

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
MOTION TO EXCLUDE EVIDENCE**

TABLE OF CONTENTS

I.	There Is No Basis for Excluding Dr. Khan’s Testimony.	1
A.	Dr. Khan Did Not Impose “Unrecited Claim Requirements.”	1
B.	Dr. Khan Applied the Teachings in the Prior Art.	3
C.	Dr. Khan Applied the Correct Standard for a Skilled Artisan.	3
II.	There Is No Basis for Excluding EX2014.	4
III.	There Is No Basis for Excluding Exhibit Nos. 2004 or 2006.	7
IV.	There Is No Basis for Excluding Any of the Marstons’ Testimony.	9
V.	Exhibit Nos. 2080-2083 Are Admissible.	12
VI.	Patent Owner Is Not Relying Upon the Substance of the Documents Logged in Exhibit 2042.	14
VII.	Exhibit Nos. 2032-2039 and 2041-2078 Are Not Improper Incorporation by Reference.	14

TABLE OF AUTHORITIES

<u>Cases</u>	<u>Page(s)</u>
<i>eSpeed, Inc. v. Brokertec USA, L.L.C.</i> , 404 F. Supp. 2d 575 (D. Del. 2005).....	6
<i>HTC Corp. v. Tech. Props.</i> , No. 5:08-cv-00882-PSG, 2013 U.S. Dist. LEXIS 129263, at *16 (N.D. Cal. Sep. 6, 2013).....	13
<i>Hynix Semiconductor Inc. v. Rambus Inc.</i> , No. C-00-20905 RMW, 2009 WL 112834, at *14 (N.D. Cal. Jan. 16, 2009).....	13
<i>KSR Int’l Co. v. Teleflex Inc.</i> , 550 U.S. 398 (2007).....	4
<i>Natera, Inc. v. NeoGenomics Lab’ys, Inc.</i> , 106 F.4th 1369 (Fed. Cir. 2024).....	1 & 3
<i>SEB S.A. v. Montgomery Ward & Co.</i> , 594 F.3d 1360 (Fed. Cir. 2010), <i>overruled on different grounds, Global-Tech Appliances, Inc. v.</i> <i>SEB S.A.</i> , 131 S. Ct. 2060 (U.S. 2011)	6
<i>Quanergy Sys., Inc. v. Velodyne Lidar, Inc.</i> , No. IPR2018-00255, 2019 WL 2237114 (P.T.A.B. May 23, 2019).....	12
<i>Unified Pats., LLC v. Flexiworld Techs., Inc.</i> , No. IPR2022-00775, 2023 WL 7198014 (P.T.A.B. Nov. 1, 2023).....	7
<i>United States v. Pulliam</i> , 973 F.3d 775 (7th Cir. 2020), <i>as amended</i> (Sept. 8, 2020).....	10
<i>United States v. Jackson</i> , 88 F.3d 845 (10th Cir. 1996).....	10
<u>Rules</u>	<u>Page(s)</u>
Fed. R. Evid. 801(a).....	10
Fed. R. Evid. 801(d)(2).....	13

<u>Rules (cont.)</u>	<u>Page(s)</u>
Fed. R. Evid. 803(6).....	9
Fed. R. Evid. 803(17).....	13
Fed. R. Evid. 902(6).....	12 n. 3
Fed. R. Evid. 1006.....	4-7

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
2017	<i>excerpt from:</i> 32nd European Union Contest for Young

Patent Owner's Opposition to Petitioner's Motion to Exclude Evidence

Patent Owner's Exhibit No.	Exhibit Description
	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 Opposition to Petitioner's Motion to Exclude Evidence

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
2052	"2004-09-10 notes on search document.doc," September 10,

Patent Owner's Opposition to Petitioner's Motion to Exclude Evidence

Patent Owner's Exhibit No.	Exhibit Description
	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
2069	"BSMR021005_jfpm6.doc," October 14, 2005

Patent Owner's Exhibit No.	Exhibit Description
2070	"Jon & Justin 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
2083	"You Can Finally Switch Your Instagram Feed to a Chronological Timeline. Here's How," Business Insider, Mar. 24, 2022

Patent Owner's Opposition to Petitioner's Motion to Exclude Evidence

Patent Owner's Exhibit No.	Exhibit Description
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)

For the reasons set forth below, Patent Owner respectfully requests the Board deny in its entirety Petitioner's motion to exclude.

