

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WALMART INC.; Z-SHADE CO., LTD.;
COSTCO WHOLESALE CORPORATION;
LOWE'S HOME CENTERS, LLC; and
SHELTERLOGIC CORP.,
Petitioner,

v.

CARAVAN CANOPY INTERNATIONAL, INC.,
Patent Owner.

IPR2020-01026¹
Patent 5,944,040

Before BART A. GERSTENBLITH, JAMES J. MAYBERRY, and
ERIC C. JESCHKE, *Administrative Patent Judges*.

JESCHKE, *Administrative Patent Judge*.

ORDER
Granting Patent Owner's Motion for
Withdrawal and Substitution of Counsel
37 C.F.R. § 42.10

¹ Z-Shade Co., Ltd.; Costco Wholesale Corporation; Lowe's Home Centers, LLC; and ShelterLogic Corp., which filed a petition in IPR2021-00449, have been joined as petitioner in this proceeding.

BACKGROUND

On May 17, 2021, we instituted trial in this *inter partes* review proceeding involving Z-Shade Co., Ltd.; Costco Wholesale Corporation; Lowe's Home Centers, LLC; and ShelterLogic Corp. (collectively, "Petitioner") and Patent Owner, Caravan Canopy International, Inc. Paper 22. After trial, we issued a Final Written Decision. Paper 57. Following Patent Owner's Request for Rehearing (Paper 58), we issued a Decision Denying the Request for Rehearing. Paper 59.

On April 13, 2022, Patent Owner filed both a Motion for Withdrawal and Substitution of Counsel (Paper 62) and a Notice of Appeal to the U.S. Court of Appeals for the Federal Circuit (Paper 63). For the reasons below, we *grant* Patent Owner's Motion.

DISCUSSION

As a preliminary matter, we first determine whether we have the authority to decide Patent Owner's Motion. The general rule is that the Board divests jurisdiction when either party files a notice of appeal to the Federal Circuit. *See In re Allen*, 115 F.2d 936, 939 (CCPA 1940) ("We have no doubt that when a notice of appeal and reasons of appeal in an appealable case are duly filed with the Commissioner of Patents, jurisdiction of the cause is transferred to this court. There is nothing left for the commissioner to do other than to certify the record and transmit it to this court."); *but see Loshbough v. Allen*, 359 F.2d 910, 912 (CCPA 1966) (restating this general rule, but discussing some functions that the Board may perform despite an applicant having filed a notice of appeal and overruling *In re Allen* to the extent it would prohibit the Board from performing those functions).

Even after an applicant has filed a notice of appeal, however, the Board still “can exercise a purely ministerial function in [its] administrative capacity” that does not make a “new or different determination of an issue[.]” and “exercise[s] no judicial function.” *In re Grier*, 342 F.2d 120, 123 (CCPA 1965) (allowing the Board to correct a typographical error where it concluded a decision with “AFFIRMED” rather than “AFFIRMED-IN-PART”); *Loshbough*, 359 F.2d at 912 (remanding appeal to the Board of Patent Interferences for it to consider appellee’s motion “to ‘cancel’ from the interference the 5 counts on which priority was awarded to him and to substitute a new count”). We view deciding whether a party can withdraw and substitute counsel as a “purely ministerial function” that does not make a “new or different determination of an issue[.]” and “exercise[s] no judicial function.” *Grier*, 342 F.2d at 123; *see Loshbough*, 359 F.2d at 912. Accordingly, we are able to decide Patent Owner’s Motion, even though a Notice of Appeal has already been filed.

We now turn to the Motion itself. A party represented by counsel must designate a lead counsel and at least one back-up counsel. 37 C.F.R. § 42.10(a). Counsel may not withdraw from a proceeding unless the Board authorizes such withdrawal. 37 C.F.R. § 42.10(e). A power of attorney must be filed with the designation of counsel, unless the designated counsel is already counsel of record. 37 C.F.R. § 42.10(b). The parties must provide certain mandatory notices, including identification of lead and back-up counsel. 37 C.F.R. § 42.8. Where there is a change of information, a party must file a revised notice within 21 days of the change. 37 C.F.R. § 42.8(a)(3).

Here, Patent Owner has requested authorization to withdraw lead counsel Kyle W. Kellar and backup-counsel Jason C. Martone and Steven French from this proceeding, and has identified substitute lead counsel Stephen Lobbin (Reg. No. 41,159) and back-up counsel Joshua Osborn (Reg. No. 77,858), who are registered practitioners. *See* Mot. 1; Paper 61 (Patent Owner’s Updated Mandatory Notices) at 2. Patent Owner asserts that its “new counsel meet the requirements of 37 C.F.R. § 42.10(c) as lead counsel and registered practitioners.” Mot. 1. Patent Owner also states that “Petitioner has indicated it does not oppose the requested withdrawal and substitution of counsel for Patent Owner.” *Id.* at 2. Patent Owner filed a power of attorney for Mr. Lobbin and Mr. Osborn and an updated Mandatory Notice identifying Mr. Lobbin and Mr. Osborn as lead and back-up counsel, respectively. *See* Paper 60 (Power of Attorney) at 1; Paper 61 at 2. We determine that Patent Owner’s Motion meets the requirements above. Thus, we *grant* Patent Owner’s Motion.

It is hereby:

ORDERED that Patent Owner’s Motion is *granted*;

FURTHER ORDERED that Kyle W. Kellar is allowed to withdraw as lead counsel from this proceeding, and Stephen Lobbin is allowed to be substituted as lead counsel; and

FURTHER ORDERED Jason C. Martone and Steven French are allowed to withdraw as back-up counsel from this proceeding, and Joshua Osborn is allowed to be substituted as back-up counsel.

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