

From: [Trials](#)
To: [Cipriano, Linnea P; "Cassella, Christopher"](#)
Cc: [Trials; Diner, Bryan; Hasford, Justin; Goldberg, Joshua; Officer, Kassandra; Yang, Christina Ji-Hye; McDonnell, Ryan; jason.zhang@finnegan.com](#)
Subject: IPR2024-00467: Pro Hac Vice Notices
Date: Wednesday, January 15, 2025 12:45:00 PM

Counsel,

From the Board –

We received Petitioner’s Notices of Intent to Designate Provisionally Recognized PTAB Attorneys [Robert Frederickson](#) and [Elaine Blais](#) as Backup Counsel (Papers 32, 33) and the accompanying certifications (Exs. 1033, 1036) in IPR2024-00467. The Notices do not comply with the Board’s requirements. The following issues with the Notices are identified:

1. Authorization has not been provided either in the Notice of Filing Date Accorded (NFDA) or in an email from the panel (Note: Authorization for filing Notices of Intent going forward is provided for in this email. See below.).
2. Each Notice of Intent (NOI) fails to Identify the most recent prior proceeding where recognized pro hac vice by order pursuant to a motion

To cure these defects, for each Provisionally Recognized PTAB Attorney, please review the requirements set forth herein (see instructions below), and then:

- a. File a new Notice (as a paper). See Notice and Certification (a) and (b) below; and
- b. File a new Certification (as an exhibit), which complies with the specified requirements. See Notice and Certification (c)(i)-(vii) below.

Please note: If the individual seeking pro hac vice recognition is unable to provide the information requested above or make the required statements or representations under oath, or if the affiant or declarant does not qualify as a provisionally recognized PTAB attorney pursuant to 37 C.F.R. § 42.10(c)(2), the procedure set forth in 37 C.F.R. § 42.10(c)(2) is not available, and pro hac vice recognition may only be obtained via the process set forth in 37 C.F.R. § 42.10(c)(1). See 37 C.F.R. § 42.10(c)(2)(iv).

Due to the defects identified above, the Notices (Papers 32, 33) and Certifications (Exhibit 1033, 1036) will be expunged. 37 C.F.R. § 42.20(b).

Below are instructions for filing a Notice going forward. Both parties are hereby authorized to file one or more notices of intent to designate a PTAB-recognized attorney as back-up counsel in compliance with the instructions set forth below.

Instructions for Filing a Notice of Intent to Designate Provisionally Recognized PTAB Attorney as Back-up Counsel.

Overall, three documents are required: (1) Notice of Intent; (2) Certification in the form of an

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affidavit or declaration; and (3) Power of Attorney. 37 C.F.R. § 42.10(b); 37 C.F.R. § 42.10(c)(2). The Certification should be a separate document that is filed as an exhibit.

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Timing

A motion or notice seeking pro hac vice recognition is a request for relief from the Board, and thus may not be entered without prior authorization. 37 C.F.R. § 42.20. In newly filed cases, authorization will typically be granted in the notice of filing date accorded. If authorization is not granted in the notice of filing date accorded, authorization must be obtained from the Board prior to filing.

Pro hac vice recognition also may not be sought sooner than 21 days after service of a petition, which is the time for filing patent owner mandatory notices. See *Unified Patents, Inc. v. Parallel Iron, LLC*, IPR2013-00639, Paper 7 (PTAB Oct. 15, 2013). Thus, even if a motion or notice seeking pro hac vice recognition is authorized prior to this date (e.g., in a notice of filing date accorded), the parties must still wait until at least 21 days after service of the petition to file a motion or notice seeking pro hac vice recognition.

Notice and Certification

The Notice must:

- (a) Identify the registered practitioner who will serve as lead counsel;
- (b) Identify the most recent prior proceeding in which the person seeking to appear was recognized pro hac vice by order of the Patent Trial and Appeal Board pursuant to a motion of the type described in 37 C.F.R. § 42.10(c)(1); and
- (c) Be accompanied by certification in the form of an affidavit or declaration in which the individual seeking pro hac vice recognition attests to the following:
 - i. Membership in good standing of the Bar of at least one State or the District of Columbia;
 - ii. No suspensions or disbarments from practice before any court or administrative body;
 - iii. No application for admission to practice before any court or administrative body ever denied;
 - iv. No sanctions or contempt citations ever imposed by any court or administrative body;
 - v. The individual seeking to appear has read and will comply with the Office Patent Trial Practice Guide and the Board's Rules of Practice for Trials set forth in 37 C.F.R. part 42;
 - vi. The individual will be subject to the USPTO Rules of Professional Conduct set forth in 37 C.F.R. § 11.101 et seq. and disciplinary jurisdiction under 37 C.F.R. § 11.19(a);
 - vii. All other proceedings before the Office for which the individual has applied to appear pro hac vice in the last three years; and
 - viii. Legal familiarity with the subject matter at issue in the proceeding.

Please note: If the individual seeking pro hac vice recognition is unable to provide the information requested above or make the required statements or representations under oath, or if the affiant or declarant does not qualify as a provisionally recognized PTAB attorney pursuant to 37 C.F.R. § 42.10(c)(2), the procedure set forth in 37 C.F.R. § 42.10(c)(2) is not available, and pro hac vice recognition may only be obtained via the process set forth in 37 C.F.R. § 42.10(c)(1). See 37 C.F.R. § 42.10(c)(2)(iv).

Power of attorney

A party must also file a power of attorney for the person seeking pro hac vice recognition pursuant to 37 C.F.R. § 42.10(b) unless a power of attorney was previously filed.

Updated mandatory notice under 37 C.F.R. § 42.10(c)(2)(iii)

Pro hac vice recognition will not be effective until the party files an updated mandatory notice after the expiration of the applicable time period (5 or 10 days) set forth in 37 C.F.R. § 42.10(c)(2)(iii). Note, a previously filed mandatory notice that includes the pro hac vice attorney does not meet 37 C.F.R. § 42.10(c)(2)(iii). A new updated mandatory notice must be filed after the expiration of the applicable time period (5 or 10 days).

Objection to notice by non-moving party

Under 37 C.F.R. § 42.10(c)(2)(iii), any objection shall be filed by a party within five business days after the filing of the notice. If an objection is not filed within five business days, the provisionally recognized PTAB attorney shall be deemed admitted pro hac vice in that proceeding upon filing of updated mandatory notices identifying that counsel as counsel of record. If an objection is filed by a party within 5 business days, unless the Board orders otherwise within 10 business days after the objection is filed, the provisionally recognized PTAB attorney shall be deemed admitted pro hac vice after updated mandatory notices identifying that counsel as counsel of record are then filed.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office