

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,

Petitioner,

v.

STERLING COMPUTERS CORPORATION,

Patent Owner.

IPR No. 2025-00270

U.S. Patent No. 8,073,911

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

TABLE OF CONTENTS

	Pages
I. Introduction	1
II. Khan’s Testimony Should Not Be Excluded	2
A. Hypothetical Questions Are a Well-Established and Proper Method of Examining Expert Witnesses	2
B. The Hypothetical Was Not “Incomplete” in Any Meaningful Sense	6
C. The Cross-Examination Was Within the Scope of Direct	7
D. Patent Owner’s Motion Improperly Challenges the Weight of the Evidence	10
III. Conclusion	11

TABLE OF AUTHORITIES

Page(s)

Cases

<i>1964 Ears, LLC v. Jerry Harvey Audio Holding, LLC</i> , No. IPR2016-00494, 2017 WL 3088112 (P.T.A.B. July 19, 2017).....	9
<i>Cardiovascular Sys., Inc. v. Shockwave Med., Inc.</i> , IPR2019-00408, Paper 70 (P.T.A.B, July 20, 2020)	11
<i>Corning Inc. v. DSM IP Assets B.V.</i> , No. IPR2013-00053, 2014 WL 1783282 (P.T.A.B. May 1, 2014)	2
<i>Daubert v. Merrell Dow Pharms., Inc.</i> , 509 U.S. 579 (1993).....	4, 9
<i>eBay Inc. v. Global Equity Mgmt. (SA) Pty. Ltd.</i> , IPR2016-01828, Paper 62 (P.T.A.B, April 18, 2018).....	11
<i>Eli Lilly & Co. v. Teva Pharms. Int’l GmbH</i> , No. IPR2018-01710, 2020 WL 1540364 (P.T.A.B. Mar. 31, 2020).....	9
<i>Harris v. Smith</i> , 372 F.2d 806 (8th Cir. 1967)	5
<i>Life Techs., Inc. v. Clontech Lab’ys, Inc.</i> , 224 F.3d 1320 (Fed. Cir. 2000)	4
<i>Williams v. Illinois</i> , 567 U.S. 50 (2012).....	2, 3, 5
<i>Willis Elec. Co., Ltd. v. Polygroup Ltd. (Macao Com. Offshore)</i> , 166 F.4th 1363 (Fed. Cir. 2026)	6, 8

Other Authorities

37 C.F.R. § 42.20	2
Fed. R. Evid. 611(b).....	7
Fed. R. Evid. 702	1, 4

Fed. R. Evid. 702 advisory committee’s note to 2000 amendment.....	4
Fed. R. Evid. 703	1, 3
1 J. Wigmore, <i>Evidence</i> § 677 (2d ed. 1923)	3
1 K. Broun, <i>McCormick on Evidence</i> § 14 (6th ed. 2006)	3
U.S. Patent & Trademark Office, <i>Patent Trial & Appeal Board</i> <i>Consolidated Trial Practice Guide</i> 79 (Nov. 2019)	10

I. Introduction

Petitioner Microsoft Corporation submits this Opposition to Patent Owner Sterling Computers Corporation’s Motion to Exclude Evidence (Paper 29) (“Motion”). The Motion seeks to exclude cross-examination testimony of Patent Owner’s own expert, Dr. Latifur Khan, in which Khan answered a hypothetical question about what would happen if a user replied to an email in the context of the Schiavone reference applying different legal compliance rules based on location of the recipient (e.g., in the US or France). EX.1022, 65:8–70:10 at 68:9–70:10.¹

Patent Owner’s Motion should be denied because the challenged cross-examination was proper under the Federal Rules of Evidence 702 and 703, which expressly contemplate hypothetical questions as a means of examining experts. The hypothetical tested the logical implications of Khan’s own opinions about Schiavone and was squarely within the scope of his Declaration (EX.2005), which opines at length that Schiavone does not disclose applying rules at the submessage level—the very limitation the hypothetical probed. And the hypothetical was well grounded in testing the bounds of the Schiavone reference within the context of the knowledge of a person of ordinary skill in the art (“POSITA”) concerning reply email messaging. Patent Owner’s Motion is an improper attempt to challenge the weight

