

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE UNITED
STATES PATENT AND TRADEMARK OFFICE

OPENSKY INDUSTRIES, LLC,
INTEL CORPORATION,
Petitioners,

v.

VLSI TECHNOLOGY LLC,
Patent Owner.

IPR2021-01064¹
Patent 7,725,759 B2

Before KATHERINE K. VIDAL, *Under Secretary of Commerce for
Intellectual Property and Director of the United States Patent and
Trademark Office.*

ORDER
*Granting Motion to Withdraw as Counsel
Granting Motion for Extension of Time
37 C.F.R. §§ 42.5, 42.10*

¹ Intel Corporation (“Intel”), which filed a petition in IPR2022-00366, has been joined as a party to this proceeding.

I. INTRODUCTION

On October 4, 2022, in my Decision on Director Review, I ordered Petitioner OpenSky Industries, LLC “to show cause as to why it should not be ordered to pay compensatory expenses, including attorney fees, to VLSI as a further sanction for its abuse of process.” Paper 102 (“Dec.” or “Decision”), 50–51; 37 C.F.R. § 42.12(b)(6). More specifically, I ordered both OpenSky and Patent Owner VLSI to file a 10-page brief by October 18, 2022, “addressing whether an award of attorney fees is appropriate, and if so, how such fees should be determined, e.g., the appropriate time frame for which fees should be assessed.” Dec. 51.

On October 7, 2022, counsel for Petitioner OpenSky filed a Motion to Withdraw as Counsel and Motion for Extension of Time, supported by a Declaration of Andrew T. Oliver. Papers 103 (“Mot.” or “Motion”), 104 (“Decl.” or “Declaration”).² The Motion requests that counsel for OpenSky, including Mr. Oliver, Vinay V. Joshi, and the law firm of Amin, Turocy & Watson LLP, be permitted to withdraw as counsel, over OpenSky’s “vehement[] oppos[ition].” Mot. 2–3. The Motion represents that OpenSky does not have replacement counsel. *Id.* at 3. According to the Motion and Declaration, withdrawal is sought pursuant to 37 C.F.R. § 11.116(a)(1). *Id.* at 2; Decl. ¶ 2.

The Motion also requests a 30-day extension of time to respond to the Director’s order to show cause. Mot. 3. The Motion intimates that a further extension of time and enlargement of pages would be requested, “as it does

² Counsel filed this Motion without authorization, due to “the extremely short deadline to respond to the order to show cause and the intervening federal holiday.” Mot. 3 (citing 37 C.F.R. § 42.20(b)). Prior authorization must be obtained for any further motion.

not appear to be possible to formulate a reasonable reply to a 51-page order within a 10-page brief or within a period of only nine business days.” *Id.* at 4. Indeed, on October 11, 2022, counsel requested permission to file an additional motion seeking an additional 30-day extension to respond to my Order, an expansion of the page limit from 10 to 35 pages, and permission to file a reply brief to address arguments made by VLSI. Ex. 3021.

Having considered the equities at issue here, I *grant* the Motion to Withdraw and *grant* the Motion for Extension of Time. I further expand the page limit and authorize reply papers to be filed as detailed below. I do not authorize any further motions for extension of time, expansion of page limits, or additional briefing.

II. MOTION TO WITHDRAW

The Motion and Declaration request that counsel be permitted to withdraw based on the requirements of 37 C.F.R. § 11.116(a)(1). Mot. 2. Rule 116(a)(1) states that a practitioner “shall withdraw from the representation of a client if: [t]he representation will result in violation of the USPTO Rules of Professional Conduct or other law.” *See also* 37 C.F.R. § 11.116(a)(c) (requiring compliance with “applicable law requiring notice to or permission of a tribunal when terminating a representation”); 37 C.F.R. § 42.10(e) (“Counsel may not withdraw from a proceeding before the Board unless the Board authorizes such withdrawal.”).

