

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
MOTION TO EXCLUDE**

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I. INTRODUCTION

Petitioner's proffered expert, Dr. Joe Lubenow, offers opinions that are unreliable and that would not help the Board "understand the evidence or to determine a fact in issue." FED. R. EVID. 702. Patent Owner Return Mail, Inc. moves pursuant to 37 C.F.R. § 42.64(c) to exclude Dr. Lubenow's opinions in Exhibit 1008, 1022 and 1028. Patent Owner also moves to exclude Exhibits 1003, 1005, 1006, 1007, 1013, 1014, 1018, 1019, 1022, 1025, and 1026.

In accordance with 37 C.F.R. § 42.64(b)(1), Patent Owner timely served its objections on October 30, 2014 and February 24, 2015, as well as any necessary objections during the deposition of Dr. Joe Lubenow. Petitioner served no supplemental evidence in response to the objections. Copies of Patent Owner's objections are marked as Exhibits 2053 and 2054.

II. ARGUMENT

Exhibit 1008 (Declaration of Dr. Joe Lubenow)

Regarding Exhibit 1008, Dr. Lubenow is not qualified to tender expert opinion in this case and his 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). Further, much of Dr. Lubenow's testimony is irrelevant to this proceeding. Consequently, his opinions should be excluded.

Patent Owner's Motion to Exclude

Dr. Lubenow's testimony should be excluded under Federal Rule of Evidence 702 because he is not qualified to act as an expert in this case. *See Daubert v. Merrell Dow Pharmaceuticals, Inc.*, 509 U.S. 579 (1993) and *Kumho Tire Co. v. Carmichael*, 526 U.S. 137 (1999) and their progeny. Dr. Lubenow attempts to express opinion about what the prior art contained, including the operation of CFS units with respect the disclosures of the *1997 ACS*. In particular, there is a question as to whether optical scanners were used in the *1997 ACS* process at CFS units. Dr. Lubenow's testimony should be excluded because he admitted in his deposition that he does not know "the internal details of the CFS operation." Ex.1023 at 145. He has never been inside a CFS unit, Ex.1023 at 172, and his testimony regarding equipment used in the CFS units is based on guesses and unsupported assumptions. Ex.1023 at 173-74.

Dr. Lubenow's testimony also should also be excluded under Federal Rule of Evidence 702 because it will not assist the Board in understanding the evidence or determining facts at issue. Further, his opinions create a significant risk of confusing the issues and are misleading. FED. R. EVID. 403. For example, many of the citations to *1997 ACS* (Exhibit 1004) are misleading because they are incorrect, incomplete, or taken out of context. In one instance, the alleged "quote" is so garbled that it takes some time to figure out how Dr. Lubenow mixed and matched the language. The real text of *1997 ACS* reads as follows:

The mail forwarding process begins when (1) a postal customer moves and files a Postal Service Form 3575, *Change of Address (COA)*

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