

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PROAMPAC HOLDINGS INC.,
Petitioner,

v.

SIGMA TECHNOLOGIES INT’L, LLC,
Patent Owner.

Case IPR2025-01143
Patent No. 11,072,148

**PETITIONER’S MOTION FOR *PRO HAC VICE* ADMISSION OF
JONATHAN M. HERNANDEZ UNDER 37 C.F.R. § 42.10**

Pursuant to 37 C.F.R. § 42.10(c) and the Notice of Filing Date Accorded to Petition and Time for Filing Patent Owner Preliminary Response (Paper 4), Petitioner ProAmpac Holdings Inc. (“Petitioner”) respectfully requests the *pro hac vice* admission of Jonathan M. Hernandez in this proceeding. As demonstrated below, and in the attached Declaration of Jonathan M. Hernandez in Support of Motion for *Pro Hac Vice* Admission (Exhibit 1018), good cause exists for his *pro hac vice* admission. Petitioner has conferred with counsel for Patent Owner Sigma Technologies Int’l, LLC (“Patent Owner”), and Patent Owner does not oppose this motion.

I. LEGAL STANDARD

The Board may recognize counsel *pro hac vice* during an *inter partes* review (“IPR”) proceeding upon a showing of good cause, “subject to the condition that lead counsel be a registered practitioner and to any other conditions as 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.*

II. ARGUMENT

As set forth below and in the accompanying Declaration of Jonathan M.

Hernandez in Support of Motion for *Pro Hac Vice* Admission (Exhibit 1018), the facts here establish good cause for the Board to recognize Jonathan M. Hernandez *pro hac vice* in this proceeding.

1. Lead counsel, Walter D. Davis, Jr., is a registered practitioner (Reg. No. 45,137) and is experienced in IPR proceedings.

2. Mr. Hernandez is a member in good standing of the State Bar Texas (Bar No. 24091867). Exhibit 1018, ¶2.

3. Mr. Hernandez has never been suspended or disbarred from practice before any court or administrative body. *Id.*, ¶3.

4. None of Mr. Hernandez's applications for admission to practice before any court or administrative body have ever been denied. *Id.*, ¶4.

5. Mr. Hernandez has not been sanctioned or had a contempt citation imposed on him by any court or administrative body. *Id.*, ¶5.

6. Mr. Hernandez has declared that he has read and will comply with the Office Patent Trial Practice Guide and the Board's Rules of Practice for Trial set forth in part 42 of 37 C.F.R. *Id.*, ¶6.

7. Mr. Hernandez has acknowledged and agrees that he 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). *Id.*, ¶ 7.

8. Mr. Hernandez has applied to appear, and appeared, *pro hac vice* before the Board in two IPR proceedings in the last three years, namely IPR2024-00875 and IPR2024-00885. *Id.*, ¶8.

9. Mr. Hernandez has been a practicing attorney for nearly eight years in the areas of patent litigation and patent advisory work. *Id.*, ¶9. He has been involved in numerous patent infringement cases in district courts across the country. *Id.* He is intimately involved and has been assisting Petitioner's attorneys of record in a related litigation captioned *Pratt Retail Specialties, LLC v. ProAmpac Holdings Inc.*, No. 1:24-cv-01073-RGA (D. Del.). *Id.*

10. Mr. Hernandez is very familiar with the technical and legal issues raised in the IPR petition and is qualified to serve as backup counsel for Petitioner in this matter.¹ *Id.*, ¶10. For example, he has studied and analyzed the field of technology relevant to U.S. Patent No. 11,072,148 ("the '148 patent"), as well as the claims, specification, and prosecution history of the '148 patent. *Id.* Accordingly, Mr. Hernandez has become very familiar with both the particular subject matter and substantive issues concerning the '148 patent. *Id.* He has also analyzed and is familiar with the prior art references asserted by Petitioner in this IPR proceeding,

¹ Petitioner notes that it has previously identified Mr. Hernandez as back-up counsel in its Mandatory Notices in accordance with 37 C.F.R. § 42.8(b)(3). Paper 1 at §I.C. Petitioner has also filed a Power of Attorney including Mr. Hernandez in accordance with 37 C.F.R. § 42.10(b). Paper 2.

as well as all of the exhibits to Petitioner's IPR petition. *Id.* Mr. Hernandez also assisted in drafting the IPR petition. *Id.*

In view of Mr. Hernandez's knowledge of the subject matter at issue in this proceeding, and in view of the interrelatedness of this proceeding and the district court case mentioned above, Petitioner has a substantial need for Mr. Hernandez's *pro hac vice* admission and his involvement in this proceeding. In addition, *pro hac vice* admission of Mr. Hernandez will enable Petitioner to avoid unnecessary expense and duplication of work between this proceeding and the related district court case. *See* 77 Fed. Reg. 48,612, 48,661 (Aug. 14, 2012) (Office's comment on final rule discussing concerns about efficiency and costs where an entity has already engaged counsel for parallel district court litigation).

III. CONCLUSION

For the foregoing reasons, Petitioner respectfully requests that the Board admit Jonathan M. Hernandez *pro hac vice* in this proceeding.

Dated: September 11, 2025

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §42.6(e), the undersigned certifies that a copy of the foregoing **PETITIONER'S MOTION FOR *PRO HAC VICE* ADMISSION OF JONATHAN M. HERNANDEZ UNDER 37 C.F.R. § 42.10** is being served on counsel of record by filing the document through the Patent Trial and Appeal Case Tracking System (P-TACTS), with a copy served via electronic mail to the following email address, as authorized in Patent Owner's Mandatory Notices:

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