¹ This line of questioning was in the context of Schiavone Paragraphs [0029] and [0033]. See EX.2005, ¶151 (citing EX.1003, ¶195 (referring to *id.*, ¶196) (citing to EX.1006, ¶¶[0029],[0033])).

of testimony rather than its admissibility. Accordingly, the Board should deny the Motion.

II. Khan's Testimony Should Not Be Excluded

A motion to exclude must be based on proper evidentiary grounds and must meet the moving party's burden of demonstrating inadmissibility. 37 C.F.R. § 42.20. "Similar to a district court in a bench trial, the Board, sitting as a non-jury tribunal with administrative expertise, is well-positioned to determine and assign appropriate weight to evidence presented." *Corning Inc. v. DSM IP Assets B.V.*, No. IPR2013-00053, 2014 WL 1783282, at *11 (P.T.A.B. May 1, 2014),

A. Hypothetical Questions Are a Well-Established and Proper Method of Examining Expert Witnesses

Patent Owner's principal argument that the hypothetical "assumes facts not in evidence" and "calls for speculation" fundamentally misapprehends the nature and purpose of hypothetical questions in expert examination.

Hypothetical questions directed to expert witnesses have been an accepted evidentiary practice for over two hundred years. *See Williams v. Illinois*, 567 U.S. 50, 57 (2012) ("For more than 200 years, the law of evidence has permitted the sort of testimony that was given by the expert in this case . . . an expert may express an opinion that is based on facts that the expert assumes, but does not know, to be true."). As the Supreme Court further explained:

It has long been accepted that an expert witness may voice an opinion based on facts concerning the events at issue in a particular case even if the expert lacks first-hand knowledge of those facts. . . . [C]ourts developed the alternative practice of allowing an expert to testify in the form of a “hypothetical question.” Under this approach, the expert would be asked to assume the truth of certain factual predicates, and was then asked to offer an opinion based on those assumptions.

Id. at 67; *see also* 1 K. Broun, *McCormick on Evidence* § 14, p. 87 (6th ed. 2006); 1 J. Wigmore, *Evidence* § 677, p. 1084 (2d ed. 1923) (“If the witness is skilled enough, his opinion may be adequately obtained upon hypothetical data alone; and it is immaterial whether he has ever seen the person, place or thing in question” (citation omitted)).

The Federal Rules of Evidence also expressly authorize this practice. Federal Rule of Evidence 703 governs what facts or data an expert may rely on and provides that “[a]n expert may base an opinion on facts or data in the case that the expert has been made aware of or personally observed. If experts in the particular field would reasonably rely on those kinds of facts or data in forming an opinion on the subject, they need not be admissible for the opinion to be admitted.” Fed. R. Evid. 703. The advisory committee’s note to Rule 703 identifies three permissible sources of facts for expert testimony and explains that “[t]he second source, presentation at the trial, also reflects existing practice. The technique may be the familiar hypothetical question or having the expert attend the trial and hear the testimony establishing the facts.” Fed. R. Evid. 703 advisory committee’s note to proposed rules.

Likewise, the advisory committee's note to Rule 702 confirms that "[t]he language 'facts or data' is broad enough to allow an expert to rely on hypothetical facts that are supported by the evidence." Fed. R. Evid. 702 advisory committee's note to 2000 amendment. The note further explains that "an expert opinion need not be excluded simply because it is based on hypothetical facts," and that "[w]hen facts are in dispute, experts sometimes reach different conclusions based on competing versions of the facts." *Id.* Moreover, the proper remedy for challenges to expert testimony is not exclusion but cross-examination: "Vigorous cross-examination, presentation of contrary evidence, and careful instruction on the burden of proof are the traditional and appropriate means of attacking shaky but admissible evidence." *Id.* (quoting *Daubert v. Merrell Dow Pharms., Inc.*, 509 U.S. 579, 595 (1993)).

