

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CONEX UNIVERSAL LIMITED,
Petitioner,

v.

RLS LLC,
Patent Owner.

Case IPR2019-00590 (Patent 9,145,992 B2)
Case IPR2019-00615 (Patent 9,638,361 B2)¹

Before MITCHELL G. WEATHERLY, RICHARD H. MARSCHALL, and
JOHN D. HAMANN, *Administrative Patent Judges*.

WEATHERLY, Administrative Patent Judge.

ORDER

Denying Without Prejudice Petitioner's Motion
for *Pro Hac Vice* Admission of Marc C. Levy
37 C.F.R § 42.10

¹ We exercise our discretion to issue one order to be entered in above-referenced proceedings. The Parties are not authorized to use this style heading without prior Board approval.

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Petitioner moves for admission *pro hac vice* of Marc C. Levy in each of the above-referenced proceedings (collectively, “Motions”). Paper 6, 1–3.² Each of the Motions included identical text set forth in a section styled as “Affadavit of Marc C. Levy in Support of *Pro Hac Vice* Application” (the “Levy Affidavit”). Paper 6, 4–6. For the reasons stated below, we deny Petitioner’s Motions without prejudice.

The Notice of Filing Date Accorded to Petition entered in this proceeding authorized parties to file motions for admission *pro hac vice* in accordance with the standards set forth in *Unified Patents, Inc. v. Parallel Iron, LLC*, Case IPR2013-00639 (PTAB Oct. 15, 2013) (Paper 7). Paper 5, 2. That Paper requires a motion for admission *pro hac vice* to be accompanied by “an affidavit or declaration of the individual seeking to appear.” *Unified Patents*, 3.

Our Rules also require parties to support motions by evidence. 37 C.F.R. § 42.22(a); *see also* 37 C.F.R. § 42.20(c) (placing burden of proof on movant). Testimonial evidence such as the Levy Affidavit must be submitted in the form of an affidavit or declaration filed as an Exhibit in the proceeding, not as a portion of the motion that is purportedly supported by the testimony. 37 C.F.R. § 42.63(a).

The Levy Affidavit suffers two flaws. First, it is not evidence under our Rules. Second, it is not separately filed as an Exhibit. We address each flaw below.

² For purposes of expediency, we refer to papers and exhibits filed in IPR2019-00590. Petitioner filed a substantively identical Motion in IPR2019-00615. Paper 6, 1–3.

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“Affidavit means affidavit or declaration under § 1.68 of this chapter. A . . . declaration under 28 U.S.C. 1746 may be used as an affidavit.”

37 C.F.R. § 42.2. The reference to “affidavit” invokes the requirements of 37 C.F.R. § 1.66, and the remainder of the definition of “affidavit” invokes the requirements of 37 C.F.R. § 1.68 or 28 U.S.C. § 1746. Thus, three avenues exist for meeting the requirements of an “affidavit” under our Rules. The Levy Affidavit meets none of these three requirements.

Under 37 C.F.R. § 1.66, “[a]n oath or affirmation may be made before any person within the United States authorized by law to administer oaths” and the “oath shall be attested in all cases in this and other countries, by the proper official seal of the officer before whom the oath or affirmation is made.” The Affidavits do not include the seal of an officer before whom Mr. Levy’s oath or affirmation was made, and, thus, the Affidavits do not comply with § 1.66. Under 37 C.F.R. § 1.68 a party relying upon testimony in the form of a declaration must include a statement in the declaration that “willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001) and may jeopardize the validity of the application or any patent issuing thereon.” 37 C.F.R. § 1.68. A similar statement exists in 28 U.S.C. § 1746 that permits a witness to “declare (or certify, verify, or state) under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.” 28 U.S.C. § 1746. The Levy Affidavit included neither of these statements. *See* Paper 6, 4–6. For all these reasons, we cannot consider the Levy Affidavit as testimonial evidence supporting the Motions. Without such evidence, we deny the Motions without prejudice.

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Petitioner is authorized to file revised motions for admission *pro hac vice* of Marc C. Levy with supporting evidence in the form of an exhibit containing testimony meeting any of the standards discussed above. Petitioner requested via e-mail on March 27, 2019, that we quickly review the Motion so that Petitioner could identify Mr. Levy as backup counsel. To support that expedited review of the issues presented by the Motion, Petitioner should file a revised motion with appropriate supporting evidence by no later than Monday, April 1, 2019.

Accordingly, for the reasons discussed above, it is:

ORDERED that Petitioner's Motion for *Pro Hac Vice* Admission Under 37 C.F.R. § 42.10 in each of the above-captioned proceedings is *denied without prejudice*; and

FURTHER ORDERED that Petitioner is authorized in each proceeding to file a revised motion for admission *pro hac vice* of Marc C. Levy along with a supporting exhibit containing testimonial evidence by the close of business Monday, April 1, 2019.

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