

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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KYOCERA CORPORATION  
MOTORLOA MOBILITY LLC  
Petitioner

v.

SOFTVIEW LLC  
Patent Owner

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Case IPR2013-00007  
Patent 7,461,353

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Before BRIAN J. McNAMARA, *Administrative Patent Judge*.

**ORDER GRANTNG MOTION FOR ADMISSION PRO HAC VICE OF  
MORGAN CHU**

***37 C.F.R. § 42.10***

Softview LLC (Patent Owner) moves for the *pro hac vice* admission of attorney Morgan Chu in accordance with 37 CFR 42.10. (Motion, Paper No 23, filed July 8, 2013). The Motion is unopposed. We grant the Motion.

### **I. Discussion**

As set forth in 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. 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.” 37 C.F.R. § 42.10(c). In authorizing motions for *pro hac vice* admission, the Board also requires a statement of facts showing, among other requirements, that 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 8, referencing the “Order – Authorizing Motion for *Pro Hac Vice* Admission” in IPR2013-00010, at 3-4.)

Patent Owner represents and provides testimony from Morgan Chu indicating that Morgan Chu is an experienced litigating attorney who has litigated patent cases for 35 years. (Ex. 2001). Moreover, Morgan Chu testifies that he has particular familiarity with the subject matter at issue in the proceeding, as he is

lead trial counsel for Patent Owner in the pending case, *Softview LLC v. Kyocera Corp., et al.*, Civil Action No. 1:12-cv-00989-LPS (D. Del. Filed July 26, 2012), which Patent Owner represents involves the same patent at issue in the current proceeding. (Ex. 2001).

Patent Owner has shown good cause why Morgan Chu should be recognized *pro hac vice* for purposes of this proceeding. The unchallenged testimony of Morgan Chu establishes on this record that Morgan Chu is an experienced attorney who is familiar with patent litigation and the subject matter at issue and who is otherwise qualified to appear before the Board in this proceeding. Moreover, Morgan Chu's familiarity with the subject matter of, and involvement in litigation related to, the present proceeding supports a determination that Patent Owner has a sufficient need for Morgan Chu's admission. Patent Owner, through the testimony of Morgan Chu (Ex. 2001), has otherwise complied with the requirements for admission.

## **II. Order**

It is

ORDERED that the Motion seeking admission *pro hac vice* for Morgan Chu is GRANTED;

FURTHER ORDERED that Morgan Chu may not act as lead counsel in the proceeding;

FURTHER ORDERED that a registered practitioner must remain as lead counsel throughout the proceeding; and

**FURTHER ORDERED** that Morgan Chu is to comply with the Office Patent Trial Practice Guide and the Board's Rules of Practice for Trials, as set forth in Part 42 of the C.F.R.; and

**FURTHER ORDERED** that Morgan Chu is to 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.*, which took effect on May 3, 2013.

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