

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 OPPOSITION TO STERLING'S MOTION TO EXCLUDE

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EXHIBIT LIST

No.	Short Name	Reference
1001	217 Patent	Certified Copy of U.S. Patent 7,716,217
1002	217 File History	Certified File History of 7,716,217
1003	828 Provisional	Certified United States Provisional Patent Application No. 60/758,828.
1004	Houh Decl.	Expert Declaration of Dr. Henry Houh
1005	Houh CV	Curriculum Vitae of Dr. Henry Houh
1006	<u>Dumais</u>	U.S. Patent Application Publication 2007/0016553A1
1007	<u>Kircher</u>	U.S. Patent Application Publication 2003/0195937A1
1008	<u>Krug</u>	Certified Translation of WIPO Patent 2003/023650A2
1009	Sch. Order	Order 32 (Scheduling Order) in <i>Sterling Computers Corporation v. X Corp.</i> , Case No. 1:24-cv-00552 (W.D. Tex. May 22, 2024)
1010	Sch. Hr. Tr.	Oct. 21, 2024, Transcript of Initial Pretrial (Scheduling) Conference in <i>Sterling Computers Corporation v. X Corp.</i> , Case No. 1:24-cv-00552 (W.D. Tex. May 22, 2024).
1011	Goldberg	David Goldberg, et al., <i>Using Collaborative Filtering To Weave An Information Tapestry</i> , COMMUNICATIONS OF THE ACM, 35:12 (Dec. 1992).
1012	Kennedy	U.S. Patent 6,134,582
1013	Mailk	U.S. Patent Application Publication 2004/0078447
1014	587 Application	International Application PCT/US07/60587
1015	587 File History	File History of PCT/US07/60587
1016	RESERVED	
1017	118 File History	File History of 11/426,118

1018	605 Provisional	Provisional Patent Application No. 60/693,605.
1019	Shaw	U.S. Patent 6,249,807
1020	Karamchedu	U.S. Patent Application Publication 2004/0054744
1021	Fitzpatrick	U.S. Patent Application Publication 2006/0168029
1022	Yao	U.S. Patent Application Publication 2003/0187937
1023	Segal	Richard Segal, et al., <i>SpamGuru: An Enterprise Anti-Spam Filtering System</i> , CEAS 2004, FIRST CONFERENCE ON EMAIL AND ANTI-SPAM, (July, 2004).
1024	Carlson	U.S. Patent Application Publication 2005/0267973
1025	Sood	U.S. Patent 7,941,491
1026	Kirsch	U.S. Patent Application Publication 2005/0091319
1027	Boykin	P. Oscar Boykin, et al., <i>Personal Email Networks: An Effective Anti-Spam Tool</i> , ARXIV.ORG, 4 (Feb. 2004)
1028	Horvitz	International PCT Application WO2001/069432
1029	Lui	Andrew K. Lui, et al., <i>An Advanced Organizer for Asynchronous Discussion Forums</i> , IEEE (2005).
1030	Claypool	Mark Claypool, et al., <i>Combining Content-Based and Collaborative Filters in an Online Newspaper</i> , ACM SIGIR WORKSHOP ON RECOMMENDER SYSTEMS (Aug. 1999).
1031	Brun	U.S. Patent Application Publication 2007/0168430
1032	Linden	Greg Linden, et al., <i>Amazon.com Recommendations Item-to-Item Collaborative Filtering</i> , IEEE INTERNET COMPUTING (2003).
1033	Frankowski	International PCT Application WO2001/53973
1034	Dabbish	Laura A. Dabbish, et al., <i>Understanding Email Use: Predicting Action on a Message</i> , CHI (2005).
1035	Basu	Chumki Basu, et al., <i>Recommendation as Classification: Using Social and Content-Based Information in Recommendation</i> , AAAI-98

