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Paper 9
Date: January 30, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PRECISION PLANTING LLC,
Petitioner,

v.

MASCHIO GASPARDO S.p.A.,
Patent Owner.

IPR2024-00008
Patent 8,770,121 B2

Before BENJAMIN D. M. WOOD, LYNNE H. BROWNE, and RICHARD H. MARSCHALL, *Administrative Patent Judges*.

WOOD, *Administrative Patent Judge*.

ORDERS
Conditionally Granting Patent Owner's Motion for *Pro Hac Vice* Admission of Ashley E. Shapiro

Conditionally Granting Patent Owner's Motion to Withdraw
37 C.F.R. § 42.10

I. INTRODUCTION

Patent Owner requests *pro hac vice* admission of Ashley E. Shapiro and withdrawal of back-up counsel Elizabeth O'Donoghue. We address the motions for admission of Ms. Shapiro and the withdrawal of Ms. O'Donoghue in the sections that follow.

II. MOTION FOR *PRO HAC VICE* ADMISSION OF ASHLEY E. SHAPIRO

On January 10, 2024, Patent Owner filed a motion requesting *pro hac vice* admission of Ashley E. Shapiro. Paper 8 ("Motion"). Patent Owner also submitted a Declaration from Ms. Shapiro in support of the Motion. Ex. 2010 ("Declaration"). Patent Owner attests that Petitioner does not oppose the Motion. Paper 8, 2. 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 (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 Ms. Shapiro 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. 2010. Accordingly, Patent Owner has established good cause for *pro hac vice* admission of Ms. Shapiro. Ms. Shapiro will be permitted to serve as back-up counsel only.[1] *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 Ms. Shapiro. Therefore, Patent Owner's Motion is *conditionally granted*, and is to be effective after Patent Owner files the aforementioned Power of Attorney. Patent Owner must also file an updated Mandatory Notice identifying Ms. Shapiro as back-up counsel in accordance with 37 C.F.R. § 42.8(b)(3).

III. MOTION FOR WITHDRAWAL OF ELIZABETH O'DONOGHUE

On January 10, 2024, Patent Owner's Lead Counsel, Kevin R. Casey, requested via email that back-up counsel Elizabeth O'Donoghue be removed from this matter. Ex. 3001. Because the Motion to admit Ms. Shapiro *pro hac vice* stated that Ms. O'Donoghue was no longer an attorney with the firm representing Patent Owner and therefore could no longer serve as back-up counsel (Paper 8, 2), we determined to consider the Motion as also a motion to withdraw Ms. O'Donoghue as back-up counsel under 37 C.F.R. § 42.10(e). Ex. 3001. Petitioner has not opposed.

We *conditionally grant* the withdrawal of Elizabeth O'Donoghue to be effective when Ms. Shapiro's admission *pro hac vice* becomes effective.

[1] We note that when identifying Lead Counsel Kevin R. Casey, the Motion appears to include a typographical error misstating Mr. Casey's registration number. Motion 2. We deem this to be harmless error.

See 37 C.F.R. § 42.10(a) ("If a party is represented by counsel, the party must designate a lead counsel and at least one back-up counsel"). Patent Owner must file an updated Mandatory Notice removing Ms. O'Donoghue 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 Patent Owner's Motion (Paper 8) for *pro hac vice* admission of Ashley E. Shapiro is *conditionally granted* provided that within ten (10) business days of the date of this order, Patent Owner submits a Power of Attorney for Ms. Shapiro in accordance with 37 C.F.R. § 42.10(b);

FURTHER ORDERED that Patent Owner's Motion for withdrawal of Elizabeth O'Donoghue is *conditionally granted*, and Ms. O'Donoghue is allowed to withdraw as counsel from the above-identified proceeding when Ms. Shapiro's admission *pro hac vice* becomes effective;

FURTHER ORDERED that Patent Owner must file updated Mandatory Notices identifying Ms. Shapiro as back-up counsel and removing Ms. O'Donoghue as back-up counsel, in accordance with 37 C.F.R. § 42.8(b)(3);

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

FURTHER ORDERED that Ms. Shapiro is authorized to represent Patent Owner as back-up counsel only in this proceeding;

FURTHER ORDERED that Ms. Shapiro comply with the Patent Trial and Appeal Board Consolidated Trial Practice Guide[2] (84 Fed. Reg. 64,280

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

(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 Ms. Shapiro 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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