

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE, INC.,
Petitioner,

v.

ALIVECOR, INC.,
Patent Owner.

IPR2021-00970 (Patent 9,572,499 B2)
IPR2021-00971 (Patent 10,595,731 B2)
IPR2021-00972 (Patent 10,638,941 B2)

Before ROBERT A. POLLOCK, ERIC C. JESCHKE, and
DAVID COTTA, *Administrative Patent Judges*.

POLLOCK, *Administrative Patent Judge*.

DECISION¹

Conditionally Granting Patent Owner's Motions for
Admission *Pro Hac Vice* of Sean S. Pak
37 C.F.R. § 42.10

¹ This Decision addresses overlapping issues in the cases listed above. Therefore, we issue one Decision to be filed in each case. The parties, however, are not authorized to use this style of filing.

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On February 21, 2022, AliveCor, Inc. (“Patent Owner”) filed a Motion for admission *Pro Hac Vice* of Sean S. Pak in each of the above-identified proceedings. Paper 13 (“Motion”).² Patent Owner also filed a Declaration of Sean Pak in support of the Motion in each case. Paper 14 (“Declaration”).³ Petitioner has not filed an opposition to the Motions.

Upon a review of the record before us, we note that Powers of Attorney in accordance with 37 C.F.R. § 42.10(b) have not been submitted for Mr. Pak in these proceedings. For the reasons provided below, Patent Owner’s Motions are *conditionally granted*, subject to the filing of Powers of Attorney for Mr. Pak.

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 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”)).

² For purposes of expediency, we cite to Papers filed in IPR2021-00970. Patent Owner filed similar Motions in IPR2021-00971 and IPR2021-00972.

³ Patent Owner filed the Declarations as Papers. We deem this to be harmless error, however, Patent Owner is reminded that affidavits and declarations must be filed as exhibits. *See* 37 C.F.R. § 42.63(a) (“Evidence consists of affidavits, transcripts of depositions, documents, and things. All evidence must be filed in the form of an exhibit.”).

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Based on the facts set forth in the Motions and the accompanying Declarations, we conclude that Mr. Pak has sufficient legal and technical qualifications to represent Patent Owner in the above-identified proceedings, that Mr. Pak has demonstrated sufficient familiarity with the subject matter of these proceedings, that Mr. Pak meets all other requirements for admission *pro hac vice*, and that Patent Owner's intent to be represented by counsel with litigation experience is warranted. Accordingly, Patent Owner has established good cause for *pro hac vice* admission of Mr. Pak. Mr. Pak will be permitted to serve as back-up counsel only. *See* 37 C.F.R. § 42.10(c).

We note that Patent Owner has filed Updated Mandatory Notices identifying Mr. Pak as back-up counsel in accordance with 37 C.F.R. § 42.8(b)(3). Paper 15. However, Powers of Attorney in accordance with 37 C.F.R. § 42.10(b) have not been submitted for Mr. Pak. Mr. Pak will not be admitted until Patent Owner files Powers of Attorney identifying Mr. Pak.

ORDER

It is:

ORDERED that Patent Owner's Motions for Admission *Pro Hac Vice* of Sean Pak are *conditionally granted* provided that within ten (10) days of the date of this Order, Patent Owner submits Powers of Attorney for Mr. Pak in each proceeding, in accordance with 37 C.F.R. § 42.10(b);

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

FURTHER ORDERED that Mr. Pak will be authorized to represent Patent Owner only as back-up counsel in the above-identified proceedings;

FURTHER ORDERED that Mr. Pak shall be familiar with the Consolidated Trial Practice Guide⁴ (84 Fed. Reg. 64,280 (Nov. 21, 2019)), and comply with 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. Pak 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.*

⁴ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

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