UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,
Petitioner,
v.

X1 DISCOVERY, INC.,
Patent Owner

U.S. Patent No. 9,633,139

Case No. IPR2025-00255

PATENT OWNER'S OPPOSITION TO MOTION TO STRIKE EX2027

The Board should deny Petitioner's motion to strike EX2027. This exhibit was introduced during Dr. Terveen's deposition, he was questioned and testified extensively about it, and it is directly relevant to the credibility of his declaration testimony; thus, the exhibit is necessary for the Board to evaluate that testimony. The Board has held in similar situations that it is proper to submit exhibits introduced at deposition with the transcript to provide full context for the testimony. *See Ascend Performance Materials Operations LLC v. Samsung SDI Co.*, IPR2020-00349, Paper 53 at 12-13 (PTAB Jul. 15, 2021) (where an exhibit is used at deposition to test credibility, it is proper to file the exhibit with a transcript "so the Board has the full context available in order to evaluate the testimony").

The deposition testimony elicited through EX2027 is directly responsive to new opinions submitted by Dr. Terveen with Petitioner's Reply and is critical for assessing the credibility of his opinions and testimony. (*See, e.g.*, Reply, 4 (citing EX1100, ¶¶13-32).) In his Supplemental Declaration, Dr. Terveen asserted for the first time that email databases in 2002 "were often between two and four megabytes," citing the storage limits of online email services such as Yahoo! Mail (EX1100, ¶13; EX1095; EX1096). In contrast, EX2027 establishes that Entourage 2001, the system described in Petitioner's primary Ground 2 references, supported databases of up to 2 GB, three orders of magnitude larger than the upper limit Dr. Terveen used in forming his opinion. (EX2026, 204:11-17.) When confronted with

EX2027 at deposition Dr. Terveen admitted he had not considered the actual maximum database size of the Entourage system. (EX2026, 205:4-207:21.)

Dr. Terveen's testimony and EX2026 establish that he relied on irrelevant information and failed to perform even the most cursory search to determine the maximum size of an email database in the very system described in Petitioner's primary Ground 2 references. (EX2026, 207:14-15 ("[T]his [Entourage's maximum email database size] is not something I have looked at specifically.")) This failure calls into question the credibility of all of Dr. Terveen's opinions and testimony that build from the irrelevant information he relied upon.

Furthermore, contrary to Petitioner's assertion, the Sur-Reply does not "rely" on EX2027. (Paper 41, 1.) The Exhibit is cited a single time in a string cite with a citation to the deposition transcript, and the information in EX2027 is not used in any part of the arguments presented in the Sur-Reply. (Sur-Reply, 24.) Indeed, Petitioner fails to state with specificity what portion of the Sur-Reply it seeks to have stricken, citing to a range of three pages while EX2027 was cited a single time on the last page of the cited page range and was not expressly relied on for the arguments presented. (Paper 41, 1; Sur-Reply, 24.) Rather, EX2027 was cited to provide context for the deposition testimony, the purpose of which was to test Dr. Terveen's credibility.

Patent Owner respectfully requests that the Board deny Petitioner's Motion.

Dated: April 20, 2026 By: /Lori A. Gordon/

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CERTIFICATE OF SERVICE

A copy of Patent Owner's Opposition to Motion to Strike EX2027 has been served on Petitioner's attorneys of record as follows via electronic mail:

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