		PROCEEDINGS (1998).
1036	Melville	Prem Melville, et al., <i>Content-Boosted Collaborative Filtering for Improved Recommendations</i> , PROCEEDINGS OF THE EIGHTEENTH NATIONAL CONFERENCE ON ARTIFICIAL INTELLIGENCE (Jul. 2002).
1037	Alspector	Joshua Alspector, et al., <i>Comparing Feature-Based and Clique-Based User Models for Movie Selection</i> , PROCEEDINGS OF THE THIRD ACM CONFERENCE ON DIGITAL LIBRARIES (1998).
1038	Balabanovic	Marko Balabanovic, et al., <i>Content-Based Collaborative Recommendation</i> , COMMUNICATIONS OF THE ACM (Mar. 1997).
1039	Kussmaul	U.S. Patent 7,860,933
1040	Rose	U.S. Patent 6,202,058
1041	MSFT Comp.	Microsoft Computer Dictionary, 3ed (1997).
1042	Levenshtein	Jan 2005 – Levenshtein Distance – Wikipedia
1043	<u>Marston</u>	U.S. Patent Application Publication 2004/0260710
1044	EX2010 Markup	EX2010 with comments and redlines enabled
1045	EX2010 metadata	System metadata for EX2010
1046	EXPUNGED	
1047	PHV Plail Dec.	<i>Pro Hac Vice</i> Declaration of Ethan L. Plail
1048	Board's Authorization Discovery	Patent Trial and Appeal Board's Correspondence Authorizing Request for Additional and Routine Discovery, November 6, 2025
1049	J. Marston Rough Depo. Tr.	Rough Deposition Transcript of Justin Marston, November 11, 2025
1050	J. Marston Final Depo. Tr.	Final Transcript of Justin Marston Deposition, November 11, 2025

1051	J. Marston C.V.	Justin Marston Curriculum Vitae
1052	BlueSpace Investment Presentation	BlueSpace Investment Presentation, December 2005
1053	Letter to Jon and Justin	Letter to Jon and Justin
1054	Letter to Justin and Jon Oct. 2005	Letter to Justin and Jon, October 14, 2005
1055	Updated EX2041 BlueSpace Doc. Log	Updated EX2041 BlueSpace Document Log, June 2005 to January 2006
1056	Updated EX2042 Priv. Comms. Log	Updated EX2042 Privileged Communications Log BlueSpace Counsel, June 2005 to January 2006
1057	Letter to Bobby Inman	Letter to Bobby Inman, August 2, 2005
1058	Dr. Khan Depo.	Final Transcript of Dr. Khan Deposition, November 13, 2025
1059	Thuraisingham	Bhavani Thuraisingham, et al., <i>Emergency-Driven Assured Information Sharing in Secure Online Social Networks: A Position Paper</i> . 2016 IEEE INTERNATIONAL PARALLEL AND DISTRIBUTED PROCESSING SYMPOSIUM WORKSHOPS (May 2016).
1060	Chandra	Swarup Chandra, et al., <i>Estimating Twitter User Locations Using Social Interactions – A Content Based Approach</i> . 2011 IEEE THIRD INTERNATIONAL CONFERENCE ON PRIVACY, SECURITY, RISK AND TRUST AND 2011 IEEE THIRD INTERNATIONAL CONFERENCE ON SOCIAL COMPUTING (Oct. 2011).
1061	Chen	Qing Chen, et al., <i>Tweets mining using WIKIPEDIA and impurity cluster measurement</i> . 2010 IEEE INTERNATIONAL CONFERENCE ON INTELLIGENCE AND

		SECURITY INFORMATICS (May 2010).
1062	Abrol Article	Satyen Abrol, et al., <i>Twiner: understanding news queries with geo-content using twitter</i> . PROCEEDINGS OF THE 6TH WORKSHOP ON GEOGRAPHIC INFORMATION RETRIEVAL (Feb. 2010).
1063	Abrol Patent	U.S. Patent 8,965,974
1064	Paul Marston Depo.	Final Transcript Dr. Victor “Paul” Marston, November 17, 2025
1065	University Schedule 2004-2005	University of Central Lancashire Schedule 2004-2005
1066	University Schedule 2005-2006	University of Central Lancashire Schedule 2005-2006
1067	Paul Marston Doc. List	Dr. Paul Marston Document List
1068	Sterling Metadata Table	Table of Metadata for Sterling’s Inventive Documents
1069	Native Metadata EX2004	Sterling’s Extracted Metadata from Native of EX2004 Conception document
1070	Native Metadata EX2006	Sterling’s Extracted Metadata from Native of EX2006 Conception document
1071	Unredacted EX2046	Unredacted version of EX2046.
1072	N. Tafradzhiyski Employment	Nayden Tafradzhiyski, Journalist, Employment History
1073	Porlezza	Colin Porlezza, <i>Accuracy in journalism</i> . OXFORD RESEARCH ENCYCLOPEDIA OF COMMUNICATION (2019).

