

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MOTOROLA SOLUTIONS, INC.,
Petitioner,

v.

STA GROUP LLC,
Patent Owner.

IPR2023-01295
Patent 8,994,830 B2

Before MICHAEL J. FITZPATRICK, DAVID C. McKONE, and
KEVIN C. TROCK, *Administrative Patent Judges*.

TROCK, *Administrative Patent Judge*.

ORDER

Conditionally Granting Petitioner's Motion for
Pro Hac Vice Admission of Stephen O'Donohue
37 C.F.R. § 42.10

On August 30, 2024, Petitioner filed a motion requesting *pro hac vice* admission of Stephen O'Donohue. Paper 21 ("Motion" or "Mot.").

Petitioner also submitted a Declaration from Stephen O'Donohue in support of the Motion. Ex. 1035 ("Declaration"). Petitioner attests that Patent Owner does not oppose the Motion. Paper 21, 5.

For the reasons provided below, Petitioner'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 (PTAB Oct. 15, 2013) (Paper 7) (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. O'Donohue has sufficient legal and technical qualifications to represent Petitioner 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. 1035. Accordingly, Petitioner has established good cause for *pro hac vice* admission of Mr. O'Donohue. Mr. O'Donohue will be 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.

O'Donohue. Therefore, 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. O'Donohue as back-up counsel. Therefore, Petitioner must file an updated Mandatory Notice identifying Mr. O'Donohue 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 Petitioner's Motion (Paper 21) for *pro hac vice* admission of Stephen O'Donohue is *conditionally granted*, provided that within ten (10) business days of the date of this order, Petitioner submits a Power of Attorney for Stephen O'Donohue in accordance with 37 C.F.R. § 42.10(b);

FURTHER ORDERED that Petitioner must file an updated Mandatory Notice identifying Mr. O'Donohue 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 this proceeding;

FURTHER ORDERED that Mr. O'Donohue is authorized to represent Petitioner as back-up counsel only in this proceeding;

FURTHER ORDERED that Mr. O'Donohue be familiar with the Patent Trial and Appeal Board Consolidated Trial Practice Guide¹ (84 Fed. Reg. 64,280 (Nov. 21, 2019)), and comply with 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>.

FURTHER ORDERED that Mr. O'Donohue 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.*²

² In the Declaration, Mr. O'Donohue indicates he will be subject to the *USPTO Code of Professional Responsibility* (as opposed to the *USPTO Rules of Professional Conduct*) set forth in 37 C.F.R. §§ 11.101 *et seq.* See Ex. 1035 ¶ 6. We excuse this mistake on this occasion, but remind Mr. O'Donohue that he shall be subject to *the USPTO Rules of Professional Conduct*.

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