

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

MASIMO CORPORATION,
Patent Owner.

IPR2020-01526
Patent 6,771,994 B2

Before JOSIAH C. COCKS, ROBERT L. KINDER, and
AMANDA F. WIEKER, *Administrative Patent Judges*.

KINDER, *Administrative Patent Judge*.

ORDER
Granting Patent Owner's Motion for Admission
Pro Hac Vice of Jeremiah S. Helm
37 C.F.R. § 42.10

On January 10, 2022, Patent Owner filed a Motion for Admission *Pro Hac Vice* of Jeremiah S. Helm. Paper 23 (“Motion”). Patent Owner also filed a Declaration of Jeremiah S. Helm in support of the Motion. Ex. 2016 (“Declaration”). Patent Owner attests that Petitioner does not oppose the Motion. Paper 23, 1. For the reasons provided below, Patent Owner’s Motion is *granted*.

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 its notice authorizing motions for *pro hac vice* admission, the Board requires 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. *See* Paper 4, 2 (citing *Unified Patents, Inc. v. Parallel Iron, LLC*, IPR2013-00639, Paper 7 (PTAB Oct. 15, 2013) (representative “Order – Authorizing Motion for *Pro Hac Vice* Admission”)).

Based on the facts set forth in the Motion and the accompanying Declaration,¹ we conclude that Mr. Helm has sufficient legal and technical

¹ *Unified Patents* indicates that “A motion for *pro hac vice* admission must: . . . Be accompanied by an affidavit or declaration of the individual seeking to appear attesting to the following: . . . All other proceedings before the Office for which the individual has applied to appear *pro hac vice* in the last three (3) years.” *See Unified Patents*, Paper 7 at 3. Although the Declaration identifies proceedings in which Mr. Helm “ha[s] appeared *pro hac vice* in proceedings before the United States Patent and Trademark Office,” the Declaration fails to identify *all* proceedings before the Office for which Mr. Helm has *applied* to appear *pro hac vice in the last three years*. *See* Ex. 2016 ¶ 11. For the purposes of this Order, we deem this harmless error.

qualifications to represent Patent Owner in this proceeding, that Mr. Helm has demonstrated sufficient familiarity with the subject matter of this proceeding, that Mr. Helm meets all other requirements for admission *pro hac vice*, and that Patent Owner's intent to be represented by counsel with litigation experience is warranted. Accordingly, Patent Owner has established good cause for *pro hac vice* admission of Mr. Helm. Mr. Helm will be permitted to serve as back-up counsel only. *See* 37 C.F.R. § 42.10(c).

We note that Patent Owner has filed a Power of Attorney including Mr. Helm in accordance with 37 C.F.R. § 42.10(b). Paper 28. However, a Mandatory Notice identifying Mr. Helm as back-up counsel in accordance with 37 C.F.R. § 42.8(b)(3), has not been submitted by Patent Owner. Accordingly, Patent Owner must update its Mandatory Notices as required by 37 C.F.R. § 42.8(b)(3), to identify Mr. Helm as back-up counsel.

Accordingly, it is:

ORDERED that Patent Owner's Motion for *pro hac vice* admission of Jeremiah S. Helm is *granted*;

FURTHER ORDERED that Patent Owner is to continue to have a registered practitioner represent it as lead counsel for this proceeding;

FURTHER ORDERED that Mr. Helm is authorized to represent Patent Owner as back-up counsel only in this proceeding;

FURTHER ORDERED that Mr. Helm is to comply with the Consolidated Trial Practice Guide² (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;

² Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

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FURTHER ORDERED that Mr. Helm shall be 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.*; and

FURTHER ORDERED that Patent Owner shall file an updated Mandatory Notice in this proceeding in accordance with 37 C.F.R. § 42.8(b)(3), identifying Mr. Helm as back-up counsel.

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