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Paper 18
Entered: May 7, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MERCEDES-BENZ USA, LLC,
Petitioner,

v.

DAEDALUS PRIME LLC,
Patent Owner.

IPR2023-01333
Patent 10,049,080 B2

Before WILLIAM V. SAINDON, THOMAS L. GIANNETTI, and GREGG I. ANDERSON, *Administrative Patent Judges*.

GIANNETTI, *Administrative Patent Judge*.

ORDER
Granting Petitioner's Motions for
Pro Hac Vice Admission of Damon M. Lewis and Jiaxing (Kyle) Xu
37 C.F.R. § 42.10

Petitioner filed motions requesting *pro hac vice* admission of Damon M. Lewis and Jiaxing (Kyle) Xu. Paper 14 ("Lewis Mot."); Paper 17 ("Xu Mot."). Petitioner also submitted declarations from Mr. Lewis and Mr. Xu in support of the Motions. Ex. 1036 ("Lewis Dec."); Ex. 1037 ("Xu Dec."). Petitioner attests that Patent Owner does not oppose the Motions. Lewis Mot. 1; Xu Mot. 1.

For the reasons provided below, Petitioner'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. Lewis and Mr. Xu have sufficient legal and technical qualifications to represent Petitioner in this proceeding, that Mr. Lewis and Mr. Xu have demonstrated sufficient litigation experience and familiarity with the subject matter of this proceeding, and that Mr. Lewis and Mr. Xu meet all other requirements for admission *pro hac vice*. *See* Motions. Accordingly, Petitioner has established good cause for *pro hac vice* admission of Mr. Lewis and Mr. Xu. Mr. Lewis and Mr. Xu will be permitted to serve as back-up counsel only. *See* 37 C.F.R. § 42.10(c).

We note that Petitioner filed a Power of Attorney including Mr. Lewis and Mr. Xu in accordance with 37 C.F.R. § 42.10(b). Paper 16. Petitioner also filed Mandatory Notices in accordance with 37 C.F.R. § 42.8(b)(3) that identify Mr. Lewis and Mr. Xu as back-up counsel. Paper 15.

In consideration of the foregoing, it is hereby

ORDERED that Petitioner's Motions for *pro hac vice* admission of Mr. Lewis and Mr. Xu are *granted*;

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

FURTHER ORDERED that Mr. Lewis and Mr. Xu are authorized to represent Petitioner as back-up counsel only in this proceeding;

FURTHER ORDERED that Mr. Lewis and Mr. Xu comply with the Patent Trial and Appeal Board Consolidated Trial Practice Guide[1] (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. Lewis and Mr. Xu are 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*.

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

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