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**UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF CALIFORNIA**

**IN RE: AMERANTH  
PATENT LITIGATION**

**CASE NOS.**

11cv1810 DMS (WVG)	12cv1643 DMS (WVG)
12cv0729 DMS (WVG)	12cv1644 DMS (WVG)
12cv0731 DMS (WVG)	12cv1646 DMS (WVG)
12cv0732 DMS (WVG)	12cv1648 DMS (WVG)
12cv0733 DMS (WVG)	12cv1649 DMS (WVG)
12cv0737 DMS (WVG)	12cv1650 DMS (WVG)
12cv0739 DMS (WVG)	12cv1651 DMS (WVG)
12cv0742 DMS (WVG)	12cv1652 DMS (WVG)
12cv0858 DMS (WVG)	12cv1653 DMS (WVG)
12cv1627 DMS (WVG)	12cv1654 DMS (WVG)
12cv1629 DMS (WVG)	12cv1655 DMS (WVG)
12cv1630 DMS (WVG)	12cv1656 DMS (WVG)
12cv1631 DMS (WVG)	13cv0350 DMS (WVG)
12cv1633 DMS (WVG)	13cv0352 DMS (WVG)
12cv1634 DMS (WVG)	13cv0353 DMS (WVG)
12cv1636 DMS (WVG)	13cv1072 DMS (WVG)
12cv1640 DMS (WVG)	13cv1520 DMS (WVG)
12cv1642 DMS (WVG)	13cv1525 DMS (WVG)
12cv2350 DMS (WVG)	13cv1840 DMS (WVG)

**DECLARATION OF JOHN W. OSBORNE IN  
SUPPORT OF PLAINTIFF AMERANTH, INC.'S  
MOTION TO DISQUALIFY COUNSEL**

**Date:** January 3, 2014  
**Time:** 1:30 p.m.  
**Location:** Courtroom 13A  
**Judge:** Hon. Dana M. Sabraw

Complaint Filed: August 15, 2011

1 I, John W. Osborne, declare as follows:

2 1. I am an attorney licensed to practice and in good standing with the  
3 State Bar of New York, and am admitted in this matter *pro hac vice* in the United  
4 States District Court for the Southern District of California. I am one of the  
5 counsel of record for Plaintiff Ameranth, Inc. (“Ameranth”), in these consolidated  
6 cases. I was also counsel of record for Ameranth in the *Ameranth v. Menusoft*  
7 case, filed in the Eastern District of Texas as Case No. 2:07-cv-271. I am also  
8 counsel of record for Ameranth in the covered business method (“CBM”) petition  
9 proceedings instituted by the defendants herein before the USPTO on four of  
10 Ameranth’s patents. On these bases, I have first-hand personal knowledge of the  
11 facts set forth in this declaration. If called upon to testify, I would and could do so  
12 competently as set forth herein. I provide this declaration in support of  
13 Ameranth’s Motion to Disqualify Counsel.

14 2. The *Ameranth v. Menusoft* case was presided over by the Honorable  
15 Chad Everingham, of the Eastern District of Texas. The defendants in that case  
16 were accused of infringing Ameranth’s ‘850, ‘325 and ‘733 patents. Those are  
17 three of the four patents that are at issue in both the consolidated cases pending  
18 before this Court and in the CBM petitions before the Patent Office.

19 3. The law firm representing the defendants in the *Ameranth v. Menusoft*  
20 lawsuit was Fulbright & Jaworski, LLP (now known as Norton Rose Fulbright  
21 LLP) (the “Fulbright Firm”). The Fulbright attorneys chiefly responsible for  
22 representing the defendants in the *Ameranth v. Menusoft* case included Richard  
23 Zembek, Mark Delflache, and Dustin Mauck, among others.

24 4. In the *Ameranth v. Menusoft* case, Judge Everingham presided over,  
25 among other things, a motion for summary judgment on a “best mode” defense, the  
26 claim construction hearing (resulting in 3 separate claim construction orders), the  
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1 jury trial (conducted from September 13-20, 2010), and settlement conferences  
2 held separately with the parties during the trial to attempt to resolve the dispute.  
3 During this period of time, Judge Everingham's sole law clerk was Jim Warriner,  
4 who was in attendance during hearings, at the *Markman* proceeding, and at trial.

5 5. Lodged with the Court as Exhibit 3 to the Notice of Lodgment filed  
6 herewith is a true and correct copy of the minutes for the *Markman* hearing held in  
7 the *Ameranth v. Menusoft* case on February 17, 2010. As reflected in those  
8 minutes, Mr. Warriner was present as Judge Everingham's law clerk, I presented  
9 the claim construction argument for Ameranth, and Richard Zembek presented the  
10 claims construction argument for the defendants, with Mark Delflache in  
11 attendance.

12 6. I also represented Ameranth in a patent infringement action entitled  
13 *Ameranth v. Par Technology Corp.*, Eastern District of Texas Case No. 2:10-cv-  
14 294. That case involved infringement of Ameranth's '850, '325 and '733 patents  
15 as well. Judge Everingham was the Magistrate Judge assigned to the *Ameranth v.*  
16 *Par* lawsuit for a period of time during which Mr. Warriner was still Judge  
17 Everingham's law clerk. Attached as Exhibit 13 to the Notice of Lodgment filed  
18 herewith is a true and correct copy of an order issued by Judge Everingham in the  
19 *Ameranth v. Par* lawsuit on August 31, 2010, Dkt. No. 10 in that Court's electronic  
20 filing system.

21 7. The defendants in the *Ameranth v. Menusoft* case also asserted an  
22 inequitable conduct defense against the patents. Judge Everingham denied and  
23 dismissed the inequitable conduct claim, without holding a separate hearing on the  
24 issue.

