

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ABB, INC.
Petitioner

v.

ROY-G-BIV CORPORATION
Patent Owner

Case IPR2013-00062
Case IPR2013-00282
Patent 6,516,236 B1

Before THOMAS L. GIANNETTI, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

This Order is entered to clarify two issues relating to *pro hac vice* appearances in these proceedings. *See* 37 C.F.R. 42.10 (c).

1. Petitioner has filed a motion to recognize Mr. Steven M. Auvil *pro hac vice*. Paper 34. The supporting affidavit establishes that Mr. Auvil is admitted to practice before the USPTO. Ex. 1031. In view of this representation, there was no need to seek *pro hac vice* recognition for Mr. Auvil as he is a registered practitioner. *See* 37 C.F.R. § 42.10 (c) (“ . . . a motion to appear *pro hac vice* by counsel who is not a registered practitioner may be granted upon showing that counsel is an experienced litigating attorney and has an established familiarity with the subject matter at issue in the proceeding.”) Petitioner’s motion is, therefore, dismissed as moot.

2. Patent Owner’s counsel contacted the Board, first by telephone and then by email, requesting guidance on whether an attorney who is admitted to practice before the USPTO could participate in a deposition in this proceeding. The communications were apparently *ex parte*, as there is no indication Patent Owner copied Petitioner’s counsel on the email, despite being requested to do so. The parties are reminded that *ex parte* communications with the Board are prohibited except in very limited circumstances. *See* 37 C.F.R. § 42.5(d); Office Trial Practice Guide, 77 Fed. Reg. 48756, 48758 (August 14, 2012).

For guidance on the deposition issue, the parties are directed to the “Frequently Asked Questions” section of the Board’s web site:

<http://www.uspto.gov/ip/boards/bpai/prps.jsp>.

Question G11 specifically addresses this issue and provides that a registered USPTO practitioner or attorney recognized *pro hac vice* in a proceeding may participate in a deposition.

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It is, therefore,

ORDERED that Petitioner's motion for *pro hac vice* recognition of
Mr. Auvil is dismissed as moot.

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