

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TOYOTA MOTOR CORPORATION,
Petitioner

v.

BLITZSAFE TEXAS, LLC,
Patent Owner

Case IPR2016-00422
Patent 7,489,786 B2

Before JAMESON LEE, THOMAS L. GIANNETTI, and HUNG H. BUI,
Administrative Patent Judges.

LEE, *Administrative Patent Judge.*

DECISION

*Patent Owner's Motion for
Pro Hac Vice Admission of Alfred R. Fabricant
37 C.F.R. § 42.10*

On January 21, 2016, Patent Owner filed a motion for *pro hac vice* admission of Alfred R. Fabricant. Paper 7 (“Motion”). Petitioner has not opposed the Motion. The 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 be 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.* Lead counsel for Patent Owner is Peter Lambrianakos, a registered practitioner.

Patent Owner’s motion relies on the Declaration of Alfred R. Fabricant. Paper 8 (“Decl.”). Mr. Fabricant declares that he has never been suspended, disbarred, sanctioned or cited for contempt by any court or administrative body, and that no court or administrative body has ever denied his application for admission to practice. *Id.* ¶¶ 3–4.

Mr. Fabricant further declares that he is familiar with the subject matter at issue in this proceeding, on the basis that he is lead counsel for Patent Owner in several district court actions involving U.S. Patent 7,489,786 B2, the same patent as that involved in this proceeding. *Id.* ¶ 8.

Mr. Fabricant further states that (1) he has read and will 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 Code of Federal Regulations”; (2) 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.*” *Id.* ¶¶ 5–6.

Mr. Fabricant has not identified the Title No. of the Code of Federal Regulations that is referred to in ¶ 5 of his Declaration. Mr. Fabricant also refers incorrectly to the Office Code of Professional Responsibility which was Part 10 of Title 37, Code of Federal Regulations, and has been replaced by the new Rules of Professional Conduct set forth in 37 C.F.R. §§ 11.101, *et seq.* See “*Changes to Representation of Others Before the United States Patent and Trademark Office;*” Final Rule, 78 Fed. Reg. 20180 (Apr. 3, 2013). The Office’s Rules of Professional Conduct took effect on May 3, 2013. *Id.* at 20180–81.

It is

ORDERED that Patent Owner’s Motion for *pro hac vice* admission of Alfred R. Fabricant is *conditionally granted*, provided that within one week of the date of this Order, Patent Owner files a Supplemental Declaration from Alfred R. Fabricant indicating that (1) he has read and will comply with the Board’s rules of practice for trials as set forth in Part 42 of Title 37 of the Code of Federal Regulations, and (2) 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 Supplemental Declaration is timely filed, then Mr. Fabricant is authorized to be designated as backup counsel, but not lead counsel, in this proceeding;

FURTHER ORDERED that Mr. Fabricant will comply with the Office Patent Trial Practice Guide and the Board’s Rules of Practice for

IPR2016-00422
Patent 7,489,786 B2

Trials, as set forth in Part 42 of Title 37, Code of Federal Regulations, and will be subject to the Office's Rules of Professional Conduct set forth in 37 C.F.R. §§ 11.101 *et seq.*, and disciplinary jurisdiction under 37 C.F.R. § 11.19(a); and

FURTHER ORDERED that Patent Owner is to continue to have a registered practitioner represent it as lead counsel in this proceeding.

COUNSEL FOR PETITIONER:

William Mandir
John Rabena
Brian Shelton
Sughrue Mion, PLLC
wmandir@sughrue.com
jrabena@sughrue.com
bshelton@sughrue.com

COUNSEL FOR PATENT OWNER:

Peter Lambrianakos
Brown Rudnick LLP
plambrianakos@brownrudnick.com