

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

T-MOBILE US, INC. and T-MOBILE USA, INC.,

Petitioner,

v.

BARKAN WIRELESS ACCESS TECHNOLOGIES, L.P.,
Patent Owner.

Case IPR2017-01098 (Patent 8,559,369 B2)
Case IPR2017-01099 (Patent 9,042,306 B2)¹

Before MEREDITH C. PETRAVICK, JOHN A. HUDALLA, and
SHARON FENICK, *Administrative Patent Judges*.

FENICK, *Administrative Patent Judge*.

ORDER

Pro Hac Vice Admission of Matthew C. Bernstein
37 C.F.R. § 42.10

¹ This decision addresses issues pertaining to both cases. Therefore, we exercise our discretion to issue a single Order to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

IPR2017-01098 (Patent 8,559,369 B2)

IPR2017-01099 (Patent 9,042,306 B2)

Petitioner filed Motions for Admission *Pro Hac Vice* of Matthew C. Bernstein (Paper 6²) and accompanying affidavits in support thereof (Exhibit 1038) in both of these proceedings. Patent Owner did not file any opposition.

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 motions 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 Chun M. Ng, a registered practitioner. In the Motions, Petitioner states that there is good cause for the Board to recognize Matthew C. Bernstein *pro hac vice* during these proceedings because Matthew C. Bernstein represents Petitioner in related matters. Paper 6, 2. The motions further assert that Matthew C. Bernstein has experience and familiarity with the subject matter of the patents at issue in these proceedings. *Id.*

Affidavits of Matthew C. Bernstein attesting to, and sufficiently explaining, the required facts, accompany the motions. Exhibit 1038. The affidavits comply with the requirements for *pro hac vice* admission and establish that Matthew C. Bernstein is an experienced attorney having

² For the purposes of this Order, IPR2016-01099 is representative and all citations are to papers in IPR2016-01099 unless otherwise noted.

IPR2017-01098 (Patent 8,559,369 B2)

IPR2017-01099 (Patent 9,042,306 B2)

established familiarity with the subject matter at issue in these proceedings.

See id. ¶¶ 9–10 The affidavits further acknowledge that Matthew C.

Bernstein 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.* ¶ 6.

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

Petitioner's motions are granted. Petitioner should update the counsel information in the PTAB E2E filing system.

ORDER

It is:

ORDERED that Petitioner's Motion for *Pro Hac Vice* Admission of Matthew C. Bernstein is *granted* in each proceeding, and Matthew C. Bernstein 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 Matthew C. Bernstein 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

IPR2017-01098 (Patent 8,559,369 B2)

IPR2017-01099 (Patent 9,042,306 B2)

FURTHER ORDERED that Matthew C. Bernstein 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.*

PETITIONER:

Chun M. Ng
Miguel Bombach
John Esterhay
PERKINS COIE LLP
cng@perkinscoie.com
mbombach@perkinscoie.com
jesterhay@perkinscoie.com

PATENT OWNER:

Robert D. Katz
KATZ, PLLC
rkatz@katzfirm.com

Spencer C. Patterson
spatterson@gchub.com