I. There Is No Basis for Excluding Dr. Khan's Testimony.

A. Dr. Khan Did Not Impose "Unrecited Claim Requirements."

Citing cross-examination testimony, Petitioner asserts that Dr. Khan inserted a "quality" limitation into the claims. Paper 44, at 2.¹ Not true. Dr. Khan repeatedly testified he understood that the claims did not recite "quality." EX1050,173:10-175:2-24;*id.*,45:6-9. Moreover, he testified that a "quality" result means a that the content most relevant to the user will receive a high "ranking" or "*relevance score*" (EX1058,44:18-23 & 59:17-24), and "*relevance score*" **is** in the claims. Finally, "[u]nclaimed factors relevant to the feasibility of creating a useful claimed invention can impact the motivation to combine analysis if a skilled artisan would reasonably consider them." *Natera, Inc. v. NeoGenomics Lab'ys, Inc.*, 106 F.4th 1369, 1378 (Fed. Cir. 2024). Here, a POSA would consider whether Petitioner's alleged obviousness combinations would result in content that is actually relevant to the first user receiving a high "relevance score" (i.e., a "quality" result).

Petitioner argues that Dr. Khan improperly distinguished prior art based on "unrecited" limitations of local and global relevancy. Paper 44, at 2-3. Dr. Khan did not distinguish the prior art on those grounds (*see* EX2029), but even if he had, the

¹ Dr. Khan's direct (EX2029) did not use the word "quality" when discussing the '217 Patent claims and, therefore, the cross-examination on "quality" should be excluded. Paper 43, at 2-3.

claims recite that “*a second measure of relevance*” can be “*a local importance*” and a “*global importance*,” so those concepts are **not** “unrecited” claim limitations.

Petitioner asserts the claims do not recite “inter-person communications” or exclude “query modification” and, therefore, it was improper for Dr. Khan to state that Dumais is “primarily used for query modification,” whereas the ‘217 Patent is “focuse[d] on assigning a relevance score to inter-person communications.” Paper 44, at 3. However, the claims **do** address inter-person communications: every claim requires “*content sent from a sender to a user*” and “*a recipient*.” Moreover, the claims score **every piece** of content (Claim Nos. 1, 6, 7) and only claim “*search*” in the dependent claims (Claim Nos. 3, 14, 19). These distinctions are relevant because a POSITA would not be motivated to look to a reference that ranks only a subset of content to solve the problems that the ‘217 Patent set out to solve. EX2029, ¶207.

Citing Dr. Khan’s testimony about “three lists of attributes,” Petitioner argues that, when Dr. Khan contrasted the ‘217 Patent and Kircher, he imposed “unclaimed limitations.” Paper 44, at 3. But the claims **do** recite these “three lists of attributes”: the claims include (1) “mail actions relevance” (e.g., “*first measure of relevance*” based upon “**actions** of the user”); (2) “collaborative relevance” (e.g., “*second measure of relevance*” can be based on “actions” of other “**cognate**” “users”); and (3) “importance factors” (e.g., “*second measure of relevance*” can be based on “*local importance*” or “*global importance*”). Even if these factors were not in the claims,

it still would be proper to analyze the differences, because they are relevant to a skilled artisan's motivation. EX2029, ¶¶205-211; *Natera*, 106 F.4th at 1378.

