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Paper 12
Entered: February11, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AGILYSYS, INC., ET AL.
Petitioner,

v.

AMERANTH, INC.
Patent Owner.

Case CBM2014-00015
Patent 6,384,850

Before JAMESON LEE, MEREDITH C. PETRAVICK, RICHARD E. RICE, and STACEY G. WHITE, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

ORDER
Conduct of Proceedings
37 C.F.R. § 42.05

Introduction

On February 7, 2014, the Board initiated a conference call with the parties, to inform the parties that although thirty-five companies are identified in the petition as "Petitioners" and real parties-in-interest, the thirty-five companies collectively constitute only a single party in this proceeding before the Board. Consequently, the designation in the petition of fifteen pairs of lead and backup counsel, one pair for each of fifteen groupings of the thirty-five companies, is unacceptable. As a single party before the Board, all thirty-five companies must speak with a uniform voice, whether in writing or orally in a conference call, hearing, or deposition.

Discussion

The conference call began with the Board posing the following question to Mr. Richard S. Zembek, counsel for Petitioner: how does he envision this proceeding conducted with the Petitioner's side being split into fifteen groups, each with its own designated lead and backup counsel. Mr. Zembek explained that with regard to paper filings, the thirty-five companies would always file a single paper, sharing the allotted pages among themselves, and that in the event of differences in the positions of different companies, there would be one or more separate sections within the same paper to articulate the differences. Mr. Zembek further explained that in case of telephone conference calls, he is authorized to speak on behalf of all the listed companies, subject, however, to any objection that may be advanced by a company that may have a different position on any issue. When asked by the Board to clarify the timing of such "objection," Mr. Zembek explained that the "objection" would have to be offered immediately in the same

conference call. Under the scenario described by Mr. Zembek, it appears that even the companies within the same grouping, which have appointed the same lead and backup counsel, may not necessarily speak with a uniform voice, as they may not share the same position on any issue.

Counsel for Patent Owner objected to the manner of conducting this proceeding, as proposed by Mr. Zembek, on the basis that Patent Owner would have to respond to multiple differing positions offered from the same side.

The manner of conducting this proceeding, as proposed by Mr. Zembek, is not in accordance with the rules governing trial practice and procedure before the Board. The thirty-five companies collectively filed a single petition, and thus, are recognized as a single party, as Petitioner, before the Board. According to 37 C.F.R. § 42.2, "Petitioner" means "the party filing a petition requesting that a trial be instituted." In circumstances not involving a motion for joinder or consolidation of separate proceedings, for each "petition" there is but a single party filing the petition, no matter how many companies are listed as petitioner or petitioners and how many companies are identified as real parties-in-interest. Even though the separate companies regard and identify themselves as "Petitioners," before the Board they constitute and stand in the shoes of a single "Petitioner."

Because the thirty-five companies constitute, collectively, a single party, they must speak with a single voice, both in writing and oral representation. Mr. Zembek's proposal transforms the "Petitioner" under 37 C.F.R. § 42.2 from a single party into thirty-five different parties. That is not only contrary to 37 C.F.R. § 42.2, which defines "Petitioner" as a single party by referring to "the party filing a petition," but also prejudicial to Patent Owner, who potentially would have to

respond to thirty-five different, possibly inconsistent, positions on every issue. Nor would the Board's interests in the speedy and efficient resolution of post-grant proceedings be served by permitting the presentation of inconsistent positions based on the filing of a single petition.

Also, during the conference call, the Board admonished counsel for Patent Owner that every party must act with courtesy and decorum in this proceeding, as is required by 37 C.F.R. § 42.1(c), and that Patent Owner's preliminary response does not exhibit proper decorum. Counsel for Patent owner acknowledged the inappropriateness of certain statements in the preliminary response, and withdrew the request in the preliminary response that the petition be denied on the alleged ground that Petitioner has acted unethically.

Conclusion

The current designation of counsel by Petitioner fails to identify either a lead attorney or backup counsel for the Petitioner in accordance with 37 C.F.R. § 42.10(a).

It is

ORDERED that within one week of the day of this communication, Petitioner shall file a paper to re-designate lead and backup counsel in accordance with 37 C.F.R. § 42.10(a) by regarding itself as a single party, and provide updated service information in light of the re-designation of lead and backup counsel;

FURTHER ORDERED that Petitioner is not authorized to divide any paper it submits in this proceeding into separate parts where any part is indicated as submitted on behalf of less than all of the companies it has identified in the petition as "Petitioners"; and

FURTHER ORDERED that in any hearing, telephone conference call, or deposition to be taken for this proceeding, any counsel making an oral representation from the side of Petitioner is presumed to speak for all of the thirty-five companies identified in the petition as "Petitioners," and that such counsel should not make the oral representation unless that is in fact the case.

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