

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

QUALCOMM INCORPORATED and
ZYXEL COMMUNICATIONS CORPORATION,¹
Petitioner,

v.

UNM RAINFOREST INNOVATIONS,
Patent Owner.

IPR2021-00375 (Patent 8,265,096 B2)
IPR2021-00377 (Patent 8,249,204 B2)
IPR2021-00582 (Patent 8,565,326 B2)²

Before KRISTEN L. DROESCH, BARBARA A. PARVIS, and
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

DROESCH, *Administrative Patent Judge*.

ORDER

Granting Patent Owner's Motions for *Pro Hac Vice*
Admission of Henning Schmidt and Cecil E. Key
37 C.F.R. § 42.10

¹ ZyXEL Communications Corporation was joined as a petitioner in these proceedings based on petitions and motions for joinder filed in IPR2021-00734, IPR2021-00739, and IPR2021-00741, respectively.

² This Order addresses overlapping issues in the cases listed above. Therefore, we issue one Order to be filed in each case. The parties, however, are not authorized to use this style of filing.

IPR2021-00375 (Patent 8,265,096 B2)
IPR2021-00377 (Patent 8,249,204 B2)
IPR2021-00582 (Patent 8,565,326 B2)

On April 28, 2022, Patent Owner filed Motions for *Pro Hac Vice* Admission of Henning Schmidt (Paper 52)³ and Cecil E. Key (Paper 53) in the above-captioned proceedings (collectively, “Motions”). Additionally, Patent Owner filed Declarations of Mr. Schmidt (Ex. 2016) and Mr. Key (Ex. 2017)⁴ in support of the Motions (collectively, “Declarations”). The Motions do not state if they are opposed, but Petitioner did not file an opposition to the Motions.

In accordance with 37 C.F.R. § 42.10(c), we 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. The representative Order authorizing motions for *pro hac vice* admission requires a statement of facts showing there is good cause for us to recognize counsel *pro hac vice*, and an affidavit or declaration of the individual seeking to appear. See Paper 5, 2 (citing *Unified Patents, Inc. v. Parallel Iron, LLC*, 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. Schmidt and Mr. Key have sufficient legal and technical qualifications to represent Patent Owner in the above-captioned proceedings, that Mr. Schmidt and Mr. Key have demonstrated sufficient familiarity with the subject matter of the proceedings, and that Mr. Schmidt and Mr. Key meet all other requirements for admission *pro hac*

³ Unless otherwise noted, we cite to the papers and exhibits filed in IPR2021-00375. Similar papers and exhibits were filed in IPR2021-00377 and IPR2021-00582.

⁴ Citations to Exhibit 2017 refer to the corrected version filed May 2, 2022.

IPR2021-00375 (Patent 8,265,096 B2)
IPR2021-00377 (Patent 8,249,204 B2)
IPR2021-00582 (Patent 8,565,326 B2)

vice. We further conclude that Patent Owner's interest in being represented in the above-captioned proceedings by counsel with litigation experience weighs in favor of granting the Motions. Accordingly, Patent Owner has established good cause for *pro hac vice* admission of Mr. Schmidt and Mr. Key. Mr. Schmidt and Mr. Key will be permitted to serve as back-up counsel only. *See* 37 C.F.R. §42.10(c).

We note that Patent Owner's Power of Attorney does not include Mr. Schmidt and Mr. Key. *See* Paper 7. Therefore, Patent Owner must submit a Power of Attorney for Mr. Schmidt and Mr. Key in accordance with 37 C.F.R. § 42.10(b). Patent Owner also must update its Mandatory Notices to identify Mr. Schmidt and Mr. Key in accordance with 37 C.F.R. § 42.8(b)(3). *See* Paper 6.

Accordingly, it is:

ORDERED that Patent Owner's Motions for *Pro Hac Vice* Admission of Henning Schmidt (IPR2021-00375, Paper 52; IPR2021-00377, Paper 50; IPR2021-00582, Paper 48) and Cecil E. Key (IPR2021-00375, Paper 53; IPR2021-00377, Paper 51; IPR2021-00582, Paper 49) are *granted*;

FURTHER ORDERED that, within one (1) business day of the date of this Order, Patent Owner must submit a Power of Attorney for Mr. Schmidt and Mr. Key in accordance with 37 C.F.R. § 42.10(b);

FURTHER ORDERED that Patent Owner must file updated Mandatory Notices identifying Mr. Schmidt and Mr. Key as back-up counsel in accordance with 37 C.F.R. § 42.8(b)(3);

FURTHER ORDERED that Mr. Schmidt and Mr. Key are authorized to represent Patent Owner only as back-up counsel in the above-captioned proceedings;

IPR2021-00375 (Patent 8,265,096 B2)
IPR2021-00377 (Patent 8,249,204 B2)
IPR2021-00582 (Patent 8,565,326 B2)

FURTHER ORDERED that Patent Owner is to continue to have a registered practitioner represent it as lead counsel in the above-captioned proceedings;

FURTHER ORDERED that Mr. Schmidt and Mr. Key are to comply with the Consolidated Trial Practice Guide⁵ (84 Fed. Reg. 64,280 (Nov. 21, 2019)), and the Board's Rules of Practice for Trials, as set forth in Part 42 of 37 C.F.R.;⁶ and

FURTHER ORDERED that Mr. Schmidt and Mr. Key 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.*

⁵ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

⁶ Each of the Declarations states "I have 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 C.F.R." Ex. 2016 ¶ 9; Ex. 2017 ¶ 9. The Office Patent Trial Practice Guide and the Board's Rules of Practice for Trials are set forth in Part 42 of *Title 37*, Code of Federal Regulations. We deem this harmless error.

IPR2021-00375 (Patent 8,265,096 B2)
IPR2021-00377 (Patent 8,249,204 B2)
IPR2021-00582 (Patent 8,565,326 B2)

PETITIONER:

Jonathan Detrixhe
Peter Chassman
REED SMITH LLP
jdetrixhe@reedsmith.com
pchassman@reedsmith.com

PATENT OWNER:

Jay Kesan
DIMUROGINSBERG, PC
DGKEYIP GROUP
jay@jaykesan.com

Alfonso Chan
SHORE CHAN LLP
achan@shorechan.com