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Paper 8
Entered: August 29, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TESLA, INC.,
Petitioner,

v.

AUTONOMOUS DEVICES, LLC,
Patent Owner.

IPR2023-01169 (Patent 10,607,134 B1)
IPR2023-01170 (Patent 10,102,449 B1)
IPR2023-01171 (Patent 11,113,585 B1)
IPR2023-01172 (Patent 11,055,583 B1)
IPR2023-01173 (Patent 11,055,583 B1)

Before BARBARA A. PARVIS, ROBERT J. WEINSCHENK, and RUSSELL E. CASS, *Administrative Patent Judges*.

PER CURIAM.

ORDER[1]
Conditionally Granting Patent Owner's Motions for
Pro Hac Vice Admission of Blair M. Jacobs
37 C.F.R. § 42.10

[1] The combined caption is for administrative convenience only and does not indicate that IPR2023-01169, IPR2023-01170, IPR2023-01171, IPR2023-01172, and IPR2023-01173 have been joined. The parties are not authorized to use this caption without express permission of the Board.

Patent Owner filed motions requesting *pro hac vice* admission of Blair M. Jacobs in each of the above-identified proceedings (collectively "Motions"). Paper 6.[2] Patent Owner also submitted declarations from Mr. Jacobs in support of the Motions (collectively "Declarations"). Ex. 2002. Petitioner did not oppose the Motions within the requisite time period.

For the reasons provided below, the Motions are 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 (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. Jacobs has sufficient legal and technical qualifications to represent Patent Owner in these proceedings, has demonstrated sufficient litigation experience and familiarity with the subject matter of these proceedings, and meets all other requirements for admission

[2] For purposes of expediency, we cite to the Papers and Exhibits filed in IPR2023-01169. Patent Owner filed similar Papers and Exhibits in IPR2023-01170, IPR2023-01171, IPR2023-01172, and IPR2023-01173.

pro hac vice. *See* Declarations. Accordingly, Patent Owner has established good cause for *pro hac vice* admission of Mr. Jacobs. Mr. Jacobs will be permitted to serve as back-up counsel only. *See* 37 C.F.R. § 42.10(c).

We note that Patent Owner filed a Power of Attorney including Mr. Jacobs in accordance with 37 C.F.R. § 42.10(b). IPR2023-01169, Paper 5. Patent Owner has also filed Mandatory Notices identifying Mr. Jacobs as back-up counsel in accordance with 37 C.F.R. § 42.8(b)(3). IPR2023-01169, Paper 4.

We further note that the Declarations do not attest to whether Mr. Jacobs has applied to appear *pro hac vice* in the last three (3) years in a proceeding before the Office. *Unified Patents*, IPR2013-00639, 3. Therefore, we grant the Motions on the condition that Patent Owner file new declarations from Mr. Jacobs that address this issue.

Accordingly, it is:

ORDERED that Patent Owner's Motions for *pro hac vice* admission of Blair M. Jacobs are *granted* on the condition that Patent Owner file new declarations from Mr. Jacobs within ten (10) business days of the date of this Order, which address whether he has applied to appear *pro hac vice* in the last three (3) years in a proceeding before the Office;

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. Jacobs is authorized to represent Patent Owner as back-up counsel only in the above-identified proceedings;

FURTHER ORDERED that Mr. Jacobs comply with the Patent Trial and Appeal Board Consolidated Trial Practice Guide[3] (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;[4] and

FURTHER ORDERED that Mr. Jacobs 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.*

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[3] Available at https://www.uspto.gov/TrialPracticeGuideConsolidated.

[4] In the Declarations, Mr. Jacobs indicates compliance with the Office Patent Trial Practice Guide and the Board's Rules of Practice for Trials set forth in part 37 C.F.R. Part 42 (as opposed to part 42 of 37 C.F.R.). *See* Ex. 2002 ¶ 5. We excuse this mistake on this occasion, but remind Mr. Jacobs that the Board's Rules of Practice for Trials are set forth in Part 42 of Title 37, Code of Federal Regulations, and it is those rules to which Mr. Jacobs will be subject.

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