

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD. and SAMSUNG ELECTRONICS
AMERICA, INC.,
Petitioners,

v.

DARELTECH, LLC INC.,
Patent Owner.

IPR2019-01528 (Patent 8,717,328 B1)
IPR2019-01529 (Patent 8,593,427 B1)
IPR2019-01575 (Patent 9,075,612 B2)¹

Before BRIAN J. McNAMARA, KEVIN C. TROCK, and
STACY B. MARGOLIES, *Administrative Patent Judges*.

TROCK, *Administrative Patent Judge*.

ORDER

¹ The Parties are not authorized to use this caption.

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On April 21, 2020, the Panel held a conference call with counsel for Petitioner, Mr. Jeffrey Miller, counsel for Patent Owner, Mr. David Hecht, and Mr. Ramzi Maalouf, Managing Director of Patent Owner, DarelTech, LLC Inc. The purpose of the call was to discuss Mr. Hecht's request to file a motion to withdraw as counsel of record under 37 CFR § 42.10(e) and for an extension of time, as well as certain *ex parte* communications ("Communications") received by the Board including a request from Mr. Maalouf, made on behalf of Patent Owner, for a stay of the proceedings.

Mr. Hecht's request for authorization under 37 CFR § 42.10(e) to file a motion to withdraw as counsel of record is denied at this time in order to provide Patent Owner time to find substitute counsel and to continue to prepare a Patent Owner Response. Mr. Hecht was advised that he may resubmit his request for authorization file a motion to withdraw at such time as Patent Owner has obtained substitute counsel.

The purpose of Mr. Maalouf's Communications with the Board involved his concern over Mr. Hecht's desire to withdraw as counsel of record and we appreciate Patent Owner's need for continuous representation. Our ruling herein denying Mr. Hecht's request to file a motion to withdraw until Patent Owner obtains new counsel should alleviate Mr. Maalouf's concern.

The rules concerning *ex parte* communications were also discussed during the conference call. *See e.g.*, 37 C.F.R. § 42.5(d). Because of a concern with possible attorney client privileged or sensitive confidential information inadvertently included in the Communications to the Board by Mr. Maalouf, we requested that Mr. Hecht advise us of any proposed

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redactions to the Communications. We have received and considered Patent Owner's proposed redactions and agree that the redactions are reasonable and warranted. Accordingly, the redacted Communications will be entered in the record as Exhibits 3001–3004, available only to the Board and the parties at this time. Exhibit 3001 is an email dated April 14, 2020, sent from Mr. Maalouf to Trials@uspto.gov. Exhibit 3002 is a redacted version of the letter attached to the April 14, 2020 email. Exhibit 3003 is a redacted version of an email dated April 22, 2020, sent from Mr. Hecht to Trials@uspto.gov. Exhibit 3004 is the PDF attached to the April 22, 2020 email.

Patent Owner's request to stay these proceedings, or for an extension of time, is denied at this time. These proceedings are in their early stages. The Decisions on Institution in these cases were issued on March 16, 2020. On the conference call, we encouraged the parties to meet and confer to reach an agreement on any movable deadlines in the schedule, if necessary. The parties subsequently stipulated to extending the deadlines for Patent Owner's response to the petition, Patent Owner's motion to amend, Petitioner's reply, and Patent Owner's sur-reply by approximately one month. *See, e.g.*, IPR2019-01528, Paper 9. In view of the parties' agreement regarding these upcoming deadlines and the early stages of these proceedings, we deny Patent Owner's request for a stay or an extension of time. We will consider additional relief in the future as circumstances brought to our attention warrant.

Accordingly, it is

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ORDERED that Patent Owner's Counsel's request for authorization under 37 CFR § 42.10(e) to file a motion to withdraw as counsel of record is denied at this time; and

FURTHER ORDERED that the redacted *ex parte* Communications shall be entered into the record of these cases as Exhibits 3001–3004, made available only to the Board and the Parties; and

FURTHER ORDERED that the request to stay these proceedings or for an extension of time is denied at this time.

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