

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MOTOROLA MOBILITY LLC
Petitioner,

v.

MICHAEL ARNOUSE
Patent Owner.

Case IPR2013-00010 (MPT)
Patent 7,516,484

Before MICHAEL P. TIERNEY, JONI Y. CHANG, and JENNIFER S. BISK,
Administrative Patent Judges.

CHANG, *Administrative Patent Judge.*

ORDER
Authorizing Motion to Withdraw as Counsel
37 C.F.R. § 42.10(e)

On March 19, 2013, a telephone conference call was held including the following individuals:

- (1) Thomas D. Kohler, counsel for the patent owner;
- (2) Mr. Michael Arnouse;
- (3) Ko-Fang Chang and Steven D. Moore, counsel for Motorola Mobility LLC; and
- (4) Michael P. Tierney, Joni Y. Chang, and Jennifer S. Bisk, Administrative Patent Judges.

Mr. Kohler initiated the conference call to seek authorization to file a motion to withdraw as counsel. Mr. Kohler indicated that Mr. Arnouse would like to represent himself as a *pro se* patent owner. Mr. Kohler requested mandatory withdrawal under 37 C.F.R. § 10.40(b)(4). Mr. Kohler alleged that Mr. Arnouse discharged him as counsel, and that he could not continue his representation of the patent owner in this proceeding. Mr. Arnouse did not raise an objection to Mr. Kohler's continuing his representation of the patent owner until such time as the Board authorizes Mr. Kohler's withdrawal as counsel.

The Board explained that, under 37 C.F.R. § 42.10(e), counsel may not withdraw from a proceeding before the Board unless the Board authorizes such withdrawal. In that regard, 37 C.F.R. § 10.40(a) provides that "a practitioner shall not withdraw from employment until the practitioner has taken reasonable steps 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." In deciding a motion to withdraw as counsel, the Board will consider the effect of granting such a motion "on the economy, the integrity of the patent system, the efficient administration of the Office, and the ability of the Office to timely complete proceedings." *See* 35 U.S.C. § 316(b).

The Board raised several concerns regarding Mr. Kohler's request to withdraw as counsel, specifically the burden on the patent owner to proceed in this trial without counsel and what reasonable steps have been taken by counsel to avoid foreseeable prejudice to the patent owner's rights. Moreover, based on this record, it is uncertain whether Arnouse Digital Devices Corp. ("ADD") is effectively the patent owner.

On June 16, 2011, ADD, as exclusive licensee of the '484 patent, filed a law suit against Motorola Mobility, Inc. for patent infringement.¹ (Ex. 2003, 1.) According to the first amended complaint filed on October 5, 2011, "ADD's exclusive license runs for the full term of the '484 patent and includes all substantial rights in such patent, including the explicit right to sue and recover damages for infringement of the '484 patent and to otherwise seek enforcement of the rights it owns under the '484 patent." (Ex. 1007, 2:11.)

If ADD is effectively the patent owner, Mr. Arnouse may not represent himself as a *pro se* patent owner in this instant trial. *See Talasila, Inc. v. United States*, 240 F.3d 1064, 1066 (Fed. Cir. 2001). Even if Mr. Arnouse is permitted to represent himself as a *pro se* patent owner, it is unclear whether counsel has informed Mr. Arnouse of the possible consequences of the withdrawal without replacement counsel. Therefore, any motion to withdraw as counsel filed in this trial must also include: (1) a statement by counsel of what information has been given to Mr. Arnouse regarding the possible consequences of the withdrawal of counsel without replacement counsel; and (2) a statement signed by Mr. Arnouse that he understood those possible consequences.

¹ *Arnouse Digital Devices Corp. v. Motorola Mobility, Inc.*, No. 5:11-cv-00155-cr (D. Vt.).

It is

ORDERED that counsel for the patent owner is authorized to file a motion to withdraw as counsel; the motion is due on March 26, 2013;

FURTHER ORDERED that the motion to withdraw as counsel must identify which identity is the patent owner, the basis of the withdrawal, and the steps that have been taken by counsel to avoid foreseeable prejudice to the patent owner's rights; and

FURTHER ORDERED that the motion to withdraw as counsel must include: (1) a statement by counsel of what information has been given to Mr. Arnouse regarding the possible consequences of the withdrawal of counsel without replacement counsel; and (2) a statement signed by Mr. Arnouse that he understood those possible consequences.

PETITIONER:

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