

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTUITIVE SURGICAL, INC.,
Petitioner,

v.

ETHICON LLC,
Patent Owner.

Case IPR2018-01247 (Patent 8,479,969 B2)
Case IPR2018-01248 (Patent 8,479,969 B2)
Case IPR2018-01254 (Patent 8,479,969 B2)¹

Before JOSIAH C. COCKS, BENJAMIN D. M. WOOD, and
MATTHEW S. MEYERS, *Administrative Patent Judges*.

MEYERS, *Administrative Patent Judge*.

ORDER
Granting Petitioner's Motions for Admission
Pro Hac Vice of Roger A. Denning
37 C.F.R. § 42.10

¹ Because this Order addresses issues that are the same in each of the proceedings, we issue one Order to be entered in each proceeding. The parties are not authorized to use this caption unless later permitted.

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On September 12, 2019, Petitioner filed Motions for Admission *Pro Hac Vice* of Roger A. Denning in the above-referenced proceedings (collectively, “Motions”). Paper 31.² Petitioner also filed Declarations of Mr. Denning in support of the Motions (collectively, “Declarations”). Ex. 1028. Petitioner represents that Patent Owner does not oppose the Motions. Paper 31, 1. For the reasons provided below, Petitioner’s Motions are *granted*.

Pursuant to 37 C.F.R. § 42.10(c), 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. In its notice authorizing motions for *pro hac vice* admission, the Board requires 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 this proceeding. *See* Paper 5, 2 (citing *Unified Patents, Inc. v. Parallel Iron, LLC*, Case IPR2013-00639 (PTAB Oct. 15, 2013) (Paper 7) (representative “Order – Authorizing Motion for *Pro Hac Vice* Admission”)).

Based on the facts set forth in the Motions and the accompanying Declarations, we conclude that Mr. Denning has sufficient legal and technical qualifications to represent Petitioner in the above-referenced proceedings, that Mr. Denning has demonstrated sufficient familiarity with the subject matter of the above-referenced proceedings, and that Petitioner’s

² Paper and exhibit numbers refer to IPR2018-01247. Corresponding Motions and Declarations were filed in IPR2018-01248 and IPR2018-01254.

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intent to be represented by counsel with litigation experience is warranted.³

Accordingly, Petitioner has established good cause for *pro hac vice* admission of Mr. Denning. Mr. Denning will be permitted to serve as back-up counsel only. See 37 C.F.R. § 42.10(c).

Petitioner's Power of Attorney does not list Mr. Denning as counsel. Paper 1. Accordingly, Petitioner must submit a Power of Attorney for Mr. Denning in accordance with 37 C.F.R. § 42.10(b), and must update its mandatory notices as required by 37 C.F.R. § 42.8(b)(3).

Accordingly, it is:

ORDERED that Petitioner's Motions for *pro hac vice* admission of Mr. Roger A. Denning are *granted*;

FURTHER ORDERED that Petitioner is to continue to have a registered practitioner represent it as lead counsel for the above-referenced proceedings;

FURTHER ORDERED that Mr. Denning is authorized to represent Petitioner only as back-up counsel in the above-referenced proceedings;

FURTHER ORDERED that Mr. Denning is to comply with the Office Patent Trial Practice Guide, as updated by the July 2019 Update, 84 Federal Register 33,925 (July 16, 2019), and the August 2018 Update,

³ The Declarations fail to attest Mr. Denning has sufficient familiarity with the subject matter of these proceedings (Ex. 1028), although this familiarity is indicated in the Motions (Paper 31, 1–2). We treat the omission in the Declarations as harmless error, as this familiarity is indicated in the Motions. However, we remind Petitioner that “a motion for *pro hac vice* admission must: . . . [b]e accompanied by an ***affidavit or declaration*** of the individual seeking to appear attesting to . . . [*inter alia*] . . . [f]amiliarity with the subject matter at issue in the proceeding.” Order – Authorizing Motion for *Pro Hac Vice* Admission, 3 (emphasis added).

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83 Federal Register 39,989 (Aug. 13, 2018), and the Board's Rules of Practice for Trials, as set forth in Part 42 of Title 37, Code of Federal Regulations;⁴

FURTHER ORDERED that Mr. Denning shall be subject to the Office's disciplinary jurisdiction under 37 C.F.R. § 11.19(a), and the USPTO Rules of Professional Conduct set forth in 37 C.F.R. §§ 11.101 *et. seq.*;

FURTHER ORDERED that, within ten (10) business days of the date of this Order, Petitioner must submit a Power of Attorney for Mr. Denning in the above-referenced proceedings in accordance with 37 C.F.R. § 42.10(b); and

FURTHER ORDERED that Petitioner shall file an updated Mandatory Notice in the above-referenced proceedings in accordance with 37 C.F.R. § 42.8(b)(3), identifying Mr. Denning as back-up counsel.

⁴ In the Declarations, Mr. Denning indicates compliance "with the Office Patent Trial Practice Guide and the Board's Rules of Practice for Trials set forth in Part 42 of *the* Code of Federal Regulations," as opposed to Part 42 of *Title 37*, Code of Federal Regulations. Ex. 1028 ¶ 8. We deem this harmless error.

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