

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

STINGRAY GROUP INC. and STINGRAY MUSIC USA, INC.,
Petitioner,

v.

EDWIN A. HERNANDEZ-MONDRAGON,
Patent Owner.

IPR2025-00349 (Patent 10,123,074 B2)
IPR2025-00350 (Patent 10,524,002 B2)
IPR2025-00351 (Patent 11,140,441 B2)¹

Before BETH Z. SHAW, JASON M. REPKO, and BRIAN P. MURPHY
Administrative Patent Judges.

REPKO, *Administrative Patent Judge.*

ORDER
Denying Motion to Withdraw Counsel
37 C.F.R. § 42.5

¹ This Order addresses issues that are the same in all three proceedings. The combined caption is for administrative convenience only and does not indicate that these proceedings have been joined. The parties are not authorized to use this caption without express permission from the Board.

IPR2025-00349 (Patent 10,123,074 B2)
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I. SUMMARY

Gregory S. Cordrey, counsel representing Patent Owner, has submitted a motion to withdraw from the three captioned proceedings. Paper 13 (“Motion”, “Mot.”).² According to the Motion, the Notice of Intent to Designate Provisionally Recognized PTAB Attorney Stanley M. Gibson as Back-up Counsel is being withdrawn. *Id.* at 1. Petitioner does not oppose the Motion. *Id.* For the reasons discussed below, we are not persuaded that counsel for Patent Owner has been properly discharged. 37 C.F.R. § 11.116(a)(3) (“a practitioner . . . shall withdraw from the representation of a client if: . . . (3) [t]he practitioner is discharged”). Thus, we deny the motion as filed without prejudice, and grant leave to file additional evidence and information in support of a renewed motion.

II. MOTION

A party requesting relief in an *inter partes* review bears the burden of proof to establish that it is entitled to the requested relief. 37 C.F.R. § 42.20(c). The burden of proof is by a preponderance of the evidence. 37 C.F.R. § 42.1(d).

The Motion states that “Patent Owner, Dr. Edwin A. Hernandez-Mondragon, respectfully requests the withdrawal of” counsel. Mot. 1. According to Patent Owner, “The real parties-in-interest for the Patent Owner are Dr. Edwin A. Hernandez-Mondragon, an individual residing in

² The same motion was filed in IPR2025-00349, IPR2025-00350, and IPR2025-00351. The motion is Paper 13 in all three proceedings. In the rest of this order, all citations are to the papers and exhibits in IPR2025-00349 with a footnote containing the citations to the papers and exhibits in IPR2025-00350 and IPR2025-00351.

IPR2025-00349 (Patent 10,123,074 B2)
IPR2025-00350 (Patent 10,524,002 B2)
IPR2025-00351 (Patent 11,140,441 B2)

Coral Springs, Florida; and EGLA Corp., is a Florida corporation with its principal place of business at 4890 NW 101st Ave Coral Springs, Florida.” Paper 5, 1.³ According to the parties, the challenged patent has been asserted in *Hernandez v. Stingray Group, Inc.*, No. 1:24-cv-21226 (S.D. Fla. Apr. 2, 2024) (the “Florida Litigation”). Pet. 5; Paper 5, 2.⁴ Dr. Edwin A. Hernandez-Mondragon and EGLA Corp. are the plaintiffs in the Florida Litigation. Ex. 1026.⁵

EGLA Corp. is a juristic entity. A juristic entity must be represented by counsel in a proceeding before the Board. *See* 37 C.F.R. § 1.31; *Motorola Mobility v. Michael Arnouse*, IPR2013-00010, Paper 27 at 4–5 (PTAB Apr. 19, 2013).

The Motion does not mention EGLA Corp. Mot. According to the Second Amended Complaint in the Florida Litigation, EGLA Corp. “has an exclusive license to the technologies owned by Dr. Hernandez.” Ex. 1016, 6;⁶ *see also* Pet. 5 (discussing the exclusive license). The Federal Circuit has held that “an exclusive licensee with all substantial rights is the ‘effective patentee,’ and thus meets the constitutional standing requirement to sue in its own name without mandatory joinder of the named patentee.” *Motorola Mobility*, Paper 27 at 3–4 (citing *Sicom Sys. Ltd. v. Agilent Techs., Inc.*, 427 F.3d 971 (Fed. Cir. 2005); *Prima Tek II, LLC v. A-Roo Co.*, 222 F.3d 1372 (Fed. Cir. 2000)). The Board has applied that rule in *inter partes* reviews. *Id.*

³ IPR2025-00350, Paper 5, 1; IPR2025-00351, Paper 4, 1.

⁴ IPR2025-00350, Pet. 1, Paper 5, 2; IPR2025-00351, Pet. 5, Paper 4, 2.

⁵ IPR2025-00350, Ex. 1028; IPR2025-00351, Ex. 1031.

⁶ IPR2025-00350, Ex. 1018, 6; IPR2025-00351, Ex. 1021, 6.

IPR2025-00349 (Patent 10,123,074 B2)
IPR2025-00350 (Patent 10,524,002 B2)
IPR2025-00351 (Patent 11,140,441 B2)

We deny the Motion as filed because it does not identify substitute counsel for EGLA Corp. or provide any further explanation on this issue.

Counsel for Patent Owner has ten days from the entry of this Order to submit additional evidence in support of the motion and to renew the motion. Counsel must file (1) an updated mandatory notice stating whether EGLA Corp. is the exclusive licensee with all substantial rights in the challenged patents and (2) a copy of the license agreement referenced in the Second Amended Complaint in the Florida Litigation. *See* Ex. 1016, 6.⁷

Counsel must further advise Patent Owner that (1) it cannot participate in this proceeding without counsel to represent it, and (2) its failure to participate in the proceeding may be considered abandonment of the contest, resulting in the entry of adverse judgment against Patent Owner. *See* 37 C.F.R. § 42.73(b)(4).

After filing the Motion, Patent Owner filed Papers 15 through 17 and Exhibits 2013–2023.⁸ We did not authorize Patent Owner to do so. Thus, we expunge those papers and exhibits.

⁷ A copy of the license agreement may be filed for the “Board Only” to preserve confidentiality in the first instance.

⁸ IPR2025-00350, Papers 15 and 16, Exs. 2013–2023; IPR2025-00351, Papers 14–16, Exs. 2013–2023.

IPR2025-00349 (Patent 10,123,074 B2)
IPR2025-00350 (Patent 10,524,002 B2)
IPR2025-00351 (Patent 11,140,441 B2)

ORDER

It is

ORDERED that Motion to Withdraw as Counsel to Patent Owner is
denied without prejudice;

FURTHER ORDERED that counsel has ten days from the entry of
this Order to submit additional evidence in support of the Motion and to
renew the Motion; and

FURTHER ORDERED that the papers and exhibits filed without the
Board's authorization shall be expunged.

IPR2025-00349 (Patent 10,123,074 B2)
IPR2025-00350 (Patent 10,524,002 B2)
IPR2025-00351 (Patent 11,140,441 B2)

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