

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FITBIT, INC.
Petitioner

v.

VALENCELL, INC.
Patent Owner

Case IPR2017-00319¹
Patent 8,923,941 B2

Before BRIAN J. McNAMARA, JAMES B. ARPIN, and
SHEILA F. McSHANE, *Administrative Patent Judges*.

ARPIN, *Administrative Patent Judge*.

DECISION
Granting Motion to Withdraw and Substitute Counsel
37 C.F.R. § 42.10(e)

On September 14, 2020, Patent Owner filed updated Mandatory Notices (IPR2017-00319, Paper 55) naming new back-up counsel and also filed an updated power of attorney (IPR2017-00319, Paper 54). On September 14, 2020, after

¹ Case IPR2017-01555 has been joined with this proceeding.

IPR2017-00319

Patent 8,923,941 B2

obtaining our e-mail authorization pursuant to 37 C.F.R. § 42.20(b), Patent Owner filed a Motion to Withdraw and Substitute Counsel requesting (1) to withdraw Nicholas C. Kliewer and Brian P. Herrmann (hereinafter “the withdrawing attorneys”), formerly of Bragalone Conroy PC, as Patent Owner’s counsel in this *inter partes* review and (2) to add Daniel F. Olejko of Bragalone Conroy PC, as back-up counsel. IPR2017-00319, Paper 52 (“Mot.”). No opposition has been filed, and Patent Owner indicates that Petitioner does not oppose this motion. Mot. 1. For the following reasons, the motion is granted.

DISCUSSION

Counsel may withdraw from an *inter partes* review proceeding only with authorization from the Board. 37 C.F.R. § 42.10(e). Normally, this is accomplished by filing a motion to withdraw, which requires the Board’s prior authorization before filing. *See* 37 C.F.R. § 42.20(b). Once authorization is granted, the motion then is made *by the attorney(s) seeking to withdraw*. *See, e.g.*, IPR2013-00010, Paper 30; IPR2013-00067, Paper 35. Here, Patent Owner filed a motion to withdraw on behalf of the withdrawing attorneys and requests to add a new back-up counsel. The motion was signed by Patent Owner’s lead counsel, rather than by the withdrawing attorneys.

Patent Owner and the withdrawing attorneys have not followed the correct procedure. Nevertheless, because Petitioner does not oppose the motion, Patent Owner continues to be represented by registered practitioners, and there is no reason to believe that the withdrawing attorneys do not seek to withdraw; there is no prejudice shown. Consequently, the panel treats the motion as if it were properly filed by the withdrawing attorneys. Turning to Patent Owner’s request to substitute counsel, the motion requests to add new back-up counsel. A motion is not required to add back-up counsel, a registered practitioner, if named on a power

IPR2017-00319

Patent 8,923,941 B2

of attorney of record and identified as back-up counsel in timely-filed Mandatory Notices. Under the circumstances, although procedurally incorrect, we see no reason to deny the motion.

It is therefore

ORDERED that Patent Owner's motion is *granted*;

FURTHER ORDERED that Nicholas C. Kliewer and Brian P. Herrmann are permitted to withdraw as counsel in this proceeding; and

FURTHER ORDERED that Daniel F. Olejko is recognized as Patent Owner's back-up counsel in this proceeding.

IPR2017-00319
Patent 8,923,941 B2

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