

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TOMMY JOHN, INC.,
Petitioner,

v.

PACKAGE APPAREL, INC.,
Patent Owner.

IPR2024-01163
Patent 10,834,974 B2

Before BARRY L. GROSSMAN, JAMES A. TARTAL, and
ROBERT J. SILVERMAN, *Administrative Patent Judges*.

SILVERMAN, *Administrative Patent Judge*.

ORDER

Conditionally Granting Patent Owner's Motion for
Pro Hac Vice Admission of HEATH A. NOVOSAD
37 C.F.R. § 42.10

On August 25, 2025, Patent Owner filed a motion requesting *pro hac vice* admission of Heath A. Novosad. *See* Paper 20 (“Motion” or “Mot.”). Patent Owner also submitted an Affidavit from Mr. Novosad in support of the Motion. *Id.* at 4–6 (“Affidavit”).¹ Patent Owner attests that Petitioner does not oppose the Motion. Mot. 3.

For the reasons provided below, Patent Owner’s Motion is *conditionally granted*.

In accordance with 37 C.F.R. § 42.10(c)(1), 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* 37 C.F.R. § 42.10(c)(1); *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 Affidavit, we conclude Mr. Novosad has sufficient qualifications to represent Patent Owner in this proceeding, has demonstrated sufficient litigation experience and legal familiarity with the subject matter of this

¹ Patent Owner filed Mr. Novosad’s Affidavit as part of the Motion. *See* Mot. 4–6. We excuse this error on this occasion, but remind the parties that affidavits and declarations must be filed as exhibits. *See* 37 C.F.R. § 42.63(a) (“Evidence consists of affidavits, transcripts of depositions, documents, and things. All evidence must be filed in the form of an exhibit.”).

proceeding, and meets all other requirements for admission *pro hac vice*. See Affidavit ¶¶ 1–8. Accordingly, Patent Owner has established good cause for *pro hac vice* admission of Mr. Novosad. Mr. Novosad will be permitted to serve as back-up counsel only. See 37 C.F.R. § 42.10(c)(1).

Patent Owner has filed Mandatory Notices identifying Mr. Novosad as back-up counsel in accordance with 37 C.F.R. § 42.8(b)(3). See Paper 23.

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 Mr. Novosad. Therefore, Patent Owner’s Motion is *conditionally granted*, and is to be effective after Patent Owner files the aforementioned Power of Attorney.

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner’s Motion (Paper 20) for *pro hac vice* admission of HEATH A. NOVOSAD is *conditionally granted*, provided that within ten (10) business days of the date of this order, Patent Owner submits a Power of Attorney for Mr. Novosad in accordance with 37 C.F.R. § 42.10(b);

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

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

FURTHER ORDERED that Mr. Novosad be familiar with the Patent Trial and Appeal Board Consolidated Trial Practice Guide² (84 Fed. Reg.

² Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

64,280 (Nov. 21, 2019)), and comply with the Board’s Rules of Practice for Trials, as set forth in Part 42 of Title 37, Code of Federal Regulations;³ and

FURTHER ORDERED that Mr. Novosad 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.*⁴

³ The Affidavit incorrectly states that “I have read and will comply with the Office Patent Trial Practice Guide and the Board’s Rules of Practice for Trials set forth in part 42 of the C.F.R.” Affidavit ¶ 5. We excuse this mistake on this occasion, but remind Mr. Novosad that the Board’s Rules of Practice for Trials are set forth in Part 42 of Title 37, Code of Federal Regulations, and it is those rules to which Mr. Novosad will be subject.

⁴ In the Affidavit, Mr. Novosad indicates he “will be subject to the USPTO Code of Professional Responsibility set forth in 37 C.F.R. §§ 10.20 *et seq.*,” as opposed to attesting that he shall be subject to the USPTO Rules of Professional Conduct set forth in 37 C.F.R. §§ 11.101 *et. seq.* Affidavit ¶ 6. We excuse the error on this occasion, noting that Mr. Novosad will be subject to the USPTO Rules of Professional Conduct set forth in 37 C.F.R. §§ 11.101 *et seq.* As attested in his Affidavit, Mr. Novosad will be subject to the Office’s disciplinary jurisdiction under 37 C.F.R. § 11.19(a). Affidavit ¶ 6.

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