B. Dr. Khan Applied the Teachings in the Prior Art.

Petitioner argues that Dr. Khan refused to acknowledge that “data items” in Dumais can include emails. Reply, 1-2. Not true. *See* EX2029, ¶98 (Dumais’ “data items ... include ... ‘email.’”); EX1058, 159:24-160:3 (agreeing with the statement in Dumais where it says that it can process data items such as e-mail messages); *id.* 160:16-21 (same); *id.* 161:14-16 (same). What Dr. Khan testified with respect to Dumais and e-mails was that (1) email was “not the main focus” of Dumais (*id.* 160:10-11); (2) Dumais’ “ranking is entirely different” from the ‘217 Patent (*id.* 161:6-9); and, (3) if Dumais were used to process e-mails, “the result may not be that high quality” – i.e., not as good as the ‘217 Patent in giving a high “ranking” or “*relevance score*” to the most relevant content (EX1058, 44:18-23 & 59:17-24) – because Dumais, unlike the ‘217 Patent, does not take into consideration “sender concepts, recipient concepts, and this importancy.” *Id.* 162:6-12. The statements are supported by the evidence and do not ignore any teaching in Dumais.

C. Dr. Khan Applied the Correct Standard for a Skilled Artisan.

Petitioner asserts that Dr. Khan applied the wrong POSITA standard because he testified that a POSITA “may not necessarily be creative.” Paper 44, at 5 (citing EX1058, 18:11-13). But he was speaking about his real-life experience with people

with that level of skill. EX1058, 18:2-9 (based upon his “over 25 years in academia,” not everyone with the same level of skill “will be able to do the same thing”).

Petitioner also complains about Dr. Khan's answer to the case-law-focused question of whether “a [POSA] can fit the multiple teachings of references together like pieces of a puzzle.” Paper 44, at 5; EX1058, 18:14-19:14. The actual quote from *KSR* is that “often,” or “in many cases a [POSA] will be able to fit the teachings of multiple patents together like pieces of a puzzle.” *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 402 & 420 (2007) (emphasis added). Because the question suggested that a POSITA can always do this, the line of questioning misstated the law, is irrelevant, and should be excluded. *See* Paper 43, at 1-2.

Dr. Khan applied the correct, “ordinary” skill standard. EX2029, ¶19.

II. There Is No Basis for Excluding EX2014.

Petitioner seeks to exclude Exhibit 2014, which is a chart prepared by counsel for Patent Owner. EX2014; EX1050, 11:21-13:1 (EX2014 was a document “that the attorneys prepared based on conversations with me and I’ve reviewed”). Exhibit 2014 summarizes Exhibit Nos. 2004 and 2006, which are drafts of the provisional patent application. Because the two exhibits together consist of nearly 100 pages of technical writing, EX2014 was provided to summarize the voluminous writings in a manner that will be more convenient for the Board. Therefore, it is a proper Rule 1006 compilation. Fed. R. Evid. 1006 (“The court may admit as evidence a summary

[or] chart... to prove the content of voluminous admissible writings...”).

Petitioner asserts that Patent Owner has had “shifting positions” regarding how EX2014 was prepared because, it asserts, Justin Marston claimed he “prepared [EX2014] with assistance ... from counsel,” but Patent Owner “claimed that Justin Marston only ‘helped prepare’” the exhibit. Paper 44, at 6 (citing Paper 38 at 21 & EX1050, 200:18-201:6). Those two statements are not contradictory: both statements reflect that preparing EX2014 was a joint effort between counsel and inventor Justin Marston. Justin Marston never testified that he **alone** prepared it.

Petitioner also complains about Patent Owner's statement that portions of Exhibit 2014 recite “Patent Owner's expert's opinions” because, Petitioner argues, Dr. Khan did not read EX2004 or EX2006. Paper 44, at 6 (citing Paper 38, at 21). But the portions of Exhibit 2014 that reflect Dr. Khan's opinions relate to Dr. Khan's opinion on **the ‘217 Patent claim language**, which Dr. Khan did review. *See* EX2029, ¶28. In particular, for each “*module*” limitation, the summary chart states that “[a] skilled artisan would understand that [the module] is software.” EX2014, at 2-4, 6, 9-10, 13-15, 17, 20, 31. Counsel for Patent Owner collected that portion of the chart from Dr. Khan's declaration. *See* EX2029, ¶28. The statement addresses the ‘217 Patent “*module*” claim language (not Exhibit Nos. 2004 or 2006).

