

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SHIRE DEVELOPMENT LLC,
Petitioner,

v.

LCS GROUP, LLC,
Patent Owner.

Case IPR2014-00739
Patent 8,318,813 B2

Before LINDA M. GAUDETTE, LORA GREEN, and
KRISTINA M. KALAN, *Administrative Patent Judges*.

GREEN, *Administrative Patent Judge*.

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

A conference call was held on Wednesday, November 19, 2014,
among Sandra Kuzmich, Laura Fanelli, and Russell Garman, representing
Petitioner; Joseph Lucci and David Farsiou, representing Patent Owner; and

Judges Green, Gaudette, and Kalan. Counsel for Patent Owner requested the call to request authorization to file a motion to withdraw from representation of Patent Owner, LCS Group, LLC.

Counsel may withdraw from an *inter partes* review proceeding only with authorization from the Board. 37 C.F.R. § 42.10(e). According to Counsel for Patent Owner, the inventor of the patent at issue, Dr. Louis Sanfilippo, wishes to represent himself in this proceeding. Patent Owner's Mandatory Notices (Paper 5), however, indicate that a juristic entity, LCS Group, LLC, is the designated as the patent owner and real party-in-interest. We informed counsel that as the patent at issue is assigned to a juristic entity, i.e., LCS Group, LLC, which is also designated as being the real party-in-interest, Dr. Sanfilippo cannot proceed *pro se* in this proceeding at this time. 37 C.F.R. § 1.31 (2012); *see Motorola Mobility LLC v. Michael Arnouse*, IPR2013-00010 (PTAB April 19, 2013) (Paper 30).

Counsel for Patent Owner also inquired as to whether LCS Group, LLC could assign ownership back to Dr. Sanfilippo, so that he could proceed *pro se* in this proceeding. As noted in *Motorola Mobility LLC*, however, patent ownership is not the proper test for determining the real party-in-interest. *Id.*, *see also Motorola Mobility LLC v. Michael Arnouse*, IPR2013-00010, slip op. at 3-5 (PTAB April 5, 2013) (Paper 27). Thus, to the extent that Dr. Sanfilippo has assigned any rights in the patent to LCS Group, LLC, merely assigning ownership of the patent at issue to Dr. Sanfilippo may not be sufficient, as counsel for Patent Owner would still have to show that Dr. Sanfilippo is also the only real party-in-interest.

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We noted further that given the complexity and very technical nature of these proceedings, *pro se* representation carries significant risk. In that regard, we note that IPR proceedings are conducted according to a statutorily mandated time frame, with a final decision rendered one year from institution. *See US Dept. of Homeland Security v. Larry Golden*, IPR2014-00714 (PTAB November 10, 2014) (Paper 17).

Accordingly, it is

ORDERED that Counsel for Patent Owner is not authorized to file a motion to withdraw from representation of Patent Owner at this time.

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