

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SQUARE, INC.,  
Petitioner,

v.

THINK COMPUTER CORPORATION,  
Patent Owner.

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Case CBM2014-00159  
Patent 8,396,808 B2

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Before MICHAEL W. KIM and BART A. GERSTENBLITH,  
*Administrative Patent Judges.*

KIM, *Administrative Patent Judge.*

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

On July 2, 2015, a conference call was held between counsel for Petitioner and Patent Owner, as well as Judges Kim and Gerstenblith. During the call, Petitioner requested authorization to file a motion for sanctions against Patent Owner, due to Patent

Owner's *ex parte* communication with and harassment of Petitioner's expert, Dr. Normal Sadeh. A copy of the email, forwarded to the Board by Petitioner's counsel, addressed from Patent Owner to Dr. Sadeh, is attached as Exhibit 3001. Petitioner characterizes generally the contents of the email as a threat to use Dr. Sadeh's cross-examination testimony (Ex. 2019) to publicly shame Dr. Sadeh and file baseless legal actions, if Dr. Sadeh does not withdraw his testimony.

As a result of Patent Owner's conduct, Petitioner asserts that Dr. Sadeh feels threatened, rattled, and harassed to the detriment of Petitioner, in that it is not entirely clear whether Dr. Sadeh will continue to be available to Petitioner in this proceeding. Petitioner relies heavily on Dr. Sadeh's expert testimony in making its case, and Petitioner asserts that the case has progressed too far to find a timely replacement. Accordingly, Petitioner requests that (1) the Board assist in discontinuing contact between Patent Owner and Dr. Sadeh, and (2) the Board sanction Patent Owner, some options including (a) deem Dr. Sadeh's testimony as unrebutted fact, and (b) expunge certain papers of record, for example, Dr. Sadeh's cross-examination (Ex. 2019) and Mr. Greenspan's Declaration (Ex. 2005).

Patent Owner's counsel responds it was not aware of the aforementioned email communication, and that sanctions are not appropriate. Patent Owner's counsel opines that Patent Owner stands behind the substance of the communication, that this does not constitute harassment as there is nothing illegal about communicating an intention to take appropriate legal action, that Patent Owner's

counsel is not involved with the referenced potential legal actions as they are outside the scope of this proceeding, and that a motion to exclude is a more appropriate vehicle for dealing with this situation. Patent Owner's counsel concedes that direct contact between Patent Owner and Dr. Sadeh is not ideal, and that generally any matter affecting a legal proceeding should run through counsel.

Petitioner replies that *ex parte* communications between a party and an opposing expert is inappropriate under any circumstances, that the threatened legal action is wholly unfounded, that a motion to exclude is not an appropriate vehicle for dealing with threatening conduct, that Dr. Sadeh's form of testimony is typical of the form of testimony presented in these types of proceedings, and that these type of actions are ongoing and have been representative of Patent Owner's conduct throughout this proceeding.

As an initial matter, we agree that any *ex parte* communication between Patent Owner and Dr. Sadeh outside the presence of counsel is wholly inappropriate. We are persuaded further that additional briefing on the matter is warranted, given the above circumstances.

IT IS ORDERED that Patent Owner is prohibited from contacting Dr. Sadeh without prior Board authorization;

IT IS FURTHER ORDERED that Petitioner is authorized to file a motion for sanctions by July 14, 2015;

IT IS FURTHER ORDERED that Patent Owner is authorized to file an opposition to the motion for sanctions by July 23, 2015; and

IT IS FURTHER ORDERED that Patent Owner is authorized to file a reply to the motion for sanctions by August 3, 2015.

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