

From: [Trials](#)
To: [Scott W. Hejny](#)
Cc: [Trials](#); [Harper Batts](#); [Chris Ponder](#); [Jeffrey Liang](#)
Subject: IPR2024-00921
Date: Thursday, February 13, 2025 3:55:34 PM

Good afternoon counsel,

From the Panel:

Our rules require that “[i]f a party is represented by counsel, the party must designate a lead counsel and at least one back-up counsel who can conduct business on behalf of the lead counsel.” 37 C.F.R. § 42.10(a).^{*} Alternatively, a party may request “to proceed without back-up counsel upon a showing of good cause. A party may show good cause by demonstrating that it lacks the financial resources to retain both lead and back-up counsel.” *Id.*

In our Institution Decision (Paper 11, 40), we pointed out that although Patent Owner purported to identify two back-up counsel in its Mandatory Notices and Power of Attorney, the back-up counsel are not authorized to practice before the PTAB. We ordered Patent Owner to correct this violation of our rules in five days. Paper 11, 40–41. Specifically, we directed to Patent Owner to “either (1) file a motion for admission *pro hac vice* for at least one of the attorneys identified as back-up counsel, (2) file updated notices and a power of attorney identifying a back-up counsel and, if necessary, move for the admission of that attorney *pro hac vice*, or (3) file a motion establishing good cause to proceed without back-up counsel.” *Id.* The five days have passed with silence from the Patent Owner.

By **February 19, 2025** Patent Owner shall either comply with 37 C.F.R. § 42.10(a) or request a conference call to explain the reason why Patent Owner is unwilling to comply with the PTAB’s rule and our Order.

^{*} Patent Owner is reminded that 37 C.F.R. § 42.10 was amended on October 24, 2024. *See* Expanding Opportunities to Appear Before the Patent Trial and Appeal Board, 89 Fed. Reg. 82,172 (Oct. 24, 2024).

Regards,

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