

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GUARDIAN ALLIANCE TECHNOLOGIES, INC.,
Petitioner,

v.

TYLER MILLER,
Patent Owner.

Case IPR2020-00031
Patent 10,043,188 B2

Before SALLY C. MEDLEY, DAVID C. MCKONE and JOHN R. KENNY,
Administrative Patent Judges.

MCKONE, *Administrative Patent Judge.*

ORDER

Granting Petitioner's Motion for *Pro Hac Vice* Recognition of Counsel
37 C.F.R. § 42.10(c)

Petitioner moves for *pro hac vice* recognition of Evan W. Talley. Paper 18 (“Mot.”). Petitioner’s Motion is supported by the Declaration of Mr. Talley. Ex. 1034 (“Talley Decl.”).¹ Patent Owner opposes Petitioner’s Motion. Paper 19 (“Opp.”).

According to our rules,

The Board 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. For example, where the lead counsel is a registered practitioner, a motion to appear *pro hac vice* by counsel who is not a registered practitioner may be granted upon showing that counsel is an experienced litigating attorney and has an established familiarity with the subject matter at issue in the proceeding.

37 C.F.R. § 42.10(c); *see also* Patent Trial and Appeal Board Consolidated Trial Practice Guide (November 2019), 11.

Petitioner and Mr. Talley represent that Mr. Talley is an experienced litigator, with approximately ten years of experience with patent matters and complex litigation in multiple district and appellate courts. Mot. 2; Talley Decl. ¶¶ 2–5. Petitioner and Mr. Talley further represent that Mr. Talley is familiar with the subject matter of this proceeding through his representation of Petitioner’s indemnitee in related district court litigation. Mot. 2–3; Talley Decl. ¶¶ 1, 4–5. We are satisfied that Mr. Talley is “an experienced litigating attorney and has an established familiarity with the subject matter at issue in the proceeding,” as recited in Rule 42.10(c).

¹ The Declaration of Mr. Talley is labeled as Exhibit 1034, but has been filed as Paper 17. Petitioner should file Mr. Talley’s Declaration as an Exhibit and seek to have Paper 17 expunged.

Patent Owner opposes by contending that Mr. Talley is likely to become a fact witness in this proceeding. Opp. 1–2 (citing 37 C.F.R. § 11.307(a)). In the Petition (Paper 1), Petitioner contends that the '188 patent would have been obvious over, *inter alia*, the POBITS reference (Ex. 1004). Pet. 4. Patent Owner contends that POBITS is not prior art to the '188 patent. Paper 7 (Prelim. Resp.) 28–34. Patent Owner argues that, because Mr. Talley participated in the preparation of POBITS as an exhibit to the Petition, he likely will be a fact witness as the parties seek to establish whether POBITS was publicly available in February 2011. Opp. 1–2.

We are not persuaded that a lawyer's participation in the preparation of petition exhibits, a seemingly necessary task in an *inter partes* review, somehow converts that lawyer into a likely fact witness and disqualifies them from further representation of the party in the proceeding. Patent Owner's objection is unpersuasive.

Patent Owner further offers "additional factors," which are an unfounded attack on Mr. Talley's character and an improper attempt to re-argue the public accessibility of POBITS. Opp. 2–5. Patent Owner argues that Mr. Talley violated his duty of candor through his alleged involvement with the preparation of the testimony of Mr. Klosson (Ex. 1014), who testified regarding POBITS. *Id.* at 2–4 (citing 37 C.F.R. § 11.303). Patent Owner's apparent concern is that Mr. Klosson did not qualify his factual assertions with "I believe" or "I have been told," and that, lacking these statements, Mr. Klosson's testimony is false or misleading. *Id.* Patent Owner then offers evidence that it alleges contradicts Mr. Klosson's testimony. *Id.* at 4–5. Patent Owner's disagreement with Mr. Klosson's testimony, however, does not mean that that testimony is willfully false.

Although we will evaluate Mr. Klosson's testimony to determine the proper weight to which it is entitled, we see nothing in Mr. Klosson's Declaration to suggest that his testimony is false or misleading. Patent Owner's allegation of misconduct is a serious one, but it is backed up by no meaningful evidence.

Patent Owner's remaining "additional factors" simply argue that, despite some indication that POBITS was archived at the Internet Archive in February 2011, it was not in fact archived until much later. Opp. 4-5. These arguments are improper in an opposition to a *pro hac vice* motion and will not be considered.

We have considered Petitioner's evidence and conclude that Mr. Talley is an experienced litigating attorney and has an established familiarity with the subject matter at issue in the proceeding. See Rule 42.10(c). Patent Owner's opposition arguments are improper in an opposition to a *pro hac vice* motion and are unpersuasive. Petitioner has shown good cause to recognize Mr. Talley in this proceeding.

I. ORDER

It is:

ORDERED that Petitioner's Motion is *granted*;

FURTHER ORDERED that Mr. Talley is authorized to represent Petitioner as back-up counsel only in this proceeding;

FURTHER ORDERED that Mr. Talley will comply with the Patent Trial and Appeal Board Consolidated Trial Practice Guide

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(November 2019), and the Board's Rules of Practice for Trials, as set forth in 37 C.F.R. Part 42; and

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

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