

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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AUTEL U.S. INC. and AUTEL INTELLIGENT TECHNOLOGY CO.  
LTD. Petitioners

v.

BOSCH AUTOMOTIVE SERVICE SOLUTIONS LLC  
Patent Owner

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Case IPR2014-00183  
Patent 6,904,796

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Before JOSIAH C. COCKS, SHERIDAN K. SNEDDEN, and  
SCOTT A. DANIELS, *Administrative Patent Judges*.

COCKS, *Administrative Patent Judge*.

ORDER  
Motion for *Pro Hac Vice* Admission  
*37 C.F.R. § 42.10*

Patent Owner, Bosch Automotive Service Solutions LLC, filed a motion for *pro hac vice* admission of Mr. John E. Berg.<sup>1</sup> Paper 13. As a part of the motion, Patent Owner provided a declaration from Mr. Berg in support thereof. The motion is unopposed. For the reasons stated below, the motion is *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 be a registered practitioner and to any other conditions as the Board may impose.” 37 C.F.R. § 42.10(c). For example, where the 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.* 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. *See* IPR 2013-00639 (Paper 7).

In its motion, Patent Owner argues that there is good cause for Mr. Berg’s *pro hac vice* admission because he is an experienced litigating attorney and has an established familiarity with the subject matter at issue in these *inter partes* reviews and is counsel for Patent Owner in concurrent district court litigation. Paper 13, 1-2. In his declaration, Mr. Berg attests that:

- (1) he is a member in good standing of the bar of the State of

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<sup>1</sup> Authorization for such motion was given in the Notice mailed December 6, 2013 (Paper 5).

Michigan;

- (2) he has never been suspended or disbarred from practice before any court or administrative body;
- (3) he has read and will comply with the Office Patent Trial Practice Guide and the Board's Rules of Practice for Trials, as set forth in part 42 of 37 C.F.R., and agrees to be subject to: (a) the USPTO Rules of Practice for Trials set forth in part 42 of 37 C.F.R.; (b) the USPTO Professional Rules of Professional Conduct set forth in 37 C.F.R. §§ 11.101 *et seq.*; and (c) disciplinary jurisdiction under 37 C.F.R. § 11.19(a); and
- (4) he is familiar with the subject matter at issue in this proceeding.

*Id.* at 1-4. We observe also that Patent Owner's lead counsel in this proceeding, Timothy M. McCarthy, is a registered practitioner. Paper 14.

Based on the facts set forth above, we conclude that Mr. Berg has sufficient legal and technical qualifications to represent Patent Owner in this *inter partes* review proceeding and that there is a need for Patent Owner to have its counsel in the related litigation involved in such proceedings. Accordingly, Patent Owner has established good cause for Mr. Berg's *pro hac vice* admission. Mr. Berg will be permitted to appear *pro hac vice* in IPR2014-00183 as back-up counsel only. *See* 37 C.F.R. § 42.10(c).

IPR2014-00183  
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Accordingly, it is:

ORDERED that Patent Owner's motion for *pro hac vice* admission is granted and Mr. John E. Berg is authorized to represent Patent Owner as back-up counsel in IPR2014-00183;

FURTHER ORDERED that Patent Owner is to continue to have a registered practitioner as lead counsel in this *inter partes* review proceeding;

FURTHER ORDERED that Mr. Berg 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 Code of Federal Regulations; and

FURTHER ORDERED that Mr. Berg is 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.*

For PETITIONER:

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