

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ALIVECOR, INC.,
Petitioner,

v.

APPLE INC.,
Patent Owner.

IPR2023-00948 (Patent 10,866,619 B2)
IPR2023-00949 (Patent 10,866,619 B2)¹

Before KEN B. BARRETT, SCOTT A. DANIELS, and
ROBERT L. KINDER, *Administrative Patent Judges*.

DANIELS, *Administrative Patent Judge*.

ORDER
Granting Patent Owner's Motions for
Pro Hac Vice Admission of Michael Amon
37 C.F.R. § 42.10

¹ The combined caption is for administrative convenience only and does not indicate that IPR2023-00948 and IPR2023-00949 have been joined or consolidated. The parties are not authorized to use this caption without express permission of the Board.

On February 1, 2024, Patent Owner filed motions requesting *pro hac vice* admission of Michael Amon in each of the above-identified proceedings (collectively “Motions”). Paper 10.² Patent Owner also submitted declarations from Mr. Amon in support of the Motions (collectively “Declarations”). Ex. 2003.³ Petitioner has not opposed the Motions. For the reasons provided below, Patent Owner’s Motions are *granted*.

In accordance with 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 authorizing a motion for *pro hac vice* admission, the Board requires the moving party to provide 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 the proceeding. *See Unified Patents, Inc. v. Parallel Iron, LLC*, IPR2013-00639 (PTAB Oct. 15, 2013) (Paper 7) (representative “Order – Authorizing Motion for *Pro Hac Vice* Admission”).

Based on the facts set forth in the Motions and the accompanying Declarations, we conclude that Mr. Amon has sufficient legal and technical qualifications to represent Patent Owner in these proceedings, and has demonstrated sufficient litigation experience and familiarity with the subject matter of these proceedings. We note, however, two issues with the Declarations. First, Mr. Amon indicates that he has applied for *pro hac vice* admission in six matters in the past three years. Ex. 2003 ¶ 7. Mr. Amon has applied for admission in at least two additional matters in the past three

² For purposes of expediency, we cite to Papers filed in IPR2023-00948. Patent Owner filed a similar Motion in IPR2023-00949 (Paper 10).

³ We cite to Exhibits filed in IPR2023-00948. Patent Owner filed a similar Declaration in IPR2023-00949 (Ex. 2003).

years. Specifically, IPR2022-01560 and IPR2022-01562, in which Mr. Amon applied and was admitted, were not identified in the Declarations. Second, the cover page of each of the Declarations indicates it is “IN SUPPORT OF PETITIONER’S UNOPPOSED MOTION,” when the Motions are for Mr. Amon to appear on behalf of Patent Owner.

Both of the issues identified above appear to be harmless error, and Mr. Amon meets all other requirements for admission *pro hac vice*. See Ex. 2003. Patent Owner has established good cause for *pro hac vice* admission of Mr. Amon. Patent Owner must, however, file corrected Declarations within ten (10) business days of this Order.⁴ Mr. Amon is permitted to serve as back-up counsel only. See 37 C.F.R. § 42.10(c).

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. Amon and must be filed.

Patent Owner must file an updated Mandatory Notice identifying Mr. Amon as back-up counsel in accordance with 37 C.F.R. § 42.8(b)(3).

In consideration of the foregoing, it is hereby

ORDERED that Patent Owner’s Motion for *pro hac vice* admission of Michael Amon is *granted*, provided that within ten (10) business days of the date of this order, Patent Owner submits, in each of the above-identified proceedings: 1) corrected Declarations and 2) a Power of Attorney for Mr. Amon in accordance with 37 C.F.R. § 42.10(b);

⁴ Patent Owner is advised to file corrected declarations only and not corrected motions for *pro hac vice* admission, as that would require Patent Owner to pay another fee for filing such motions.

IPR2023-00948 (Patent 10,866,619 B2)

IPR2023-00949 (Patent 10,866,619 B2)

FURTHER ORDERED that Patent Owner must file, in each of the above-identified proceedings, an updated Mandatory Notice identifying Mr. Amon as back-up counsel in accordance with 37 C.F.R. § 42.8(b)(3);

FURTHER ORDERED that Patent Owner is to continue to have a registered practitioner represent it as lead counsel for the above-identified proceedings;

FURTHER ORDERED that Mr. Amon is authorized to represent Patent Owner as back-up counsel only in the above-identified proceedings;

FURTHER ORDERED that Mr. Amon comply with the Patent Trial and Appeal Board Consolidated Trial Practice Guide⁵ (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

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

⁵ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

IPR2023-00948 (Patent 10,866,619 B2)

IPR2023-00949 (Patent 10,866,619 B2)

FOR PETITIONER:

Christopher TL Douglas

Scott M. Stevens

J. Ravindra Fernando

Erin Beaton

ALSTON & BIRD LLP

christopher.douglas@alston.com

scott.stevens@alston.com

ravi.fernando@alston.com

erin.beaton@alston.com

FOR PATENT OWNER:

W. Karl Renner

Grace Kim

Ryan Chowdhury

Parvin Ghane

Jeremy Monaldo

FISH & RICHARDSON P.C.

axf-ptab@fr.com

gkim@fr.com

rchowdhury@fr.com

ghane@fr.com

jjm@fr.com