

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MICROSOFT CORPORATION  
Petitioner

v.

SURFCAST, INC  
Patent Owner

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Case IPR2013-00292<sup>1</sup>  
Patent 6,724,403

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Before MICHAEL P. TIERNEY, JONI Y. CHANG, and  
MATTHEW R. CLEMENTS, *Administrative Patent Judge*.

CLEMENTS, *Administrative Patent Judge*.

ORDER  
Conduct of Proceedings  
*37 C.F.R. § 42.05*

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<sup>1</sup> Cases IPR2013-00293, IPR2013-00294, and IPR2013-00295 have been consolidated with the instant proceeding.

Cases IPR2013-00292, IPR2013-00293,  
IPR2013-00294, and IPR2013-00295  
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On February 18, 2014, a conference call was held between respective counsel for Petitioner and Patent Owner, and Judges Tierney, Chang, and Clements. The stated purpose of the call was to discuss Patent Owner's requests for (1) the Board to be available during the deposition of Patent Owner's counsel; and (2) leave to file additional exhibits under seal and corrected declarations to reference those exhibits. The following issues were discussed.

*Additional Exhibits*

Patent Owner requested authorization to file additional exhibits not previously referenced in declarations filed by Patent Owner. According to Patent Owner, the exhibits are needed to refute potential allegations of witness tampering, which is an issue raised by the Petitioner in the related district court proceeding. For example, one exhibit to be submitted is a consulting agreement that was not previously identified in an underlying declaration. Petitioner objected on the grounds that (1) the exhibits are untimely; (2) Patent Owner had access to this information at the time it filed its declarations and Patent Owner Response; and (3) they are now being offered the day before the relevant deposition is to take place. Petitioner also objected that Patent Owner had not met and conferred with Petitioner prior to emailing the Board to seek authorization.

As the exhibits go to the declarations submitted in support of the Patent Owner Response, the time for filing and discussing the exhibits was the time for filing the Patent Owner Response. At this juncture, Patent Owner has failed to demonstrate that consideration of the supplemental

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information contained in the exhibits is in the interests-of-justice. 37 C.F.R. § 42.123(b). Additionally, Patent Owner has already provided the documents to Petitioner. Accordingly, Petitioner is free to use the documents during the depositions of the various witnesses. Should Petitioner choose to rely upon the documents in support of its case, Petitioner will be required to file the documents with its substantive paper. Should Petitioner choose not to rely on the documents, the Board does not need the documents to be in the record. Accordingly, Patent Owner's request for leave to file the additional exhibits as supplemental information was denied.

*Deposition of Mr. Bone*

Patent Owner noted the possibility of a witness issue under 37 CFR § 11.307, and requested that the Board be available during the deposition of Mr. Bone scheduled to occur the next day, February 19, from noon to 7PM Eastern Time. Petitioner stated that it did not foresee a problem. The Board indicated that it would be available, if needed. The Board also referred the parties to the Testimony Guidelines in Appendix D of the Office Patent Trial Practice Guide, and encouraged the parties to attempt to resolve disputes, if any, amongst themselves.

*Pro Hac Vice Admission of Karen Boyd*

Petitioner raised the issue of whether Ms. Boyd, whom Patent Owner intends to represent Mr. Bone at his deposition, could do so without being designated as lead or backup counsel, or being admitted *pro hac vice*. The

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Board advised that an attorney defending a deposition should, at a minimum, be admitted *pro hac vice*.

As set forth in 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 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 8, referencing the “Order – Authorizing Motion for *Pro Hac Vice* Admission” in IPR2013-00010, at 3-4.)

Due to the exigent circumstances presented by Patent Owner’s need for Ms. Boyd to represent Mr. Bone at a deposition scheduled for the next day, the Board waived the requirement for a written Motion for *Pro Hac Vice* Admission and accompanying declaration, and took Ms. Boyd’s oral testimony. During the conference before the Board, Ms. Boyd attested to the fact that (1) she is to defend the deposition of Mr. Bone scheduled for the next day; (2) she represented Mr. Bone in his personal capacity in the related litigation and is best suited to do so again here; (3) she is in good standing with at least one bar; (4) she has not been suspended; (5) she has never been denied admission to a bar; (6) she has not been sanctioned or cited for contempt; (7) she has read and is willing to comply with the Office Patent Trial Practice Guide; (8) she recognizes that she will be subject to the USPTO Rules of Professional Conduct set forth in 37 C.F.R. §§ 11.101 *et. seq.* and the Office’s disciplinary jurisdiction under 37 C.F.R. § 11.19(a); (9)

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she has not been admitted *pro hac vice* to any other proceedings before the Board in the last three years; and (10) she is familiar with the subject matter involved in this proceeding. Petitioner did not object.

For the foregoing reasons, the Board determined that Ms. Boyd has sufficient legal and technical qualifications, and Patent Owner has established that there is good cause for Ms. Boyd's *pro hac vice* admission in this proceeding. Therefore, the Board exercised its discretion to admit Ms. Boyd *pro hac vice*, and authorized Ms. Boyd to represent Patent Owner only as back-up counsel in this proceeding.

*Length of Deposition of Patent Owner's Expert*

Petitioner raised an issue relating to its deposition of Patent Owner's expert scheduled in a few weeks. Petitioner contends that it needs two days to depose Patent Owner's expert. Patent Owner offered 10.5 hours. The only prejudice identified by Patent Owner was that it had not taken two days, or even one full day, of time to depose Petitioner's expert. Hearing no prejudice, and in consideration of the fact that Patent Owner's expert put in two declarations and that this is a consolidated proceeding, the Board ordered that Patent Owner's expert be available for 13 hours of testimony (excluding redirect examination and re-cross examination, the time for which remains that normally granted in the rules).

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ORDER

It is

ORDERED that Patent Owner's request for authorization to file additional exhibits is DENIED;

FURTHER ORDERED that Patent Owner will make its expert available for 13 hours of deposition by Petitioner;

FURTHER ORDERED that Patent Owner's motion for *pro hac vice* admission of Ms. Karen Boyd is *granted*; Ms. Karen Boyd is authorized to represent Patent Owner only as back-up counsel in the instant proceeding;

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

FURTHER ORDERED that Ms. Karen Boyd 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 Ms. Karen Boyd 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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