UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,

Petitioner

v.

LBT IP I LLC,

Patent Owner

Case No. IPR2020-01189
U.S. Patent No. 8,497,774

PETITIONER APPLE INC.'S OPPOSITION TO PATENT OWNER'S MOTION FOR ADMISSION *PRO HAC VICE* OF BRIAN S. SEAL

Patent Owner LBT IP I LLC ("LBT") seeks to have its lead trial counsel, Brian S. Seal, appear in this proceeding in direct violation of the District Court's Protective Order. For over 11 months Mr. Seal has had access in the litigation to Apple's highly confidential technical documents describing the core operational details of the products LBT accuses of infringement. Now, LBT seeks to both amend its claims and add Mr. Seal as counsel of record to the IPR. This is the very situation contemplated—and expressly forbidden—by the District Court's Protective Order. For this reason, Apple opposes Mr. Seal's *pro hac vice* admission to this proceeding.

I. *Pro Hac Vice* Admission is Discretionary

Pro hac vice admission before the Board may be granted "upon a showing of good cause" and is subject to "any other conditions as the Board may impose." 37 C.F.R. § 42.10(c). Thus, granting a motion to appear *pro hac vice* is a "discretionary action taking into account the specifics of the proceeding." 77 Fed. Reg. 48618 (August 14, 2012).

II. Timeline of Events

LBT filed suit against Apple alleging infringement of the Challenged Patents on July 1, 2019, listing Brian Seal as lead counsel. EX. 1067, Complaint, 15. On June 12, 2020, Apple produced its confidential "core tech docs" to LBT, including Mr. Seal. *See* EX. 1072. Until recently, LBT maintained a separation of litigation counsel from IPR counsel. Mr. Zajac was LBT's sole IPR counsel until Mr. Gregory

was added December 9, 2020. Paper 7. It was not until May 11, 2021—the day before the deposition of Apple's IPR expert—that LBT sought to include Mr. Seal as counsel for both the litigation and the IPR. Because LBT had not yet disclosed any intent to amend, Apple raised no objection to Mr. Seal's involvement. The very next day, on May 12, Mr. Seal appeared as counsel for LBT and deposed Apple's IPR expert. EX. 1068. Two days later, on Friday, May 14, LBT emailed the Board indicating its intent to file a Motion to Amend in each proceeding. EX. 1069. Apple's counsel was not copied. *Id.* On May 18, the Board scheduled a hearing to discuss LBT's motion to amend. EX. 1070. This was the first time Apple learned of LBT's intent to amend. Counsel for Apple reviewed the Protective Order in the District Court and raised its objections to Mr. Seal's involvement during the May 20 hearing.

III. Mr. Seal's Access to Apple's Confidential Information in the District Court Litigation and the Related Protective Order Should Preclude Him from Participating in this Proceeding

Pending contemporaneously with this IPR is district court litigation between Apple and LBT involving all of the Challenged Patents. *LBT IP I LLC v. Apple Inc.*, No. 1-19-cv-01245 (D. Del.). In that litigation, Brian Seal serves as lead trial counsel for LBT. EX. 2002; EX. 1071. Though the litigation is now stayed pending the outcome of these IPRs, it progressed through discovery and Apple produced "core tech documents" to LBT (and, specifically, to Mr. Seal) on June 12, 2020. *See* EX. 1072, Annotated Notice of Service of Apple's Core Tech Documents. These

documents describe the core operation of the accused products, are some of Apple's most confidential and proprietary material, and ultimately have been (or will be) used by LBT to argue Apple's alleged infringement of the Challenged Patents.

The disclosure and use of Apple's proprietary information should not be allowed to infect the amendment process. Allowing LBT to craft amended claims after accessing Apple's confidential information for the Accused Products would subject Apple to extreme prejudice. This is why this scenario is expressly precluded by the District Court's Protective Order. EX. 1073, Protective Order. Section 6(b) of the Protective Order, titled "Patent Prosecution Bar," governs this situation:

> (a) Patent Prosecution Bar. Absent the written consent of the Producing Party, ***any person*** **on behalf of the Plaintiff** ***who receives one or more items designated by a Defendant shall not be involved, directly or indirectly*****, in any of the following activities**: (i) **advising on, consulting on, preparing, prosecuting, drafting, editing, and/or amending of patent [] claims**, and/or responses to office actions, or otherwise affecting the scope of claims in patents or patent applications relating to the functionality, operation, and design of systems and methods for power monitoring and conservation in location tracking devices (generally or as described in any patent in suit), before any foreign or domestic agency, including the United States Patent and Trademark Office; and (ii) the acquisition of patents (including patent applications), or the rights to any such patents or patent applications with the right to sublicense, relating to the functionality, operation, and design of systems and methods for power monitoring and conservation in location tracking devices. These prohibitions are not intended to and shall not preclude counsel from participating in proceedings on behalf of a Party challenging the validity of any patent, including any inter partes review or post-grant review proceedings, **but are intended to preclude counsel from participating** ***directly or indirectly*** **in drafting or amending claims in any** ***inter partes*** **review or post-grant review proceedings**, in any reexamination proceedings, or in any reissue

> proceedings on behalf of a patentee. ***These prohibitions shall begin when access to materials are first received by the affected individual***, and shall end two (2) years after the final resolution of this action, including all appeals.

EX. 1073, at 4-5 (emphasis added).

There are two key aspects of the prosecution bar relevant to the current dispute. First, the "Patent Prosecution Bar" begins upon *receipt* of the confidential materials by Mr. Seal. *Id.*, at 5 ("these prohibitions shall begin when access to materials are *first received*…"). As indicated by Apple's Notice of Service, Mr. Seal received these materials on June 12, 2020, when Apple served its "core tech documents" upon all counsel of record for LBT. EX. 1072 at 1 (specifically listing Mr. Seal as a recipient of the "core tech documents"). Thus, it is irrelevant for purposes of determining a protective order violation whether Mr. Seal has (or has not) reviewed Apple's confidential information (though he undoubtedly has or will as LBT's lead counsel). EX. 1074 at 21:3-7.

Second, the "Patent Prosecution Bar" broadly precludes Mr. Seal from participating "directly or ***indirectly*** in drafting or amending claims" in the IPR proceedings. EX. 1073, at 5. Even if LBT provides assurances that Mr. Seal will not be "directly" involved with the amendment process, the Protective Order precludes any "indirect" involvement. As the Board is aware, the amendment process is inextricably intertwined with the question of whether the original claims should be canceled. For example, the parties will examine whether and how the challenged art

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