

Paper No. _____

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

THE UNITED STATES POSTAL SERVICE (USPS)
AND THE UNITED STATES OF AMERICA,
AS REPRESENTED BY THE POSTMASTER GENERAL
Petitioner,

v.

RETURN MAIL, INC.
Patent Owner.

Case CBM2014-00116
Patent 6,826,548

**PATENT OWNER RETURN MAIL, INC.'S OBJECTIONS TO
PETITIONER'S EVIDENCE**

PATENT OWNER'S OBJECTIONS TO PETITIONER'S EVIDENCE

Patent Owner Return Mail, Inc. ("RMI") hereby objects to the admissibility of the evidence cited in support of the Petition (Paper 2). As set forth with particularity below, RMI's objections are based on the Federal Rules of Evidence, relevant case law and the Board's Rules governing the present covered business method patent review of U.S. Patent No. 6,826,548 ("the '548 patent").

Exhibit 1008

In accordance with Bd. R. 42.64, RMI objects to Exhibit 1008 (Declaration of Joe Lubenow) on the following grounds. Generally, Patent Owner objects based on FRE 104(a), 104(b), 401-403, 601-602, and 701-703 because Lubenow's testimony is largely based on information from counsel, adopts incorrect claim constructions, and consists of conclusory statements that the elements of Claims 39-44 of the '548 patent are contained in the prior art reference 1997 ACS (Exhibit 1004).

Patent Owner objects to Exhibit 1008 under FRE 401-403 as containing irrelevant information that is not admissible. More specifically, ¶¶ 36-68 relate to Petitioner's impermissible broadening argument, which is not one of the grounds at issue in this proceeding. Further, ¶¶ 70-83 relate to Petitioner's proposed claim constructions, which were not adopted by the Board. Also, the following paragraphs relate to prior art and/or grounds not at issue in this proceeding: ¶¶ 84, 86-170, 237-305.

Patent Owner objects to Exhibit 1008 under FRE 702 because it will not assist the Board in understanding the evidence or determining facts at issue. Further, the opinions in Exhibit 1008 are not based on sufficient facts or data. For example, many of the citations to 1997 ACS (Exhibit 1004) are incorrect, incomplete, or taken out of context. Further, there is no explanation provided as to how Lubenow reaches his conclusions. His opinions are not the product of reliable principles or methods, and he did not apply any reliable principles or methods to the facts. Additionally, many of his opinions throughout the background sections and the discussion of 1997 ACS are conclusory.

Patent Owner also objects to Exhibit 1008 under FRE 702 because Lubenow is not qualified to act as an expert in this case. There is no indication that he has the experience or qualifications to provide expert testimony on the grounds at issue in this proceeding.

Patent Owner objects to Exhibit 1008 under FRE 703 because of Lubenow's reliance on Exhibits 1003, 1018, and 1019, which are inadmissible themselves, as discussed below.

Further, Patent Owner objects to ¶ 3 of Exhibit 1008 under FRE 104, 401-403, 601-602, and 701-703. Patent Owner objects to ¶¶ 4-8 of Exhibit 1008 under FRE 104, 601-602, and 702-703 because there is an inadequate foundation for his testimony as an expert in this proceeding. Patent Owner objects to ¶¶ 27-30 of Exhibit 1008 under FRE 104, 401-403, 601-602, and 701-703 because they include

opinions that rely on claim constructions that are contrary to the claim constructions adopted by the Board. Patent Owner objects to ¶¶ 32-35 of Exhibit 1008 under FRE 104, 401-403, 601-602, and 701-703. Based on the Board's decision, any opinions within these paragraphs are irrelevant. Further, these opinions rely on claim constructions contradicted by the Board's claim construction adoption, and they include opinions that Lubenow is not qualified to testify about as an expert. Patent Owner objects to ¶¶ 36-68 of Exhibit 1008 under FRE 104, 401-403, 601-602, and 701-703. Based on the Board's decision, any opinions within these paragraphs are irrelevant. Further, these opinions rely on claim constructions contradicted by the Board's claim construction adoption, and they include opinions that Lubenow is not qualified to testify about as an expert. Patent Owner objects to ¶ 69 of Exhibit 1008, regarding person of ordinary skill in the art, under FRE 104, 401-403, 601-602, and 701-703. Lubenow's opinion on this topic is not based on any facts or bases, and there is no explanation as to how he arrived at this opinion. Patent Owner objects to ¶¶ 70-83 of Exhibit 1008 under FRE 104, 401-403, 601-602, and 701-703. As stated above, Lubenow's opinions on claim construction are irrelevant and contradicted by the Board's claim construction.

Exhibit 1018

Patent Owner objects to Exhibit 1018 (United States Postal Service's Redirection History) because it is inadmissible hearsay under FRE 802, and it is not authenticated under FRE 901. Further, it is irrelevant under FRE 401-403.

Exhibit 1019

Patent Owner objects to Exhibit 1019 (Move Update, April 1997) because it is inadmissible hearsay under FRE 802, and it is not authenticated under FRE 901. Further, it is irrelevant under FRE 401-403.

Exhibits 1003, 1005, 1006, 1007, 1013, and 1014

Patent Owner objects to the following exhibits as irrelevant under FRE 402 because they relate to grounds not at issue in this proceeding: Exhibits 1003, 1005, 1006, 1007, 1013, and 1014.

These objections are being timely served within ten business days of initiation of this CBM proceeding and the granting, in part, of the Petition (Paper 2), to which the evidence objected to above was attached.

Respectfully submitted,

Dated: October 30, 2014

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