

Paper No. \_\_\_\_\_

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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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.

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Case CBM2014-00116  
Patent 6,826,548

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**PATENT OWNER'S REPLY IN SUPPORT OF ITS  
MOTION TO EXCLUDE EVIDENCE**

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## I. ARGUMENT

### A. Exhibit 1008 (Dr. Lubenow's Declaration)

In its Motion to Exclude, Patent Owner showed that Dr. Lubenow is not qualified to testify about operations in CFS units—particularly as to whether optical scanners were used in the *1997 ACS* process. (PO Motion at 5). Dr. Lubenow testified in his deposition that he did not know “the internal details of the CFS operation.” (Ex.1023 at 145). He also testified repeatedly that he could not answer questions related to optical scanners because he had never been inside a CFS unit. (*Id.* at 172-74). His testimony is clear, and he lacks knowledge about CFS operations.<sup>1</sup>

Dr. Lubenow also misquotes *1997 ACS* several times. (PO Motion at 5-6). In one example, his “quote” was completely inaccurate and related to irrelevant carrier-filed forms that have no updated addresses. (*Id.*). This was also raised in Patent Owner's Response. (PO Resp. at 53-54, 73). This testimony related to carrier-filed forms is misleading.

In response, Petitioner misquotes *1997 ACS*, which includes the following statement: “Undeliverable Mailpieces Matched to Carrier-Filed Actions: The mailpiece is returned with manual nondelivery information attached, ***and no ACS notification is generated.***” (Ex.1004 at 15) (emphasis added). In another section, it states “Undeliverable Mailpieces Matched to Carrier-Filed Actions: The mailpiece is

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<sup>1</sup> There are no mischaracterizations or false suggestions—the testimony is clear.

discarded, and an electronic ACS notification with Deliverability Code “K,” “G,” or “C,” is generated (see page 22, Deliverability Code).” (*Id.*). Deliverability Codes “K,” “G,” and “C” indicate “that the mailpiece was matched with a COA order **but new address information is unknown.**” (*Id.* at 23-24) (emphasis added). Petitioner leaves out the references to the deliverability codes and claims that this misquoted language shows that notifications providing updated addresses, which is incorrect.

Patent Owner has pointed to specific instances where Dr. Lubenow merely “quoted” excerpts from *1997 ACS* and then stated that a certain claim element was disclosed in his opinion. (PO Motion at 7-8). Petitioner’s response is insufficient in that it merely states that no explanation is necessary. Patent Owner maintains its objections as stated on pages 7-8.<sup>2</sup>

Patent Owner also moved to exclude specific paragraphs of Dr. Lubenow’s declaration related to a provisional application and related reexamination proceedings. (PO Motion at 9-10). Patent Owner pointed out that he was not qualified to testify as an expert on patent applications or proceedings because he has no real experience in

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<sup>2</sup> As for Petitioner’s argument that Dr. Lubenow’s declaration testimony related to claim constructions (¶¶ 70-83) is still relevant because the Board’s claim construction is not final, it should be noted that Petitioner made no claim construction arguments in its Reply.

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