

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FELLOWES, INC.,
Petitioner,

v.

TREEFROG DEVELOPMENTS, INC.,
Patent Owner.

IPR2020-01543 (Patent 8,564,950 B2)
IPR2020-01575 (Patent 8,393,466 B2)¹

Before JOSIAH C. COCKS, GRACE KARAFFA OBERMANN, and
PATRICK R. SCANLON, *Administrative Patent Judges*.

OBERMANN, *Administrative Patent Judge*.

DECISION

Granting Patent Owner's Motions for *Pro Hac Vice*
Admission of James W. Beard
37 C.F.R. § 42.10

¹ This Order applies to each of the above-listed proceedings. We exercise our discretion to issue one Order to be filed in each proceeding. Unless otherwise authorized, the parties shall not use this heading style in any subsequent papers.

Patent Owner filed motions for *pro hac vice* admission of James W. Beard in the above-identified proceedings (collectively, “Motions”). Paper 6 (“Mot.”).² Patent Owner also filed declarations from Mr. Beard in support of the Motions (collectively, “Declarations”). Ex. 2001.³ Patent Owner states that counsel for Petitioner does not object to Mr. Beard’s admission *pro hac vice*. Mot. 8.

In accordance with 37 C.F.R. § 42.10(c), we may recognize counsel *pro hac vice* during a proceeding upon a showing of good cause. In authorizing a motion for *pro hac vice* admission, the Board requires the moving party to provide 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 the proceeding. *See 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”).

Lead counsel for Patent Owner, Andrew J. Lagatta, a registered practitioner, filed the Motions. Mot. 4. In the Motions, Patent Owner states there is good cause for the Board to recognize Mr. Beard *pro hac vice* during these proceedings because he “is an experienced litigation attorney,” “has established familiarity with the subject matter at issue” in these proceedings, and is counsel for Patent Owner in co-pending district court litigation involving patents at issue in these proceedings. *Id.* at 4–5; *see* Ex. 2001 ¶¶ 8–11. Mr. Beard’s Declarations also comply with the requirements for

² All citations are to IPR2020-01543. Patent Owner filed a similar motion in IPR2020-01575. Paper 6.

³ Patent Owner filed a similar declaration in IPR2020-01575. Ex. 2001.

pro hac vice admission. Ex. 2001 ¶¶ 1–7; *see Unified Patents*, slip op. at 3–4.

Based on the information presented in the Motions and Declarations, and in view of Patent Owner’s assertion that Petitioner does not oppose the Motions, we find that good cause exists for *granting* the Motions and permitting the *pro hac vice* admission of Mr. Beard.

It is

ORDERED that the Motions are *granted*, and James W. Beard is authorized to represent Patent Owner only as back-up counsel in each proceeding identified in the heading;

FURTHER ORDERED that a registered practitioner will continue to represent Patent Owner as lead counsel in the above-identified proceedings;

FURTHER ORDERED that Mr. Beard shall comply with the Office Patent Trial Practice Guide (84 Fed. Reg. 64,280 (Nov. 21, 2019)), and the Board’s Rules of Practice for Trials, as set forth in Part 42 of Title 37, Code of Federal Regulations; and

FURTHER ORDERED that Mr. Beard is subject to the USPTO’s Rules of Professional Conduct set forth in 37 C.F.R. §§ 11.101 *et seq.* and to the USPTO’s disciplinary jurisdiction under 37 C.F.R. § 11.19(a).

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FOR PETITIONER:

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