

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 REPLY TO PETITIONER'S OPPOSITION TO
PATENT OWNER'S MOTION TO EXCLUDE**

37 C.F.R. §§ 42.62 & 42.64(c)

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I. INTRODUCTION

Petitioner makes general statements regarding Patent Owner's objections raised in Patent Owner's Motion to Exclude, but Petitioner fails to address the substance of the objections in its "Opposition to the Patent Owner's Motion to Exclude." Paper 21.

II. EXHIBIT 1002 – DECLARATION OF DR. GOLDBERG

A. Petitioner Makes Multiple Misrepresentations

Dr. Goldberg's declaration is both irrelevant and improper, as it imports bias into the case. Petitioner not only admits that Dr. Goldberg considered both the '108 and '620 patent together, Paper 21, p. 1, Petitioner asserts for the first time in its Response to Patent Owner's Motion to Exclude that the "underlying lawsuit" and its five patents were also considered by Dr. Goldberg in making his analysis. *See Id.*

Petitioner's argument fails because it is supported by false statements. First, Petitioner argues that "at the time of the Petition, Patent owner maintained a lawsuit asserting both the '108 Patent and '620 Patent, and hence both were 'in-suit' at the time of the Petition." (Paper 9, p. 1). This statement is simply false. Petitioner filed its Petition on May 9, 2023 (Paper 1), *after* PO voluntarily withdrew its Complaint on May 4, 2023. Petitioner's misrepresentations to the Board aside, the facts of record show that at the time of the petition, there was no "underlying lawsuit."

Petitioner's reliance on the district court matter is particularly egregious, as it misrepresents the nature of the proceedings and the ultimate outcome of that case. Specifically, Petitioner asserts that the "underlying lawsuit has now been entirely dismissed as two of Patent Owner's related family member patents were invalidated early in the proceeding." Paper 21, p.1. This statement is also false. Patent Owner voluntarily withdrew its Complaint prior to an answer being filed, and the purported "invalidated" patents remain in force. Petitioner nevertheless hangs its hat on this misrepresentation.

Additional misrepresentations are found in Dr. Goldberg's Declaration. Nowhere in Dr. Goldberg's First Declaration, Exhibit 1002, did he disclose that he was reviewing or considering the dismissed lawsuit. *See* Ex. 1002, ¶16. Such consideration of challenges in different forums imports bias and is improper. *See Prolitec Inc. v. Scentair Techs.*, Civil Action 20-984-WCB, at *11 (D. Del. Aug. 8, 2023) ("The district court erred as a matter of law to the extent that it decided to 'review' the PTAB's determination that the claims of the '413 patent are more likely than not invalid") (citing *Ethicon, Inc. v. Quigg*, 849 F.2d 1422 (Fed. Cir. 1988)). This fact alone is a basis for the Board to exclude the declaration because we do not know the documents upon which Dr. Goldberg's opinions are based, and whether he was biased by reading court proceedings related to other patents. Patent Owner has only learned of this in Petitioner's Paper 21 (Opposition to this Motion to Exclude)

and, since discovery is closed, can take no action to determine what was relied on by Dr. Goldberg.

B. Patent Owner Properly Objected to Exhibit 1002

PO timely objected with clarity to Exhibit 1002 and raised the issue of a patent not part of this proceeding being opined upon by Dr. Goldberg. *See* Paper 9, p.3. The patent that is not part of this proceeding is referred to in Exhibit 1002 as “Patents-in-suit” by Dr. Goldberg.

Petitioner’s argument that PO failed to object to Dr. Goldberg’s reliance on the ’620 patent also fails. According to Petitioner, PO’s objection is improper because it does not identify the term “Patents-in-Suit.” (Paper 21, 2). As explained above, there were no “Patents-in-Suit.” As such, PO objected on the basis that the Declaration relies on “a patent that is not at issue in the current IPR.” (Paper 9, p. 3). Despite Petitioner’s argument, there is no dispute that Dr. Goldberg’s use of the term “Patents-in-Suit” refers to the ’108 and ’620 patents. Nor is there a dispute to the fact that only the ’108 Patent is at issue here.

Therefore, Petitioner’s assertion otherwise is without merit and baseless.

III. EXHIBIT 1009 – SUPPLEMENTAL DECLARATION OF DR. GOLDBERG

PO timely and properly objected to Exhibit 1009. *See* Paper 13. Petitioner, in its Opposition, Paper 21, reiterates Dr. Goldberg’s position that PO’s Exhibit 2003

should be excluded as it was labeled as “shall not be implemented.” *See* Paper 21, p. 4-5 (*citing* Ex. 1009). However, Dr. Goldberg identifies no technical deficiencies with the technology and approaches provided in Exhibit 2003. Because no technical deficiencies are identified in Exhibit 1009 to support his opinion, Dr. Goldberg’s opinion lacks support, and Exhibit 2003 should be excluded. Finally, as set forth in PO Surreply, Paper 15, pp. 11-12, the “Change History” of Ex. 2003, pp. 103-107, the portion relied upon by PO is identical to the version that was implemented. As such, Dr. Goldberg’s concerns are moot.

IV. CONCLUSION

For the above reasons, the PO requests that Exhibits 1002 & 1009 be excluded.

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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 Reply 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 22, 2024

By: *Meredith Martin Addy*
Meredith Martin Addy