

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
Patent 11,200,779 B2

Before WILLIAM V. SAINDON, HYUN J. JUNG, and
SEAN P. O'HANLON, *Administrative Patent Judges*.

O'HANLON, *Administrative Patent Judge*.

ORDER

Granting Patent Owner's Motion for Admission *Pro Hac Vice*
of Timothy Gilbert
37 C.F.R. § 42.10

I. INTRODUCTION

On June 20, 2024, Patent Owner filed a motion for admission *pro hac vice* of Timothy Gilbert in this proceeding. Paper 23 (“Mot.” or “Motion”). The Motion relies on a Declaration of Mr. Gilbert. Ex. 2006. Mandatory Notice and Powers of Attorney identifying Mr. Gilbert have been filed. Papers 24, 25. Patent Owner states that Petitioner does not oppose the Motion. Mot. 2. For the reasons provided below, Patent Owner’s Motion is *granted*.

II. DISCUSSION

In accordance with 37 C.F.R. § 42.10(c), we 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. The representative Order authorizing motions for *pro hac vice* admission requires a statement of facts showing that there is good cause for us to recognize counsel *pro hac vice*, and an affidavit or declaration of the individual seeking to appear. *See* Paper 3, 2 (citing *Unified Patents, Inc. v. Parallel Iron, LLC*, IPR2013-00639, Paper 7 (PTAB Oct. 15, 2013) (Order – Authorizing Motion for *Pro Hac Vice* Admission)).

In this proceeding, lead counsel for Patent Owner, Matthew Juren (Reg. No. 68,233), is a registered practitioner. Mot. 3. Patent Owner asserts that there is good cause for us to recognize Mr. Gilbert *pro hac vice* in this proceeding. *Id.* at 3–7. Patent Owner’s assertions are supported by the Declaration of Mr. Gilbert. Ex. 2006.

Of particular relevance here is the requirement set forth in *Unified Patents* under part 2(b) that an attorney applying for admission *pro hac vice*

must attest to “[m]embership in good standing of the Bar of at least one State or the District of Columbia.” *Unified Patents* at 3. However, the instructions also specify that “[w]here the affiant or declarant is unable to provide any of the information requested above in part 2(b) or make any of the required statements or representations under oath, the individual should provide a full explanation of the circumstances as part of the affidavit or declaration.” *Id.* at 4.

Here, Mr. Gilbert declares that he is “not admitted to the bar of any U.S. State” Ex. 2006 ¶ 5; *see also* Mot. 4. Mr. Gilbert, however, declares that he is “duly licensed and in good standing to practice law in the Province of Ontario, Canada, where [he] was called to the bar in 1990.” Ex. 2006 ¶ 2. Mr. Gilbert further declares that he has “been practicing law in the field of intellectual property, and specifically patent litigation, since 1990” and has “extensive experience litigating intellectual property cases in provincial Courts in Canada, the Federal Court of Canada, and the Patented Medicines Review Prices Review Board.” *Id.* ¶ 4. Mr. Gilbert declares he has “been admitted *pro hac vice* in six U.S. District Courts in nine intellectual property cases over the last 20 years,” specifically the district courts of the “District of Delaware, Eastern District of Texas, Eastern District of Pennsylvania, Western District of Kentucky, District of Wyoming, and Northern District of West Virginia.” *Id.* ¶¶ 5, 8–10, 14; Mot. 4 n.1. Notably, Mr. Gilbert declares that he has been admitted *pro hac vice* in the Delaware district court litigation between the parties regarding the ’779 patent. Ex. 2006 ¶ 8–10; *see also* Mot. 5. Mr. Gilbert also declares that he is familiar with the subject matter at issue in this proceeding and intellectual property law in the United States. Ex. 2006 ¶¶ 12–13, 20–21.

Given the totality of the circumstances, and specifically that Mr. Gilbert has more than 30 years of intellectual property litigation experience including 20 years of U.S. patent litigation experience, is a licensed attorney in Canada, is familiar with U.S. intellectual property law, and has been admitted to practice before a number of U.S. District Courts in intellectual property cases, we consider Mr. Gilbert's experience to outweigh the fact that Mr. Gilbert is not a member of the bar of at least one State or the District of Columbia. On this record, we determine that Mr. Gilbert has sufficient legal and technical qualifications to represent Patent Owner in this proceeding. Accordingly, Patent Owner has established that there is good cause for the *pro hac vice* admission of Mr. Gilbert in this proceeding.

III. ORDER

It is:

ORDERED that Patent Owner's motion for *pro hac vice* admission of Timothy Gilbert is *granted*;

FURTHER ORDERED that Mr. Gilbert is authorized to represent Patent Owner only as back-up counsel in this proceeding;

FURTHER ORDERED that Patent Owner is to continue to have a registered practitioner as lead counsel in this proceeding;

FURTHER ORDERED that Mr. Gilbert shall comply with the Office Patent Trial Practice Guide¹ (84 Fed. Reg. 64,280 (Nov. 21, 2019)) and the Board's Rules of Practice for Trials as set forth in Part 42 of Title 37, Code of Federal Regulations; and

¹ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

FURTHER ORDERED that Mr. Gilbert shall be subject to the Office's disciplinary jurisdiction under 37 C.F.R. § 11.19(a) and the Office's Rules of Professional Conduct set forth in 37 C.F.R. §§ 11.101 *et seq.*

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For PETITIONER:

Eliot D. Williams
G. Hopkins Guy III
Jamie R. Lynn
Thomas C. Martin
Andrew D. Wilson
BAKER BOTTS L.L.P.
Eliot.Williams@BakerBotts.com
Hop.Guy@BakerBotts.com
Jamie.Lynn@BakerBotts.com
Tommy.Martin@bakerbotts.com
Andrew.Wilson@BakerBotts.com
DLDraftKingsvDiogenes@BakerBotts.com

For PATENT OWNER:

Matthew C. Juren
Kelly D. Stephens
STEPHENS JUREN, PLLC
mjuren@patent-lawyers.com
kstephens@patent-lawyers.com
service@patent-lawyers.com

Timothy Gilbert
GILBERT'S LLP
tim@gilbertslaw.ca