Moreover, expert testimony in patent cases is inherently hypothetical in nature; experts are required to assess patentability from the perspective of a hypothetical POSITA. *See Life Techs., Inc. v. Clontech Lab'ys, Inc.*, 224 F.3d 1320, 1325 (Fed. Cir. 2000) ("[P]atentability is assessed from the perspective of the hypothetical person of ordinary skill in the art."). Cross-examination probing an expert's understanding of the prior art through hypothetical questions is the natural counterpart to this inherently hypothetical form of testimony.

The hypothetical posed to Khan of whether different legal compliance rules disclosed in Schiavone would be applied to a reply message is precisely the type of

question the Federal Rules and caselaw contemplate here. Whether Schiavone discloses a “reply” scenario does not render the hypothetical improper; to the contrary, it is the very purpose of a hypothetical to test the logical boundaries of an expert’s opinions by asking the expert to apply his understanding to scenarios beyond those explicitly stated in the prior art. *See Williams*, 567 U.S. at 68 (noting that experts “could be asked on cross-examination what their opinion . . . would be if different hypothetical facts were assumed”).

Patent Owner’s reliance on *Harris v. Smith*, 372 F.2d 806 (8th Cir. 1967) is misplaced. In *Harris*, the Eighth Circuit found hypothetical questions defective because they improperly incorporated the opinion of another expert witness rather than being grounded in the plain facts of the case. 372 F.2d at 810. The court held the questions were improper because they asked the expert, a doctor, to assume another doctor’s conclusions about the “normalcy” of a patient’s condition, rather than presenting the actual temperature, pulse, and respiration data. *Id.* at 811–12.

Here, by contrast, the hypothetical was not based on another expert’s opinion but instead a reply email scenario well within the common knowledge of a POSITA and within the scope of the evidence. Indeed, the Board has already found that the relevant POSITA “would have had a working knowledge of the telecommunications and networking art . . . including . . . internet-based communication technologies and electronic mail systems.” Institution Decision (Paper 12), at 9. A POSITA would

plainly understand what happens when a user replies to an email, making the hypothetical's factual premise well-grounded in the facts of the Schiavone reference and the knowledge of a POSITA.

B. The Hypothetical Was Not “Incomplete” in Any Meaningful Sense

Patent Owner's argument that the hypothetical was “incomplete” because it did not specify whether the user hit “reply all” or replied only to the sender (Motion at 4–5) similarly fails. Hypothetical questions need not specify every conceivable detail to be proper. *Cf. Willis Elec. Co., Ltd. v. Polygroup Ltd. (Macao Com. Offshore)*, 166 F.4th 1363, 1378 (Fed. Cir. 2026) (holding that “[r]ule 702 does not require a damages expert to account for every conceivable variation among products, nor does it demand mathematical exactness.”). The purpose of cross-examination is to test the witness's reasoning and the robustness of his opinions, not to present a perfectly specified scenario that answers itself.

Patent Owner's own expert did not express confusion about the hypothetical or request clarification of any missing details he would need to answer the hypothetical.² *See generally* EX.1022. To the contrary, Khan engaged substantively

² Counsel for Patent Owner had full opportunity to redirect Khan on this very topic, yet Patent Owner's counsel chose not to do so. EX.1022, 70:11–25. Had counsel believed the hypothetical was incomplete or otherwise confusing, it could have elicited testimony on redirect to clarify or rehabilitate Khan's response. Its failure to do so on redirect confirms that Khan's answer was responsive and complete as given, and otherwise that there was no prejudice to Patent Owner.

