

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

LBT IP I LLC,
Patent Owner.

IPR2020-01189 (Patent 8,497,774 B2)
IPR2020-01190 (Patent 8,542,113 B2)
IPR2020-01191 (Patent 8,102,256 B2)
IPR2020-01192 (Patent 8,421,618 B2)
IPR2020-01193 (Patent 8,421,619 B2)¹

Before JOHN A. HUDALLA, SHEILA F. McSHANE, and
JULIET MITCHELL DIRBA, *Administrative Patent Judges*.

HUDALLA, *Administrative Patent Judge*.

ORDER
Granting Patent Owner's Motion for *Pro Hac Vice*
Admission of Brian S. Seal
37 C.F.R. § 42.10

¹ We exercise our discretion to issue a single Order, to be filed in each case.
The parties are not authorized to use this caption for subsequent papers.

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Patent Owner filed a motion for *pro hac vice* admission of Brian S. Seal in each of the above-identified proceedings (collectively, “PHV Motions”). Paper 12.² Patent Owner also filed initial declarations of Mr. Seal in support of the PHV Motions. Ex. 2002.³ Mr. Seal is Patent Owner’s lead counsel in the underlying district court litigation. PHV Motions 2–3.

Petitioner initially did not oppose the PHV Motions. *See* Paper 12, 1. Nevertheless, after Patent Owner indicated that it would be filing motions to amend in each of these cases, Petitioner changed its position such that now opposes Patent Owner’s PHV Motions. *See* Paper 13, 2. Petitioner’s change in position is based on its contention that Mr. Seal cannot participate in amending claims of the challenged patents under the terms of a protective order entered in the underlying district court litigation. *See* Ex. 1073 (protective order). Based on the changed circumstances, we authorized further briefing on the PHV Motions. *See* Paper 13, 3. Petitioner subsequently filed an opposition to each of the PHV Motions (Paper 15, “Opp.”), and Patent Owner filed a reply in support of each of the PHV

² For purposes of expediency, we cite to papers and exhibits filed in IPR2020-01189. Similar papers and exhibits are filed in each of the above-identified proceedings.

³ We note that Patent Owner filed two versions of Mr. Seal’s initial declarations. The later-filed version includes the required certification that Mr. Seal’s statements were made with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001.

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Motions (Paper 19, “Reply”). Patent Owner also filed revised declarations of Mr. Seal in support of the PHV Motions. Ex. 2014.⁴

For the reasons set forth below, we grant Patent Owner’s motions for *pro hac vice* admission of Brian S. Seal.

I. BACKGROUND

In the underlying litigation, the district court entered a protective order to protect the parties’ proprietary and confidential information produced during discovery. *See* Ex. 1073. In June 2020, Petitioner produced to Patent Owner protected information describing the core operational details of Petitioner’s accused devices. Opp. 1–2; Ex. 1072 (notice of service regarding information designated as “CONFIDENTIAL – ATTORNEYS’ EYES ONLY”). Petitioner contends that, since that time, “Mr. Seal has had access in the litigation to [Petitioner’s] highly confidential technical documents describing the core operational details of the products [Patent Owner] accuses of infringement.” Opp. 1.

Petitioner contends Mr. Seal is prohibited from participating in the amendment of the challenged claims in the instant proceedings based on a “Patent Prosecution Bar” provision in the district court’s protective order. Opp. 3–4 (quoting Ex. 1073, 4–5). That provision states that

any person on behalf of [Patent Owner] who receives one or more items designated “CONFIDENTIAL – ATTORNEYS’ EYES ONLY” or “CONFIDENTIAL – ATTORNEYS’ EYES

⁴ Hereinafter, we refer only to the revised versions of Mr. Seal’s declarations (e.g., Exhibit 2014).

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ONLY – SOURCE CODE” by [Petitioner] 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 applications, specifications, claims, and/or responses to office actions, or otherwise affecting the scope of claims in patents or patent applications

related to the litigation. Ex. 1073, 4–5. The provision further states that “[t]hese prohibitions shall begin when access to ‘CONFIDENTIAL – ATTORNEYS’ EYES ONLY’ or ‘CONFIDENTIAL – ATTORNEYS’ EYES ONLY – SOURCE CODE’ materials are first received by the affected individual.” *Id.* at 5.

Citing its production of protected information in June 2020, Petitioner argues that “the ‘Patent Prosecution Bar’ begins upon *receipt* of the confidential materials by Mr. Seal.” Opp. 4 (citing Ex. 1073, 5). As such, Petitioner argues that “it is irrelevant for purposes of determining a protective order violation whether Mr. Seal has (or has not) reviewed [Petitioner’s] confidential information.” *Id.* Petitioner further argues that the Patent Prosecution Bar provision prohibits even Mr. Seal’s indirect involvement in the amendment process. *Id.* (quoting Ex. 1073, 5). Petitioner contends that “it is unreasonable to assume [Patent Owner’s] counsel of record for this IPR . . . will be able to completely insulate Mr. Seal through some ‘wall’ to ensure he is not involved in the amendment process.” *Id.* at 5.

Patent Owner argues that “Mr. Seal has not, and will not access any of the proprietary material until after conclusion of this IPR and certainly until

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after conclusion of the amendment process in th[ese] proceeding[s].”

Reply 2; *see also* Ex. 2014 ¶¶ 12–13 (Mr. Seal testifying that he has not had access to Petitioner’s confidential information). Patent Owner notes that the district court stayed the underlying litigation until the conclusion of the instant *inter partes* reviews, so Patent Owner contends that Petitioner’s concerns about Mr. Seal’s potential or eventual access to protected materials are unfounded. Reply 2. Patent Owner also contends that the Patent Prosecution Bar provision is triggered on actual access to protected materials and not just on the ability to access protected materials. *See id.* at 2–3. Patent Owner further argues that Mr. Seal is not a patent attorney and that he will not be involved in amending the challenged patents. *See id.* at 3; *see also* Ex. 2014 ¶ 13 (Mr. Seal testifying that he has “not participated and [is] not participating in any claim amendments in this IPR or in any other related IPR”).

Patent Owner additionally contends that we should admit Mr. Seal *pro hac vice* because of his familiarity with the subject matter of these proceedings. PHV Motions 3. Patent Owner further contends that it “wishes to apply Mr. Seal’s knowledge of the patent[s] and litigation experience by employing him as counsel in th[ese] proceeding[s]” and that it hopes to “avoid unnecessary expense and duplication of work” by virtue of his admission. *Id.*

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