

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

X CORP.

Petitioner,

v.

STERLING COMPUTERS CORPORATION

Patent Owner.

Case IPR2025-00299

U.S. Patent No. 7,716,217

**PATENT OWNER'S OPPOSITION TO PETITIONER'S REQUEST FOR
ADDITIONAL AND ROUTINE DISCOVERY**

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EXHIBIT LIST

Patent Owner's Exhibit No.	Exhibit Description
2001	Declaration of Latifur Khan (March 12, 2025)
2002	Curriculum vitae of Latifur Khan
2003	Declaration of Justin Marston (March 12, 2025)
2004	"BlueSpace Mail Search" Document, Sept. 2, 2004
2005	"The Development of the Mathematical Algorithms," May 12, 2005
2006	"BlueSpace Mail Relevance," June 7, 2005
2007	"BlueSpace Mail Relevance," Aug. 16, 2005
2008	"BlueSpace Mail Relevance," Aug. 17, 2005
2009	"Importance," Sept. 18, 2005
2010	"BlueSpace Mail Relevance," Oct. 6, 2005
2011	"BlueSpace Mail Relevance," Oct. 7, 2005
2012	"BlueSpace Mail Relevance," Oct. 7, 2005
2013	"There are many cognate relevance values that must be calculated," Nov. 9, 2004
2014	Claim Chart for BlueSpace Mail Documents
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

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
2029	Declaration of Latifur Khan (September 10, 2025)
2030	Declaration of Justin Marston (September 9, 2025)
2031	Declaration of Paul Marston (September 9, 2025)
2032	"BlueSpace Mail Relevance," September 21, 2005
2033	"BlueSpace Mail Relevance," October 2, 2005
2034	"BlueSpace Mail Relevance," November 8, 2005
2035	"BlueSpace Mail Relevance," November 12, 2005
2036	"BlueSpace Mail Relevance," November 13, 2005

Patent Owner's Exhibit No.	Exhibit Description
2037	"Frequency analysis stats," August 21, 2005
2038	"Relevance typology 2.bmp," November 13, 2005
2039	"Relevance process flow 2.bmp," November 13, 2005
2040	<i>intentionally omitted (duplicate)</i>
2041	Log of BlueSpace documents showing BlueSpace work from June 28, 2005, until January 13, 2006
2042	Log of J. Marston privileged communications with BlueSpace counsel regarding BlueSpace work from June 28, 2005, until January 13, 2006
2043	Version of EX2010/EX1044 showing tracked changes and comments by Justin Marston
2044	Version of EX2010/EX1044 showing tracked changes and comments by Paul Marston
2045	Version of EX2010/EX1044 showing tracked changes and comments by Jon Fernyhough
2046	Redacted (for privilege) correspondence from J. Marston to B. Hoffman, January 12, 2006
2047	"Transmail Relevance Formulae," September 9, 2004
2048	"Notes on Search Document," September 13, 2004
2049	"Pauls Formula Section Sept 17.doc," September 20, 2004
2050	"General Comments," May 17, 2005
2051	"Some Thoughts on the TransMail Relevance/Importance Algorithm," May 17, 2005

Patent Owner's Opposition to Petitioner's Request for Additional and Routine Discovery

Patent Owner's Exhibit No.	Exhibit Description
2052	"2004-09-10 notes on search document.doc," September 10, 2004
2053	"Changes to document_.doc," September 15, 2004
2054	"BlueSpaceMailSearchfor JamesB.doc," September 15, 2004
2055	"Importance 1.1.1.doc," September 18, 2004
2056	"formula.doc," August 17, 2005
2057	"SoftwareImplementation.doc," August 18, 2005
2058	"SoftwareImplementationComment.doc," August 19, 2005
2059	"BlueSpaceRelevancePM250805.doc," August 25, 2005
2060	"BlueSpaceMailRelevancePM250905.doc," September 25, 2005
2061	"BlueSpaceMailRelevancePM270905c.doc," September 28, 2005
2062	"BlueSpaceMailRelevancePM280905.doc," September 28, 2005
2063	"Comments to Jon and Justin 07.doc," October 8, 2005
2064	"Alterations to document.doc," October 8, 2005
2065	"BSMR021005_jfpm2.doc," October 13, 2005
2066	"BSMR021005_jfpm3.doc," October 13, 2005
2067	"BSMR021005_jfpm4.doc," October 13, 2005
2068	"BSMR021005_jfpm5.doc," October 13, 2005

