

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

VOIP-PAL.COM INC.,
Patent Owner

Cases IPR2016-01198 and IPR2016-01201
Patents 9,179,005 B2 and 8,542,815 B2¹

Before JOSIAH C. COCKS and JOHN A. HUDALLA, *Administrative
Patent Judges.*

COCKS, *Administrative Patent Judge.*

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

¹ This Order pertains to both noted proceedings. The Board exercises its discretion to issue a single Order for entry in each proceeding. The parties are not authorized to use this style heading for any subsequent papers.

1. Introduction

On January 19, 2017, a call was held between counsel for the respective parties and Judges Cocks, Chagnon, and Hudalla. Apple Inc. (“Petitioner”) was represented by Adam Seitz. Voip-Pal.com, Inc. (“Patent Owner”) was represented by Kevin Malek. In e-mail correspondence requesting the call, Patent Owner indicated that it was seeking authorization to file a motion for withdrawal of counsel associated with the Knobbe Martens law firm² who had been representing Patent Owner in these proceedings.³

2. Discussion

During the call, counsel for Patent Owner (Mr. Malek) indicated that Patent Owner had discharged its prior counsel (Knobbe Martens) and that such was the reason for the request to file a motion for withdrawal. Petitioner indicated that it objected to Patent Owner’s request to file a motion for withdrawal of counsel because a motion requesting sanctions against Patent Owner is pending in each of IPR2016-01198 and IPR2016-01201 (Paper 55 in each proceeding, “Motions for Sanctions”). According to Petitioner, those Motions for Sanctions raise the question of the involvement of counsel associated with Knobbe Martens in connection with certain correspondence to the Board.

Pursuant to 37 C.F.R. § 42.10(e), “[c]ounsel may not withdraw from a proceeding before the Board unless the Board authorizes such withdrawal.”

² No counsel associated with Knobbe Martens was present on the call.

³ Both parties had arranged for a court reporter on the call. As agreed by the parties, when a transcript of the call is available, Petitioner will file a copy of the transcript using its next available exhibit number.

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At this time, and pending resolution of the Motions for Sanctions, we do not authorize either a motion for withdrawal of counsel or any withdrawal of counsel. Mr. Malek, however, may take the necessary steps to designate himself lead counsel for Patent Owner going forward in these proceedings.

3. Order

It is ORDERED that a motion for the withdrawal of counsel is not authorized, nor is any counsel authorized to withdraw from these proceedings at this time.

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