

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RIOT GAMES, INC.,
Petitioner,

v.

PALTALK HOLDINGS, INC.,
Patent Owner.

Cases IPR2018-00129 & IPR2018-00130
Patent 5,822,523 & 5,822,523 C1
Cases IPR2018-00131 & IPR2018-00132
Patent 6,226,686 & 6,226,686 C1¹

Before THU A. DANG, KARL D. EASTHOM, and
NEIL T. POWELL, *Administrative Patent Judges*.

EASTHOM, *Administrative Patent Judge*.

DECISION
Granting Petitioner's Motions for
Pro Hac Vice Admission of Scott M. Border
37 C.F.R. § 42.10(c)

¹ This Decision addresses an issue that is identical in all four cases. We, therefore, exercise our discretion to issue one Decision to be filed in each case. The parties, however, are not authorized to use this heading style in any subsequent papers.

IPR2018-00129 & IPR2018-00130
Patent 5,822,523 & 5,822,523 C1
IPR2018-00131 & IPR2018-00132
Patent 6,226,686 & 6,226,686 C1

On May 15, 2018, Petitioner filed a motion for *pro hac vice* admission of Scott M. Border, Esq., in each proceeding identified above. Paper 12 (“Motion”).² Patent Owner has not opposed the Motions. For the reasons provided below, the Motions are *granted*. See 37 C.F.R. § 42.10(c); see also Case IPR2013-00639, Paper 7 (setting forth requirements for *pro hac vice* admission).³

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. 37 C.F.R. § 42.10(c). If lead counsel is a registered practitioner, a non-registered practitioner 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 these proceedings, lead counsel for Petitioner is Joseph A. Micallef, a registered practitioner. Petitioner’s Motions are supported by the Declarations of Scott M. Border. Exhibit 1037 (“Decl.”).

In its Motions, Petitioner asserts that there is good cause for Mr. Border’s *pro hac vice* admission because (1) Mr. Border is an experienced litigator and has been involved in numerous patent litigation cases in federal courts and matters before the Board; and (2) Mr. Border has reviewed and is

² For purposes of expediency, we refer to the papers and exhibits filed in Case IPR2018-00129. Petitioner filed similar papers and exhibits in Cases IPR2018-00130, IPR2018-00131 and IPR2018-00132.

³ Available at http://www.uspto.gov/ip/boards/bpai/ptab_trials.jsp, “Representative Orders, Decisions, and Notices,” “Other Representative Orders and Decisions”).

IPR2018-00129 & IPR2018-00130
Patent 5,822,523 & 5,822,523 C1
IPR2018-00131 & IPR2018-00132
Patent 6,226,686 & 6,226,686 C1

familiar with U.S. Patent Nos. 5,822,523 and 6,226,686, and thus, has established familiarity with the subject matter at issue in these proceedings and the conduct of these proceedings to date. Paper 12, 3. In support of the Motions, Mr. Border attests to these facts in his Declarations with sufficient explanations. Ex. 1037, 1–3. Additionally, the Motions and Mr. Border’s Declarations comply with the requirements set forth in the Board’s order authorizing Petitioner’s motion for *pro hac vice* admission.

Based on the record before us, we find that Mr. Border has sufficient legal and technical qualifications to represent Petitioner in these proceedings. Accordingly, Petitioner has established that there is 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. Border are granted; Mr. Border is authorized to represent Petitioner as back-up counsel in these proceedings only;

FURTHER ORDERED that Petitioner is to continue to have a registered practitioner as lead counsel in 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 Title 37, Part 42 of the C.F.R., 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.*

IPR2018-00129 & IPR2018-00130
Patent 5,822,523 & 5,822,523 C1
IPR2018-00131 & IPR2018-00132
Patent 6,226,686 & 6,226,686 C1

PETITIONER:

Joseph A. Micallef
Samuel A. Dillon
SIDLEY AUSTIN LLP
jmicallef@sidley.com
samuel.dillon@sidley.com

PATENT OWNER:

Gregory M. Howison
Keith D. Harden
Brian D. Walker
MUNCK, WILSON, MANDALA, LLP
ghowison@munckwilson.com
kharden@munckwilson.com
bwalker@munckwilson.com