Next, Petitioner contends that there is no support for the statement that a POSITA “would understand that these algorithms are implemented using software”

because (1) Justin Marston is not a POSITA; and (2) Dr. Khan did not review Exhibit Nos. 2004 and 2006. Paper 44, at 7. With respect to Justin Marston, although he does not have a degree in engineering, the POSITA definition² states that “a higher level of [experience] can make up for less [education].” Paper 13, at 8-9. At the time of the invention, in addition to considerable experience with computer programming, Justin Marston had **4 years** of experience working on an “email-based management system” at BlueSpace. EX1050, 32:20-33-11 &56:1-58:9; EX2015-2018. Moreover, regardless of whether Justin Marston is a POSITA, he has relevant technical experience. *See SEB S.A. v. Montgomery Ward & Co.*, 594 F.3d 1360, 1373 (Fed. Cir. 2010), *overruled on different grounds*, *Global-Tech Appliances, Inc. v. SEB S.A.*, 131 S. Ct. 2060 (U.S. 2011) (district court did not abuse its discretion by admitting testimony in a patent dispute involving a deep fryer, where witness “[wa]s not skilled in designing deep fryers” but had relevant technical experience); *eSpeed, Inc. v. Brokertec USA, L.L.C.*, 404 F. Supp. 2d 575, 579–80 (D. Del. 2005) (rejecting argument that testimony should be excluded because witness was not a POSITA where witness had an understanding of relevant industry and was “able to render a helpful opinion”). With respect to Dr. Khan, although he did not review Exhibit Nos.

² Paper 13, at 8-9 (defining POSITA to be someone with “a bachelor’s degree in electrical or computer engineering, or a related field, and two to three years of experience with web or email-based content management systems; a higher level of education or skill can make up for less experience, and vice versa”).

2004 or 2006, he did testify that a POSITA would understand that the “*modules*” used to determine the relevance score are software, such as program or code (*e.g.*, EX2029, ¶28), and he testified at length about the inventive math/algorithms used to determine the relevance score. *E.g.*, *id.* ¶88-96; *see also id.* ¶33 (“A POSA would recognize that software instructions (*e.g.*, programs or code) are structure used to determine the relevance score.”). For all of these reasons, there is no basis for excluding the statements in Exhibit No. 2014 regarding a POSITA.

Petitioner argues that Exhibit 2014 is improper incorporation by reference. Paper 44, at 8. However, the Board is free to consider, and has considered, such analyses in assessing issues of priority. *See, e.g., Unified Pats., LLC v. Flexiworld Techs., Inc.*, No. IPR2022-00775, 2023 WL 7198014, at *5 (P.T.A.B. Nov. 1, 2023) (considering “a claim chart purporting to show where each limitation ... may be found in [the corroborating document]”); *see also* Fed. R. Evid. 1006.

Importantly, regardless of whether EX2014 is admitted, Patent Owner has provided evidence of conception prior to Dumais. It is not EX2014 that shows that the ‘217 Patent is entitled to an earlier priority date: it is EX2004 and EX2006, which are, on their own, ample independent evidence to corroborate conception. EX2014 merely summarizes the content in EX2004 and EX2006. *See* Fed. R. Evid. 1006.

III. There Is No Basis for Excluding Exhibit Nos. 2004 or 2006.

Petitioner moves to exclude Exhibit Nos. 2004 and 2006, which were prepared

by the Marstons and demonstrate that the Marstons conceived of their inventions before Dumais. *See* EX2004 & EX2006. Petitioner argues that the Marstons' "testimony alone is insufficient to corroborate EX2004 and EX2006." Paper 44, at 9. But Patent Owner is not relying upon "testimony alone"; Patent Owner is relying upon Exhibit Nos. 2004 and 2006, which the Board found "*themselves* are evidence of conception, which do not require further corroboration." Paper 13, at 31.

