

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOOGLE LLC,  
Petitioner,

v.

BRODTI INC.,  
Patent Owner.

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IPR2025-00472  
Patent 11,416,898 B2

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Before FRANCES L. IPPOLITO, STEPHEN E. BELISLE, and  
BRIAN P. MURPHY, *Administrative Patent Judges*.

BELISLE, *Administrative Patent Judge*.

ORDER

Denying *Without Prejudice* Patent Owner's Motion  
to Proceed Without Back-up Counsel  
37 C.F.R. §§ 42.5, 42.10(a), 42.71(a)

On April 30, 2025, Patent Owner filed a Motion To Proceed Without Back-up Counsel, seeking to proceed in this case with only lead counsel. Paper 13 (“Motion”). The Motion does not indicate whether Petitioner opposes (*id.*), and the due date for opposition has not yet passed. See 37 C.F.R. § 42.25. We *deny* the Motion *without prejudice* to refiling as discussed below.

Rule 42.10(a) states, in part: “The Board may permit a party to proceed without back-up counsel *upon a showing of good cause*. A party may show good cause *by demonstrating* that it lacks the financial resources to retain both lead and back-up counsel. 37 C.F.R. § 42.10(a) (emphases added). In moving forward with this rule provision, the Office<sup>1</sup> explained:

[I]t would likely be difficult for a party to demonstrate a lack of financial resources *where that party has also elected to pursue litigation* involving the challenged patents in other forums. The Office also notes that the good cause inquiry focuses on the needs of the party seeking relief, not the needs or preferences of counsel. Thus, for example, *the fact that lead counsel is a solo practitioner who prefers to work alone would not constitute good cause for a party to proceed without separate back-up counsel*.

*Expanding Opportunities To Appear Before the Patent Trial and Appeal Board*, 89 Fed. Reg. 82172, 82174 (October 10, 2024) (emphases added).

In this case, according to Petitioner, Patent Owner has filed a district court action against Petitioner for infringement of the subject patent, i.e., U.S. Patent No. 11,416,898 B2. Paper 2, 1; *see BrodTi Inc. v. Google LLC*, No. 1:24-cv-00173-JCB (D. Del.). According to the docket in this district court action, Patent Owner is represented by multiple counsel.

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<sup>1</sup> U.S. Patent and Trademark Office (“Office” or “USPTO”).

Patent Owner sets forth two bases for this Motion: (1) Patent Owner “meets the definition of USPTO small entity status”; and (2) “Patent Owner does not have the *budget* at present for both lead counsel and backup counsel.” Paper 13, 2 (emphasis added). Patent Owner does not provide any supporting declaration or other evidence for these two statements, such as evidence showing it lacks the financial resources to retain both lead and back-up counsel. As to (1), Patent Owner does not explain why qualifying for small entity status alone should act as a blanket exception to the Board’s requirement for both lead and back-up counsel. As to (2), Patent Owner does not explain what it means by it “does not have the budget,” and how that translates into lacking the financial resources to retain both lead and back-up counsel, particularly where Patent Owner retains multiple counsel in a district court patent infringement action against Petitioner.

In consideration of the foregoing, it is hereby:

ORDERED that the Motion is *denied without prejudice* to refiling within two (2) weeks of this Order; and

FURTHER ORDERED that, if Patent Owner refiles the Motion, the Motion must state whether Petitioner opposes the Motion.

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