Patent Owner's Exhibit No.	Exhibit Description
2069	"BSMR021005_jfpm6.doc," October 14, 2005
2070	"Jon & Juistin 14.10.05.doc," October 14, 2005
2071	"Comments to Justin and Jon Oct 15th.doc," October 15, 2005
2072	"BlueSpaceMailRelevanceJM06,11,05.doc," November 10, 2005
2073	"BlueSpace Mail Relevance," August 21, 2005
2074	"BlueSpace Mail Relevance," November 12, 2005
2075	Paul Marston LinkedIn Profile
2076	Paul Marston employment history (1968-2024) (from teachers' pensions employment history)
2077	Article: "Farewell after almost 50 years: Paul Marston, Senior Lecturer in Mathematics."
2078	Letter appointing P. Marston as lecturer at Nazarene Theological College, July 25, 2005
2079	"Twitter's Recommendation Algorithm," X Blog, March 31, 2023
2080	"Twitter Revenue and Usage Statistics (2025)," Business of Apps, Sept. 2, 2025
2081	"Twitter Is Changing Your Timeline: What You Need to Know," ABC News, Feb. 10, 2016
2082	"News Feeds, Old Content: A Brief History of Algorithmically Curated Feeds on Facebook and Twitter," Medium, April 29, 2019

Patent Owner's Exhibit No.	Exhibit Description
2083	"You Can Finally Switch Your Instagram Feed to a Chronological Timeline. Here's How," Business Insider, Mar. 24, 2022
2084	Complaint, <i>Sterling v. X Corp.</i> , Case No. 1:24-cv-00552 (W.D. Texas)
2085	Complaint, <i>Sterling v. Meta</i> , Case No. 1:24-cv-00551 (W.D. Texas)

I. Petitioner's Request Should Be Denied Because There Has Been No Waiver.

The Board should deny Petitioner's request for Mr. Marston's privileged communications with counsel because he did not rely upon the substance of any document on the privilege log (EX2042) or any unredacted statement in EX2046.

A. Documents Listed in the Privilege Log (EX2042)

Petitioner seeks production of 77 attorney-client privileged documents set forth in the privilege log (EX2042). The log was provided, along with testimony and other documents, in response to the Board's invitation that Patent Owner submit evidence of diligence. Decision (Paper 13), at 33 ("Patent Owner has the opportunity to introduce additional relevant evidence and to explain why the evidence ... shows reasonable diligence."). The law is clear that providing a privilege log does not result in waiver. *E.g., Opensky Industries, LLC v. VLSI Technology LLC*, No. IPR2021-01064, 2022 WL 4963049, at *7 (P.T.A.B. Oct. 4, 2022) ("avoiding [privilege] waiver is the point of a privilege log"). Instead, not providing a log may result in waiver. Fed. R. Civ. P. 45(d) advisory committee's note to 1991 amendment. Thus, Petitioner admits (as it must) that providing a privilege log did not result in waiver.

Instead, Petitioner asserts that Mr. Marston's testimony about the "underlying documents" on the log waived privilege. As the Board has explained, the question is whether Mr. Marston's testimony "relie[d] on the particular substance" of the logged documents. EX1048. Here, Mr. Marston did not. *E.g., EX1049*, 210:18-21. Instead,

he relied upon the **fact** that he “exchanged correspondence with counsel for BlueSpace regarding BlueSpace matters” on specific dates. He did not need to rely upon the substance of the logged documents to make those statements, because those facts are apparent from (1) the metadata and (2) the fact that all of the emails came from Fenwick's BlueSpace files. Mr. Marston's factual testimony did not waive privilege. *E.g., Oakley, Inc. v. Bugaboos Eyewear Corp.*, No. 09-CV-2037-JLS JMA, 2010 WL 4117223, at *4 (S.D. Cal. Oct. 15, 2010) (finding no waiver of AC privilege where plaintiff “did not divulge any legal advice in the privilege log”).

Petitioner asserts that Mr. Marston relied upon the logged documents because he testified that “[e]verything [he] read informed the testimony in [his] declaration.” Mt. at 2. That generalized testimony does not show, however, that Mr. Marston's declaration relied upon “the particular substance” of any logged document.

Petitioner cites only two cases in support of this allegation of waiver, and both are inapposite. The *GEA* case related to waiver of a document covered by the work product doctrine. *GEA Process Engineering, Inc. v. Steuben Foods, Inc.*, IPR2014-00055, Paper 43, at 2 (July 21, 2014, PTAB). In contrast, here, all of the communications at issue here are attorney-client communications. Although Petitioner insists that the distinction is unimportant (Mt. at 3), Petitioner ignores that “[t]he attorney-client privilege and the work product doctrine ... are subject to different analyses when considering the propriety of a finding of waiver.” *Chimie v.*

PPG Indus., Inc., 218 F.R.D. 416, 421 (D. Del. 2003). For example, work product that does **not** involve an attorney's mental process (e.g., the draft declaration in *GEA*) is subject to discovery solely upon a showing of "substantial need" and "undue hardship." Fed. R. Civ. P. 26(b)(3). That is **not**, however, the standard for attorney-client communications. Moreover, *GEA* presented unique circumstances that are not present here: patent owner's declarant had signed the draft declaration and authorized it for filing, but, instead of filing that declaration, patent owner filed five different declarations under his name that the deponent had never seen. Because of these unique circumstances and because the case did not involve waiver of the attorney-client privilege, the case is not relevant to the present dispute.

