

Redacted, non-confidential version of  
Patent Owner's Opposition to  
Petitioner's Motion to Correct Clerical  
Mistake under 37 CFR § 42.104(c)

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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RUBICON COMMUNICATIONS, LP  
Petitioner,

v.

LEGO A/S  
Patent Owner.

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Case IPR2016-01187  
Patent 8,894,066

**PATENT OWNER'S OPPOSITION TO PETITIONER'S  
MOTION TO CORRECT  
CLERICAL MISTAKE UNDER 37 CFR § 42.104(C)**

## **I. Introduction**

Per the Board's authorization given on November 16, 2016, LEGO A/S (the "Patent Owner") respectfully submits its opposition to Petitioner's Motion to Correct Clerical Mistake under 37 CFR § 42.104(c) (the "Motion to Correct"). Through its motion, Rubicon Communications, LP (the "Petitioner") seeks permission to file a corrected petition listing Smallworks, LLC as a real party in interest. The Petitioner has failed to meet its burden as the moving party under 37 C.F.R. §§ 42.20(c) and 42.22(a)(2) and has falsely claimed the absence of prejudice to the Patent Owner. Accordingly, the Patent Owner respectfully requests the Board deny the Petitioner's Motion to Correct.

## **II. Background**

Before responding to the Petitioner's Statement of Material Facts, the Patent Owner submits a more comprehensive set of facts here. On May 29, 2015, the Patent Owner filed a complaint against Rubicon Communications, LP dba Smallworks in District of Connecticut, alleging infringement of the U.S. Patents Nos. 7,731,191; 8,091,892; 8,628,085; and 8,894,066 (the "Connecticut litigation"). (Ex. 1024.) Summons to the Petitioner was issued on June 1, 2015 and served on June 10, 2015. On July 31, 2015, "Defendant Rubicon

Communications, LLC ('Rubicon') and SmallWorks, LLC ('SmallWorks')"

answered, stating:

Rubicon Communications, LP dba SmallWorks does not exist. There are now two separate companies: Rubicon Communications, LLC and SmallWorks, LLC. Rubicon no longer engages in any of the alleged infringing activities. Rubicon also no longer does business as SmallWorks. Current manufacturing, offering for sale, and sales of the accused products are done solely by SmallWorks, which should be the only defendant entity in this lawsuit.

(Ex. 2011 at Paragraph 2.) The Petitioner's Corporate Disclosure Statement filed concurrently also states: "Rubicon Communications, LP dba SmallWorks is no longer a corporate entity. There are now two corporate entities: Rubicon Communications, LLC and SmallWorks, LLC." (Ex. 2012.) On September 11, 2015, Rubicon Communications, LLC and SmallWorks LLC filed their First Amended Answer, repeating the block quote above verbatim. (Ex. 2003 at Paragraph 2.)

On October 14, 2015, the Patent Owner moved to add Smallworks, LLC as a defendant and extend the deadline to join parties and amend pleadings after further discovery. (Ex. 2004.) The court granted the motion and also ordered, "on or before 12/3/2015, Defendant must produce discovery regarding the corporate transaction(s) referenced in paragraph 2 of its answer . . . ." (Ex. 2005.) Despite the court's Order, the parties have been engaged in prolonged discovery disputes

over the Petitioner's corporate transactions, and the Patent Owner continues to search for more information through depositions beginning on December 5, 2016 and further written discovery. (Ex. 2017 ("Alquist Decl.") at Paragraph 3.) On November 5, 2015, Rubicon Communications, LP and SmallWorks, LLC answered the amended complaint, stating: "Rubicon no longer exists. Current manufacturing, offering for sale, and sales of the accused products are done solely by SmallWorks, which should be the only defendant entity in this lawsuit." (Ex. 2013 at Paragraph 2.)

Notwithstanding representations made to the United States District Court for the District of Connecticut, the allegedly-non-existent Rubicon Communications, LP filed on June 10, 2016 its Petition for Inter Partes Review of United States Patent No. 8,894,066 Pursuant to 35 U.S.C. §§ 311–319, 37 C.F.R. § 42 (the "Petition"), while omitting (at least) two corporate entities, Rubicon Communications, LLC and Smallworks, LLC. On June 27, 2016, the Petitioner sent a letter to the Patent Owner's counsel noting the omission of Smallworks, LLC and seeking consent to its motion to correct. (Ex. 2010.) Based on the inconsistent statements made by the Petitioner and the Defendants in the Connecticut litigation, the Patent Owner objected. The Petitioner subsequently filed on July 8, 2016 its Power of Attorney (Paper 7) and Motion for Pro Hac Vice Admission of Ryan T. Beard (Paper 9), listing only Rubicon Communications, LP

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