

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION
Petitioner,

v.

SURFCAST, INC.
Patent Owner

Patent No. 6,724,403

Issued: April 20, 2004

Filed: October 30, 2000

Inventors: Ovid Santoro *et al.*

Title: SYSTEM AND METHOD FOR SIMULTANEOUS DISPLAY OF
INFORMATION SOURCES

Inter Partes Review Nos. IPR2013-00292, IPR2013-00293,
IPR2013-00294, and IPR2013-00295

**PETITIONER'S MOTION FOR ADMISSION *PRO HAC VICE* OF
SCOTT M. BORDER PURSUANT TO 37 C.F.R. § 42.10(c)**

Petitioner, Microsoft Corporation (“Microsoft”) respectfully requests that the Board recognize Scott M. Border, Esq. as counsel *pro hac vice* during this proceeding.¹

I. BACKGROUND

Microsoft’s Motion for *Pro Hac Vice* Admission is being filed pursuant to and in compliance with the Notice of Filing Date Accorded to Petition and Time Period For Filing Patent Owner Preliminary Response for this Petition, which was mailed May 24, 2013 (Paper 9) (the “Notice”). The Notice authorizes the parties to file motions for *pro hac vice* admission under 37 C.F.R. § 42.10(c). Further to the Notice, such “motions shall be filed in accordance with the ‘Order – Authorizing Motion for *Pro Hac Vice* Admission’ in Case IPR2013-00010” as well as the more recent IPR2013-00639 ” (the “Order”).

II. TIME OF FILING

This Motion for *Pro Hac Vice* admission is being filed in accordance with the Notice authorizing the filing of a Motion for *Pro Hac Vice* admission 21 days after issuance of the Notice.

¹ A corresponding motion for *Pro Hac Vice* admission is being concurrently filed in co-pending *Inter Partes* Review Case Nos. IPR2013-00293, IPR2013-00294, and IPR2013-00295.

III. STATEMENT OF FACTS

As required by the Order, the following statement of facts, supported by the attached Declaration of Scott M. Border in Support of Motion for *Pro Hac Vice* Admission (“Border Decl.”), shows that there is good cause for the Patent Trial and Appeal Board (“Board”) to recognize Mr. Border *pro hac vice* in this proceeding.

Lead counsel, Jeffrey P. Kushan, and Backup counsel, Joseph Micallef, are registered practitioners and are experienced in proceedings before the USPTO.

Mr. Border is an experienced litigation attorney. Mr. Border has been a litigating attorney for more than six years, and has been involved in numerous patent litigation cases in federal courts and matters before the Board. Mr. Border’s experience includes representing a wide range of clients in complex intellectual property litigation, and he has appeared as counsel for Microsoft in a number of litigation matters before the International Trade Commission and various District Courts over the span of his career. Mr. Border is a member in good standing of the Virginia State Bar and the District of Columbia Bar, with no suspensions or disbarments from practice, nor any application for admission to practice denied, nor any sanctions or contempt citations, and is admitted to practice in the United States Court of Appeals for the Federal Circuit, as well as the United States District Courts for the Northern District of Florida, Eastern District of Texas, and

Eastern District of Virginia. His mailing address is at Sidley Austin LLP, 1501 K Street, N.W., Washington, D.C. 20005, his email address is sborder@sidley.com, and his direct dial is (202) 736-8818.

Mr. Border has worked with lead and backup counsel in most aspects of these proceedings, including the preparation and strategy behind Microsoft's Petitions and the Declarations of David R. Karger. As such, he has reviewed and is familiar with (i) U.S. Patent No. 6,724,403, the patent at issue in these proceedings, (ii) the prior art relied upon in Microsoft's Petitions, (iii) the legal and factual arguments that have been addressed by Microsoft and (iv) the development in these proceedings since the filing of Microsoft's Petitions. Mr. Border has also been involved in a number of other proceedings before the Board, has been admitted *pro hac vice* as backup counsel in another matter before the Board, and is familiar with its established practices. Accordingly, he has established familiarity with the subject matter at issue in these proceedings and the conduct of these proceedings to date.

