

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE INC.,
Petitioner

v.

PATRICK ZUILI,
Patent Owner.

Case CBM2016-00022
Patent 8,326,763 B2

Before JAMESON LEE, GLENN J. PERRY, and
MIRIAM L. QUINN, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

Decision
On Counsel's Motion to Withdraw
37 C.F.R. § 42.10(e)

On February 13, 2017, a Motion to Withdraw was filed by Petitioner's counsel Brian Rosenthal. Paper 45. Mr. Rosenthal represents that he joined a new law firm on January 19, 2017 after resigning from the law firm whose Customer Number was identified in Petitioner's Power of Attorney for this proceeding. *Id.* Mr. Rosenthal was not specifically named in that Power of Attorney. Paper 2. An Updated Mandatory Notice was filed by Petitioner on January 31, 2017, which designated Robert G. Pluta as Lead Counsel and Saqib J. Siddiqui as Backup Counsel. Paper 41. Thus, after the proposed withdrawal of Brian Rosenthal, Petitioner still will be represented by a Lead Counsel and a Backup Counsel.

Patent Owner opposes the proposed withdrawal of Brian Rosenthal as counsel for Petitioner. Paper 46. Patent Owner submits two reasons for its opposition: (1) that according to Patent Owner, Mr. Rosenthal violated numerous rules of the United States Patent and Trademark Office, in connection with Patent Owner's position that certain exhibits of Petitioner had been tampered with or falsified; and (2) that according to Patent Owner, the Motion to Withdraw is filed late, by 12 days, based on 37 C.F.R. § 41.108. *Id.* at 3–4. For reasons discussed below, these reasons are insufficient to preclude granting of the Motion to Withdraw, in light of the circumstances presented in the Motion to Withdraw.

On May 23, 2016, Mr. Rosenthal was granted *pro hac vice* admission to this proceeding. Paper 9. In support of that admission, Mr. Rosenthal had agreed to be subject to the Office's Rules of Professional Conduct as set forth in 37 C.F.R. §§ 11.101 *et. seq.* and disciplinary jurisdiction under 37 C.F.R. § 11.19(a). Ex. 1039 ¶ 6. We also ordered that Mr. Rosenthal will be subject to the Office's Rules of Professional Conduct as set forth in

37 C.F.R. §§ 11.101 *et. seq.* and disciplinary jurisdiction under 37 C.F.R. § 11.19(a). Paper 9, 3. Withdrawal of Mr. Rosenthal as counsel for Petitioner does not negate or nullify the applicability of the Office's Rules of Professional Conduct to Mr. Rosenthal or the imposition of the Office's discipline jurisdiction over Mr. Rosenthal for misconduct, if any, engaged by Mr. Rosenthal in this proceeding prior to his withdrawal.

Part 41 of Title 37 of the Code of Federal Regulations governs appeals and interferences before the Board. 37 C.F.R. § 41.1. Part 42 of Title 37 of the Code of Federal Regulations governs proceedings before the Board, including this covered business method patent review proceeding. 37 C.F.R. § 42.1. Under 37 C.F.R. § 42.8, a party has 21 days to inform the Board of a change in information regarding its counsel. Petitioner filed its Updated Mandatory Notice on January 31, 2017, indicating a change of circumstance for Brian Rosenthal and referencing an even earlier request for authorization to file a motion to withdraw with respect to Mr. Rosenthal. Paper 41, 2. Patent Owner's assertion of lateness was based on applying January 19, 2017, the date when Mr. Rosenthal joined another firm, as the triggering date of the applicable time period within which to notify the Board of the change. Paper 46, 4. The 12 days between January 19, 2017, and January 31, 2017, is within the 21 day period permitted by 37 C.F.R. § 42.8.

Subsequent to the filing of Petitioner's Updated Mandatory Notice, on February 10, 2017, we authorized Mr. Rosenthal to file a Motion to Withdraw by February 25, 2017. Paper 43, 3. The Motion to Withdraw was filed on February 13, 2017. Paper 45. The record does not support Patent Owner's assertion that the Motion to Withdraw was filed late. Even assuming that the Motion to Withdraw was filed 12 days late as alleged by

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Patent Owner (Paper 46, 4), precluding Mr. Rosenthal from withdrawing is not an appropriate remedy when he no longer possesses an effective power of attorney.

ORDER

Accordingly, it is
ORDERED that Brian Rosenthal's Motion to Withdraw as counsel for Petitioner is *granted*.

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