

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)
Case CBM2013-00023 (Patent 5,966,440)¹

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
Lauren N. Robinson
37 C.F.R. § 42.10

¹ This Decision addresses an issue pertaining to both cases. Therefore, we exercise our discretion to issue one Decision 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 a motion requesting *pro hac vice* admission of Lauren N. Robinson and provided a declaration from Ms. Robinson in support of the request.² *See* CBM2013-00020, Paper 55; CBM2013-00023, Paper 52. Patent Owner did not file an opposition to either of the motions. For the reasons stated below, Petitioner’s motions are *granted*. As the motions and declarations in the two proceedings are substantially similar, we will refer herein to the papers filed in Case CBM2013-00020 for convenience.

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).

² Petitioner filed each motion and declaration as a single document in the Patent Review Processing System (PRPS). Petitioner is reminded that exhibits (e.g., declarations) should be filed separately from other papers, such as motions, so that they may be referenced individually by number. *See* CBM2013-00020, Paper 39 at n.1; CBM2013-00023, Paper 35 at n.1; 37 C.F.R. § 42.63.

In its motions, Petitioner argues that there is good cause for Ms. Robinson's *pro hac vice* admission because she is an experienced litigation attorney and she has an established familiarity with the subject matter at issue in these proceedings. Paper 55 at 2-3. Specifically, Ms. Robinson is counsel for Petitioner in the related litigation involving the patents being challenged in the instant proceedings, and has been "heavily involved with forming invalidity positions against" the challenged patents. *Id.* at 3. Petitioner states that given Ms. Robinson's involvement in the related litigation, Petitioner prefers for her to act as counsel in these proceedings as well. *Id.* In her declaration, Ms. Robinson attests that:

- (1) she is "a member in good standing of the Bar of California";
- (2) she has "never been suspended or disbarred from practice before any court or administrative body" and "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 [her] by any court or administrative body";
- (3) she 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 understands that she "will 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) in the last three years, she has "not applied to appear *pro hac vice* before the Office" in any proceeding other than the instant proceedings;
- (5) she has been "practicing law since 2008 and [has] extensive experience litigating patent infringement cases"; and
- (6) she has "represented [Petitioner] against [Patent Owner] in the pending District Court litigation since 2012," and has been

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“heavily involved with forming invalidity positions against [the challenged patents] and related patents.”

See Paper 55, Declaration of Lauren N. Robinson 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 Ms. Robinson has 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 *Unified Patents, Inc. v. Parallel Iron, LLC*, IPR2013-00639, Paper 7 (Oct. 15, 2013) (superseding IPR2013-00010, Paper 6, dated 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 Ms. Robinson’s *pro hac vice* admission. Ms. Robinson 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 Lauren N. Robinson in the instant proceedings are granted and Ms. Robinson is authorized to represent Petitioner as back-up counsel 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 Ms. Robinson 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

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FURTHER ORDERED that Ms. Robinson 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).

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