

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ENSIGN US SOUTHERN DRILLING LLC
Petitioner,

v.

C&M OILFIELD RENTALS, LLC
D/B/A C-MOR ENERGY SERVICES
Patent Owner.

IPR2023-00804
Patent 10,976,016 B2

Before NORMAN H. BEAMER, KEVIN C. TROCK, and
JULIA HEANEY, *Administrative Patent Judges*.

HEANEY, *Administrative Patent Judge*.

ORDER
Conditionally Granting Petitioner's Motion for
Pro Hac Vice Admission of Neil Kelly
37 C.F.R. § 42.10

On November 13, 2023, Petitioner filed a motion for *pro hac vice* admission of Neil Kelly in the above-identified proceeding (“Motion”). Paper 12. Petitioner also filed a declaration from Mr. Kelly in support of the Motion (“Declaration”). Paper 13¹. Petitioner asserts that the Motion is unopposed. Motion 2.

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 5, 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 Mr. Kelly has sufficient legal and technical qualifications to represent Petitioner in this proceeding, that Mr. Kelly has demonstrated sufficient litigation experience and familiarity with the subject matter of this proceeding, and that Mr. Kelly meets all other requirements for admission *pro hac vice*. Accordingly, Petitioner has established good cause for *pro hac vice* admission of Mr. Kelly.

¹ Petitioner filed the Declaration as a Paper. We excuse this mistake on this occasion, but remind the parties that affidavits and declarations must be filed as exhibits. *See* 37 C.F.R. § 42.63(a) (“Evidence consists of affidavits, transcripts of depositions, documents, and things. All evidence must be filed in the form of an exhibit.”).

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 Mr. Kelly. 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 not filed updated mandatory notices identifying Mr. Kelly as back-up attorney. Therefore, Petitioner must file an updated mandatory notice identifying Mr. Kelly as back-up counsel in accordance with 37 C.F.R. § 42.8(b)(3).

Accordingly, it is:

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

FURTHER ORDERED that Petitioner must file an updated mandatory notice identifying Mr. Kelly as back-up counsel in accordance with 37 C.F.R. § 42.8(b)(3);

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

FURTHER ORDERED that Mr. Kelly is to comply with the Patent Trial and Appeal Board's Consolidated Trial Practice Guide² (November

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

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 Mr. Kelly 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.*

FOR PETITIONER:

Chad C. Walters
Douglas M. Kubehl
Jeffery S. Becker
Joseph Andrew Grado
BAKER BOTTS L.L.P.
chad.walters@bakerbotts.com
doug.kubehl@bakerbotts.com
jeff.becker@bakerbotts.com
Andrew.grado@bakerbotts.com

FOR PATENT OWNER:

Lawrence P. Cogswell III, Ph.D.
Timothy J. Meagher
Keith J. Wood
HAMILTON, BROOK, SMITH & REYNOLDS, P.C.
lawrence.cogswell@hbsr.com
timothy.meagher@hbsr.com
keith.wood@hbsr.com