

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION.
Petitioner

v.

B.E. TECHNOLOGY, L.L.C.
Patent Owner

Case IPR2014-00039 (Patent 6,628,314 B1)
Case IPR2014-00040 (Patent 6,771,290 B1)¹

Before SALLY C. MEDLEY, KALYAN K. DESHPANDE, and
LYNNE E. PETTIGREW, *Administrative Patent Judges*.

MEDLEY, *Administrative Patent Judge*.

DECISION
Motion for *Pro Hac Vice* Admission
37 C.F.R. § 42.10

¹ This decision addresses motions for *pro hac vice* admission submitted in both cases. We exercise our discretion to issue one decision to be entered in each case. The parties are not authorized to use this heading style without authorization from the Board.

Case IPR2014-00039 (Patent 6,628,314 B1)

Case IPR2014-00040 (Patent 6,771,290 B1)

On May 12, 2014, Patent Owner, B.E. Technology, LLC (hereinafter “Patent Owner” or “B.E. Technology”), filed motions for *pro hac vice* admission of Mr. Robert E. Freitas. IPR2014-00039, Paper 19; IPR2014-00040, Paper 18.² The motions are unopposed.³ For the reasons provided below, B.E. Technology’s motions are *granted*.

Pursuant to 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. In authorizing motions for *pro hac vice* admission, the Board requires the moving party to provide a statement of facts showing 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, Notice of Filing Date Accorded to Petition, 3 (incorporating requirements in the “Order – Authorizing Motion for *Pro Hac Vice* Admission” in IPR2013-00010).

In the above-identified proceedings, lead counsel for B.E. Technology, Mr. Jason Angell, is a registered practitioner. B.E. Technology’s motion indicates that there is good cause for the Board to recognize Mr. Freitas *pro hac vice* during these proceedings, and is supported by the declarations of Mr. Freitas. Paper 19.

In particular, Mr. Freitas declares that he is an experienced litigation attorney and has served as counsel in numerous patent infringement cases in

² For the purpose of clarity and expediency, we treat IPR2014-00039 as representative, and all citations are to IPR2014-00039 unless otherwise noted.

³ Petitioner, Microsoft Corporation, did not file an opposition within one week from the filing of B.E. Technology’s motion.

Case IPR2014-00039 (Patent 6,628,314 B1)
Case IPR2014-00040 (Patent 6,771,290 B1)

various district courts and the International Trade Commission. Declaration, ¶ 9.⁴ Mr. Freitas is also counsel for B.E. Technology in a co-pending litigation, B.E. Technology, L.L.C. v. Microsoft Corporation., No. 2:12-cv-02829, which involves U.S. Patent No. 6,628,314. *Id.*, ¶ 10.

Further, Mr. Freitas has reviewed and is familiar with the asserted patent, prior art references, claim construction issues, and invalidity contentions in the co-pending litigation. The motions and declarations comply with the requirements set forth in the Notice, as well as the updated requirements set forth in the Board's order authorizing *pro hac vice* admission.

Upon consideration, Patent Owner has demonstrated that Mr. Freitas possesses sufficient legal and technical qualifications to represent Patent Owner in these proceedings, and the Board recognizes that there is a need for Patent Owner to have related litigation counsel involved. Accordingly, Patent Owner has established good cause for Mr. Freitas's admission. Mr. Freitas will be permitted to appear *pro hac vice* in these proceedings as back-up counsel only. See 37 C.F.R. § 42.10(c).

For the foregoing reasons, it is

ORDERED that Patent Owner's motions for *pro hac vice* admission of Mr. Robert E. Freitas for these proceedings are *granted*;

FURTHER ORDERED that Mr. Freitas is authorized to represent Patent Owner as back-up counsel;

⁴ The Declaration should have been filed as an exhibit and not as a motion attachment. 37 C.F.R. § 42.63(a).

Case IPR2014-00039 (Patent 6,628,314 B1)

Case IPR2014-00040 (Patent 6,771,290 B1)

FURTHER ORDERED that Patent Owner is to continue to have a registered practitioner represent Patent Owner as lead counsel for these proceedings; and

FURTHER ORDERED that Mr. Freitas 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 Title 37, Code of Federal Regulations, and to be subject to the Office's disciplinary jurisdiction under 37 C.F.R. § 11.19(a) and the USPTO Rules of Professional Conduct⁵ set forth in 37 C.F.R. §§ 11.101 et seq.

⁵ Mr. Freitas incorrectly refers to this title as the "USPTO Code of Professional Responsibility." Declaration, ¶ 7.

Case IPR2014-00039 (Patent 6,628,314 B1)
Case IPR2014-00040 (Patent 6,771,290 B1)

FOR PETITIONER:

Jeffrey P. Kushan
Scott M. Border
Sidley Austin LLP
jkushan@sidley.com
sborder@sidley.com

FOR PATENT OWNER:

Jason S. Angell
Robert E. Freitas
Freitas Tseng & Kaufman LLP
jangell@ftklaw.com
rfreitas@ftklaw.com