

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RUBICON COMMUNICATIONS, LP

Petitioner,

v.

LEGO A/S

Patent Owner.

Case IPR2016-01187

Patent 8,894,066

**PETITIONER'S MOTION TO LIST ADDITIONAL PARTIES AS REAL
PARTIES-IN-INTEREST**

Petitioner Rubicon Communications, LP (“Petitioner”) moves to list additional real parties-in-interest (“RPIs”). The Board authorized this motion in an order issued February 24, 2017.

I. Introduction

Petitioner had a good faith belief, grounded in fact and supported by prior Board decisions, that its RPI listing was correct upon the addition of SmallWorks, LLC. As demonstrated below, Petitioner disputes that Rubicon Communications, LLC or James and Jamie Thompson are RPIs, although they are related by privity to the named RPIs (and thus subject to the same estoppel). Nevertheless, because Patent Owner continues to press the issue in an attempt to terminate this proceeding on procedural grounds, Petitioner is willing to concede that these parties be identified as RPIs in order to conclusively resolve any questions of estoppel that might arise from this proceeding.

Petitioner’s requested relief finds support in prior Board decisions. Petitioner did not act in bad faith, attempt to circumvent estoppel rules, or engage in “gamesmanship.” Moreover, Patent Owner is not harmed by—and in fact benefits from—the listing of additional RPIs. Under these facts, Board decisions hold that permitting additional RPIs to be added, even when their status as RPIs is

disputed, promotes the core functions of RPI practice and the “just, speedy, and inexpensive resolution” of Board proceedings.

II. Statement of Material Facts

1. James W. and Jamie L. Thompson, husband and wife, are entrepreneurs and small business owners who have organized a number of distinct business ventures under different legal entities. The currently active entities owned by the Thompsons are SmallWorks, LLC; Rubicon Communications, LLC; Pono Paani, LLC; and Electric Sheep Fencing, LLC.

2. Patent Owner was aware of the existence of each of the above-named entities at least as of the date of James Thompson’s deposition on December 5, 2016 (the “Thompson Deposition”). Indeed, over a year prior to the Thompson Deposition, Patent Owner sent a set of interrogatories to Petitioner in the related litigation that inquired as to each of these entities except for Electric Sheep Fencing, LLC (Exhibit 1034 at 7).

3. Pono Paani, LLC is a holding company for intellectual property assets owned by the Thompsons that does not have any employees or sell any products or services, and thus conducts no business related to this proceeding (Exhibit 2016 at 74-75). Electric Sheep Fencing, LLC is principally a holding company for intellectual property assets related to the Thompsons’ pfSense® network security products, which are entirely unrelated to this proceeding (Exhibit 1030 at 2).

4. Petitioner previously provided Patent Owner a “Certificate of Conversion of a Limited Partnership Converting to a Limited Liability Company” evidencing conversion of Rubicon Communications LP to Rubicon Communications LLC on June 26, 2014. Patent Owner referred to this document as Exhibit 4 in the Thompson Deposition (Exhibit 1031).

5. As shown in Exhibit 1031, the conversion was effected by Rubicon Communications Management Group LLC, the management company of the converted LP. Subsequent to the conversion, this LLC no longer actively conducted business, and was terminated on December 1, 2016 (Exhibit 1032).

6. Petitioner previously provided Patent Owner a “Bill of Sale and Assignment and Assumption Agreement” that, on its face, transfers all assets and liabilities of Rubicon Communications, LLC to SmallWorks, LLC on June 5, 2015. Patent Owner referred to this document as Exhibit 7 in the Thompson Deposition (Exhibit 1033).

7. Patent Owner’s initial lawsuit named Rubicon Communications, LP as a defendant, and was subsequently amended to add SmallWorks, LLC as a defendant (Exhibit 1023, para. 4).

8. Petitioner filed its initial petition on June 10, 2016 naming only Rubicon Communications, LP as an RPI. On November 28, 2016, Petitioner filed a motion seeking leave to add SmallWorks, LLC as an RPI.

9. On December 16, 2016, the Board issued a Decision Granting Motion to Correct RPI (“Decision”), permitting Petitioner to list SmallWorks, LLC as an RPI while retaining Petitioner’s original filing date. Decision at 6. The Board further stated that “[t]o the extent that further correction of the real parties-in-interest may be required, Petitioner is encouraged to pursue such correction promptly.” Decision at 5.

10. On December 21, 2016, Petitioner filed a corrected petition listing SmallWorks, LLC as an additional RPI.

11. On January 30, 2017, Patent Owner indicated that it would file a motion to add Rubicon Communications, LLC, James Thompson, and Jamie Thompson as defendants in the related litigation, and would further seek authorization to file a motion to terminate for Petitioner’s failure to list all RPIs, specifically referencing these same parties. Patent Owner did not indicate that it intended to add Pono Paani, LLC or Electric Sheep Fencing, LLC as defendants.

III. Precise Relief Requested

Although Petitioner submits that no RPIs have been omitted in its corrected petition, Petitioner requests leave to submit—without altering the filing date of the petition—updated mandatory disclosures listing Rubicon Communications, LLC, and James W. and Jamie L. Thompson (in their executive capacities as owners/managers of the named entities) as real parties-in-interest, in order to

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