

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ITRON NETWORKED SOLUTIONS, INC.,
Petitioner,

v.

ACOUSTIC TECHNOLOGY, INC.,
Patent Owner.

Case IPR2017-01024 (Patent 6,509,841 B1)
Case IPR2017-01030 (Patent 5,986,574)
Case IPR2017-01031 (Patent 5,986,574)¹

Before THU A. DANG and PATRICK M. BOUCHER,
Administrative Patent Judges.

BOUCHER, *Administrative Patent Judge.*

ORDER
Motion for Withdrawal and Substitution of Counsel
37 C.F.R. § 42.10

¹ The parties are not authorized to use this style of caption.

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On April 11, 2017, Patent Owner submitted mandatory notices appointing Edward M. Weisz as lead counsel in these proceedings. Paper 6.² On June 27, 2017, Patent Owner submitted revised mandatory notices appointing Erik Swensen as lead counsel, and appointing Robert Hayes and Edward M. Weisz as back up counsel. Paper 8. These three attorneys, as well as their law firm, “move to withdraw as counsel for Patent Owner and, at Patent Owner’s request, to appoint Daniel Callaway as lead counsel . . . and James L. Day . . . as backup counsel.” Paper 41, 2. A representation is made in the motion that “Petitioner has indicated it does not oppose the requested withdrawal and substitution of counsel for Patent Owner.” *Id.* at 3.

“Counsel may not withdraw from a proceeding before the Board unless the Board authorizes such withdrawal.” 37 C.F.R. § 42.10(e). Patent Owner has filed a power of attorney appointing Messrs. Callaway and Day, both of whom are registered practitioners, to act in these proceedings. Paper 34. The motion represents that “[n]ew counsel for Patent Owner . . . will promptly file Amended Patent Owner’s Mandatory Notices upon grant of this motion.” Paper 41, 3–4. In addition, the motion asserts that “Patent Owner verifies that no extensions of time will be sought by Substitute Counsel.” *Id.* at 3.

We are mindful that the motion is filed relatively late in this proceeding, with oral argument scheduled for June 4, 2018. Papers 30, 31. Nevertheless, we are persuaded by the representations made in the motion, and by Patent Owner’s filing of a power of attorney appointing Messrs. Callaway and Day, that reasonable steps have been taken to “avoid foreseeable prejudice to the rights of the client,

² Citations are to IPR2017-01024. Similar papers were filed in each of the three proceedings, but sometimes with different paper numbers.

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including giving due notice to his or her client, [and] allowing time for employment of another practitioner.” 37 C.F.R. § 10.40(a). Messrs. Swensen, Hayes, and Weisz also make such an assertion in the motion, and further represent that “Patent Owner believes 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.” Paper 41, 3 (citing 35 U.S.C. § 316(b)).

Upon consideration of these facts, the motion is *granted*.

It is

ORDERED that Erik Swensen, Robert Hayes, and Edward M. Weisz are permitted to withdraw as counsel in each of these proceedings, contingent upon filing of satisfactory updated Patent Owner Mandatory Notices;

FURTHER ORDERED that Daniel Callaway is recognized as lead counsel in each of these proceedings, contingent upon filing of satisfactory updated Patent Owner Mandatory Notices; and

FURTHER ORDERED that James L. Day is recognized as backup counsel in each of these proceedings, contingent upon filing of satisfactory updated Patent Owner Mandatory Notices.

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