

From: [Trials](#)
To: [Okano, David](#); britta@paddalawgroup.com; devan@paddalawgroup.com; andy@paddalawgroup.com; shari@paddalawgroup.com; paul@paddalawgroup.com; sri@paddalawgroup.com; [W&C SterlingComputer-XCorp](#); [Chaikovsky, Yar](#); [Plail, Ethan](#)
Cc: [Trials](#)
Subject: RE: IPR2025-00299 | Request for Leave to File a Reply to POPR
Date: Wednesday, April 9, 2025 11:53:26 AM

Counsel,

As Patent Owner does not oppose, the Board grants Petitioner's request to file two additional exhibits: (1) a complete version of Exhibit 2010 and (2) screenshots of the system metadata for Exhibit 2010. Petitioner may file those two exhibits with its Preliminary Reply in the manner described in Petitioner's request.

Regards,

Andrew Kellogg,
Deputy Chief Clerk, Trials
Patent Trial and Appeal Board
USPTO
andrew.kellogg@uspto.gov
(571) 272-5366

From: Okano, David <david.okano@whitecase.com>
Sent: Tuesday, April 8, 2025 11:06 PM
To: Trials <Trials@USPTO.GOV>; britta@paddalawgroup.com; devan@paddalawgroup.com; andy@paddalawgroup.com; shari@paddalawgroup.com; paul@paddalawgroup.com; sri@paddalawgroup.com; [W&C SterlingComputer-XCorp](#) <WCSterlingComputerXCorp@whitecase.com>; Chaikovsky, Yar <yar.chaikovsky@whitecase.com>; Plail, Ethan <ethan.plail@whitecase.com>
Subject: RE: IPR2025-00299 | Request for Leave to File a Reply to POPR

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Dear Honorable Board,

Thank you for the Board's authorization to file a reply to Patent Owner Sterling Computer Corporation's POPR. The Board's authorization notes that "no additional evidence may be submitted at this time." Petitioner respectfully requests permission to file with its reply: (1) a complete version of EX2010, and (2) screenshots of the system metadata for EX2010.

Patent Owner Sterling submitted with its POPR, Mr. Marston's declaration (EX2003) and alleged evidence of conception (EXS2004-2013). Petitioner requested that Patent Owner produce the native versions of EXS2004-2013 under the rules of Routine Discovery. And Patent Owner produced the requested files on March 27, 2025. However, the native versions EX2007, EX2008, EX2010, EX2011, and EX2012 include comments and native redlines that are not present or visible in the versions of these exhibits that Patent Owner submitted to the Board. In particular, the native versions of EX2010, EX2011, and EX2012 show redlines, and comments made by a third party, Jon Fernyhough. Accordingly,

Petitioner respectfully requests permission to file the complete version of at least EX2010 (i.e., printing the file to PDF with redline/comments set to visible) so the Board can consider a complete record when preparing its Institution Decision. While EX2010 is most relevant to Petitioner's arguments, should it be helpful to the Board, Petitioner can additionally file complete versions of EX2007, EX2008, EX2011, and EX2012.

Similarly, the metadata for EXS2004-2013 was relied on and cited in Mr. Marston's declaration. However, the metadata printouts provided by Patent Owner are likewise incomplete. The metadata for EX2010 shows that EX2010 was also last saved by Mr. Fernyhough. As such, Petitioner respectfully requests permission to file the complete metadata for EX2010.

Petitioner has conferred with Patent Owner, who has indicated they do not oppose this request.

Respectfully,
David

David Okano | Partner
T [+1 650 213 0363](tel:+16502130363) M [+1 949 478 4350](tel:+19494784350)

From: Trials <Trials@USPTO.GOV>
Sent: Monday, April 7, 2025 11:44 AM
To: Okano, David <david.okano@whitecase.com>; britta@paddalawgroup.com;
devan@paddalawgroup.com; andy@paddalawgroup.com; shari@paddalawgroup.com;
paul@paddalawgroup.com; sri@paddalawgroup.com; W&C SterlingComputer-XCorp
<WCSterlingComputerXCorp@whitecase.com>; Chaikovsky, Yar <yar.chaikovsky@whitecase.com>;
Plail, Ethan <ethan.plail@whitecase.com>
Cc: Trials <Trials@USPTO.GOV>
Subject: [EXT] RE: IPR2025-00299 | Request for Leave to File a Reply to POPR

Counsel,

As Patent Owner does not oppose, the Board grants Petitioner's request for additional briefing on the issues identified below. We adjust the requested page limit and briefing schedule, however. Petitioner may file a 7-page Preliminary Reply no later than Monday, April 14, 2025. Patent Owner may file a 7-page Preliminary Sur-Reply no later than Monday, April 28, 2025. The briefs may not address issues outside the scope of the issues identified below and no additional evidence may be submitted at this time.