The other case that Petitioner relies upon is distinguishable both because the party had (1) waived privilege by disclosing counsel's "opinion" and (2) relied upon the particular substance of the withheld document to establish an earlier invention date.¹ *Willis Elec. Co. v. Polygroup Macao Ltd.*, 2020 WL 1934425, at *2 (D. Minn. Apr. 22, 2020). In contrast, here, Mr. Marston did not rely upon (1) any opinion of counsel or (2) "the particular substance" of any logged document.

Petitioner has failed to cite to any authority supporting a finding of waiver in these circumstances. And there is none. Patent Owner has located no authority in

¹ Petitioner asserts that Mr. Marston relied upon correspondence with its attorney "to claim an earlier conception date." Mt. at 4. That is false. The documents and testimony relied upon for the earlier conception date were produced in their entirety. EX2003, EX2004, EX2006.

which a court or the Board found that privilege was waived (1) based upon providing a privilege log; or (2) based upon statements of fact about communications with counsel. Privilege over the logged communications has not been waived.

B. EX2046

There also is no waiver with respect to EX2046. The relevant question is whether Mr. Marston “relie[d] on the particular substance of evidence **that has been redacted.**” EX1048 (emphasis added). He did not. To the contrary, the only “substance” he relied upon was an unredacted factual statement that “Jon Fernyhough helped out a bit with the thinking in the computing side, but none of his ideas actually ended up in the patent.” EX2046. Although Petitioner asserts that Mr. Marston also relied upon the redacted portions,² Mr. Marston testified that he had no recollection of what was in the unredacted portions.³ Tr., at 251:6-16.

The only statement left unredacted in that document is a factual statement. Facts are not privileged. *See, e.g., Oxygenator Water Techs., Inc. v. Tennant Co.*, No. 20-CV-358 (KMM/DTS), 2023 WL 11959150, at *8 (D. Minn. July 25, 2023) (finding no error in determination that “documents were not privileged because the redacted portion of these documents strictly communicate factual updates”);

² Petitioner also claims that Mr. Marston’s speculation that the redacted portions of EX2042 were “benign” demonstrates that the withheld information is “not privileged.” Mt. at 4-5. This is absurd: “benign” is not a synonym for “not privileged.”

³ Petitioner asserts that Sterling failed to preserve its privilege by failing to object during the deposition (Mt. at 2), but Mr. Marston did not recall what was in the unredacted portions. Tr., at 251:6-16. Therefore, he could not have revealed any privileged communication.

Shire Dev. Inc. v. Cadila Healthcare Ltd., No. CA 10-581-KAJ, 2012 WL 5247315, at *4 (D. Del. June 15, 2012) (“[P]urely factual information is not privileged.”).

Therefore, Mr. Marston did not waive privilege by revealing this factual statement.

II. Petitioner's Request Should Be Denied Because It Is Not Part of Routine Discovery and the Additional Discovery Is Not “in the Interests of Justice.”

The rules do not entitle Petitioner to the discovery it seeks because the discovery sought is neither (1) routine nor (2) “in the interests of justice.” The discovery is not “routine” because neither the unredacted portions of EX2046 nor the underlying documents on the privilege log were “cited ... in [Mr. Marston's] testimony.” 37 C.F.R. § 42.51. Moreover, the documents also are not subject to “additional discovery” because production would not be “in the interests of justice.”⁴ Ordering Patent Owner to produce these privileged communications here would be **contrary** to “the interests of justice” because it would require Mr. Marston to provide privileged communications with his counsel where no waiver has taken place. To find privilege waiver in the circumstances of this case would be to turn the law of privilege on its head. The finding would have devastating consequences on parties' willingness to provide privilege logs and factual information in discovery.

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

⁴ Petitioner previously claimed that it needed the underlying documents to determine whether “whether any of the documents referenced in the privilege log even relate to the claimed invention, BlueSpace, or TransMail.” EX1048, at 3. Petitioner, however, no longer makes that argument here, because Mr. Marston was able to provide that information during his deposition based upon the privilege log descriptions alone. EX1049, at 216:2-229:21.

Respectfully submitted,

Dated: November 20, 2025

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. 42.6(e), I certify that on this 20th day of November, 2025, a true and correct copy of the foregoing **Patent Owner's Opposition to Petitioner's Request for Additional and Routine Discovery** was served by electronic mail on Petitioner's lead and backup counsel at the following addresses:

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