UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

EDWIN A. HERNANDEZ-MONDRAGON,
Patent Owner

Case No. IPR2025-00350
U.S. Patent No. 10,524,002

PATENT OWNER'S RENEWED MOTION FOR WITHDRAWAL

TABLE OF CONTENTS

Page

I. PATENT OWNER'S TERMINATION OF COUNSEL AND THE BREAKDOWN IN THE ATTORNEY-CLIENT RELATIONSHIP 2

II. COUNSEL'S MOTION TO WITHDRAW SHOULD BE GRANTED 6

A. Patent Owner Terminated Counsel 6

B. The Breakdown of the Attorney-Client Relationship 6

III. PATENT OWNER SHOULD BE GIVEN A REASONABLE TIME TO SUBSTITUTE COUNSEL OR PROVIDE INFORMATION REGARDING EGLA'S EXCLUSIVE LICENSE.....8

IV. CONCLUSION.....10

Pursuant to 37 C.F.R. § 11.116(a)(3), Counsel for Patent Owner respectfully requests the withdrawal of Gregory S. Cordrey (Reg. No. 44,089) as lead counsel, and further withdraw Patent Owner's Notice of Intent to Designate Provisionally Recognized PTAB Attorney Stanley M. Gibson as Back-up Counsel (Paper 8). Authorization for this renewed motion was granted by the Board via its order Denying Motion to Withdraw without prejudice dated June 13, 2025. Paper 17. The parties have conferred, and Petitioner does not oppose this motion.[1]

Patent Owner's counsel respectfully renews its motion to withdraw from representation in this *Inter Partes* Review proceeding following the complete breakdown of the attorney-client relationship. On May 28, 2025, Patent Owner Dr. Edwin Hernandez-Mondragon terminated counsel's representation via email, explicitly stating that counsel was "no longer authorized to make any decisions on [his] behalf for this [IPR proceeding]." This termination was compounded by Patent Owner's false accusations against counsel of unethical conduct, including the baseless claim that counsel conspired with Petitioner's counsel against Patent Owner's interests.

The breakdown in the attorney-client relationship has rendered effective representation impossible. Patent Owner has refused to communicate with counsel

[1] Counsel emailed Patent Owner with this motion asking if Patent Owner was opposing the motion. As of the time of filing, counsel had not received a response.

on matters in this proceeding, failed to respond to multiple communications regarding Petitioner's requests for supplemental briefing, and filed unauthorized submissions with the Board without consulting counsel. These circumstances have created an untenable situation where counsel cannot fulfill its professional and ethical obligations to the Board or adequately represent Patent Owner's interests.

Under 37 C.F.R. § 11.116(a)(3), withdrawal is mandatory when a practitioner is discharged by the client. Moreover, the irretrievable breakdown of the attorney-client relationship provides independent grounds for withdrawal. The same circumstances led to counsel's successful withdrawal from the related Florida litigation, where the Magistrate Judge found good cause based on Patent Owner's confirmed termination of counsel.

I. PATENT OWNER'S TERMINATION OF COUNSEL AND THE BREAKDOWN IN THE ATTORNEY-CLIENT RELATIONSHIP

On May 28, 2025, Patent Owner Dr. Edwin Hernandez-Mondragon emailed counsel and terminated counsel as Patent Owner's representative in this matter: "Please notify [Petitioner's counsel] ALAVI that you are no longer representing me, and that you are no longer authorized to make any decisions on my behalf for this [IPR proceeding]." EX2024 [Dkt. 288] at 21[2] [email dated May 28, 2025 from Patent Owner]. On June 5, in a subsequent filing with the Florida district court in

[2] Unless otherwise indicated, Page numbers refer to the stamped page number.

connection with counsel's motion to withdraw from representation in the Florida district court due to Plaintiffs insistence upon taking action that Counsel considered imprudent and with which Counsel had a fundamental disagreement, Dr. Hernandez falsely accused counsel of unethical conduct in this IPR proceeding:

> However, despite first stating that no more work was going to be done by JMBM, on May 28th ,2025, **JMBM interacted with ALAVI and apparently agreed to STINGRAY submit a brief to the IPR courts on Dr. Hernandez' patents**. The same day, via e-mail, Dr. Hernandez contacted JMBM and stated that their firm was NOT authorized to do any more decisions on behalf of EGLA CORP and Dr. Hernandez (**See Exhibit C). Despite these requests, JMBM has been pushing for ALAVI to file a brief with the PTAB and I ignore what the plans are there**.

