

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 2032 – 2039 and 2041 – 2083, paragraphs 1-3, and 5-61 of the Declaration of Justin Marston (EX2030), paragraphs 7, 10, and 12-40 of the Declaration of Paul Marston (EX2031) and paragraphs 28-31, 33, 35, 38-49, 144, and 207-228 of the Declaration of Dr. Latifur Khan (EX2029).

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 2029 (Declaration of Dr. Latifur Khan)

Petitioner objects to Paragraphs 28-31, 33, 35, 38-49, 144, and 207-228 of EX2029, 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 and should be excluded.

Petitioner also objects to Exhibit 2029 to the extent it relies on other inadmissible exhibits and testimony (as discussed below). Exhibit 2029 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 2030 (Supplemental Declaration of Justin Marston)

Petitioner objects to Paragraphs 1, 3, 5, 6, 13, 27, 37, 38, 46, 57, 60 and 61 of EX2030 because they incorporate or refer to Mr. J. Marston's initial declaration (EX2003). Petitioner already provided objections to EX2003 and objects to the above paragraphs for the same reason. *See* Paper 15.

Petitioner objects to Paragraphs 6-12, 14-19, 21-45, 47-55, 58, 59 and 61 for lack of authentication under FRE 901. Mr. J. Marston relies on these paragraphs to allege that he and Paul Marston “worked reasonably continuously, within the confines of [their] occupations, to diligently finalize the inventions,” but fails to provide any citations sufficient to support Mr. J. Marston's claims. EX2030, ¶6. Patent Owner has not proffered 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. J. Marson claims to be true in his declaration. As an example, the metadata slips provided for the exhibits referenced in Paragraphs 21-23, 26, 39-45, and 61 are incomplete. For instance, EX2032's metadata slip lists the author as "." rather than an individual's name (as alleged in Paragraph 23). Furthermore, Paragraphs 10, 19, 25, 29-32, 36, 49, 50, and 53-55 cite exhibits that lack metadata slips altogether. For example, the log of BlueSpace documents from June 28, 2005 until January 13, 2006 (EX2041) cited in Paragraphs 10, 19, 25, 36, 49, and 53 does not include metadata, or tie the documents described within the log to specific exhibits.

Petitioner also objects to Paragraphs 10, 19, 25, 36, 49, and 53 because they cite to EX2041 (log) and rely on the underlying documents referenced in EX2041 but Patent Owner did not submit the underlying documents. Such reliance is improper under 37 C.F.R. § 42.51. Petitioner also objects to Paragraphs 19, 36, 49, 50, and 53-55 for the same reason because they cite to EX2042 (priv log) without including the underlying documents. Sterling cannot use privilege as a sword and a shield—arguing documents are privileged to prevent their disclosure but also relying on said documents in an attempt to prove an earlier date of invention. *GEA Process Engineering, Inc. v. Steuben Foods, Inc.*, IPR2014-00055, Paper 43 (July 21, 2014, PTAB).

Petitioner objects to Paragraphs 6-9, 11-12, 16-18, 24, 33-35, 47, 48, 51, 52, 58, 59, and 61, 62 for lack of foundation because Mr. J. Marston fails to provide any citations to evidence or the record tending to show his statements are true. Again, these paragraphs are used to allege that Justin Marston and Paul Marston worked “reasonably continuously” to finalize the invention. EX2030, ¶6. For instance, Mr. J. Marston claimed that he worked on tasks for the claimed invention for approximately 55 hours from August 17 to October 6 without providing independent evidence or testimony. EX2030, ¶34. Petitioner also objects to Paragraphs 58, 59, and 62 since Mr. J. Martson claimed that Tony Morton-Jones, Rick Turner, and Tim Couper only provided comments to technical documents and no inventive contributions without offering independent evidence or testimony. Mr. Morton-Jones, Mr. Turner, and Mr. Couper are listed as the author and individual who last saved the document in the exhibits’ metadata (EX2047, EX2048, and EX2050) that are referenced in Paragraphs 58, 59, and 62. Therefore, Mr. J. Marston’s Declaration lacks foundation because it directly contradicts the physical evidence.

Mr. J. Marston’s Declaration is also objected to because it relies on (1) inauthentic documents under FRE 901 (discussed in Section V); and (2) incomplete documents under FRE 106 (also discussed in Section V).

Petitioner also objects to Paragraph 10-12, 18, 19, 24, 25, 35, 36, 48, 49, and 51-53 as irrelevant under FRE 401.