Although counsel does not indicate the factual basis for its position that further representation will result in violation of the USPTO Rules of Professional Conduct or other law, I accept that certain conflicts may exist in this case, due to the multiple abuses of process discussed in my Decision. For example, as outlined in my Decision, I determined that “OpenSky,

through its counsel, abused the IPR process by filing this IPR in an attempt to extract payment from VLSI and joined Petitioner Intel, and expressed a willingness to abuse the process in order to extract the payment.” Dec. 3. I expressed concern with “counsel’s proposal to VLSI to intentionally undermine the proceeding and thereby violate the duty of good faith and candor to the Board.” *Id.* at 40 (discussing that “OpenSky, through its counsel, was willing to offer its advocacy to either side of this adversarial proceeding, depending on who was willing to pay”) (citations omitted). I also noted that “[t]he conduct of the individual attorneys in this case might also rise to the level of an ethical violation under the rules of their respective bars.” *Id.* at 4.

Because the abuses detailed in my Decision arguably implicate conduct of both OpenSky and its counsel, I appreciate that there may be a divergence in the interests of OpenSky from that of its counsel, notwithstanding OpenSky’s objection to the requested withdrawal. Given these apparent conflicts of interest, I recognize that it may be impossible for OpenSky’s counsel to zealously represent OpenSky in responding to my show cause order without violating attorney-client privilege or other client confidences. Accordingly, I authorize Mr. Oliver, Mr. Joshi, and the law firm of Amin, Turocy & Watson LLP to withdraw from this proceeding.

As discussed below, I grant an extension of time for OpenSky to obtain replacement counsel and prepare its response to my show cause order. The record demonstrates that OpenSky may have limited funds with which to retain and compensate replacement counsel. *See, e.g.*, Ex. 1528; Ex. 1529; Dec. 40–41. However, consistent with the findings in my Decision, that possibility only further supports my determination that OpenSky “did

not budget for litigating this proceeding throughout its expected life.” Dec. 41. If OpenSky lacks sufficient funding to hire counsel to prosecute the proceeding that it willingly initiated, I am unsympathetic. Therefore, if OpenSky cannot obtain counsel such that it cannot respond to my show cause order, I will proceed to utilize the record before me at that time to resolve the question of whether OpenSky should be ordered to pay compensatory expenses, including attorney fees, to VLSI as a further sanction for its abuse of process. *See* 37 C.F.R. §§ 42.12(b)(1) and 42.12(b)(6).

III. MOTION FOR EXTENSION OF TIME

The Motion and the subsequent request for authorization to file an additional motion both seek an extension of time for OpenSky to respond to my show cause order. Mot. 4; Ex. 3021. The Motion asserts that “it does not appear to be possible to formulate a reasonable reply to a 51-page order within a 10-page brief or within a period of only nine business days.” Mot. 4.

To be clear, I did not order briefing to allow OpenSky to “reply” to my Decision. Instead, I ordered OpenSky to provide narrow briefing on a narrow issue, i.e., whether OpenSky should be ordered to pay compensatory expenses, including attorney fees and, if so, how such fees should be determined. Dec. 50–51. OpenSky’s brief must respond to those questions only.

That being said, I determine that an extension of time is appropriate here to afford OpenSky time to obtain replacement counsel and to prepare a response to my show cause order. Accordingly, I grant both OpenSky and VLSI the requested 30-day extension of time, to November 17, 2022, to each

file a brief responding to my show cause order. Moreover, in an effort to ensure OpenSky has sufficient opportunity to present its arguments, I further expand the page limit for OpenSky and VLSI's briefs to 25 pages.

Additionally, I authorize both OpenSky and VLSI to each file a 10-page reply brief in response to the initial briefing, two and a half weeks later, on December 5, 2022. I do not authorize any further motions to extend time, enlarge pages, or provide additional briefing.

IV. ORDER

For the foregoing reasons, it is hereby:

ORDERED that Mr. Oliver, Mr. Joshi, and the law firm of Amin, Turocy & Watson LLP are permitted to withdraw from this proceeding;

FURTHER ORDERED that the due date for OpenSky and VLSI's briefs responding to my show cause order is extended by 30 days, to November 17, 2022;

FURTHER ORDERED that the page limit for OpenSky and VLSI's briefs responding to my show cause order is expanded from 10 pages to 25 pages, however, briefing is authorized only on the narrow issue of whether an award of attorney fees by OpenSky to VLSI is appropriate, and if so, how such fees should be determined; and

FURTHER ORDERED that OpenSky and VLSI may file a 10-page reply brief responding to the initial briefing and due two and a half weeks later, on December 5, 2022.

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