Id. at 6 (emphasis added). Patent Owner's accusation of conspiring with Petitioner's counsel in this IPR is categorically false. Neither I, nor anyone at Jeffer Mangels Butler & Mitchell LLP ("JMBM"), agreed with Petitioner that it could submit a brief to the PTAB or pushed for Petitioner's counsel to file a brief with the PTAB. Counsel for Petitioner emailed Attorney Cordrey to inquire whether Patent Owner would oppose a further two-page briefing. *Id*. at 22. Consistent with our obligations as the counsel of record in the proceedings, Attorney Cordrey forwarded Petitioner's counsel's email to Patent Owner and explained his options. *Id*. at 21-22. At no time did Attorney Cordrey or anyone at JMBM agree that Petitioner could file a brief or push for Petitioner's counsel to file a brief with the Board. Such false accusations

from the Patent Owner to its counsel in this proceeding, and in the related litigation, have resulted in a complete breakdown of the attorney-client relationship.

This breakdown in the attorney-client relationship includes the Patent Owner's refusal to communicate with counsel in this proceeding, as evidenced by the following:

- Patent Owner did not respond to counsel's email regarding whether or not it would oppose Petitioner's request to the Board to submit a 2-page supplemental brief on the *Fintiv* factors following the filing of litigation counsel's motion to withdraw in the Florida litigation. EX2025 at 1.
- Following the Board's email of May 30, 2025 allowing the parties to file a 2-page brief, Patent Owner did not communicate with counsel regarding whether to submit a 2-page supplemental brief. EX2026 at 1.
- Patent Owner did not consult with counsel regarding the filing of the reply and exhibits on June 12, which the Board subsequently expunged in its June 13, 2025 Order. Paper 17 at 4 n. 8.[3]

In addition, the breakdown in the attorney-client relationship is evident from Patent Owner's statements filed in the Florida litigation where the same counsel represents the Plaintiffs, who are the Patent Owners here (Dr. Hernandez and EGLA CORP.). In the Florida litigation Plaintiffs made the following statements and accusations in their June 5, 2025 submission to the Court:

- Under the heading "EGLA CORP looses [sic] trust on JMBM," Patent Owner states that EGLA terminated JMBM and that there was a

[3] Had Patent Owner communicated with counsel in advance of this filing, counsel would have informed Patent Owner of the need to obtain authorization from the Board before filing a reply and exhibits.

"misalignment between the JMBM firm interests and EGLA CORP's interest."

- Patent Owner stated that "[t]his loss of trust was enhanced when Mr. Cordrey in a phone call asked Dr. Edwin Hernandez to oppose or not this motion without disclosing the contents, which was verbally opposed, and now opposed in writing herein."
- Patent Owner further stated that "these events made EGLA CORP's board to conclude that our lawyers at JMBM were no longer acting to protect our interest and had to be immediately terminated, however for unknown reasons they appear to keep working with defendants."

EX2024 at 5-6.[4]

As this shows, the complete breakdown in the attorney-client relationship cannot be repaired and places counsel in an untenable position of not being able to fulfill its professional and ethical obligations to the Board and effectively represent the Patent Owner. For similar reasons, counsel moved to withdraw from representation of Plaintiffs in the Florida litigation. EX1024. Upon the Plaintiffs' representation to the Court that it had terminated counsel, the Magistrate Judge held that there was good cause to grant counsel's motion to withdraw. EX1026 at 2 (stating that "Plaintiffs [] submitted a response that confirmed Plaintiffs' termination of counsel of record in the action. [D.E. 288].").

