

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

META PLATFORMS, INC.,

Petitioners

v.

STERLING COMPUTERS CORPORATION,

Patent Owner.

Case No. IPR2025-00430

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 Meta Platforms, Inc. (“Meta” or “Petitioner”) submits the following objections to Sterling Computer Corp. (“Patent Owner”) Exhibits 2004–2014, paragraphs 3–30 of the Declaration of Justin Marston (EX2003), and paragraphs 23–26, 28, 30, 33–44, 125, 157–159 of the Declaration of Dr. Latifur Khan (EX2001).

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

II. EXHIBIT 2001 (DECLARATION OF DR. LATIFUR KHAN)

Meta objects to paragraphs 23–26, 28, 30, 33–44, 157–159 of the Declaration of Dr. Latifur Khan (EX2001) as *ipse dixit*. Because these paragraphs lack foundation, they are not based in sufficient facts or data under FRE 702. As a result, Petitioner has not established these paragraphs are relevant under FRE 401, and the Board should exclude them as inadmissible under FRE 402/403.

Specifically, Khan provides conclusory opinions and statements regarding what a person of ordinary skill in the art (“POSITA”) would understand or could implement and what existing systems provided, but he fails to provide any supporting testimony, explanation, or evidence. Meta, thus, objects to the paragraphs

for lack of foundation and for including testimony that is not based on sufficient facts or data under FRE 702. *Cephalon, Inc. v. Watson Pharms., Inc.*, 707 F.3d 1330, 1338 (Fed. Cir. 2013) (citing *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 294 (Fed.Cir.1985)) (“Lack of factual support for expert opinion going to factual determinations, however, may render the testimony of little probative value in a validity determination.”); *see also Gen. Elec. Co. v. Joiner*, 522 U.S. 136, 146 (1997) (“[N]othing in either Daubert or the Federal Rules of Evidence requires . . . admit[ting] opinion evidence that is connected to existing data only by the *ipse dixit* of the expert.”).

Meta further objects to Exhibit 2001 under FRE 802, to the extent it relies on other inadmissible exhibits and testimony (as discussed below) for the truth of the matters asserted.

III. EXHIBIT 2003 (DECLARATION OF JUSTIN MARSTON)

Meta objects to paragraphs 3–30 of EX2003 for the reasons below. Further, because remaining paragraphs 1–2 only identify the witness’s name and the date of filing the provisional application, they are irrelevant under FRE 401/402 and the entire declaration should be excluded.

A. Paragraphs 15–30: Improper Expert Testimony Under FRE 702/703

Meta objects to Paragraphs 15–30 of the Declaration of Justin Marston (EX2003) as improper expert testimony offered by an inventor. *See Air Turbine*

Tech., Inc. v. Atlas Copco AB, 410 F.3d 701, 714 (Fed. Cir. 2005) (affirming exclusion of co-inventor’s testimony as improper expert testimony).

There is no evidence that Mr. Marston has personal knowledge regarding the statements in Paragraphs 15–30, was a POSITA at the relevant time, or is even familiar with the knowledge of a POSITA at the relevant time.

Despite this, Mr. Marston makes several statements in Paragraphs 15–30 that are improper expert opinions regarding (1) claim construction (§§15-28), (2) what the patent enables (§30), and (3) whether the claims are “new and nonobvious” (§29).

As to (1), Mr. Marston opines on the claim construction for certain claim terms of the ’217 patent, including what the claims require, whether they provide sufficient structure to perform the claimed functions, and whether the claims could be implemented with standard techniques/off-the shelf systems. EX2003, §§15-18, 19 (“The claim calls out sufficient structure to perform the monitoring action . . .”), 20-28.

As to (2), Mr. Marston improperly opines on what a POSITA would find to be enabling:

The provisional patent application contains an enabling disclosure of the invention. With that disclosure in hand, a person of ordinary skill in the art would be able to practice the claimed invention using tools and techniques that were known or conventional in the art by 2004.

EX2003, ¶30.

As to (3), Mr. Marston improperly opines that the invention was “new and nonobvious”:

A great deal of effort went into the conception and development of the inventions of the ‘217 patent. The invention was new and nonobvious.

EX2003, ¶29.

Patent Owner did not identify Mr. Marston as a technical witness, nor did Mr. Marston’s declaration show that he satisfied the qualifications under FRE 702/703 to provide expert opinions. Because Mr. Marston is a lay witness, the Board should exclude the opinions in Paragraphs 15–30 as improper expert testimony.

B. Paragraphs 15–30: Lack of Foundation

Meta also objects to paragraphs 15–30 for lack of foundation because Mr. Marston failed to provide citations to any evidence or the record tending to show that his statements are true.