Petitioner also objects to Paragraphs 5-8, 10, 19, 25, 29, 31, 32, 36, 49, 53, 55, 56, 58, 59, and 61-63 as including impermissible hearsay under FRE 801(c) and 802. For example, Mr. J. Marston states that EX2047 was “Last Saved by” Tony Morton-Jones “because Paul Marston asked his friend, Tony Morton-Jones, to review the formulas that Paul Marston had prepared.” EX2030, ¶58. However, Mr. J. Marston is merely conveying second-hand information. He does not claim to have any personal knowledge of Mr. Tony Morton-Jones’ involvement or contribution, apart from this second-hand knowledge. Petitioner objects to Paragraphs 1, 2, 5-7, 10, 13-15, 19-23, 25-32, 34, 36-47, 49, 50, 53-56, and 58-63 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.

Petitioner also objects to Paragraphs 32, 58, 59, and 62 as lacking foundation and being unduly prejudicial. In each paragraph Mr. J. Marston states in a summary fashion that various individuals (including Rick Turner, Tony Morton-Jones, John Fernyhough, and Tim Couper) “did not contribute in any way to this document or to the inventions” but fails to state what these individuals’ roles were.

Petitioner also objects to Paragraph 2 of EX2030 because it improperly cites to an exhibit that has been expunged (EX2015). EX2015 was improperly submitted and Patent Owner agreed to expunge it, yet now cites to this exhibit. EX2015 is not part of the record.

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. Exhibit 2031 (Declaration of Paul Marston)

Petitioner objects to Paragraphs 14-18, 19, and 24-26 for lack of corroboration of the testimony and documents cited in them. For instance, in Paragraphs 14-18 Mr. P. Marston alleges that “from May 2005 until the provisional patent application was filed on January 13, 2006, Justin Marston and [Paul Marston] worked reasonably continuously,” to finalize the inventions for the provisional patent application. EX2031, ¶14. Mr. P. Marston makes these comments without providing independent testimony or evidence to show “regular correspondence regarding the draft patent application with Justin Marston” over the time in question. EX2031, ¶17. Petitioner also objects to Paragraphs 19 and 24-26 since Mr. P. Martson claimed that Tony Morton-Jones and Jon Fernyough only provided comments and no inventive contributions without offering independent evidence or testimony. Mr. Morton-Jones and Mr. Fernyough are listed as the author and individual who last saved the document in the exhibits’ metadata that are referenced in Paragraphs 19 and 24-26. These paragraphs are objected to under FRE 802, 401-403, and 901 for the same reasons.

Petitioner objects to Paragraphs 27-30, 33-37, and 40 for lack of authentication under FRE 901. Mr. P. Marston relies on these paragraphs to allege that he and Justin Marston “worked reasonably continuously” to finalize the invention. EX2031, ¶14. Mr. P. Marston makes comments that these documents were the work of him and Justin Marston, and that they reflect the refinement of the claimed relevance model. Patent Owner has 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. P. Marston claims to be true in his declaration. For instance, Paragraphs 33-37 reference Exhibits 2065 – 2069 and the metadata slip lists the author as “.” instead of an individual’s name. Similar deficiencies were found in the Exhibits referenced in Paragraphs 27-30 and 40. Mr. P. Marston’s Declaration is also objected to because it relies on (1) inauthentic documents under FRE 901 (discussed in Section V); and (2) incomplete documents under FRE 106 (also discussed in Section V).

Petitioner also objects to Paragraphs 19, 24-26, 31, and 38-39 as lacking foundation and being unduly prejudicial. In each paragraph Mr. P. Marston states in a summary fashion that various individuals (including Tony Morton-Jones and Jon Fernyhough) did not contribute to the inventions but fails to state what these individuals’ roles were.

Paragraphs 19, 24-26, 31, and 38-39 also are objected to as containing hearsay under FRE 801(c) and 802. For example, in Paragraph 25 Mr. P. Marston states that “My understanding of why Jon is listed as the Author is because Justin asked Jon to cut and paste the draft section into a Word document for my review.” Mr. P. Marston is merely repeating secondhand information from 20 years ago with no support and relying on it for the truth of the matter asserted. This is classic hearsay. Petitioner objects to Paragraphs 7, 10, 12, 13, 15 and 19-40 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.

V. Exhibits 2032-2039, 2041-2078¹

Petitioner objects to Exhibits 2032 – 2039, 2041 – 2078 for lack of authentication under FRE 901. As stated above in relation to Exhibits 2030 and 2031, there is no evidence or testimony presented that identified exhibits are what Patent Owner claims they are, or who wrote them, aside from the testimony of the biased inventors, Justin Marston and Paul Marston. This is in addition to that many

¹ EX2040 was intentionally omitted by Patent Owner.

of Exhibits 2032 – 2039, 2041 – 2078 contradict the testimony of Justin Marston and Paul Marston.