with the question and provided detailed testimony, explaining that if a user replies, “the role has been reversed here in this case, the sender and the recipient. In that case there is a possibility that a different rule may be applied.” EX.1022, 69:5–8. He further testified that “the rule now will be applied only for Message 2 when I reply back. It does not take into consideration Message 1.” EX.1022, 70:5–6. The witness understood the question, answered it, and his answer speaks for itself.³

C. The Cross-Examination Was Within the Scope of Direct

Patent Owner’s final argument that the hypothetical “goes beyond the scope of direct” is incorrect. Federal Rule of Evidence 611(b) provides that “[c]ross-examination should not go beyond the *subject matter* of the direct examination.” (emphasis added). This rule limits cross-examination to the subject matter of the direct, not to the precise words that the expert used.

³ Patent Owner argues in footnote 1 of its Motion that even if the testimony is not excluded, it “still does not supply the missing limitation” because “the same rule (i.e., COPPA) applies to both the initial message and the hypothetical reply.” But Patent Owner mischaracterizes the testimony. Khan testified that, in a situation where one recipient “lives in the US [and] [a]nother one lives in France, ... you may end up with different rules to be applied based on the recipient’s profile” under Schiavone’s system. EX.1022, 65:20–66:7. He then confirmed that under Schiavone’s system, when a user replies to a message (“the first submessage, [which] is Message 1”), different rules would be applied to the reply (“Message 2”—the “most recent submessage”) because Schiavone “does not take into consideration Message 1” for the reply. *Id.*, 69:12–70:6. That is differential treatment at the submessage level.

Khan's Declaration squarely addresses the subject matter at issue. In his Declaration (EX.2005), Khan devotes extensive discussion to whether Schiavone discloses applying rules at the submessage level, the very subject matter at issue. Khan opined that "Schiavone does not discuss the different components of email threads (i.e., original message, replies, and forwards)—i.e., 'submessages'—at all," and that "Schiavone also does not discuss applying rules at the submessage level." EX.2005, ¶142. He further opined that Schiavone's disclosures about applying different rules to recipients in US and France relate to "treatment of the message as a whole" and "applying different rules to the same message" rather than to different submessages. *Id.* at ¶¶143, 151.

The cross-examination hypothetical directly tested the subject matter of these opinions by exploring whether, under the different legal compliance rules disclosed in Schiavone, a reply to the original message would result in different rules being applied to different submessages. This is paradigmatic cross-examination, probing the soundness of an expert's opinion on direct by presenting a scenario within the scope of that opinion. *See Willis Electric*, 166 F.4th 1374 ("'[V]igorous cross-examination, presentation of contrary evidence, and careful instruction on the burden of proof' remain the appropriate means to test 'shaky but admissible evidence.'"") (quoting *Daubert*, 509 U.S. at 596). The question was not about some new, unrelated topic; it was about exactly what Khan opined on: whether Schiavone's rule-based

system, when applied to an email conversation, would result in different rules applying to different submessages.

Patent Owner's cited cases are distinguishable, and in fact, they support Petitioner's position. In *Eli Lilly & Co. v. Teva Pharmaceuticals International GmbH*, the Board denied the vast majority of the patent owner's motion to exclude cross-examination testimony, finding that objections about question form "address issues of weight rather than admissibility." No. IPR2018-01710, 2020 WL 1540364 at *67 (P.T.A.B. Mar. 31, 2020). Notably, the Board refused to exclude testimony relating to a "legal hypothetical," reasoning that "because this is not a jury trial, the Board can separate legal issues from fact issues in rendering interpreting witness testimony." *Id.* The Board only excluded a narrow line of cross-examination questioning about "cyclic AMP" that was entirely unrelated to the expert's declaration. *Id.* (granting exclusion because "questions on cyclic AMP were beyond the scope of the Ferrari Declaration"). Similarly, in *1964 Ears, LLC v. Jerry Harvey Audio Holding, LLC*, the Board excluded cross-examination testimony only because the expert's opinion about driver positioning was based on *other* prior art references (Mostardo, Nielsen, and Van Halteren '807), not the reference about which the cross-examiner was asking (Van Halteren '223). No. IPR2016-00494, 2017 WL 3088112 at *9 (P.T.A.B. July 19, 2017) ("because Mr. Kadis' opinion that a person of ordinary skill in the art would have known how to position the two drivers in a