For example, Mr. Marston opined on what was known in the art by 2004 but fails to provide any support for said statements. EX-2002, ¶¶15-19. Similarly, Mr. Marston opines, without citation or support, as to whether the claims provide sufficient structure for various limitations, as well as what a POSITA would be able to implement. *Id.*, ¶¶20-28. Finally, Mr. Marston discusses the amount of “effort” that went into the disclosure, (¶29), and that the provisional application contains an

“enabling disclosure” that a POSITA would have been able to practice using “known or conventional” tools in 2004, (¶30), all without providing support for either paragraph. Thus, Patent Owner has presented no testimony or evidence to show that Mr. Marston had the prerequisite knowledge or experience for his testimony; without such a foundation, Mr. Marston’s testimony paragraphs 15–30 should be excluded as irrelevant under FRE 403.

C. Paragraphs 15–30: Undue Prejudice and Waste of Time Under FRE 401/402/403

Meta objects to Paragraphs 15–30 of Mr. Marston’s declaration because, as a non-expert and without support for his statements, his testimony is unduly prejudicial and a waste of time under FRE 401, 402, and 403. To the extent Patent Owner relies on Mr. Marston’s testimony for the purposes of claim construction, Meta objects because courts generally give no deference to inventor testimony as to how a claim term should be construed. *See Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 983 (Fed. Cir. 1995), *aff’d*, 517 U.S. 370 (1996) (*en banc*) (“First, the testimony of Markman [the inventor] and his patent attorney on the proper construction of the claim is entitled to no deference.”); *Convolve, Inc. v. Compaq Computer Corp.*, 812 F.3d 1313, 1319 (Fed. Cir. 2016) (finding that the “post-hoc explanation” of claim scope in an inventor’s declaration was “not enough to overcome the language of the claims and the disclosures in the specification”).

Accordingly, paragraphs 15–30 should be excluded as irrelevant under FRE 401, 402, and 403.

D. Paragraphs 3–14: Lack of Authentication Under FRE 901

Meta objects to Paragraphs 3–14 for failing to provide proper authentication for the referenced exhibits under FRE 901. Mr. Marston relies on these paragraphs to “show the continued work on mathematics for the relevance model,” but fails to provide any testimony sufficient to support a finding that the referenced exhibits are what Mr. Marston claims them to be. Mr. Marston also fails to provide independent evidence sufficient to show what these documents are, who authored them, and how they were created. *See Apator Miitors ApS v. Kamstrup A/S*, 887 F.3d 1293, 1296–97 (Fed. Cir. 2018); *Kolcraft Enterprises, Inc. v. Graco Children’s Prod., Inc.*, 927 F.3d 1320, 1324 (Fed. Cir. 2019). The documents fail to show on their face the information that Mr. Marston claims to be true in his declaration. For example, of the metadata slip sheets provided at the end of the ten exhibits, only EX2009 and EX2013 list who authored the document. Mr. Marston’s declaration thus relies on non-authenticated documents under FRE 901.

E. Paragraphs 3–14: Lack of Corroboration

Meta further objects to paragraphs 3–14 because they lack corroboration of the testimony and documents cited therein. *See NFC Tech. v. Matal*, 871 F.3d 1367, 1371-72 (Fed. Cir. 2017) (discussing “rule of reason” for evaluating corroboration).

Mr. Marston relies on these paragraphs to show conception of “a system with relevance model that includes all features of the claims,” of the ’217 patent. EX2003, ¶14. Though Mr. Marston avers that the referenced documents show the combined work he and his co-inventor Paul Marston performed and the iterative improvements to the claimed relevance model, the documents fail to confirm the facts contained in Mr. Marston’s declaration. For example, Mr. Marston provides no independent testimony or evidence that the exhibits disclose “a system with relevance model that includes all features of the claims.” Meta, thus, objects to paragraphs 3–14 because they have not been corroborated.

F. Paragraphs 4 and 10–11: Hearsay Under FRE 801(c) and 802

Meta further objects to Paragraphs 4 and 10–11 of Mr. Marston’s declaration as hearsay under FRE 801(c) and 802. Mr. Marston states in Paragraph 4 that EX2004 is allegedly “[a]n early document” establishing conception of the claimed features because it describes the basic concepts of creating the BlueSpace Mail Search relevance model. EX-2003, ¶4. For further example, in Paragraphs 10–11, Mr. Marston claims that these documents reflect the math for specific algorithms (e.g., “Aim of Relevance Formula,” “Factors in Relevance Formula,” etc.) and that the documents identify the math as “highly complex,” which he relies on to explain details about the Provisional Application. *Id.*, ¶¶10-11. Thus, Patent Owner appears to rely on these cited exhibits and offer them in evidence for the truth of the matter

asserted therein. Because the statements do not meet any of the conditions of 801(d), Paragraphs 4 and 10–11 should be excluded as hearsay.

