

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FOURSQUARE LABS, INC.,

Petitioner,

v.

BOARDACTIVE CORPORATION,

Patent Owner.

U.S. PATENT NO. 10621620 B1

**Title: PLATFORM FOR LOCATION AND TIME BASED
ADVERTISING**

IPR2023-00918

PATENT OWNER'S MOTION TO EXCLUDE

37 C.F.R. §§ 42.62 & 42.64(c)

TABLE OF CONTENTS

TABLE OF CONTENTS.....	i
TABLE OF AUTHORITIES	ii
I. INTRODUCTION	1
II. CONCLUSION.....	2

TABLE OF AUTHORITIES

Rules

Federal Rules of Evidence 402	1
Federal Rules of Evidence 403	1

I. INTRODUCTION

Patent Owner (PO) objects (Paper No. 10) to Petitioner's Expert Declaration of Dr. Steven Goldberg (Exhibit 1002) under Federal Rules of Evidence 402 and 403 because paragraphs 90-91 and 239-420 refer to a patent not at issue in the current IPR (IPR2023-00918). Therefore, those paragraphs should be excluded.

Petitioner's Expert Declaration of Dr. Steven Goldberg (Exhibit 1002), paragraphs 88-89 and 93-238 refer to US Patent No.10,692,108, which is not at issue in the current IPR, but rather is the subject of IPR2023-00919. Placing such testimony referring to multiple "Patents-in-Suit" in the record for this IPR is prejudicial and irrelevant. Therefore, those paragraphs should be excluded.

Dr. Goldberg's Declaration improperly states that both the '620 and '108 patents are the "Patents-In-Suit." Ex. 1002, p.4. The Declaration states that "a POSITA would have been capable of understanding the Patents-in-Suit and the prior art references discussed herein." Ex. 1002, p13. In other words, his opinions are not based on the '620 patent only, despite it being the only patent at issue. The Expert is improperly making assertions about multiple "Patents-in-Suit" when only one patent is at issue and is therefore the only patent that is relevant. Throughout the Declaration, reference is made to "Patents-in-Suit" or "this Petition." It is unclear which petition is being referred to by "this Petition." There is no single

petition for the “Patents-in-Suit,” and there are not multiple patents at issue in “this Petition.” It is not the Board’s job or the PO’s job to discern which part of “this declaration” is used for which one of the “Patents-in-Suit,” and which IPR is the correct IPR.

In an email dated July 31, 2024, the Board requested a response from the parties as to whether the two IPRs should be heard together. Petitioner and PO were in agreement “and jointly propose that independent hearings being held for the -00918, and -00919 proceedings, in series, in that order, for the sake of avoiding confusion of the issues.” See Email to Board, July 21, 2024.

For the same reason, to avoid confusion, the paragraphs of the Declaration of Dr. Steven Goldberg (Exhibit 1002) that fail to distinguish between the IPR Petitions should be excluded.

The PO is prejudiced by an Expert declaration presenting “Patents-in-Suit” when only one patent is at issue in IPR2023-00918. As Petitioner admits, confusion can occur if IPR2023-00918 and IPR2023-00919 are discussed together.

II. CONCLUSION

For the above reasons, PO requests that Exhibit 1002 be excluded.

August 8, 2024

Respectfully submitted,

Meredith Martin Addy /

Meredith Martin Addy
Reg. No. 37,883
meredith@addyhart.com

ADDYHART P.C.
10 Glenlake Parkway, Suite 130
Atlanta, Georgia 30328
312.320.4200

Robert Hart
Reg. No. 35,184
robert@addyhart.com

Gregory B. Gulliver
Reg. No. 44,138
gbgulliver@addyhart.com

ADDYHART P.C.
401 N. Michigan Ave., Suite 1200-1
Chicago, Illinois 60611
312.834.7701

Counsel for Patent Owner
BoardActive Corporation

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies the service of Patent Owner BoardActive Corporation served Patent Owner's Motion to Exclude on the counsel of record for Petitioner Foursquare Labs, Inc. by filing this document through the P-TACTS, as well as delivering a copy via electronic mail to the following:

Michael.Carrillo@btlaw.com

Steven.Shipe@btlaw.com

Date: August 8, 2024

By: *Meredith Martin Addy*
Meredith Martin Addy