Contrary to Petitioner's arguments (*see* Paper 44, at 8-9), there is ample evidence demonstrating the authenticity of, and authorship of, Exhibit Nos. 2004 and 2006. **First**, Justin Marston is the custodian of the documents (i.e., they came from his files). *See* EX2004,35, EX2006,61, EX1050,203:16-21. **Second**, the Marstons provided comments (in tracked changes) to various drafts of the same document. *E.g.*, EX2043/EX2044. **Third**, other documents from the timeframe show the Marstons' work on the same invention. *E.g.*, EX2005,10 (File Name "Pauls Formula for Justins Business"); EX2009 (Author is "Marston"); *see also* Reply,20 (acknowledging "'Marston'-authored documents"). **Fourth**, the "template" used for the documents is a BlueSpace template. EX2019 & EX2021. **Finally**, EX2004/EX2006 are drafts of the provisional (EX1003), which Justin Marston emailed to his attorney for filing. EX1056, at 18 (Jan. 11, 2006 email with Subject "New Patent" from Justin Marston to Brian Hoffman, attaching "BlueSpace mail Relevance JM 131105"). The exhibits are what the Marstons purport them to be.

Next, Petitioner argues that “[t]he Marstons’ claim is also inconsistent with the time period they were part of BlueSpace.” Paper 44, at 9. As an initial matter, Paul Marston was never “part of BlueSpace”; only Justin Marston was. EX1050, 46:8-9. With respect to Justin Marston, Petitioner notes that Justin Marston “was not CEO of BlueSpace when EX2004 and EX2006 were created” and that that somehow demonstrates that the documents are not authentic. But Justin Marston was working for BlueSpace at the time the documents were created (just not in the role of CEO). *E.g.*, EX2015, ¶10. It is irrelevant what role he held at BlueSpace at the time.

Petitioner claims the Marstons’ testimony is biased because they are being paid. Paper 44, at 9. Any payment they received in 2025, however, cannot, of course, alter the content of documents last modified in 2004 (EX2004) and early June 2005 (EX2006). Exhibits 2004 and 2006 are independent evidence of conception.

Next, Petitioner contends that Exhibit Nos. 2004 and 2006 are hearsay. To the contrary, they are business records that fall within an exception to the hearsay rule. Fed. R. Evid. 803(6) & EX2015, ¶¶12-15 & 21-24. As the documents’ custodian (*see supra* at 8), Justin Marston is capable of establishing, and has established, that the business records exception applies. *See id.*

IV. There Is No Basis for Excluding Any of the Marstons’ Testimony.

Paragraph 24 of Paul Marston’s declaration: Petitioner seeks to exclude Paul Marston’s testimony regarding Jon Fernyhough. There is no basis for excluding the

testimony as hearsay because the testimony does not reflect a “statement”; instead, it reflects Paul Marston’s understanding of Jon Fernyhough’s role. *See* Fed. R. Evid. 801(a). Regarding the alleged “lack of foundation,” although Petitioner stresses that Paul Marston never met or had a verbal conversation with Jon Fernyhough (Paper 44, at 10), Paul Marston does have personal knowledge of Jon Fernyhough’s role: the two exchanged written correspondence. EX1053 (“Letter to Jon & Justin” from Paul Marston); EX2054 (“Letter to Justin & Jon” from Paul Marston”).

Paragraph 19 of Paul Marston’s declaration: Petitioner asserts that the following sentence is hearsay: “I [Paul Marston] asked [Dr. Morton-Jones] to review for me the formulas that I had prepared.” Paper 44, at 11. The sentence, however, is not a “statement”; at most, it is a non-assertive **question**, and questions are not “statements” under Rule 801. *See, e.g., United States v. Pulliam*, 973 F.3d 775, 783 (7th Cir. 2020), *as amended* (Sept. 8, 2020); *United States v. Jackson*, 88 F.3d 845, 848 (10th Cir. 1996) (finding that question was not a hearsay “statement” where it could not reasonably “be construed to be an intended assertion”). Petitioner also asserts that the following sentence is hearsay: “Tony Morton-Jones did not prepare any of the formulas in the draft (or final) provisional patent application.” Paper 44, at 11. Again, this sentence is not a “statement”; it discusses an **action** that someone did (or, in this case, did not) perform (i.e., preparing a formula).

Paragraph 58 of Justin Marston’s declaration: Petitioner asserts that the

following sentence is hearsay: “I understand that this is because Paul Marston asked his friend, Tony Morton-Jones, to review the formulas that Paul Marston had prepared.” Paper 44, at 11. Again, this is not a “statement”; Paul Marston asking Tony Morton-Jones to review a formula is, again, a question, which is not a hearsay “statement.” *Supra* at 11. And, the sentence that “Tony Morton-Jones did not prepare any of the formulas himself” is a comment upon an action that someone did (or, in this case, did not) perform (i.e., preparing a formula), not an assertion.

