

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HILTI AKTIENGESELLSCHAFT,
Petitioner,

v.

SPECIFIED TECHNOLOGIES INC.,
Patent Owner.

IPR2024-00192 (Patent 9,157,232 B2)
IPR2024-00193 (Patent 10,143,868 B2)¹

Before ROBERT L. KINDER, RICHARD H. MARSCHALL, and
MICHAEL A. VALEK, *Administrative Patent Judges*.

VALEK, *Administrative Patent Judge*.

ORDER
Conditionally Granting Petitioner's Motions for *Pro Hac Vice*
Admission of W. Cook Alciati
37 C.F.R. § 42.10

¹ This Order is entered in both cases. The parties are not authorized to use this style heading for any subsequent papers.

On February 13, 2024, Petitioner filed a motion for *pro hac vice* admission of W. Cook Alciati in each of the above-identified proceedings (collectively, “Motions”). Paper 6.² Petitioner also filed declarations from Mr. Alciati in support of the Motions (collectively, “Declarations”). Ex. 1017. Petitioner indicates that Patent Owner does not oppose the Motions. Mot. 1.

Pursuant to 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 its notice authorizing motions for *pro hac vice* admission, the Board requires 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 this proceeding. See Paper 3, 2 (citing *Unified Patents, Inc. v. Parallel Iron, LLC*, IPR2013-00639, Paper 7 (PTAB Oct. 15, 2013) (“Order – Authorizing Motion for *Pro Hac Vice* Admission”) (“*Unified Patents*”).

Based on the facts set forth in the Motions and the accompanying Declarations, we conclude that Mr. Alciati has sufficient legal and technical qualifications to represent Petitioner in these proceedings, that Mr. Alciati has demonstrated sufficient litigation experience and familiarity with the subject matter of these proceedings, and that Mr. Alciati meets all other requirements for admission *pro hac vice*. Accordingly, Petitioner has established good cause for *pro hac vice* admission of Mr. Alciati.

Upon review of the record before us, we note that Powers of Attorney in accordance with 37 C.F.R. § 42.10(b) have not been submitted for Mr.

² We refer to the Papers and exhibits filed in IPR2024-00192. Petitioner filed a similar motion and declaration in IPR2024-00193.

Alciati. In view thereof, and for the reasons set forth below, Petitioner's Motions are conditionally granted, and are to be effective after Petitioner files the aforementioned Powers of Attorney.

Petitioner has not filed updated mandatory notices identifying Mr. Alciati as back-up attorney. Therefore, Petitioner must file updated mandatory notices identifying Mr. Alciati as back-up counsel in accordance with 37 C.F.R. § 42.8(b)(3).

Accordingly, it is:

ORDERED that Petitioner's Motions for *pro hac vice* admission of W. Cook Alciati are *conditionally granted* provided that within ten (10) business days of the date of this order, Petitioner must submit Powers of Attorney for Mr. Alciati in accordance with 37 C.F.R. § 42.10(b);

FURTHER ORDERED that Petitioner is to continue to have a registered practitioner represent it as lead counsel for the above-identified proceedings;

FURTHER ORDERED that Petitioner must file updated mandatory notices identifying Mr. Alciati as back-up counsel in accordance with 37 C.F.R. § 42.8(b)(3);

FURTHER ORDERED that Mr. Alciati is authorized to represent Petitioner as back-up counsel only in the above-identified proceedings;

FURTHER ORDERED that Mr. Alciati is to comply with the Patent Trial and Appeal Board's Consolidated Trial Practice Guide³ (November 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. Alciati shall be subject to the

³ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

IPR2024-00192 (Patent 9,157,232 B2)
IPR2024-00193 (Patent 10,143,868 B2)

Office's disciplinary jurisdiction under 37 C.F.R. § 11.19(a), and the
USPTO Rules of Professional Conduct under 37 C.F.R. §§ 11.101 *et. seq.*⁴

⁴ Mr. Alciati declares that he agrees to “be subject to the USPTO *Code of Professional Responsibility*” rather than the USPTO Rules of Professional Conduct set forth in 37 C.F.R. §§ 11.101 *et seq.* Decl. ¶ 6 (emphasis added). We understand this to be an oversight and that Mr. Alciati has agreed to be subject to the applicable rules.

IPR2024-00192 (Patent 9,157,232 B2)
IPR2024-00193 (Patent 10,143,868 B2)

FOR PETITIONER:

Michael Dorfman
Natalie Grace
GARDELLA GRACE P.A.
mdorfman@gardellagrace.com
ngrace@gardellagrace.com

FOR PATENT OWNER:

Ryan Miller
Jeff Schwartz
Carol Thorstad-Forsyth
Lukas Toft
Paul Ticer
Bradley Edgington
John Edwin Ryan Guerrero
FOX ROTHSCHILD LLP
rmiller@foxrothschild.com
jeschwartz@foxrothschild.com
cforsyth@foxrothschild.com
ltoft@foxrothschild.com
mticer@foxrothschild.com
bedgington@foxrothschild.com
jguerrero@foxrothschild.com