Mr. Border has read and will comply with the Office Patent Trial Practice Guide and the Board's Rules for Practice for Trials set forth in part 42 of 37 C.F.R., and he agrees to be subject to the USPTO Rules of Professional Conduct set forth in 37 C.F.R. §§11.01 *et seq.*, and to disciplinary jurisdiction under 37 C.F.R.

§11.19(a). Mr. Border has been admitted *pro hac vice* in IPR2014-00039 and IPR2014-00040.

IV. ANALYSIS

The facts contained in the Statement of Facts above, and contained in the Border Declaration, establish that there is good cause to admit Mr. Border *pro hac vice* in this proceeding under 37 C.F.R. § 42.10(c). Lead and Backup counsel are registered practitioners, Mr. Border is an experienced litigating attorney, and Mr. Border has an established familiarity with the subject matter at issue in these proceedings.

V. CONCLUSION

Therefore, Microsoft respectfully submits that there is good cause for the Board to recognize Mr. Border as *pro hac vice* counsel during these proceedings.

Microsoft's Motion for *Pro Hac Vice* Admission is accompanied by a Declaration of Scott M. Border as required by the Order.

Dated: February 20, 2014

Respectfully submitted,

/Jeffrey P. Kushan/

Jeffrey P. Kushan

Reg. No. 43,301

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Attorney for Petitioner

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**DECLARATION OF SCOTT M. BORDER IN SUPPORT OF MOTION
FOR *PRO HAC VICE* ADMISSION**

I, Scott M. Border, being duly sworn and upon oath, hereby attest to the following:


1. I am a member in good standing of the Bar of the State of Virginia and the District of Columbia.
2. I have not been suspended or disbarred from practice before any court or administrative body.
3. I have never had an application for admission to practice before any court or administrative body denied.
4. No sanctions or contempt citations has been imposed against me by any court or administrative body.
5. I have read and will comply with the Office Patent Trial Practice Guide and the Board's Rules of Practice for Trials set forth in part 42 of 37 C.F.R.
6. I will be subject to the USPTO 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).
7. I have applied to appear *pro hac vice* and have been granted permission to appear *pro hac vice* before the Office in two proceedings in the last three (3) years. *See* IPR2014-00039 and IPR2014-00040.
8. I am an experienced litigation attorney, with 6 years of experience litigating patent cases in federal courts. My experience includes representing a

wide range of clients in complex intellectual property litigation. I have appeared as counsel for Microsoft in a number of litigation matters over the span of my career.

9. I have worked closely with lead and backup counsel in most aspects of these proceedings, including the preparation and strategy behind Microsoft's Petitions and the Declarations of David R. Karger. As such, I have reviewed and am familiar with (i) U.S. Patent No. 6,724,403, the patent at issue in this matter, (ii) the prior art relied upon in Microsoft's Petitions, (iii) the legal and factual arguments made by Microsoft, and (iv) the developments in these proceedings after the filing of Microsoft's Petitions. I have also been involved in a number of other proceedings before the Board and I am familiar with its established practices.

10. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements are made with knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code.

Dated: February 20, 2014

A handwritten signature in black ink, appearing to read "S. M. Border", written over a horizontal line.

Scott M. Border

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), this is to certify that on this 20th day of February, 2014, I caused to be served a true and correct copy of the foregoing **MICROSOFT CORPORATION'S MOTION FOR *PRO HAC VICE* ADMISSION OF SCOTT M. BORDER UNDER 37 C.F.R. § 42.10 (and accompanying DECLARATION OF SCOTT M. BORDER)** by Federal Express on the following:

Richard G. A. Bone (Lead Counsel)
RBone@VLPLawGroup.com;
Patents@VLPLawGroup.com

James M. Heintz (Backup Counsel)
292_IPR_DLAteam@dlapiper.com

Dated: February 20, 2014

Respectfully submitted,

/Jeffrey P. Kushan/
Jeffrey P. Kushan
Reg. No. 43,401
Attorney for Petitioner