

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

X CORPORATION,
Petitioner,

v.

STERLING COMPUTERS CORPORATION,
Patent Owner.

Case No. IPR2025-00299
U.S. Patent No. 7,716,217

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

I. Introduction

Pursuant to 37 C.F.R. § 42.64(b)(1) and the Federal Rules of Evidence (FRE), Petitioner X Corp. (“Petitioner”) submits the following objections to Sterling Computer Corp. (“Patent Owner”) Exhibits 2004-2014, paragraphs 3-30 of the Declaration of Justin Marston (EX2003), and paragraphs 23-26, 28, 30, 33-36, 101, 141-145, 147 of the Declaration of Dr. Latifur Khan (EX2001).

Petitioner’s objections are made pursuant to the Code of Federal Regulations (“C.F.R.”) governing this proceeding, including without limitation 37 C.F.R. §§42.61-42.65 and §42.6(a)(3). As required by 37 C.F.R. §42.62, Petitioner’s objections below apply the Federal Rules of Evidence (“FRE”).

II. Exhibit 2001 (Declaration of Dr. Latifur Khan)

Petitioner objects to Paragraphs 23-26, 28, 30, 33-36, 101, 141-145, 147 of EX2001, the Declaration of Dr. Latifur Khan, as each paragraph is simply *ipse dixit*. Khan provides conclusory opinions and statements in these paragraphs relating to what a person of ordinary skill in the art (“POSA”) would and would not do, without providing any testimony, explanation, or evidence in support beyond his statements. These paragraphs are objected to for lacking foundation and because they are not based in sufficient facts or data under FRE 702.

Due to these deficiencies, Patent Owner has failed to establish that these paragraphs are relevant under FRE 401, and therefore these paragraphs are inadmissible under FRE 402/403 and should be excluded.

Petitioner also objects to Exhibit 2001 to the extent it relies on other inadmissible exhibits and testimony (as discussed below). Exhibit 2001 is objected to under FRE 802 to the extent it relies on those exhibits or testimony for the truth of the matters asserted.

III. Exhibit 2003 (Declaration of Justin Marston)

Petitioner objects to Paragraphs 15-30 of EX2003 as being improper expert testimony offered by the inventor and lay witness. *See Air Turbine Tech., Inc. v. Atlas Copco AB*, 410 F.3d 701 (Fed. Cir. 2005). There is no evidence tending to show that Mr. Marston was a person of ordinary skill in the art at the relevant time. Additionally, there is no evidence showing Mr. Marston was familiar with the knowledge of a person of ordinary skill in the art at the relevant time. There is no indication that the statements in Paragraphs 15-30 are based on Mr. Marston's personal knowledge. Yet in Paragraphs 15-30 Mr. Marston makes several statements from the perspective of an expert and opining on the knowledge of a person of ordinary skill in the art, for example:

The provisional patent application contains an enabling disclosure of the invention. With that disclosure in hand, a person of ordinary skill in

the art would be able to practice the claimed invention using tools and techniques that were known or conventional in the art by 2004.

EX2003, ¶30.

Mr. Marston's improper testimony takes three forms. First, Mr. Marston explicitly provides improper testimony on claim construction for certain claim terms of the '217 patent and whether they provide sufficient structure to perform the claimed functions. Second, Mr. Marston explicitly opines as to how a POSA would understand these claim terms and implement them. Finally, in Paragraph 29, Mr. Marston improperly opines that the invention was "new and nonobvious." Patent Owner did not identify Mr. Marston as a technical witness, nor were any of qualifications required under FRE 702/703 provided in Mr. Marston's Declaration to justify these opinions. All three forms are Mr. Marston providing improper legal opinions and should accordingly be excluded. Mr. Marston's Declaration is also objected to under FRE 403 for the same reasons—i.e., the testimony of a non-expert is unduly prejudicial and a waste of time.

The same paragraphs lack foundation because Mr. Marston fails to provide any citations to evidence or the record tending to show his statements are true.

To the extent Mr. Marston's testimony is relied on for the purposes of claim construction, Petitioner objects because "as a general matter courts give no deference to testimony from an inventor as to how a claim term should be construed."

Markman v. Westview Instruments, Inc., 52 F.3d 967, 983 (Fed. Cir. 1995), *aff'd*, 517 U.S. 370 (1996) (en banc) (“First, the testimony of [Mr.] Markman [the inventor] and his patent attorney on the proper construction of the claim is entitled to no deference”). Accordingly, these paragraphs would be irrelevant under FRE 401, 402, and 403.

Petitioner objects to Paragraphs 3-14 for lack of authentication under FRE 901. Mr. Marston relies on these paragraphs to “show the continued work on mathematics for the relevance model,” but fails to provide any testimony sufficient to support a finding that the documents referenced within them are what Mr. Marston claims they are. Patent Owner has also not provided independent evidence sufficient to show what these documents are, who created them, and how they were created. *Apator Miitors ApS v. Kamstrup A/S*, 887 F.3d 1293, 1295 (Fed. Cir. 2018). The documents fail to show on their face the information Mr. Marston claims to be true in his declaration. For example, of the metadata slip sheet provided for ten exhibits, only exhibits 2009 and 2013 list any authors. Mr. Marston’s Declaration is also objected to because it relies on (1) inauthentic documents under FRE 901 (discussed below); (2) incomplete documents under FRE 106 (also discussed below); and (3) because the Declaration is itself incomplete under FRE 106. Mr. Marston relies on cherry-picked documents from a year long span but fails to provide the full context for his alleged inventive activity.

