

Paper No. 20
Date: August 15, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FOURSQUARE LABS, INC.,
Petitioner,

v.

BOARDACTIVE CORPORATION,
Patent Owner.

IPR2023-00918

U.S. Patent No. 10,621,620 B1

OPPOSITION TO PATENT OWNER'S MOTION TO EXCLUDE
37 C.F.R. § 42.64(c)

OPPOSITION TO PATENT OWNER'S MOTION TO EXCLUDE

Pursuant to 37 C.F.R. §§ 42.62 & 42.64(c), Petitioner, Foursquare Labs, Inc. opposes Patent Owner's motion to exclude Exhibit 1002 from the proceedings in this *inter partes* review. Patent Owner's issues with Exhibit 1002 are hollow, and lack sufficient basis in the record. Nevertheless, Patent Owner has failed to demonstrate its accusations that relevance is lacking or that the document is otherwise unhelpful.

I. EXHIBIT 1002 – DECLARATION OF DR. STEVEN GOLDBERG

Patent Owner argues that Dr. Goldberg's declaration is irrelevant to the proceeding because he considered the '620 Patent together with its child U.S. Patent No 10,692,108 (the "108 Patent"). Notably, at the time of the Petition, Patent Owner maintained a lawsuit asserting both the '108 Patent and the '620 Patent, and hence both were "in-suit" at the time of the Petition. That underlying lawsuit has now been entirely dismissed as two of Patent Owner's related family member patents were invalidated early in the proceeding. *BoardActive Corp. v. Foursquare Labs, Inc.*, No. 1:22-CV-00597-JDW, 2023 WL 2587688, at *6 (D. Del. Mar. 21, 2023).

A. Patent Owner Failed To Maintain Sufficient Objection For Its Motion as to Exhibit 1002.

Patent Owner points to its objection but immediately cites to sections of Exhibit 1002 never mentioned in its objections. Paper 19, p. 1. Patent Owner also

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never before identified the term “Patents-in-suit” which it now believes makes unclear Dr. Goldberg’s statements. Indeed, Patent Owner did not even identify where the mention of the ‘108 Patent, the Petition, or the Declaration overall would have been unclear as it now asserts. Moreover, Patent Owner has failed to demonstrate that merely mentioning alleged clarity concerns can identify the grounds for the objection with sufficient particularity, as required by Rule 42.64(b)(1). Therefore, Patent Owner’s objections were insufficient to support its motion as to Exhibit 1002. 37 C.F.R. § 42.64(c), which is now untimely as a result.

B. Patent Owner’s Fails To Apply the Correct Standard.

Nevertheless, Patent Owner’s motion fails to demonstrate a lack of relevance under the Federal Rules of Evidence 401, 402, 403. Indeed, even assuming *arguendo* the truth of its allegations that any particular statement might be read to include consideration of the ‘108 Patent, Patent Owner has failed to support why this would make the document lack relevance to this -00918 proceeding. For example, interpretation and/or consideration of the family member patents is routinely to proper understanding. Similarly, Patent Owner fails to demonstrate any prejudice, let alone prejudice that outweighs the strong substantive value of Dr. Goldberg’s declaration.

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To the extent that Patent Owner alleges that any issue of clarity exists as to Dr. Goldberg's testimony, Patent Owner has failed to link such allegations to relevant evidentiary concerns, under the applicable Federal Rules of Evidence standards. Moreover, Patent Owner's reliance on the party's joint election to maintain separate oral hearings disregards the additional briefings since the time of the Declaration, including Patent Owner's contribution to those briefings.

Accordingly, Patent Owner has failed to demonstrate its burdens for exclusion of Exhibit 1002.

II. CONCLUSION

Patent Owner has failed to maintain a proper basis for its motion with respect to Exhibit 1002, by failing to timely and sufficiently object to the issues on the basis it now argues. Nevertheless, its arguments in support of its motion are well short of demonstrating inadmissibility or prejudice. For at least these reasons, Patent Owner's motion should be denied.

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Respectfully submitted,

Date: August 15, 2024

/ Steven D. Shipe /

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on this 15th day of August 2024, I caused a true and correct copy of the foregoing
OPPOSITION TO PATENT OWNER'S MOTION TO EXCLUDE in IPR2023-
00918 to be served on Patent Owner via electronic mail at the following addresses
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Date: August 15, 2024

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