

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

STARBUCKS CORPORATION,
Petitioner,

v.

AMERANTH, INC.,
Patent Owner.

Case CBM2015-00091 (Patent 6,384,850)
CBM2015-00099 (Patent 6,871,325)¹

Before MEREDITH C. PETRAVICK, RICHARD E. RICE, and
STACEY G. WHITE, *Administrative Patent Judges*.

WHITE, *Administrative Patent Judge*.

DECISION

Petitioner's Motions for *Pro Hac Vice* Admission of Matthew C. Bernstein
37 C.F.R. § 42.10

¹ This order addresses a similar issue in the two cases. Therefore, we exercise discretion to issue one order to be filed in each case. The parties, however, are not authorized to use this caption in subsequent papers.

CBM2015-00091 (Patent 6,384,850)

CBM2015-00099 (Patent 6,871,325)

In each of the instant proceedings, Petitioner Starbucks Corporation filed a motion requesting *pro hac vice* admission of Mr. Matthew C. Bernstein and provided an affidavit from Mr. Bernstein in support of the request.² Patent Owner Ameranth, Inc. did not file an opposition to either of the motions. For the reasons stated below, Petitioner’s motions are *granted*. As the motions and affidavits in both proceedings are substantially similar, we will refer herein to the papers filed in CBM2015-00091 for convenience.

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.* 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. Paper 7 (referencing the “Order – Authorizing Motion for *Pro Hac Vice* Admission,” Paper 7 in IPR2013-00639).

In the motion, Petitioner asserts that there is good cause for Mr. Bernstein’s *pro hac vice* admission because: (1) Mr. Bernstein is an experienced litigation attorney with experience in numerous patent infringement litigations; and (2) Mr. Bernstein has an established familiarity

² See CBM2015-00091, Paper 6, Ex. 1052; CBM2015-00099, Paper 6, Ex. 1062.

CBM2015-00091 (Patent 6,384,850)

CBM2015-00099 (Patent 6,871,325)

with subject matter at issue in this proceeding. Paper 3, 2–3. In support of the motion, Mr. Bernstein attests to these facts in his declaration with sufficient explanations. Ex. 1052.

Based on the facts set forth above, we conclude that Mr. Bernstein has sufficient legal and technical qualifications to represent Petitioner in these proceedings. *See Unified Patents, Inc. v. Parallel Iron, LLC*, Case IPR2013-00639, slip op. at 2–4 (PTAB Oct. 15, 2013) (Paper 7) (setting forth the requirements for *pro hac vice* admission). Accordingly, Petitioner has established good cause for Mr. Bernstein’s *pro hac vice* admission. Mr. Bernstein will be permitted to appear *pro hac vice* in the instant proceedings as back-up counsel only. *See* 37 C.F.R. § 42.10(c).

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner’s motions for *pro hac vice* admission of Matthew C. Bernstein in the instant proceedings are granted and Mr. Bernstein is authorized to represent Petitioner as back-up counsel in the instant proceedings;

FURTHER ORDERED that Petitioner is to continue to have a registered practitioner as lead counsel in the instant proceedings;

FURTHER ORDERED that Mr. 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

FURTHER ORDERED that Mr. Bernstein is subject to the USPTO Rules of Professional Conduct set forth in 37 C.F.R. §§ 11.101 *et seq.* and the Office’s disciplinary jurisdiction under 37 C.F.R. § 11.19(a).

CBM2015-00091 (Patent 6,384,850)

CBM2015-00099 (Patent 6,871,325)

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