

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*.

DECISION

Petitioner's Motion for *Pro Hac Vice* Admission of Scott M. Border  
*37 C.F.R. § 42.10*

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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  
Patent 6,724,403

Microsoft (“Petitioner”) filed a motion for *pro hac vice* admission of Mr. Scott M. Border. Paper 42. SurfCast, Inc. (“Patent Owner”) did not file an opposition to the motion. For the reasons provided below, Petitioner’s motion is *granted*.

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. For example, where the lead counsel is a registered practitioner, a non-registered practitioner may be permitted to appear *pro hac vice* “upon showing that counsel is an experienced litigating attorney and has an established familiarity with the subject matter at issue in the proceeding.” 37 C.F.R. § 42.10(c). In authorizing motions for *pro hac vice* admission, the Board also required 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 9 at 2 (referencing the “Order – Authorizing Motion for *Pro Hac Vice* Admission” in IPR2013-00010, Paper 8).

In its motion, Petitioner asserts that there is good cause for Mr. Border’s *pro hac vice* admission because: (1) Mr. Border is an experienced litigation attorney and has been involved in numerous patent litigations in federal court and in matters before the Board; (2) Mr. Border has represented Petitioner before the International Trade Commission and in various district courts; and (3) Mr. Border worked with lead and backup counsel in most aspects of this proceeding, and therefore has an established familiarity with

Cases IPR2013-00292, IPR2013-00293,  
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Patent 6,724,403

the patent-at-issue, the relevant prior art and the legal and factual arguments, and has kept abreast of developments in this proceeding. Paper 42 at 3-4. In support of the motion, Mr. Border attests to these facts in his declaration with sufficient explanations. Paper 42 at 6-8 (Declaration of Scott M. Border In Support of Motion for *Pro Hac Vice* Admission). Additionally, the motion and Mr. Border's declaration comply with the requirements set forth in the Board's order authorizing Petitioner's motion for *pro hac vice* admission.

Based on the record, we find that Mr. Border has sufficient legal and technical qualifications to represent Petitioner in the instant proceeding. Accordingly, Petitioner has established that there is good cause for Mr. Border's admission. Mr. Border will be permitted to appear *pro hac vice* in this proceeding as back-up counsel only. *See* 37 C.F.R. § 42.10(c).

For the foregoing reasons, it is

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

FURTHER ORDERED that Petitioner is to continue to have a registered practitioner as lead counsel in the instant proceeding; and

FURTHER ORDERED that Mr. Border is to comply with the Office Patent Trial Practice Guide and the Board's Rules of Practice for Trials, as set forth in Title 37, Part 42 of the C.F.R., and 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.*

Cases IPR2013-00292, IPR2013-00293,  
IPR2013-00294, and IPR2013-00295  
Patent 6,724,403

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