Paragraphs 59 and 62 of Justin Marston's declaration: Petitioner seeks to exclude Justin Marston's testimony that Rick Turner and Tim Couper “did not contribute ... to the inventions” on the alleged basis that the testimony lacks foundation. Paper 44, at 11-12. But Justin Marston worked with Rick Turner and Tim Couper at BlueSpace (EX2030, ¶¶59, 62) and, therefore, he had personal knowledge of their roles. Moreover, Justin Marston is the named inventor on the '217 Patent; therefore, he has personal knowledge of who contributed what to the invention. Moreover, Justin Marston's testimony that Rick Turner and Tim Couper did not contribute to the invention is consistent with the documents, which establish that the Marstons were the two people working on the invention and that the roles of any third parties were limited to the Marstons running their ideas by them. Petitioner was free to ask Justin Marston about their roles (which they did), but Petitioner cannot genuinely contend that he lacked personal knowledge regarding their roles.

Petitioner also argues that Justin Marston's testimony that "Tim Couper did not contribute in any way to this document" refers to EX2050 and should therefore be excluded as contradicted by the metadata. However, it is apparent that his comment about "this document" was referring to the "provisional patent application" (EX1003) referenced earlier in the paragraph. This is because Justin Marston testified that, in EX2050, Tim Couper wrote the black text (and that Paul Marston wrote the blue text). EX1050, 195:11-20; EX1064, 133:19-25) (same); EX1050, 196:11-12 ("he provided very limited commentary on the document").

EX2050, 2048, 2047, 2056, 2058, 2057: Because the paragraphs above do not contain inadmissible hearsay (*see supra* at 11-13), there also is no basis for excluding EX2050, 2048, 2047, 2056, 2058, or 2057.

V. Exhibit Nos. 2080-2083 Are Admissible.

Exhibit Nos. 2080-2083 are articles from periodicals that Patent Owner cited as evidence of secondary considerations of non-obviousness (commercial success, praise by others, copying).³ Resp. at 54-56. Petitioner alleges that these articles are "hearsay and unduly prejudicial." Paper 44, at 12. However, numerous courts and Board decisions have found that similar articles, when used as evidence of secondary considerations, were not being offered for their truth and, therefore, are not hearsay. *See Quanergy Sys., Inc. v. Velodyne Lidar, Inc.*, No. IPR2018-00255, 2019 WL

³ Each of these articles is self-authenticating. Fed. R. Evid. 902(6).

2237114, at *17 (P.T.A.B. May 23, 2019) (denying motion to exclude articles, submitted as evidence of industry praise and commercial success, because “[w]e do not consider news articles such as these to be inadmissible hearsay as they are ‘offered simply as evidence of what [each] described, not for proving the truth of the matters addressed in the document’” (internal quotation and citation omitted)); *Hynix Semiconductor Inc. v. Rambus Inc.*, No. C-00-20905 RMW, 2009 WL 112834, at *14 (N.D. Cal. Jan. 16, 2009), *aff'd*, 645 F.3d 1336 (Fed. Cir. 2011) (article referencing praise in the industry was not hearsay “because it was admitted not for its truth, but as a proper secondary consideration”); *HTC Corp. v. Tech. Props.*, No. 5:08-cv-00882-PSG, 2013 U.S. Dist. LEXIS 129263, at *16 (N.D. Cal. Sep. 6, 2013) (evidence of “industry acclaim” served a non-hearsay purpose).

An independent basis for admitting the statements in EX2080 and EX2081 is that the relevant statements are statements by a party opponent. *See* Fed. R. Evid. 801(d)(2); EX2081, at 3 (statements by Mike Jahr, a senior engineering manager at Twitter); EX2080, at 14 (stating that source of data is “Company data”).

