

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EMC CORPORATION
Petitioner,

v.

PERSONALWEB TECHNOLOGIES, LLC
Patent Owner.

Case IPR2013-00082 (Patent 5,978,791)
IPR2013-00083 (Patent 6,415,280)
IPR2013-00084 (Patent 7,945,544)
IPR2013-00085 (Patent 7,945,539)
IPR2013-00086 (Patent 7,949,662)
IPR2013-00087 (Patent 8,001,096)¹

Before KEVIN F. TURNER, JONI Y. CHANG, and
MICHAEL R. ZECHER, *Administrative Patent Judges*.

ZECHER, *Administrative Patent Judge*.

DECISION

EMC Motion for *Pro Hac Vice* Admission of Mr. Robert Galvin
37 C.F.R. § 42.10

¹ This Decision addresses an issue that is identical in all six cases. Therefore, we exercise our discretion to issue one opinion to be filed in each of the six cases. The parties, however, are not authorized to use this style heading in any subsequent papers. Note that the Petitioners for IPR2013-00082 and IPR2013-00083 are EMC Corporation and VMware, Inc.

IPR2013-00082, Patent 5,978,791
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Petitioner EMC Corporation (“EMC”) requests *pro hac vice* admission of Mr. Robert Galvin. Paper 42.² EMC provides an affidavit from Mr. Galvin in support of its motion. Ex. 1073.³ In a separate correspondence with the Board, Patent Owner PersonalWeb Technologies, LLC (“PersonalWeb”) indicated that it would not oppose EMC’s *pro hac vice* motion. For the reasons stated below, EMC’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. Papers 9 and 32 (referencing the “Order – Authorizing Motion for *Pro Hac Vice* Admission,” Paper 8 in IPR2013-00010, at 3-4).

In its motion, EMC argues that there is good cause for Mr. Galvin’s *pro hac vice* admission because he is an experienced litigation attorney and

² For purposes of expediency, we refer to the documents filed in IPR2013-00082. However, equivalent documents have been filed in the other five IPRs, *i.e.*, IPR2013-00083, IPR2013-00084, IPR2013-00085, IPR2013-00086, and IPR2013-00087.

³ See *supra* FN 2.

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IPR2013-00085, Patent 7,945,539

IPR2013-00083, Patent 6,415,280

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IPR2013-00087, Patent 8,001,096

has an established familiarity with the subject matter at issue in these *inter partes* reviews. Paper 42 at 3-4. Specifically, Mr. Galvin is counsel for EMC in *PersonalWeb Technologies LLC v. EMC Corporation and VMware, Inc.*, Case No. 6:11-cv-00660-LED (E.D. Tex.), where the patents being challenged in these *inter partes* reviews are being asserted. *Id.*; Ex. 1073,

¶ 10. In his declaration, Mr. Galvin attests that:

- (1) he is “a member in good standing of the Bar of the State of California”;
- (2) he has “not been suspended, disbarred, sanctioned or cited from contempt by any court or administrative body,” and has “never had a court or administrative body deny [his] application for admission to practice”;
- (3) he has “read and will 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 agrees to be “subject to the United States Patent and Trademark Office Code of Professional Responsibility set forth in 37 C.F.R. §§ 11.100 *et seq.* (78 Fed. Reg. 20202-20211) and disciplinary jurisdiction under 37 C.F.R. § 11.19(a)”;
- (4) he has “practic[ed] law for over nineteen years, and litigat[ed] patent cases for over eighteen years. Several of these patent litigations concerned patent office rules and regulations”; and
- (5) he is familiar with “the prior art references that are the subject of [these] proceeding[s] as well as the evidentiary objections that PersonalWeb has raised in response to certain prior art references submitted by [EMC],” and he is familiar with “the subject of the references as well as the relevant facts relating to their authenticity, admissibility, and publication.”

Ex. 1073, ¶¶ 2-11. We also note that EMC’s lead counsel in this proceeding, Peter Dichiara, is a registered practitioner. Paper 42 at 2.

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Based on the facts set forth above, we conclude that Mr. Galvin has sufficient legal and technical qualifications to represent EMC in these *inter parte* reviews and that there is a need for EMC to have its counsel in the related litigation involved in such proceedings. Accordingly, EMC has established good cause for Mr. Galvin's *pro hac vice* admission. Mr. Galvin will be permitted to appear *pro hac vice* in these *inter partes* reviews as back-up counsel only. *See* 37 C.F.R. § 42.10(c).

Accordingly, it is:

ORDERED that EMC's motion for *pro hac vice* admission is granted and Mr. Robert Galvin is authorized to represent EMC as back-up counsel in the six *inter partes* reviews set forth above;

FURTHER ORDERED that EMC is to continue to have a registered practitioner as lead counsel in these *inter partes* reviews;

FURTHER ORDERED that Mr. Galvin 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. Galvin is 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.*

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