

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BIONTECH SE and PFIZER INC.,
Petitioner,

v.

MODERNATX, INC.,
Patent Owner.

IPR2023-01359
Patent 10,933,127 B2

Before TIMOTHY G. MAJORS and
DAVID COTTA, *Administrative Patent Judges*.

MAJORS, *Administrative Patent Judge*.

ORDER
Granting Petitioner's Motion for
Pro Hac Vice Admission of Michael J. Mestitz
37 C.F.R. § 42.10

Pfizer Inc. (“Petitioner”) filed a motion requesting *pro hac vice* admission of Michael J. Mestitz. Paper 67 (“Mot.”). Petitioner also submitted a declaration from Mr. Mestitz in support of the Motion. Ex. 1319 (“Dec.”). Petitioner attests that Patent Owner does not oppose the Motion. Mot. 1.

For the reasons provided below, Petitioner’s Motion is *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. Mestitz has sufficient legal and technical qualifications to represent Petitioner in this proceeding, that Mr. Mestitz has demonstrated sufficient litigation experience and familiarity with the subject matter of this proceeding, and that Mr. Mestitz meets all other requirements for admission *pro hac vice*. *See* Motion. Accordingly, Petitioner has established good cause for *pro hac vice* admission of Mr. Mestitz. Mr. Mestitz 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. Mestitz in accordance with 37 C.F.R. § 42.10(b). Paper 68. Petitioner also

filed updated filed Mandatory Notices in accordance with 37 C.F.R. § 42.8(b)(3) that identifies Mr. Mestitz as back-up counsel. Paper 69.

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner's Motion for *pro hac vice* admission of Michael J. Mestitz is *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. Mestitz is authorized to represent Petitioner as back-up counsel only in this proceeding;

FURTHER ORDERED that Mr. Mestitz 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

FURTHER ORDERED that Mr. Mestitz 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.*

¹ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

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