

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CHARTER COMMUNICATIONS, INC.,
Petitioner,

v.

IARNACH TECHNOLOGIES LTD.,
Patent Owner.

Case IPR2024-01287
Patent 9,287,982

**PETITIONER'S MOTION FOR *PRO HAC VICE*
ADMISSION OF THOMAS L. DUSTON**

**PETITIONER’S MOTION FOR *PRO HAC VICE*
ADMISSION OF THOMAS L. DUSTON**

I. Requested Relief

Petitioner presents this motion, pursuant to 37 C.F.R. § 42.10, for Thomas L. Duston to appear *pro hac vice* on its behalf in this proceeding. This motion is presented in accordance with the Board’s August 21, 2024, “Notice of Filing Date Accorded to Petition and Time for Filing Patent Owner Preliminary Response” (Paper No. 3).

II. Statement of Facts

The Petitioner respectfully submits that the following facts, supported by the Declaration of Thomas L. Duston (Exh. 1010), establish good cause for Mr. Duston’s admission *pro hac vice* in this proceeding:

1. The undersigned Lead Counsel for the Petitioner is a registered practitioner.
2. Mr. Duston is a partner at the same law firm as the Petitioner’s Lead Counsel, Marshall, Gerstein & Borun LLP. Exh. 1010, at ¶ 1.
3. Mr. Duston has been practicing in the field intellectual property law, and particularly patent litigation, for thirty-seven (37) years. Exh. 1010, at ¶ 2.
4. Mr. Duston is a member in good standing of the Bar of the State of Illinois; he is admitted to practice before the United States Court of Appeals for the Federal Circuit, the United States Court of Appeals for the Seventh Circuit,

the United States District Court for the Northern District of Illinois (Trial Bar Member), the United States District Courts for the Eastern District and the Western District of Texas; the United States District Court for the District of Nebraska, the United States District Court for the District of Colorado; and, he is also admitted to practice *pro hac vice* in a number of other Federal District courts. Exh. 1010, at ¶ 3.

5. Mr. Duston has never been suspended or disbarred from practice before any court or administrative body. Exh. 1010, at ¶ 4.
6. Mr. Duston has never had an application for admission to practice before any court or administrative body denied. Exh. 1010, at ¶ 5.
7. Mr. Duston has never had sanctions or contempt citations imposed upon him by any court or administrative body. Exh. 1010, at ¶ 6.
8. Mr. Duston is a member of the American Bar Association, the Intellectual Property Owners Association, the Chicago Bar Association, the Eastern District of Texas Bar Association, the Seventh Circuit Bar Association, and the International Association for the Protection of Intellectual Property. Exh. 1010, at ¶ 7.
9. Mr. Duston has read and will comply with the Office Patent Trial Practice Guide, the Consolidated Trial Practice Guide, and the Board's Rules of

Practice for Trials set forth in part 42 of the Code of Federal Regulations.

Exh. 1010, at ¶ 8.

10. Mr. Duston has read and will abide by and be subject to the U.S. Patent and Trademark Office Code of Professional Responsibility set forth in 37 C.F.R. § 11.101 *et. seq.* and the Office's disciplinary jurisdiction under 37 C.F.R. § 11.19(a). Exh. 1010, at ¶ 9.
11. Mr. Duston has been admitted *pro hac vice* before the Office during the past three years in the following *inter partes* review proceedings: (1) *Canfield Scientific, Inc. v. Quantificare S.A.*, Case IPR2021-01511; (2) *Canfield Scientific, Inc. v. Quantificare S.A.*, Case IPR2021-01518; (3) *Canfield Scientific, Inc. v. Quantificare S.A.*, Case IPR2021-01519; (4) *Streck, Inc. v. Ravgen, Inc.*, Case IPR2021-01577; and (5) *Termax LLC v. Illinois Tool Works Inc.*, Case IPR2021-00724. Exh. 1010 at ¶ 10.
12. Mr. Duston is an experienced litigating attorney and is familiar with the subject matter at issue in the proceeding. He has read the patent-at-issue, its file history, and the Petition in this proceeding. Exh. 1010, at ¶ 11.
13. Further, in his declaration, Mr. Duston attests to each of the items required by 37 C.F.R. § 42.10(c) and the Board's order in *Unified Patents, Inc. v. Parallel Iron, LLC*, Case IPR2013-00639, Paper 7, at 3–4 (P.T.A.B. Oct. 15, 2013). See Exh. 1010, at ¶¶ 1-12.

III. Reasons for Granting this Motion

The Board may recognize counsel *pro hac vice* during an *inter partes* review proceeding “upon a showing of good cause, subject to the condition that lead counsel be a registered practitioner and to any other conditions the Board may impose.” 37 C.F.R. § 42.10(c). “For example, where the lead counsel is a registered practitioner, a motion to appear *pro hac vice* by counsel who is not a registered practitioner may be granted upon showing that counsel is an experienced litigating attorney and has an established familiarity with the subject matter at issue in the proceeding.” *Id.*

A grantable motion for *pro hac vice* admission must be accompanied by a declaration of the individual who is seeking admission, and the motion must contain a statement of facts showing there is good cause for the Board to recognize the individual *pro hac vice* during the proceeding. *See Unified Patents, Inc. v. Parallel Iron, LLC*, Case IPR2013-00639, Paper 7, at 3–4 (P.T.A.B. Oct. 15, 2013). The individual’s declaration must contain certain attestations. *Id.*

This motion and Mr. Duston’s accompanying declaration meet all of the Board’s requirements. Specifically, and as set forth above, the Petitioner’s Lead Counsel in this proceeding is a registered practitioner. Mr. Duston is an experienced litigating attorney and has an established familiarity with the subject matter at issue in the proceeding. In his declaration, Mr. Duston makes the

attestations set forth in the Board's order in *Unified Patents, Inc. v. Parallel Iron, LLC*, Case IPR2013-00639, Paper 7, at 3–4 (P.T.A.B. Oct. 15, 2013).

IV. Conclusion

For the foregoing reasons, the Petitioner respectfully requests the Board to admit Mr. Duston *pro hac vice* in this proceeding.

Respectfully submitted,

September 20, 2024

/Raymond R. Ricordati III (Reg. No. 62,856)/
Raymond R. Ricordati, III (Reg. No. 62,856)
Lead Counsel for Petitioner

CERTIFICATE OF FILING AND SERVICE

The undersigned hereby certifies that, pursuant to 37 CFR § 42.6(e), a copy of the foregoing **“PETITIONER’S MOTION FOR PRO HAC VICE ADMISSION OF THOMAS L. DUSTON”** is being filed via the Patent Trial and Appeal Case Tracking Systems (P-TACTS) and is being served today, September 20, 2024, by electronic mail on counsel for the Patent Owner:

Blaine A. Larson
Heim Payne & Chorush, LLP
609 Main Street, Suite 3200
Houston, TX 77002
E: blarson@hpcllp.com

Michael F. Heim
Eric J. Enger
William B. Collier, Jr.
Heim Payne & Chorush, LLP
609 Main Street, Suite 3200
Houston, TX 77002
E: mheim@hpcllp.com
E: eenger@hpcllp.com
E: wcollier@hpcllp.com

/Raymond R. Ricordati III (Reg. No. 62,856)/
Raymond R. Ricordati III (Reg. No. 62,856)
Lead Counsel for Petitioner