

Filed on behalf of: United States Postal Service

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UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNITED STATES POSTAL SERVICE
Petitioner

v.

RETURN MAIL, INC.
Patent Owner

U.S. Patent No. 6,826,548

DECLARATION OF JOE LUBENOW, Ph.D.

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I, Joe Lubenow, declare as follows:

I. Introduction

1. I have been retained by the United States Postal Service (USPS) as an independent expert consultant in this proceeding before the United States Patent and Trademark Office (USPTO). I am being compensated at my rate of \$250 per hour for the time I spend on this matter. My compensation does not depend on the outcome of this matter.

2. Counsel has told me this proceeding involves U.S. Patent No. 6,826,548 (the '548 patent) (attached as Ex. 1001 to the petition). Ralph M. Hungerpiller and Ronald C. Cagle filed the application for the '548 patent on Jan. 24, 2002, as U.S. Patent Application No. 10/057,608.

3. It is my opinion that certain references disclose or suggest the features recited in claims 39-44 of the '548 patent.

II. Qualifications

4. I am the President of Lubenow and Associates, a postal consulting firm located in Chicago, Illinois. Before that, I worked in the postal and mailing industry for more than forty years, starting in 1966 with R.R. Donnelley & Sons Company, a global provider of integrated communications. At R.R. Donnelly, I was a computer programmer, a manager, and in 1995, Vice President of Postal Affairs for R.R. Donnelley and Metromail Corporation (a subsidiary of R.R. Donnelly that specialized in computerized marketing information and production services to direct-mail

companies). In the relevant 2001–2002 timeframe, I was the President of Lubenow & Associates, a postal consultancy focusing on international and domestic address standardization, mailpiece barcoding, and intelligent mail.

5. The USPS has never employed me. But, in 1991, I was appointed a member of the USPS Mailer’s Technical Advisory Committee (MTAC). MTAC is not a part of the USPS, but is composed of major mailing associations and organizations working with the USPS. MTAC advises the USPS on technical postal matters. In 1995, I was elected to the MTAC Engineering and Technology committee, which discussed postal barcodes. I was the chair of several MTAC committees, and, in 1995, I was elected to the MTAC leadership. From 2001–2002, I was the elected head of the MTAC.

6. Since 1995, I have also advised the Universal Postal Union (UPU) on matters such as international postal address standards, with the aim of reducing undeliverable-as-addressed mail internationally.

7. I received a B.A. from Lawrence University in 1964 in philosophy and a Ph.D. from the University of Chicago in philosophy in 2013. My curriculum vitae, which includes a more detailed summary of my background, experience, and publications, is attached as Appendix A. I have published a number of articles about mail services and systems and given numerous speeches at conferences and forums.

8. I am not an attorney and I do not offer any legal opinions. I was hired to be an expert witness once before, in a case that is still pending.¹ I have some experience studying and analyzing patents and patent claims. I am the named inventor on two issued patents.² Given my experience and expertise in the field, I can speak authoritatively about what one of ordinary skill in my art would have known, and when.

III. Materials Reviewed

9. I have known about and dealt with many of the systems described in the patents and printed publications I describe here. In forming my opinions, I reviewed the '584 Patent, the Provisional Patent Application No. 60/263,788, the prosecution history of the '584 patent, the patent's ex parte reexamination certificate and the prosecution history of the reexamination, and the following references:

- Korean Patent No. 2000-3860 (Park);
- Translation Certification for Korean Patent No. 2000-3860 (Park);
- The Address Change Service System, as described in Address Change Service, Publication 8, July 1997 (1997 ACS);
- U.S. Patent No. 6,292,709 (Uhl);

¹ *Secured Mail Solutions LLC v. Advance Image Direct LLC et al.*, No. 12-cv-01090 (C.D. Cal. Jul. 3, 2012).

² U.S. Patent No. 5,715,398 (filed Mar. 13, 1996) (expired); U.S. Patent No. 4,674,052 (filed Nov. 7, 1984) (expired).

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