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IPR2015-00122 Paper 30; IPR2015-00123 Paper 30
IPR2015-00124 Paper 29; IPR2015-00125 Paper 28;
IPR2015-00133 Paper 26; IPR2015-00137 Paper 25
Entered: March 6, 2015

PUBLIC REDACTED VERSION

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*.

Chang, *Administrative Patent Judge*.

ORDER

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

IPR2015-00122 (Patent 8,523,063)

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IPR2015-00124 (Patent 8,540,152)

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Real Party-in-Interest and Vacating Filing Date

37 C.F.R. §§ 42.8(b)(1) and 42.106(b)

I. INTRODUCTION

Petitioner Askeladden LLC (“Askeladden”) filed a Petition requesting an *inter partes* review in each of the above-identified proceedings. Paper 2,² “Pet.” The Petitions identify Askeladden as the sole real party-in-interest to these proceedings. Pet. 1.

In response, Sean McGhie and Brian Buchheit (“Patent Owner”) filed a Preliminary Response in each proceeding at issue. Paper 10, “Prelim. Resp.” Patent Owner asserts that The Clearing House Payments Company LLC (“PayCo”) also is a real party-in-interest. *Id.* at 54.

Subsequently, we authorized Askeladden to file a reply to Patent Owner’s Preliminary Response for the sole purpose of addressing the real party-in-interest issue. Paper 13. Pursuant to our authorization, Askeladden filed a Reply³ (“RPI Reply”⁴) and supporting evidence, including a

² Citations are to IPR2015-00133.

³ The Reply was time-stamped February 24, 2015, 12:02 a.m. ET, and, thus, was filed untimely. Patent Owner does not object to the entry of the late filing. Upon consideration, we determined, in accordance with 37 C.F.R. § 42.5(c)(3), to excuse the late filing.

⁴ Askeladden filed two versions of its Reply—a confidential version (Paper 14) and a public redacted version (Paper 15).

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Declaration of Mr. Sean Reilly (Ex. 1531⁵). In addition, in response to our request for relevant portions of Askeladden’s Operating Guidelines, which are referenced in Mr. Reilly’s Declaration (Ex. 1531 ¶ 11), Askeladden filed a redacted confidential version of Askeladden’s Limited Liability Company Agreement (Ex. 1533, “LLC Agreement”), which contains Askeladden’s Operating Guidelines.

We have considered the parties’ contentions and evidence in the present record. For the reasons set forth below, we determine that Askeladden also should have identified PayCo as a real party-in-interest in the Petitions, as required by 35 U.S.C. § 312(a)(2). Pursuant to 37 C.F.R. § 42.106(b), we, hereby, vacate the previously-accorded filing date of each Petition, and provide Askeladden an opportunity to correct the Petitions in accordance with this Order.

II. DISCUSSION

Factual Background

Askeladden is a wholly-owned subsidiary of PayCo. Ex. 1531 ¶ 6.

[REDACTED]

[REDACTED] Ex. 1533, 1. In short, PayCo is the parent company [REDACTED] of Askeladden.

⁵ Askeladden filed both the confidential version and public redacted versions of Mr. Reilly’s Declaration, as Exhibits 1531.

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[REDACTED]

[REDACTED] the members of Askeladden’s Executive Committee appear to be current executive officers of PayCo. Ex. 2029.

[REDACTED]

PayCo purportedly is a banking industry group representing more than twenty financial institutions (“PayCo’s member banks”). Ex. 2027, 1. PayCo formed Askeladden to implement the Patent Quality Initiative (“PQI”), which is said to improve the quality of patents that affect the financial services industry. Ex. 1531 ¶ 7; Ex. 1533, 8. PQI is the product of thought leadership provided by PayCo. Ex. 2029, 1. [REDACTED]

[REDACTED]

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The Parties' Contentions

Notwithstanding the identification of Askeladden as the sole real party-in-interest in each Petition (Pet. 1), Patent Owner asserts that PayCo also is a real party-in-interest. Prelim. Resp. 54. In its Preliminary Response, Patent Owner argues that “the boundary between Askeladden and the Clearing House has been a legal fiction based on the evidence available.” *Id.* at 55. As support, Patent Owner submitted two press releases (Exs. 2033, 2034), an article from iam-magazine (Ex. 2027), and several webpages⁶ from the websites of Askeladden and PayCo (Exs. 2028–2032).

In its Reply, Askeladden counters that it is the sole real party-in-interest because no other entity funds or controls the above-identified *inter partes* reviews. RPI Reply 1. In particular, Askeladden alleges that PayCo is not a real party-in-interest, as PayCo has not funded these proceedings. *Id.* at 2 (citing Ex. 1531 ¶¶ 16). Askeladden also contends that it, independently and, in its sole discretion, identifies and selects the involved patents, and directs all aspects of these proceedings. *Id.* at 1–5 (citing Ex. 1531 ¶¶ 11–12, 18). Askeladden further maintains that Patent Owner’s evidence is insufficient to overcome the presumption that distinct legal entities operate independently. *Id.* at 6–11. Askeladden argues that Patent Owner improperly seeks an advisory opinion, as Patent Owner has not sued

⁶ <http://www.patentqualityinitiative.com> and <https://www.theclearinghouse.org>.

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