

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DEFI EDUCATION FUND,
Petitioner,

v.

TRUE RETURN SYSTEMS, LLC,
Patent Owner.

IPR2023-01388
Patent 10,025,797 B1

Before KEVIN F. TURNER, JEFFREY S. SMITH, and
CHRISTA P. ZADO, *Administrative Patent Judges*.

ZADO, *Administrative Patent Judge*.

DECISION

Conduct of the Proceeding

37 C.F.R. § 42.5(a)

I. INTRODUCTION

A. Background

On January 5, 2024, we instituted *inter partes* review in this matter. Paper 7, “Institution Decision” or “Inst. Dec.” We noted in our Institution Decision that the Preliminary Response (Paper 6, “Preliminary Response” or “Prelim. Resp.”) was filed by the sole named inventor of the ’797 patent, Jack Fonss, even though lead counsel had been designated to represent Patent Owner True Return Systems, LLC (“Patent Owner”). Inst. Dec. 1, fn. 1; *see* Prelim. Resp. 48 (signed by Mr. Fonss), Certification of Word Count and Certification of Service filed with Preliminary Response (signed by Mr. Fonss); Paper 4, 1 (designating David A. Boag as lead counsel). In our Institution Decision, we further noted that previous PTAB panels have followed the rule that an inventor may not proceed *pro se* before the PTAB when the challenged patent is assigned to an entity other than the inventor. Inst. Dec. 1, fn. 1. We further noted that Mr. Fonss’s filing of the Preliminary Response raises the issue of whether he may appear *pro se* before the PTAB in this proceeding, or whether Patent Owner must be represented by legal counsel. *Id.*

The Scheduling Order issued with the Institution Decision directed the parties to contact the Board within two weeks to schedule a mandatory conference call, and required each party to be represented by legal counsel on the call. Paper 8, 1.

Pursuant to our order, on January 24, 2024 a conference call was held, attended by 1) Judges Smith, Turner, and Zado; 2) Mark DeBoy and Patrick Finnan, counsel for DeFi Education Fund (“Petitioner”); and 3) David Boag, counsel for Patent Owner, and Mr. Fonss. During the call, we discussed the

issue of whether Mr. Fonss seeks to represent Patent Owner, and he indicated that he does.

Presently, Mr. Boag has been designated as lead counsel for Patent Owner, and he is in fact lead counsel for Patent Owner, unless and until he requests, and the Board grants, his withdrawal.¹ Paper 4, 1; *see also* 37 C.F.R. § 42.10(e) (“Counsel may not withdraw from a proceeding before the Board unless the Board authorizes such withdrawal.”).

Mr. Fonss is not authorized to represent Patent Owner in this matter. We therefore order Patent Owner to file a paper to show good cause as to why Mr. Fonss should be allowed to do so. Patent Owner may respond in the paper that Mr. Fonss will not represent Patent Owner in this matter. 37 C.F.R. § 42.5(a) (“The Board may determine a proper course of conduct in a proceeding for any situation not specifically covered by this part and may enter non-final orders to administer the proceeding.”). Petitioner is authorized to respond.

II. ORDER

Accordingly, it is

ORDERED that Patent Owner file a paper compliant with 37 C.F.R. § 42.22, not to exceed five (5) pages, no later than ten (10) days after entry of this Order, to show good cause why Mr. Fonss should be allowed to

¹ We note that backup counsel has not been designated, and we direct Patent Owner to designate backup counsel. *See* Paper 4, 1 (designating lead counsel, but not designating backup counsel; 37 C.F.R. § 42.10 (“If a party is represented by counsel, the party must designate a lead counsel and at least one back-up counsel who can conduct business on behalf of the lead counsel.”)).

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represent Patent Owner in this matter² or state that Mr. Fonss will not represent Patent Owner in this matter; and

FURTHER ORDERED that Petitioner is authorized to file a response compliant with 37 C.F.R. § 42.23, not to exceed five (5) pages, no later than one week after entry of Patent Owner's filing.

² Patent Owner's brief must be signed and submitted by Patent Owner's legal counsel.

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