From:	Trials
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Cc:	Trials
Subject:	IPR2025-01018 - PHV Notice of Intent
Date:	Tuesday, August 26, 2025 10:56:43 AM

Counsel,

The Board received Patent Owner's notice of intent to designate Scott D. Sherwin as provisionally recognized PTAB attorney ("Notice") (Paper 8) in IPR2025-01018. However, the Notices are improper because they fail to 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). *See* Paper 3, 5.

Because the Notice is defective, the Notice and certification (Paper 8; Ex. 2001) will be expunged in this proceeding. 37 C.F.R. § 42.20(b).

To cure the identified defects, Patent Owner should:

1. File a new Notice (*see* Notice and Certification ¶ 2 below); and
2. File a new Certification.

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) and 37 C.F.R. § 42.10(c)(2). The Certification should be a separate document that is filed as an exhibit.

Timing

Pro hac vice recognition 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).

Notice and Certification

The Notice must:

1. Identify the registered practitioner who will serve as lead counsel;
2. 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
3. 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:
    a. Membership in good standing of the Bar of at least one State or the District of Columbia;
    b. No suspensions or disbarments from practice before any court or administrative body;

c. No application for admission to practice before any court or administrative body ever denied;
d. No sanctions or contempt citations ever imposed by any court or administrative body;
e. 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;
f. 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);
g. All other proceedings before the Office for which the individual has applied to appear pro hac vice in the last three years; and
h. 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 CFR § 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.