

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EP FAMILY CORP.,
Petitioner,

v.

OFFICE KICK, INC.,
Patent Owner.

IPR2025-00471 (Patent 11,849,843 B1)
IPR2025-00497 (Patent 11,910,926 B1)¹

Before JAMES A. WORTH, KARA L. SZPONDOWSKI, and
BRENT M. DOUGAL, *Administrative Patent Judges*.

DOUGAL, *Administrative Patent Judge*.

DECISION
Granting Petitioner's Motions for Admission Pro Hac Vice
of Joshua G. Simon
37 C.F.R. § 42.10

¹ This Order applies to each of the listed cases. We exercise our discretion to issue one Order to be docketed in each case. The parties, however, are not authorized to use this caption for any subsequent papers.

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Petitioner submitted a Motion for *pro hac vice* admission of Joshua G. Simon in each of the above-identified proceedings. Paper 9 (“Motions”).² The Motions are supported by Declarations of Mr. Simon that were filed with the Motions (“Declarations”).³ Patent Owner did not oppose the Motions within the requisite time period.

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. Good cause is shown by an appropriate statement of facts, and an affidavit or declaration of the individual seeking to appear. *See Unified Patents, Inc. v. Parallel Iron, LLC*, IPR2013- 00639, Paper 7 (PTAB Oct. 15, 2013) (setting forth requirements for admission *pro hac vice*).

Based on the facts set forth in the Motions and the accompanying Declarations, we conclude that Mr. Simon has sufficient legal and technical qualifications to represent Petitioner in these proceedings, that Mr. Simon has demonstrated sufficient familiarity with the subject matter of these proceedings, and that Petitioner’s desire to be represented by counsel with litigation experience is warranted. Accordingly, Petitioner has established

² For expediency, this Order cites only to papers filed in IPR2025-00471. Similar papers were also filed in IPR2022-00497.

³ Petitioner filed the Declarations with the Motions as a single paper instead of filing the Declarations separately as exhibits. We excuse this mistake on this occasion, but remind the parties 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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good cause for *pro hac vice* admission of Mr. Simon.

Upon review of the record before us, we note that a Power of Attorney in accordance with 37 C.F.R. § 42.10(b) has been submitted for Mr. Simon. Paper 1. Petitioner has also filed Mandatory Notices identifying Mr. Simon as back-up counsel. Paper 2, 14.

Accordingly, it is

ORDERED that Petitioner's Motions for *pro hac vice* admission of Joshua G. Simon 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. Simon is authorized to represent Petitioner only as back-up counsel in these proceedings, in accordance with 37 C.F.R. § 42.10(c);

FURTHER ORDERED that Mr. Simon shall comply with the Office Patent Trial Practice Guide, as updated by the Office Patent Trial Practice Guide⁴ (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 37⁴ of the Code of Federal Regulations; and

FURTHER ORDERED that Mr. Simon 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 The Declarations state that Mr. Simon has “read and will comply with the Office Patent Trial Practice Guide and the Board's Rules of Practice for Trials, as set for[th] in part 42 of the C.F.R.” Declarations ¶ 9. We note, however, that the Board's Rules of Practice for Trials are set forth in Part 42 of 37 C.F.R., and it is those rules to which Mr. Simon will be subject.

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