

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AM GENERAL LLC,
Petitioner,

v.

UUSI, LLC,
Patent Owner.

IPR2016-01049 (U.S. Patent No. 5,570,666)
IPR2016-01050 (U.S. Patent No. 6,148,258)
IPR2016-01051 (U.S. Patent No. 5,729,456)

Before PHILLIP J. KAUFFMAN, MEREDITH C. PETRAVICK, and
RICHARD E. RICE, *Administrative Patent Judges*.

PETRAVICK, *Administrative Patent Judge*.

ORDER¹

Pro Hac Vice Admission of Paul M. Schoenhard
37 C.F.R. § 42.10(c)

INTRODUCTION

¹ This Order addresses the same or similar issue in the proceedings listed above. Therefore, we issue one Order to be filed in each proceeding. The parties, however, are not authorized to use this style of filing.

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Petitioner filed Motions for Admission *Pro Hac Vice* of Paul M. Schoenhard (Paper 20²) and an accompanying declarations in support thereof (Paper 21) in each of these proceedings. The Motions indicate that Patent Owner does not oppose. Paper 20, 3.

DISCUSSION

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 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 this proceeding.

IPR2013-00639, Paper 7, “Order – Authorizing Motion for *Pro Hac Vice* Admission.”

Lead Counsel for Petitioner is Nicole Jantzi, a registered practitioner. In the Motions, Petitioner states that there is good cause for the Board to recognize Paul M. Schoenhard *pro hac vice* during these proceedings because he represents Petitioner in related matters against the Patent Owner. Paper 20, 2–3. The motions further assert that Paul M. Schoenhard has experience and familiarity with the subject matter of the patents at issue in these proceedings. *Id.*

Declarations of Paul M. Schoenhard attesting to, and sufficiently explaining, the required facts, accompany the motions. The Declarations comply with the requirements for *pro hac vice* admission and establish that Paul M. Schoenhard is

² For the purposes of this Order, IPR2016-01049 is representative and all citations are to papers in IPR2016-01049 unless otherwise noted.

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an experienced attorney with an established familiarity with the subject matter at issue in these proceedings. *See* Paper 21. The Declarations further acknowledge that Paul M. Schoenhard is 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). *Id.* at ¶¶ 5–6.

Upon consideration, Petitioner has demonstrated sufficiently that Paul M. Schoenhard has sufficient legal and technical qualifications to represent Petitioner in this proceeding. Accordingly, Petitioner has established that there is good cause for admitting Paul M. Schoenhard. Paul M. Schoenhard may only be designated as backup counsel.

ORDER

It is:

ORDERED that Petitioner's Motions for *Pro Hac Vice* Admission of Paul M. Schoenhard is *granted* in each proceeding, and Paul M. Schoenhard is authorized to represent Petitioner only as back-up counsel in these proceedings;

FURTHER ORDERED that Petitioner should continue to have a registered practitioner as lead counsel in these proceedings;

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

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