

From: Brian Buchheit [<mailto:brian.buchheit@patentsondemand.com>]
Sent: Friday, December 12, 2014 11:41 AM
To: Oliver, Justin; DeLucia, Frank
Subject: RE: Petition Real Party of Interest Question

Justin and Frank,

Pleasure meeting you during the conference. What is a good time/contact for following up with you about information relating to the relationships between Askelladen, PQI, the Clearing House, and the 20 banks that the clearing house represents. Specifically, I'm trying to determine what roles if any these other companies/organizations had in suggesting any of the particular patents in question be filed. Further, the structure of selecting counsel and paying for the Petitions is relevant based on RPX Corp v. VirnexX.

To elaborate, I have noticed a strong cross pollination between employees of the two companies and the board of directors of the two companies. Therefore, if the same person (wearing a hat of the clearing house) made one set of decisions then made a second set of decisions (wearing the hat of an Askelladen employee) it would appear that that person made a suggestion for filing the IPR, which would appear to have an effect on whether The Clearing House was effectively making the suggestion. I noticed some online documents indicating that the board of directors are identical for Askelladen and the Clearing House, so if the board of directors of Askelladen made decisions, effectively the same board of directors for the Clearing House was making those decisions.

So, if you have established any Chinese walls to ensure autonomy of decision making between the two companies despite the strong cross pollination, it would definitely be useful to know. Basically, I'm asking for information that would be relevant in determining or not whether the Clearing House would be legally considered a real party of interest for the IPRs in light of RPX Corp v. VirnexX and the Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,759 (TPG). The TPG cites In re Guan, Reexamination Control No. 95/001, 045(Aug 25, 2008)(Decision Vacating Filing Date) there the Office held that an entity named as the sole real party of interest may not receive a suggestion from another party that a particular patent should be the subject of a request for inter partes reexamination and be compensated by that party for the filing of the request without naming the party who suggested and compensated the entity for the filing of the request.

You may be aware of more current law/procedure on this issue, in which case I would greatly appreciate being apprised.

Thanks again,

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