

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)¹

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

ELLURU, *Administrative Patent Judge.*

DECISION

Granting Petitioner's Motions for Admission
Pro Hac Vice of Aaron Fountain
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 May 23, 2018, Petitioner filed motions for admission *pro hac vice* of Aaron Fountain in the above-identified proceedings (collectively “Motions”). Paper 17.² Petitioner also filed affidavits of Mr. Fountain in support of the Motions (collectively “Affidavits”). Ex. 1078.³ Petitioner attests that Patent Owner does not oppose the motion. Paper 17, 3. For the reasons provided below, Petitioner’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 Affidavits, we conclude that Mr. Fountain has sufficient legal and technical qualifications to represent Petitioner in these proceedings, that Mr. Fountain has demonstrated sufficient familiarity with the subject matter of these proceedings, and that Petitioner’s intent to be represented by counsel with litigation experience is warranted. For example, Mr. Fountain attests that he has appeared *pro hac vice*

² For purposes of expediency, we cite to Papers filed in CBM2018-00014. Similar Motions were filed in CBM2018-00015 (Paper 17) and CBM2018-00016 (Paper 18). We note that no motion for admission *pro hac vice* of Mr. Fountain was filed in CBM2018-00017.

³ Similar Affidavits were filed in CBM2018-00015 (Ex. 1078) and CBM2018-00016 (Ex. 1078).

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before the Office in several post grant proceedings, is “a technically trained analytical chemist and an experienced patent litigation attorney,” and has “an established familiarity with the subject matter at issue in this proceeding” and is a principal attorney in the co-pending litigation. Ex. 1078 ¶¶ 7–8. Accordingly, Petitioner has established good cause for *pro hac vice* admission of Mr. Fountain. Mr. Fountain will be permitted to serve as back-up counsel only. See 37 C.F.R. § 42.10(c).

Accordingly, it is

ORDERED that Petitioner’s Motions for *pro hac vice* admission of Aaron Fountain are *granted*;

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

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

FURTHER ORDERED that Mr. Fountain 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;

FURTHER ORDERED that Mr. Fountain 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.*;⁴ and

FURTHER ORDERED that Petitioner 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. Fountain as back-up counsel.

⁴ In the Affidavits, Mr. Fountain indicates he will be subject to the USPTO *Code* of Professional Conduct, as opposed to USPTO *Rules* of Professional Conduct. Ex. 1078 ¶ 6. We deem this harmless error.

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