

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FISERV, INC., JACK HENRY & ASSOCIATES, INC., Q2 SOFTWARE, INC.,
AMERICAN NATIONAL BANK OF TEXAS, and HANMI BANK,
Petitioner,

v.

MIRROR IMAGING, LLC,
Patent Owner.

Case CBM2018-00014 (Patent 6,963,866 B2)
Case CBM2018-00015 (Patent 9,141,612 B2)
Case CBM2018-00016 (Patent 7,836,067 B2)
Case CBM2018-00017 (Patent 7,552,118 B2)¹

Before KARL D. EASTHOM, JUSTIN T. ARBES, and RAMA G. ELLURU,
Administrative Patent Judges.

ELLURU, *Administrative Patent Judge.*

DECISION

Granting Patent Owner's Motions for Admission
Pro Hac Vice of Mayer Morganroth
37 C.F.R. § 42.10

¹ This Decision addresses issues that are the same in the above-identified proceedings. We exercise our discretion to issue one Decision to be entered in each proceeding. The parties are not authorized to use this joint heading and filing style in their papers.

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On July 3, 2018, Patent Owner filed motions for admission *pro hac vice* of Mayer Morganroth in the above-identified proceedings (collectively “Motions”). Paper 21.² Patent Owner also filed declarations of Mr. Morganroth in support of the Motions (collectively “Declarations”). Ex. 2013.³ Petitioner has not filed an opposition to the Motions. For the reasons provided below, Patent Owner’s Motions are *granted*.

Pursuant to 37 C.F.R. § 42.10(c), 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 its notice authorizing motions for *pro hac vice* admission, the Board requires 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 this proceeding. *See* Paper 9, 2 (citing *Unified Patents, Inc. v. Parallel Iron, LLC*, Case 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 Motions and the accompanying Declarations, we conclude that Mr. Morganroth has sufficient qualifications to represent Patent Owner in these proceedings, that Mr. Morganroth has demonstrated sufficient familiarity with the subject matter of these proceedings, and that Patent Owner’s intent to be represented by counsel with litigation experience is warranted. For example, Mr. Morganroth attests that he has “63

² For purposes of expediency, we cite to Papers filed in CBM2018-00014. Similar Motions were filed in CBM2018-00015 (Paper 21), CBM2018-00016 (Paper 22), and CBM2018-00017 (Paper 22).

³ Similar Declarations were filed in CBM2018-00015 (Ex. 2013), CBM2018-00016 (Ex. 2013), and CBM2018-00017 (Ex. 2013).

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years of complex litigation experience,” “discussed the substance of this case with Patent Owner’s lead and backup counsel and have consulted with them about litigation strategy,” and is corporate counsel for Patent Owner and has become familiar with the subject matter at issue in these proceedings, including the patents at issue. Ex. 2013 ¶¶ 8–10. Accordingly, Patent Owner has established good cause for *pro hac vice* admission of Mr. Morganroth. Mr. Morganroth will be permitted to serve as back-up counsel only. See 37 C.F.R. § 42.10(c).

Accordingly, it is

ORDERED that Patent Owner’s Motions for *pro hac vice* admission of Mayer Morganroth are *granted*;

FURTHER ORDERED that Patent Owner is to continue to have a registered practitioner represent it as lead counsel for the above-identified proceedings;

FURTHER ORDERED that Mr. Morganroth is authorized to represent Patent Owner only as back-up counsel in the above-identified proceedings;

FURTHER ORDERED that Mr. Morganroth is to comply with the Office Patent Trial Practice Guide and the Board’s Rules of Practice for Trials, as set forth in Part 42 of Title 37, Code of Federal Regulations;⁴

⁴ In the Declarations, Mr. Morganroth indicates compliance with the Office Patent Trial Practice Guide and the Board’s Rules of Practice for Trials set forth in “part 42 of the Code of Federal Regulations,” as opposed to part 42 of 37 C.F.R. Ex. 2013 ¶ 5. We deem this harmless error.

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FURTHER ORDERED that Mr. Morganroth shall be 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.*;⁵ and

FURTHER ORDERED that Patent Owner shall file updated mandatory notices in each of the above-identified proceedings in accordance with 37 C.F.R. § 42.8(b)(3), identifying Mr. Morganroth as back-up counsel.

⁵ In the Declarations, Mr. Morganroth indicates he will be subject to the USPTO Rules of Professional Conduct set forth in "C.F.R. §§ 11.101 *et. seq.*," as opposed to 37 C.F.R. §§ 11.101 *et. seq.* Ex. 2013 ¶ 6. We deem this harmless error.

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