

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY CORPORATION,
Petitioner,

v.

ONE-E-WAY, INC.,
Patent Owner.

Case IPR2016-01638 (Patent 9,282,396 B2)
Case IPR2016-01639 (Patent 9,282,396 B2)¹

Before DAVID C. MCKONE, ROBERT J. WEINSCHENK, and
JOHN F. HORVATH, *Administrative Patent Judges*.

WEINSCHENK, *Administrative Patent Judge*.

TELECONFERENCE SUMMARY
Conduct of the Proceeding
37 C.F.R. § 42.5

¹ This Summary pertains to both of these cases. Therefore, we exercise our discretion to issue a single Summary to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

IPR2016-01638 (Patent 9,282,396 B2)

IPR2016-01639 (Patent 9,282,396 B2)

In an email on March 30, 2017, Patent Owner's lead counsel, Ms. Megan Lyman, requested authorization to withdraw from representation of Patent Owner in these cases because she was closing her legal practice to pursue another opportunity. On April 6, 2017, Judges Weinschenk and Horvath held a telephone conference call with counsel for Petitioner and Patent Owner. During the call, Ms. Lyman indicated that Patent Owner was in the process of finding new lead counsel, but had not retained anyone yet. We requested that Ms. Lyman explain to Patent Owner the importance of retaining new lead counsel as soon as possible and requested that Ms. Lyman provide us with a status update by April 12, 2017. We also explained to Patent Owner's identified back-up counsel, Mr. Jim Passe, that he must file a power of attorney from Patent Owner if he intends to serve as back-up counsel for Patent Owner in these cases. In an email on April 12, 2017, Ms. Lyman informed us that Patent Owner had not retained new lead counsel yet.

On April 24, 2017, Judges McKone, Weinschenk, and Horvath held a telephone conference call with counsel for Petitioner and Patent Owner and Mr. C. Earl Woolfork, the Chief Executive Officer of Patent Owner. During the call, Mr. Woolfork stated that Patent Owner had identified new lead counsel, Ms. Daphne Burton, but had not executed a formal agreement to retain Ms. Burton yet. Mr. Woolfork stated that he expected Patent Owner to execute a formal agreement to retain Ms. Burton shortly. Because of the upcoming deadlines in these cases, we explained to Mr. Woolfork the importance of retaining new lead counsel for Patent Owner as soon as possible.

IPR2016-01638 (Patent 9,282,396 B2)

IPR2016-01639 (Patent 9,282,396 B2)

Specifically, during the call on April 24, 2017, we explained to Mr. Woolfork, and Mr. Woolfork stated that he understood, each of the following: 1) that one possible outcome in these cases is that the claims of the challenged patent owned by Patent Owner may be found unpatentable; 2) that the likelihood of an outcome adverse to Patent Owner in these cases may increase significantly if Patent Owner is unrepresented or does not retain new lead counsel promptly; 3) that Patent Owner's Responses to the Petitions in these cases are currently due May 17, 2017; and 4) that any arguments for patentability not raised in Patent Owner's Responses may be waived. Accordingly, we encouraged Mr. Woolfork to retain new lead counsel for Patent Owner, and to have new lead counsel file a power of attorney and make an appearance in these cases by updating Patent Owner's mandatory notices by April 28, 2017.

IPR2016-01638 (Patent 9,282,396 B2)

IPR2016-01639 (Patent 9,282,396 B2)

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