

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 REPLY EXHIBITS**

PATENT OWNER'S OBJECTIONS TO PETITIONER'S REPLY EXHIBITS

Patent Owner Return Mail, Inc. hereby objects to the admissibility of the exhibits cited in support of Petitioner's Reply (Paper 22).¹ As set forth with particularity below, Patent Owner'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 1025

Patent Owner objects to Exhibit 1025 (Auxiliary Markings Newsletter) because it is inadmissible hearsay under FRE 802. Further, it is not the best evidence under FRE 1002 and FRE 1004, and it is inadmissible under FRE 601-603 and 701-703 regarding the article cited by Petitioner and authored by Michael M. Ludeman.

EXHIBIT 1026

Patent Owner objects to Exhibit 1026 because it is inadmissible hearsay under FRE 802. Further, it is not the best evidence under FRE 1002 and FRE 1004, and it is inadmissible under FRE 601-603 and 701-703 regarding the article cited by Petitioner and authored by Randall Root and Edward J. Kuebert. Additionally, Patent Owner objects to this copy of the article because it has hand-written comments and underlining, which are inadmissible under FRE 401-403.

¹ To the extent Patent Owner has already objected to any of the exhibits cited by Petitioner, Patent Owner maintains those objections.

EXHIBIT 1028

In accordance with Bd. R. 42.64, Patent Owner objects to Exhibit 1028 (Supplemental Declaration of Joe Lubenow) on the following grounds. Generally, Patent Owner objects based on FRE 104(a), 104(b), 401-403, 601-602, 701-703, and 802 because Lubenow's opinions are not based on sufficient facts or data, lack explanations, and will not assist the Board. Further, Lubenow expresses opinions beyond the proper scope of a reply declaration and suggests irrelevant and incorrect constructions for terms.

Patent Owner objects to Exhibit 1028 under FRE 104(a), 601-603, and 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 prove expert testimony on the grounds at issue in this proceeding.

Patent Owner objects to Exhibit 1028 under FRE 104, 601-602, and 702-703 because there is an inadequate foundation for his testimony as an expert in this proceeding. Throughout each section in which Lubenow provides opinion testimony, he expresses opinions or states conclusions, which are not supported. Many of his statements have no support, and to the extent there are any references cited, they cited materials do not support Lubenow's opinions or conclusions. This applies to each section of Lubenow's Reply Declaration. Further, Lubenow continually fails to provide explanations as to how the citations support his opinions or conclusions. In fact, many of Lubenow's opinions are not based on any facts or bases.

Patent Owner also objects to Exhibit 1028 under FRE 401-403 because Lubenow's testimony regarding ZIP codes in Paragraph 14 is irrelevant. Additionally, Patent Owner objects to Lubenow's reliance on inadmissible materials in Paragraph 34. More specifically, Lubenow relies on Exhibits 1018 and 1025, which are not admissible.

Additionally, Patent Owner objects to Paragraphs 11-21 and 26 of Exhibit 1028 because they include testimony that belatedly presents new arguments for establishing a *prima facie* case. This violates 37 C.F.R. § 42.23(b), and it is further supported by *The Scott Company LLC v. Encap, LLC*, IPR2013-00110, Paper 79, at 7.

These objections are being timely served within five business days of filing and service of Petitioner's Reply and its attached exhibits.

Respectfully submitted,

Dated: February 24, 2015

/Douglas H. Elliott/
Douglas H. Elliott (Reg. No. 32,982)
THE ELLIOTT LAW FIRM, PLLC
6750 West Loop South, Suite 920
Bellaire, Texas 77401
(832) 485-3508
(832) 485-3511 fax
delliott@elliottiplaw.com

Attorney for Patent Owner

CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing Patent Owner Return Mail, Inc.'s Objections to Petitioner's Reply Evidence was served on February 24, 2015, by FEDERAL EXPRESS standard overnight shipping to the following attorneys of record for Petitioner as well as by electronic service at the e-mail address listed below.

Lionel Lavenue
Erika H. Arner
Finnegan, Henderson, Farabow, Garrett & Dunner LLP
Two Freedom Square
11955 Freedom Drive
Reston, VA 20190

Elizabeth D. Ferrill
Joshua L. Goldberg
Finnegan, Henderson, Farabow, Garrett & Dunner LLP
901 New York Avenue, NW
Washington, DC 20001

USPS-RMI-CBM@finnegan.com

/Douglas H. Elliott/
Douglas H. Elliott
Registration No. 32,982
Attorney for Patent Owner