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Paper 18
Entered: February 22, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY CORPORATION OF AMERICA; AXIS COMMUNICATIONS AB; and AXIS COMMUNICATIONS INC.
Petitioners

v.

NETWORK-1 SECURITY SOLUTIONS, INC.
Patent Owner

Case IPR2013-00092
Patent 6,218,930

Before JAMESON LEE, JONI Y. CHANG, and JUSTIN T. ARBES, *Administrative Patent Judges.*

ARBES, *Administrative Patent Judge.*

DECISION
Network-1 Motion for *Pro Hac Vice* Admission of Greg Dovel
37 C.F.R. § 42.10

Patent Owner Network-1 Security Solutions, Inc. ("Network-1") requests *pro hac vice* admission of Mr. Greg Dovel. Paper 13. Network-1 provides a declaration from Mr. Dovel in support of its request. Ex. 2001. Petitioners oppose Network-1's motion. Paper 16. For the reasons stated

below, Network-1'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 9 (referencing the "Order – Authorizing Motion for *Pro Hac Vice* Admission" in IPR2013-00010, at 3-4).

In its motion, Network-1 argues that there is good cause for Mr. Dovel's *pro hac vice* admission because Mr. Dovel is an experienced litigation attorney and has been involved in numerous patent infringement cases. Paper 13 at 1-2. Network-1 also asserts that as its lead counsel in two litigations where Patent 6,218,930 (the "'930 patent") – the patent being challenged in this proceeding – was asserted, Mr. Dovel has an established familiarity with the subject matter at issue in this proceeding. *Id*. at 2-3. In particular, Network-1 states that Mr. Dovel is lead counsel in *Network-1 Security Solutions, Inc. v. Alcatel-Lucent USA Inc., et al.*, E.D. Tex. Case No. 6:11-cv-00492-LED-JDL (the "pending litigation"), filed in 2011 and currently pending, and was lead counsel in *Network-1 Security Solutions, Inc. v. Cisco Systems, Inc., et al.*, E.D. Tex. Case No. 6:08-cv-00030-LED

(the "Cisco litigation"), which has settled. Paper 13 at 2.

In his declaration, Mr. Dovel attests that:

(1) he has "been primarily litigating patent cases since 2000," has "been lead counsel on over 30 patent cases" and "litigated a number of them through trial," and has "conducted oral arguments on 6 patent cases before the Federal Circuit";

(2) in the Cisco litigation, he "conduct[ed] the *Markman* hearing," "depos[ed] the Defendant's technical expert relating to the validity of the '930 Patent," and tried the case to a jury, including "opening statement, direct examination of Network-1's technical expert and cross-examination of the Defendant's technical expert," before the case settled on the fourth day of trial;

(3) he is a "member in good standing of the Bar of the State of California and . . . admitted to practice before the United States Supreme Court, United States Courts of Appeals for the Ninth Circuit and the Federal Circuit, and six federal District Courts";

(4) he has "never been suspended, disbarred, sanctioned or cited for contempt by any court or administrative body";

(5) he has "never had a court or administrative body deny [his] application for admission to practice" and has "never had sanctions or contempt citations imposed on [him] by any court or administrative body"; and

(6) 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. § § 10.20 *et seq*. and disciplinary jurisdiction under 37 C.F.R. § 11.19(a)," and "agree[s] to be subject to the United States Patent and Trademark Office Code of Professional Responsibility set forth in 37 C.F.R. § § 10.20 *et seq*. and disciplinary jurisdiction under 37 C.F.R. § 11.19(a)."

Ex. 2001 ¶¶ 2, 7-13.

Based on the facts set forth above, we find that Mr. Dovel is competent to represent Network-1 in this proceeding and that there is a need

for Network-1 to have its lead counsel in the litigations involved in this proceeding. We turn now to Petitioners' arguments as to why good cause does not exist for Mr. Dovel's *pro hac vice* admission.

Petitioners make three arguments. First, Petitioners argue that a Stipulated Protective Order (Ex. 1016) in the pending litigation prohibits Mr. Dovel from being "counsel of record" in this proceeding and from divulging confidential information received from the defendants, including Petitioners, to Network-1's other counsel in this proceeding. Paper 16 at 3-6. Petitioners cite the following portion of the Stipulated Protective Order:

> [Network-1] shall create an ethical wall between those persons with access to technical information (e.g., information relating to the functionality of the disclosing parties' products rather than confidential economic information relating to such products) designated "CONFIDENTIAL" or "HIGHLY CONFIDENTIAL" and those individuals who prepare, prosecute, supervise, or assist in the prosecution of any patent application pertaining to Power over Ethernet technology. Outside litigation counsel for [Network-1] who obtains, receives, accesses, or otherwise learns of, in whole or in part, technical information designated "CONFIDENTIAL" or "HIGHLY CONFIDENTIAL," however, may participate in any reexamination proceeding of the patent at issue in this Action, except that outside counsel for [Network-1] *may not act as counsel of record in any reexamination proceeding and may not reveal the contents of any "CONFIDENTIAL" or "HIGHLY CONFIDENTIAL" information to reexamination patent counsel or agents*.

Ex. 1016 ¶ 12 (emphasis added). According to Petitioners, the language of the protective order applies to Mr. Dovel in this *inter partes* review proceeding because "the phrase '*any* reexamination proceeding' is used broadly to encompass all forms of Patent Office proceedings (e.g., *ex parte* or *inter partes*) involving the '930 patent" and "*inter partes* review is the

successor of *inter partes* reexamination." Paper 16 at 3-6 & n.2. Petitioners also cite paragraph 23 of the protective order, which states that "Confidential Materials shall be used solely for the purposes of [the pending litigation]," and argue that there would be "an unacceptably high risk of improper use or disclosure" of Petitioners' confidential information if Mr. Dovel is permitted to appear in this proceeding. *Id*. at 4-6 (citing Ex. 1016 ¶ 23).

We disagree that the presence of the protective order in the pending litigation means there is not good cause to recognize Mr. Dovel *pro hac vice*. An *inter partes* review proceeding is not a reexamination proceeding. In an *inter partes* review proceeding, a petitioner files a petition "request[ing] to cancel as unpatentable 1 or more claims of a patent." 35 U.S.C. § 311. An *inter partes* review is an administrative trial (i.e., a "contested case instituted by the Board based upon a petition") conducted by the Board according to Board rules. 37 C.F.R. §§ 42.2, 42.100(a), 42.100-.123. By contrast, reexaminations are another examination of the claims of a patent and are conducted by a patent examiner according to the procedures established for initial examination. *See, e.g.*, 37 C.F.R. §§ 1.510-.565. Consequently, on its face the protective order's prohibition on certain litigation counsel acting as counsel of record in "any reexamination proceeding" of the '930 patent and revealing confidential information to "reexamination" counsel does not apply to this proceeding.

Further, we do not agree with Petitioners that the "risk" that Mr. Dovel might violate the protective order by receiving and improperly using or disclosing confidential information in this proceeding justifies denying his *pro hac vice* admission. *See* Paper 16 at 6. Petitioners have not established any violation of the protective order by Mr. Dovel that would indicate a lack

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