

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. 10,692,108 B1

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

IPR2023-00919

**PATENT OWNER'S OBJECTIONS TO PETITIONER'S PETITION
AND EXPERT DECLARATION
UNDER 35 U.S.C. § 42.107**

Petitioner Foursquare Labs, Inc. (“Foursquare” or “Petitioner”) filed a Petition for *Inter Partes* Review of U.S. Patent No. 10,692,108 (the “’108 patent”) on May 9, 2023. (IPR2023-00919, Paper No. 1 (“Petition”)). on May 9, 2023. (IPR2023-00919, Paper No. 1 (“Petition”)). The Board instituted the IPR on November 29, 2023. Patent Owner objects to evidence submitted during the preliminary phase of this IPR under 35 U.S.C. § 42.64(b)(1).

Patent Owner Objects to the petition for failing to meet the particularity requirement of 35 U.S.C. § 312(a)(3) and 37 C.F.R. § 42.104(b)(4). The Petition utilizes confusing conjunctive and alternative combinations of the references in the asserted Grounds, and it uses string citations throughout with little or no explanatory parentheticals. This lack of particularity adversely affects the ability of the Patent Owner to respond to the issues raised by the Petitioner. For these reasons, the Petition also fails to meet the requirement of the PTAB’s Trial Practice Guide, which advises to “avoid submitting a repository of all the information that a judge could possibly consider, and instead focus on concise, well-organized, easy-to-follow arguments supported by readily identifiable evidence of record.” PTAB’s Consolidated Trial Practice Guide, p. 39 (Nov. 2019).

Patent Owner Objects, under Federal Rules of Evidence 402 and 403, to Petitioner using the wrong standard for determining the claim’s meaning: “Petitioner believes that the constructions of terms can be appreciated from their overall

discussion herein...” Pet. 4. Title 35 U.S.C. § 282(b) requires “construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.” 37 C.F.R. § 42.100(b). Petitioner’s improper method of construction ignores these instructions and ignores the prosecution history of the ’108 patent.

Patent Owner Objects to the Petitioner’s Expert Declaration of Dr. Steven Goldberg (Exhibit 1002) under Federal Rules of Evidence 402 and 403. The Declaration paragraphs 88-89 and 93-238 seem to be referring to a patent that is not at issue in the current IPR.

Date: December 12, 2023

/s/ *Meredith Martin Addy*

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies service of Patent Owner BoardActive served this PATENT OWNER'S OBJECTIONS TO PETITIONER'S PETITION AND EXPERT DECLARATION on the counsel of record for Petitioner Foursquare, Inc. by filing this document through the P-TACTS, as well as delivering a copy via electronic mail to the following:

Michael A. Carrillo
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Date: December 12, 2023

By: /s/ *Meredith Martin Addy*
Meredith Martin Addy