

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

META PLATFORMS, INC.,
Petitioners

v.

STERLING COMPUTERS CORPORATION,
Patent Owner.

IPR2025-00430

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

**PETITIONER'S OPPOSITION TO
PATENT OWNER'S MOTION TO EXCLUDE**

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I. INTRODUCTION

Patent Owner (PO) seeks to exclude testimony from its own expert about his understanding of the '217 patent and its claims because that testimony contradicts its attorney arguments about conception documents in EX2014. Setting aside that PO failed to object to the vast majority of this testimony, none of it is specific to conception or PO's conception documents, confirming there is no serious scope objection that justifies excluding this testimony. Moreover, how PO's expert understands the claims and specification of the '217 patent is plainly relevant, both to that expert's credibility and the substantive merits of PO's conception arguments—this testimony is not somehow prejudicial merely because it contradicts PO's arguments about conception. PO's motion should be denied.

II. ARGUMENT

At his deposition in the X IPR, PO's expert testified that several passages in the '217 patent did not disclose the full "identify" limitation, as PO understands the claims, because they did not disclose that the other users needed to be recipients of the same content. EX1044, 114:8-115:20; 123:3-131:21 (discussing EX-1001, 8:23-25, 43:30-37, 12:50-59, 14:45-67). In its Reply, Petitioner argued that this testimony supports that PO's conception evidence, which relies on similar passages to those disclaimed by PO's expert, likewise did not disclose that limitation. Reply, 18-19. As outlined below, this relevant testimony should not be excluded.

A. PO Waived Any Objections to This Cross-Examination Testimony

Although PO claims its counsel “objected repeatedly,” (Motion, 1), the record confirms counsel did not object to the majority of the testimony PO now seeks to exclude. EX1044, 114:8-115:20, 123:3-20, 124:4-126:5, 126:21-127:24, 128:8-131:21; *but see* 37 C.F.R. § 42.64(a) (requiring objections to deposition evidence to be made “during the deposition”); *see also Boehringer Ingelheim Animal Health USA Inc. v. Kan. State Univ. Rsch. Found.*, PGR2020-00076, Paper 42, 44-45 (Jan. 31, 2022) (denying hearsay challenges where party did not raise hearsay objections at deposition). For example, the below shows multiple questions that go to PO’s expert’s understanding of the claims—including whether passages in the specification disclose the full “identify...” limitation—without any PO objections:

124:25-126:5

Q. · You’re saying this portion, 43, 30 through 37, doesn’t disclose both of those ideas?

A. · Yeah

Q. · Later in the patent, outside of column 43, line 30 through 37, they may describe what you’re referring to. · But this portion, 43, lines 30 through 37, does not disclose the full identifying limitation?

A. · They focus on collaborative filtering on the implementation.

129:10-23

Q. · Is column 14, lines 45 through 53, an example of identifying?

A. · Yeah; this is one way you can do it, yes.

Q. · Okay. · And in this example, you can use a tree structure to identify?

A. · Yes; some sort of role base, yeah.

Q. · And so using a tree structure would satisfy both parts of the identifying limitation?

A. · You said tree structure would satisfy?

Q. · Both parts of the identifying limitation?

A. · No. It satisfy only the collaborative by cognate user part. So -- but it doesn't satisfy whether the person will receive the same electronic message or not.

131:9-21

Q. · So column 14, lines 53 through 58, is not an example of the entire identifying limitation, correct?

A. · Yeah; identifying cognate users and the same electronic message, right?

Q. · So column 14, lines 53 through 58, is not an example of the entire identifying limitation, correct?

A. · So identifying means that, right, in this?

Q. · In the claim.

A. · Okay. All right, yeah.

Q. · So column 14, lines 53 through 58, is not an example of the entire identifying limitation, correct?

A. · Correct.

EX1044. PO has thus waived its ability to move to exclude this testimony now.

B. The Objected-To Testimony Does Not Itself Relate to Conception, Eliminating Any “Scope” Objections

PO seeks to exclude its own expert's deposition testimony about the '217 patent's claims and specification—not testimony about conception—because of how Petitioner relies on that testimony in its Reply. Specifically, Petitioner cites that testimony to show that PO's alleged conception documents similarly did not disclose the “identify” limitation. Because that testimony is unrelated to conception, PO's scope objections should be rejected.

