

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EIZO CORPORATION
Petitioner

v.

BARCO N.V.
Patent Owner

Case IPR2014-00778
Patent RE43,707E

MOTION FOR *PRO HAC VICE* ADMISSION

UNDER 37 C.F.R. § 42.10

Pursuant to 37 C.F.R. § 42.10(c), the Patent Owner respectfully requests that the Board recognize Jeffrey C. Morgan as counsel *pro hac vice* during this proceeding.

1. Time For Filing

This Motion for *Pro Hac Vice* Admission is being filed no sooner than twenty-one (21) days after service of the petition, in accordance with the “Order -- Authorizing Motion for *Pro Hac Vice* Admission” in Case IPR2013-00639, Paper No. 7 and as instructed by the Notice mailed June 11, 2014, Paper No. 3 in this proceeding.

2. Statement of Facts

In accordance with the above-referenced Order and Notice, the following statement of facts, as supported by the Affidavit of Jeffrey C. Morgan submitted herewith respectfully shows that there is good cause for the Board to recognize Mr. Morgan *pro hac vice*.

Patent Owner’s lead counsel, Kerry T. Hartman, is a registered practitioner (Reg. No. 41,818).

Mr. Morgan is a partner with the law firm of Barnes & Thornburg LLP. (Affidavit at ¶ 8.) Mr. Morgan is an experienced patent litigation

attorney. (*Id.*) Mr. Morgan has litigated patent cases for his entire career—over seventeen (17) years. (*Id.*)

Mr. Morgan is a member in good standing of the State Bar of Georgia and the Commonwealth of Massachusetts, as well as multiple federal courts. (*Id.*, at ¶ 1.)

Mr. Morgan has never been suspended or disbarred from practice before any court or administrative body. (*Id.*, at ¶ 2.)

No application of Mr. Morgan for admission to practice before any court or administrative body has ever been denied. (*Id.*, at ¶ 3.)

No sanctions or contempt citations have ever been imposed against Mr. Morgan by any court or administrative body. (*Id.*, at ¶ 4.)

Mr. Morgan 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. (*Id.*, at ¶ 5.)

Mr. Morgan understands that he will be subject to the USPTO Rules of Professional Responsibility Conduct, as set forth in 37 C.F.R. § 11.101 et seq. and disciplinary jurisdiction under 37 C.F.R. § 11.19(a). (*Id.*, at ¶ 6.)

On May 6, 2014, the Board granted Patent Owner's motion for *pro hac vice* admission of Mr. Morgan in another *inter partes* review on the

same challenged patent, U.S. RE43,707E (Case No. IPR2014-00358). Mr. Morgan has not otherwise applied to appear *pro hac vice* before the Office in any other proceeding in the last three (3) years. (*Id.*, at ¶ 7.)

3. Good Cause Exists For The Pro Hac Vice Admission of Mr. Morgan In This Proceeding.

The Board may admit counsel *pro hac vice* upon the 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). Petitioner’s lead counsel, Kerry T. Hartman, is a registered practitioner. The Patent Owner respectfully submits that there is good cause for the Board to recognize Mr. Morgan as counsel *pro hac vice* during this proceeding.

Mr. Morgan has reviewed in detail the pleadings submitted by Petitioner in this proceeding. (Affidavit at ¶ 9.) Mr. Morgan has reviewed in detail the challenged patent, U.S. RE43,707E (“the ‘707 Patent”). (*Id.*) He has also reviewed in detail the relevant references asserted by Petitioner. (*Id.*)

Mr. Morgan has at all times been the Patent Owner’s lead trial counsel in its co-pending 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 same patent—U.S. RE43,707E (“the ‘707

Patent”), its predecessor patent—U.S. Patent No. 7,639,849 (“the ‘849 Patent”), and the subject matter at issue in this proceeding. (*Id.*, at ¶ 10.) As trial counsel, Mr. Morgan 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. (*Id.*) As trial counsel in this litigation, Mr. Morgan has reviewed numerous treatises, articles, documents, and other information regarding the subject matter of the ‘707 Patent. (*Id.*)

Mr. Morgan has also been admitted *pro hac vice* and is designated as back-up counsel in another *inter partes* review on the ‘707 Patent (Case No. IPR2014-00358).

Thus, Mr. Morgan has an established familiarity with the subject matter at issue in this proceeding. Mr. Morgan’s significant litigation experience and expertise will be of great value to the Patent Owner in this proceeding. (*Id.*, at 11.)

4. Affidavit or Declaration of Individual Seeking to Appear

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