

Filed on behalf of Treefrog Developments, Inc.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FELLOWES, INC.,

Petitioner,

v.

TREEFROG DEVELOPMENTS, INC.,

Patent Owner.

Case IPR2020-01543
U.S. Patent No. 8,554,950

**PATENT OWNER'S MOTION FOR ADMISSION PRO HAC VICE OF
JAMES W. BEARD UNDER 37 C.F.R. § 42.10(C)**

RELIEF REQUESTED

Under 37 C.F.R. § 42.10(c), and in accordance with the Board’s “Order – Authorizing Motion for *Pro Hac Vice* Admission” in case IPR2013-00639, Patent Owner Treefrog Developments, Inc., requests that the Board admit James W. Beard *pro hac vice* in this proceeding.

GOVERNING LAWS, RULES, AND PRECEDENT

Section 42.10(c) provides the “Board may recognized counsel *pro hac vice* during a proceeding upon a showing of good cause, subject to the condition that lead counsel be a registered practitioner and any other conditions as the Board may impose.” The Rule provides that counsel who is not a recognized 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.”

The Board’s September 30, 2020, Notice of Filing Date Accorded to Petition and Time for Filing Patent Owner Preliminary Response, Paper No. 5, authorized the parties to file motions for *pro hac vice* admission under 37 C.F.R. § 42.10(c). The Notice provided *pro hac vice* motions shall be filed in accordance with the “Order – Authorizing Motion for *Pro Hac Vice* Admission” in Case IPR2013-00639, which provides guidelines for admission under 37 C.F.R. § 42.10(c).

The “Order – Authorizing Motion *for Pro Hac Vice* Admission” in Case IPR2013-00639 states that motions for *pro hac vice* shall “[c]ontain a statement of facts showing there is good cause for the Board to recognize counsel *pro hac vice* during the proceeding.” The Order further provides the motion is to be “accompanied by an affidavit or declaration of the individual seeking to appear attesting to the following:

- i. Membership in good standing of the Bar of at least one State or the District of Columbia;
- ii. No suspensions or disbarments from practice before any court or administrative body;
- iii. No application for admission to practice before any court or administrative body ever denied;
- iv. No sanctions or contempt citations imposed by any court or administrative body;
- v. 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 part 42 of 37 C.F.R.;
- vi. 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);

- vii. All other proceedings before the Office for which the individual has applied to appear *pro hac vice* in the last three (3) years; and
- viii. Familiarity with the subject matter at issue in the proceeding.

TIME OF FILING

In accordance with the rules, this motion is being filed no sooner than twenty one (21) days after service of the petition. This motion is timely filed.

STATEMENT OF THE FACTS

The following facts, supported by the attached Declaration of James W. Beard in Support of Patent Owner's Motion for Admission *Pro Hac Vice*, establish good cause to recognize Mr. Beard *pro hac vice* in this proceeding.

There is good cause for the Board to recognize counsel James W. Beard *pro hac vice* during this proceeding.

Patent Owner's lead counsel, Andrew J. Lagatta, is a registered practitioner (Reg. No. 62,529).

Counsel James W. Beard is an experienced litigating attorney. Mr. Beard is a partner at the law firm of Merchant & Gould P.C. Mr. Beard has been a litigating attorney since December 2009. Beard Decl., ¶ 8. His experience includes

representing a wide range of clients in intellectual property litigation. Mr. Beard has been litigating patent cases since 2010. *Id.*, ¶ 9.

Mr. Beard has established familiarity with the subject matter at issue in this proceeding. Mr. Beard is counsel for Patent Owner in a co-pending district court litigation filed by Patent Owner. *Id.*, ¶ 10. That litigation is captioned *Otter Products, LLC and Treefrog Developments, Inc. v. Fellowes, Inc.*, Northern District of Illinois, Civil Action No. 19-cv-06195, filed September 16, 2019. *Id.* The litigation involves the same patent at issue in this proceeding. *Id.* Mr. Beard, as counsel for Patent Owner, has been actively involved in the district court litigation. *Id.*, ¶ 11.

During the co-pending litigation, Mr. Beard has worked on analyzing and defending against the invalidity positions, including contentions based on the same references raised in the Petition, advanced by Defendant/Petitioner Fellowes, Inc. He is thus familiar with prior art relied upon in the Petitioner's Petition as well as the patent at issue. *Id.*, ¶ 11.

