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Paper 19
Entered: June 17, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ACTIVISION BLIZZARD, INC.,
ELECTRONIC ARTS INC.,
TAKE-TWO INTERACTIVE SOFTWARE, INC.,
2K SPORTS, INC., and
ROCKSTAR GAMES, INC.,
Petitioner,

v.

ACCELERATION BAY, LLC,
Patent Owner.

Cases IPR2015-01951, IPR2015-01953, IPR2016-00932[1]
Patent 6,714,966 B1
Cases IPR2015-01970, IPR2015-01972, IPR2016-00931
Patent 6,701,344 B1
Cases IPR2015-01964, IPR2015-01996
Patent 6,829,634 B1

Before SALLY C. MEDLEY, LYNNE E. PETTIGREW and WILLIAM M. FINK, *Administrative Patent Judges*.

FINK, *Administrative Patent Judge*.

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[1] This Order applies to each of the listed cases. We exercise our discretion to issue one Order to be entered in each case. The parties, however, are not authorized to use this caption for any subsequent papers.

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

On June 8, 2016, the Board received separate emails from counsel to the parties in the following eight proceedings: IPR2015-01951, IPR2015-01953, IPR2015-01964, IPR2015-01970, IPR2015-01972, IPR2015-01996, IPR2016-00931, and IPR2016-00932 (the "Proceedings").[2] These emails are too lengthy to reproduce here in full (*see* Ex. 3001), but the relevant facts are as follows: In its initial email, sent after close of business, Petitioner requested a conference call the next day to request expunging Acceleration Bay's filings and barring Acceleration Bay from further participation in the Proceedings, because the United States District Court for the District of Delaware determined Acceleration Bay to be an "exclusive licensee" with fewer than "all substantial rights." Petitioner proposed times when it was available the next day for conference but did know when Patent Owner would be available. In a responsive email, Patent Owner stated Petitioner had not met and conferred prior to sending an email request to the Board and, if it had, it would have known Patent Owner was not available for a call on June 9th, as Petitioner proposed. However, Patent Owner's email proceeded to brief the issue of its standing as Patent Owner in the

[2] Counsel for Petitioner in these Proceedings also represents that its email was sent with permission from counsel for Petitioner Bungie, Inc. in the related proceedings: IPR2016-00724, IPR2016-00726, IPR2016-00727, and IPR2016-00747. *See* Ex. 3001 (email chain). However, at this time, the Board does not enter this Order in these proceedings.

Proceedings. Before the Board had an opportunity to respond to these emails, at 2:42 AM on June 13th, 2016, the Board received yet another email, from counsel for Petitioner, disputing Patent Owner's positions and reiterating its request for a conference.

Because the Board's orders have not been complied with, Petitioner's request for a conference call is denied without prejudice.

As an initial matter, part A.2 of the Board's Scheduling Order in these Proceedings requires that a party requesting a call must, *inter alia*, "certify that it has conferred with the other party in an effort to resolve the dispute" and "propose specific dates and times at which *both* parties are available for the conference call." Paper 12, 2 (emphasis added).[3] Based on the content of the emails received from Petitioner and Patent Owner on June 8, we determine that neither of these requirements was satisfied by Petitioner prior to sending its email to the Board.

Moreover, it is inappropriate to include substantive arguments in emails to the Board. *See* Patent Review Processing System (PRPS), Technical Issue 3 (hereinafter, "Technical Issue 3") (describing content of emails to Trials@uspto.gov) *available at* http://www.uspto.gov/patents-application-process/appealing-patent-decisions/trials/patent-review-processing-system-prps-0; *Kingston Tech. Co. v. CATR Co., Ltd.*, Case IPR2015-00149, slip op. at 2 (PTAB June 5, 2015) (Paper 22). Once again, however, we are in receipt of emails from the parties containing substantive,

[3] We refer to the papers in IPR2015-01951 unless otherwise specified.

off-the-record arguments to the Board, despite our previous instructions in these Proceedings that emails to the Board "requesting a conference call should be limited to a short statement regarding the purpose of the call only and should not contain substantive communications to the Board." Ex. 3002.

The Board's rules are "construed to secure the just, speedy, and inexpensive resolution of every proceeding." 37 C.F.R. § 42.1(b). Failure to meet and confer, and off-the-record, unauthorized briefing of disputed issues through email correspondence, wastes time and undermines the Board's goal to expeditiously resolve disputes. *See Kingston*, slip op. at 2. Accordingly, in the future, the parties to these Proceedings must agree to the content of emails requesting conference calls before they are sent to the Board, including a short statement of the issue and the position of each party with respect to that issue, and times when both parties are available, and the party sending the email must certify that the other party has agreed to the content of the email request. *See* 37 C.F.R. §§ 42.5(a); 42.12(b). The Board expects that the parties will exercise good faith in observing these orders. *See* 37 C.F.R. § 42.1(c).

ORDER

Accordingly, it is:

ORDERED that Petitioner's request for a conference call is denied without prejudice; and

FURTHER ORDERED that the parties to these Proceedings must agree to the content of emails requesting conference calls before they are sent to the Board, including a short statement of the issue and the position of each party with respect to that issue, and times when both parties are available, and the party sending the email must certify that the other party has agreed to the content of the email request.

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