

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE INC. and APPLE INC.
Petitioner

v.

JONGERIUS PANORAMIC TECHNOLOGIES, LLC
Patent Owner

Case IPR2013-00191
Patent 6,563,529

Before KARL D. EASTHOM, JONI Y. CHANG, and MICHAEL R. ZECHER,
Administrative Patent Judges.

CHANG, *Administrative Patent Judge.*

DECISION

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

Google Inc. and Apple Inc. (collectively “Petitioner”¹) filed a motion for *pro hac vice* admission of Mr. James R. Batchelder. Paper 45 (“Mot.”). Jongerius Panoramic Technologies (“Patent Owner”) opposes Petitioner’s motion. Paper 49 (“Opp.”). For the reasons provided below, Petitioner’s motion is *granted*.

Pursuant to 37 C.F.R. § 42.10(c), 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. In its notice authorizing motions for *pro hac vice* admission, the Board requires a statement of facts showing there is good cause for the Board to recognize counsel *pro hac vice* and an affidavit or declaration of the individual seeking to appear in this proceeding. Paper 7.

In this proceeding, lead counsel for Petitioner, Ms. Michelle K. Holoubek, is a registered practitioner. Mot. 2. Petitioner’s motion indicates that there is good cause for the Board to recognize Mr. Batchelder *pro hac vice* during this proceeding (*id.* at 5-6), and is supported by the declaration of Mr. Batchelder. Ex. 1036.

In particular, Mr. Batchelder declares that he has extensive experience litigating patent cases. Ex. 1036 ¶¶ 4-6. Mr. Batchelder also declares that he has established familiarity with the subject matter at issue in the instant proceeding, as he has been representing Apple Inc. in related district court litigation that involves the same patent being challenged in this proceeding. *Id.* at ¶ 13; *see also* Mot. ¶ 3. Additionally, Mr. Batchelder’s declaration complies with the requirements set forth in the Board’s order authorizing motions for *pro hac vice* admission. Ex. 1036 ¶¶ 1-14.

¹ “*Petitioner* means the party filing a petition requesting that a trial be instituted.” 37 C.F.R. § 42.2.

On this record, we determine that Mr. Batchelder has sufficient legal and technical qualifications to represent Petitioner in the instant proceeding. We further recognize that there is a need for Petitioner to have its counsel in the related district court litigation involved in this proceeding. We now turn to Patent Owner's arguments regarding Petitioner's good cause showing for Mr. Batchelder's *pro hac vice* admission.

Patent Owner argues that Petitioner has not demonstrated a sufficient need for Mr. Batchelder's appearance as counsel in the instant proceeding, as all of the substantive briefings have been filed by the parties, and Mr. Batchelder already is assisting Petitioner's existing counsel in an "advisory capacity." Opp. 1 (citing Ex. 1036 ¶ 13). In support of its argument, Patent Owner asserts that "no admission *pro hac vice* is needed for Mr. Batchelder to continue his advisory role, which would seem perfectly adequate to avoid the expense and duplication of work sought by [Petitioner]." Opp. 1. However, Patent Owner's assertion is speculative. Patent Owner fails to recognize that the parties' motions to exclude evidence, oppositions to motions to exclude evidence, and replies to such oppositions have yet to be filed in this proceeding. More importantly, Patent Owner has not explained adequately why Petitioner would not need Mr. Batchelder, who is an experienced litigator and has established familiarity with the subject matter in this proceeding, to participate as its back-up counsel at the final oral hearing.

Patent Owner further takes the position that Mr. Batchelder should not appear in this proceeding because of the prosecution bar issued in the underlying litigation. Opp. 1-2 (citing Ex. 2032, 14-15; Ex. 2033, 17, 19). Patent Owner indicates that the protective order entered in related district court litigation, *Jongerius Panoramic Technologies, LLC v. Google Inc. et al.*, No. 12-03797-YGR

(N.D.C.A.), precludes attorneys appearing in that action who have received access to certain confidential materials from engaging in “prosecution activities.” *Id.* Patent Owner does not believe Mr. Batchelder can be counsel in this proceeding without engaging in “prosecution activity” in violation of the protective order. *Id.*

We are not persuaded by Patent Owner’s arguments. The protective order at issue specifically bars litigation counsel from prosecution activities without mentioning litigation or trials before the Patent Trial and Appeal Board. An *inter partes* review is neither a patent examination nor a patent reexamination. Rather, it is a trial, adjudicatory in nature and constitutes litigation. Further, as Patent Owner noted, all of the substantive briefings, including those related to amending claims, have been completed in the instant proceeding. Patent Owner fails to explain sufficiently what “prosecution activities” it believes Mr. Batchelder would be engaging in this proceeding.

It is important to note that counsel is subject to sanctions from the United States District Court for the Northern District of California for any violation of that court’s protective order. In that regard, Patent Owner does not indicate that Mr. Batchelder, who has been assisting Petitioner’s existing counsel in the instant proceeding, is currently in violation of the district court’s protective order. The Board presumes that Mr. Batchelder will not violate the protective order and that, if it becomes impossible for counsel to represent Petitioner properly without violating the protective order, counsel promptly will bring that issue to the attention of the Board. Moreover, Patent Owner is not without recourse before the district court. It may seek relief before the district court insofar as how the protective order should be applied to Mr. Batchelder, including seeking an expansion of the order to expressly bar participation in an *inter partes* review.

For the foregoing reasons, Petitioner has established that there is good cause for Mr. Batchelder's *pro hac vice* admission in the instant proceeding.

It is

ORDERED that Petitioner's motion for *pro hac vice* admission of Mr. James R. Batchelder is *granted*; Mr. Batchelder is authorized to represent Petitioner only as back-up counsel in the instant proceeding;

FURTHER ORDERED that Petitioner is to continue to have a registered practitioner represent it as lead counsel for the instant proceeding;

FURTHER ORDERED that Mr. Batchelder is to comply with the Office Patent Trial Practice Guide and the Board's Rules of Practice for Trials, as set forth in Part 42 of Title 37, Code of Federal Regulations; and

FURTHER ORDERED that Mr. Batchelder is 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.*

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