

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WHATFIX INC.,
Petitioner,

v.

WALKME LTD.,
Patent Owner.

IPR2023-01368 (Patent 10,819,664 B2)
IPR2023-01379 (Patent 11,258,732, B2)
IPR2023-01443 (Patent 10,819,664)¹

Before CHARLES J. BOUDREAU, KARA L. SZPONDOWSKI, and
MICHAEL T. CYGAN, *Administrative Patent Judges*.

PER CURIAM.

ORDER

Granting Patent Owner's Motions for Withdrawal
and Substitution of Counsel as to Lead Counsel James M. Heintz and
Substitute Lead Counsel Kim Kennedy

Denying Without Prejudice Patent Owner's Motions
as to Christopher Deck and George Stamatopoulos
37 C.F.R. § 42.10(e)

¹ This Order addresses issues that are the same in each of the above-identified proceedings. We issue one Order to be entered in each proceeding. The parties are not authorized to use this style caption unless later permitted.

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On November 21, 2023, with Board authorization, Patent Owner filed a Motion to Withdraw and Substitute Counsel in each of the above-identified proceedings. Paper 7.² Patent Owner requests the withdrawal of James M. Heintz and Christopher Deck and substitution of Kim Kennedy and George Stamatopoulos as counsel. *Id.* at 2. Patent Owner indicates the Motion in each proceeding is unopposed, and asserts that “granting this Motion will not hinder the economy, the integrity of the patent system, the efficient administration of the Office, or the ability of the Office to timely complete this proceeding.” *Id.* at 2–3.

We have reviewed Patent Owner’s Motion in each proceeding and determine the withdrawal of Mr. Heintz as lead counsel and substitution of Ms. Kennedy is warranted. Accordingly, we grant Patent Owner’s Motion in each proceeding as to Mr. Heintz and Ms. Kennedy.

A party represented by counsel, however, “must designate a lead counsel and at least one back-up counsel who can conduct business on behalf of the lead counsel.” 37 C.F.R. § 42.10(a). In the above-identified proceedings, although Mr. Deck is designated as back-up counsel in Patent Owner’s Power of Attorney and identified in Patent Owner’s Mandatory Notices (Papers 4, 5), Mr. Deck is not a registered practitioner and has not been admitted *pro hac vice*. Accordingly, there is no need to withdraw Mr. Deck as back-up counsel, and the Motion in each proceeding is denied without prejudice as to withdrawing Mr. Deck and substituting Mr. Stamatopoulos as back-up counsel.

² For expediency, we cite to papers in IPR2023-01368. Similar papers were filed in IPR2023-01379 and IPR2023-01443.

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Further, Mr. Stamatopoulos is not identified as a registered practitioner, and Patent Owner has not yet filed a motion for *pro hac vice* for Mr. Stamatopoulos. *See* Paper 8, 1. As a result, Mr. Stamatopoulos cannot appear as back-up counsel until and unless Patent Owner files and the Board grants a motion for his admission *pro hac vice*. *See* 37 C.F.R. § 42.10(a), (c). Patent Owner's new lead counsel may file a motion to admit Mr. Stamatopoulos *pro hac vice* in the above-identified proceedings.

Additionally, although Patent Owner filed an updated Power of Attorney for Ms. Kennedy and Mr. Stamatopoulos (Paper 8), Patent Owner is reminded that our rules also require updated Mandatory Notices identifying Ms. Kennedy as lead counsel and Mr. Stamatopoulos as back-up counsel, to the extent Patent Owner submits a motion for admission of Mr. Stamatopoulos *pro hac vice*. *See* 37 C.F.R. § 42.8(a)(3).

Accordingly, it is,

ORDERED that Patent Owner's Motion in each of the above-identified proceedings is *granted* with respect to withdrawing James M. Heintz and substituting Kim Kennedy as lead counsel;

FURTHER ORDERED that Patent Owner's Motion in each of the above-identified proceedings is *denied without prejudice* with respect to withdrawing Christopher Deck and substituting George Stamatopoulos as back-up counsel; and

FURTHER ORDERED that Patent Owner must designate at least one back-up counsel who is either a registered practitioner, or for whom a motion for admission *pro hac vice* is submitted.

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