

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PALO ALTO NETWORKS, INC.,
Petitioner,

v.

FINJAN, INC.,
Patent Owner.

Case IPR2015-01979
Patent 8,141,154 B2

Before, THOMAS L. GIANNETTI, RICHARD E. RICE, and
MIRIAM L. QUINN *Administrative Patent Judges.*

QUINN, *Administrative Patent Judge.*

ORDER

Denying Petitioner's Motion for Admission *Pro Hac Vice*
37 C.F.R. § 42.10

Petitioner filed a motion for *pro hac vice* admission of Mr. Peter Sauer. Paper 24. We require that a party seeking admission *pro hac vice* proffer a statement of facts showing good cause. *See Unified Patents v. Parallel Iron*, Case IPR2013-00639 (PTAB Oct. 15, 2013) (setting forth the requirements for *pro hac vice* admission) (Paper 7). The present motion and attached affidavit, however, do not satisfy that requirement.

Pro hac vice admission is necessary for Back-Up counsel who will conduct business with the Office on behalf of Lead Counsel when Lead Counsel is not available. 77 Fed. Reg. 48758. Also, *pro hac vice* admission is necessary for an attorney who is neither Lead nor Back-Up Counsel, but who desires to take or defend a deposition of a witness in AIA proceedings. *Id.*; see also Frequently Asked Questions (FAQs), Question G11, accessible at <http://www.uspto.gov/patents-application-process/appealing-patent-decisions/trials/patent-review-processing-system-prps-0>. There are many other reasons additional counsel may be desired, such as, for example, complexity of the proceeding, schedule conflicts, or prior experience in the underlying patent litigation.

Petitioner alludes to good cause being met merely by experience in litigation and familiarity with the proceeding. Paper 24, 1. These are attestations required in the affidavit. But they do not constitute, alone, a statement of facts showing good cause. *See Unified Patents* (listing separately the statement of facts requirement from the affidavit requirement). At best, Petitioner shows Mr. Sauer may be qualified. We find, however, that neither Mr. Sauer's affidavit nor the motion shows either a general or specific need for Petitioner to have this particular counsel admitted. We also consider that, in addition to the Lead Counsel, there are a total of three Back-Up Counsel already enlisted in this proceeding.

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The Motion is hereby denied without prejudice to refiling.

Order

It is

ORDERED that Petitioner's Motion for *pro hac vice* admission of Mr. Peter Sauer is *denied*.

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