

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VOLKSWAGEN GROUP OF AMERICA, INC.,
Petitioner,

v.

STRATOSAUDIO, INC.,
Patent Owner.

IPR2021-00712 (Patent 8,903,307 B2)
IPR2021-00716 (Patent 8,688,028 B2)
IPR2021-00720 (Patent 9,355,405 B2)
IPR2021-00721 (Patent 8,166,081 B2)¹

Before JUSTIN T. ARBES and HYUN J. JUNG, *Administrative Patent Judges*.

ARBES, *Administrative Patent Judge*.

ORDER

Granting Petitioner's Motions for *Pro Hac Vice* Admission
of Mark Hannemann and Thomas Makin
37 C.F.R. § 42.10(c)

¹ This Order addresses issues pertaining to all four cases. Therefore, we exercise our discretion to issue a single Order to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

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In each of the instant proceedings, Petitioner filed motions requesting *pro hac vice* admission of Mark Hannemann and Thomas Makin, along with supporting declarations from Mr. Hannemann and Mr. Makin.² Petitioner states that Patent Owner does not oppose the motions. *See* Paper 23, 1; Paper 24, 1. For the reasons stated below, Petitioner’s motions are *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 motions 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. Paper 3, 2 (citing *Unified Patents, Inc. v. Parallel Iron, LLC*, IPR2013-00639, Paper 7 (PTAB Oct. 15, 2013) (“Order – Authorizing Motion for *Pro Hac Vice* Admission”)).

In the motions, Petitioner asserts that there is good cause for *pro hac vice* admission because Mr. Hannemann and Mr. Makin (1) are “experienced

² Petitioner filed similar papers and exhibits in each of the instant proceedings. *See* IPR2021-00712, Papers 23, 24, Exs. 1016, 1017; IPR2021-00716, Papers 23, 24, Exs. 1010, 1011; IPR2021-00720, Papers 24, 25, Exs. 1015, 1016; IPR2021-00721, Papers 22, 23, Exs. 1013, 1014. We refer to those filed in Case IPR2021-00712 for convenience.

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litigating attorney[s],” and (2) have “an established familiarity with the subject matter at issue in th[ese] proceeding[s], having represented Petitioner . . . as a defendant in [the] related litigation” involving the challenged patents. *See* Paper 23, 1–3; Paper 24, 1–3. Mr. Hannemann and Mr. Makin attest to these facts in their declarations with sufficient explanation. *See* Exs. 1016, 1017.

Based on the facts set forth above, we conclude that Mr. Hannemann and Mr. Makin have sufficient legal and technical qualifications to represent Petitioner in these proceedings and that there is a need for Petitioner to have its counsel in the related litigation involved in these proceedings. *See* IPR2013-00639, Paper 7 (setting forth the requirements for *pro hac vice* admission). Accordingly, Petitioner has established good cause for the *pro hac vice* admission of Mr. Hannemann and Mr. Makin. Mr. Hannemann and Mr. Makin 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).

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner’s motions for *pro hac vice* admission of Mr. Hannemann and Mr. Makin in the instant proceedings are *granted*, and Mr. Hannemann and Mr. Makin are authorized to represent Petitioner as back-up counsel only in the instant proceedings;

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

FURTHER ORDERED that Mr. Hannemann and Mr. Makin are to comply with the Patent Trial and Appeal Board’s Consolidated Trial Practice Guide (November 2019), *available at* <https://www.uspto.gov/>

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TrialPracticeGuideConsolidated, 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. Hannemann and Mr. Makin 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 at 37 C.F.R.

§§ 11.101–11.901.

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