[4] Counsel for Patent Owner denies these accusations, but proffer them as evidence of Patent Owner's state of mind regarding the breakdown of the attorney-client relationship with JMBM and Attorney Cordrey.

II. COUNSEL'S MOTION TO WITHDRAW SHOULD BE GRANTED

A. Patent Owner Terminated Counsel

Here, as in the Florida litigation, Patent Owner has terminated JMBM and Attorney Cordrey as its counsel. In the exhibits attached to this motion, counsel has submitted evidence of Patent Owner's termination of JMBM and its attorneys, including Attorneys Cordrey and Gibson. Patent Owner discharged JMBM and Attorney Cordrey as his representatives in this proceeding on May 28, 2025 by email and so confirmed again in writing in its June 5 submission to the Florida district court. EX2024 at 4, 21. As the Board noted in its order, Rule 11.116(a)(3) requires that a practitioner "shall withdraw from representation of a client if…[t]he practitioner is discharged." Paper 17 at 2. Accordingly, as required by Section 11.116(a)(3), upon notification that they were terminated, JMBM and Attorney Cordrey were mandated to cease representing Patent Owner and withdraw from representation of Patent Owner. *Major League Baseball Players Association et al. v. Chisena*, 2024 WL 3617587 (Trademark Tr. & App. Bd. July 23, 2024).

B. The Breakdown of the Attorney-Client Relationship

In addition to Patent Owner's termination of counsel, counsel has further provided evidence of the breakdown in the attorney-client relationship between Patent Owner and counsel, including that Patent Owner has made false accusations against counsel, including allegedly collaborating with Petitioner against the Patent

Owner's interests. EX2024 at 21. Patent Owner also has ceased communicating with counsel on important issues in this proceeding. EX2025, EX2026. As noted above, the Magistrate Judge in the Florida litigation found good cause to grant counsel's motion to withdraw. EX2026 at 1. Courts faced with similar circumstances have found the breakdown in the attorney-client relationship warrants the withdraw of counsel, even in the instance where no substitute counsel has made an appearance. In *STAG Williamsport, LLC v. BHN Associates, LLC*, as with Patent Owner here, the client had informed counsel that client did not want counsel to represent it any further in the matter. In addition to the client's termination of counsel, the Magistrate Judge determined that the standard for an irretrievable breakdown had been satisfied based on counsel's "unreasonable difficulties in communicating with respect to discovery and legal strategy." *STAG Williamsport, LLC*, 2023 WL 4995327, *1-*2 (D. Mass. July 11, 2023), report and recommendation adopted, Civil Action No. 21-11958-NMG, 2023 WL 4995327 (D. Mass. Aug. 1, 2023); *see also Capstone Associated Services, Ltd. v. United States*, 2023 WL 5624712, *4 (Fed. Cl. Aug. 31, 2023) (finding good cause for withdrawal where there has been a "total breakdown of the attorney-client relationship" between counsel and Plaintiff as evidenced by Plaintiff's attempt to file an unauthorized motion with the Court against counsel and the inability to cooperate to file necessary pleadings); *White v. BAC Home Loans Servicing, LP*, No. 309-CV-

2484-G, 2010 WL 2473833, at *2 (N.D. Tex. June 15, 2010) (collecting cases establishing that an attorney has good cause for withdrawal when there has been a total breakdown of the attorney-client relationship); *see, e.g.*, *Gold's Gym Licensing, LLC v. K–Pro Mktg. Grp., Inc*., No. 09-1211, 2009 WL 3520858, at *3 (D. Minn. Oct. 26, 2009) ("We have, in the past, found that good cause exists where counsel cannot adequately represent the client ... or where a degree of fractiousness, between the client and counsel, has developed which inhibits 'the just, speedy, and inexpensive determination of [the] action.' " (quoting Fed. R. Civ. P. 1)); *United States v. Reynolds*, 2009 WL 1874035, at *1 (E.D. Tenn. June 26, 2009) (allowing an attorney to withdraw after finding "that the trust between attorney and client necessary for an adequate defense no longer exists, that communications between the defendant and counsel have broken down, and that the situation is unlikely to improve"). As explained above, the same is true here where Patent Owner has falsely accused counsel of conspiring with Petitioner to act against its interests and has refused to communicate with counsel regarding matters in these IPRs.

