

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DK CROWN HOLDINGS INC.
Petitioner,

v.

DIOGENES LIMITED
Patent Owner

IPR2023-00268
U.S. Patent No. 11,200,779

**PATENT OWNER'S UNOPPOSED MOTION FOR *PRO HAC VICE*
ADMISSION OF TIMOTHY GILBERT UNDER 37 C.F.R. § 42.10 (c)**

I. RELIEF REQUESTED

Patent Owner respectfully requests that the Board recognize Timothy Gilbert as counsel *pro hac vice* during this proceeding.

II. NO OPPOSITION TO THIS MOTION

Patent Owner has conferred with Petitioner concerning this Motion, and Petitioner has confirmed that they do not oppose the instant Motion.

III. GOVERNING LAWS, RULES, AND PRECEDENT

The Board may recognize counsel *pro hac vice* during a proceeding on a showing of good cause; “...where the lead counsel is a registered practitioner, a motion to appear *pro hac vice* may be granted upon a showing that counsel is an experienced litigation attorney and has an established familiarity with the subject matter at issue in the proceeding.” 37 C.F.R. § 42.10(c).

The Board has the power to determine a proper course of conduct for any situation not specifically covered by the Code of Federal Regulations (the “Regulations”) 37 C.F.R. § 42.5. This is relevant in the current Motion, as the Regulations do not specifically address the admission of foreign counsel *pro hac vice*.

Various District Courts have found that when local rules do not specify the procedure for admission of foreign lawyers, the court should use its sound discretion and evaluate *pro hac vice* admissions on a case-by-case basis considering the nuances of the particular case, the attorney's level of knowledge with federal practice in the United States and their familiarity with the Federal Rules of Civil Procedure and Federal Rules of Evidence. *Agjunction, LLC v. Agrain, Inc.*, No. 14-2069-JAR, 2014 WL 1745498, at *1 (D.Kan. May 1, 2014)

IV. STATEMENT OF FACTS

Based on the following statement of facts, and supported by the Declaration of Timothy Gilbert submitted herewith as EX2006, Patent Owner submits that a showing of good cause has been made and respectfully requests the *pro hac vice* admission of Timothy Gilbert in this proceeding:

1. Patent Owner's lead counsel, Matthew Juren, is a registered practitioner (Reg. No. 68,233).
2. Mr. Gilbert is an experienced litigation attorney who has been practicing law in the field of intellectual property litigation since 1990. EX2006, ¶4.
3. Mr. Gilbert is highly experienced in intellectual property law and advocacy. He teaches the *Intensive Advocacy Program* at Osgoode Hall

Law School in Toronto, and previously taught courses at OCAD University (*IP & Creativity*) from 2015 to 2018 and the University of Toronto (*Trial Advocacy*) from 1997 to 2015. *See* EX2006, ¶6. He has also been summoned to testify before the Canadian Parliamentary Standing Committee on Technology regarding proposed legislation, specifically to comment upon implications for domestic innovation and intellectual property. *See* EX2006, ¶7.

4. Mr. Gilbert is duly licensed and in good standing to practice law in the Province of Ontario, Canada, which is where he was called to the bar in 1990. *See* EX2006, ¶2. He has litigated before provincial Courts in Canada and the Federal Court of Canada for over 30 years and, while Mr. Gilbert is not a member of a state bar, he has been admitted *pro hac vice* to practice before six U.S. District Courts¹ in various patent infringement, trade secret misappropriation, and Hatch-Waxman proceedings over the last 20 years. *See* EX2006, ¶¶4-5, 9, 14. He has

¹ District of Delaware, Eastern District of Texas, Eastern District of Pennsylvania, Western District of Kentucky, District of Wyoming, and Northern District of West Virginia.

considerable familiarity with the Federal Rules of Civil Procedure and Federal Rules of Evidence. *See* EX2006, ¶20.