Sterling’s motion seeks to exclude evidence (1) within the scope of direct testimony, (2) relevant to the credibility of its witnesses, and (3) on grounds it did not preserve during deposition. Sterling misunderstands—and takes positions in conflict with—Fed. R. Evid. (“FRE”) 611(b). Sterling’s motion should be denied.

I. Paul Marston’s Cross-Examination Testimony Should Not Be Excluded.

A. No Basis to Exclude Under FRE 601 or 602.

Sterling contends EX1064, 95:1–13 should be excluded because Paul Marston is not a person of ordinary skill in the art (“POSITA”). Sterling’s challenge should be denied because (1) it seeks inconsistent application of evidentiary rules and (2) Sterling did not preserve an objection on these grounds.

Sterling seeks to exclude Paul Marston’s testimony because “he does not have personal knowledge of what a [POSITA] would have understood at the time of the invention.” Mot. 9. But Sterling relies on direct testimony from inventors Justin and Paul Marston as if they were POSITAs to support positions on conception and reduction-to-practice that require evidence from the perspective of a POSITA. *See, e.g.*, Paper 38 at 23 (relying on P. and J. Marston to claim refinements to algorithms did not require “more than ordinary skill”); *id.* at 19–20, 22; EX1050, 200:18–201:6 (relying on J. Marston for knowledge of a POSITA in EX2014); Paper 17 at 42 (same). Paul adopted Justin Marston’s testimony that “[b]y June 7, 2005, Paul and I had conceived a system with a relevance model that includes all features of the

claims” and that “a person of ordinary skill in the art ... would understand that the claim[s] ... are directed to structure.” EX2003, ¶14, ¶16, ¶19, ¶¶23–26, ¶¶28–30.¹

Sterling cannot pick and choose which cross-examination testimony from its paid witnesses is admissible. If Paul Marston’s **cross**-examination testimony is excludable because he is not a POSITA and “does not have a background in computer science,” Mot. 9, then **direct** testimony from Paul Marston on the same issues must also be excluded. *Kyocera Senco Indus. Tools Inc. v. Int’l Trade Comm’n*, 22 F.4th 1369, 1376–77 (Fed. Cir. 2022) (administrative judge abused discretion by permitting testimony “from the perspective of a skilled artisan” where witness did not “at least have ordinary skill in the art.”).

Further, Sterling did not object to Paul Marston’s testimony as opinions from an unqualified expert witness under FRE 702 or 703. Sterling objected only under FRE 602 (personal knowledge) and FRE 601 (competency). Neither supports Sterling’s challenge. Accordingly, the Board should also deny this challenge.

FRE 601 relates to a witness’s capacities or infirmities, not the content of his testimony. *United States v. Phibbs*, 999 F.2d 1053, 1068 (6th Cir. 1993) (courts “strongly disfavor barring witnesses on competency grounds”). FRE 602 is

¹ Paul Marston “reviewed the declarations of Justin Marston ...” and testified that Justin Marston’s discussion was “consistent with my recollection.” EX2031, ¶11.

inapplicable because Paul Marston testified—based on his personal knowledge—that “an ordinary skilled person wouldn’t understand” the formulas in the Conception Documents. Paul Marston was a lecturer in statistics at the University of Central Lancashire for almost 50 years. EX2031, ¶7. He is no doubt aware of whether a mathematical formula is difficult to understand and apply.

B. No Basis To Exclude As Outside The Scope Of Direct Testimony

Sterling contends that Paul Marston’s testimony at EX1064, 95:1–13 should be excluded because the questions were beyond the scope of direct. Not so.

On direct, Paul Marston testified that he “refin[ed] the formulas” in the Conception Documents after the critical date of June 7, 2005, and adopted Justin Marston’s testimony as to the knowledge of a POSITA. EX2031, ¶11, ¶16; EX2003, ¶16, ¶19, ¶¶23–25, ¶26, ¶¶28–30. On cross, Petitioner sought clarification on the inventors’ “refinements” and whether conception of the claimed invention was complete prior to June 7, 2005.

[PETITIONER] Q. Would the math for the cognate relevant system be agnostic to the type of content?

