

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

YITA LLC,
Petitioner

v.

MACNEIL IP LLC,
Patent Owner

Case No. IPR2020-01139
Patent No. 8,382,186

**PATENT OWNER MACNEIL IP LLC
MOTION FOR WITHDRAWAL AND SUBSTITUTION OF COUNSEL**

I. 37 C.F.R. §42.10 – STATEMENT OF RELIEF REQUESTED

Pursuant to 37 C.F.R. § 42.10(e), Patent Owner respectfully requests that the Board authorize withdrawal of Michele Bosch, David Reese, and Nicholas Cerulli, of Finnegan, Henderson, Farabow, Garrett & Dunner, LLP as its counsel, and appointment of David G. Wille of Baker Botts LLP as lead counsel, and Chad C. Walters and Clarke W. Stavinoha of Baker Botts LLP as backup counsel in this matter. The Board authorized Patent Owner to file this motion via email on October 8, 2020. Petitioner does not oppose this motion.

II. STATEMENT SHOWING GOOD CAUSE FOR THE BOARD TO AUTHORIZE WITHDRAWAL AND SUBSTITUTION OF COUNSEL

On July 21, 2020, Patent Owner submitted its Mandatory Notices Under 37 C.F.R. §§ 42.8(a)(2) and 42.8(b), appointing Michele Bosch, David Reese, Nicholas Cerulli, and Jefferson Perkins as its counsel in the above-captioned *inter partes* review (Paper 5).

For good cause, Patent Owner requests that Michele Bosch, David Reese, and Nicholas Cerulli as counsel be deemed withdrawn from the present proceeding, and new counsel, David G. Wille be designated as lead counsel, and Chad C. Walters, and Clarke W. Stavinoha be designated as back-up counsel, to represent Patent Owner in this proceeding. David G. Wille (Reg. No. 38,363), Chad C. Walters (Reg. No. 48,022), and Clarke W. Stavinoha (Reg. No. 71,152) are registered

practitioners. Jefferson Perkins of Perkins IP Law Group LLC remains as backup counsel.

In identifying and designating new counsel who are ready and able to take over the representation, reasonable steps have been taken to “avoid foreseeable prejudice to the rights of the client, including giving due notice to his or her client, [and] allowing time for employment of another practitioner.” *See* 37 C.F.R. § 10.40(a). Further, 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. *See* 35 U.S.C. § 316(b).

III. PETITIONER DOES NOT OBJECT TO THE SUBSTITUTION

Petitioner has indicated it does not oppose the requested withdrawal and substitution of counsel for Patent Owner.

IV. CONCLUSION

Patent Owner respectfully requests that the Board grant its motion to authorize withdrawal of counsel and permit substitution of counsel. Concurrently, Patent Owner respectfully files a Substitute Power of Attorney in accordance with 37 C.F.R. § 42.10(b) appointing David G. Wille as lead counsel, and Chad C. Walters, Clarke W. Stavinoha, and Jefferson Perkins as back-up counsel to effect this designation of substitute counsel. Patent Owner also respectfully files Updated

Mandatory Notices in accordance with 37 C.F.R. § 42.8(a)(3) should the present motion be granted.

Respectfully submitted,

Date: October 8, 2020

By: /Michele C. Bosch/
Michele C. Bosch, Lead Counsel
Registration No. 40,524

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **Motion for Withdrawal and Substitution of Counsel** was served on October 8, 2020, via email directed to counsel of record for the Petitioner at the following:

Mark P. Walters (Reg. No. 46,050)
walters@LoweGrahamJones.com

Ralph W. Powers III, Reg. No. 63,504
tpowers-PTAB@sternekessler.com

Jason A. Fitzsimmons, Reg. No. 65,367
jfitzsimmons-PTAB@sternekessler.com

Stephen A. Merrill, Reg. No. 72,955
smerrill-PTAB@sternekessler.com

John J. Bamert, Reg. No. 74,859
bamert@LoweGrahamJones.com

PTAB@sternekessler.com

Date: October 8, 2020

/Bradley J. Moore/
Bradley J. Moore
Litigation Legal Assistant

FINNEGAN HENDERSON
FARABOW, GARRETT &

DUNNER LLP