Petitioner objects to Paragraphs 3-14 for lack of corroboration of the testimony and documents cited in them. Mr. Marston relies on these paragraphs to show conception of “a system with relevance model that includes all features of the claims,” of the ’217 patent. EX2003, ¶14. Mr. Marston makes comments that these documents were the work of him and Paul Marston, and that they reflect the refinement of the claimed relevance model. However, the documents fail to confirm the facts in Mr. Marston’s declaration. Mr. Marston provides no independent testimony or evidence that these documents disclose “a system with relevance model that includes all features of the claims.” These paragraphs are objected to under FRE 802, 401-403, and 901 for the same reasons.

Petitioner objects to Paragraphs 15-18 for lack of foundation. Mr. Marston opined on what was known in the art by 2004 but failed to provide any support for said statements. There is no testimony or evidence presented that would support Mr. Marston having the prerequisite knowledge or experience to support.

Petitioner objects to Paragraphs 4, 10-11 as hearsay under FRE 801(c) and 802. Patent Owner appears to be attempting to rely on the documents referenced in these paragraphs for the truth of the matter asserted within them.

Due to these deficiencies, Patent Owner has failed to establish that these paragraphs are relevant under FRE 401, and therefore these paragraphs are inadmissible under FRE 402 and should be excluded.

IV. Exhibits 2004 - 2014

Petitioner objects to Exhibits 2004 – 2014 for lack of authentication under FRE 901. As stated above in relation to Exhibit 2003, there is no evidence or testimony presented that Exhibits 2004 – 2014 are what Patent Owner claims they are, or who wrote them, aside from the testimony of a biased inventor, Mr. Marston.

For example, with reference to EX2004, Mr. Marston claims that Paul Marston and himself “prepared the Initial Document in August and September 2004.” EX2003, ¶9. However, the metadata for EX2004 (as shown in the native version of the file) shows that a user named “.” is the “author” and that user named “Bal” last edited the file. There is no indication within EX2004 or its metadata that the file was created or edited by Mr. Marston or Paul Marston. Exhibits 2005 – 2014 are objected to for the same reason. These documents are objected to under 401-403 for the same reasons: and at least because they lack any foundation or connection to the issues of the case.

Exhibits 2004 – 2014 are also not the documents that Patent Owner claim them to be. *See* FRE 901. As an example, the native version of EX2010 includes comments and redlines that were not submitted into evidence with EX2010. Therefore, EX2010 is simply not the same document as the native version of EX2010. Likewise, the metadata slips attached to each of Exhibits 2004 – 2014 omit important information from the true metadata records. Accordingly, Exhibits 2004

– 2014 are not the documents Patent Owner proports them to be. For the same reasons, Exhibits 2004 – 2014 are also inadmissible under FRE 106 for lack of completeness.

Petitioner objects to Exhibits 2004 – 2014 as hearsay under FRE 801(c) and 802. Patent Owner appears to be attempting to rely on the documents for the truth of the matter asserted within them.

Petitioner also objects to Exhibits 2004 – 2014 based on 37 C.F.R. § 42.6(a)(3), FRE 401 and 402. Each of Exhibits 2004 – 2014 is improperly incorporated by reference into Patent Owner’s Preliminary Response (POPR). Accordingly, these exhibits are not relied upon for any proper purpose and are irrelevant.

V. Exhibit 2014

Petitioner additionally objects to Exhibit 2014 as lacking authentication or any indication of providence. Exhibit 2014 appears to be a claim chart comparing the Challenged Claims with “EX2004 & EX2006.” However, there is no indication who created Exhibit 2014 or for what purpose. Exhibit 2014 is not cited in either of the declarations Patent Owner’s submitted with its POPR. See EX2001 and EX2003.

To the extent Exhibit 2014 is merely attorney argument, then it is not evidence, and should be excluded as improper incorporation by reference. See 37 C.F.R. § 42.6(a)(3) and FRE 901.

Petitioner also objects to Exhibit 2014 for the same reasons as above because it incorporates citations to other exhibits within it. For example, as explained above, Exhibits 2004 – 2013 are inauthentic and, therefore, Exhibit 2014 is infected by the same issue.

Petitioner also objects to Exhibit under FRE 802 to the extent it is relied on for the truth of the matters asserted therein, FRE 403 as unduly prejudicial, FRE 702/703 as presenting unsown and unsupported expert testimony, and FRE 401-403 as lacking foundation.

Dated: June 25, 2025

Respectfully Submitted,

/s/David Okano

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §42.6(e), I hereby certify that on this 25th day of June, 2025, I caused to be served a true and correct copy of the foregoing by e-mail on the following counsel:

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