

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MICROSOFT CORPORATION,  
Petitioner,

v.

IPR LICENSING, INC.,  
Patent Owner.

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Case IPR2015-00074  
Patent 8,380,244 B2

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Before BEVERLY M. BUNTING, *Administrative Patent Judge*.

DECISION

Motion to Withdraw  
Motion for Pro Hac Vice Admission of Mr. Scott M. Border  
37 C.F.R. § 42.10

## I. Background

On December 12, 2014, in an email to the Panel, Microsoft Corporation (“Petitioner”), requested authorization to file a motion to withdraw Mr. John Haynes and Mr. David Frist both of Alston & Bird LLP, as counsel in IPR2015-00074 and substitute new counsel. Petitioner indicated that the parties had conferred, and IPR Licensing, Inc. (“Patent Owner”) did not oppose either the motion to withdraw or substitution of new counsel. On December 15, 2015, the Panel authorized filing of the motion to withdraw via email, and requested that Petitioner, in the motion, certify that it had conferred with Patent Owner and that Patent Owner did not oppose either the motion to withdraw or substitution of new counsel.

Petitioner filed the motion to withdraw on December 16, 2014 (Paper 15) certifying that “it has conferred with Patent Owner regarding this request, and Patent Owner has indicated that it does not oppose the withdrawal of counsel or the substitution of new counsel.” *Id.* at 3. Petitioner contemporaneously filed a new Power of Attorney, appointing Mr. Joseph A. Micallef as lead counsel, and Mr. Douglas I. Lewis and Mr. Scott M. Border as back-up counsel, all of Sidley Austin. Paper 14. Petitioner subsequently filed a motion for pro hac vice admission of Mr. Border, supported by the Declaration of Mr. Border. Paper 16. Patent Owner indicated via an email dated February 12, 2012, that it does not oppose Petitioner’s motion.

For the following reasons, the motions are granted.

## II. Discussion

### *Withdrawal of Previous Counsel*

Counsel may withdraw from an *inter partes* review proceeding only with authorization from the Board. 37 C.F.R. § 42.10(e). In deciding a motion to withdraw, the Board will consider the effect of granting such a motion “on the economy, the integrity of the patent system, the efficient administration of the Office, and the ability of the Office to timely complete proceedings.” *See* 35 U.S.C. § 316(b). Upon review of Petitioner’s motion, we note that Petitioner seeks withdrawal so that Petitioner may be represented by new counsel, and Patent Owner does not oppose. The motion sets forth good cause for withdrawal of Petitioner’s current counsel and substitution of counsel, and we are aware of no prejudice to either party that would result from such withdrawal.

### *Motion for Pro Hac Vice Admission*

Pursuant to 37 C.F.R. § 42.10(c), we may recognize counsel *pro hac vice* during a proceeding upon a showing of good cause, subject to the condition that lead counsel be a registered practitioner. In authorizing motions for *pro hac vice*, we require the moving party to provide a statement of facts showing there is good cause for us to recognize counsel *pro hac vice*, and an affidavit or declaration of the individual seeking to appear in the proceedings.

Upon review of Petitioner’s motion and supporting evidence, we determine that Petitioner has demonstrated that Mr. Border has sufficient legal and technical qualifications to represent Petitioner in the instant proceeding. We also recognize that there is a need for Petitioner to have Mr.

Border be involved in the proceedings at issue. Accordingly, Petitioner has established that there is good cause for admitting Mr. Border.

### III. Order

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner's motion to withdraw is granted and that Mr. John Haynes and Mr. David Frist are allowed to withdraw as counsel from this proceeding;

FURTHER ORDERED that Mr. Joseph A. Micallef is recognized as Lead Counsel for Petitioner and that Mr. Douglas I. Lewis and Mr. Scott M. Border are recognized as Back-up Counsel for Petitioner;

FURTHER ORDERED that Petitioner shall update its Mandatory Notices to reflect the change in counsel;

FURTHER ORDERED that Petitioner's motion for pro hac vice admission of Scott M. Border for this proceeding is granted; and

FURTHER ORDERED that Mr. Border is to comply with the Office Patent Trial Practice Guide and the Board's Rules of Practice for Trials, as set forth in Part 42 of the C.F.R., and to be subject to the Office's Code of Professional Responsibility set forth in 37 C.F.R. §§ 11.01 et seq. and disciplinary jurisdiction under 37 C.F.R. § 11.10(a).

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PETITIONER:

Joseph A. Micallef  
Sidley Austin LLP  
[jmicallef@sidley.com](mailto:jmicallef@sidley.com)

Douglas I. Lewis  
Sidley Austin LLP  
[dilewis@sidley.com](mailto:dilewis@sidley.com)

Scott Border  
Sidley Austin LLP  
[sborder@sidley.com](mailto:sborder@sidley.com)

PATENT OWNER:

Jonathan D. Link  
Latham & Watkins LLP  
[jonathan.link@lw.com](mailto:jonathan.link@lw.com)

Julie M. Holloway  
Latham & Watkins LLP  
[julie.holloway@lw.com](mailto:julie.holloway@lw.com)