IV. EXHIBITS 2004–2014 (ALLEGED EVIDENCE OF CONCEPTION)

A. Lack of Authentication Under FRE 901

Meta objects to EX2004–2014 for lack of authentication under FRE 901. As discussed above regarding EX2003, Patent Owner has presented no evidence or testimony (other than Mr. Marston’s) showing what EX2004–2013 are, who authored them, and how they were created. First, while referencing EX2004, Mr. Marston claims that he and Paul Marston “prepared the Initial Document in August and September 2004.” EX2003, ¶9. But the metadata for EX2004 (as seen in the native version of the file) shows that the “author” is a user named “.” and that another user named “Bal” last edited the document.¹ Neither EX2004 nor its metadata indicate that Mr. Marston or Paul Marston created or edited the file. EX2005–2008 and EX-2010–EX-2012 have similar issues, displaying either (1) an author of “.”, (2) they were last modified by someone other than Mr. Marston (e.g., “bal” or John Fernyhough), or (3) both.

¹ As explained in Petitioner’s Preliminary Reply (Paper 12), Sterling produced native versions of EX2004-EX2013. However, on June 23, 2025, the Board advised that “no additional evidence may be submitted” with Meta’s reply. Paper 11.

Exhibits 2004–2013 are also not the documents that Patent Owner claims them to be. *See* FRE 901. As an example, the native version of EX2010 includes comments and redlines that were not submitted into evidence with EX2010. Therefore, EX2010 is simply not the same document as the native version of EX2010. Similar issues exist for at least EX-2011 and EX-2012. Likewise, the metadata slips attached to each of Exhibits 2004–2013 omit important information from the true metadata records; using EX-2004 as an example, the metadata slipsheet lists a “Custodian” field and “author” field, but it does not include a “Last Modified By” field, as contained in the Natives. For these reasons, Exhibits 2004–2013 are not the documents Patent Owner purports them to be.

Further, EX2014 lacks authentication because it appears to be a claim chart of the Challenged Claims against the alleged conception documents EX2004 and EX2006. Thus, like EX2003, EX2014 improperly incorporates citations to other exhibits that lack authentication. As discussed for EX2004-EX2013, Patent Owner did not indicate who created EX2014, when, and for what purpose. Patent Owner also did not cite EX2014 in either of the declarations submitted with its POPR. *See* EX2001, EX2003. To the extent EX2014 constitutes mere attorney argument, it is not evidence and should be excluded as improper incorporation by reference under 37 C.F.R. § 42.6(a)(3) and FRE 901.

B. Irrelevance and Undue Prejudice Under FRE 401/402/403.**1. Exhibits 2004–2014**

Meta objects to Exhibits 2004–2014 as irrelevant and unduly prejudicial. Each of EX2004–2014 are incorporated by reference into Patent Owner’s Preliminary Response (POPR), which is improper under 37 C.F.R. § 42.6(a)(3). Accordingly, these exhibits are not relied upon for any proper purpose and should be excluded as irrelevant and unduly prejudicial.

2. Exhibit 2014

Meta further objects to Exhibit 2014 as irrelevant and unduly prejudicial because Patent Owner attempts to introduce unsupported expert testimony through EX2014 regarding the inventors’ alleged conception. *See* EX2014 at 1 (“The BlueSpace mail documents reflect that, by at least June 7, 2005, Justin and Paul Marston had conceived of a computer-implemented system for determining a relevance score of a piece of electronic content sent from a sender to a user.”). Thus, because EX2014 lacks foundation and constitutes improper expert testimony under FRE 702/703, it should be excluded as irrelevant and unduly prejudicial.

C. Lack of Completeness Under FRE 106

Because Exhibits 2004–2013 are not the documents that Patent Owner claims them to be, they should be excluded for lack of completeness under FRE 106. The native version of EX2010 includes comments and redlines that Patent Owner did not submit into evidence with EX2010 (pdf), which means that they are not the same

document. Likewise, the metadata slips attached to each of EX2004–2013 omit important information from the true metadata records. Because EX2004–2013 are not the documents Patent Owner purports them to be, they should be excluded as inadmissible under FRE 106 for a lack of completeness.

D. Hearsay

Meta further objects to EX2004–2014 as hearsay under FRE 801(c) and 802 because Patent Owner appears to rely on these documents for the truth of the matter asserted therein.

Date: August 27, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on August 27, 2025 true and correct copies of the foregoing **PETITIONER'S OBJECTIONS TO EVIDENCE** were served via electronic mail upon the following counsel of record for Patent Owner:

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Date: August 27, 2025