Mr. Beard is in good standing and admitted to practice law in the States of Colorado, California, and Washington. *Id.*, ¶ 1.

Mr. Beard has had no suspensions or disbarments from practice before any court or administrative body. *Id.*, ¶ 2.

Mr. Beard has never been denied application to practice before any court or administrative body. *Id.*, ¶ 3.

Mr. Beard has never been sanctioned or cited for contempt by any court or administrative body. *Id.*, ¶ 4.

Mr. Beard has read and will comply with the Office Patent Trial Practice Guide and the Board's Rules of Practice for Trials set forth in part 42 of 37 C.F.R. *Id.*, ¶ 5.

Mr. Beard has agreed to be subject to the United States Patent and Trademark Office Rules of Professional Conduct, as set forth in 37 C.F.R. §§ 11.101 *et. seq.* and disciplinary jurisdiction under 37 C.F.R. § 11.19(a). *Id.*, ¶ 6.

Mr. Beard has requested to appear *pro hac vice* in IPR2020-00852, IPR2020-00869, IPR2020-01435, IPR2020-01469, and IPR2020-1509 before the Office. *Id.*, ¶ 7.

ANALYSIS

37 C.F.R. § 42.10(c) states that 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 and to any other conditions as the Board may impose.” 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.” The “Order -- Authorizing Motion for Pro Hac Vice Admission” in Case IPR2013-00639 clarified the requirements for a motion for *pro hac vice* admission under 37 C.F.R. § 42.10(c).

The Statement of Facts, above, and the Beard Declaration establish that there is good cause to admit Mr. Beard *pro hac vice* in this proceeding under 37 C.F.R. § 42.10(c). Lead counsel, Andrew J. Lagatta, is a registered practitioner. Mr. Beard is a litigating attorney with ten years of experience litigating patents. Mr. Beard has established familiarity with the subject matter at issue in the proceeding. He is counsel for Patent Owner in a co-pending district court litigation involving the same patent at issue in this proceeding.

Admission of Mr. Beard *pro hac vice* will enable Patent Owner to avoid unnecessary expense and duplication of work between this proceeding and its district court litigation. *See* 77 Fed. Reg. 157 (Aug. 14, 2012), at 48661 (Office’s comment on final rule discussing concerns about efficiency and costs where an entity has already engaged counsel for parallel district court litigation). As litigation counsel for Patent Owner, Mr. Beard has been actively involved in all aspects of the district court litigation. In view of Mr. Beard’s knowledge of the subject matter at issue in the district court proceeding and the overlapping

knowledge of the subject matter in this proceeding, Patent Owner has a substantial need for Mr. Beard's *pro hac vice* admission and involvement in this proceeding.

Counsel for Patent Owner have met and conferred with counsel for Petitioner. Counsel for Petitioner does not oppose this Motion.

CONCLUSION

For the reasons stated above, Patent Owner respectfully requests that the Board admit James W. Beard to appear *pro hac vice* in this proceeding.

Respectfully submitted,

MERCHANT & GOULD P.C.

Date: October 7, 2020

/Andrew J. Lagatta/

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(Trial No. IPR2020-01543)

ATTORNEYS FOR PATENT OWNER

CERTIFICATE OF SERVICE

The undersigned certifies, in accordance with 37 C.F.R. § 42.6(e), that service was made on Counsel for Petitioner as detailed below.

Date of service:	October 7, 2020
Manner of service:	Electronic mail addressed to: docket_ip@pillsburylaw.com bryan.collins@pillsburylaw.com patrick.doody@pillsburylaw.com henry.fildes@pillsburylaw.com william.atkins@pillsburylaw.com
Documents served:	Patent Owner's Motion for Admission Pro Hac Vice of James W. Beard under 37 C.F.R. § 42.10 (c)
Persons served:	Bryan P. Collins (Reg. No. 43,560) Patrick A. Doody (Reg. No. 35,022) William P. Atkins (Reg. No. 38,821) Henry Fildes (Reg. No. 76,774) PILLSBURY WINTHROP SHAW PITTMAN LLP 1650 Tysons Boulevard McLean, Virginia 22102

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