III. PATENT OWNER SHOULD BE GIVEN A REASONABLE TIME TO SUBSTITUTE COUNSEL OR PROVIDE INFORMATION REGARDING EGLA'S EXCLUSIVE LICENSE

Pursuant to the Board's order (Paper 17), counsel advised Patent Owner "that (1) [Patent Owner] 'cannot participate in this proceeding without counsel to represent it, and (2) its **failure to participate in this proceeding may be considered**

abandonment of the contest, resulting in an adverse judgement against the Patent Owner.'" EX2027 (quoting IPR2025-00349, Paper 17 at 4 (citing 37 C.F.R. § 42.73(b)(4))) (emphasis added). As of the filing of this motion, counsel has not received a response. However, in its June 12 submission to the Board (expunged Paper 16), Patent Owner stated that it "has multiple options of attorneys that can represent him and his company, EGLA CORP." EX2028 at 7 [reply from Patent Owner].

In its order denying the motion to withdraw, the Board further stated that 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." Paper 17 at 4. Regarding the license agreement, Patent Owner has represented in the Florida litigation that the license was a verbal one.[5] Given the breakdown in the attorney-client relationship between counsel and Patent Owner and Patent Owner's refusal to communicate with counsel, counsel respectfully requests that the Board have the Patent Owner update its mandatory notice to provide any

[5] In its opposition to Defendants' motion to dismiss the second amended complaint, Plaintiffs represented that the license agreement between Dr. Hernandez and EGLA Corp. was a verbal one. EX2029 [Dkt. 162] at 3 ("Discovery will further reveal that the license agreement between Dr. Hernandez and EGLA was a verbal one, further evidence that he retained ownership.").

information about its license agreement with EGLA Corp. that the Board requires given Patent Owner's refusal to cooperate and communicate with counsel.

IV. CONCLUSION

Patent Owner's counsel respectfully requests that the Board grant this renewed motion for withdrawal. Patent Owner has unequivocally terminated counsel's representation and made false accusations that have irreparably damaged the attorney-client relationship. Under these circumstances, continued representation is neither ethically permissible nor practically feasible.

Counsel respectfully submits that the circumstances presented here mandate withdrawal under both the mandatory provisions of 37 C.F.R. § 11.116(a)(3) and the well-established precedent recognizing withdrawal where the attorney-client relationship has suffered an irretrievable breakdown.

The Board should grant counsel's withdrawal and allow Patent Owner a reasonable time to substitute counsel and comply with the Board's requirements regarding EGLA Corp.'s licensing status. Patent Owner has represented that it "has multiple options of attorneys that can represent him and his company," and Petitioner does not oppose this motion. Granting withdrawal will serve the interests of justice while ensuring that both parties can proceed with proper representation in this matter.

DATED: June 16, 2025

Respectfully submitted,

/s/ Gregory S. Cordrey
Gregory S. Cordrey
Reg. No. 44,089
Jeffer Mangels Butler & Mitchell LLP
3 Park Plaza, Suite 1100
Irvine, CA 92614
Tel: (949) 623-7236
Email: gcordrey@jmbm.com

CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing document was served electronically via electronic mail on June 16, 2025 on the following counsel of record for Petitioners:

Masood Anjom
Reg. No. 62,167
Joshua S. Wyde
Reg. No. 57, 698
Michael D. McBride
Alavi & Anaipakos PLLC
609 Main Street, Suite 3200
Houston, Texas 77002
Phone: (713) 751-2367
Fax: (713) 751-2341
Email: manjom@aatriallaw.com
Email: ipr2025-00350@aatriallaw.com
Email: twestmoreland@aatriallaw.com
Email: jwyde@aatriallaw.com
Email: mmcbride@aatriallaw.com

Counsel for STINGRAY GROUP INC. and STINGRAY MUSIC USA INC.