dual driver so that their oscillations interact to reduce distortion was based on the teachings of Mostardo, Nielsen, or Van Halteren '807, and was not based on the teachings of Van Halteren '223. Patent Owner's questioning of Mr. Kadis regarding the specific positioning of the two drivers shown in Figure 1 of Van Halteren '223 was beyond the proper scope of cross-examination"). Here, the situation is the opposite: the cross-examination addressed Schiavone, the very reference on which Khan's opinions are based, and the identical claim limitation—"different rules of the compliance policy are applicable to different ones of the plurality of sent submessages"—that Khan discussed at length in his declaration. EX.2005, 66–67. The hypothetical simply tested the bounds of Khan's opinion about that limitation.

D. Patent Owner's Motion Improperly Challenges the Weight of the Evidence

Patent Owner's Motion is not a proper motion to exclude. It is an attempt to prevent the Board from considering testimony that Patent Owner finds inconvenient. "A motion to exclude must explain why the evidence is not admissible (e.g., relevance or hearsay) but may not be used to challenge the sufficiency of the evidence to prove a particular fact." U.S. Patent & Trademark Office, *Patent Trial & Appeal Board Consolidated Trial Practice Guide* 79 (Nov. 2019). Patent Owner's arguments about the hypothetical being "incomplete" or that Schiavone "does not discuss" a reply scenario are arguments about the sufficiency of the testimony and not about its admissibility. It is settled that the Board is well-equipped to assess

evidence presented to it, and challenges to expert testimony based on support go to the weight, not admissibility, of the evidence. *See, e.g., eBay Inc. v. Global Equity Mgmt. (SA) Pty. Ltd.*, IPR2016-01828, Paper 62 at 3 (P.T.A.B, April 18, 2018); *Cardiovascular Sys., Inc. v. Shockwave Med., Inc.*, IPR2019-00408, Paper 70 at 55 (P.T.A.B, July 20, 2020).

Here, Khan's cross-examination testimony was well-supported and the Board should accord it full weight.

III. Conclusion

For the foregoing reasons, Petitioner respectfully requests that the Board deny Patent Owner's Motion to Exclude Evidence in its entirety.

Dated: June 9, 2026

Respectfully submitted,

/s/ Dustin J. Edwards

Dustin J. Edwards

Reg. No. 57,649

WINSTON TAYLOR LLP

800 Capitol St., Suite 2400

Houston, Texas 77002-2925

dustin.edwards@winstontaylor.com

T: 713.651.2627 F: 713.651.2700

*Lead Counsel for Petitioner
Microsoft Corporation*

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. 42.6(e), I certify that on this 9th day of June, 2026, a true and correct copy of the foregoing **Petitioner's Opposition to Patent Owner's Motion to Exclude Evidence** was served by electronic mail on Patent Owner's lead and backup counsel at the following addresses:

Devan Padmanabhan - devan@paddalawgroup.com

Michelle E. Dawson - michelle@paddalawgroup.com

Britta S. Loftus - britta@paddalawgroup.com

Dated: June 9, 2026

Respectfully submitted,

/s/ Dustin J. Edwards

Dustin J. Edwards

Reg. No. 57,649

WINSTON TAYLOR LLP

800 Capitol St., Suite 2400

Houston, Texas 77002-2925

dustin.edwards@winstontaylor.com

T: 713.651.2627 F: 713.651.2700

*Lead Counsel for Petitioner
Microsoft Corporation*