PO misrepresents the objected-to testimony to argue it exceeds the scope of its expert's direct testimony because it purportedly relates to conception. Motion, 2

(“[A]ny questioning about the Conception Documents is outside the scope of his direct.”); *but see id.*, 4 (arguing prejudice because “Dr. Khan was not questioned about any of the seven passages in the Conception Documents” (emphasis in original)). To be clear, *none* of the objected-to testimony discusses the conception documents in any way. EX1044, 114:8-115:20; 123:3-131:21. Thus, this testimony does not exceed the scope of PO’s expert’s declaration by virtue of also being relevant to conception.

C. PO’s Expert’s Testimony About the ’217 Patent’s Claims and Specification Is Relevant to PO’s Conception Evidence

PO disputes whether the challenged testimony is relevant, arguing that the passages in the ’217 patent that its expert discussed at his deposition are not actually “similar” to those cited in its conception documents. Motion, 3-4. PO thus takes issue with the sufficiency of the evidence for Petitioner’s argument—i.e., whether PO’s expert’s testimony supports that its conception documents do not disclose the “identify” limitation—which, at most, goes to the weight to be afforded to this testimony, not a reason to exclude it. *See, e.g., ResMed Ltd. v. Fisher & Paykel Healthcare Ltd.*, IPR2016-01724, Paper 50, 31 (Mar. 7, 2018) (declining to exclude “portions of [PO’s Expert’s] deposition testimony [that] d[id] not support Petitioner’s assertions for which they are cited” because these arguments were “directed to the weight and interpretation of the evidence”).

This testimony is appropriate because it explored how PO’s expert

understands the claims. *Samsung Elecs. Co. v. Acorn Semi, LLC*, IPR2020-01279, Paper 55, 47, 49 (Jan. 12, 2022) (permitting cross-examination into expert’s “views concerning the composition of a layer,” including “whether certain metal oxides fall within the scope of the challenged claims,” after expert testified a prior art article “did not teach such distinct layers”); *see also Westinghouse Air Brake Techs. Corp. v. Siemens Mobility, Inc.*, IPR2017-01263, Paper 56, 23-24 (Oct. 24, 2018) (permitting admission of infringement expert report “to show inconsistency between Patent Owner’s arguments”). Throughout this IPR, PO has tried to bolster its patent claims by placing particularly heavy emphasis on the “identify” limitation (1[f]). *See, e.g.*, POR, 18-19 (seeking to construe “recipient” in “identify” limitation), 37 (arguing Rose does not meet “identify” limitation), 51 (same for Dumais). Thus, Petitioner was entitled to cross-examine PO’s expert as to the implications of his understanding of the claims, including whether passages within the ’217 patent disclose the “identify” limitation according to that understanding. *Microsoft Corp. v. Proxyconn, Inc.*, IPR2012-00026, Paper 66, 2 (Nov. 1, 2013) (denying motion to exclude because “[expert’s] testimony that certain prior art does not disclose certain steps such as ‘search,’ opened him to cross-examination on the meaning he attaches to those terms”).

Taking a closer look at the passages in PO’s conception documents helps show why the testimony at issue in PO’s motion is relevant. The below organizes the cross-

examination testimony according to how it relates to the passages in the '217 patent¹:

- EX1044, 114:8-115:20 (discussing EX1001, claim 1);
- EX1044, 124:3-22 (confirming that claim 1 requires “two conditions,” i.e., being cognate and being a “recipient of the same electronic message”);
- EX1044, 124:25-126:5 (agreeing EX1001, 43:30-37’s discussion of ways to identify cognate groups does not “disclose both of those ideas” does not disclose the “full identifying limitation”);
- EX1044, 126:6-20 (agreeing EX1001, 8:23-25’s discussion of “mail data” for “collaborative messages” did not disclose the “identifying limitation”);
- EX1044, 126:21-128:12 (agreeing EX1001, 12:50-59’s discussion—looking to whether users are cc’d on or read global emails—discloses identifying “content relevancy” but is “not an example of identifying”);
- EX1044, 128:13-130:3 (agreeing EX1001, 14:45-67 discusses using a “tree structure” to identify cognate users, without disclosing the “entire identifying limitation”).