For example, with reference to EX2032, Mr. J. Marston claims that Paul Marston and himself “prepared another draft of the patent application” by September 21, 2005. EX2030, ¶23. For EX2032, Mr. J. Marston claimed that the “initials “JM” in this File Name refer to revisions” made by himself. *Id.* But the metadata slip for EX2032 shows that “.” is the “author” and no user was shown to last edit the file. There is no indication within EX2032 or its metadata slip that the file was created or edited by Justin Marston or Paul Marston. Furthermore, Exhibits 2041 – 2046 refer to document logs, documents with tracked changes, and correspondence that lack metadata slips altogether. Exhibits 2032 – 2039, 2041 – 2078 are objected to for the same or similar reasons.

Exhibits 2032 – 2039, 2041 – 2078 are objected to under FRE 401-403 for the same reasons: and at least because they lack any foundation or connection to the issues of the case.

Exhibits 2032 – 2039, 2041 – 2078 are also not the documents that Patent Owner claim them to be. *See* FRE 901. As an example, EX2059 includes comments and redlines from only users “JM” or “Marston” but also has comments from additional user “JPM” who was not discussed in Mr. P. Marston’s declaration. EX2059, 23; EX2031, ¶27. Likewise, the metadata slips attached to each of Exhibits

2032 – 2039, 2041 – 2078 omit important information from the true metadata records. *See e.g.*, EX2045. For the same reasons, Exhibits 2032 – 2039, 2041 – 2078 are also inadmissible under FRE 106 for lack of completeness.

Petitioner objects to Exhibits 2032 – 2039, 2041 – 2078 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 Patent Owner’s reliance of Exhibits 2032 – 2039, 2041 – 2078 as improper incorporation by reference based on 37 C.F.R. § 42.6(a)(3), FRE 401 and 402. For these exhibits Patent Owner simply bulks cites them with no analysis or discussion. For example, Patent Owner’s analysis of these exhibits in its reply consists of statements such as: “EX2032 through EX2078 (corroborating documentation).” Paper 17, 6. Accordingly, these exhibits are not relied upon for any proper purpose and are irrelevant.

VI. Exhibits 2042, 2046

Exhibit 2042 purports to be a “Log of J. Marston privileged communications with BlueSpace counsel regarding BlueSpace work from June 28, 2005, until January 13, 2006.” However, Patent Owner is relying on these documents to show diligence “relating to TransMail” and “regarding BlueSpace matters.” For example, Mr. J. Marston states that these communications “show that I worked on BlueSpace documents” during critical periods. EX2030, ¶¶19, 36, 49. Patent Owner cannot rely

on privilege to shield these documents from view while at the same time using them to prove its claims. For example, as of right now there is no evidence that any of the communications listed in EX2042 even relate to the alleged inventions, instead of other unrelated issues. As some examples, the log lists communications which includes subject lines relating to unrelated Canadian and U.S. Patents which appear to have their date redacted. The log also includes a subject email relating to “Tamper Proofing GOS 839” (September 29, 2005), which appears to have no relation to the alleged invention. EX2042, 2. Mr. Marson relies on these entries to testify that he, for example, “exchanged correspondence with counsel for BlueSpace regarding BlueSpace matters on September 19, 26, 28, and 29.” EX2030, ¶36. Therefore, Patent Owner (1) improperly redacts information that is not privileged (such as the date of communications); (2) relies on the privileged communications to establish diligence, and (3) has not included any information in the log that would substantiate its arguments or privilege claims.²

As another example, Mr. J. Marston relies on this log to claim he sent his Patent Attorney “a draft of the provisional patent application” on January 11, 2006. EX2030, ¶¶50, 53. While the log does include an entry on January 11, without being able to inspect the underlying documents and communications there is no way for

² EX2042 also appears to include communications between non-lawyers without any explanation for Patent Owner’s basis to assert privilege.

Petitioner or the Board to confirm that this communication did in fact relate to the alleged inventions. As Patent Owner is relying on these document to prove its claims, it has waived privilege. It is well established that selective waiver of privilege may lead to the inequitable result that the waiving party could waive its privilege for favorable advice while asserting its privilege on unfavorable advice. In these circumstances the Federal Circuit has recognized that when a party defends its actions by disclosing an attorney-client communication, it waives the attorney-client privilege as to all such communications regarding the same subject matter. *Fort James Corp. v. Solo Cup Co.*, 412 F.3d 1340, 1349 (Fed. Cir. 2005) (“The waiver extends beyond the document initially produced out of concern for fairness, so that a party is prevented from disclosing communications that support its position while simultaneously concealing communications that do not.”)