25 8. Ameranth commenced the earliest of consolidated cases pending  
26 before this Court in August of 2011. One of the original defendants was Papa  
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1 John's. Papa John's has been represented at all times by the Fulbright Firm, and  
2 Richard Zembek, and Mark Delflache and Dustin Mauck have been among the  
3 primary members of the Fulbright team representing Papa John's in the matter.  
4 Attorney Gilbert Greene of the Fulbright Firm's Austin office has also been  
5 involved in the matter.

6 9. As the litigation has progressed, and additional defendants have been  
7 added to the consolidated cases, the Fulbright Firm has expanded its representation  
8 of defendants accused of infringing Ameranth's '850, '325, '733 and '077 patents,  
9 so that the Fulbright Firm now represents Papa John's, Expedia, Fandango, Hotel  
10 Tonight, Hotels.com, Hotwire, Kayak, Live Nation/TicketMaster, Micros, Orbitz,  
11 StubHub, Travelocity, Wanderspot and OpenTable (the "Fulbright Defendants").  
12 Furthermore, Richard Zembek serves as the "liaison counsel" for the non-Fulbright  
13 defendants in the consolidated cases pursuant to a directive by Magistrate Judge  
14 Stormes for the appointment of such a primary liaison counsel for the defendants.

15 10. In October of 2013, the majority of the defendants in the consolidated  
16 cases, including the Fulbright Defendants, filed CBM petitions with the USPTO  
17 challenging Ameranth's '850, '325, '733 and '077 patents. Richard Zembek, of  
18 the Fulbright Firm's Houston office, and Gilbert Greene, of the Fulbright Firm's  
19 Austin office, are listed as the primary attorneys for the petitioners. Thus, the  
20 Fulbright Firm was and/or is involved in the *Ameranth v. Menusoft* lawsuit, the  
21 consolidated cases, and the CBM proceedings involving Ameranth and the same  
22 Ameranth patents.

23 11. As discussed in the Motion to Disqualify Counsel, the defendants  
24 have raised a number of challenges to the validity of the 850, '325 and '733 patents  
25 in the consolidated cases, including many of the same challenges previously raised  
26 to those same patents in the *Ameranth v. Menusoft* action. Furthermore, the  
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1 defendants, including the Fulbright Defendants, raise a number of defenses and  
2 issues arising directly out of the *Ameranth v. Menusoft* lawsuit, including  
3 allegations of collateral estoppel and inequitable conduct charges, and a number of  
4 issues that are impacted by Judge Everingham's rulings in *Ameranth v. Menusoft*,  
5 including his three claim construction orders. Thus, there are substantial  
6 overlapping issues between the *Ameranth v. Menusoft* litigation and the  
7 consolidated cases before this Court. Likewise, the CBM petitions challenge the  
8 validity of the patents in suit on many of the grounds unsuccessfully asserted as  
9 defenses in the *Ameranth v. Menusoft* matter or at odds with Judge Everingham's  
10 rulings and claim constructions, as discussed in Ameranth's Opposition to the  
11 defendants' Motion to Stay [Dkt. No. 526].

12       12. In emails recently exchanged between the Fulbright Firm and counsel  
13 for Ameranth concerning the consolidated cases and the CBM petitions (see NOL,  
14 Exhs. 4-9), Jim Warriner was included as a recipient. I did not "pick up" on the  
15 inclusion of Mr. Warriner in the list of email recipients, or realize who he was,  
16 until mid-November of 2013. At that time I checked the Fulbright Firm's website  
17 and learned, for the first time, that the same Jim Warriner who clerked for Judge  
18 Everingham in the *Ameranth v. Menusoft* case was now working as an associate  
19 attorney in the Fulbright Firm's Austin office (the same office in which Mr.  
20 Greene apparently works) adverse to Ameranth in both the consolidated cases and  
21 the CBM petitions.

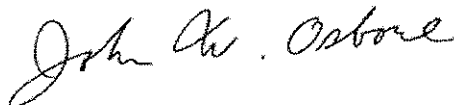
22       13. Ameranth was never notified by Mr. Warriner, the Fulbright Firm or  
23 any of the Fulbright attorneys working on these matters that Mr. Warriner had  
24 joined Fulbright. Ameranth was never asked to consent to allow Mr. Warriner to  
25 work on these matters (and no such consent would have been given in any event).  
26 Neither Ameranth, the Court, nor the USPTO, to my knowledge, has been served  
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1 with the “screening” notices required by Model Rule of Professional Conduct  
2 1.12(c)(2) or 37 C.F.R. §11.112(c)(2).

3 14. Because of Mr. Warriner’s substantial personal involvement in the  
4 *Ameranth v. Menusoft* case, and the significant overlap and similarities between  
5 that case, the consolidated cases, and the CBM proceedings, Ameranth believes  
6 that it is prejudiced by Mr. Warriner’s participation in these matters and objects to  
7 his involvement and the continuing involvement of any attorneys in his law firm.

8 15. Furthermore, because of the joint defense agreement in place between  
9 the defendants, Mr. Zembek’s role as liaison counsel for the non-Fulbright  
10 Defendants, and the high level of communication and cooperation that appears to  
11 exist between all of the joint defense group defendants, Ameranth is concerned that  
12 other defense counsel may have been tainted by contact and communication with  
13 the Fulbright attorneys working on these matters.

14 I declare under penalty of perjury under the laws of the United States that  
15 the foregoing is true and correct of my own personal knowledge and that I  
16 executed this declaration on November 20, 2013, in Cortlandt Manor, New York.

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John W. Osborne