

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SQUARE, INC.,
Petitioner,

v.

THINK COMPUTER CORPORATION,
Patent Owner.

Case CBM2015-00067
Patent 8,396,808 B2

Before TONI R. SCHEINER, MICHAEL W. KIM, and
BART A. GERSTENBLITH, *Administrative Patent Judges*.

KIM, *Administrative Patent Judge*.

ORDER

Motion to Withdraw as Counsel
37 C.F.R. §§ 42.5, 42.10

On August 15, 2015, Mr. Sean Goodwin filed a Motion to Withdraw as Counsel. Paper 18; "Motion." Mr. Goodwin is lead counsel for Patent Owner. Papers 6, 8. Mr. Michael Aschenbrener has been admitted as *pro hac vice* counsel in this proceeding, and is recognized as backup counsel.

Papers 6, 8. In the Motion, Mr. Goodwin requests that the Board waive the requirement under 37 C.F.R. § 42.10(c) that *pro hac vice* counsel is allowed only where the lead attorney is a registered patent practitioner, allow him to withdraw as lead counsel, and allow Mr. Aschenbrener to continue to serve as backup counsel, but without any lead counsel. For the reasons set forth below, the Motion is *denied*.

Mr. Goodwin asserts that he is no longer providing of-counsel services for Aschenbrener Law P.C., has no contractual relationship with Patent Owner, and that Patent Owner will continue to be represented by Aschenbrener Law P.C. Motion 1–2. We are not persuaded, however, that Mr. Goodwin’s contractual status, or lack thereof, with Aschenbrener Law P.C. and Patent Owner is sufficient to outweigh the aforementioned rules’ implication that the presence of a registered practitioner as lead counsel is highly desirable to protect a party’s rights in these potentially technically complex proceedings.

Mr. Goodwin asserts further that his contractual terms are such that he has never been paid, he was misled to the extent of representation and the nature of the client, and that he has endured personal and financial hardships due to this representation. *Id.* Although Mr. Goodwin’s assertions engender our sympathy, we have to balance the interests of counsel seeking withdrawal with the interests of the client, as well as the interests of the United States Patent Office, the profession, and the public. *See, e.g.,* <http://www.uspto.gov/patent/laws-and-regulations/america-invents-act-ia/message-chief-judge-james-donald-smith-board#heading-4> (discussing how the rules pertaining to *pro hac vice* admission balance various needs). When Patent Owner’s Power of Attorney appointing Mr. Goodwin as lead

counsel was entered in this proceeding, Mr. Goodwin understood, or should have understood, the requirement that lead counsel be a registered patent practitioner under 37 C.F.R. § 42.10(c). Whatever contractual relationship Mr. Goodwin entered with Aschenbrener Law P.C., it was incumbent upon Mr. Goodwin to understand that he was stepping into an important role in the proceeding and that the time demands upon him would be commensurate in scope with the duties of lead counsel.

Additionally, Mr. Goodwin's assertions with respect to payment and representations regarding the extent of representation are not supported by any evidence before us. We do not suggest, however, that Mr. Goodwin should have submitted his contractual agreement into the record of this proceeding; rather, Mr. Goodwin's assertions regarding payment for his services do not outweigh the Board's requirement that lead counsel be a registered practitioner. If Mr. Goodwin has a dispute with Aschenbrener Law P.C. regarding payment for his services, that issue is for another day, and another proceeding.

Further, Mr. Goodwin acknowledges in his Motion that there are "few matters" remaining. Motion 2. Thus, although we recognize that his continued representation of Patent Owner may be burdensome, that burden is nearing its end, whether the end comes as a result of the conclusion of this matter or Patent Owner's retention of replacement counsel.

Mr. Goodwin asserts also that it is his information and belief that Patent Owner has been actively searching for replacement counsel at least since July 2015, and that there is no reason to think that Patent Owner will not be able to find a replacement. This assertion does not weigh in favor of granting the Motion. If Patent Owner is able to find a registered practitioner

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to serve as replacement counsel, Mr. Goodwin may request withdrawal at that time.

Mr. Goodwin asserts additionally that the remaining procedural steps in this matter can be performed by backup counsel, Mr. Aschenbrener, and that a registered patent practitioner is not necessary for those steps.

Motion 2. This assertion also does not weigh in favor of granting the Motion, as Mr. Aschenbrener has been, and continues to be free to conduct all remaining matters, whether or not Mr. Goodwin is lead counsel.

IT IS ORDERED that Mr. Goodwin's Motion (Paper 18) is *denied*; and

IT IS FURTHER ORDERED that insofar as traveling to attend any hearing may impose additional financial hardships on Mr. Goodwin, Mr. Goodwin is authorized to attend the hearing telephonically.

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