

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.
Petitioner

v.

SIGHTSOUND TECHNOLOGIES, LLC
Patent Owner

Case CBM2013-00020
Patent 5,191,573

Before MICHAEL P. TIERNEY, JUSTIN T. ARBES, and
GEORGIANNA W. BRADEN, *Administrative Patent Judges*.

ARBES, *Administrative Patent Judge*.

DECISION

Petitioner's Motion for *Pro Hac Vice* Admission of James R. Batchelder
37 C.F.R. § 42.10

Petitioner filed a motion requesting *pro hac vice* admission of James
R. Batchelder and provided a declaration from Mr. Batchelder in support of

its request.¹ Paper 23. Patent Owner did not file an opposition to the motion. For the reasons stated below, Petitioner's motion is *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 5 (referencing the “Order – Authorizing Motion for *Pro Hac Vice* Admission,” Paper 6 in IPR2013-00010, at 3-4).

In its motion, Petitioner argues that there is good cause for Mr. Batchelder's *pro hac vice* admission because he is an experienced litigation attorney and has an established familiarity with the subject matter at issue in this proceeding. Paper 23 at 2-3. Specifically, Mr. Batchelder is lead counsel for Petitioner in the related litigation involving the patent being challenged in this proceeding, and has been “heavily involved with forming non-infringement and invalidity positions against” the challenged patent. *Id.* at 3. Petitioner states that given Mr. Batchelder's involvement in the related

¹ Petitioner filed its motion and declaration as one document in the Patent Review Processing System (PRPS). In the future, the parties should file exhibits separately from other papers, such as motions, so that they may be referenced individually by number. *See* 37 C.F.R. § 42.63.

litigation, there is a need for him to act as counsel for Petitioner in this proceeding as well. *Id.* In his declaration, Mr. Batchelder attests that:

- (1) he is “a member in good standing of the Bar of California”;
- (2) he has “never been suspended or disbarred from practice before any court or administrative body,” has “never been denied an application for admission to practice before any court or administrative body,” and “[n]o sanction or contempt citation has ever been imposed against [him] by any court or administrative body”;
- (3) he has “read and will comply with the Office Patent Trial Practice Guide and the Board’s Rules of Practice for Trials set forth in part 42 of [Title 37 of] the Code of Federal Regulations,” and agrees to be “subject to the USPTO Rules of Professional Conduct set forth in 37 C.F.R. §§ 11.101 *et seq.* and disciplinary jurisdiction under 37 C.F.R. § 11.19(a)”;
- (4) he has not “applied to appear *pro hac vice* before the Office in any other matters,” other than related Case CBM2013-00023;
- (5) he has been “practicing law since 1988 and [has] extensive experience litigating patent infringement cases”; and
- (6) he has “represented [Petitioner] against [Patent Owner] as lead counsel in the pending District Court litigation since shortly after October 2011,” and has been “heavily involved with forming non-infringement and invalidity positions against [the challenged patent] and related patents.”

See Paper 23, Declaration of James R. Batchelder in Support of Motion for *Pro Hac Vice* Admission ¶¶ 1-8. Also, Petitioner’s lead counsel, J. Steven Baughman, is a registered practitioner.

Based on the facts set forth above, we conclude that Mr. Batchelder has sufficient legal and technical qualifications to represent Petitioner in this proceeding and that there is a need for Petitioner to have its counsel in the related litigation involved in this proceeding. *See* IPR2013-00639, Paper 7, dated October 15, 2013 (superseding IPR2013-00010, Paper 6, dated

Case CBM2013-00020
Patent 5,191,573

October 15, 2012, and setting forth the requirements for *pro hac vice* admission) (copy available on the Board Web site under “Representative Orders, Decisions, and Notices”). Accordingly, Petitioner has established good cause for Mr. Batchelder’s *pro hac vice* admission. Mr. Batchelder will be permitted to appear *pro hac vice* in the instant proceeding 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 motion for *pro hac vice* admission of James R. Batchelder is granted and Mr. Batchelder is authorized to represent Petitioner as back-up counsel;

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

FURTHER ORDERED that Mr. Batchelder is to comply with the Office Patent Trial Practice Guide and the Board’s Rules of Practice for Trials, as set forth in Title 37, Part 42 of the Code of Federal Regulations; and

FURTHER ORDERED that Mr. Batchelder is subject to the USPTO Rules of Professional Conduct set forth in 37 C.F.R. §§ 11.101 *et seq.* and the Office’s disciplinary jurisdiction under 37 C.F.R. § 11.19(a).

Case CBM2013-00020

Patent 5,191,573

PETITIONER:

J. Steven Baughman

Ching-Lee Fukuda

ROPES & GRAY LLP

steven.baughman@ropesgray.com

ching-lee.fukuda@ropesgray.com

PATENT OWNER:

David R. Marsh

Kristan L. Lansbery

ARNOLD & PORTER LLP

david.marsh@aporter.com

kristan.lansbery@aporter.com