Regards,

Andrew Kellogg,
Deputy Chief Clerk, Trials
Patent Trial and Appeal Board
USPTO
andrew.kellogg@uspto.gov
(571) 272-5366

From: Okano, David <david.okano@whitecase.com>

Sent: Friday, April 4, 2025 4:32 PM

To: Trials <Trials@USPTO.GOV>

Cc: britta@paddalawgroup.com; devan@paddalawgroup.com; andy@paddalawgroup.com; shari@paddalawgroup.com; paul@paddalawgroup.com; sri@paddalawgroup.com; W&C SterlingComputer-XCorp <WC SterlingComputerXCorp@whitecase.com>; Chaikovsky, Yar <yar.chaikovsky@whitecase.com>; Plail, Ethan <ethan.plail@whitecase.com>

Subject: IPR2025-00299 | Request for Leave to File a Reply to POPR

CAUTION: This email has originated from a source outside of USPTO. **PLEASE CONSIDER THE SOURCE** before responding, clicking on links, or opening attachments.

Dear Honorable Board,

Petitioner X Corp. writes to respectfully request leave to file a reply to Patent Owner Sterling Computer Corporation's POPR submitted in IPR2025-00299. Petitioner has conferred with Patent Owner, and Patent Owner indicates it does not oppose this request, as set forth below.

Petitioner seeks leave to file a short reply to address certain issues raised for the first time in Patent Owner's POPR, including: (1) the inventors alleged earlier conception and reduction to practice of the claimed invention, and (2) the proper construction of claim terms "cognate" and "recipient." Petitioner requests a 9-page reply to the POPR, due one week after the Board's authorization, and does not oppose a reciprocal 9-page sur-reply from Patent Owner, due three weeks after Petitioner's reply.

Good cause for this request exists at least because the POPR introduces new arguments and evidence (including Mr. Marston's declaration) (EX2003) relating to alleged conception and reduction to practice of the '217 Patent. In particular, Patent Owner argues, based on non-public drafts and testimony, that "the inventors of the '217 Patent conceived of their invention at least as early as June 7, 2005." POPR at 24. Based on this earlier conception date, Patent Owner argued that "the '217 Patent has a priority date that is earlier than the Dumais [prior art] priority date." *Id.* Petitioner was unaware of Patent Owner's conception evidence while preparing the Petition and could not have predicted Patent Owner's new arguments. Accordingly, good cause exists to allow Petitioner to respond to Patent Owner's newly introduced evidence and arguments. Petitioner's request here is consistent with the Trial Practice guide and the Board's consistent practice of allowing Petitioners to reply to new testimonial evidence submitted in the preliminary trial stage. See Trial Practice Guide at 51 ("Submission of patent owner testimonial evidence at the preliminary stage may warrant granting the petitioner a reply to such evidence."); see also *Samsung Electronics Co., Ltd. v. Netlist, Inc.*, IPR2022-00639, Paper 10; Ex. 3002 (granting Petitioner's request for a preliminary reply where patent owner introduced a new supporting expert declaration at the POPR stage); *Cisco Systems, Inc. v. Egenera, Inc.*, IPR2017-01341, Paper 8 (granting request for preliminary reply to address "Patent Owner's argument and supporting evidence cited in the Preliminary Response that the named inventors conceived of the claimed subject matter before the priority date of Petitioner's cited art"); *Apple Inc. v. Personalized Media Communications, LLC*, IPR2016-00755, Paper 8 (similar).

The POPR also introduces two new claim construction issues relating to the terms "*a recipient*" and "*cognate*." Patent Owner expressly construes "*a recipient*" to be a user that actually received the piece of electronic content sent from a sender. POPR at 20. Patent Owner also argues that "cognate users in the '217 Patent are **more restricted** than the generic collaborative filtering described in Dumais." POPR at 34 (emphasis added). Petitioner could not have predicted that Patent Owner would construe either term. Therefore, good cause exists to grant Petitioner's request for a reply. *Flywheel Sports, Inc. et al v. Peloton Interactive, Inc.*, IPR2019-00564, Paper 13 ("Petitioner is authorized to file a reply addressing only the claim construction arguments in the Preliminary Response.")

Both parties are available for a telephonic conference if requested by the Board. We appreciate the

Board's attention and await further instructions.

Respectfully,

David

David Okano | Partner

T +1 650 213 0363 **M** +1 949 478 4350 **E** david.okano@whitecase.com

White & Case LLP | 3000 El Camino Real | 2 Palo Alto Square, Suite 900 | Palo Alto, CA 94306-2109

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