

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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QUALCOMM INCORPORATED,  
Petitioner,

v.

UNM RAINFOREST INNOVATIONS,  
Patent Owner.

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IPR2021-00375 (Patent 8,265,096 B2)  
IPR2021-00377 (Patent 8,249,204 B2)  
IPR2021-00582 (Patent 8,565,326 B2)<sup>1</sup>

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

DROESCH, *Administrative Patent Judge*.

ORDER

Granting Petitioner's Motions for Admission *Pro Hac Vice*  
of Jonah D. Mitchell and Christine M. Morgan  
*37 C.F.R. § 42.10(c)*

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<sup>1</sup> This Order addresses issues that are the same in all above-captioned proceedings. We exercise our discretion to issue one Order to be filed in each proceeding. The parties are not authorized to use this style heading in subsequent papers.

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Petitioner filed motions for admission *pro hac vice* of Mr. Jonah D. Mitchell (Paper 16<sup>2</sup>) and Ms. Christine M. Morgan (Paper 17) in each of the above-captioned proceedings (collectively, “Motions”). The Motions are supported by Declarations of Mr. Mitchell (Ex. 1030) and Ms. Morgan (Ex. 1031). Petitioner represents that Patent Owner does not object to Mr. Mitchell (Paper 16, 5) and Mr. Kahn (Paper 17, 5) being admitted *pro hac vice* in the above-captioned proceedings.

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 these proceedings. *See* Paper 5, 2 (citing *Unified Patents, Inc. v. Parallel Iron, LLC*, IPR2013-00639, Paper 7 (PTAB Oct. 15, 2013) (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. Mitchell and Ms. Morgan have sufficient legal and technical qualifications to represent Petitioner in these proceedings, that Mr. Mitchell and Ms. Morgan have demonstrated sufficient familiarity with the subject matter of these proceedings, that Mr.

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<sup>2</sup> Paper and exhibit numbers refer to Proceeding IPR2021-00375. Corresponding papers and exhibits were filed in IPR2021-00377 and IPR2021-00582.

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Mitchell and Ms. Morgan meet all other requirements for admission *pro hac vice*, and that Petitioner's intent to be represented by counsel with litigation experience is warranted. Accordingly, Petitioner has established good cause for *pro hac vice* admission of Mr. Mitchell and Ms. Morgan. Mr. Mitchell and Ms. Morgan will be permitted to serve as back-up counsel only. See 37 C.F.R. § 42.10(c).

Accordingly, it is:

ORDERED that Petitioner's Motions for *pro hac vice* admission of Mr. Mitchell and Ms. Morgan are *granted*;

FURTHER ORDERED that Petitioner is to continue to have a registered practitioner represent it as lead counsel for these proceedings;

FURTHER ORDERED that Mr. Mitchell and Ms. Morgan are authorized to represent Petitioner as back-up counsel only in these proceedings;

FURTHER ORDERED that Mr. Mitchell and Ms. Morgan are to comply with the Consolidated Trial Practice Guide<sup>3</sup> (84 Fed. Reg. 64,280 (Nov. 21, 2019)), and the Board's Rules of Practice for Trials, as set forth in Part 42 of Title 37, Code of Federal Regulations; and

FURTHER ORDERED that Mr. Mitchell and Ms. Morgan 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.*

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<sup>3</sup> Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

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