was written several years before the invention of the ’366 Patent.” POR at 23-24.

FRE 801, 802, 901, 1002, 1003: Petitioner objects to Exhibit 2007 for lacking authentication, lacking foundation, for containing hearsay, and/or causing

undue prejudice. For example, PO has neither authenticated this exhibit, nor laid for the foundation for any hearsay exception.

VII. Exhibit 2009

FRE 702 and 703: Petitioner objects to Exhibit 2009 in its entirety because PO's declarant, Dr. Seth Nielson, is not qualified as a person of ordinary skill in the art ("POSITA") under the undisputed definition of a POSITA provided by Petitioner and Petitioner's expert, Mr. Hurlbut, because Dr. Nielson has no experience "designing or implementing threat models." EX-1003, ¶33 (Petitioner's proposed definition of a POSITA requiring experience "designing or implementing threat models"); EX-2009, ¶49 ("Patent Owner does not contest Petitioner's proposed definition of a [POSITA]. Consequently, I have applied Petitioner's proposed level of ordinary skill in the art in rendering my opinions in this Declaration."); EX-2009, ¶¶7-25 (describing Dr. Nielson's experience); EX-2009, Appx. C (Dr. Nielson's CV). Dr. Nielson thus does not have sufficient scientific, technical, or other specialized knowledge that will help the Board to understand the evidence or to determine a fact in issue under FRE 702.

Conversely, Petitioner's expert, Mr. Hurlbut, has extensive experience designing and implementing threat models. EX-1003, ¶¶5-17. For example, Mr. Hurlbut testifies: "Between September 2017 and November 2021, I was the Senior Vice President and Threat Modeling Senior Architect/Lead at Bank of America,

where I started, led, and further developed Bank of America's threat modeling program." EX-1003, ¶12.

Petitioner further objects to EX-2009, including at least ¶¶78-89, 90-93, 105, 108, 111-12 as improper expert testimony under FRE 702 and 703. The testimony is based on insufficient facts or data, is not the product of reliable principles and methods, and does not reliably apply the appropriate principles and methods to the facts of the case. For example, the testimony is based on cross-examination testimony from Petitioner's expert, Mr. Hurlbut, (Exhibit 2002) that is taken out of context, does not support the proposition it is relied upon to establish, and is inadmissible on its own independent bases as, for example, stemming from vague and confusing questioning. For example, Dr. Nielson states that "Mr. Hurlbut testified that FAIR was 'not considered to be a threat modeling book because it looks at risks,'" but this statement is taken out of context and does not represent Mr. Hurlbut's opinion. See EX-2002, 43:10-44:22 ("[Exhibit 2005] looks at threats slightly different than most other threat modeling resources.").

Petitioner further objects to EX-2009 as improper expert testimony under FRE 702 and 703 to the extent it relies on deposition testimony resulting from improper questioning. For example, PO questioned Mr. Hurlbut on multiple documents, including EX-2002-2005, that were not included or referenced by Mr. Hurlbut's declaration (EX-1003) and thus PO's questioning on these documents

was improperly outside the scope of Mr. Hurlbut's direct testimony. 37 CFR § 42.53(d)(5)(ii) ("For cross-examination testimony, the scope of the examination is limited to the scope of the direct testimony.").

Petitioner further objects to EX-2009 as improper expert testimony under FRE 702 and 703 to the extent it relies on facts and data that experts in threat modeling would not reasonably rely on in forming an opinion on the subject and thus the testimony is based on insufficient facts or data, is not the product of reliable principles and methods, and does not reliably apply the appropriate principles and methods to the facts of the case. Dr. Nielson forms his opinions based on documentation that experts in the threat modeling industry would not reasonably rely on, including at least EX-2003, EX-2004, EX-2005, EX-2006, and EX-2007. For example, PO showed at least EX-2004 and EX-2005 to Mr. Hurlbut during his deposition—and Mr. Hurlbut testified that these documents were not documents that a threat modeling expert would rely upon. EX-2002, 35:22-36:10, 39:5-17, 39:19-42:8 ("[Exhibit 2005 is] not a threat modeling book."), 43:10-44:22 ("[Exhibit 2005] looks at threats slightly different than most other threat modeling resources.").

FRE 401, 402, 403: Petitioner objects to Exhibit 2009 as irrelevant, misleading, or confusing, and its probative value, if any, is outweighed by prejudice for the reasons stated above with respect to FRE 702 and 703.

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**CERTIFICATE OF SERVICE ON PATENT OWNER
UNDER 37 C.F.R. § 42.105**

Pursuant to 37 C.F.R. §§ 42.6(e) and 42.105(b), the undersigned certifies that on January 22, 2024, a copy of the foregoing document was served on Patent Owner electronically, by agreement, by emailing a copy of the same to the following attorneys for the Patent Owner:

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