

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.¹

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)²

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

MEDLEY, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding

¹ The parties are to style all forthcoming papers in this manner.

² 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.

37 C.F.R. § 42.5

On December 12, 2014, a conference call was held among counsel³ for the respective parties and Judges Medley, Chang, and Braden. The purpose of the call was for Patent Owner to seek authorization to: (1) file motions to reset the filing date accorded the Petitions for failure to properly serve; (2) file motions to dismiss the Petitions for failing to name the correct Patent Owner's real party-in-interest; (3) file documents allegedly showing that Petitioner's real party-in-interest was not properly identified; and (4) file motions for sanctions against Petitioner for out-of-pocket expenses incurred by Patent Owner regarding items (1)–(3).

Service

Patent Owner explained that Petitioner served the Petitions and supporting evidence to the wrong address. Service of a petition and supporting evidence is made by serving the patent owner at the correspondence address of record for the subject patent. 37 C.F.R. § 42.105(a). Here, Petitioner, did what it was supposed to do – it served the requisite papers upon Patent Owner at the correspondence address of record. Moreover, Patent Owner received the papers. As we explained, if the address of record is not accurate, it is the responsibility of Patent Owner to update the Office records. For these reasons, Patent Owner is not authorized to file motions to reset the filing date accorded the Petitions for failure to properly serve.

Real Party-In-Interest – Patent Owner

The Petitions name Loyalty Conversion Systems Corporation (LCS)

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.

as the Patent Owner. *See, e.g.*, IPR2015-00122, Paper 1, fn1. Patent Owner explained that LCS has no right or interest with respect to any of the involved patents, and that Petitioner's naming LCS as the patent owner was incorrect. As such, Patent Owner seeks authorization to file motions to dismiss the Petitions, because the Petitions fail to name the true patent owner. Petitioner responded that it went on information and belief that LCS had an ownership right of the involved patents and, therefore, listed LCS as the patent owner in the Petitions.

Within 21 days of service of a petition, a patent owner must file mandatory notices. The notice serves as patent owner's opportunity to identify, among other things, its real party-in-interest. 37 C.F.R. § 42.8(b)(1). Patent Owner filed its mandatory notice papers in each of the proceedings. *See, e.g.*, IPR2015-00122, Paper 4. In its Mandatory Notices, Patent Owner names the inventors of the involved patents as the real parties-in-interest. Petitioner does not contest that representation. Thus, to the extent that the Petitions incorrectly identified Patent Owner, Patent Owner's Mandatory Notices clarify the record. For these reasons, Patent Owner is not authorized to file motions to dismiss the Petitions for failing to name the correct Patent Owner's real party-in-interest.

Real Party-In-Interest – Petitioner

The Petitions name Askeladden LLC as Petitioner's real party-in-interest. *See, e.g.*, IPR2015-00122, Paper 1. Patent Owner explained that it had information it wished to file to show that Askeladden allegedly is not the sole real party-in-interest. As explained, Patent Owner may file such information in connection with any preliminary response it files, and, thus, does not need prior Board authorization to file such information. The panel appreciates Petitioner's willingness to cooperate with Patent Owner should

Patent Owner have any further questions regarding Petitioner's real party-in-interest.

Sanctions

Based on the information provided to the parties during the call, Patent Owner no longer sought sanctions in the form of out-of-pocket expenses. Accordingly, Patent Owner's request for authorization to file motions for sanctions is dismissed as moot.

Order

It is

ORDERED that Patent Owner's requests to file motions to (1) reset the filing date accorded the Petitions for failure to properly serve; and (2) dismiss the Petitions for failing to name the correct Patent Owner's real party-in-interest are *denied*; and

FURTHER ORDERED that Patent Owner's request to file motions for sanctions is *dismissed* as moot.

PETITIONER:

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PATENT OWNER:

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