

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 Proceeding
37 C.F.R. § 42.5

Introduction

On February 11, 2014, the Board ordered Petitioner to file, within one week of the date of the Order (Paper 12), 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 to provide updated service information in light of the re-designation of lead and backup counsel. To this date, Petitioner remains in non-compliance with the Order and 37 C.F.R. § 42.10(a). Although Petitioner did file, on February 18, 2014, a Notice of Re-Designation of Lead and Backup Counsel, the paper purports to redefine Petitioner, without authorization of the Board, as excluding Apple Inc., one of the 35 companies which jointly filed the petition in this proceeding. Paper 13.

Petitioner filed no request for rehearing of the Board's Order of February 11, 2014, prior to filing the non-compliant paper dated February 18, 2014. Petitioner further did not alert the Board of its non-compliance. The Board noticed the non-compliance on its own, and then initiated a telephone conference call to discuss the matter. The conference call was held on March 7, 2014. The participants were respective counsel for the parties and Judges Lee, Petravick, Rice, and White.

Discussion

The conference call began with the Board stating the impropriety of Petitioner's actions in responding to the Board's Order of February 11, 2014. Had the Board not noticed the non-compliance, this proceeding would have continued indefinitely without a clear picture of the constitution of Petitioner or a clear designation of lead and backup counsel. More importantly, Petitioner chose to file

a paper purporting to re-designate counsel for less than all of the companies that jointly filed the petition and that the Board ruled collectively constitute Petitioner, without seeking an opportunity to explain its difficulties to the Board and to ask for an alternative resolution. Such conduct is inappropriate. We give notice to Petitioner that such action should not be repeated. It should have contacted the Board, prior to filing a noncompliant paper, to discuss an alternative resolution.

Notwithstanding the contrary indication in Paper 13, Apple Inc. remains a member of the group of 35 companies that is collectively regarded as Petitioner. That will remain so unless and until the Board authorizes withdrawal of Apple Inc. from the proceeding or terminates the proceeding with respect to Apple Inc.

Counsel for Petitioner asked that the required filing of a paper re-designating lead and backup counsel for Petitioner as one party be postponed until after the Board has decided whether to allow Apple Inc. to withdraw from this proceeding. The postponement request is *granted*.

Counsel for Petitioner explained that Petitioner would like to seek authorization for Apple Inc. to withdraw from this proceeding. The Board stated that the parties can move jointly to terminate the proceeding with respect to Apple Inc. *See* 37 C.F.R. § 42.74. However, counsel for Patent Owner stated that Patent Owner and Petitioner have not reached an agreement that would lead to the filing of a joint motion to terminate the proceeding with respect to Apple Inc., and that Patent Owner opposes the withdrawal of Apple Inc. from the proceeding at this time.

Under these circumstances, we authorize briefing by the parties as to why Petitioner should be allowed to reconstitute itself to exclude Apple, Inc. During

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the conference call, we suggested that such briefing from Petitioner be filed as a belated rehearing request. Upon further consideration, however, we rescind that authorization, and require that Petitioner's briefing be filed as a Motion to Reconstitute Petitioner to Exclude Apple Inc., subject to 37 C.F.R. § 42.20.

Order

It is

ORDERED that Petitioner is authorized to file a Motion to Reconstitute Petitioner to Exclude Apple Inc., by March 12, 2014, limited to 7 pages;

FURTHER ORDERED that in the motion, Petitioner shall specifically address what withdrawal of Apple Inc. would enable Apple Inc. to do, in terms of filing or maintaining other petitions or actions against Patent Owner with regard to the same patent, including, but not limited to, an additional *inter partes* review petition or covered business method patent review petition, which it otherwise could not do if not withdrawn from this proceeding; and why no prejudice would be imposed on Patent Owner by allowing Apple Inc. to withdraw at this time;

FURTHER ORDERED that Patent Owner is authorized to file a Response to Petitioner's motion, limited to 7 pages, within 5 calendar days of the date of filing of Petitioner's motion;

FURTHER ORDERED that Petitioner is authorized to file a Reply, limited to 5 pages, to Patent Owner's Response, within 5 calendar days of the filing of Patent Owner's opposition;

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FURTHER ORDERED that if all of Petitioner's constituents do not speak with one voice in the motion, the motion will be dismissed and not considered on the merits.

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