

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICRO MOTION, INC.,
Petitioner,

v.

INVENSYS SYSTEMS, INC.,
Patent Owner.

Cases: IPR2014-00167 (Patent 7,505,854)
IPR2014-00170 (Patent 6,311,136)
IPR2014-00178 (Patent 7,136,761)
IPR2014-00179 (Patent 7,124,646)
IPR2014-00390 (Patent 6,754,594)
IPR2014-00392 (Patent 8,000,906)
IPR2014-00393 (Patent 7,571,062)
IPR2014-01409 (Patent 7,571,062)¹

Before WILLIAM V. SAINDON, MICHAEL R. ZECHER, and
JENNIFER M. MEYER, *Administrative Patent Judges*.

MEYER, *Administrative Patent Judge*.

DECISION
Petitioner's Motion for *Pro Hac Vice*
Admission of Kadie M. Jelenchick
37 C.F.R. § 42.10

¹ This order addresses identical motions filed in each of the eight related cases. We exercise our discretion to issue one decision to be entered in each case. The parties are not authorized to use this style heading in their papers.

IPR2014-00167 (Patent 7,505,854)
IPR2014-00170 (Patent 6,311,136)
IPR2014-00178 (Patent 7,136,761)
IPR2014-00179 (Patent 7,124,646)

IPR2014-00390 (Patent 6,754,594)
IPR2014-00392 (Patent 8,000,906)
IPR2014-00393 (Patent 7,571,062)
IPR2014-01409 (Patent 7,571,062)

For each of these proceedings, Petitioner filed a motion requesting *pro hac vice* admission of Ms. Kadie M. Jelenchick (Paper 27, “Mot.”),² as well as a supporting affidavit of Ms. Jelenchick (Ex. 1056). Patent Owner did not oppose the motion within the one-week period permitted for filing an opposition. For the reasons stated below, Petitioner’s motion is *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 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 a motion 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. *See Unified Patents, Inc. v. Parallel Iron, LLC*, Case IPR2013-00639, slip op. at 3 (PTAB Oct. 15, 2013) (Paper 7).

Petitioner comes forward with evidence that Ms. Jelenchick is an experienced litigation attorney with an established familiarity with the subject matter at issue in this *inter partes* review. Mot. 2 (citing Ex. 1056 ¶ 10). In particular, Petitioner asserts that Ms. Jelenchick is a member of the trial team in *Invensys Systems, Inc. v. Emerson Electric Co.*, Case No. 6:12-

² Unless otherwise noted, citations to the record herein are in reference to IPR2014-00167. Similar papers may be found in the related cases.

IPR2014-00167 (Patent 7,505,854)	IPR2014-00390 (Patent 6,754,594)
IPR2014-00170 (Patent 6,311,136)	IPR2014-00392 (Patent 8,000,906)
IPR2014-00178 (Patent 7,136,761)	IPR2014-00393 (Patent 7,571,062)
IPR2014-00179 (Patent 7,124,646)	IPR2014-01409 (Patent 7,571,062)

cv-00799 (E.D. TX), which involves the same patents as the instant proceedings. *Id.* (citing Ex. 1056 ¶ 11). Petitioner shows that Ms. Jelenchick is a member in good standing of the state bar of Wisconsin, and has never been suspended or disbarred from practice, denied application to practice, sanctioned, or cited for contempt by any court or administrative body. *Id.* (citing Ex. 1056 ¶¶ 3–6).

Based on the facts set forth in support of the motion, we conclude that Ms. Jelenchick has sufficient legal and technical qualifications to represent Petitioner in this proceeding, and that there is a need for Petitioner to have its counsel in the related litigations involved in this proceeding.

Accordingly, Petitioner has established good cause for Ms. Jelenchick's *pro hac vice* admission.

Ms. Jelenchick shall be subject to the Office's disciplinary jurisdiction under 37 C.F.R. § 11.19(a) and the Office's Rules of Professional Conduct set forth in 37 C.F.R. § 11.101 *et seq.* See Ex. 1056 ¶ 8. Furthermore, Ms. Jelenchick is directed 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 C.F.R. See Ex. 1056 ¶ 7. Ms. Jelenchick 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).

ORDER

In consideration of the foregoing, it is

ORDERED that Petitioner's motion for *pro hac vice* admission of Kadie M. Jelenchick is granted, and Ms. Jelenchick is authorized to represent Petitioner in the instant proceedings as back-up counsel only;

IPR2014-00167 (Patent 7,505,854)
IPR2014-00170 (Patent 6,311,136)
IPR2014-00178 (Patent 7,136,761)
IPR2014-00179 (Patent 7,124,646)

IPR2014-00390 (Patent 6,754,594)
IPR2014-00392 (Patent 8,000,906)
IPR2014-00393 (Patent 7,571,062)
IPR2014-01409 (Patent 7,571,062)

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

FURTHER ORDERED that Ms. Jelenchick 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 Ms. Jelenchick 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).

IPR2014-00167 (Patent 7,505,854)
IPR2014-00170 (Patent 6,311,136)
IPR2014-00178 (Patent 7,136,761)
IPR2014-00179 (Patent 7,124,646)

IPR2014-00390 (Patent 6,754,594)
IPR2014-00392 (Patent 8,000,906)
IPR2014-00393 (Patent 7,571,062)
IPR2014-01409 (Patent 7,571,062)

For PETITIONER:

Andrew S. Baluch
Jeffrey N. Costakos
Angela Murch
Michelle Moran
Linda Hansen
FOLEY & LARDNER LLP
abaluch@foley.com
jcostakos@foley.com
amurch@foley.com
mmoran@foley.com
lhansen@foley.com

For PATENT OWNER:

Jeffrey L. Johnson
James M. Heintz
DLA PIPER LLP (US)
Jeffrey.johnson@dlapiper.com
Invensys_Micro_IPR@dlapiper.com