

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

KINIK COMPANY,
Petitioner,

v.

CHIEN-MIN SUNG,
Patent Owner.

Cases IPR2014-01523
Patent No. 8,777,699

Before MICHAEL W. KIM, DONNA M. PRAISS, and
BARRY L. GROSSMAN, *Administrative Patent Judges*.

CRUMBLEY, *Administrative Patent Judge*.

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

In this *inter partes* review proceeding, counsel for Patent Owner filed a Motion to Withdraw on November 4, 2014, without prior authorization of the Board. Paper 6. A conference call was held on November 6, 2014, at the request of the Board, with Gordon K. Hill, counsel for Patent Owner, Brian C. McCormack and William D. McSpadden, counsel for Petitioner, and Judges Kim, Praiss, and Grossman. For the following reasons, we *expunge* the Motion as improperly filed.

During the call, Mr. Hill represented that he filed the Motion to Withdraw because he has not received an engagement letter or retainer from the Patent Owner. When asked whether Patent Owner will retain alternate counsel, Mr. Hill was not aware of alternate counsel and indicated that he has not had any communications with Patent Owner since about October 15, 2014. We explained that a power of attorney from Patent Owner is in the record and that until a motion to withdraw is granted, he has real responsibilities as attorney of record.

Counsel may withdraw from an *inter partes* review proceeding only with authorization from the Board. 37 C.F.R. § 42.10(e). We will not authorize Mr. Hill to file a motion to withdraw at this time because he has not been relieved of duty from Patent Owner, he simply has not received instructions from Patent Owner. At this stage in the proceeding, a Preliminary Response may be filed by January 2, 2015 and such a filing is optional not mandatory. 37 C.F.R. § 42.107(a). Going forward, counsel for Patent Owner shall request a conference with the Board to discuss the need for a motion to withdraw when circumstances warrant, for example, if new counsel is retained by Patent Owner or Patent Owner participates in the conference with the Board.

“The Board may expunge any paper directed to a proceeding or filed while an application or patent is under the jurisdiction of the Board that is not authorized

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under this part or in a Board order.” 37 C.F.R. § 42.7(a). Accordingly, we shall expunge the improperly filed Motion to Withdraw (Paper 6) from the record of this case.

Based on the foregoing, it is

ORDERED that Paper 6 shall be expunged from the record of Case IPR2014-01523;

FURTHER ORDERED that Gordon Hill and A. John Pate are not authorized, at this time, to file a motion to withdraw as counsel for Patent Owner; and

FURTHER ORDERED that Gordon Hill and A. John Pate both remain as attorney of record for Patent Owner.

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