

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VIKING DRILL & TOOL, INC.,

Petitioner,

v.

HONGJIA WANG,

Patent Owner.

Case IPR2023-00473

Patent 11,007,583

**PETITIONER'S UNOPPOSED MOTION FOR
PRO HAC VICE ADMISSION OF KATHERINE CHEN**

Petitioner Viking Drill & Tool, Inc. (“Viking”) hereby respectfully moves for the *pro hac vice* admission of Katherine Chen due to her experience representing the Petitioner in a related litigation involving the same patent at issue this proceeding and her familiarity with the technical and substantive issues involved in this proceeding. The parties have conferred, and the Patent Owner does not oppose this Motion.

In support of this motion, Petitioner states as follows:

The Board may recognize counsel *pro hac vice* upon a showing of good cause, subject to the condition that lead counsel be a registered practitioner and to any other conditions the Board may impose. 37 C.F.R. § 42.10(c). A motion for *pro hac vice* admission may be granted where a party shows that “counsel is an experienced litigating attorney and has an established familiarity with the subject matter at issue in the proceeding.” *Id.*

Good cause exists under 37 C.F.R. § 42.10(c) for the *pro hac vice* admission of Katherine Chen as backup co-counsel in this matter. Ms. Chen is representing Viking in a related patent infringement action in the District of Minnesota (Civil Action. No. 0:21-cv-02759 (JWB/JFD), filed December 28, 2021) involving the same parties and the same patent at issue in this proceeding.

As a result of this experience, Ms. Chen has developed an intimate familiarity with the patent at issue and the Petitioner’s validity challenges, and the

Petitioner wishes to have Ms. Chen continue representing it in this matter before the Board.

The Petitioner has invested significant financial resources in the related proceedings described above, in which Ms. Chen has served as counsel. If this motion was denied, the Petitioner would be prejudiced because it would have to undertake the burdensome and costly task of educating another attorney regarding the patent at issue in this proceeding, and the related evidence. The Petitioner respectfully requests that the Board avoid this prejudice and grant this Motion.

Pursuant to the requirements of 37 C.F.R. § 42.10(c), Derek Vandenburg, a registered practitioner, will remain as lead counsel in this matter. Mr. Vandenburg is a partner at Carlson Caspers, the same law firm that is representing the Petitioner in the related federal court action involving the patent at issue here. Ms. Chen has worked with Mr. Vandenburg on other similar matters.

Pursuant to the requirements of the “Order -- Authorizing Motion for *Pro Hac Vice* Admission” Case IPR2013-00639, Paper 7, this Motion is also supported by the Declaration of Katherine Chen (Exhibit 1027), filed herewith.

In the Declaration of Katherine Chen (Ex. 1027), Ms. Chen attests that she has read and will comply with the Patent Office Trial Practice Guide and the Board’s Rules of Practice set forth in 35 C.F.R. § 42. Ms. Chen further attests that she agrees to be subject to the USPTO’s 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).

For the foregoing reasons, and in view of the Declaration submitted herewith, Petitioner submits that good cause exists for the *pro hac vice* admission of Katherine Chen and respectfully requests that the Board grant this motion.

Dated: July 19, 2023

Respectfully submitted,

/s/ J. Derek Vandenburg

J. Derek Vandenburg (Lead Counsel)

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CERTIFICATION OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e) and the agreement of the parties, the undersigned certifies that on July 19th, 2023, a true and correct copy of the foregoing *Petitioner's Unopposed Motion for Pro Hac Vice Admission of Katherine Chen*, along with the accompanying Exhibit 1027, was served via electronic mail upon the following:

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/s/ J. Derek Vandenburg
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