Thus, PO’s expert testified that these passages from the '217 patent do not disclose the full “identify...” limitation because they focus only on identifying “cognate” users and do not discuss whether users are “recipients” of the same content.

This testimony supports that PO’s conception documents fail to demonstrate conception because they, likewise, do not disclose the full “identify...” limitation.

¹ At times, PO refers to the “’911 Patent.” Motion, 2, 4. Petitioner assumes these are typographical errors that are meant to refer to the '217 patent, the challenged patent in this IPR.

Specifically, EX2014² cites seven passages from EX2004 and EX2006 to support conception of the “identify...” limitation. EX2014, 5 (citing EX2004 at 4, 13, 15-16 and EX2006 at 22, 58). Each discusses only **(a)** how to identify cognate users—for example, by looking to the “mail actions” of other users (EX2004, 15; EX2006, 58) or using “tree” or “branched” hierarchical structures (EX2006, 22)—or **(b)** evaluating content relevancy—for example, by looking at actions of other users (EX2004, 4) or “scenarios involving other users’ actions” (*id.*, 13, 15-16)—without ever disclosing PO’s expert’s *second* requirement for the “identify” limitation, *i.e.*, making sure that the user is also a “recipient of the same electronic message.” EX1044, 124:3-22.

As a concrete example, PO tries to argue its conception documents discuss the “recipient” limitation by stating that users “read a piece of content sent globally.” Motion, 6 n.3. But this is, word-for-word, precisely the kind of language that its expert confirmed that, in his opinion, *does not* disclose the “identify” limitation. *Compare* EX1001, 12:50-59 (“[I]f the vast majority of the users in a given department *read a piece of content sent globally*, then the content is likely to be

² EX2014 is comprised entirely of attorney argument and should be excluded as improper incorporation by reference, as discussed in Petitioner’s motion to exclude. Paper 38, 1-3.

relevant to another user in that department.”), *with* EX1044, 126:21-128:12 (explaining that 12:50-59 “talks about the content relevancy” and “is not an example of identifying”). Petitioner’s Reply properly criticizes PO for taking positions in one context (conception) that are diametrically opposed to the positions of its expert in another (obviousness and validity).

D. The Objected-To Testimony Is Not Prejudicial Merely Because It Hurts PO’s Conception Arguments

At bottom, the fact that this cross-examination testimony is negative to PO is not a reason to exclude it as prejudicial. *See, e.g., Amazon.com, Inc. v. CustomPlay, LLC*, IPR2018-01496, Paper 34, 56 (Mar. 4, 2020) (“Rule 403 has limited applicability, if any, to bench trials like this proceeding. . . . That Petitioner would rely on the evidence most supportive of its positions is unremarkable and . . . does not form a basis for excluding evidence under the Federal Rules of Evidence.”). PO presents several “prejudice” arguments that do not merit excluding this testimony.

PO argues that this cross-examination testimony is prejudicial because Dr. Khan was not questioned about PO’s conception documents and “none of the cited Conception Document passages is exactly the same as any passage from the ‘217 Patent.” Motion, 4. These passages do not need to be “exactly the same” for Petitioner to explain why PO’s expert’s understanding of the claims are inconsistent with PO’s arguments about its conception evidence. *See* Section II.C. To the extent PO wanted its expert to provide testimony about conception, it could have had its

expert do so (but chose not to).

PO argues it was “deprived of the opportunity to respond by showing that the passages are not actually ‘similar.’” Motion, 4. PO’s argument is incorrect—its own exhibit defines the small universe of passages *that PO cited* to show conception of the “identify” limitation. Petitioner’s Reply, 18-19 (pointing to the passages cited in EX2014, 5 and arguing PO’s expert testimony confirms they “ignore whether such users are ‘recipients’ of the same content”).

PO argues that this testimony is prejudicial because it relies on “**four** ‘217 Patent passages” to rebut discussion from “**seven** passages from the Conception Documents.” Motion, 5 (emphasis in original). The *number* of passages is entirely irrelevant to the substance contained in those passages, which the Board is more than capable of evaluating.

III. CONCLUSION

For these reasons, Patent Owner’s Motion to Exclude should be denied.

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on April 29, 2026 true and correct copies of the foregoing
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