

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTERNATIONAL BUSINESS MACHINES CORPORATION,
Petitioner,

v.

DIGITAL DOORS, INC.,
Patent Owner.

IPR2023-00973
Patent 8,468,244 B2

Before THU A. DANG, THOMAS L. GIANNETTI, and
ELIZABETH M. ROESEL, *Administrative Patent Judges*.

ROESEL, *Administrative Patent Judge*.

ORDER
Conditionally Granting Patent Owner's Motion for
Pro Hac Vice Admission of C. Graham Gerst
37 C.F.R. § 42.10(c)

Patent Owner filed a Motion for *Pro Hac Vice* Admission of C. Graham Gerst. Paper 12 (“Motion”). Patent Owner submitted a Declaration of C. Graham Gerst in support of the Motion. Ex. 2009. Patent Owner attests that Petitioner does not oppose the Motion. Motion 4. For the reasons provided below, Patent Owner’s Motion is *conditionally 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, Paper 7 (PTAB Oct. 15, 2013) (representative “Order – Authorizing Motion for *Pro Hac Vice* Admission”).

Based on the facts set forth in the Motion and the accompanying Declaration, we conclude that Mr. Gerst has sufficient legal and technical qualifications to represent Patent Owner in this proceeding, has demonstrated sufficient litigation experience and familiarity with the subject matter of this proceeding, and meets all other requirements for admission *pro hac vice*. *See* Ex. 2009. Accordingly, Patent Owner has established good cause for *pro hac vice* admission of Mr. Gerst. Mr. Gerst will be permitted to serve as back-up counsel only. *See* 37 C.F.R. § 42.10(c).

We note that a Power of Attorney in accordance with 37 C.F.R. § 42.10(b) has not been submitted for Mr. Gerst. Therefore, Patent Owner’s

Motion is *conditionally granted*, and will become effective after Patent Owner files a Power of Attorney for Mr. Gerst.

Patent Owner also has not filed an updated Mandatory Notice identifying Mr. Gerst as back-up counsel. Patent Owner must therefore file an updated Mandatory Notice identifying Mr. Gerst as back-up counsel in accordance with 37 C.F.R. § 42.8(b)(3).

Accordingly, it is

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

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

FURTHER ORDERED that Patent Owner continue to have a registered practitioner represent it as lead counsel for this proceeding;

FURTHER ORDERED that Mr. Gerst is authorized to act as back-up counsel only in this proceeding;

FURTHER ORDERED that Mr. Gerst comply with the Patent Trial and Appeal Board Consolidated Trial Practice Guide (84 Fed. Reg. 64,280 (Nov. 21, 2019))¹ 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>.

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FURTHER ORDERED that Mr. Gerst 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.*

PETITIONER:

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