

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TOYOTA MOTOR CORPORATION
Petitioner,

v.

AMERICAN VEHICULAR SCIENCES LLC
Patent Owner.

Case IPR2013-00419 (JL)
Patent 6,772,057

Before JAMESON LEE, MICHAEL W, KIM, and LYNNE E. PETTIGREW,
Administrative Patent Judges.

LEE, *Administrative Patent Judge.*

DECISION

Petitioner's Motion for *Pro Hac Vice* Admission of Thomas R. Makin
37 C.F.R. § 42.10

On July 18, 2013, Petitioner ("Toyota") filed a motion for *pro hac vice* admission of Mr. Thomas R. Makin. (Paper 5.) A motion for *pro hac vice* admission of counsel may be filed no earlier than twenty-one (21) days after service of the Petition. IPR2013-00010 (Paper 8, October 26, 2012.) Toyota's

Certificate of Service appended to its Petition indicates service by Express Mail on July 12, 2013. (Paper 3.) Therefore, the motion was filed prematurely, fifteen (15) days too early. The Board regards the motion as having been filed on August 2, 2013, and thus Patent Owner's time to oppose the motion, *i.e.*, one week, did not commence to run until August 2, 2013. It is noted that as of August 12, 2013, Patent Owner has not filed an opposition to the motion. For reasons discussed below, Toyota's motion is *conditionally granted*.

The Board may recognize counsel *pro hac vice* during a proceeding upon a showing of good cause, subject to the condition that lead counsel is a registered practitioner. 37 C.F.R. § 42.10(c). If 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 this proceeding, lead counsel for Toyota is Matthew Berkowitz, a registered practitioner. Toyota's motion relies on a declaration of Thomas R. Makin (Ex. 1017). Mr. Thomas R. Makin declares that he is a member in good standing of the Bar of New York. (Ex. 1017, ¶ 1.) Mr. Thomas R. Makin also declares that he has never been suspended, disbarred, sanctioned or cited for contempt by any court or administrative body, and that he has never had an application for admission to practice denied by any court or administrative body. (Ex. 1017, ¶¶ 2-4.) Mr. Thomas R. Makin further declares that he is familiar with the subject matter at issue in this proceeding based on his work as counsel for Toyota in the related district court litigation between the parties involving Patent 6,772,057: *American Vehicular Sciences LLC v. Toyota Motor Corp. et al.*, No. 6:12-CV-410 (E.D. Tex.). (Ex. 1017, ¶ 8.)

Mr. Thomas R. Makin further states (1) that he has read and will comply with the Board's Rules of Practice for Trials as set forth in Part 42 of Title 37, Code of Federal Regulations, as well as the Office Patent Trial Practice Guide, and (2) that he agrees to be subject to the "United States Patent and Trademark Office Code of Professional Responsibility set forth in 37 C.F.R. §§ 11.101 *et seq.* and disciplinary jurisdiction under 37 C.F.R. § 11.19(a)." (Ex. 1017, ¶¶ 5-6.)

Effective May 3, 2013, the USPTO Code of Professional Responsibility was replaced by the USPTO Rules of Professional Conduct. *See Changes to Representation of Others Before the United States Patent and Trademark Office; Final Rule, 78 Fed. Reg. 20180-81 (Apr. 3, 2013).* Thus, Mr. Thomas R. Makin should have declared, but failed to declare, that he agrees to comply with the USPTO "Rules of Professional Conduct" as set forth in 37 C.F.R. §§ 11.101 *et seq.*

But for not having a statement from Mr. Thomas R. Makin that he will comply with the USPTO "Rules of Professional Conduct," Toyota has established good cause for admission, *pro hac vice*, of Mr. Thomas R. Makin.

It is

ORDERED that Toyota's motion for *pro hac vice* admission of Mr. Thomas R. Makin is *conditionally granted*, provided that within seven (7) days of the date of this order, Toyota files a declaration statement from Mr. Thomas R. Makin, labeled as an exhibit, indicating that he agrees to be subject to the USPTO's Rules of Professional Conduct as set forth in 37 C.F.R. §§ 11.101 *et seq.*;

FURTHER ORDERED that if the above-noted declaration statement, labeled as an exhibit, is filed within seven (7) days of the date of this order, Mr. Thomas R. Makin is authorized to be designated as backup counsel, but not lead counsel, in this proceeding; and

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FURTHER ORDERED that Mr. Thomas R. Makin is subject to the
USPTO's Rules of Professional Conduct as set forth in 37 C.F.R. §§ 11.101 *et seq.*

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