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Paper 9
Entered: September 23, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HENKEL CORPORATION,
Petitioner,

v.

H.B. FULLER CO.,
Patent Owner.

Case IPR2014-00606
Patent 6,833,404 B2

Before DONNA M. PRAISS, CHRISTOPHER L. CRUMBLEY, and BRIAN P. MURPHY, *Administrative Patent Judges.*

MURPHY, *Administrative Patent Judge*.

DECISION
Patent Owner's Motion for *Pro Hac Vice* Admission of
Timothy E. Grimsrud
37 C.F.R. § 42.10

On September 12, 2014, Patent Owner filed a motion for *pro hac vice* admission of Timothy E. Grimsrud. Paper 8. Petitioner has not filed an opposition to the motion. For the reasons discussed below, Patent Owner's motion is *conditionally granted*.

The Board may recognize counsel *pro hac vice* during a proceeding upon a showing of good cause, subject to the condition that lead counsel is a registered practitioner. 37 C.F.R. § 42.10(c). If lead counsel is a registered practitioner, a non-registered practitioner may be permitted to appear *pro hac vice* "upon showing that counsel is an experienced litigating attorney and has an established familiarity with the subject matter at issue in the proceeding." *Id*. In authorizing motions for *pro hac vice* admission, the Board requires a statement of facts showing there is good cause to recognize counsel *pro hac vice*, and an affidavit or declaration of the individual seeking to appear in this proceeding. *See Unified Patents, Inc. v. Parallel Iron, LLC*, Case IPR2013-00639 Order Authorizing Motion for *Pro Hac Vice* Admission, Paper 7, Oct. 15, 2013 (copy available on Board Web site under "Representative Orders, Decisions, and Notices.").

In this proceeding, lead counsel for Patent Owner is Walter C. Linder, a registered practitioner. Paper 8, 3. Patent Owner's motion is supported by the Affidavit of Timothy E. Grimsrud. Ex. 2001.

In its motion, Patent Owner asserts there is good cause for Mr. Grimsrud to be admitted *pro hac vice* because: (1) Mr. Grimsrud is an experienced litigator; (2) Mr. Grimsrud has an established familiarity with the subject matter at issue in this proceeding and U.S. Patent No. 6,833,404; and (3) Mr. Grimsrud is trial counsel in the related co-pending district court

litigation between the parties involving U.S. Patent No. 6,833,404: Case No. 13-cv-02980 (D. Minn.). Paper 8, 3. In support of the motion, Mr. Grimsrud attests that he is a partner at the law firm of Faegre Baker Daniels LLP and a member in good standing of the State Bar of Minnesota, the United States District Courts for the District of Minnesota and the Eastern District of Wisconsin, and the United States Court of Appeals for the Federal Circuit. Ex. 2001 ¶¶ 1-2. Mr. Grimsrud attests that he never has been suspended, disbarred, sanctioned, or cited for contempt by any court or administrative body, and that he never has had an application for admission to practice denied. *Id.* at ¶¶ 4-6. Mr. Grimsrud attests that he has been in private practice for about nine years, during which time he has been litigating patent cases continuously. *Id.* at ¶ 9. Mr. Grimsrud attests that he is familiar with the subject matter at issue in this proceeding based on his work as trial counsel in the related district court litigation referenced above, which involves the same patent at issue in this proceeding. *Id.* at ¶ 10.

Mr. Grimsrud further attests that (1) he has read and will comply with the Board's Rules of Practice for Trials as set forth in Part 42 of Title 37, Code of Federal Regulations and the Office Patent Trial Practice Guide, and (2) he agrees to be subject to the USPTO Rules of Professional Responsibility set forth in 37 C.F.R. §§ 10.20 *et seq.* and disciplinary jurisdiction under 37 C.F.R. § 11.19(a). Ex. 2001 ¶¶ 7-8.

Patent Owner filed its motion after publication of the Office's Final Rule adopting new Rules of Professional Conduct. *See Changes to Representation of Others Before the United States Patent and Trademark Office*; Final Rule, 78 *Fed. Reg*. 20180 (Apr. 3, 2013). The Final Rule also

removes Part 10 of Title 37, Code of Federal Regulations. The changes set forth in that Final Rule, including the USPTO's Rules of Professional Conduct, took effect on May 3, 2013. *Id*. at 20180-81. Therefore, Mr. Grimsrud should have declared that he agrees to comply with the USPTO "Rules of Professional Conduct" as set forth in 37 C.F.R. §§ 11.101 *et seq*. instead of the Rules of Professional Responsibility under Part 10.

But for not having a statement from Mr. Grimsrud that he will comply with the USPTO Rules of Professional Conduct as set forth in 37 C.F.R. §§ 11.101 *et seq*., Patent Owner has established good cause for admission of Mr. Grimsrud, *pro hac vice*. Mr. Grimsrud will be permitted to appear *pro hac vice* in this proceeding as back-up counsel only. 37 C.F.R. § 42.10(c).

It is

ORDERED that Patent Owner's motion for *pro hac vice* admission of Mr. Timothy E. Grimsrud is *conditionally granted*, provided that within seven (7) days of the date of this order, Patent Owner files an affidavit or declaration from Mr. Grimsrud, labeled and submitted as an exhibit, indicating that he agrees to be subject to the USPTO's Rules of Professional Conduct as set forth in 37 C.F.R. §§ 11.101 *et seq.*;

FURTHER ORDERED that if the above-noted affidavit or declaration, labeled and submitted as an exhibit, is filed within seven (7) days of the date of this order, Patent Owner is to continue to have a registered practitioner as lead counsel in the instant proceeding, but Mr. Grimsrud is authorized to be designated as backup counsel; and

FURTHER ORDERED that Mr. Grimsrud is to comply with the Office Patent Trial Practice Guide and the Board's Rules of Practice for

Trials, as set forth in Title 37, Part 42 of the C.F.R., and is subject to the USPTO's disciplinary jurisdiction under 37 C.F.R. § 11.19(a) and the USPTO Rules of Professional Conduct as set forth in 37 C.F.R. §§ 11.101 *et seq.*

FOR PETITIONER:

Anthony C. Tridico, Lead Counsel
Michele Bosch, Backup Counsel
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
anthony.tridico@finnegan.com
michele.bosch@finnegan.com

FOR PATENT OWNER:

Walter C. Linder, Lead Counsel
FAEGRE BAKER DANIELS LLP
walter.linder@faegrebd.com