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Paper No. 38
Date Entered: August 26, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WINTEK CORPORATION,
Petitioner,
v.

TPK TOUCH SOLUTIONS,
Patent Owner.

Case IPR2013-00567
Case IPR2014-00541[1]
Patent 8,217,902

Before TONI R. SCHEINER and JOSIAH C. COCKS, *Administrative Patent Judges*.

SCHEINER, *Administrative Patent Judge*.

DECISION
Patent Owner's Motion for *Pro Hac Vice* Admission of Derek Tang
37 C.F.R. § 42.10

[1] IPR2014-00541 has been joined with IPR2013-00567. *See* IPR2013-00567, Paper 23.

Patent Owner, TPK Touch Solutions ("TPK") filed a motion for *pro hac vice* admission of Derek Tang. Paper 33 ("Mot."). TPK provided an affidavit of Mr. Tang, filed separately as Exhibit 2026, in support of its motion. The motion is unopposed. The motion is GRANTED, contingent on fulfilment of the condition discussed below.

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). In authorizing motions for *pro hac vice*, 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 in the proceeding.

A Notice of Filing Date Accorded to Petition was entered in this proceeding on September 2, 2013. Paper 3 ("Notice"). The Notice advised that motions for *pro hac vice* admission be filed in accordance with the "Order—Authorizing Motion for *Pro Hac Vice* Admission" in IPR2013-00010 (MPT) . . . available on the Board Web site under "Representative Orders, Decisions, and Notices." Notice 2. However, the Notice further advised that "[a]ny motion for *pro hac vice* admission filed by the parties shall also indicate that the person sought to be admitted will be subject to the USPTO Rules of Professional Conduct," which took effect May 3, 2013.[2] *Id.*

In its motion, TPK states that there is good cause for the Board to recognize Mr. Tang as *pro hac vice* backup counsel during this proceeding, as Mr. Tang is an experienced litigation attorney with an established familiarity with the subject

[2] *See* Changes to Representation of Others Before the United States Patent and Trademark Office; Final Rule, 78 Fed. Reg. 20180 (Apr. 3, 2013).

matter at issue in this proceeding. Mot. 4. Moreover, TPK points out that Mr. Tang has assisted TPK in preparing its responses in a co-pending *ex parte* reexamination of the same patent at issue in this proceeding. *Id.*

Mr. Tang's affidavit in support of TPK's motion attests to, and sufficiently explains, these facts. Ex. 2026 ¶ 8. Mr. Tang's affidavit otherwise complies with the requirements set forth in the Notice, except that Mr. Tang attests that he understands that he "will be subject to the USPTO Code of Professional Responsibility set forth in 37 C.F.R §§ 10.20 et seq." *Id.* at ¶ 6. However, as discussed above, the USPTO Code of Professional Responsibility set forth in part 10 of title 37 has been superseded by the USPTO Rules of Professional Conduct.

Accordingly, the affidavit or declaration of the individual seeking to appear must attest that the individual will be subject to the USPTO Rules of Professional Responsibility set forth in 37 C.F.R. §§ 11.101 *et seq*.

We recognize that TPK has a substantial need for Mr. Tang's *pro hac vice* admission and involvement in this proceeding. Moreover, with the exception of the deficiency noted above, TPK has demonstrated sufficiently that Mr. Tang has sufficient legal and technical qualifications to represent TPK in this proceeding, and that there is good cause for admitting Mr. Tang. Accordingly, TPK's motion for *pro hac vice* admission of Derek Tang is granted—contingent on full compliance with the ORDER set forth below.

It is

ORDERED that TPK's motion for *pro hac vice* admission of Derek Tang for this proceeding is GRANTED, contingent on Mr. Tang's filing, no later than 5:00 PM Eastern Time on August 29, 2014, an affidavit attesting that he will be subject to the Office's 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);

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

FURTHER ORDERED that Mr. Tang is to comply with the Office Patent Trial Practice Guide and the Board's Rules of Practice for Trials, as set forth in Part 42 of the C.F.R., and to be subject to the Office's 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).

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