

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION
Petitioner,

v.

B.E. TECHNOLOGY, LLC
Patent Owner.

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

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

DESHPANDE, *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 each of the two 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.

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

Petitioner filed motions for *pro hac vice* admission of Mr. Scott M. Border in the above-identified cases on October 25, 2013. IPR2014-00039, Paper 7²; IPR2014-00040, Paper 6. Patent Owner did not file an opposition to the motions. For the following reasons, the 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 is 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, 2-3 (incorporating requirements in the “Order – Authorizing Motion for *Pro Hac Vice* Admission” in IPR2013-00639).³

In these proceedings, lead counsel for Petitioner is Mr. Jeffrey P. Kushan, a registered practitioner. In the motions, Petitioner states that there is good cause for the Board to recognize Mr. Border *pro hac vice* during these proceedings, because Mr. Border is an experienced litigation attorney and has been involved in complex intellectual property litigation, and has appeared as counsel for Petitioner in a number of litigation matters before the International Trade Commission and various district courts. Paper 7, 3. In addition, the motion states that Mr. Border is familiar with U.S. Patent No. 6,628,314 and U.S. Patent No. 6,771,290, the prior art relied upon by Petitioner, and the legal and factual arguments made by

² For expediency, IPR2014-00039 is representative and all subsequent citations are to IPR2014-00039 unless otherwise noted.

³ After the Notice was entered, an expanded panel of the Board updated the requirements for filing a motion for *pro hac vice* admission. See IPR2013-00639, Paper 7.

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Petitioner. Paper 7, 4. Mr. Border submits declarations attesting to, and explaining, these facts. *Id.*, Border Declaration.⁴ The motions and declarations comply with the requirements set forth in the Notice.

Upon consideration, Petitioner has demonstrated that Mr. Border possesses sufficient legal and technical qualifications to represent Petitioner in these proceedings, and the Board recognizes that there is a need for Petitioner to have its litigation counsel involved. Accordingly, Petitioner has established good cause for Mr. Border's admission. Mr. Border 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 Petitioner's motions for *pro hac vice* admission of Mr. Scott M. Border for these proceedings are *granted*;

FURTHER ORDERED that Mr. Border is authorized to represent Petitioner as back-up counsel;

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

FURTHER ORDERED that Mr. Border 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 Conduct set forth in 37 C.F.R. §§ 11.101 *et seq.*

⁴ Petitioner is reminded that each exhibit must be uniquely numbered sequentially and must be appropriately labeled. *See* 37 C.F.R. § 42.63.

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