

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY CORPORATION,
Petitioner,

v.

ONE-E-WAY, INC.,
Patent Owner.

Case IPR2016-01638 (Patent 9,282,396 B2)
Case IPR2016-01639 (Patent 9,282,396 B2)¹

Before DAVID C. MCKONE, ROBERT J. WEINSCHENK, and
JOHN F. HORVATH, *Administrative Patent Judges*.

WEINSCHENK, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

¹ This Order pertains to both of these cases. Therefore, we exercise our discretion to issue a single Order to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

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IPR2016-01639 (Patent 9,282,396 B2)

I. INTRODUCTION

As set forth in the Teleconference Summary entered on April 28, 2017, Patent Owner's lead counsel, Ms. Megan Lyman, requested authorization to withdraw from representation of Patent Owner in these cases because she was closing her legal practice to pursue another opportunity. IPR2016-01638, Paper 15; IPR2016-01639, Paper 11. The substance of previous telephone conference calls regarding Ms. Lyman's request to withdraw are summarized in the Teleconference Summary. On May 1, 2017, Judges McKone, Weinschenk, and Horvath held another telephone conference call with counsel for Petitioner and Patent Owner and Mr. C. Earl Woolfork, the Chief Executive Officer of Patent Owner. During the call, Mr. Woolfork stated that Patent Owner had retained new lead counsel, Ms. Daphne Burton, and new back-up counsel, Mr. Thomas Robbins. Mr. Woolfork also stated that he expected Patent Owner to file a new power of attorney shortly. We again explained to Mr. Woolfork, and Mr. Woolfork stated that he understood, the importance of retaining new counsel for Patent Owner as soon as possible.

On May 1, 2017, Patent Owner filed a new power of attorney in both cases. The power of attorney filed in IPR2016-01638 identifies Ms. Burton as lead counsel and Mr. Robbins as back-up counsel. However, the power of attorney filed in IPR2016-01639 only identifies Ms. Burton as lead counsel. Thus, Patent Owner should file a new power of attorney in IPR2016-01639 that also identifies Mr. Robbins as back-up counsel. In addition, Patent Owner should file updated mandatory notices in both cases that designate Ms. Burton as lead counsel and Mr. Robbins as back-up counsel. *See* 37 C.F.R. § 42.8. The updated mandatory notices should

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remove the designation of Ms. Lyman as lead counsel and Mr. Jim Passe as back-up counsel. After the new power of attorney is filed in IPR2016-01639 and the updated mandatory notices are filed in both cases, Ms. Lyman is authorized to file a motion to withdraw from representation of Patent Owner in both cases. Further, as noted in the Teleconference Summary, Mr. Passe did not file a power of attorney from Patent Owner in either case. As a result, Mr. Passe need not file a motion to withdraw from representation of Patent Owner in these cases, but, as discussed above, Patent Owner should remove the designation of Mr. Passe as back-up counsel in the updated mandatory notices in both cases.

II. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner should file a new power of attorney in IPR2016-01639 that identifies Mr. Robbins as back-up counsel;

FURTHER ORDERED that Patent Owner should file updated mandatory notices in both cases that designate Ms. Burton as lead counsel and Mr. Robbins as back-up counsel and that remove the designation of Ms. Lyman as lead counsel and Mr. Passe as back-up counsel; and

FURTHER ORDERED that, after the new power of attorney is filed in IPR2016-01639 and the updated mandatory notices are filed in both cases, Ms. Lyman is authorized to file a motion to withdraw from representation of Patent Owner in both cases.

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