Exhibit 2046 purports to be an email between Brian Hoffman and Justin Marston. Mr. J. Marston relies on a heavily redacted version of this exhibit to claim that Jon Fernyhough is not an inventor. But Patent Owner’s selective wavier on one sentence of this email is improper. It is unclear what this email relates to, and Petitioner is entitled to understand the full context. Patent Owner cannot choose to waive only the one sentence that supports their positions and omit the rest. *Fort James Corp.*, 412 F.3d at 1349 (Finding reversible error where District Court limited wavier too narrowly to cover only the two sentences expressly released); *Willis*

Electric Co., Ltd. v. Polygroup Macao Limited, 2020 WL 1934425, *1-*4 (D. Minn. 2020).

VII. Exhibits 2079 - 2083

Petitioner objects to Exhibits 2079 – 2083 as hearsay under FRE 801(c) and 802. Exhibits 2079 – 2083 are webpages allegedly describing Petitioner’s product X (f/k/a Twitter) and Meta’s Facebook product. However, these exhibits are irrelevant under FRE 401 and 402, at least because they do not tend to support any claims or defenses and are unduly prejudicial. Petitioner also objects to these Exhibits under FRE 901 as lacking any authenticity. They also represent improper expert opinion under FRE 702. Each Exhibit is also objected to for lacking foundation.

VIII. Expunged Exhibits 2015-2028

Petitioner objects to Exhibits 2015 – 2028 since they were previously expunged from the docket but are now referenced in the Exhibit List of Patent Owner’s Response. Paper 17, vi-vii (see screenshots below for IPR2025-00299 docket from the PTAB website and Paper 17 Patent Owner’s Response Exhibit List). The expunged Exhibits are also referenced in newly submitted exhibits. For instance, EX2030 incorporated by reference EX2015. EX2030, ¶2. Petitioner objects to reference to any of the expunged Exhibits 2015 – 2028 in the Patent Owner Response and other Exhibits.



55	Exhibit 2031	Exhibit	2031	09/10/2025	Patent Owner	Public
56	Exhibit 2030	Exhibit	2030	09/10/2025	Patent Owner	Public
57	Exhibit 2029	Exhibit	2029	09/10/2025	Patent Owner	Public
58	EXPUNGED	Exhibit	2028	07/09/2025	Patent Owner	EXPUNGED-Public
59	EXPUNGED	Exhibit	2027	07/09/2025	Patent Owner	EXPUNGED-Public
60	EXPUNGED	Exhibit	2026	07/09/2025	Patent Owner	EXPUNGED-Public
61	EXPUNGED	Exhibit	2025	07/09/2025	Patent Owner	EXPUNGED-Public
62	EXPUNGED	Exhibit	2024	07/09/2025	Patent Owner	EXPUNGED-Public
63	EXPUNGED	Exhibit	2023	07/09/2025	Patent Owner	EXPUNGED-Public
64	EXPUNGED	Exhibit	2022	07/09/2025	Patent Owner	EXPUNGED-Public
65	EXPUNGED	Exhibit	2021	07/09/2025	Patent Owner	EXPUNGED-Public
66	EXPUNGED	Exhibit	2020	07/09/2025	Patent Owner	EXPUNGED-Public
67	EXPUNGED	Exhibit	2019	07/09/2025	Patent Owner	EXPUNGED-Public
68	EXPUNGED	Exhibit	2018	07/09/2025	Patent Owner	EXPUNGED-Public
69	EXPUNGED	Exhibit	2017	07/09/2025	Patent Owner	EXPUNGED-Public
70	EXPUNGED	Exhibit	2016	07/09/2025	Patent Owner	EXPUNGED-Public
71	EXPUNGED	Exhibit	2015	07/09/2025	Patent Owner	EXPUNGED-Public
72	Exhibit 2014	Exhibit	2014	03/12/2025	Patent Owner	Public

2015	Supplemental Declaration of Justin Marston (July 8, 2025)
2016	<i>listing of NATURE article:</i> Marston, Justin, "Chaos in the Classroom," Jan. 25, 1996, NATURE, <i>available at</i> https://www.nature.com/articles/379306b0

vi

Patent Owner's Response

Patent Owner's Exhibit No.	Exhibit Description
2017	<i>excerpt from:</i> 32nd European Union Contest for Young Scientists (2020-2021) ("Winners 1989-2019")
2018	LinkedIn profile: Justin Marston
2019	Metadata extracted from native of EX2004
2020	Metadata extracted from native of EX2005
2021	Metadata extracted from native of EX2006
2022	Metadata extracted from native of EX2007
2023	Metadata extracted from native of EX2008
2024	Metadata extracted from native of EX2009
2025	Metadata extracted from native of EX2010
2026	Metadata extracted from native of EX2011
2027	Metadata extracted from native of EX2012
2028	Metadata extracted from native of EX2013

Dated: September 17, 2025

Respectfully Submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §42.6(e), I hereby certify that on this 17th day of September, 2025, I caused to be served a true and correct copy of the foregoing and any accompanying exhibits by express mail on the following counsel:

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