A. I don’t know whether it would have to be *tweaked*. It probably would, but the same basic ideas...

EX1064, 94:6–12.

Following up on the meaning of “tweaked,” Paul Marston testified:

[PETITIONER] Q. [W]hen you said the formula might need to be *tweaked*, is that something that a person of ordinary skill would be able to do?

A. I doubt if anybody of ordinary skill could understand it in the first place.

[] I doubt whether anyone of -- what was it? Of average competence?

Q. Ordinary skill.

A. Ordinary skill. *No, an ordinary skilled person wouldn't understand it.*

EX1064, 95:1–13 (objection on Rules 601, 602, and 611 omitted).

Questions about how significantly the Conception Document formulas were “tweaked” and the level of skill necessary to modify them are within the scope of Paul Marston’s direct testimony. FRE 611(b).

The challenged cross-examination testimony also relates to “matters affecting the witness’s credibility.” See FRE 611(b). Sterling and its paid witness Paul Marston contend that the named inventors had complete conception of the inventions prior to the critical date. Paper 38 at 23 (refinements to algorithms did not require “more than ordinary skill”). Cross-examination testimony—such as the above—that conflicts with Sterling’s positions bears on the credibility of its witnesses.

Nor did Sterling preserve an objection to all the testimony it seeks to exclude. Sterling objected to a prior question—not the question at 95:11–13.

II. Justin Marston’s Cross-Exam Testimony Should Not Be Excluded.

A. Cross-Exam Testimony on Time Paul Marston Spent on the Invention is Not Outside the Scope of Direct.

Sterling contends that Justin Marston lacks “personal knowledge” of the time Paul spent on the alleged invention and that his cross testimony was outside the scope of direct. Mot. 8. Sterling’s contention is unsupported by the facts.

On direct, Justin Marston provided time estimates for work he and Paul spent on the claimed inventions. EX2030, ¶17 (“20 hours”); ¶34 (“55 hours”); ¶47 (“30 hours”). He estimated that he and Paul worked a mere 108 combined hours on the alleged invention during the entire 198-day critical period. During cross-examination, Justin Marston made clear that his time estimates “would be [for] **both** of our time.” EX1050, 283:19–284:7; 289:20–290:4; 299:7–11.

Justin was uncertain of Paul Marston’s time for only two periods. *Id.* 297:21–298:12 (Aug. 21 to Sept. 21, 2005), 299:19–21 (Nov. 13, 2005 to Jan. 13, 2006), 300:10–15 (same). For these two periods, Paul Marston was not aware of any work done after Nov. 10, 2005. EX1064, 84:21–24. Nor could he provide an estimate for Aug. to Sept. 2005, but he agreed with Justin Marston’s estimates. EX1064, 116:18–22; 114:21–22 (“[I]f Justin feels he can make those hours [estimates], then it’s consistent with my recollections.”).

Sterling does not explain how the challenged cross-exam testimony is outside the scope of Justin Marston’s direct testimony. Justin Marston provided testimony on both Marstons’ time. EX2030, ¶17, ¶34, ¶47. Justin was also the “driving force” behind the claimed inventions. EX1064, 78:4–10. Justin has personal knowledge of what others on his team—including his father and close collaborator Paul—were working on. If he does not, EX2030 and EX2003 should also be struck under FRE 602, as those exhibits also include time outside of his own.

Further, Sterling did not object under FRE 602 and objected to only a single question under FRE 611 out of dozens. Its objection is forfeited. EX1050, 298:6–7 (objecting only once under FRE 611); see also EX1050, 296:19–300:18.

B. Cross-Exam Testimony on the Value of BlueSpace is Admissible.

Sterling seeks to exclude EX1050, 45:14–21; 46:20–47:5; 53:5–15; 54:8–21, because Justin Marston allegedly lacked personal knowledge of “the purchase price of BlueSpace.” Mot. 10. Sterling contends that “Petitioner cites this testimony in its Reply to suggest the ’217 Patent invention was not valuable.” Sterling mischaracterizes Petitioner’s Reply.

Petitioner cites testimony where Justin Marston admits the inventors “pivoted” to other products because there was no “money” in the products associated with the claimed invention. Paper 36, 29 (citing EX1050, 20:2–13 (below)).

