

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ASKELADDEN LLC,
Petitioner,

v.

SEAN I. MCGHIE and BRIAN BUCHHEIT,
Patent Owner.

Cases IPR2015-00122 (Patent 8,523,063)
IPR2015-00123 (Patent 8,523,063)
IPR2015-00124 (Patent 8,540,152)
IPR2015-00125 (Patent 8,540,152)
IPR2015-00133 (Patent 8,297,502)
IPR2015-00137 (Patent 8,297,502)¹

Before SALLY C. MEDLEY, JONI Y. CHANG, and
GEORGIANNA W. BRADEN, *Administrative Patent Judges*.

MEDLEY, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

¹ This order addresses issues that are the same in the identified cases. We exercise our discretion to issue one order to be filed in each case. The parties are not authorized to use this style heading.

IPR2015-00122 (Patent 8,523,063) IPR2015-00123 (Patent 8,523,063)
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On May 21, 2015, the initial conference call² was held among counsel³ for the respective parties and Judges Medley, Chang, and Braden.

Procedural Matters

We find ourselves, once again, explaining the proper procedure for requesting a conference call and the appropriate content of any email filed with the Board regarding a requested conference call. In particular, in requesting an initial conference call, Patent Owner's email request was improper. An email requesting a conference call should copy the other party to the proceeding, indicate generally the relief being requested or the subject matter of the conference call, state whether the other party opposes the request, and include times when all parties are available. Emails regarding a conference call should not include arguments or attachments. *See* Technical issue 3 on the Board's website (<http://www.uspto.gov/ip/boards/bpai/prps.jsp>). During the conference call, the particular deficiencies were discussed, along with the potential consequences for any future abuse of the process.

We also find ourselves, once again, explaining to Patent Owner rules and procedures for taking action in these proceedings. For example, and as we explained, since neither party filed a motions list in preparation for the initial conference call, we assumed that neither party seeks authorization to

² The initial conference call is held to discuss the Scheduling Order and any motions that the parties anticipate filing during the trial. Office Patent Trial Practice Guide, 77 *Fed. Reg.* 48756, 48765 (Aug. 14, 2012).

³ Patent Owner is represented by Mr. Brian Buchheit, one of the named inventors of the involved patents, who is registered to practice before the Office.

IPR2015-00122 (Patent 8,523,063) IPR2015-00123 (Patent 8,523,063)
IPR2015-00124 (Patent 8,540,152) IPR2015-00125 (Patent 8,540,152)
IPR2015-00133 (Patent 8,297,502) IPR2015-00137 (Patent 8,297,502)

file a motion. Counsel for Petitioner verified that Petitioner did not file a motions list, nor does Petitioner seek authorization to file a motion at this time. Counsel for Patent Owner, however, Mr. Buchheit, argued that he did not know he needed to file a list prior to the conference call, he is acting *pro se*, and that he is not familiar with the Board's rules and procedures.

Instructions to file a motions list prior to the initial conference call are found at least in the April 23, 2015 Scheduling Order filed in each of these proceedings. Paper 37 at 3.⁴ In particular, the Scheduling Order directs attention to the Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,765–66, which describes that the Board expects the parties to file a list of proposed motions to provide the Board and opposing party adequate notice to prepare for the conference call and to plan for the proceeding. Thus, the parties were placed on notice that the Board expected the parties to file a motions list.

From the beginning of these proceedings, Mr. Buchheit has feigned ignorance of Board rules and procedures, explaining that he is acting “pro se” and is unfamiliar with these types of proceedings. Mr. Buchheit, however, is an attorney, and significantly, is registered to practice before the Office. He has listed himself as “Lead Counsel” and is representing co-inventor Mr. Sean I. McGhie, who also is registered to practice before the Office, and who is listed as “Back-up Counsel.” Paper 4 at 4.

We have been patient with Mr. Buchheit up to this point, by repeatedly explaining procedural matters that we would expect a registered practitioner to know. For example, the Board has on at least two occasions

⁴ Citations are to IPR2015-00122.

IPR2015-00122 (Patent 8,523,063) IPR2015-00123 (Patent 8,523,063)
IPR2015-00124 (Patent 8,540,152) IPR2015-00125 (Patent 8,540,152)
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explained the proper procedure for requesting a conference call with the Board.⁵ Yet, we had to spend time explaining, at the outset of this call, the proper procedure for requesting a conference call with the Board, along with explaining to Mr. Buchheit that he should have filed a motions list prior to the call. Based on past behavior, and giving Mr. Buchheit the benefit of the doubt that he is not blatantly ignoring the Board's rules and procedures, we assume that Mr. Buchheit has not read thoroughly the statutory provisions, Board rules, the Trial Practice Guide, or visited the Board's webpage, which has much guidance and to which we have directed the parties to on several occasions. Accordingly, we herein order Mr. Buchheit to file a declaration certifying that he has read thoroughly the statutory provisions, Board rules, and Trial Practice Guide that governs these proceedings.

Motion for Additional Discovery

Patent Owner seeks authorization to file a motion for additional discovery. In particular, Patent Owner is of the impression that several banks should be listed as real parties-in-interest to these proceedings. Petitioner opposes. Notwithstanding Patent Owner's failure to provide a motions list with this item on it, we have determined that Patent Owner is authorized to file a motion for additional discovery. As explained, the parties may agree to additional discovery between themselves. 37 C.F.R. § 42.51(b)(2). The parties are encouraged to work together to come to any agreement regarding the discovery Patent Owner seeks prior to Patent

⁵ Exhibit 3001 is a copy of two electronic mail messages, explaining the proper procedure for requesting a conference call with the Board.

IPR2015-00122 (Patent 8,523,063) IPR2015-00123 (Patent 8,523,063)
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IPR2015-00133 (Patent 8,297,502) IPR2015-00137 (Patent 8,297,502)

Owner filing its motion for additional discovery. The motion should include only those items for which the parties could not agree.

During the call, the Board also explained that a party moving for additional discovery “must show that such additional discovery is in the interests of justice.” *See* 35 U.S.C. § 316(a)(5); 37 C.F.R. § 42.51(b)(2). The factors set forth in *Garmin Int’l, Inc. et al. v. Cuozzo Speed Techs. LLC*, Case IPR2012-00001 (PTAB March 13, 2013) (Paper 26) are important factors in determining whether a discovery request meets the statutory and regulatory necessary “in the interest of justice” standard. Accordingly, Patent Owner’s motion should explain with specificity the discovery requested and why such discovery is necessary “in the interest of justice” using those factors. In that regard, Patent Owner should not expect the Board to attempt to sort through a list of items to ascertain which items may meet the necessary in the interest of justice standard. Patent Owner bears the burden to demonstrate that the additional discovery (*e.g.*, each requested item) should be granted. *See* 37 C.F.R. § 42.20(c).

Motion to Amend

Patent Owner indicated that it may decide to file a motion to amend. If Patent Owner determines that it will file a motion to amend, Patent Owner must arrange a conference call with the Board and opposing counsel to discuss the proposed motion to amend. *See* 37 C.F.R. § 42.121(a).

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