

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 MOTION TO EXCLUDE

37 C.F.R. §§ 42.62 & 42.64(c)

TABLE OF CONTENTS

TABLE OF CONTENTS.....	ii
TABLE OF AUTHORITIES	iii
I. INTRODUCTION	1
A. Petitioner’s Expert Declaration of Dr. Steven Goldberg (Exhibit 1002) Improperly Relies on Multiple “Patents-in-Suit,” Despite Only One Patent Being at Issue in this IPR	1
B. Petitioner’s Supplemental Declaration of Dr. Steven Goldberg (Exhibit 1009) Draws an Improper Legal Conclusion.....	3
II. CONCLUSION.....	4

TABLE OF AUTHORITIES

Cases

<i>In re Lee</i> , 277 F.3d 1338 (Fed. Cir. 2002).....	4
---	---

Rules

Federal Rules of Evidence 401	1
Federal Rules of Evidence 402	1
Federal Rules of Evidence 403	1

I. INTRODUCTION

Patent Owner (PO) objects (Paper No. 9) to Petitioner's Expert Declaration of Dr. Steven Goldberg (Exhibit 1002) under Federal Rules of Evidence 401, 402, and 403 because, at least, paragraphs 88-89 and 93-238 refer to a patent not at issue in the current IPR and therefore, should be excluded.

PO also objected (Paper 13) to Petitioner's Supplemental Declaration of Dr. Steven Goldberg (Exhibit 1009) under Federal Rules of Evidence 402, and 403 because it improperly draws a legal conclusion as to the admissibility of PO's evidence. An expert witness is not qualified to opine on matters of law and, therefore, those opinions should also be excluded.

A. Petitioner's Expert Declaration of Dr. Steven Goldberg (Exhibit 1002) Improperly Relies on Multiple "Patents-in-Suit," Despite Only One Patent Being at Issue in this IPR

Petitioner's Expert Declaration of Dr. Steven Goldberg (Exhibit 1002), paragraphs 88-89 and 93-238 refer to US Patent No. 10,621,620, which is not at issue in the current IPR, but rather is the subject of IPR2023-00918. Placing such testimony in the record for this IPR is prejudicial and irrelevant.

Dr. Goldberg's declaration states that both the '620 and '108 patents are the "Patents-In-Suit." Ex. 1002, p.3. 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, p.12. The Expert admits that his “opinions have considered the actual language as listed within the patent documents themselves.” Ex. 1002, ¶ 92. Therefore, his opinions are not based on the ’108 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 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 the Expert is referring to by “this Petition,” which prejudices PO’s ability to respond. 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.

Just as previously agreed for oral hearings, to avoid confusion, the parties’ written submissions should treat the Petitions as separate and distinct as well. Because they fail to do so, the paragraphs or Dr. Goldberg’s declaration that treat the IPRs as one in the same should be excluded.

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

B. Petitioner’s Supplemental Declaration of Dr. Steven Goldberg (Exhibit 1009) Draws an Improper Legal Conclusion

Patent Owner Objects to the Petitioner’s Supplemental Declaration of Dr. Steven Goldberg (Exhibit 1009) under Federal Rules of Evidence 402 and 403. Paragraph 3 of The Declaration (Ex. 1009, 1-2) because it draws a legal conclusion as to the sufficiency of the reference to be relied on in violation of FRE Rule 702.

In paragraph 3 of the Declaration, the Expert states:

it is unclear to me that there is sufficient support that Exhibit 2003 is actually a technically valid source to rely on.

Ex. 1009, ¶ 3. That is the wrong legal standard and conclusion. Exhibit 2003 is a printed publication that is publicly available. The Expert ignores those facts and asserts that:

a POSITA would not understand this document to provide reliable real-world, actively used or leveraged technology, and cannot and should not be relied upon for valid assertions of GSM implementations and certainly not in the IPR2023-00919.

Id. Using this standard, the expert should have found all the references asserted by Petitioner that were not implemented as not to be relied upon by a POSTIA.

The Federal Circuit has recognized the principle that technical expertise is not a substitute for prior art evidence. *See, e.g., In re Lee*, 277 F.3d 1338, 1344-45 (Fed. Cir. 2002) (agency expertise is not evidence, and cannot serve as a substitute for evidence). Paragraphs 4-13 of Exhibit 1009 are irrelevant and prejudicial, confuse the issues, and a waste of time, as they relate to cell reuse pattern. Cell reuse pattern is a different issue from cell selection. Cell reuse is reusing radio frequencies in cells so as not to interfere with neighboring cells. Cell selection is selecting which cell to handoff to when leaving a cell or selecting a service. *See* Paper 11, p.56 (citing Ex. 2003, “Section 6.6 of TS 45.008, titled “Measurements for Cell Reselection”). Petitioner’s Expert is not authorized to draw such legal conclusions, and here they are factually incorrect.

II. CONCLUSION

For the above reasons, PO requests that the identified portions of Exhibits 1002 & 1009 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