

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EIZO CORPORATION
Petitioner

v.

BARCO N.V.
Patent Owner

Case IPR2014-00358
Patent RE43,707 E

Before KALYAN K.DESHPANDE, JAMES B. ARPIN, and
DAVID C. McKONE, *Administrative Patent Judges*.

ARPIN, *Administrative Patent Judge*.

DECISION

Granting Patent Owner's Motion for *Pro Hac Vice* Admission
of Jeffrey C. Morgan
37 C.F.R. § 42.10

Patent Owner, Barco N.V., moves for *pro hac vice* admission of Mr. Jeffrey C. Morgan. Paper 7. Patent Owner provides an affidavit from Mr. Morgan in support of its motion. Paper 7, 7-10. Petitioner, Eizo Corporation, did not file an opposition to Patent Owner's motion.

See IPR2013-00639, Paper 7, 3 (parties seeking to oppose a motion for admission must file their opposition no later than one week after the filing of the motion). For the reasons stated below, Patent Owner's motion is *granted*.

We 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, such as Mr. Morgan, 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, we require the moving party to provide a statement of facts showing that there is good cause for us to recognize counsel *pro hac vice* and an affidavit or declaration of the individual seeking to appear. Paper 3, 3 (referencing IPR2013-00639, Paper 7).

In its motion, Patent Owner argues that there is good cause for Mr. Morgan's *pro hac vice* admission because he is an experienced patent litigation attorney and has an established familiarity with the subject matter at issue in this proceeding. Paper 7, 2-4. Specifically, Mr. Morgan represents Patent Owner in a related proceeding, *Barco, N.V., et al. v. Eizo Nanao Corporation, et al.*, Case No. 1:11-cv-02964-RLV (N.D. Georgia), concerning Patent No. US RE43,707 E (Ex. 1001; “the '707 Patent”) and its predecessor, Patent No. US 7,639,849 B2. *Id.* at 4. The '707 Patent is challenged in the present petition. In his affidavit, Mr. Morgan attests that:

- (1) he is “a member in good standing of the State Bar of Georgia and the Commonwealth of Massachusetts” and is admitted to practice before the U.S. District Court for the District of Massachusetts, U.S. District Court for the Western District of Wisconsin, U.S. District Court for the Northern District of Georgia, U.S. District Court for the Middle District of Georgia, U.S. District Court for the Eastern District of Texas, U.S. Court of Appeals for the First Circuit, U.S. Court of Appeals for the Ninth Circuit, U.S. Court of Appeals for the Eleventh Circuit, U.S. Court of Appeals for the Federal Circuit, and U.S. Supreme Court;
- (2) he has “not been suspended or disbarred from practice before any court or administrative body” and “never had an application for admission to practice before any court or administrative body denied,” and “[n]o sanction or contempt citation has been imposed against [him] by any court or administrative body”;
- (3) he has “read and will comply with the Office Patent Trial Practice Guide and the Board’s Rules of Practice for Trials set forth in part 42 of 37 C.F.R.,” and acknowledges that he “will be subject to the USPTO Rules of Professional Conduct, as set forth in 37 C.F.R. §§ 11.101 et seq. and disciplinary jurisdiction under 37 C.F.R. § 11.19(a)”;
- (4) he has “not applied to appear *pro hac vice* before the Office in any other proceeding in the last three (3) years”; and
- (5) he [is] “a partner with the law firm of Barnes & Thornburg LLP[, and he is] an experienced patent litigation attorney, [who has] litigated patent cases for [his] entire career—over seventeen (17) years,” and has “at all times been the Patent Owner’s lead trial counsel in its copending district court litigation against Petitioner, *Barco, N.V., et al. v. Eizo Nanao Corporation, et al.*, Case No. 1:11-cv-02964-RLV (N.D. Georgia), which concerns the [’707 Patent], its predecessor patent . . . , and the subject matter at issue in this proceeding. As trial counsel, [he has] been actively involved in all aspects of the district court litigation, including (1) Patent Owner’s factual investigation and development of its infringement

positions; (2) Patent Owner's factual investigation and development of its validity positions; (3) motion practice in the district court; and (4) overall strategy regarding litigation of the infringement and validity issues relating to the '707 Patent. As trial counsel in this litigation, [and has] reviewed numerous treatises, articles, documents, and other information regarding the subject matter of the '707 Patent."

Affidavit of Declaration of Jeffrey C. Morgan, Paper 7, 7-10. We also note that Patent Owner's lead counsel in this proceeding, Kerry T. Hartman, is a registered practitioner. Paper 7, 2.

Based on the facts set forth above, we conclude that Mr. Morgan has sufficient legal and technical qualifications to represent Patent Owner in this proceeding and that there is a need for Patent Owner to have counsel with experience as a litigation attorney in patent matters involved in this proceeding. Accordingly, Patent Owner has established good cause for Mr. Morgan's *pro hac vice* admission. Mr. Morgan will be permitted to appear *pro hac vice* in this proceeding as back-up counsel only. See 37 C.F.R. § 42.10(c).

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner's motion for *pro hac vice* admission of Mr. Jeffrey C. Morgan is *granted*, and Mr. Morgan 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;

FURTHER ORDERED that Mr. Morgan 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

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FURTHER ORDERED that Mr. Morgan is subject to the Office's disciplinary jurisdiction under 37 C.F.R. § 11.19(a), and to the USPTO Rules of Professional Conduct set forth in 37 C.F.R. §§ 11.101 *et seq.*

PETITIONER:

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PATENT OWNER:

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