[PETITIONER] Q. You said that BlueSpace pivoted away from the relational—sorry, the relevance models in the ’217 patent into this multi-domain security. Why was that?

A. Money.

Petitioner also cites statements where Justin Marston testified that BlueSpace and its patent portfolio were sold for a low price. Petitioner does not rely on these statements for the truth of the sales price, but to show the patents were not valuable. Justin Marston has personal knowledge of BlueSpace and its patent portfolio’s value because he was BlueSpace’s CEO. EX1030, ¶¶11–12.

III. Sterling’s Attempt to Exclude Unhelpful Testimony By Its Expert Should Be Rejected.

A. Dr. Khan’s Testimony on His Own Papers is Admissible.

Sterling seeks to exclude testimony referring to academic papers by Dr. Khan under FRE 602. *See* EX1058, 134:3–15; 136:4–16; 139:1–15; 148:25–150:8; EX1059–EX1063 (Khan as author). Sterling has not met its burden to establish that this testimony should be excluded.

First, Sterling did not object to the authenticity or admission of these academic papers (EX1059–EX1063). Second, Sterling does not explain how Khan lacks personal knowledge of his own prior written statements. EX1058, 132:8–12 (“Q. This is one of your old papers, right? A. Yeah.”); 137:6–8; 144:24 (“my paper.”). Indeed, the testimony Sterling seeks to exclude often includes direct quotes from papers authored by Khan. For example, EX1058, 134:3–15 restates what is in Khan’s own paper and asks if he agrees. *See* EX1059, 1.

Sterling also contends this testimony should be excluded under FRE 611—a misreading of that rule. “Cross-examination may embrace any matter germane to direct examination, qualifying or destroying it, or tending to elucidate, modify, explain, contradict or rebut testimony given by the witness.” *United States v. Smith*, 591 F.3d 974, 981 (8th Cir. 2010). Khan’s direct testimony discussed (1) his professional background, including his papers (EX2029, ¶¶15–18), and (2) the content management system described in the ’217 Patent (EX2029, ¶¶88–96).

Khan's papers on content management and analysis systems are within the scope of his direct testimony—as Khan admitted himself. EX1058, 137:2–3 (admitting EX1060 was a “very good paper” on this topic). Khan's prior statements on his personal implementation of content management systems are also relevant to his credibility on the same issues in his direct testimony.

Sterling's motion should also be denied because it did not object to large portions of the cross-exam testimony it now seeks to exclude. Mot. 6. For example, Sterling did not object to 134:3–15. Sterling seeks to exclude 148:25–150:8 under FRE 611 and 602, but objected to only two questions in that range on either ground. In 136:4–16 and 139:1–15, Sterling did not object to any question under FRE 611.

B. Dr. Khan's Reliance on “Empirical Studies” to Discuss the Scope of the Claims Opened the Door

Sterling seeks to exclude EX1058, 200:19–25 and 252:15–19 because Dr. Khan's direct testimony (EX2029) did not discuss any “empirical study.” Mot. 5. But Sterling ignores that Khan *introduced* “empirical study” during cross-exam on the scope of the claims:

[PETITIONER] Q. Okay. So are all four of these measures required?

A. All four, no.

Q. Okay. Which of them are required?

A. That, I cannot answer because it requires *empirical study*.

EX1058, 95:8–13.

Khan's refusal to respond by invoking “empirical stud[ies]” opened the door

and entitled Petitioner to further questioning on them. *See United States v. Cavale*, 688 F.2d 1098, 1112 (7th Cir. 1982) (when a party introduces a subject, it cannot complain if the opposing party introduces further evidence on that subject).

In later testimony Sterling seeks to exclude, Khan discussed the same “empirical study” concept he had introduced earlier:

[PETITIONER] Q. [Y]ou don’t have an answer for what is an acceptable set size?

A. Because the **empirical experiment** is -- empirical experiment is required to say that number.

EX1058, 252:15–19 (objection on Rule 611 omitted); and

[PETITIONER] Q. All right. So a person of skill [in the art] would need to do an empirical study to determine how large a cognate group is?

A. No. They need to do more experiment -- **extensive experiment** and play with these numbers and do the -- try to understand all of this statistical methods and then find the right -- it’s not trivial.

EX1058, 200:19–201:2 (objection omitted).

