

Paper No. 21
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.

IPR2023-00919

U.S. Patent No. 10,692,108 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 Exhibits 1002 and 1009 from the proceedings in this *inter partes* review. Patent Owner's issues with Exhibits 1002 and 1009 are hollow, and in any case are insufficiently maintained by lacking sufficient basis in the record. Nevertheless, Patent Owner has failed to demonstrate its accusations that relevance is lacking or that the documents are 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 '108 Patent together with U.S Patent No 10,621,620 (the "'620 Patent'") which is the parent patent from which the '108 Patent's underlying continuation application was originally filed. 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).

*OPPOSITION TO PATENT OWNER'S MOTION TO EXCLUDE***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 20, pp. 1-2. Patent Owner also 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 ‘620 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 parent ‘620 Patent, Patent Owner has failed to support why this would make the document lack relevance to this -00919 proceeding. For example, as a parent to the ‘108 Patent, interpretation and/or understanding of the

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parent is relevant to understanding the child. Similarly, Patent Owner fails to demonstrate any prejudice, let alone prejudice that outweighs the strong substantive value of Dr. Goldberg's declaration.

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. EXHIBIT 1009 – SUPPLEMENTAL DECLARATION OF DR. STEVEN GOLDBERG

Patent Owner argues that Dr. Goldberg's supplemental declaration, Exhibit 1009, is irrelevant to the proceeding because he allegedly draws a legal conclusion, and further because that conclusion allegedly violates FED R. EVID. 702. Yet, Patent Owner itself applies the wrong legal standard in asserting that improper legal conclusions were drawn. Nevertheless, Patent Owner is simply wrong where Dr. Goldberg opined only on the technical sufficiency of Exhibit 2003 in light of

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self-depreciating statements that the document is unapproved and shall not be implemented.

A. Patent Owner Failed To Maintain Sufficient Objection For Its Motion as to Exhibit 1009.

Patent Owner points to its objections but only to allege that improper conclusions are drawn and that “paragraphs 4-13 be (sic) irrelevant and prejudicial, confusing the issues, and wasting time.” However, Patent Owner has failed to demonstrate that merely mentioning that any conclusion has been drawn can identify the grounds for the objection with sufficient particularity, as required by Rule 42.64(b)(1). Moreover, Patent Owner fails to make any statement why paragraphs 4-13 of Exhibit 1002 would be irrelevant or prejudicial. Therefore, Patent Owner’s objections were insufficient to support its motion as to Exhibit 1002, which is now untimely as a result. 37 C.F.R. § 42.64(c).

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

Patent Owner’s motion fails to demonstrate a lack of relevance under the Federal Rules of Evidence 401, 402, 403. Initially, Patent Owner fails to explain why Dr. Goldberg’s opinion that “it is unclear [] that there is sufficient support that Exhibit 2003 is actually a technically valid source to rely on,” is anything beyond his expert opinion. Namely, Dr. Goldberg’s opinion that Exhibit 2003’s self-depreciating statements that the document is unapproved and “shall not be

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implemented” merely demonstrates that these statements raise serious questions about the technical information therein. Even if Dr. Goldberg draws a conclusion, Patent Owner fails to explain why this is not relevant at least for its technical weight. But moreover, Rule 702, as Patent Owner relies on, makes no mention of any restriction on opinions merely because they concern an ultimate issue. Indeed, Rule 704 does just the opposite, stating explicitly “Opinion on an Ultimate Issue (a) In General—Not Automatically Objectionable. An opinion is not objectionable just because it embraces an ultimate issue.” (emphasis added). Thus, Patent Owner has failed to even attempt to demonstrate its case, but regardless fails entirely on the law which directly refutes Patent Owner’s positions.

Accordingly, Patent Owner has failed to demonstrate its burdens for exclusion of Exhibit 1009.

III. CONCLUSION

Patent Owner has failed to maintain a proper basis for its motion with respect to each of Exhibits 1002 and 1009, by failing to timely and sufficiently object to the issues on the basis it now argues. Nevertheless, its arguments in support of its motion concerning each exhibit are well short of demonstrating inadmissibility or prejudice, and often misapply the law altogether. 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-
00919 to be served on Patent Owner via electronic mail at the following addresses
of record:

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Date: August 15, 2024

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