

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VIVITRO LABS INC.,
Petitioner,

v.

BIOMEDICAL DEVICE CONSULTANTS & LABORATORIES OF
COLORADO, LLC,
Patent Owner.

IPR2024-00320
Patent 9,237,935 B2

Before JOHN F. HORVATH, JOHN A. HUDALLA, and
DONALD E. DAYBELL, *Administrative Patent Judges*.

DAYBELL, *Administrative Patent Judge*.

ORDER
Granting Petitioner's Motion for
Pro Hac Vice Admission of John W. Harbin
37 C.F.R. § 42.10

Petitioner filed a motion requesting *pro hac vice* admission of John W. Harbin. Paper 3 (“Mot.”). Petitioner also submitted a declaration from Mr. Harbin in support of the Motion. Ex. 1039 (“Dec.”). Petitioner’s motion does not indicate whether it met and conferred with Patent Owner, nor Patent Owner’s position on the motion. However, Patent Owner’s counsel was served with the Motion (Mot. 4) and Patent Owner did not file an opposition within the requisite time period. Thus, we deem the motion to be unopposed.

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 Motion and the accompanying declaration, we conclude that Mr. Harbin has sufficient legal and technical qualifications to represent Petitioner in this proceeding, that Mr. Harbin has demonstrated sufficient litigation experience and familiarity with the subject matter of this proceeding, and that Mr. Harbin meets all other requirements for admission *pro hac vice*. *See* Motion.¹ Accordingly, Petitioner has

¹ We observe that in PGR2022-00019 and PGR2022-00020, Mr. Harbin’s applications for *pro hac vice* admission were initially denied,

established good cause for *pro hac vice* admission of Mr. Harbin.

Mr. Harbin 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. Harbin in accordance with 37 C.F.R. § 42.10(b). Paper 2. Petitioner also filed Mandatory Notices in accordance with 37 C.F.R. § 42.8(b)(3) that identify Mr. Harbin as back-up counsel. Paper 1.

In consideration of the foregoing, it is hereby

ORDERED that Petitioner's Motion for *pro hac vice* admission of Mr. Harbin is *granted*;

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

without prejudice, because the accompanying declarations failed to comply with the *Unified Patents* standards. *See, e.g.*, PGR2022-00019 (PTAB March 3, 2022) (Paper 7). These defects were subsequently cured and Mr. Harbin's renewed applications were granted. *See, e.g.*, PGR2022-00019 (PTAB Mar. 3, 2022) (Paper 9). The *Unified Patents* standards require a *pro hac vice* applicant to attest to, *inter alia*, "[n]o application for admission to practice before any court or administrative body ever [being] denied." *Unified Patents*, Paper 7 at 3 (emphasis added). It appears that Mr. Harbin may have understood this requirement to be addressing whether his *pro hac vice* status was ever substantively denied, and not whether his application was ever denied. To assist in future proceedings, we clarify that the *Unified Patents* standards require an applicant to attest that "no application" for admission has ever been denied. *Id.* In the event an applicant is unable to so attest, then the applicant is required to "provide a full explanation of the circumstances" relating to the denial of any such application. *Id.* at 4. In the interests of effectuating a just, speedy, and inexpensive resolution to this motion (37 C.F.R. § 42.1(b)), we will not require Mr. Harbin to re-file these applications with the required explanation, as the explanation is apparent from the record of the prior proceedings. *See, e.g.*, PGR2022-00019, Papers 7, 8, 9 and Ex. 1051.

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

FURTHER ORDERED that Mr. Harbin comply with the Patent Trial and Appeal Board Consolidated Trial Practice Guide² (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. Harbin 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 Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

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