These studies are also within the scope of Khan’s direct testimony. Khan testified on the meaning and scope of the “*cognate*” limitation. EX2029, ¶¶72–73. As revealed by cross-exam, Khan relied on undisclosed “empirical studies” to form his opinions. Petitioner is entitled to cross Khan on how he formed his opinions.

C. Dr. Khan’s Reliance on Algorithm Search Result “Quality” to Discuss the Scope of the Claims Opened the Door

Sterling seeks to exclude testimony showing that Dr. Khan relied on an

unclaimed “quality” limitation as outside the scope of his direct testimony, on the ground that he did not use the word “quality” in his declaration. Mot. 2; EX1058, 45:6–10, 57:5–6, 62:12–23, 96:3–14, 169:24–170:3, 200:19–201:2. Sterling’s objection ignores the record and is unsupported.

No limitation of the challenged claims recites a particular “quality.” But Khan voluntarily *injected* a required algorithm “quality” into his testimony on claim scope—with no question pending (EX1058, 45:5–10):

[PETITIONER] Q. Okay.

A. So I think that this algorithm, the patent ’217 algorithms have come up with a **very high quality -- high quality** ranking process, so that will improve the efficiency significantly....

Khan repeatedly testified that the ’217 “patent focuses on the quality of the result,” referencing the word “quality” **64** times in his deposition and admitting that he “evaluat[ed] the relative quality between the algorithms for the ’217 patent and the algorithms for the prior art” when forming his opinions. EX1058, 45:6–10, 57:5–6, 62:12–23, 96:3–14, 169:24–170:3, 200:19–201:2. Petitioner was entitled to probe what Khan meant by “quality” and how he used the concept in his analysis of the claims. See EX1058, 169:24–170:3 ([PETITIONER] Q. You were evaluating the relative quality between the algorithms for the ’217 patent and the algorithms for the prior art when you were forming the analysis of the claims? A. Correct.).

That Khan did not use the exact word “quality” in his declaration does not

justify Sterling's objection. The purpose of cross under FRE 611 is to permit the opposing party to test and draw out concepts underlying a written declaration.

Khan's analysis is problematic for Sterling because Khan relied on an unrecited limitation to distinguish prior art. But while prejudicial to Sterling's case, this evidence is not "unfairly prejudicial" under FRE 403. *United States v. Starnes*, 583 F.3d 196, 215 (3d Cir. 2009) ("[U]nfair prejudice does not simply mean damage to the opponent's cause."). Sterling retained Khan as an expert and asked him to submit declarations on the scope of the claims. Sterling cannot now complain that its own paid expert provided testimony "unfairly prejudicial" to its position.

Sterling asks the Board to accord outsized weight to two instances (out of 64) where Khan used the word "no" when discussing the "*cognate user*" limitation, Mot. 3, and to ignore Khan's other unequivocal statements on "quality." But Sterling mischaracterizes the quotes, which simply show Khan's confusion:

[PETITIONER] Q. ... [T]he claim requires a high-quality algorithm in order to identify a cognate user, correct?

A. No.

Q. No?

A. ***What did you say?***

Q. The claim requires a high-quality algorithm in order to identify the cognate user?

A. No. I said the claims come up with a ***very efficient scoring mechanism***, and that efficient scoring mechanism is based on a number of algorithms or

approaches, the first relevance ...

EX1058, 173:10–24 (objections omitted).

Khan then testified that another claim limitation—the “second measure of relevancy”—produces “high-quality scoring,” which made the patent “impressive.” EX1058, 175:10–15. The faulty interpretation of the claims by Sterling’s own paid expert is a fault of its own making, not “unfair” evidence against Sterling.

Nor did Sterling object to the challenged testimony under FRE 403. Sterling did not object at all to 45:6–10 and objected to 57:5–6 under FRE 613—not FRE 611 or 403. *See also* 62:12–23, 96:3–14, 169:24–170:3, 200:19–201:2 (no objection under FRE 403, only FRE 611).

D. Dr. Khan’s Cross-Exam Testimony on the Scope Of The ’217 Patent is Relevant and Not Outside The Scope of His Direct Testimony

Sterling challenges EX1058, 114:10–115:15 and 123:3–131:21 under FRE 611, and challenges how Petitioner applied that testimony in its Reply under FRE 403. Mot. 3–4. Both challenges lack merit and should be rejected.

