

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LIFESCAN, INC.,
Petitioner,

v.

FACET TECHNOLOGIES, LLC,
Patent Owner.

IPR2023-00712
Patent 8,840,635 B2

Before ULRIKE W. JENKS, JASON W. MELVIN, and DAVID COTTA,
Administrative Patent Judges.

JENKS, *Administrative Patent Judge.*

ORDER

Conditionally Granting Petitioner's Motion for
Pro Hac Vice Admission of An Le
37 C.F.R. § 42.10

On May 16, 2024, Petitioner filed a motion for *pro hac vice* admission of An Le in the above-identified proceeding (“Motion”). Paper 60. Petitioner also filed a declaration from Ms. Le in support of the Motion (“Declaration”). Ex. 1060. Petitioner attests that Patent Owner does not oppose the Motion. Motion 1.

Pursuant to 37 C.F.R. § 42.10(c), 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. In its notice authorizing motions for *pro hac vice* admission, the Board requires a statement of facts showing there is good cause for the Board to recognize counsel *pro hac vice* and an affidavit or declaration of the individual seeking to appear in this proceeding. See Paper 4, 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”) (“*Unified Patents*”)).

Based on the facts set forth in the Motion and the accompanying Declaration, we conclude that Ms. Le has sufficient legal and technical qualifications to represent Petitioner in this proceeding, that Ms. Le has demonstrated sufficient litigation experience and familiarity with the subject matter of this proceeding, and that Ms. Le meets all other requirements for admission *pro hac vice*. Accordingly, Petitioner has established good cause for *pro hac vice* admission of Ms. Le.

Upon review of the record before us, we note that a Power of Attorney in accordance with 37 C.F.R. § 42.10(b) has not been submitted for Ms. Le.¹

¹ Petitioner asserts that “An Le is an attorney associated with Morgan, Lewis & Bockius LLP and is authorized to represent Petitioner under Petitioner LifeScan, Inc.’s Power of Attorney (Paper 1).” Motion 2. Notwithstanding that Petitioner’s Power of Attorney is Paper 2, the Power of Attorney states,

In view thereof, and for the reasons set forth below, Petitioner's Motion is *conditionally granted*, and is to be effective after Petitioner files the aforementioned Power of Attorney.

Petitioner has filed updated mandatory notices identifying Ms. Le as back-up attorney.

Accordingly, it is:

ORDERED that Petitioner's Motion for *pro hac vice* admission of An Le is *conditionally granted*, provided that within ten (10) business days of the date of this order, Petitioner must submit a Power of Attorney for Ms. Le in accordance with 37 C.F.R. § 42.10(b);

FURTHER ORDERED that Petitioner is to continue to have a registered practitioner represent it as lead counsel for the above-identified proceeding, Ms. Le is authorized to represent Petitioner as back-up counsel only;

FURTHER ORDERED that Ms. Le is to comply with the Patent Trial and Appeal Board's Consolidated Trial Practice Guide² (November 2019), and the Board's Rules of Practice for Trials, as set forth in Part 42 of Title 37, Code of Federal Regulations; and

FURTHER ORDERED that Ms. Le shall be subject to the Office's disciplinary jurisdiction under 37 C.F.R. § 11.19(a), and the USPTO Rules of Professional Conduct under 37 C.F.R. §§ 11.101 *et seq.*

"Petitioner hereby appoints practitioners associated with Morgan, Lewis & Bockius LLP, and Carter Ledyard & Milburn LLP, Customer Numbers 24,341 and 63,973, respectively, as their attorneys." Ms. Le is not a practitioner (*see* 37 C.F.R. § 1.32(a)(1)), and is not associated with either Customer Number.

² Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

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