5. Importantly, Mr. Gilbert is counsel to the Patent Owner, Diogenes Limited, in related litigation between the parties to this proceeding in *Diogenes Limited, Colossus (IOM) Limited v DraftKings Inc.*, Case No. 21-1695-JLH-CJB (U.S. District Court for the District of Delaware). *See* EX2006, ¶8. That litigation concerns various patent infringement and validity claims, including in respect of US Patent No. 11,200,779—the patent at issue in this *inter partes* review. *See* EX2006, ¶10. As such, Mr. Gilbert has intimate familiarity with the issues in this proceeding and in related District Court proceedings between the same parties concerning the same patent. *See* EX2006, ¶12. Petitioner is represented by the same counsel in both these proceedings and the Delaware proceedings. *See* EX2006, ¶11.
6. Mr. Gilbert has never been suspended or disbarred from any court, nor has any adverse disciplinary decision been rendered against him by any provincial or state bar, bar association, or Court. *See* EX2006, ¶15.
7. No application filed by Mr. Gilbert for admission to practice before any court or administrative body has ever been ultimately denied. *See*

EX2006, ¶16. (While Mr. Gilbert was in one instance initially denied admission *pro hac vice* in the U.S. District Court for the District of Wyoming on the basis that he was not a member of the “Bar in any state in the United States of America”, he was admitted on a motion for reconsideration upon evidence of (a) several other U.S. District Court admissions, (b) specific knowledge of the case before the Court, (c) familiarity with U.S. federal practice, and (d) his commitment to comply with the local Rules of Professional Conduct). *See* EX2006, Appendices H and I.

8. No sanctions or contempt citations have been imposed against Mr. Gilbert by any court or administrative body. *See* EX2006, ¶17.
9. Mr. Gilbert has read and agrees to comply with the Office Patent Trial Practice Guide and the Board’s Rules of Practice for Trials set forth in part 42 of Title 37 of the C.F.R. *See* EX2006, ¶18.
10. Mr. Gilbert understands that he will be subject to the USPTO Rules of Professional Conduct as set forth in 37 C.F.R. §§ 11.101 *et seq.* and disciplinary jurisdiction under 37 C.F.R § 11.19 (a). *See* EX2006, ¶19.
11. Mr. Gilbert has an established familiarity with the subject matter at issue in this proceeding. Not only is Mr. Gilbert counsel to Diogenes Limited

in related litigation in the U.S. District Court for the District of Delaware where the patent at issue in this *inter partes* review is the subject of both the complaint and counterclaim, Mr. Gilbert has substantively reviewed all materials filed in this proceeding, including the briefing, expert testimony, the '779 Patent, and the asserted prior art. *See* EX2006, ¶21.

12. Mr. Gilbert has not applied for pro hac vice admission before the Office in any other proceedings in the last three years. *See* EX2006, ¶22.

V. GOOD CAUSE EXISTS FOR THE PRO HAC VICE ADMISSION OF MR. GILBERT IN THIS PROCEEDING

The Board may recognize counsel *pro hac vice* during a proceeding upon a showing of good cause, subject to the condition that lead counsel be a registered practitioner and any other conditions as the Board may impose. 37 C.F.R. §42.10(c). Patent Owner's lead counsel, Matthew Juren, is a registered practitioner. Based on the facts contained herein, as supported by Mr. Gilbert's declaration (Ex. 2006), good cause exists to admit Mr. Gilbert *pro hac vice* as backup counsel in this proceeding. He is an experienced litigator familiar with federal practice and patent law, and closely involved in the underlying facts of this proceeding.

VIII. CONCLUSION

For the foregoing reasons as well as the reasons contained in the declaration filed as EX2006, Patent Owner respectfully requests admission of Timothy Gilbert as counsel *pro hac vice* as backup counsel in this proceeding.

Dated: June 20, 2024

Respectfully submitted,

/Matthew C. Juren/

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CERTIFICATE OF SERVICE

I hereby certify that on this 20th day of June 2024, a copy of Patent Owner's Unopposed Motion for Pro Hac Vice Admission of Timothy Gilbert under 37 C.F.R. § 42.10(c). has been served in its entirety via email on the following:

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Dated: June 20, 2024

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