

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PNY TECHNOLOGIES, INC.
Petitioner

v.

PHISON ELECTRONICS CORP.
Patent Owner

Case IPR2013-00472¹
Patent 7,518,879

Before KEVIN F. TURNER, STEPHEN C. SIU, and
RAMA G. ELLURU, *Administrative Patent Judges*.

TURNER, *Administrative Patent Judge*.

DECISION
Patent Owner's Motion for *Pro Hac Vice* Admission of David M. Barkan
37 C.F.R. § 42.10

¹ Case IPR2014-00150 has been joined with this proceeding.

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Phison Electronics Corp. (“Patent Owner”) filed a motion for *pro hac vice* admission of Mr. David M. Barkan. Paper 21. PNY Technologies, Inc. (“Petitioner”) did not file an opposition to the motion. For the reasons provided below, Patent Owner’s motion is *granted*.

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 required 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 in this proceeding. Paper 4 at 2 (referencing the “Order – Authorizing Motion for *Pro Hac Vice* Admission” in IPR2013-00010, Paper 8); *see also* IPR2013-00639, Paper 7² (setting forth requirements for *pro hac vice* admission).

In its motion, Patent Owner asserts that there is good cause for Mr. Barkan’s *pro hac vice* admission because: (1) Mr. Barkan is an experienced litigation attorney and has been involved in numerous patent litigations in

² Available at http://www.uspto.gov/ip/boards/bpai/ptab_trials.jsp, “Representative Orders, Decisions, and Notices,” “Other Representative Orders and Decisions”). Supersedes IPR2013-00010, “Order – Authorizing Motion for *Pro Hac Vice* Admission,” Paper 8.

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federal court and in the US International Trade Commission; (2) Mr. Barkan has represented Patent Owner as lead counsel in numerous matters involving the patent-at-issue, the most recent of which is currently stayed pending the outcome of this proceeding; and (3) Mr. Barkan has an established familiarity with the patent-at-issue, the relevant prior art and the legal and factual arguments, and has kept abreast of developments in this proceeding. Paper 21 at 1-3. In support of the motion, Mr. Barkan attests to these facts in his declaration with sufficient explanations. Ex. 2007 at 2-4 (Affidavit of David M. Barkan In Support of Patent Owner's Motion for *Pro Hac Vice* Admission). Additionally, the motion and Mr. Barkan's declaration comply with the requirements set forth in the Board's order authorizing Patent Owner's motion for *pro hac vice* admission.

Based on the record, we find that Mr. Barkan has sufficient legal and technical qualifications to represent Patent Owner in the instant proceeding. Accordingly, Patent Owner has established that there is good cause for Mr. Barkan's admission. Mr. Barkan will be permitted to appear *pro hac vice* in this proceeding as back-up counsel only. See 37 C.F.R. § 42.10(c).

For the foregoing reasons, it is

ORDERED that Patent Owner's motion for *pro hac vice* admission of Mr. Barkan for the instant proceeding is granted; Mr. Barkan is authorized to represent Patent Owner as back-up counsel in the instant proceeding;

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

FURTHER ORDERED that Mr. Barkan is to comply with the Office Patent Trial Practice Guide and the Board's Rules of Practice for Trials, as

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set forth in Title 37, Part 42 of the C.F.R., and 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.*

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