

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,
Petitioner,

v.

X1 DISCOVERY, INC.,
Patent Owner.

IPR2025-00255
Patent 9,633,139

PETITIONER'S MOTION TO STRIKE EX2027

The Board should strike Patent Owner's EX2027, filed with its Sur-Reply, and give no weight to the portions of the Sur-Reply that rely on this exhibit.

The Board did not authorize PO to file EX2027, and the rules and regulations prohibit such sur-reply exhibits. 37 C.F.R. § 42.23(b); USPTO, *Patent Trial & Appeal Board Consolidated Trial Practice Guide* at 73-74 (Nov. 2019). As the Board has explained, "the proper avenue for seeking entry of additional evidence is not by submitting such evidence *sub silentio*, but by requesting authorization to file such evidence." *Resi Media LLC v. Boxcast Inc.*, IPR2022-00067, Paper 56 at 48-49 (PTAB Apr. 12, 2023).

Although deposition exhibits can be submitted to provide context for an expert's testimony, PO improperly relies on this exhibit to support its patentability arguments. Specifically, PO alleges that a POSITA would not have reasonably expected success in implementing the Petition's prior art combinations because "[t]ypical [d]atabases in 2002 [f]ar [e]xceeded Petitioner's [a]ssumed [s]ize" of 2-10 MB and points to EX2027 as alleged evidence that "Entourage supports databases of up to 2 GB." Paper 37 at 22-24.

Further, EX2027 does not provide context for Dr. Terveen's deposition testimony and should not be considered even for this limited purpose. Dr. Terveen had not seen EX2027 before the deposition and the exhibit adds nothing beyond what is already in the deposition transcript (EX2026).

Dr. Terveen explained that EX2027 was something that he was “just reading ... right now” and was “something that [he] ha[d] not looked at specifically.” EX2026, 205:4-5, 207:14-15. *See Netflix Inc. v. DivX, LLC*, IPR2020-00511, Paper 46 at 55 (PTAB Aug. 13, 2021) (finding that the sur-reply exhibit did not provide context for the expert’s deposition because the expert “repeatedly testified that he had not seen the exhibits”). These facts are quite different from *Ascend Performance Materials Operations LLC v. Samsung SDI Co.*, IPR2020-00349, where the expert had already seen the molecular structure shown in the deposition exhibits (EX2048, EX2052) and recalled addressing that structure in his declaration (EX2049, 45:21-46:5 (“[] I believe I addressed that in my declaration.”)). *See id.*, Paper 53 at 11-13 (PTAB Jul. 15, 2021).

Further, unlike in *Ascend*, where the exhibit was an image (a molecular diagram) that provided context for the deposition testimony, here, EX2027 contains text that PO’s counsel had Dr. Terveen read out loud during his deposition. EX2026, 203:16-207:21 (“[A]gain, I’m just reading this document ... and I see ‘Entourage 2001 has a limit of 2 gigabytes’”). Thus, the substance of EX2027 is already captured in the transcript and provides no additional contextual value.

For at least these reasons, the Board should strike EX2027 and give no weight to the portions of the Sur-Reply that rely on this exhibit.

Respectfully submitted,

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CERTIFICATE OF SERVICE
IN COMPLIANCE WITH 37 C.F.R. § 42.6(e)(4)

The undersigned certifies that on April 16, 2026, a complete copy of **PETITIONER’S MOTION TO STRIKE EX2027** was served on counsel for the Patent Owner via electronic mail as follows:

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