First, Dr. Khan’s challenged testimony is not outside the scope of his direct testimony. EX1058, 114:10–115:15 and 123:3–131:21 address the “*identifying*” claim limitation—the former laying the foundation for Khan’s view, the latter confirming that parts of the specification (EX1001, 8:23–25, 43:30–37, 12:50–59, 14:45–67) are not examples of the “*identifying...*” limitation:

[PETITIONER] Q. So column 14, lines 45 through 53, is not an example of

the entire identifying limitation, correct?

A. Correct.

See, e.g., EX1058, 130:11–13.

Sterling seeks to exclude this testimony because it conflicts with its attorney argument that similar passages in the Conception Documents disclose “*identifying*.” *Compare* EX1001, 8:23–25, 43:30–37, 12:50–59, 14:45–67 *with* EX2014, 5. Sterling contends that Khan never testified “about the Conception Documents.”

Sterling’s contention is misdirection. The challenged testimony does not refer to—and is not about—the Conception Documents. It concerns the scope of the “*identifying*” limitation, on which Khan provided direct testimony. EX2029, ¶80, ¶87. Indeed, Sterling now claims that portions of EX2014 are based on this direct testimony. *Compare* Paper 38 at 21 (EX2014 “...discussions come from Patent Owner’s expert’s opinion”) *with* Paper 42 at 4. Its challenge here amounts to no more than an improper attempt to excise unfavorable testimony.

Sterling also appears to contend that Petitioner was somehow not permitted to ask questions about portions of the challenged ’217 Patent that Khan did not explicitly discuss in his declaration. *See* Paper 42 at 4. But FRE 611 does not limit cross-examination in this manner. *See Smith*, 591 F.3d at 981. Moreover, Khan’s declaration did not indicate that he omitted any parts of the challenged ’217 Patent from his review. EX2001; EX2029.

Second, Khan’s testimony is not “unfairly prejudicial” to Sterling under FRE

403. Sterling contends that because the Conception Documents and '217 Patent do not contain “identical” passages, Petitioner’s comparison between the two is “unfairly prejudicial.” Mot. 4–5. But Sterling took the opposite position earlier: to support its invention position, Sterling asserted “the Conception Documents disclose identifying another ‘cognate’ user using nearly the exact same language.” Paper 12, 1–2. Sterling cannot have it both ways. To the extent non-“identical” passages in the Conception Documents are excludable, nearly all of Sterling’s affirmative evidence on conception—EX2014—should be excluded. At best, Sterling’s contention is relevant to the weight of the evidence, not its admissibility.

Finally, Sterling did not preserve any objection to this testimony. 114:10–115:15 includes no objections. 123:3–131:21 is an eight-page swath of testimony comprising 43 questions, to which Sterling objected to only 5. Nor did Sterling object to how Petitioner used Khan’s testimony in its Reply.

IV. Dr. Khan’s Failure to Understand *KSR* Is Relevant.

Sterling seeks to exclude testimony from Khan showing that he applied an understanding of obviousness inconsistent with Supreme Court law. Sterling’s objection is based on a mischaracterization of the record. Mot. 1–2.

Petitioner questioned Khan about his understanding of the abilities and knowledge of a POSITA. For example, at 18:11–13:

[PETITIONER] Q. So you’re saying that a person of ordinary skill in the art

may not necessarily be creative?

A. Yeah.

Sterling claims that Khan's testimony adjacent to these questions (18:14–19:14) should be excluded under FRE 401 or 403 because the questions misstate the law. Sterling did not preserve objections on these grounds—its objection occurred four questions before the testimony it seeks to exclude.

Even if it had, Sterling's argument goes to the weight of the evidence, not its admissibility. Khan claimed he understood and applied the legal obviousness standard. EX2001, ¶¶16–19. He could have clarified his answer to Petitioner's questions. He did not. Khan's understanding of the KSR obviousness standard underlying his opinions is relevant, and the fact that he applied a standard inconsistent with KSR is not "unfairly prejudicial." Sterling's counsel's attempt to recharacterize both the question and the answer should be rejected.

V. Conclusion.

Sterling's motion should be denied.

Dated: February 25, 2026

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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 February, 2026, I caused to be served a true and correct copy of the foregoing and any accompanying exhibits by email on the following counsel:

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