From:	Trials
To:	jpmurphy@polsinelli.com; ccasey@polsinelli.com; msitzman@mwe.com; millerra@pepperlaw.com; endejann@pepperlaw.com
Cc:	Trials
Subject:	IPR2025-00464, -00465, -00466: non-compliant PHV Notices Filed (Best) - Padagis US LLC v. Neurelis, Inc.
Date:	Friday, February 7, 2025 4:16:42 PM

Counsel,

Patent Owner's notice of intent to designate Timothy P. Best as a provisionally recognized PTAB attorney as back-up counsel (Notice) in each of IPR2025-00464, -00465, and -00466 pursuant to 37 C.F.R. § 42.10(c)(2) is improper.

The following deficiency is identified: The Notices were filed without the required prior authorization. *See* 37 C.F.R. § 42.20.

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.

Because the Notices and accompanying declarations were unauthorized, they will be expunged. 37 C.F.R. § 42.20(b).

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, and Patent Owner is hereby authorized to re-file its notices and declarations in compliance with those instructions.

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 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.

-

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,

Franchesca I. Alicea Villanueva

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