Exhibit Nos. 2082 and 2083 are articles that identify when Facebook and Instagram moved to relevancy-based algorithms (2011 and 2016, respectively). These market reports and commercial publications are generally relied upon by the public and, therefore, are subject to a hearsay exception. Fed. R. Evid. 803(17).

Finally, Petitioner contends that the articles are “unduly prejudicial.” Paper

44, at 13. Petitioner **does not dispute the facts** from the articles that Patent Owner cites. While the information may not be helpful to Petitioner (because it supports a finding of non-obviousness), it is not “unduly” prejudicial.

VI. Patent Owner Is Not Relying Upon the Substance of the Documents Logged in Exhibit 2042.

Exhibit No. 2042 is a privilege log setting forth the metadata for communications Justin Marston had with his patent counsel during the critical period. Petitioner seeks to exclude the Exhibit (and testimony discussing it) on the alleged basis that “Sterling relied on the ‘specific substance of the emails’ in EX2042.” Paper 44, at 13-14. To the contrary, as the Board has already found, Patent Owner has not relied upon the substance of any of the logged documents; instead, Patent Owner is relying upon the fact that certain communications took place on certain dates – i.e., information can be extracted from the metadata alone. Paper 31, at 5-6 (finding that the cited portions of Justin Marston’s testimony “at most, confirm email subject lines listed on the privilege log, rather than discuss specific email content” and that Justin Marston “merely relies on the *existence* of those emails to show the exchange of emails” (internal citations omitted)).

VII. Exhibit Nos. 2032-2039 and 2041-2078 Are Not Improper Incorporation by Reference.

Petitioner contends that “EX2032-2039 and EX2041-2078 should be excluded because Sterling improperly incorporates these exhibits by reference.”

Paper 44, at 15 (citing 37 C.F.R. § 42.6(a)(3); FRE 401, 402). In particular, Petitioner contends that Patent Owner provides “no explanation” as to what the documents are. To the contrary, Patent Owner explained exactly what the documents are: “additional evidence that both corroborates Justin Marston’s testimony and shows reasonable diligence.” Paper 38 at 19; *see also* Paper 17 at 6 & 46. Although Petitioner complains that Patent Owner did not provide detailed “pin cites” or “analysis,” the detailed information about the specific work performed on each day of the critical period is not necessary. What is relevant is that the inventors were working reasonably continuously on the invention, and the documents show that.

Petitioner also contends that “[t]hese exhibits are not relied upon for any proper purpose.” To the contrary, the Board invited Patent Owner to “introduce additional relevant evidence ... [to] show[] reasonable diligence” (Paper 13, at 33) and Patent Owner submitted EX2032-2039 and EX2041-2078 in response. Therefore, the purpose of submitting these exhibits was most proper.

Finally, Petitioner contends that these documents are “irrelevant.” However, the documents show that the inventors worked reasonably continuously to reduce the invention to practice, which is highly relevant to the issue of priority.

CONCLUSION

For the reasons set forth in the Response and above, Patent Owner respectfully requests the Board deny in its entirety Petitioner’s motion to exclude.

Respectfully submitted,

Dated: February 25, 2026

By: /Devan Padmanabhan/

Devan Padmanabhan

Lead Attorney for Patent Owner

Reg. No. 38,262

PADMANABHAN & DAWSON PLLC

9800 Shelard Parkway, Suite 120

Minneapolis, Minnesota 55441

Telephone: 612-444-3377

Email: devan@paddalawgroup.com

Attorney for Patent Owner

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. 42.6(e), I certify that on this 25th day of February, 2026, a true and correct copy of the foregoing **Patent Owner's Opposition to Petitioner's Motion to Exclude Evidence** was served by electronic mail on Petitioner's lead and backup counsel at the following addresses:

WHITE & CASE LLP
David Okano
Yar Chaikovsky
david.okano@whitecase.com
yar.chaikovsky@whitecase.com
WCSterlingComputerXCorp@whitecase.com

By: /Devan Padmanabhan/

Devan Padmanabhan (Reg. No. 38,262)
devan@paddalawgroup.com
Padmanabhan & Dawson, PLLC
9800 Shelard Parkway, Suite 120
Minneapolis, Minnesota 55441
Telephone: 612-444-3377